

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

**Fourth Session**  
**Geneva, December 12 to 16, 2011**

### **DRAFT REPORT**

*prepared by the Secretariat*

1. The Working Group on the Development of the Lisbon System (Appellations of Origin) ("the Working Group") held its fourth session, in Geneva from December 12 to 16, 2011.
2. The following Contracting Parties of the Lisbon Union were represented at the session: Costa Rica, Cuba, Czech Republic, France, Georgia, Hungary, Iran (Islamic Republic of), Italy, Mexico, Peru, Portugal, Republic of Moldova, Serbia, Slovakia, The former Yugoslav Republic of Macedonia (15).
3. The following States were represented as observers: Australia, Chile, Germany, Indonesia, Malaysia, Romania, Saudi Arabia, Spain, Sri Lanka, Switzerland, Thailand, Turkey, United States of America, Viet Nam (14).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: European Union (EU), World Trade Organization (WTO) (2).
5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: Brazilian Intellectual Property Association (ABPI), Centre for International Intellectual Property Studies (CEIPI), European Communities Trade Mark Association (ECTA), 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) (7).
6. The list of participants is contained in Annex II to this report.

## AGENDA ITEM 1: OPENING OF THE SESSION

7. Mr. Francis Gurry, Director General, opened the session and started the meeting by recalling some developments concerning the Lisbon system since the third session of the Working Group.

8. First, the Director General highlighted some statistics concerning registrations under the Lisbon system, pointing out that to date, 900 appellations of origin had been recorded in the International Register – a figure reached in August 2011. He added that, interestingly enough, 170 of those international registrations – i.e., about 20% – had been recorded after January 1, 1995, i.e., the date on which the WTO TRIPS Agreement had entered into force.

9. The Director General noted that such continued – albeit still relatively modest – use of the international registration system of the Lisbon Agreement showed, together with the increase of its membership since 1997 – from 17 to 27 member States – the interest that existed in an international registration system for appellations of origin in addition to a system for the international registration of geographical indications or, as was being considered in the Working Group, as part of an international registration system for geographical indications.

10. The Director General went on to say that, in September 2011, the Assembly of the Lisbon Union had adopted amendments of Rule 5(3) on Optional Contents of the International Application, and Rule 16(1) on Notifications of Invalidation, as recommended by the Working Group.

11. In that regard, he recalled that, as a result of the amendment of Rule 5(3), a country of origin would have the option of indicating any additional information in an international application, notably factual information that had permitted the grant of protection in respect of the appellation of origin for which international protection was sought, such as particulars that had helped in ascertaining that definition requirements were met and that the link between the product in question and a precise geographical area had been established.

12. Meanwhile, the amendment of Rule 16(1) would require any member State in which the effects of an international registration had been invalidated to indicate in its notification of invalidation to the International Bureau the ground(s) on the basis of which the invalidation had been pronounced. Thus, those grounds would be available from the International Register not only in the language of the notifying member State, but also in the three working languages of the Lisbon system.

13. The Director General recalled that those amendments to the Lisbon Regulations, as adopted by the Assembly, would become effective as from January 1, 2012.

14. He further said 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. E-mail was now being used as the principal means of communication under the Lisbon procedures between WIPO and the competent authorities of 16 member States.

15. He recalled that, as a result of the discontinuation of its paper version, the next issue of the *WIPO Bulletin Appellations of Origin*, the official publication of the Lisbon system, No. 40, would only be available electronically, on the WIPO web site, free of charge and with full text search facilities.

16. He informed the Working Group that an e-mail alert system would be made available for users who would like to be informed whenever a new issue of the Bulletin was published or whenever any new item was posted on the Lisbon pages of the WIPO web site. For that purpose, interested users should convey their e-mail address to the International Bureau of WIPO.
17. As regards the objectives of the fourth session of the Working Group, the Director General recalled that the Working Group had been established in September 2008 by the Lisbon Union Assembly and that its first session had been held in March 2009. As a result of the recommendations agreed at that session, the Assembly had extended the mandate of the Working Group, so as to allow the Working Group to engage in a full-fledged review of the Lisbon system.
18. For the purpose of this review, the Working Group had requested the International Bureau to do a survey on the Lisbon system among stakeholders, in the widest possible sense, i.e. Member State and non-Member State governments, intergovernmental organizations, non-governmental organizations (NGOs) and interested circles; and to prepare a document reflecting the results of that survey. The Working Group had also requested the International Bureau to prepare a document reflecting a study on the relationship between regional systems for the protection of geographical indications and the Lisbon system and the conditions for possible accession to the Lisbon Agreement by competent intergovernmental organizations.
19. The Working Group had discussed those two documents at its second session, in August/September 2010 and, as a result, the International Bureau had been requested to prepare, for the third session of the Working Group, draft provisions on a number of topics, including, in particular, definitions for geographical indications and appellations of origin, the scope of protection for geographical indications and appellations of origin, prior use, applications for geographical indications and appellations of origin concerning products from trans-border areas, accession criteria for intergovernmental organizations, and procedures in Contracting Parties prior to the issuance of possible refusals and for challenging refusals issued.
20. Following discussion of these draft provisions at its third session, in May 2011, the Working Group had requested the International Bureau to prepare a Draft New Instrument (DNI) containing the draft provisions set out in Annex II of document LI/WG/DEV/3/2, as revised on the basis of comments made during the third session of the Working Group, as well as any further draft provisions the inclusion of which would be necessary for making the DNI as complete as possible, while leaving open the question as to the legal instrument by which it might be formalized.
21. In response to that request from the Working Group, the International Bureau had prepared the working documents for the present meeting, i.e., a DNI concerning the international registration of geographical indications and appellations of origin (LI/WG/DEV/4/2) and the draft regulations under the DNI (LI/WG/DEV/4/3), along with corresponding explanatory notes (documents LI/WG/DEV/4/4 and LI/WG/DEV/4/5).
22. The Director General recalled that the objective pursued by the Working Group was to review the international registration system of the Lisbon Agreement so as to make the system more attractive for users and prospective new members while preserving the principles and objectives of the Lisbon Agreement.
23. He further indicated that at its recent meeting, in September/October 2011, a little over two months previously, the Assembly of the Lisbon Union had taken note of the considerable progress made by the Working Group and the planned work ahead in the review of the Lisbon system.

24. The Director General said that, as a result, the task of the Working Group at the present session was twofold, as reflected in the working documents for the present meeting. Firstly, participants were invited to indicate their recommendations with regard to the proposed draft new instrument and draft regulations, in terms of both content and the further preparation of a process that might result in a revision of the Lisbon Agreement and/or a protocol or a new treaty supplementing the Lisbon Agreement. Secondly, participants were invited to decide on any other follow-up action they might deem appropriate.

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

25. Mr. Mihály Ficsor (Hungary) was unanimously elected as Chair of the Working Group, while Mr. Hossein Gharibi (Islamic Republic of Iran) and Mr. Alberto Monjaras Osorio (Mexico) were respectively elected as Vice-Chairs.

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

## **AGENDA ITEM 3: ADOPTION OF THE AGENDA**

27. The Working Group adopted the draft agenda (document LI/WG/DEV/4/1 Prov.) without any modification.

## **AGENDA ITEM 4: ADOPTION OF THE REPORT OF THE THIRD SESSION OF THE WORKING GROUP**

28. The Working Group adopted the revised draft report of the third session of the Working Group on the Development of the Lisbon System (Appellations of Origin), as contained in document LI/WG/DEV/3/4 Prov.2, without any modification.

## **AGENDA ITEMS 5 AND 6: DRAFT NEW INSTRUMENT CONCERNING THE INTERNATIONAL REGISTRATION OF GEOGRAPHICAL INDICATIONS AND APPELLATIONS OF ORIGIN (“DNI”) AND DRAFT REGULATIONS UNDER THE DNI (“DR”)**

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

30. In introducing the documents, the Secretariat said that, at its previous session, the Working Group had requested the Secretariat to prepare a DNI on the basis of the discussions that had taken place on a set of seven draft provisions on seven topics to be addressed in the context of the review of the Lisbon system. More particularly, the Working Group had requested the preparation of a DNI as complete as possible while leaving open the question as to the legal instrument by which it might be formalized. The Secretariat added that various elements of the draft provisions on the seven topics in the previous document had been presented in the form of different options or by the use of square brackets, in particular where a proposed draft had not received sufficient support at the second session of the Working Group. In light of the request made, the question had arisen as to whether such options or square brackets had to be maintained. The Secretariat had come to the conclusion, for the sake of the discussion, to be slightly provocative and make choices one way or the other, and therefore to present options or brackets only in respect of those questions that the Working Group had specifically asked the Secretariat to leave open.

31. As regards the Draft Regulations (“DR”), the Secretariat had come to the conclusion that the most appropriate way of presenting Regulations would be to use the current Lisbon Regulations as a basis and propose adaptations as and when necessary.

32. As for the DNI itself, the Secretariat recalled that the Lisbon system was comparable in structure with the Madrid System for the International Registration of Marks and the Hague System for the International Registration of Industrial Designs, which had already been the subject of a development similar to the review of the Lisbon system embarked upon by the Working Group. In respect of the Madrid system, that had resulted in the conclusion of the Madrid Protocol, in 1989, and in respect of the Hague system in the conclusion of the Geneva Act of the Hague Agreement, in 1999. Both these treaties had built into the system a number of flexibilities which were supposed to allow a much larger group of countries to accede to the Madrid and Hague systems, respectively. In addition, they had introduced into the Madrid and Hague systems the possibility of accession by intergovernmental organizations. For those reasons, the Secretariat had, whenever possible, taken provisions of the Madrid Protocol and the Geneva Act of the Hague Agreement as models when preparing the DNI.

33. Nonetheless, the Secretariat wished to emphasize that the proposed DNI should not be seen as a new start of the review, but rather as a continuation of the discussions that had taken place at the previous session of the Working Group on the basis of the draft provisions presented in document LI/WG/DEV/3/2. The DNI should therefore be examined in the light of those discussions. In that regard, the Secretariat suggested that the Working Group take up the documents under consideration on a topic-by-topic basis using the themes that had been on the table at the previous session of the Working Group. Thus, the issue of the basis for protection and definitions might be discussed first, followed by the issue of the content and scope of protection as a second topic and the issue of prior use as a third topic. The remaining substantive provisions of the DNI, namely Articles 10, 11 and 15, could then be taken up as a fourth item. Thereafter, the procedural provisions could be addressed, beginning with the issue of filing international applications, followed by the issues of international registration, notification of international registration and possible subsequent notifications by Contracting Parties.

34. As a next topic, the preparation of a process that might result in a revision of the Lisbon Agreement and/or a protocol or a new treaty might be addressed, i.e., the issue as to how the Working Group would continue its deliberations after the present session. In that regard, it should be noted that, if it would be possible to finish the review of the Lisbon system at a Diplomatic Conference by the end of 2013, it would be necessary to have a decision by the Assembly of the Lisbon Union in 2012 concerning the holding of such a Diplomatic Conference.

35. Finally, the provisions dealing with “Becoming Party to This Agreement” in Articles 29 and 30 could be addressed, including the issue of possible accession by intergovernmental organizations, as well as Articles 1 and 32, which depended on the form that the DNI would eventually take, and Chapters 6 and 7, which dealt with Administrative Provisions and Revision of the Agreement, respectively.

## GENERAL STATEMENTS

36. The Delegation of Georgia expressed support for the DNI and recalled that Georgia was a country of ancient cultures and traditions which were embodied in unique and millennial products of agricultural nature. Georgia had more than 500 grape varieties with universally known unique features that had survived up to the present day. Exports of agricultural products of traditionally Georgian origin were increasing strongly every year, facilitating recognition of Georgian wines, mineral water, various traditional foodstuffs and other protected goods in the European and global markets. Consequently, the Delegation viewed the protection of

appellations of origin and geographical indications as one of the most important areas of State intellectual property policy. The Delegation emphasized that, as a result of government-wide efforts in the last two years, an agreement between the European Union and Georgia on the mutual recognition and protection of geographical indications of agricultural products and foodstuffs had been concluded in 2010. Along the same lines, negotiations were also underway with non-EU Member States with a view to concluding bilateral treaties to the same effect. The Delegation therefore unequivocally supported the proposed development of a new system for the international registration of geographical indications and appellations of origin and believed that that was a step in the right direction, since active participation of an increasing number of States in the Lisbon system was of utmost importance for the economy of Georgia and for the development of intellectual property law in general.

37. The Delegation of Peru reiterated its strong commitment to the principles and aims of the Lisbon Agreement: Peru attached great importance to the protection of appellations of origin, as it was firmly convinced of their key role in promoting the economic development of countries and as a tool for combating poverty and improving living conditions, especially among rural inhabitants. That was reflected by the fact that Peru had adopted ambitious legislation in that field and had in recent years increased the number of its protected appellations of origin to a current total of eight appellations of origin of an agricultural or handicrafts nature. The Peruvian authorities continued to do their utmost to promote knowledge and use of such protection mechanisms. Indeed, the Delegation of Peru's commitment to the protection of appellations of origin was reflected by the holding of the recent *World Symposium on Geographical Indications*, which was co-hosted with WIPO in June 2011. The Delegation supported all processes for the further improvement of the Lisbon Agreement system, not only because it felt that its members would benefit but also because it was mindful of the need to make the system more attractive with a view to it being made universal. In that respect, the Delegation recalled that the terms of reference of the Working Group were to examine the international registration system embodied in the Lisbon Agreement with a view to making the system more appealing for users and prospective new members, while maintaining the principles and aims of the Agreement. However, the Delegation also considered that the review process underway should be aimed at clarifying, simplifying, complementing and improving, but not replacing, the system. In its view, the review should strengthen the current regime, and it was therefore prepared to contribute to the debates that would take place at the current session of the Working Group with a view to achieving that goal.

38. The Representative of the European Union also expressed support in respect of the efforts to review the Lisbon system with the objective of making the system more attractive for users and prospective new members. She reiterated the importance of ensuring that the DNI and DR were compatible with the TRIPS Agreement and the Doha Development Agenda negotiations within the framework of the WTO and welcomed the progress made so far, as demonstrated by the DNI. Nonetheless, the European Union would also like to see provisions in the DNI for an efficient means to settle disputes between interested parties, e.g. via the WIPO Arbitration and Mediation Center.

39. The Delegation of Switzerland said that even though Switzerland was not party to the Lisbon Agreement, it wished to participate actively in the Working Group, as it had done in the past, with a view to making the Lisbon system more attractive for new members. It had carefully studied the DNI, which was indeed close to the Hague and Madrid registration systems, and said that that option could be examined in the context of the Working Group. Nevertheless, it was of the view that the Lisbon system had to go beyond a simple international registration system. As the Delegation saw it, the Lisbon Agreement had to offer a high level of protection not only for appellations of origin but also for geographical indications.

40. The Delegation of Italy called for a balanced and ambitious result that would encourage new member States to join the Lisbon system while also preserving the advantages of the current system. The Delegation expressed its preference for a single level of protection for geographical indications and appellations of origin. Although the aim behind the introduction of a broad geographical indication definition was to promote accession by those WIPO Member States that did not have different definitions for geographical indications and appellations of origin, the Delegation was of the view that it was questionable that this would require the DNI to lay down different levels of protection for geographical indications and appellations of origin. When doing so, there might be a risk of having a differentiated and asymmetrical level of protection for geographical indications and appellations of origin that would produce unbalanced results. Like Switzerland, the Delegation was of the view that the work of the Working Group should move beyond a simple registration system and aim for a more ambitious level of protection for both geographical indications and appellations of origin. The Working Group should focus on improving the Lisbon Agreement or perhaps consider a dual track approach, with one track focusing on registration and the other on improvement of the Lisbon Agreement. The Delegation stood ready to engage in such an exercise, and the Working Group could count on its constructive spirit and collaboration.

41. The Delegation of Serbia strongly supported further work in developing the Lisbon system in order to make it more attractive for the accession of potential new members. The Delegation acknowledged the importance of introducing geographical indications into the system and recalled that, at the previous session, the emphasis had been placed on the definition of appellations of origin and geographical indications, as well as on the issue of their scope of protection. Various options had been presented regarding those very complex issues, and the DNI represented significant progress in the modernization of the Lisbon system in a way that would be beneficial to all. The Delegation stressed its strong desire to collaborate in an open-minded and dedicated way, and believed that with a positive spirit and constructive engagement, the Working Group would certainly have a fruitful discussion.

42. The Representative of ORIGIN believed that the DNI contained positive advances, in particular the introduction of the concept of geographical indications and the possibility for producer groups to submit an international application directly to WIPO. However, there were also some problematic points, such as a certain level of complexity in reading the DNI, which might not fulfill the objective of making the system more attractive for users. By way of example, he referred to the issue of protection, which was dealt with in Articles 3, 6, 9 as well as in several other articles. As mentioned by the Delegations of Italy and Switzerland, the Representative of ORIGIN also believed that a double level of protection would be problematic, and recalled that, at the previous session, many interventions had called for a single level of protection for both geographical indications and appellations of origin. It would therefore be preferable to work at least on two parallel texts, one with a single level of protection and one making a distinction between different levels of protection for geographical indications and appellations of origin such as the text under consideration.

43. The Delegation of Cuba said that its country was committed to keep working to improve the system, provided that the principles and aims of the Lisbon Agreement were duly safeguarded. It would surely be necessary to pursue efforts aimed at rendering the system more attractive for users and prospective new members, without, however, losing sight of the system's key components, which were spelled out in the text of the Agreement. The Delegation further asked the Secretariat to keep the document open for future comments, which could be sent in writing in the coming months and could also be submitted at the next session of the Working Group. The Delegation emphasized that, under the present circumstances, active participation in the discussions of the Working Group was extremely important inasmuch as some member States displayed the political will to promote the adoption of decisions within the

Working Group aimed at making the system more appealing for users and prospective new members. However, any new legal instrument had to be studied in detail prior to its submission for adoption in plenary.

44. The Representative of AIPPI pointed out that the Working Group was working on a document that should be appealing for new members while enhancing the protection of two important forms of intellectual property. The Working Group had to keep in mind that the proposed DNI would be important for national economic growth, as it would be used, interpreted and enforced in many jurisdictions. Attention should therefore be devoted to the wording used therein, which in AIPPI's view had to be broad enough without being ambiguous. The Working Group should bear in mind that the DNI would ultimately be used and implemented by actual holders and users of appellations of origin and geographical indications.

#### BASIS FOR PROTECTION AND DEFINITIONS (ARTICLES 2 AND 3)

45. The Secretariat indicated that the provisions on the basis for protection and definitions could be found in Article 3 as well as in the related abbreviated expressions in subparagraphs (vii) and (viii) of Article 2. Article 3 followed quite closely the provisions discussed at the previous session while also introducing some new elements. The Secretariat started with the elements that were already contained in Draft Provision A, as presented to the previous session of the Working Group, in May 2011. The question of the basis for protection had already been addressed several times by the Working Group, and on each occasion, it had been confirmed that the basis for protection as provided for under national law or regional law would be the subject of flexibility. In other words, there was a possibility that a country would implement the provisions and provide protection on the basis of a *sui generis* form of legislation for geographical indications and appellations of origin, or for geographical indications only, but it would also be possible to provide such protection on the basis of other legislation. Consequently, Article 3(3) stated clearly that protection could be provided through *sui generis* legislation or other legislation. Article 3(1) was modeled after Article 1(2) of the Lisbon Agreement and functioned as the introductory paragraph for the entire article. Explaining the distinction between the legal instruments referred to in Articles 3(2) and 3(3), the Secretariat said that, on the one hand, Article 3(3) concerned legal instruments through which protection was available for geographical indications and appellations of origin, while on the other hand, Article 3(2) concerned instruments by which the grant of legal protection was effected in respect of an individual geographical indication or appellation of origin, e.g. by virtue of its actual registration. As explained in the report of the previous session of the Working Group, the fundamental difference was that the instrument by which protection was granted to an individual geographical indication or appellation of origin could be either a legislative act, or an administrative act, or a judicial decision, or a registration, effected by an Office granting protection or in the case of a judicial decision, by a Court providing protection. Such a grant of an individual right would occur under the law that a country had enacted for the protection of geographical indications and appellations of origin.

46. Continuing, the Secretariat said that Article 3(4) addressed the question of what had to be done if a geographical indication originated from an area which was covered by two or more different countries. In that respect, the Secretariat recalled that there had been agreement and a clear desire from the Working Group to allow for such geographical indications or appellations of origin to be registered jointly by the countries concerned. The Secretariat indicated that even though that was not as an obligation, the option still had to appear in the text and that was precisely the aim of Article 3(4). However, if the countries in question could not agree on a joint application they would still have the other option, namely to apply only for the part of the territory which was situated within their borders with respect to the geographical indication or appellation of origin in question.



47. Turning to the question of definitions, the Secretariat referred to Articles 2(vii), 2(viii), 3(2), and 3(5). Article 3(2) laid down the definitions for geographical indications and appellations of origin and it did so by reference to Article 3(5). Article 2(vii) and (viii) clarified that appellations of origin formed a special category of geographical indications. Article 3(5)(c) introduced a new element. As explained in paragraph 3.07 of the Notes on Article 3 contained in the document LI/WG/DEV/4/4, the negotiating history of the Lisbon Agreement showed that the 1958 Diplomatic Conference had decided to add a definition of appellations of origin to the draft treaty – which until then had not contained a definition of appellations of origin, but only a definition of country of origin – in order to make it clear which appellations of origin registered under the Lisbon Agreement would require protection in the other members of the Lisbon Agreement. At the same time, the Diplomatic Conference had, however, clarified that such a definition would not preclude the use of national definitions for appellations of origin that would be broader or more precise. In other words, the negotiators had recognized that, if one would specify a definition in the treaty itself, such a definition might not be identical to each and every definition which existed at the national level, and in such cases, appellations of origin registered that did not meet the definition of the Lisbon Agreement could be refused. The novelty introduced by Article 3(5)(c) was that appellations of origin or geographical indications protected in the country of origin on the basis of that kind of other definition could not be refused by another Contracting Party whose law provided for protection on the basis of the same definition. Article 3(5)(d) specified that Contracting Parties would not have the option of applying stricter definitions with respect to geographical indications or appellations of origin registered under the DNI.

48. The definition of geographical indications under Article 3(5)(a) followed the text that had been discussed at the previous session of the Working Group, whereas the definition of appellations of origin under Article 3(5)(b) had been adapted on the basis of comments made in respect of the text discussed at the previous session of the Working Group. Article 3(5)(b) stipulated that the geographical environment underlying protection at the national level for an appellation of origin could be based on either on natural or human factors or on natural and human factors. In that regard, a country would be free to establish those cumulative requirements as existed under the current Lisbon Agreement but, since other countries had implemented laws which allowed for natural or human factors to form such a basis, it would be appropriate to reflect that as well in the DNI without, however, obliging those countries which required a cumulative application of those factors at the national level to protect the denominations in question as appellations of origin under the DNI. The notion of reputation had been incorporated in the proposed definition of appellation or origin by using the terms “known as the designation of a product that originates in a given geographical area”.

49. By way of introduction, the Delegation of France raised several points on which views had been exchanged at previous sessions, in particular the reasons why the Lisbon Agreement was not perceived as attractive. It recalled, in that connection, the proposal to close the system, which some saw as a regime reserved for certain types of legislation. In addition, it emphasized that issues relating to an overly restrictive definition of appellations of origin, the need to include geographical indications, and the scope of protection had also been taken up. At the time, the Delegation had considered that Article 3 of the DNI was at the heart of the system and its development, because it dealt with two main points which, according to the analyses conducted, diminished the attractiveness of the Lisbon Agreement. However, it found the wording a bit complex in certain respects, particularly with regard to the first point which had been taken up, where the consistency and the link between paragraphs (2) and (3) was sometimes difficult to see. Did paragraph (2) therefore cover systems that could be put in place by States, whereas paragraph (3) covered the individual act recognizing a given appellation of origin or geographical indication? Accordingly, the Delegation wondered why the notion of *sui generis*

legislation appeared suddenly in paragraph (3), whereas it had not been mentioned in paragraph (2). The Delegation stressed that that kind of treatment did not facilitate an understanding of the different scope of the two paragraphs in question.

50. Moreover, as far as the definitions of “appellations of origin and “geographical indications” were concerned, the Delegation was somewhat surprised by the definitions proposed by the Secretariat, not so much with regard to the definition of “geographical indications”, because it took up elements with which all were familiar, but rather in respect of the definition of “appellations of origin”. In its opinion the Secretariat appeared, however, to have opted for a negatively worded definition that was only dealt with through the refusal to grant protection. The Delegation specified that it had difficulty understanding why the previous wording had been dropped, both the wording contained in the Lisbon Agreement for appellations of origin and that of the TRIPS Agreement for geographical indications, where a simple definition had been given in both cases. The Delegation understood clearly the definition provided by the Secretariat, which referred to the Diplomatic Conference of 1958, but added that it still had trouble seeing the paragraph in connection with Article 19, which dealt with refusals to grant protection. It therefore wondered whether, in the end, there might be two articles in the case at hand dealing with the same subject matter, given that a form of refusal to grant protection was also involved, namely, the possibility of refusing protection if a given definition was not met. Consequently, it considered that the issue involved had to be covered by Article 19, not Article 3.

51. With regard to the other element concerning the definition of “appellations of origin”, particularly the alternative character which appeared in the phrase “natural and/or human factors”, the Delegation seemed to recall that at previous sessions, there had been a majority in favor of keeping the current definition and was therefore surprised by the present turn of events, all the more so in view of the fact that the reference to “geographical indications” already provided the requisite flexibility for the definition. It considered that introducing the notion of “geographical indications” injected the flexibility needed to accept products which bore the appellations to be protected and which would not satisfy the definition of “appellations of origin”. Moreover, the Delegation felt that the notion of “*notoriété*” was somewhat concealed by the use of the term “*connue*” and that it was therefore possible to consider that the reputation criterion had not been sufficiently developed. Finally, the Delegation asked for clarifications as to the real scope of Article 3(5)(c), because it did not understand what was meant with that provision and in particular the “other definitions” that did not appear to be covered by the Agreement. It therefore requested the Secretariat to provide clarifications in that respect with a view to explaining the scope of the provision.

52. The Delegation of Italy supported the points raised by the Delegation of France regarding the negative approach as to the definition of geographical indications and appellations of origin, and would prefer the reputation criteria to be more clearly defined in the definition of appellations of origin. Moreover, the Delegation requested further clarification on the scope of Article 3(5)(c).

53. The Delegation of the Republic of Moldova supported the comments made by the Delegation of France in that negatively worded definitions were difficult to understand, and preferred to see them drafted in a more positive way. The Delegation asked whether that provision had to be understood as “the Contracting Party may not protect a geographical indication only if the definition is not met”, and if so, wondered what should be done with prior well-known trademarks because under the Republic of Moldova’s domestic law, there was a provision by virtue of which an appellation of origin could be refused if a prior well known trademark already existed.

54. The Delegation of Portugal aligned itself with the Delegations of France, Italy and the Republic of Moldova, in particular as regards the complexity of Article 3 and the negatively worded definition, as well as the issue of natural and/or human factors.

55. The Delegation of Peru also preferred a positively worded definition of “appellations of origin” and “geographical indications” before developing a definition based on refusal of protection. Moreover, when it read the definition proposed by the Secretariat in the DNI, it wondered whether what was being proposed was in reality a substantive change to the legal nature of what had been the introduction of “appellations of origin” as intellectual property rights. In its view, the definition of “appellations of origin” had undergone considerable change, insofar as the reference to “natural and human factors” contained in the current Lisbon Agreement had been replaced by “natural and/or human factors”. In other words, there had been a shift from a cumulative requirement to a more alternative approach. The Delegation further saw the danger of a change in an institution which already contained a precedent in respect of the Lisbon Agreement and with regard to domestic or regional legislation. In the case of Peru, where regional legislation applied to the four member countries of the Andean Community, what was involved was a cumulative requirement, following a legal and historical tradition with regard to appellations of origin.

56. The Delegation of Mexico was concerned precisely by the negatively worded definitions conveyed by Article 3(5)(a) and (b). As it saw things, such definitions would open the door for substantive examinations by each Contracting Party to determine whether or not an appellation of origin or a geographical indication was involved in a given instance. It therefore suggested new, more precise wording stipulating in which cases Contracting Parties could stop protecting an appellation of origin or a geographical indication that was already subject to international registration.

57. The Delegation of Hungary shared the views expressed by other delegations as regards the proposed definitions, and more particularly on the way in which such definitions were formulated. The Delegation was in favor of a more positive definition for both categories, but was in general not opposed to the idea of having two separate categories and considered the proposal of having a broad and general category for geographical indications, which would include appellations of origin as a specific subcategory, to be perfectly acceptable. However, with regard to the proposed definition for appellations of origin, the Delegation was not certain whether the requirement for reputation in the proposed wording was the correct one. In addition, the Delegation preferred to keep the former wording concerning natural and human factors, and expressed its satisfaction following the clarification of the Secretariat that Article 3(4) was merely optional. Finally, the Delegation requested further explanations on the scope of Article 3(5)(c).

58. The Delegation of Spain endorsed the comments made by other delegations, such as those of France, Hungary or Italy, in relation to the need to establish definitions of a positive rather than a negative nature, given that positively worded definitions would be much more useful and easier to understand. With regard to definitions, it wondered whether it might be possible to adapt Article 2, which set out abbreviated expressions and definitions, with a view to defining at that stage what was meant by appellations of origin and geographical indications. That would also create a more user-friendly document, as it would eliminate cross-references between articles to a large extent.

59. The Delegation of Switzerland associated itself with the views expressed by the Delegations of France, Italy, the Republic of Moldova and Spain, among others. With regard more specifically to Article 3, it also favored a more positively worded definition of geographical indications and appellations of origin, so as to strengthen and promote protection of geographical indications. In the Delegation’s opinion, there had to be a specific article devoted

to refusal of protection, as was already the case with the Lisbon Agreement, rather than dealing with the question of refusal via protection or via definitions. In that respect, it found the proposal by the Delegation of Spain to introduce definitions of geographical indications and appellations in origin in Article 2 to be interesting and timely. With regard to the definition of geographical indications, the Delegation took due note that the definition was directly based on the TRIPS Agreement but also noted that the definition had not been taken up as it stood, and therefore recommended using the same definition as the one contained in the TRIPS Agreement. In particular, it noted that the term of “*notoriété*” rather than that of “*réputation*” had been introduced, which in its view could well lead to pointless interpretation issues to determine how to interrelate those two articles and those two notions. The Delegation further had serious doubts as to the usefulness and impact of Article 3(5)(c), as did other delegations. Finally, with regard to Article 3(2), and more particularly the reference made to the “legal instrument applicable in the geographical area of origin”, it could understand that the instrument in question tried to encompass more than the notion of a State or country as such. However, as the notion of a geographical area of origin could be interpreted more narrowly than the territory of a State, it would be preferable to switch to concepts such as “Contracting Party”.

60. The Representative of the European Union noted that according to Article 2(viii) of the DNI and Rule 1(iv) of the DR, the term “*appellation of origin*” meant a “geographical indication defined as an appellation of origin in accordance with Article 3(5) of this Agreement”, whereas under Article 3(5)(b) that term referred to a “geographical denomination known as the designation of a product that originates in a given geographical area, including any denomination traditionally known as designating the geographical origin of a product”. Given that, according to the Notes on Article 2, the intention was to make clear that appellations of origin form a special category of geographical indications, the Representative thought that it would be pertinent to bring Article 3(5)(b) into line with Article 2(viii) and added that a possible solution in that regard would be to clarify the relationship between appellations of origin and geographical indications directly in the DNI. As regards Article 3, the Representative could go along with the proposed protection of both “geographical indications” within the meaning of Article 22.1 of the TRIPS Agreement and “appellations of origin” based on the current definition provided under Article 2 of the Lisbon Agreement. She could support the possibility under Article 3(5)(c) to protect also any geographical indication or appellation of origin registered under the Agreement on the basis of another definition, which would be broader or more precise. She was of the view that broadening the scope of protection in such a manner would allow for the flexibility needed and would significantly contribute to making the Lisbon system more attractive. Referring to Article 3(5)(b), the Representative sought clarification of the term “denomination traditionally known as designating the geographical origin of a product”. Like the Delegation of Switzerland, she believed that it would be appropriate to align Article 3(5)(d) with the definition of geographical indications in Article 22 of the TRIPS Agreement by amending that Article along the following lines: “In any event, a Contracting Party shall not apply a stricter definition than the definition of a geographical indication under Article 22 of the TRIPS Agreement to refuse protection under this Agreement in respect of international registrations of other Contracting Parties”. The Representative asked whether a term such as “*Reblochon*” would also be covered by the definitions. In that regard, she referred to Article 2(2) of EU Regulation 510/2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs, which laid down that “traditional geographical or non-geographical names designating an agricultural product or a foodstuff which fulfills the conditions... shall also be considered as designations of origin or geographical indications”. Such language would also be useful for the purpose of the DNI, and the Representative sought further clarification of Article 3(3), in particular its reference to the scope of protection.

61. The Representative of ORIGIN supported the delegations that had expressed some doubts as to the negative formulation of the proposed definitions for appellations of origin and geographical indications, and believed that a more positive approach would be necessary. In

particular, he was of the view that the current wording of Article 2 of the Lisbon Agreement, namely “appellation of origin means”, which by analogy could also read “geographical indication means”, would be more appropriate. He shared the comment made by the Delegation of Switzerland as to the definition of geographical indications, and would prefer such a definition to better match the one contained in Article 22.1 of the TRIPS Agreement. In the same manner, the definition of appellations of origin should remain similar to the one contained in the Lisbon Agreement. Introducing a concept of geographical indications as defined in the TRIPS Agreement would allow a large number of States to join the Lisbon system, as the TRIPS definition was the most widely accepted. Along the same lines, the Representative did not understand the rationale for Article 3(5)(c) and (d) and sought clarification as to the necessity of having those two paragraphs. As to the basis for protection, the Representative understood the attempt made by the Secretariat to clarify that not all countries had *sui generis* systems, but wondered whether, in view of Rule 5(2)(6) of the DR, it was necessary to also deal with that issue in the DNI.

62. The Representative of CEIPI suggested replacing the words “provided that” with the words “as long as” in the third line of Article 3(2). He added that the expression “as long as” came from Article 6 of the Lisbon Agreement and that there were no strong reasons for amending that expression. For the rest, the Representative supported the Delegation of France and all those who had spoken afterwards, particularly with regard to the two doubly negative definitions in Article 3(5)(a) and (b), which should indeed be worded positively. As the Delegation of Spain had already indicated, those definitions could be included in Article 2, thereby considerably simplifying the wording. As for Article 3(5)(b), which defined appellations of origin, he was also in favor of keeping the present wording, which referred to “natural and human factors”. Finally, with regard to Article 3(5)(c), he asked the Secretariat to provide concrete examples, especially those given at the 1958 Conference, as applicable, because that would help participants understand better what had been behind the statement made at the 1958 Diplomatic Conference.

63. The Representative of ECTA raised a couple of questions concerning Article 3(5), and noted in particular that when one departed from the premise that one had to keep the system simple and that appellations of origin were a subspecies of geographical indications, it was difficult to believe that that was indeed the case when reading the proposed definition. In that respect, he preferred to see more or less the same kind of definition as the one contained in EU Regulation 510/2006, notably in the second line of Article 3(5)(a) of the DNI which referred to “indication identifying” whereas Article 3(5)(b) referred to “denomination known”. In his view, it would be preferable to refer to “indication” instead of “denomination” as that would somewhat broaden up the concept. He also noted that Article 3(5)(a) of the DNI was more or less similar to the definition of geographical indication in the TRIPS Agreement. However, he deplored the absence of the phrase “as originating in the territory”. He also noted the use of the expression “known as” in Article 3(5)(b), which was different from “reputation”. As regards Article 3(5)(d), he pointed out that the expression “not applies stricter” was used while the explanation contained in the Notes referred to “narrower”, and he wished to know what the difference between those two terms was. He made a small vocabulary remark in Article 3(5)(a),(b) and (c) where the word “may” was used, whereas the word “shall” was used in Article 3(5)(d). He therefore wished to know the reason for such a difference in vocabulary.

64. In view of the comments made, the Chair indicated, as a general policy comment on how to achieve greater flexibility in order to make the system more attractive, that one approach could be to maintain the provisions of the Lisbon Agreement and its Regulations more or less in their current state and only add new provisions where necessary to allow the international registration of geographical indications in addition to appellations of origin. Another approach could be to look at the existing provisions of the Lisbon Agreement and its Regulations and to

amend some of them, especially those that appeared to stand in the way of accession of prospective new members. In his view, the question as to whether those two approaches could be combined had to be further considered by the Working Group.

65. The Secretariat said that, if a system with two definitions and different levels of protection were to be maintained, it would be important for the review process for the Working Group to provide an explanation as to why it would be necessary to limit appellations of origin to products that were based on “natural and human factors”. In that connection, the Secretariat clarified that the DNI aimed to establish a system in which a Contracting Party requiring certain appellations of origin to be defined by both natural and human factors would have an opportunity to refuse an appellation of origin for a product that would not meet that cumulative requirement.

66. The Secretariat noted the suggestions made for a dual track approach, i.e., to focus, on the one hand, on an international registration system like the Madrid system, without provisions dealing with substantive law, and, as a second track, on a separate instrument, e.g. a protocol, dealing with substantive law.

67. As far as the question of the negatively worded definitions was concerned, the Secretariat referred to Article 3(2) of the DNI, which stipulated that “protection... shall be provided in respect of a geographical indication or appellation of origin that meets the respective definition of paragraph (5)”. In other words, that provision had the effect of putting the negatively worded definition of paragraph (5) in a positive way. One could not simply reiterate in the DNI the definition of geographical indication of the TRIPS Agreement and the definition of appellation of origin of the Lisbon Agreement, as it had already been agreed that additional elements had to be inserted, notably in order to explicitly specify their application in respect of trans-border areas and non-geographical terms that were traditionally known as geographical indications or appellations of origin.

68. Regarding Article 3(5)(c), in response to the question as to whether examples of broader or more limited definitions than the one stipulated in the Lisbon Agreement had been given at the Diplomatic Conference of 1958, the Secretariat indicated that he did not recall that examples appeared in the negotiating history. However, other documents might provide some assistance. In that respect, he referred to a document originally produced in 2001 by the World Trade Organization<sup>1</sup>, which presented a summary of the answers to the TRIPS Council’s questionnaire that WTO members had given on their application of the provisions of the TRIPS Agreement on geographical indications. One of the chapters in that document dealt with definitions, and indicated that there were two main definitions that countries had identified as definitions that they had put in place to implement their obligations under the TRIPS Agreement. One of the two definitions was the definition of Article 22.1 of the TRIPS Agreement, whereas the other was the definition of Article 2(1) of the Lisbon Agreement. However, the WTO document also identified variations of those definitions applied in national law. In addition, the document specified in an annex a whole list of national definitions with a completely different formulation. In 2002, in the context of the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, the WIPO Secretariat had prepared a document on the definition of geographical indications (document SCT/9/4), which explained the issue of definitions in a similar manner, namely that there were two main definitions but that some countries had enacted these definitions with variations. For example, if the Secretariat recalled correctly, some of the definitions for geographical indications added the phrase “including natural and human factors”, while there were also definitions requiring a geographical indication to have an

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<sup>1</sup> WTO document IP/C/W/253. An updated version of this document is available as document IP/C/W/253/Rev.1.

established quality, general reputation and other characteristics. As regards the question as to the limits of Article 3(5)(c), and whether the provision would also extend to any indication of source, the Secretariat said that the provision had been drafted without any such limitation.

69. The Secretariat also clarified that the element of reputation, as contained in Article 2(2) of the Lisbon Agreement, had been incorporated in the definition of appellations of origin of Article 3(5)(b) through the insertion of the phrase “denomination known as the designation of a product that originates in a given geographical area”. The phrase “known as the designation of a product that originates in a given geographical area” had been used to indicate that the product had to be known to consumers, which was another way of circumscribing reputation.

70. The Secretariat said that the definition of geographical indications in Article 3(5)(a) did not include the phrase contained in the definition of the TRIPS Agreement requiring the product to originate in the territory of a WTO member, in light of the need to have a definition that would also apply to trans-border areas.

71. Finally, as regards the distinction between a legal instrument establishing protection for geographical indications or appellations of origin, and a legal instrument granting protection to an individual geographical indication or appellation of origin, the Secretariat recalled that the application form for an international registration under the Lisbon Agreement required the identification of the legal instrument by which protection had been granted at the national level, such as the registration, ministerial decree or judicial decision that had been issued in order to provide the protection to the appellation of origin in question. However, international applications received by the International Bureau often identified the basic law, i.e., the geographical indications law or the industrial property law. Hence, since what had to be indicated was apparently not clear, the Secretariat had decided to explain the requirements more clearly in the proposed DNI, notably by specifying two types of legal instruments, namely, on the one hand, the law which provided the protection in general terms, and, on the other hand, the registrations, judicial decisions or ministerial decrees which provided such protection in respect of a specific appellation of origin or geographical indication.

72. The Delegation of Iran (Islamic Republic of) suggested reading the proposed articles under the DNI in conjunction with the report of the previous Working Group sessions prepared by the Secretariat. The Delegation recalled that many comments and suggestions that had been made by member States and that did not conflict with the principles and objectives of the Lisbon Agreement had indeed been incorporated in the DNI. Upon reading Article 3 in conjunction with the report of the third session of the Working Group, the Delegation was of the view that most of the elements incorporated in the DNI had been suggested by the Working Group. Referring to the negatively worded definitions, the Delegation believed that it was a way to comprehensively capture the issues at stake. Possible alternatives to such negative formulations would be either to provide more comprehensive definitions in Article 2(vii) and (viii) of the DNI or simply delete “not” in Article 3(5)(a) and (b) so that the text would for example read “A Contracting Party may protect a geographical indication registered under this Agreement...”. As regards the sentence “natural and/or human factors”, the Delegation agreed with the Secretariat insofar as for some products, the “human” factor was more important than the “natural” factor, as for example in the case of handicrafts. In that respect, it referred back to the example of nomad people producing handicrafts to point out that obviously in such a case, the human factor was largely predominant. The Delegation added that its interpretation of the sentence “natural and human factors” was that a product was required to have both elements to be protected as an appellation of origin, whereas under the expression “natural and/or human factors”, a product could still qualify for registration if at least one of the two requirements was satisfied. The Delegation referred back to paragraph 80 of the report of the third session of the Working Group in that regard.

73. With regard to the Working Group's approach and in light of the comments made by the Delegation of Iran (Islamic Republic of) in that respect, the Delegation of France recalled that the Working Group's third session had been a sort of initial examination, where all had been able to express their views on the directions identified in the first draft that had been submitted by the Secretariat. In that regard, the Delegation added that the Working Group had not achieved conclusive outcomes on a number of points, even though it had been able to identify positions held by a majority or points on which there were more Delegations in favor of a specific stand. It further emphasized that the Secretariat had committed itself to drafting on the basis of those elements. It then referred to the words of the Chair, namely, that the debate was open once again on those conclusions and that those were only options which had been presented to the members of the Working Group. Consequently, the conclusions had to be discussed once again at the current session, in the same spirit of openness that had prevailed at previous sessions. For example, when the discussion had resumed between "natural and human factors" and "natural and/or human factors", the report of the Working Group's third session had not been conclusive at all on that point and the Secretariat's proposal in that regard took up a position that had been defended by very few delegations. Consequently, the Delegation asked for a brief reminder of the Working Group's working methods in order to avoid any ambiguity, particularly with regard to that last point. Failing that, it urged the Chair to indicate clearly that the delegations had to take positions at the close of each debate on the different issues before them, as that would avoid, for example, reopening at the Working Group's next session the same questions on the definition of appellations of origin, the scope of protection, or the definition of geographical indications. However, it emphasized that the Working Group would have to be reconfigured if the goal was to achieve conclusive outcomes.

74. With regard to the substance of the proposals made, especially those relating to Articles 3(2) and 3(3), it did not always understand the clear separation between those two provisions. In particular, it noted that those provisions were closely interrelated, given that Article 3(2) referred to Article 3(5), whereas Article 3(3) referred to Article 3(2) and to Article 9. That made the section in question extremely complex, and if the goal was to make the Agreement more attractive, it also had to be easier to understand in terms of the obligations it entailed. Accordingly, the Delegation called for a simplified proposal that would avoid links between different provisions or between different paragraphs, where such cross-references were not necessarily essential for understanding the subject matter of the provision and tended to create doubt. As for the protection of geographical indications or appellations of origin in the French version of Article 3(2), it noted for example that the text stipulated that both should benefit from protection granted "by virtue of" of a whole series of acts which could serve as a basis for protection. The Delegation of France deemed that a single text relied too heavily on "by virtue of" and therefore suggested simplifying the wording. Moreover, after noting that Article 3(3) indicated that what was referred to in the previous paragraph could be a national law or a law that applied to the member States of an intergovernmental organization, it thanked the Secretariat for having thus sought to deal with an issue of particular interest for France, given that part of the French mechanism for the protection of geographical indications was henceforth based on European regulations. It felt, however, that the term "law" was perhaps not appropriate, and emphasized that Article 3(3) contained a reference to the protection afforded under Article 9, the thrust of which it did not fully understand in the case at hand. Finally, after underscoring that the reference to "by virtue of *sui generis* legislation or other legislation" appeared once again in Article 3(3), it reiterated the need to simplify the proposed wording and clarify what each of the paragraphs was intended to cover.

75. With regard to Article 3(5)(c), the Delegation took note of the explanation that States sometimes applied definitions differently because some were not comfortable with the definitions in the TRIPS Agreement or those in the Lisbon Agreement. It emphasized in that respect that some forms of wording could nevertheless give rise to concern, such as that of Brazil, which used the notion of "indications of source" to refer to what others would call



“geographical indications”. There as well, the Delegation asked for clarification as to the intended subject matter, because it felt that Article 3(5)(c) opened the door to bilateral protection. It considered that whereas a multilateral protection system was involved, the provisions of Article 3(5)(c) implied that if two States agreed on the definition of a geographical indication or shared the same definition, they could decide to protect their respective geographical indications bilaterally.

76. As regards the working methods of the Working Group, the Chair recalled that three sessions of the Working Group had taken place at which there had already been successive discussions on the Results of the Survey, the Study and the Draft Provisions<sup>2</sup>. In that regard, he said that he had tried to sum up those discussions whenever it seemed appropriate, bearing in mind that he was not supposed to draw conclusions that did not meet with the unanimous approval of the Working Group. While differences of view could only be mentioned in the Summary by the Chair, all the Summaries by the Chair of the three previous sessions of the Working Group as well as the reports of these sessions had been adopted unanimously. As that working method had so far been regarded as appropriate by the Working Group, he would prefer to continue to proceed in the same manner, on the understanding, of course, that nothing was conclusive, including the conclusions drawn by the Chair, until the conclusion of a new instrument. On the other hand, he said that efficiency dictated that whenever some sort of common ground had been found, the Working Group should only depart therefrom if there were compelling reasons for doing so. Of course, if any delegation realized that a preliminary agreement that had been reached did not really meet its interests, that delegation was free to voice its concerns.

77. The Delegation of Cuba viewed the wording of Article 3 as complex, in that not all of the elements which constituted the subject matter of protection were described or simplified. It was therefore necessary to keep working on the wording of the different paragraphs of Article 3, and in particular to change the negative formulation in which many of its components were expressed. With regard to Article 3(5)(a), speaking of “*notoriedad*” did not reflect the concept of “*reputación*”, as expressed in the definition provided by the Lisbon Agreement. Moreover, Article 3(5)(b) referred to “natural and/or human factors”, whereas in reality the interpretation to which Cuba had adhered since it acceded to the Lisbon Agreement was that natural and human factors invariably affected the reputation of a product. The Delegation therefore considered that the new wording implied a variation of the concept which currently governed the Lisbon Agreement and that it contradicted long-standing efforts and ran counter to legislation adopted by Cuba. Moreover, the text spoke of what could happen when changing from one area to another while maintaining the concept of geography as such but not that of natural and human factors. That was also of concern to the Delegation, as it considered that the interpretation when speaking of human factors would vary when geography changed as well. Consequently, the Delegation could not accept the current proposed wording for those paragraphs, and deemed it necessary to continue working together to arrive at wording that did justice to the concept in question. It was also extremely concerned by the fact that the current wording of Article 3 was inconsistent with such core components of the Lisbon system as the definition of appellations of origin.

78. As an observer, the Delegation of Indonesia was very keen to follow deliberations in the Working Group, as Indonesia was considering acceding to the Lisbon system, which appeared to be suitable to its national interests and compatible with its legal system for intellectual property protection. In general, Indonesia protected geographical indications as a subset of trademarks under Law 15/2001 and also under special regulations. Under the Indonesian system, the geographical indication definition was based on the TRIPS Agreement, to which the country was already a party, whereas the indication of source definition was based on the

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<sup>2</sup> Documents LI/WG/DEV/2/2, LI/WG/DEV/2/3 and LI/WG/DEV/3/2, respectively.

Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods, despite the fact that Indonesia was not a party to that Agreement. Even though Indonesian legislation did not use the term appellation of origin as such, it still referred to certain aspects of appellations of origin, given that some elements of the TRIPS Agreement had been combined with some elements of the Lisbon system therein. In that regard, the Delegation was particularly keen to follow the debate on the definitions proposed in the DNI. The Delegation also pointed out that it did not use cumulative requirements to establish a link between the product and the geographical origin. Instead, such a link could be established either by natural factors, by human factors, or by a combination of both. In that regard, the Delegation preferred to continue using alternative rather than cumulative requirements. As regards the scope of protection, the Delegation indicated that an effort was made to protect national resources by conferring on such products a level of protection as high as the one provided for wines and spirits under the TRIPS Agreement. In that respect, the Delegation underlined that Indonesia was rich with typical tropical products such as coffee, rice and spices, which were as important for Indonesia as wine and spirits were for European countries. In addition, the Delegation referred to handicrafts produced by local communities which were still deeply attached to their environment and which needed to be economically empowered. Besides, since the assumption was that protection was always conferred on human intellectual interventions under intellectual property law, the Delegation suggested that a simple reference to natural factors be included in the text. In other words, it was of the view that a reference to natural factors also implied some form of human intervention, since intellectual property protection was involved. The Delegation was also favorable to an extension of the scope of protection for geographical indications and also pointed out that under Indonesian legislation, rights could only be granted collectively, to a community and not to individuals. In that regard, the Delegation sought clarification as to the possible consequences if Indonesia were to accede to the Lisbon system, and in particular whether Indonesia could still refuse to grant protection to individual producers in light of the fact that the rules on national treatment and the most favored nation would in principle apply. The Delegation added that its comment applied more specifically to the meaning of the terms “stricter definition” under Articles 3(5)(d) and 5(6)(ii) regarding “the holder or holders of the right”, and further clarified that its understanding was that the only valid grounds for refusal for registered appellations of origin were either prior registered trademarks or if an appellation of origin had become generic in a given country. In that regard, the Delegation referred more particularly to the case of “Gayo coffee”, which had been registered in Indonesia as a geographical indication in the name of the original producers from the highlands of Gayo in North Sumatra. However, “Gayo coffee” had been registered as a trademark in a European country. The Delegation wondered whether that meant that the registration of “Gayo coffee” from Indonesia could be refused in that European country. In more general terms, the Delegation sought clarification as to how the country would be able to deal with that type of issues if Indonesia were to accede to the Lisbon system, and hoped to be able to find a way to solve the Gayo case in an amicable manner.

79. Following up on the intervention made by the French Delegation, the Delegation of Italy reiterated that the approach adopted by the Working Group was very constructive, and was convinced that ways could be found to make delegations comfortable with the fact that their comments would be taken on board without having to refer to the reports of previous meetings every time. The Delegation added that whenever controversial issues remained, brackets or options could always be introduced in future drafts, and echoed the concerns of the Delegation of France regarding the reference to “another definition” in Article 3(5)(c). The Delegation was also in favor of positively worded definitions in Articles 3(5)(a) and (b). Moreover, the concept of reputation had to be better reflected in Article 3(5)(b).

80. The Delegation of The former Yugoslav Republic of Macedonia recalled its country had become a member of the Lisbon Agreement recently, and added that under Macedonian law geographical names were protected by appellations of origin and geographical indications. The

Delegation was of the view that those two separate categories had to be maintained in the DNI and indicated that it was favorable to a positive formulation of the corresponding definitions in Articles 3(5)(a) and (b). Finally, the Delegation sought clarification in respect of Article 3(5)(c).

81. Referring to the discussion on the proposed definition of appellations of origin, the Representative of ORIGIN understood that one of the reasons behind the need to refer to “natural and/or human factors” was the possibility for countries with handicrafts that were deeply linked to a geographical area to be part of the Agreement in order to protect those geographical names through the Agreement. However, he believed that if the concept of geographical indication was introduced, those products which were deeply based on the human factor would fall under the geographical indication category. Hence, in practical terms, he wondered whether the Working Group should really embark on such a reform of the current definition of the appellation of origin to which some member States, and also some members of ORIGIN, were genuinely attached.

82. The Chair indicated that the answer to the first observation made by the Representative of ORIGIN would probably depend on whether there would be different levels of protection or not for appellations of origin and geographical indications, because the suggestion made by the Representative of ORIGIN would have the effect of depriving handicraft products of the possibility to enjoy the higher level of protection provided for appellations of origin.

83. The Delegation of Portugal shared the views expressed by the Representative of ORIGIN and pointed out that, in Portugal, handicrafts were protected as geographical indications and not as appellations of origin. The Delegation believed that it was important to maintain the current definition of appellation of origin and to refer to “natural and human factors” as cumulative requirements. It added that, if a new definition for geographical indications were to be included in the Agreement, handicrafts would qualify for that category.

84. The Delegation of Peru hoped that by the end of the review of the Lisbon Agreement, the outcome would be reflected by an Act or a Protocol to the Agreement, not a new instrument that would replace it. With regard to the definition of appellations of origin proposed by the new instrument which would leave open the possibility that a natural and human factor would not have to be a cumulative requirement for configuring an appellation of origin, it would prefer to keep the definition laid down in Article 2 of the Lisbon Agreement. Referring to a comment by the Delegation of Iran (Islamic Republic of) pointing out that handicraft products were based on human factors, the Delegation noted that Peru had an appellation of origin called “*Chulucanas*”, which was registered at WIPO under the Lisbon system. For that product, the human factor was of course fundamental in respect of the configuration of handicrafts, but the natural factor was also key, that is, the environment in which craftsmen worked as well as the ingredients with which such crafts were produced. In the case of the “*Chulucanas*”, it was the special pigment or the clay that was only found in the mud of that locality. Accordingly, as the Delegation saw it, those two factors converged in the appellation of origin. Naturally, the human factor was vital, but alongside the human factor was the natural factor, which provided the link to the surrounding geography. As for the reference to Article 3(5)(c), the Delegation had a doubt as to how protection “on the basis of another definition” could be interpreted and asked for clarifications in that respect. In particular, it wished to know whether that kind of “another definition” would also encompass geographical indications that were protected as collective trademarks or certification trademarks in countries which protected geographical indications in that way.

85. With regard to Article 3(5)(a) and (b), regardless of the negative wording, the Delegation of Mexico considered that the Article in question opened up the possibility of a substantive examination by each of the Contracting Parties, because subparagraphs (a) and (b) indicated that the Contracting Party could not protect, or that it was impossible to protect, a geographical

indication or an appellation of origin. That being so, the Delegation said that the registration could contain geographical indications or appellations of origin which were already registered but which did not fulfill the definition of geographical indications or appellations of origin for some or all of the Contracting Parties, a factor which it viewed as contradictory and difficult to understand.

86. With respect to the definition and the dispute on the cumulative or alternative character of human and natural factors, the Delegation of the Republic of Moldova invited Lisbon member States to give some thought to the case of those 20 appellations of origin for mineral water already registered under the Lisbon Agreement, in order to determine in particular what the exact involvement of the human factor in that kind of product was, and more generally what would be the implication of the human factor in determining the substantial qualities of any other natural resource, such as stones, salt, or any other product mostly influenced by natural factors. The Delegation therefore wondered whether the system would not simply be closed for some products that might not satisfy the cumulative requirements of the current appellation of origin definition.

87. The Delegation of Switzerland wished to associate itself with the statements made by the Delegations of France and Italy with regard to the working methods as well as their views on substantive issues. As far as the definition of appellations of origin was concerned, it favored keeping the definition as it stood in the Lisbon Agreement, adding that including a definition of geographical indications in the new instrument would ensure the flexibility needed to deal with appellations which were not covered by a narrower definition of appellations of origin. It understood clearly the proposal to broaden the definition of appellations of origin to include designations that would not be covered by a strict definition of appellations of origin, but noted that in such a case the problem was not so much determining whether or not it was necessary to broaden the definition of appellations of origin at the present stage. Rather, it would be preferable to start examining the question of protection, namely, whether or not protection should be granted to geographical indications in the new instrument. Once that issue had been cleared up, it would be possible to determine whether or not it was necessary to broaden the definition of the terms used in the new instrument. The Delegation noted that the members of the Working Group continued to express concern over the fact that the new instrument made provision for two levels of protection, whereas in its view it was preferable to launch the discussion on protection rather than continuing to focus on the issue of definitions. As far as Article 3(5)(c) was concerned, it had doubts as to the relevance and aim of that provision, because it opened the instrument up to appellations that could have a very low level of terms of protection. In other words, it did not see how indications of source as such could be protected via the new instrument if two Contracting Parties shared the same definition for such indications. It further wondered how that could be reconciled overall in the instrument with all of those different levels of definitions and with all those very uniform terms that would be introduced, and how the protection that would be granted by two countries via the agreement could be consistent with the most-favored nation clause under Article 4 of the TRIPS Agreement.

88. The Delegation of Spain endorsed the comments made by the Delegation of Switzerland insofar as it also considered that reaching an agreement on uniform protection for both cases would to a certain extent eliminate the present debate on the use or otherwise of a cumulative requirement for appellations of origin.

89. With regard to the use of the terms “*notoriété*” and “*réputation*”, the Representative of CEIPI compared four texts, namely, Article 2(2) of the Lisbon Agreement, Article 22.1 of the TRIPS Agreement, and Articles 3(5)(a) and 9(2)(a)(ii) of the DNI. He recalled that the Lisbon Agreement had been concluded in French only, and that French was therefore the only binding language. He further explained that the word “*notoriété*” had been employed and that it had been translated into English by “reputation” and into Spanish by “*notoriedad*”. He then noted

that the TRIPS Agreement had been concluded in three languages, all of which were binding, even if it had been negotiated in English, and that the word “reputation” had indeed been used also in English, whereas the French version had used the word “*réputation*” and the Spanish one had employed the word “*reputación*”. As for Article 3(5)(a) of the DNI, he pointed out that “reputation” in English had been translated by “*notoriété*” in French and by “*notoriedad*” in Spanish. That being so, he felt that where geographical indications were involved, it was preferable to speak of “*réputation*” in French and “*reputación*” in Spanish, at least to ensure consistency with the terminology of the TRIPS Agreement. Moreover, Article 9(2)(a)(ii) had kept “reputation” in English but that term had been translated by “*réputation*” in French and “*notoriedad*” in Spanish. In his view, the Spanish text was no doubt correct because it reproduced the terminology of the Lisbon Agreement, but he felt that in French, it was perhaps necessary to replace “*réputation*” with “*notoriété*” in the context of Article 9(2)(a)(ii).

90. The Representative of INTA elaborated on a suggestion by the Delegation of Switzerland concerning the reintroduction into the DNI of the notion of “country of origin”, which had to be abandoned because the proposed text would not only allow for the accession by States but also by intergovernmental organizations, and also because of the issue of trans-border geographical indications and appellations of origin. However, in his view, the notion of “country of origin” might as well be retained, albeit as “contracting party of origin”, if defined in such a way as to capture all three situations. Doing so would allow simplification of Article 3(2) to 3(4) of the DNI as well as other provisions of the DNI.

91. The Secretariat recognized the calls for simplification of the DNI. In that connection, it sought clarification from the Representative of INTA as to the possible replacement of Article 3(3) by a definition of Contracting Party of origin. In particular, the Secretariat was wondering how the DNI would then determine, in the case of a geographical indication or appellation of origin from, for example, Germany, which should be the Contracting Party with which the International Bureau should communicate under the procedures of the DNI in respect of that particular appellation of origin or geographical indication. As regards the issue of “*notoriété*” or “*réputation*”, the Secretariat would have another look at the proposed text as suggested by the Representative of CEIPI. In principle, the Secretariat had followed the terminology of the TRIPS Agreement where the DNI referred to geographical indications and the terminology of the Lisbon Agreement where the text referred to appellations of origin. On the issue of natural and human factors, it had become clear that it might be necessary to introduce square brackets into the DNI. It had also become clear that there were situations which might justify natural factors alone or human factors alone as a basis for an appellation of origin. However, the Secretariat pointed out that the issue was very much linked to the issue of scope of protection.

92. In summarizing the discussion, the Chair said that the plea for simplification of the DNI was quite clear. As regards the negatively worded definitions, there was an almost consensual view to go back to a positive formulation of the definitions, irrespective of whether such definitions should form part of Article 2 or whether they should remain in Article 3. Almost all delegations had indicated their preference for maintaining the current definition of appellation of origin under the Lisbon Agreement, while no one had objected to the idea of clarifying certain aspects of that definition, such as for example the way in which traditional denominations indicating the geographical origin of a product without containing a geographical name *strictu sensu* should be dealt with. In the same manner, he noted that there had been no opposition to addressing the issue of trans-border areas in an appropriate manner. However, views differed on whether the DNI had to refer to natural and human factors as alternative or cumulative requirements. Hence, square brackets would be used to indicate any remaining differences of opinion. Furthermore, concerns had been expressed regarding Article 3(5)(c). In that regard, one option would be to delete that subparagraph altogether. Other options were to put it in

square brackets or draft it in a way that might alleviate the concerns expressed. In that connection, a basic question was to what extent any new instrument should aim to bring about harmonization or to lay down minimum protection standards.

93. The Chair recalled that the Secretariat had pointed out several times that, even under the current Lisbon system, contracting countries had definitions in their legislation that did not exactly correspond to the one contained in the Lisbon Agreement. In that regard, he was of the view that the Working Group could work on the basis of the assumption that contracting countries of the Lisbon Agreement did comply with their obligations under that instrument. He further indicated that the existence of variations of the definition of the Lisbon Agreement under national law also showed that a country could comply with the definition of the Agreement in various ways, provided that all the elements of the definition were also contained in the respective national law. The same would apply in respect of the DNI. The question remained whether the Working Group was to aim for an international registration system without laying down minimum protection standards or without harmonizing the different definitions, or should do so while also laying down certain protection standards. The answer to that question would also reflect on the title of the DNI, which currently only referred to international registration and not to protection. Moreover, if the Working Group were to aim for protection standards, a further question was whether those standards would only concern appellations of origin or both appellations of origin and geographical indications. As regards Article 3(5)(c), the Chair noted that concerns raised were that the provision might lead to harmonization towards the lowest common denominator and that its practical application was not clear.

94. Finally, the Chair referred to other comments made, saying that all comments made would be duly reflected in the report of the session and that it could be assumed that the Secretariat would duly take them into account when revising the DNI, and would, whenever necessary, introduce square brackets to indicate differences of opinion that remained among the members of the Working Group.

95. In response to the Secretariat, the Representative of INTA said that the question raised would also appear to apply in respect of Article 3(3).

96. With regard to the question of positive or negative definitions, the Delegation of Switzerland suggested that both options be retranscribed in the revised text of the DNI.

97. The Chair indicated that the request made to the Secretariat was clear and that the text would be reformulated so as to incorporate positively worded definitions. However, he did not see the point of retaining an option B with a negative formulation of such definitions, as no one had made a request along those lines.

98. The Secretariat sought additional clarification from the Chair with respect to his conclusion that the next draft for the definition of appellations of origin should be drafted along the lines of the current definition of the Lisbon Agreement.

99. The Chair said that his conclusion was that one should stick to the definition of the Lisbon Agreement, while allowing for the clarifications on which the Working Group had managed to agree, such as those concerning traditional denominations with a geographical connotation and products originating in trans-border areas.

100. The Secretariat then sought clarification as to how the notion of reputation should be reflected or included in that definition.

101. The Chair said that what he had heard from delegations was a clear request for a more emphatic expression of the requirement of reputation, although no particular textual proposal had been advanced. He recalled that the element of reputation under the Lisbon Agreement did not appear in the definition contained in Article 2(1) itself but that it was instead referred to in Article 2(2) and to a certain extent also in Article 1(2). It was his understanding that, one way or another, the definition of appellation of origin in the DNI should also refer to the element of reputation.

102. The Delegation of Cuba said that the Representative of CEIPI had put his finger on the elements which cast doubt on the appropriateness of the term “*notoriedad*”, and also recalled that in its previous statement it had clearly stated that it favored the term “*reputación*”, as it considered that term to be the closest to the concept which prevailed in the Lisbon Agreement.

#### SCOPE OF PROTECTION (ARTICLES 4 AND 9)

103. Introducing Articles 4 and 9, the Secretariat referred to Draft Provisions D and E of document LI/WG/DEV/3/2, which were based on the results of the Survey on the Lisbon System conducted in 2010 and had generated a very difficult discussion at the previous session of the Working Group on the issue of the content and scope of protection. The levels of protection presented in Draft Provisions D and E were minimum levels and did not exclude more extensive protection in a particular Contracting Party, as specified in Draft Provision E(6). Article 4 of the DNI concerned a provision that was similar to Draft Provision E(6), and specified that “the provisions of this Agreement shall in no way exclude more extensive protection as may be available in a Contracting Party”. At the end of the discussion at the previous session of the Working Group, the Secretariat had suggested that the easiest solution on scope of protection would be for the DNI to remain silent on the issue and to leave it up to national law. Thus, the DNI would follow the example of two other international registration systems administered by WIPO, namely the Madrid system and the Hague system. Such an approach had never been possible in the past in respect of geographical indications and appellations of origin, because the differences in levels of protection under national laws were considered to be too big. However, the question could be asked whether, in the post-TRIPS era, the levels of protection under national laws might have come closer to each other. In view of the discussion at the previous session, the Secretariat had decided to be slightly provocative by inserting in the DNI a provision – Article 9(1) – which would actually have the effect of applying national treatment in relation to international registrations of geographical indications. In the case of appellations of origin, the situation was somewhat different, because the current Lisbon system stipulated a specific level of protection for appellations of origin registered under the Lisbon Agreement. Moreover, in view of the mandate which required the Working Group to preserve the objectives and principles of the Lisbon Agreement, the Secretariat also had to reflect such provisions on scope of protection in respect of appellations of origin in the DNI. The Secretariat had done so in Article 9(2) through the use of provisions which reflected all the proposals made in response to the Survey and reflected as options in Draft Provision E of the document discussed at the previous session of the Working Group. The Secretariat had decided not to choose between those options but rather to combine all the options, as had been reflected in Draft Provision E, in Article 9(2).

104. Referring to Article 9(3), which had already been contained in Draft Provision E as well, the Secretariat indicated that such a provision dealt with the situation concerning the use of a geographical indication or an appellation of origin by someone who was entitled to use the geographical indication or the appellation of origin, but who was not doing so in conformity with the requirements of use for that geographical indication or appellation of origin. In that regard, Article 9(3) proposed to leave that issue up to national law and only referred to appellations of origin, as the status of geographical indications was already covered by Article 9(1).

Article 9(4), which had also appeared in Draft Provision E, dealt with the situation in which someone who was not entitled to use the internationally registered appellation of origin or geographical indication in question would nonetheless be using such an appellation of origin or geographical indication for a product of the same kind. Article 9(4) established in respect of such use a presumption that there was an infringement, unless otherwise proved by the presumed infringer. In that regard, the Secretariat apologized for an error in Article 9(4), which only referred to Article 9(2) whereas it should instead refer to both Article 9(1) and Article 9(2), so that the sentence would read “unlawful use under paragraphs (1) or (2) shall be presumed”. Articles 9(5) and 9(6) had also been contained in Draft Provision E and reflected the corresponding provisions of Article 23.3 and Article 22.4 of the TRIPS Agreement. Those provisions dealt with homonymous appellations of origin or geographical indications which had to be both protected unless one of the two falsely indicated to the public that the other product was represented. Article 9(2) referred to Article 6(4) when indicating that the scope of protection provided for appellations of origin was subject to Article 6(4) which dealt with the situation of countries that did not distinguish in their national law between appellations of origin and geographical indications. In those countries, protection was only provided for geographical indications under a definition for geographical indications. In such a case, if an international registration related to an appellation of origin and was registered as an appellation of origin, the question arose as to how countries which only provided protection for geographical indications would protect those appellations of origin, and therefore Article 6(4) specified that they had to do so under their geographical indication law.

105. The Delegation of the Republic of Moldova asked the Secretariat whether Article 4 should not also include a reference to bilateral agreements, since such agreements were becoming increasingly important instruments for the protection of geographical indications. The Delegation did not see why it would not be possible to have the same level of protection for geographical indications and appellations of origin while still keeping two separate definitions. There were two fundamental reasons for doing so, the first being that even though international treaties established a minimum level of protection, each country was still free to ensure a higher level of protection. The level of protection described under the DNI satisfied both geographical indications and appellations but each Contracting Party was free to provide a higher level of protection for appellations of origin. The Delegation noted that the words “at least” at the end of the first sentence of Article 9(2)(a) could be understood as an invitation to do so. The second reason for having a single level of protection was that the proposed text was not sufficiently clear as to the content of protection for geographical indications and therefore created an important breach between those two related objects of intellectual property protection. The Delegation was of the view that the subsequent paragraphs (3), (4) and (5) further accentuated that breach, as those paragraphs only referred to appellations of origin. The Delegation suggested examining the possibility of unifying the provisions under Article 9(2)(b) with the provision of Article 9(4), given that both paragraphs dealt with the same issue, namely the conflict with trademarks.

106. The Chair pointed out that Article 9(4) concerned not only the use or registration as a trademark, but “any use” as well as “use or registration as a trademark”. In his view, if the text were amended to read “use of an internationally registered geographical indication or appellation of origin or its registration as a trademark in respect of products of the same kind”, that would perhaps make it clearer that the text was dealing not only with conflicts between trademarks and geographical indications but also with any possible use of geographical indications and appellations of origin.

107. Referring to Article 9(1), the Delegation of Hungary was of the view that the text should set minimum standards for protection, which should be applicable in all Contracting Parties instead of the solution proposed under that provision. In addition, the text of Article 9 could be simplified so as to provide greater transparency. As regards the terminology used in Articles 9(2)(a)(i)



and (ii), the Delegation sought clarification as to the meaning of the terms “related or linked”, “comparable” and “the geographical area of production”. The Delegation noted that in some other parts of the DNI, the terminology used was “the area of origin”, and wondered whether there was a difference between “the area of origin” and “the geographical area of production”.

108. The Delegation of Italy reiterated its preference for a single level of protection for both geographical indications and appellations of origin which had to be aligned with the higher level of protection proposed for appellations of origin. Referring to Article 9(2)(a)(i), the Delegation asked whether the word “evocation” could also be included after the terms “usurpation or imitation”, so that the sentence would read “usurpation, imitation or evocation”. Referring to Article 5(6)(ii), it asked whether the sentence “the holder or holders of the right to use the geographical indication or appellation of origin” could also incorporate the term “or the association of holders of the right to use” so as to reflect the situation which existed for example in Italy where there were consortia grouping right holders that were recognized by the Ministry for Agricultural Policy. The Delegation therefore suggested that Article 9(2)(b) be amended so that the text read “the provisions of subparagraph (a), above, apply *mutatis mutandis* to the registration of a trademark containing or consisting of the appellation of origin by the holder or the holders of the right to use the appellation of origin in question or their association”.

109. The Chair pointed out that the current text of Article 9(2)(b) read “by someone who is not a holder”.

110. The Delegation of Italy clarified that that did not change its proposal, the aim of which was simply to align associations of holders of the right with the holders themselves. Regarding Article 9(5), the Delegation asked the Secretariat whether a reference to cases of total or partial homonymy could also be included in that provision, as it was a common practice to distinguish between those two situations. Depending on how the discussion on the level of protection would go, the Delegation might have reservations with respect to Article 6(4).

111. As regards the comment of the Delegation of Italy in relation to the beneficiaries of protection, the Chair pointed out that even the current Regulations under the Lisbon Agreement, and more particularly Rule 5(2)(ii), referred to the possibility of designating the holders of the right to use the appellation, collectively. In his understanding, that was the general rule and the individual designation of the holders was only the exception where collective designation was not possible. In other words, even the current legal framework provided for the possibility of identifying as beneficiaries of protection the holders of the right to use the appellation of origin collectively, through a single reference to their association. However, he wondered whether it was really the association itself that was entitled to use the appellation of origin or whether it was merely a way of referring to the holders of the right to use the appellation of origin collectively. As a separate remark, from the point of view of optimal drafting, he was of the view that references to the collective personality of the right holders or the beneficiaries of the right to use the appellation of origin should not be systematically included in the text. On the contrary, it would be preferable to make it clear in the DNI or in the DR that whenever reference was made to the “holders or the holder of the right to use the appellation of origin or the geographical indication”, such wording also meant the membership of an association representing them. In other words, there should be a clarification that the holders of the right could also be identified by a single reference to the association to which they belong. However, as regards the reference to the “holder and holders of the right to use the appellation of origin” in the DNI and in the current Regulations of the Lisbon Agreement, he understood that in principle there could be a single holder of the right to use the appellation of origin or geographical indication, but nonetheless wondered to what extent such cases were really frequent in practice. The Chair then pointed out that the Lisbon Agreement itself only used the plural form when referring to “natural persons or legal entities” and, therefore, wondered whether there was a reason to use both the plural and singular forms in the DNI and in the Lisbon Regulations.

112. The Delegation of France said that as far as Article 9 was concerned, it endorsed the comments made by previous delegations, which had called for a single level of protection aligned with the protection proposed for appellations of origin. It was essential to bear in mind that the framework which the members were in the process of building was not merely a legal framework but also an operational framework for economic actors seeking to enhance the value of their products and that even though that was done through different identifiers, namely appellations of origin and geographical indications, each of those products deserved the same level of protection. With regard to the changes made by Article 9(2)(a), the Delegation had difficulty understanding the difference between subparagraphs (i) and (ii), particularly given that it failed to grasp the distinction between a product and a similar product. It further emphasized that other parts of the text referred to “products of the same type”, and therefore saw a need to harmonize and simplify the provisions as a whole. It also had many questions in respect of the beginning of Article 9(2), which stipulated “subject to Articles 6(4), 19(1) and 21.” In that connection, it explained that it understood the reference to Article 19(1), because that concerned the case of countries which had refused to protect an appellation of origin. However, it had trouble understanding the reference to Article 21, because that pertained to cases where a country invalidated the protection of an appellation of origin. Finally, it found it much harder to accept the reference to Article 6(4). Indeed, if it had correctly understood the explanations provided, that would mean that the agreement would not have any standardizing impact on some countries which would have no definition of appellations of origin. More specifically, it recalled that Article 6(4) stipulated that “appellations of... are protected as appellations of origin in the Contracting Parties” but only as geographical indications in the Contracting Parties offering protection for geographical indications. It therefore wished to know whether that meant that in such a case, a country which did not have a definition for geographical indications and which did not protect appellations of origin would not have an obligation to apply Article 9(1), namely, protection on the basis of its domestic law. It wished to know whether that was how it should interpret the exception in Article 6(4) and whether the links between the various provisions would lead to a lack of protection for appellations of origin in countries with no definition of appellations of origin, as geographical indications. Naturally, that issue was closely tied to the question of retaining a dual-level approach, because if there were a single level the question would no longer arise, but it wished to know whether that was how the exception in Article 6(4) should be interpreted. For the rest, the Delegation of France endorsed the previous statements made on the question of marks and homonymy.

113. The Chair confirmed that the Delegation of France had correctly understood the provisions of Article 6(4).

114. Referring to the statements made by the Delegations of France, Italy and the Republic of Moldova, with regard to the importance of establishing a single level of protection rather than two as the text suggested, the Delegation of Costa Rica endorsed that point of view. It also wished to recall that in a way, the Working Group’s mandate was to establish the best framework of protection in accordance with the Lisbon Agreement, but not so much to take up the substantive aspects of various topics. It feared that the Working Group was adopting the latter approach when delegations started to express views on words or on certain phrases with which they disagreed. In its view, that was a topic that the Secretariat had to resolve, by providing the Working Group with somewhat more consensus-based material in order to avoid discussions on terminology. However, given that the Working Group was conducting discussions on that level at the present working session, in the Delegation’s view Article 9 relating to the content of protection indeed established a series of words which clearly gave rise to terminological inaccuracies. As the text was a legal document which was being and had to be incorporated in domestic legislation, the fundamental goal was to ensure that the document and the phrases used dispelled any doubts with regard to interpretation. If phrases such as “any direct or indirect use” or “use that represents an evocation” were used, for example, that would without any doubt raise interpretation issues. Accordingly, the Delegation stressed the

need to avoid references to words that required an interpretation of the concepts, and therefore suggested using terms common to those which existed in domestic legislation and which avoided the need for interpretation to achieve compliance with the Agreement and the Regulations. In its view, whenever an authority attempted to interpret those texts, it would make it more difficult to determine with certainty the degree of protection and the interpretation of the provisions of the Agreement. In respect of Article 9(3), the Delegation considered that the use of the phrase “but which do not meet the requirements on the basis of which protection was granted to the appellation of origin” was not the most suitable wording, because it involved a concept which it felt to be poorly defined and difficult for the authorities of the Contracting Parties to verify. In that respect in particular, the Delegation believed that the right approach would be to require anyone wishing to use the appellation of origin to produce an official document which had been approved by the relevant authority of the country of origin of a given appellation of origin. It further noted that in Article 9(2)(a)(ii), which stated that “use represents an evocation of the appellation of origin”, the word “evocation” also suggested a need for interpretation, and stated that in accordance with the experience of certain authorities in given countries, there might be such an evocation, whereas in others there might not be any reference to evocation. Where it was stated that it “is likely that this is detrimental”, it suggested replacing those terms with “which is detrimental to its reputation or which takes undue advantage of this reputation”. Finally, the Delegation wholeheartedly endorsed the point of view expressed by the Delegation of France with regard to Article 6(4) and Article 21.

115. The Delegation of Portugal was also in favor of a single level of protection for appellations of origin and geographical indications. The Delegation would prefer a single level of protection as provided under EU Regulations or under Portuguese law, given that appellations of origin and geographical indications deserved the same level of protection. The Delegation sought clarification of Article 9(2)(a)(ii), in particular the use of the terms “comparable, identical or similar, related or linked...” The Delegation further asked whether Article 9(4) could also include products that were not of the same kind that could still benefit from the reputation of the geographical indication or appellation of origin.

116. As regards the proposal made by the Secretariat on the possibility of having two different levels of protection, the Delegation of Peru wished to maintain a high level of protection for appellations of origin in any case. As for the suggestion of having a single level of protection, the Delegation needed to consult its capital before expressing its views in that respect. With regard to the content of the protection indicated in Article 9, the Delegation said that if the end result was different protection for geographical indications and for appellations of origin, the question that came to mind was the kind of protection that would be granted to geographical indications in countries whose domestic legislation only covered appellations of origin. In any event, given that the requirements for appellations of origin to benefit from protection were more stringent than those for geographical indications, the Delegation wondered whether it would be valid, within the framework of the draft proposed by the Secretariat, for a country that protected only appellations of origin to refuse protection for a geographical indication because it did not entirely meet the requirements or the definition of appellations of origin. Moreover, the Delegation also had doubts as to the terminology used in the DNI: for example, in the case of Article 9(2), it would appreciate an explanation of what was meant by “any direct or indirect use” and what the scope of that phrase would be. It was further concerned by the term “evocation”, which appeared in Article 9(2)(a)(ii), and also asked whether the term “*notoriedad*” which appeared in that same Article referred to reputation from the viewpoint of the trademark law, that is, if it had the same implications as reputation in trademark law. Moreover, with regard to Article 9(2)(b), there was a need to specify whether the protection referred was in relation to an application filed and/or an application already granted.

117. The Delegation of the Republic of Moldova sought clarification as regards Article 9(2)(a)(ii), and more particularly as to how it would be possible to have an identical product that would not be covered by the international registration.

118. The Delegation of Switzerland supported the stands taken by the Delegations of France, Italy and other countries with regard to the question of the two different levels of protection. More specifically, it also backed the position taken by the Delegation of Portugal in respect of Article 9(2)(a)(ii) concerning application to other products. In the Delegation's view, that would make it possible to move away from the somewhat complicated definition that was proposed in the DNI, which referred to a product that was "comparable, identical or analogous, near or related..." and whose practical applicability appeared subject to doubt. With regard to the way to proceed with the discussion of the proposed review of the Lisbon Agreement, in the light of the discussions that had already taken place at the Working Group's previous session on whether two different levels of protection were necessary, the Delegation considered that everything depended on the normative context in which the Working Group operated and that the body of the other discussion points, namely, the definitions, the possible links between domestic legislation and the protection that would be granted by the new instrument, could only be truly settled once a decision had been taken on the issue of two different levels of protection or a single level of protection. In the Delegation's view, the difference in relation to the Working Group's previous session was that it had become increasingly clear that the distinction between two levels of protection was all the more problematic as it was somewhat vague and the decision on the applicable level of protection would to a certain extent be left up to the members, whether or not their own domestic legislation distinguished between the two categories of geographical indications and appellations of origin. In that connection, the members had also recognized the possibility of the inclusion of other categories in the relevant domestic legislation. It added that the complex nature of the subject was compounded by difficulties already present at the last meeting, namely, the distinction between appellations of origin and geographical indications in a number of domestic legislations and the distinction between different product types that was currently in force within the WTO framework. In conclusion, the Delegation of Switzerland felt strongly that the discussion should be focused on that key issue. The other questions could only be discussed subsequently, but if that question was not resolved, the danger was that the Working Group members might once again find themselves at the same dead-end at their next session.

119. As regards Article 4, the Representative of the European Union supported the proposed approach that the DNI would not itself be an obstacle to the possibility of enjoying more extensive protection which may be available in a Contracting Party either under the law of a Contracting Party or by virtue of other international conventions. As regards Article 6(4), the Representative noted that that Article stipulated that internationally registered appellations of origin had to be protected as geographical indications in Contracting Parties providing protection in respect of geographical indications on the basis of criteria that did not distinguish between geographical indications and appellations of origin. However, she pointed out that, in the European Union, EC Regulation No. 510/2006 referred to "designations of origin" rather than "appellations of origin". In that respect, the Representative sought clarification as to how the European Union should treat an "appellation of origin" from a third country if the European Union became a Contracting Party in the future. It would therefore be useful to find a solution to treat "appellations of origin" as "designations of origin". She then pointed out that Article 9 made a distinction between geographical indications in Article 9(1) and appellations of origin in Article 9(2). The protection of internationally registered geographical indications would be governed by a legal instrument of a Contracting Party, and in that respect, the Representative suggested some amendments to the proposed text. In particular, Article 9(2)(a)(i) could perhaps specify that such direct or indirect use would amount not only to "usurpation or imitation", but also to "evocation". Furthermore, the non-exhaustive list of terms at the end of that paragraph could be amended so as to read "such as style, kind, type, method, make, as

produced in, imitation, like or similar". She further suggested adding to new subparagraphs (iii) and (iv) under Article 9(2)(a), and specified that subparagraph (iii) would read "any other false or misleading indications as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin", while subparagraph (iv) could read "any other practice liable to mislead the consumer as to the true origin of the product". In parallel, Article 9(2)(b) could be clarified so that the provision would read "The provisions of subparagraph (a), above, apply *mutatis mutandis* to the application for and registration of a trade mark containing or consisting of the appellation of origin and relating to the same class of product by someone who is not a holder of the right to use the appellation of origin in question". The Representative was of the overall view that a careful analysis of the scope of protection under Article 9(2) would be appropriate.

120. The Delegation of Cuba referred to the content of the protection in Article 9(1), which indicated that "the protection of the geographical indication which has been subject to international registration in each of the Contracting Parties shall be the same as if the protection had been granted by virtue of a legal instrument, as indicated in Article 3(3)". Noting that the title of Article 3 referred to geographical indications and appellations of origin, it wondered whether the Working Group was not excluding the term "appellations of origin" from Article 9(1). From another perspective, the Delegation had doubts similar to the ones raised by other delegations in respect of the use of a group of new general words and concepts that should be drafted in such a way as to imply general and not such specific elements as those put forward in Article 9. The Delegation explained that a group of new words and terms were being introduced that could be combined with terms relating to the substantive examination to be carried out by each party in relation to those geographical indications and appellations of origin. Moreover, the Delegation reserved the right not to make critical comments at that point in time in relation to a single level of protection, insofar as it had various considerations in mind leading it to believe that a single level of protection would be different from the legislation. Consequently, the topic had to be studied in greater depth.

121. The Delegation of Chile, referring to the Director General's comments at the beginning of the Working Group's present meeting on the need to make the Lisbon system more attractive, wholeheartedly endorsed that position, given that in its opinion, the outcome of the present session had to be geared to that goal. It was also necessary to include the opinions and views of the parties to the Agreement as well as those of other observer delegations such as Chile. With regard to Article 9 on the content of protection, the Delegation of Chile associated itself with those delegations which had requested clarifications in respect of Articles 9(2)(a)(i) and (ii), especially concerning the use of the words "direct or indirect". It did not see at all what the word "indirect" was intended to add. As for Article 9(2)(a)(ii) in particular, the Delegation expressed doubts as to the broadening of the scope of protection that would be granted under that Article when introducing protection in the event that an indirect term was used in respect of a product not included in the international registration. It suggested that the Secretariat might clarify whether the intention of that paragraph was indeed to broaden the protection of the protected term to any kind of product, including where the term was used indirectly. If that were indeed the aim, it did not see clearly what form would be compatible with the principle of specialization.

122. With regard to Articles 9(5) and 9(6), the Delegation of Chile welcomed the inclusion in that proposal of a paragraph like paragraph (5), which specifically included the possibility of protecting homonymous geographical indications or appellations of origin. Likewise, it emphasized that paragraph (5) was very similar to Article 23.3 of the TRIPS Agreement, and from its point of view it was very important to introduce it into the Lisbon system, since it was consistent with the aim of making the system clearer and more attractive. Nevertheless, the Delegation of Chile still had a doubt with regard to the compatibility of paragraphs (5) and (6) of Article 9: even though Article 9(5) covered the possibility of homonyms and of protecting

homonymous appellations of origin insofar as the different producers were treated fairly and consumers were not misled, paragraph (6) did not, however, seem at all consistent with paragraph (5), since the last phrase indicated that homonymous indications would not be protected where that would mislead the public into thinking that the product had originated elsewhere. In the Delegation's view, the condition envisaged in paragraph (5), namely, that homonymy would be protected insofar as the public was not misled or deceived and provided that equal treatment was obtained, was sufficient. Consequently, the Delegation did not see how paragraph (6) could be compatible with paragraph (5), and therefore asked the Secretariat for clarification.

123. The Chair said that the language used in Article 9(6) seemed to reflect that of Article 22.4 of the TRIPS Agreement, and indicated that the way in which that provision was worded in the TRIPS Agreement would indeed relate to the level or to the scope of protection, as that provision stated that "protection shall be available against a geographical indication...", while Article 9(6) stated that "A Contracting Party may not accord protection..." Consequently, the Chair wondered whether the issue at stake was whether geographical indications that fell within the scope of Article 9(6) had to be protected, or whether Contracting Parties were required to provide protection against such geographical indications. There was a difference between granting an exclusive right to use a certain geographical indication and conferring the possibility of exercising such a right against a certain geographical indication. He therefore suggested further reflection on the way in which the provision was worded and perhaps aligning its wording more closely with that of the corresponding provision in the TRIPS Agreement.

124. The Representative of ORIGIN supported the views expressed on the need to be as accurate and consistent as possible when referring to various concepts such as similar, identical or comparable products. He further stressed the need to try to group as much as possible provisions dealing with legal protection and to reduce as much as possible the references to other provisions. He reiterated his support for a single level of protection for both geographical indications and appellations of origin modeled after Article 3 of the current Lisbon Agreement but with the addition of the concept of "evocation", which should appear in Article 9(2)(a)(i) rather than in Article 9(2)(a)(ii). In the current wording of Article 9(2)(a), there would be the paradox of giving stronger protection to an appellation of origin when used by unauthorized persons for products of a different kind compared to its protection when used by such persons for products to which the appellation of origin related, as reflected in the international registration.

125. The Representative of INTA congratulated the Secretariat on the somewhat bold step of encouraging a debate to look into the possibility of creating an international registration system for geographical indications on the basis of a treaty that would, like the Madrid and Hague systems, not at the same time stipulate provisions dealing with specific aspects of substantive law. He recalled that there had been a standstill over a possible registration system at WTO for some 10 years. In that regard, he further indicated that there had been no progress and that there would be no progress precisely because issues of substance were combined with the concept of a registration system. He added that sometimes it was more appropriate to be slightly more modest to eventually achieve more, and therefore did not want to discard the idea of looking into a registration system similar to the Madrid system or the Hague system, which were systems that were operating very well. Moreover, the whole geographical indication community would be served very well by a system that would work smoothly. In his view, such a result would be a big step forward, and having such a big step forward sooner rather than later would be a significant achievement. As he listened to the discussion, he understood that there was also an interest in discussing substantive issues, such as the scope of protection, notably a uniform level of protection. In that regard, he echoed the comment made by the Delegation of France that the issue at stake also concerned the selling of products and that the focus of the debate should not only be on finding the broadest possible scope of protection, but rather on

establishing legal certainty, about working on the basis of legal concepts that would function in every country. He particularly appreciated the statements of the Delegations of Chile, Costa Rica and Peru which had clearly pointed out that in their respective legal systems, concepts such as “usurpation”, “imitation”, “kind of”, “translation” or “evocation” simply did not work, as there was no body of case law or precedents to which judges in those countries could refer when they had to decide whether a geographical indication or an appellation of origin had been infringed. Even in the system of the European Union, it had taken the “*Gorgonzola*” manufacturers some 10 years to litigate – unsuccessfully – in Austria over the question whether or not “*Cambozola*” was an evocation of their appellation of origin. Nor were matters cut and dried under the concepts applied in the EU system. Rather, trademark concepts, such as “likelihood of confusion” and “dilution”, might be considered, since every country had hundreds of case law precedents based thereupon.

126. With regard to Article 4 and the reference made by the Delegation of the Republic of Moldova to bilateral treaties, the Representative of CEIPI considered that such treaties were already covered by Article 4 as international instruments, and the enumeration which followed, namely, “the Paris Convention, the Madrid Agreement, the TRIPS Agreement”, was not exhaustive, as indicated by the words “such as”. It was therefore not essential to refer specifically to bilateral treaties in Article 4. Moreover, with regard to the suitability or otherwise of adopting a single level of protection comparable to that of the Lisbon Agreement, despite the Representative’s understanding for that approach, there was no gainsaying that it might prevent many new countries from joining the system and therefore risked thwarting the goal of making the system more attractive for prospective new members. With regard to Article 6(4), if it were retained in the next version of the DNI, he hoped that it could be transferred to Article 9, as that would facilitate the reading of the body of provisions dealing with the scope of protection. Finally, with regard to the date of the entry into force of international registration, he noted that Articles 8(1)(a) and (b) stipulated the date on which international registration took effect, which included not only the actual registration date but a possible future date as defined by subparagraph 1(b). As Article 9(1) contained only a single reference to the date of registration, he wished to know what the actual date was on which the protection of the geographical indication, as defined by Article 9(1), took effect. Finally, he noted that in Article 9(2), there was no reference to the date of entry into force.

127. The Representative of MARQUES supported the call for a single level of protection for geographical indications and appellations of origin. He referred to Article 9(2)(b), which stated that “The provisions of subparagraph (a) above, apply *mutatis mutandis* to the registration of a trademark containing or consisting of the appellation of origin by someone who is not a holder of the right to use the appellation of origin in question”, and said that the text of the provision was confusing as it might be interpreted, “*a contrario sensu*”, as meaning that the registration of a trademark containing or consisting of the appellation of origin for products identical or similar, related or linked but not covered by the international registration by someone who is a holder of the right to use the appellation of origin in question could take place. The Representative of MARQUES assumed that, in respect of trademarks consisting of an appellation of origin, that was not the desired interpretation, as it would seem that no one should be authorized to proceed with such a registration. He also shared the doubts expressed by the Delegation of the Republic of Moldova as to the use of the term “identical” in that context. He further expressed the view that it should remain possible, in countries where trademark rights could only be acquired through registration, for a producer who would be planning to seek accreditation as a legitimate user of a certain appellation of origin to apply, in advance, for the registration of a trademark containing the appellation of origin in question with a view to using it in the future. If such an early registration would not be allowed, the producer in question would first have to be accredited as a legitimate user of the appellation of origin before being able to apply for a trademark containing the appellation of origin. The Representative of MARQUES was of the opinion that that would amount to an unnecessary loss of time. Instead, registration of a

trademark containing an internationally registered appellation of origin might be limited to its use in respect of goods complying with the product specification of the appellation of origin. The Representative of MARQUES also sought clarification as regards the text of Article 9(4), which stated that “unlawful use under paragraph (2) shall be presumed”. He recalled that, according to the introduction made by the Secretariat, that was a “*juris tantum*” and not a “*juris et de jure*” presumption, namely, a presumption which admits evidence to the contrary and not one which does not admit it. In his view, that should be spelled out in the text of the Article to avoid doubts and divergent interpretations.

128. Referring to Article 9(5), the Delegation of Peru said that what had caught its attention was the fact that the proposal was a novel one for the Lisbon system insofar as the Lisbon Agreement did not envisage the possibility of homonyms between appellations of origin. It understood that the proposed wording for the DNI came from Article 23.3 of the TRIPS Agreement, but the difference it saw was, however, that the TRIPS Agreement referred only to homonyms for wines, whereas the proposal formulated in Article 9(5) did not pertain exclusively to wines. Accordingly, given that the proposal went beyond the present state of multilateral norms and was potentially detrimental to Peru’s recognized rights, the Delegation could not support the text of Article 9(5).

129. The Delegation of Australia recalled that its country was not party to the Lisbon Agreement, but that it nonetheless followed closely developments relating to that instrument. The Delegation supported the interventions made by the Delegation of Chile and the Representative of INTA. At the outset, the Delegation was very pleased by the efforts undertaken to attract greater membership, but was disappointed that the proposals for changes to the system appeared to be simply inconsistent with the legal means in Australia, and apparently in many other countries, for the protection of geographical indications. For example, the presumption under Article 10 that a protected geographical indication or appellation of origin could not become generic dictated beyond the requirements of the TRIPS Agreement, and a provision like the one proposed was not only extraterritorial but also incompatible with Australian law. Article 9 also went well beyond the requirements of the TRIPS Agreement, and it would be disappointing if the work on the development of the Lisbon system resulted in the retention or strengthening of provisions that made it unattractive to many countries. The Delegation would not be in a position to accede to an instrument that would be incompatible with its system for protecting geographical indications.

130. The Secretariat referred to the statement of the Delegation of Switzerland that it was actually a prerequisite for the Working Group to decide first on whether the DNI should stipulate a single level of protection for both appellations of origin and geographical indications or different levels. He then referred to the statement of the Representative of CEIPI, who had rightly pointed out that, if the Working Group decided to adopt a single level of protection that would be too high, for example as reflected in Article 9(2), the Working Group’s review exercise was unlikely to meet its objective of generating broader membership of the Lisbon system. As regards the question raised by the Delegation of Peru concerning countries that only had laws for the protection of appellations of origin, he said that the assumption under the DNI was that countries would either have laws based on two definitions, i.e., one for appellations and a separate one geographical indications, or laws based on one definition, i.e., for geographical indications. Article 6(2) stipulated that, in the case of a geographical indication which had been nationally registered in a country that had only legislated on the basis of a geographical indication definition, a given geographical indication for a product which inherently met the definition of an appellation of origin under the DNI could be registered under the DNI as an appellation of origin, subject to evidential material to be submitted with the international application that the product in question would meet the requirements of the definition of an appellation of origin. Referring to Article 6(4), the Secretariat said that, without that provision,



the question would arise under the DNI as to whether a country which only had a geographical indication definition would actually be obliged to protect an appellation of origin registered under the DNI as a geographical indication.

131. As regards Article 9(2) and the requests for clarification of the terminology used, the Secretariat said that ample consideration had been given to the question how to present Article 9(2) in the DNI. At the previous session of the Working Group, there had been a discussion on the basis of Draft Provision E, which provided several options in respect of the protection for appellations of origin in Draft Provision E(1). That provision contained two main options and, within those options, there were several square brackets reflecting the various options submitted by respondents to the questionnaire circulated in the context of the Survey. In the end, as the Secretariat had obtained little guidance at the previous session of the Working Group as to the options that should not be used, it had eventually decided to include all the proposed concepts in Article 9(2). Of course, the terms “comparable”, “identical or similar”, “related or linked”, “exploiting the reputation”, “taking unfair advantage of the reputation”, “detrimental to the reputation”, could have been left in brackets, but instead a decision was taken not to do so and to see what the reactions would be. Requests for clarification of those terms should actually be addressed to those that had proposed them in their responses to the Survey. As regards the concept of “evocation”, the Secretariat noted the comment made that the concept might not be well understood everywhere in the world. On the other hand, other concepts proposed in response to the Survey would seem to be comparable, such as those aimed to prevent “detriment to the reputation” or “undue exploitation of the reputation”. Regarding Article 9(4), the Secretariat believed that the suggestion to make the provision applicable in respect of use of the appellation with regard to any kind of product by someone who was not entitled to use the appellation of origin would be going too far. Article 9(4) was based on the principle that also underlay both Article 23.1 of the TRIPS Agreement, which provided stronger protection for geographical indications for wines and spirits in respect of use of such a geographical indication in relation to another wine or spirit, and also the provision of Article 16.1 of the TRIPS Agreement, which dealt with the protection of trademarks and which stated that “in case of the use of an identical sign for identical goods or services a likelihood of confusion shall be presumed”. As regards Article 9(4) and Article 9(5), the Secretariat sought clarification from the Delegation of Italy on its proposal concerning the issue of partial homonymy, i.e., whether the Delegation was referring to a geographical indication consisting of two words of which only one would correspond to another geographical indication.

132. The Delegation of Italy said that it would revert to the matter later on.

133. The Secretariat noted that the Delegation of Peru had also referred to Article 9(5), which indeed dealt with homonymous geographical indications and appellations of origin irrespective of the kind of product that was covered, whereas Article 23.3 of the TRIPS Agreement only dealt with homonymous geographical indications for wines. In that regard, the Secretariat pointed out that under national law, that provision was not always only limited to wines and that the same principle would appear to be applicable in respect of geographical indications and appellations of origin for other products as well. However, the Secretariat also noted the reference made by the Delegation of Peru to its national law, which would make it impossible for Peru to accept a provision that went beyond wines.

134. The Delegation of Peru confirmed that that was indeed the case, explaining that it was not only because of its national law but that it was also because of its national interests. In that regard, it referred to the “Pisco” case, pointing out that the proposed provision was potentially prejudicial to the interests of Peru with regard to its appellation of origin, whose rights were broadly known and recognized.

135. The Secretariat recalled that WIPO had registered the Peruvian appellation of origin “Pisco” under the Lisbon Agreement in 2005. Prior to that registration, several Lisbon member States had already granted protection to the Chilean appellation of origin “Pisco”. That had resulted in the issuance of partial refusals by those member States, which were not really refusals but rather acknowledgements of protection of the Peruvian “Pisco” with one exception, namely, that the right could not be used against use of the Chilean appellation of origin “Pisco” in their territories, which in effect led to a situation of coexistence. That was the way such cases could be dealt with under the Lisbon system.

136. Turning to Article 9(1), which laid down the protection to be accorded to geographical indications under the DNI, the Secretariat recalled that, at its previous session, the Working Group had discussed Draft Provision E(2), which was based on proposals made in response to the Survey and stated that “internationally registered geographical indications shall be protected against use in the designation or presentation of a good if such use or registration...” followed by a number of different options as proposed by various respondents to the Survey. In particular, there had been several proposals – notably, but not only, from countries that were not parties to the Lisbon Agreement – for the phrase “if such use would result in a likelihood of confusion”, while other proposals had suggested “if such use is of such a nature as to mislead the public as to the geographical origin of the product”. Yet others had suggested “if such use exploits or weakens the reputation or dilutes the geographical indication”. There had also been calls for stipulating the same protection in respect of geographical indications as had been proposed for appellations of origin. Since the discussion had revealed seemingly irreconcilable positions, the Secretariat had suggested that a provision stipulating that the protection of internationally registered geographical indications would be subject to national treatment would seem to be the only viable solution. That might appear as a provocative suggestion, but it was in fact the way in which the international registration systems for trademarks (the Madrid system) and industrial designs (the Hague system) worked. Understandably, such a solution was not favored by delegations that were in favor of a single level of protection for geographical indications and appellations of origin. However, if the Working Group would establish a level of protection for geographical indications under the DNI in line with the provisions of Article 9(2), the Working Group might not achieve the objective of attracting a wide membership. The Secretariat suggested that, for a solution that lay somewhere between Article 9(1) and Article 9(2), it might be useful to look at what was actually provided, country by country, in terms of level of protection in respect of geographical indications. Such information was to a large extent available in the *WIPO GOLD* database of national laws. Another avenue that might be considered was to look at what should be the object of protection. For example, if the focus of the protective measures should be the reputation attached to a geographical indication, then it might be worthwhile to have a closer look at the proposals that had been made to the effect that protection should be available against use that is detrimental to the reputation or that unduly exploits the reputation.

137. Finally, the Secretariat clarified that the terminology “direct or indirect use” had been taken from the proposals made in response to the Survey. The terminology “designation of origin” instead of “appellation of origin” would not appear to pose a real problem, as long as the definitions in respect of those terms were the same. The Secretariat would reconsider Article 9(2)(b) and 9(6) in view of the comments made in respect of those provisions.

138. The Chair concluded that a near consensus had emerged in favor of a single level of protection for appellations of origin and geographical indications. Whereas several delegations had indicated a preference for a level of protection similar to the one under the current Lisbon Agreement, it had also been pointed out that that might prevent the enlargement of the membership of the current system. In that respect, the Working Group would have to find ways of striking a balance between those conflicting wishes. On the point made that the Working Group should not discard the idea of establishing a mere registration system, the Chair pointed

out that such an idea could be combined with a revised Lisbon system that would basically set the same protection standards as those under the current Lisbon system. Several requests had been made for grouping together the provisions on the content and level of protection in the DNI, for example by moving Article 6(4) to Article 9. As regards the requests for clarification of the terms used in Article 9(2), the Chair referred to what the Secretariat had said. Further reflection on the wording of those provisions was necessary. In that connection, the Chair wondered whether combining expressions that could rather be seen as alternatives was the appropriate approach, even though there was little guidance as to which concepts should be used. There had been conflicting views on the term "evocation", which some delegations had suggested to add as well to Article 9(2)(a)(i), while others had preferred to delete that term from the DNI altogether. Among the changes that had been suggested in respect of Article 9(2), the Chair elaborated on those relating to Article 9(2)(b). The Chair was of the view that part of the problem was that the provision referred to the person who would seek registration of a trademark, as that was an element on which the corresponding provisions of the TRIPS Agreement were silent. Moreover, if registration as a trademark was applied for by a person who was a holder of the right to use the appellation of origin, that would not necessarily make the registration of such a trademark consisting of an appellation of origin or geographical indication valid where the person in question was entitled to use the appellation of origin or the geographical indication. The Chair said that the Secretariat would redraft Articles 9(4), 9(5) and 9(6) on the basis of the comments made on those provisions. Article 9(4) should more clearly reflect the fact that it covered all kinds of use and not only use related to a trademark. Article 9(6) would be redrafted to make it clear that the provision concerned the content of protection rather than eligibility for protection. As regards Article 9(5), one delegation had indicated that it would be opposed to the insertion in the DNI of the provision as drafted, while another delegation had requested the inclusion of the concept of partially homonymous indications. The Chair also recalled the offer made by the Secretariat to prepare, for the next session of the Working Group, a factual document reflecting the levels of protection provided for geographical indications in WIPO Member States.

139. The Chair said that he would be particularly interested in hearing the views of delegations on how to reconcile the clear wish of a large number of delegations to provide for a single level of protection for appellations of origin and geographical indications, along the lines of the Lisbon Agreement, with the need to make the system more attractive so as to allow for an expansion of its membership.

140. The Representative of CEIPI recalled that he had indeed raised the question of the apparent contradiction between the desire of a majority of the member States of the Lisbon Union to maintain or even strengthen the current level of protection and to apply it in a uniform fashion to both appellations of origin and geographical indications on the one hand, and on the other hand the fact that such a position might compromise the purpose of the review, which was to make the system more attractive for countries which were not in the system at present. Yet it was perhaps possible to find a solution similar to what had been done for the PCT. Within the PCT framework, there had been a dual track system, with on the one hand the core system of Chapter I, and on the other hand a system that had been hotly disputed during the PCT negotiations and in the first years of PCT operations, namely, the system of international preliminary examination set out in Chapter II. In view of the fact that no consensus had been reached on that notion of international preliminary examination, but that it had nevertheless been endorsed by a great number of States, Contracting Parties had been given the option of expressing reservations with regard to Chapter II, which provided for the system of preliminary examination. The Representative went on to say that the system had worked quite well, that some countries had expressed such reservations, and that States had come little by little to trust the system of international preliminary examinations, as a result of which all reservations had gradually been withdrawn. In other words, efforts had been made over time, in different stages, to reach the goal set. It was therefore possible to proceed in that fashion in international public

law, especially in connection with WIPO conventions, given that the PCT served as a model. That being so, it was possible to imagine a new instrument setting out, for example in a first chapter, a registration system similar to the Madrid or the Hague systems, but without substantive provisions. That would be followed by a second chapter stipulating protection standards based, for instance, on a level of protection that would correspond more or less to that of the Lisbon Agreement. A Contracting Party which adhered to that kind of new instrument would be free not to accept such a second chapter via a reservation covering all of the provisions laid out in that chapter. Nevertheless, the various provisions of that chapter could be gradually withdrawn. In the Representative's view, that would respond to the desire for a high level of protection for both categories of appellations of origin and geographical indications, while attracting also those countries which were not prepared to take such a step but which would nonetheless be interested in a simple registration system modeled on the Madrid or the Hague system.

141. The Chair was of the view that the suggestion made by the Representative of CEIPI deserved further consideration, and therefore invited the members of the Working Group to give it some thought.

142. The Delegation of France wished to revert to two points raised previously. First of all was the desire to make the system more attractive. In that respect, the Delegation said that it was possible to make the system more attractive, but not only by reducing the protection granted. Moreover, it stressed that certain States had already taken steps to join the Lisbon Agreement, with a view to enjoying a high level of protection over a broader territory. Accordingly, the Delegation felt that the requirements should not be lowered, as that might fail to meet the expectations of some countries. In that connection, it emphasized that some countries had no doubt given thought to acceding to the Lisbon Agreement, not to benefit from the protection offered by the TRIPS Agreement but to enjoy stronger protection over a broader area. The Delegation further recalled that some of those countries had already expressed the view that the proposal on the table was not appealing, that is, they saw a reference to domestic legislation as insufficient. There was also a need to reflect on ways of making the system more attractive without losing its fundamental principles. With regard to the second issue raised, the level of protection, the Delegation recalled that complex discussions had taken place on the subject because the proposal on the table was itself complex, and that as a result the members of the Working Group were not able to propose clear guidelines on the question of the level of protection. To help them in that connection, the Secretariat had proposed to conduct a study on current practices in the different States. The Delegation was afraid that the outcome would be a study presenting on the one hand States which had a level of protection for appellations of origin that was more or less similar to that of the Lisbon Agreement, and on the other hand a majority of States which only protected geographical indications and appellations of origin on the basis of trademark law. It therefore wished to draw the Working Group's attention to the fact that the protection on which they should reflect had to be based on what currently existed in the Lisbon Agreement and that reduced protection should not be accepted. The Delegation specified that the idea was not to end up with protection that would reflect the lowest common denominator between all States which offered protection for geographical indications and appellations of origin.

143. The Chair confirmed that, since the establishment of the Lisbon Working Group, a double goal had been pursued, namely to make the system more attractive for users and prospective new members while preserving the principles and objectives of the Lisbon Agreement.

144. As regards the scope and objective of the proposed paper, the Secretariat clarified that such a paper would not address the protection systems as a whole in all countries, but would rather focus on the provisions in national and regional laws dealing with the scope of protection only, namely, the rights conferred and the protection granted under those laws, in order to allow

a comparison among the different ways and formulations of the rights conferred or the protection provided under those laws. The Secretariat further indicated that everybody knew that there were different systems and different laws that applied from country to country and that there were even countries which applied more than one system. However, such differences would not matter for the preparation of the proposed paper, as the document would only reflect the acts that could be prevented by right holders and not under what kind of system those acts could be prevented. Moreover, the document would be merely factual and would not suggest any conclusions that might be drawn from it. The Secretariat further specified that the information would be collected from the national and regional laws that had been notified to WIPO or to the WTO, as available from the *WIPO GOLD* Database, which was accessible on the WIPO web site.

145. The Delegation of the Republic of Moldova agreed with the Delegation of France that, without a high level of protection for international registrations, their enforceability and usefulness would be limited. The Delegation did not see why strong protection would make the Lisbon system less attractive.

146. The Delegation of Romania recalled that it had observer status, because even though it had signed the Lisbon Agreement in 1958, it had never ratified it. Furthermore, between 1958 and 1998, Romania had not introduced any legislative or regulatory measures for the protection of geographical indications or appellations of origin as such: the only protection available at the time had been indirect protection by means of trademarks or against unfair competition. At present, the Industrial Property Office was responsible for the protection of geographical indications, whereas appellations of origin came under the Ministry of Agriculture, in accordance with applicable legislation, which basically took up the *acquis communautaire* (accumulated legislation) of the European Union with regard to appellations of origin. The Delegation then expressed its support for the proposal of a high level of protection for both geographical indications and appellations of origin. Finally, it felt that CEIPI's suggestion of introducing a system in two stages deserved closer study, but did not wish to give up the idea of strong protection for both geographical indications and appellations of origin. On another point, the Delegation stressed that the document that was being examined by the Working Group was called a "Draft New Instrument", and therefore requested clarification as to the respective status of the Contracting Parties, the signatory States and observers participating in the Working Group, given that the document did not, strictly speaking, deal with the Lisbon Agreement. The Delegation also wondered whether it might not be preferable to turn the Working Group into a Committee of Experts.

147. The Chair said that the mandate of the Working Group was to discuss a draft new instrument as complete as possible while leaving open the question as to the legal form by which it might be formalized. Furthermore, paragraph 6(ii) of the document under consideration (LI/WG/DEV/4/2) invited the Working Group to indicate its recommendations not only in terms of content but also "as to the further preparation of a process that might result in a revision of the Lisbon Agreement and/or a protocol or a new treaty supplementing the Lisbon Agreement". He concluded by saying that, under both scenarios, the review exercise was related to the Lisbon Agreement and therefore believed that, at the present stage, it was still appropriate to discuss the DNI within the framework of the Working Group for the Development of the Lisbon System.

148. The Delegation of Thailand recalled that, even though Thailand was not yet party to the Lisbon Agreement, it had been informed of developments concerning the Lisbon system, including the possibility of expanding the Lisbon system so that it would also cover geographical indications. The Delegation indicated that Thailand had a law on geographical indications, namely the Geographical Indications Protection Act of 2003, which only applied to geographical indications and did not extend to appellations of origin. Should the revised Lisbon Agreement also extend to geographical indications, the Delegation was of the view that WIPO should

organize some activities related to that matter at its next *Worldwide Geographical Indications Symposium*, due to take place in Thailand. Lastly, the Delegation asked whether the DNI would overlap with the Lisbon Agreement, if the latter were also maintained.

149. The Secretariat said that it very much welcomed the suggestion to address the Lisbon system and its review in the context of the next *Worldwide Symposium on Geographical Indication* that WIPO would be organizing in cooperation with the Government of Thailand, either as a separate item in the context of that Symposium or back to back with the Symposium.

150. The Delegation of Switzerland fully endorsed the position expressed by the Delegations of France and the Republic of Moldova. As the Delegation had itself said during the debate, it was firmly convinced that reducing the level of protection which the Lisbon system offered for geographical indications and appellations of origin would not make the system more appealing *per se* for a great many potential new members. That question was apparently interpreted in different ways, because, paradoxically, lowering the level of protection could fail to satisfy both countries which did not wish to make any kind of a commitment to protecting geographical indication and countries which would understandably be attracted by the added value in terms of protection that the Lisbon system could offer. With regard to the study proposed by the Secretariat, the Delegation asked the Secretariat for clarifications as to the aims of such a study and the way in which it would subsequently be dealt with by the Working Group.

151. The Chair clarified that the objective of the review on which the Working Group had collectively embarked had never been to lower the level of protection of appellations of origin. Rather, the question was whether there should be a single level of protection for appellations of origin and geographical indications or whether there should be two different levels of protection. One way of addressing that question would be to see whether the Working Group would be prepared to provide for a level of protection for geographical indications in general that would be identical to the level of protection provided for appellations of origin under the current Lisbon Agreement or in an improved version thereof.

152. The Secretariat referred to its earlier intervention and reiterated that the proposed paper would be a factual document reflecting only the acts that could be prevented under the provisions in national and regional laws laying down the scope of protection for geographical indications and appellations of origin. The information would be taken from the WIPO Database containing legislation as notified by Member States of WIPO and WTO members. That kind of document would allow the Working Group to see what the actual protection in the various countries was. Contrary to the general assumption that countries had implemented their TRIPS obligations in the area of geographical indications at the very minimum level, the information might show that countries had actually gone beyond that minimum level.

153. The Chair said that he sensed doubts among delegations and wondered whether such a document might not distract attention from the DNI.

154. The Delegation of Indonesia said that it would be interesting to know the actual protection offered by the various national systems, be it under trademark law, as collective or certification marks, or under *sui generis* systems for the protection of geographical indications and/or appellations of origin. The Delegation therefore supported the preparation of the paper suggested by the Secretariat. The Delegation went on to say that it was of the view that a high level of protection did not equal *sui generis* protection and that, if discussions came to a deadlock, a two-tier approach should not be excluded, for example by establishing an international registration system along the lines of the Madrid system and a protocol laying down provisions of substantive law. The Delegation said that, if Indonesia joined the Lisbon system, the Delegation could understand that the benefit for wine producers from, for example,

France would be to obtain a high level of protection in Indonesia. However, the benefit for Indonesia lay in securing a high level of protection for its geographical indications, including those in respect of handicrafts, in countries such as France, which was currently not the case.

155. The Delegation of France considered that the fundamental issue was whether, assuming that the proposed document reflected the fact that 50 States protected appellations of origin and geographical indications on a level aligned with that of the TRIPS Agreement whereas only 27 States protected appellations of origin and geographical indications on the basis of a level equivalent to that of the Lisbon system, would that imply, given the need to make the system more attractive, that the Working Group would therefore be obliged to meet the needs of the greatest number, that is, the 50 countries which protected geographical indications or appellations of origin on the basis of the TRIPS Agreement? The Delegation explained that it was concerned to know what conclusion would be drawn from that document, because above and beyond simple stock-taking, the perception would perhaps be that strong protection was protection that was perhaps still a bit isolated. As for assessing protection and levels of protection, the Delegation stressed for example that Community regulations were difficult to understand and that there was only a single article at Community level devoted to protection, namely, Article 13 of Regulation 510/2006 of the European Union, which had been adapted in different ways for other sectors. In addition, there were four subparagraphs defining arrangements for protection that were differentiated. The Delegation therefore considered that it would be worthwhile for either the European Commission or the member States to make a joint effort to enlighten the Working Group, in order to be able to explain in practical terms the meaning of the terms used, namely, “direct or indirect use”, “comparable product” or in case it was felt that “undue advantage of reputation” had occurred. The Delegation thought that, in addition to simple words, there was a need to clarify the actual scope of regulations. There could be a host of possible compilations of domestic or regional regulations, but without sufficient explanations some regulations would be difficult to understand.

156. Before moving to the next topic on the agenda, the Chair referred to the suggestion made by the Representative of CEIPI, as he was of the view that it could constitute a basis for reconciling the apparently conflicting goals and wishes that the Working Group had to cope with. The Representative of CEIPI had suggested that the DNI might contain two chapters, of which Chapter I would aim at the establishment of a mere registration system similar to the Madrid and Hague systems, without provisions concerning protection standards, while Chapter II would lay down a level of protection for appellations of origin and geographical indications basically along the lines of the current Lisbon Agreement, probably with some refinements. Provision could then be made for countries and intergovernmental organizations to express, upon accession, their reservations and opt out from such a Chapter II. The underlying idea for such a two-tier approach was that, from the outset, there would be an international registration system with a relatively wide geographical coverage, and that, gradually, more and more Contracting Parties would accede to Chapter II.

157. The Representative of INTA said that it viewed the suggestion made by the Representative of CEIPI with interest and sympathy insofar as it took up the positions previously taken by INTA in another forum in favor of a Madrid-like registration system.

158. As regards the objective of making the system more attractive, the Representative of ORIGIN wondered whether in parallel with the legislative policy-making work undertaken by the Working Group to amend the Lisbon Agreement, the Secretariat also envisaged the possibility of doing some technical assistance projects in developing countries or LDC's. In that connection, he deplored the absence of OAPI at the present meeting. The Representative of ORIGIN further specified that such technical assistance projects should be aimed at the identification by developing countries of potential geographical indications or appellations of origin and the establishment of associations of producers.

159. The Secretariat said that WIPO had already provided such technical assistance on a number of occasions in cooperation with other organizations and was ready to engage further in such technical cooperation activities, as appropriate. The Secretariat added that for 2012, there were already a couple of projects in preparation in different regions. The Secretariat was also in contact with OAPI to see whether an activity with a focus on the review of the Lisbon system could be organized with OAPI and its member States in 2012. The Secretariat indicated that the reason why OAPI was not represented at the present session of the Working Group was that, as expressed in a letter that WIPO had received from the Director General of OAPI, the present meeting of the Working Group overlapped with the annual meeting of OAPI's Administrative Council. The Director General of OAPI had nonetheless underlined the interest of the OAPI in the present Lisbon review exercise.

160. The Delegation of Italy expressed its support for the Delegation of France as regards the factual paper proposed by the Secretariat.

#### PRIOR USE (ARTICLES 12, 13, 14 AND 18)

161. Introducing Articles 12, 13, 14 and 18, the Secretariat said that those provisions were based on Draft Provision F of document LIWG/DEV/3/2 and were designed to reflect the concerns expressed by delegations at the third session of the Working Group. More specifically, Article 12, which concerned use under a prior trademark, was a shortened version of Draft Provision F(3), and reflected the part that had not led to difficulties at the time of discussion. A further clarification was provided by stipulating that the safeguard for trademarks under Article 12 would not apply in respect of a generic term contained in a trademark. In view of other legitimate rights safeguarded by Article 24 of the TRIPS Agreement, such as trade names, Article 13 had been added. Use of an internationally registered geographical indication or appellation of origin as a generic was not safeguarded, as stipulated in Article 14. That did not necessarily apply in respect of prior use as a generic, which would continue to be a possible ground for refusal – as under the current Lisbon system. However, in case a Contracting Party would not submit a declaration of refusal, any such generic use of the geographical indication or appellation of origin would have to be phased out within a defined time period. Article 18(1) concerned the phasing-out provision for appellations of origin and Article 18(2) for geographical indications. Those provisions were modeled on Article 5(6) of the Lisbon Agreement but were limited to prior use as a generic – including prior use of a generic term as part of a trademark – and with a longer period for phasing out such prior use. Instead of the period of two years under Article 5(6) of the Lisbon Agreement, a flexible time limit was proposed. That time limit should, in principle, be five years, but could be shorter in specific cases and, only in exceptional cases, longer. In accordance with a suggestion made at the third session of the Working Group, Article 18(4) stipulated that the phasing-out provisions would also apply in case a refusal was withdrawn.

162. Concerning Article 12, the Delegation of France sought clarification on the French language version, as the terminology used was rather complex and different from the classic terminology used in trademark law. The Delegation further enquired as to whether the notion “term” would include sales denominations. Moreover, how could it be determined whether trademark rights extend to a term or not? In the second part of Article 12, “*les titulaires*” should be “*le titulaire*”, so as to avoid limiting the provision to collective agreements alone. The Delegation proposed to add a provision like Article 24.1 of the TRIPS Agreement, providing that exceptions provisions could not be used to refuse to negotiate improved protection in respect of individual geographical indications or appellations of origin. The Delegation further said that Article 18 should explicitly refer as well to prior use in a trademark. The phasing-out of use under a prior trademark could currently be found in bilateral agreements. The European Union provided for the phasing-out option of use as a generic, which would also apply to use under a



prior trademark. With regard to Article 13, the Delegation sought clarification as to what was covered by “another legitimate prior right”, apart from trade names. The Delegation was in favor of the proposed phasing-out period in Article 18, which would provide sufficient time for the necessary adaptations. The current two-year time limit under the Lisbon Agreement was too short. Finally, the Delegation sought clarification of the phrase “it should normally not extend beyond five years”, in particular with regard to the use of the word “normally”.

163. The Delegation of Hungary supported the Delegation of France in seeking clarification on the use of certain terminology in Article 12, more specifically the use of the term “corresponds”. That term was used in the text to describe the relation between prior trademarks and geographical indications or appellations of origin. Like the Delegation of France, the Delegation of Hungary requested clarification on the reason why the text in Article 12 departed from traditional trademark terminology, and shared its concerns as to the scope of “another legitimate prior right” in Article 13.

164. The Delegation of Cuba sought clarification from the Secretariat concerning its interpretation of Article 12. In its view, Article 12 was related to Article 5(6) of the Lisbon Agreement, and could be interpreted as depriving competent authorities of the right to notify right holders of prior trademarks to terminate the use of such marks. Under Article 12, that could only be done through an agreement between the holders of the right to use the geographical indications of appellations of origin and the owner of the prior trademark. If its interpretation was correct, the Delegation wished to know why that departure from the current Lisbon system was proposed.

165. Like the Delegations of France and Hungary, the Delegation of Italy sought clarification as to what was covered by “another legitimate prior right, such as a trade name” in Article 13.

166. The Delegation of Peru enquired about the reference in Article 12 to use under a prior trade mark “acquired in good faith”, as, under Peruvian legislation, bad faith had to be proven by the person alleging that bad faith was involved and, if so, such bad faith would result in the nullity of the registration of the trademark. With regard to Article 13, the Delegation of Peru joined the Delegations of France, Hungary and Italy in seeking clarification on what was meant by “another legitimate prior right”, besides the one example given. It asked whether such a right would refer to IP rights or also rights under commercial or civil law. The Delegation also requested clarification from the Secretariat as to the way in which Article 14 was worded, in particular, as to what was meant by “use as a generic”.

167. The Delegation of Portugal also supported the statements made by the Delegations of France, Hungary and Italy concerning Articles 12 and 13. It also sought clarification regarding the phrase “provided that the trademark right extends to that term” in Article 12.

168. The Delegation of the Republic of Moldova sought clarification concerning the relation between geographical indications and trademarks or other prior rights under Articles 12 and 13, notably as to what those provisions prescribed for competent authorities which detected, during substantive examination, a prior trademark that conflicted with the notified geographical indication. In such cases, should the geographical indication be refused or should it coexist, particularly when the trademark holder had not submitted any opposition? The current text was not sufficiently clear, as, according to the rules governing trademarks, a disclaimer would exclude neither the misleading character of a sign nor the infringement of trademark rights. For example, infringement of the “Coca Cola” trademark could not be prevented by a disclaimer in respect of a trademark for “Natalia Coca Cola”.

169. The Delegation of Switzerland supported the previous statements made on Articles 12 and 13, referring explicitly in that regard to the introduction of a phasing-out possibility in Article 18 for prior use as a generic in a trademark, as indicated by the Delegation of France. The Delegation wondered whether the DNI, as drafted, envisaged the possibility of coexistence between a prior trademark and a geographical indication, as it could not see any reference to that in the text. In any event, the Working Group should consider that possibility. The Delegation also supported the statements made to specify what other “legitimate prior right” was being considered in Article 13, and expressed discomfort with the conditional tense of Article 18.

170. The Delegation of Spain expressed doubts regarding the second sentence of Article 12, as it gave the impression that geographical indications or appellations of origin would have supremacy over trademarks. Given that an agreement, as referred to, would be optional, the added value of the sentence was questionable. Moreover, it was a matter for private parties, and considering that holders of a prior trademark could always give up the trademark at a certain point in time, it would not be necessary to have such a provision in Article 12.

171. The Representative of the European Union welcomed the introduction of a coexistence principle in Article 12. However, she suggested adding a phrase indicating that the trademark could have been acquired by registration or by use, in accordance with Article 24.5 of the TRIPS Agreement. The Representative further suggested inserting in the first sentence of Article 12, after the words “corresponds to”, the phrase “one of the uses covered by Article 9(2) of”, and replacing, in the phrase “...provided the trade mark right extends to that term...”, the word “term” with “use”. The second sentence of Article 12 could be deleted as being superfluous. She supported other delegations on the need to align the terminology of Article 12 with the one usually applied in the field of trade marks. Concerning Article 13, she suggested deleting the phrase “such as a trade name” from the title, as there was no need to give examples in the title of an article. Furthermore, the exact scope of the term “legitimate prior right” should be determined. In the European Union, there was no indefinite right to continue prior use, except for prior trademarks under EU Regulation 510/2006, and that could only be temporarily authorized if the issue were raised during an opposition procedure. The Representative sought clarification from the Secretariat with regard to the proposed phasing-out period in Article 18, which should apparently not extend beyond five years. In that regard, she drew the attention of the Working Group to the Draft “Quality Regulation” (COM(2010)733) in the European Union, which proposed a transitional period of up to 15 years. EU producers would then be treated unfairly compared to beneficiaries of international registrations would be notified under the Lisbon system. According to the Notes on Article 18, the phasing-out period was limited to prior use as a generic under the DNI. In that regard, the requirement under Rule 14(1)(ii) of the DR – to indicate the identity of the third parties to whom a transitional period had been granted – might be difficult to meet.

172. The Delegation of Romania emphasized the usefulness of Article 12. In Romania, many geographical names were protected by trademarks, which had been acquired before 1998, when the notion of geographical indications had been introduced into Romanian law. Since then, geographical indications had come into existence for those geographical names, while the prior trademarks continued to exist as well. However, whereas rights to trademarks could be transferred freely, rights to use a geographical indication should remain linked to products from a particular geographical area. That had resulted in undesirable situations on the Romanian market. Article 12 would not really solve that problem because if parties would not enter into an agreement, the trademark and the geographical indication would coexist in the market and be in conflict with one another. In connection with Article 13, the Delegation drew the attention to the fact that the registration of a trade name would provide rights to conduct business, not to defend rights.

173. The Representative of Origin supported the delegations that had expressed interest in providing a phasing-out period in Article 18 for use as a generic under a prior trademark. Further, Article 12 should allow for coexistence. He believed that that possibility had to some extent been discussed at previous sessions of the Working Group, as it could be a way to provide flexibility. However, the DNI did not seem to reflect that possibility. Like other delegations, he had doubts as to the added value of the second sentence of Article 12, as well as the wording of Article 13, especially regarding the general nature of “another legitimate prior right”, which could create legal uncertainty. He further suggested that all the provisions dealing with exceptions might be grouped under a separate heading, as in the TRIPS Agreement. Finally, the Representative sought clarification on the relation between the provisions on exceptions and those on grounds for refusal.

174. The Representative of INTA recalled that INTA had been a firm defender of the “first in time, first in right” principle. Under that principle, any conflict between a trademark and a geographical indication should be resolved on the basis of the principles of priority, exclusivity, and territoriality. That was the law under the TRIPS Agreement, as confirmed by a WTO Dispute Settlement Panel. While welcoming the inclusion of a clause to safeguard trademark rights, the Representative believed that the current draft was incomplete and expressed concerns about several statements made, which would appear to imply an actual limitation or expropriation of trademark rights. The Representative questioned the appropriateness of the phrase “for a sign containing or consisting of a term that corresponds to the geographical indication or appellation or origin in a given Contracting Party” in Article 12, as it could lead to confusion, in particular if the rights under Article 9(2) extended to “evocation”. The phrase “extends to that term” in the second half of the first sentence of Article 12 could also lead to confusion and should therefore also be deleted, all the more where the phrase would not appear to be necessary. As regards the second sentence of Article 12, the Representative endorsed the concerns raised by the Delegation of Spain and the Representative of the European Union about its necessity and appropriateness. Moreover, Article 12 only seemed to safeguard the use of a trademark and not its registration. The current text was silent on the question of whether prior trademark rights could provide a basis for challenging a later geographical indication, and it was INTA’s position that that should be possible. On the suggestions made to extend the scope of Article 18 to include prior use under a trademark, the Representative recalled that trademark rights had been recognized by the European Court of Human Rights in the Anheuser Busch vs. Portugal decision as protected property benefitting from fundamental rights guarantees, which had the effect that trademarks should be protected against unlawful expropriation.

175. Like previous delegations, the Representative of CEIPI had doubts about the second sentence of Article 12, and suggested moving that sentence to the Notes. He also supported the statement of the Delegation of Switzerland on the conditional tense in Article 18, particularly in the first sentence. When comparing the linguistic versions of the DNI, the English and Spanish versions were perfectly clear, whereas the French version posed problems. Its rather strange grammatical construction also appeared in the current text of Article 5(6) of the Lisbon Agreement, which should in his view also be adjusted, so that the text would read more clearly. For instance, the first word “if” could lead to a grammatical problem later on, and the French phrase “*se trouvait*” sounded rather strange. The English phrase “was already in use” was better. Also, the phrase “would have” should be replaced by “will have” in the French text, so as to make it clear that there was no conditional. With regard to the time limit of 15 months in Article 18(1), and considering the time frames set out in Articles 17, 18 and 19, the Representative said that it would be useful to have more flexible wording, which would enable amendments to be made and adopted, when necessary, without having to go through a Diplomatic Conference to do so. Therefore, he suggested that the time frames could be included in the DR, subject, given their importance, to a qualified majority or unanimity to modify

them. Alternatively, the time frames could be left in the DNI, with an indication that they could be amended through a unanimous decision of the Assembly. Such wording had worked within the framework of the PCT.

176. The Delegation of Costa Rica supported the deletion of the second sentence of Article 12. Instead, the Delegation proposed that the text might indicate that, if those interested in the registration of a geographical indication or appellation of origin could not register because of the existence of prior rights, ultimately, the judicial authorities in the Contracting Party concerned should decide whether use of the prior right could be terminated. Further, the Delegation shared the view that “such as a trade name” should be removed from the title of Article 13.

177. The Delegation of France was of the view that the scope of Article 12 should be clear. Referring to the statement of the Delegation of Romania, the Delegation said that the objective of the Article was to deal with conflicts arising in the use of a geographical indication, and not with cases in which trademarks had been legitimately registered and used continuously. It should be clear that Article 12 referred to those trademarks that were in contradiction with a geographical indication or appellation of origin. With regard to right holders, the Delegation said that Article 24.1 of the TRIPS Agreement covered the possibility of having negotiations on the possible discontinuation of the application of an exception to the rights under any geographical indication, including any exception based on a prior trademark. That aspect should be reflected in the DNI. As regards the phasing-out period in Article 18, the Delegation expressed the view that 15 years was too long. All that was required were time periods that would be sufficient for operators to adapt their equipment and production tools. The Lisbon system already had an established process in that regard, and one should be careful when adapting the system.

178. The Delegation of Romania clarified that it had referred to trademarks for other products than those to which the geographical indications related and which were misleading the consumer. Those trademarks would fall in a different category compared to trademarks that belonged to holders of the right to use a geographical indication. When Romania was still a socialist country, anyone could simply register a trademark, even if that mark involved a geographical indication from different location. For example, in Romania, both “*Champagne*” and “*Cognac*” had been registered as trademarks by State socialist enterprises. In the past, it had been fashionable to do so. A commission had subsequently been established to deal with a request from producers to annul those trademarks in court.

179. Referring to the statements by the Delegations of Costa Rica and Romania, the Representative of INTA said that if a trademark was misleading or geographically descriptive, there should always be a means to challenge it. As regards the TRIPS Agreement, she said that the Panel in the WTO Dispute Settlement proceedings which Australia and the United States of America had initiated against the European Union on a number of issues concerning the protection of geographical indications had taken the view that Article 24.5 of the TRIPS Agreement did not establish a general coexistence rule but only safeguarded prior trademark rights in the context of the Section on geographical indications in the TRIPS Agreement, and that exceptions to trademark rights were dealt with in the Section of the TRIPS Agreement on trademarks, notably Article 17, under which only limited exceptions could be applied in respect of use under a geographical indication. Geographical indications and trademarks were, in principle, rights on an equal footing under the TRIPS Agreement.

180. The Chair provided a summary on an article-by-article basis. Concerning Article 12, there were repeated requests for bringing the terminology closer to so-called traditional trademark terminology. That could perhaps be done by following more closely the wording of, in particular, Article 24.5 of the TRIPS Agreement. Phrases of that Article regarded as problematic included “corresponds to” and “the trademark right extends to that term”. In addition, there had been requests for simplification of the first sentence by deleting the phrase “containing or consisting

of a term that corresponds to the geographical indication or appellation of origin". There had also been inquiries about the scope of that Article, in particular as to whether it covered the validity as well as the use of a prior trademark. However, in view of the reference in Article 12 to Article 9, and given that Article 9(2)(b) covered, *inter alia*, the registration of trademarks, it would appear that Article 12 also covered the issue of whether or not the validity of a prior trademark could be called into question. That could perhaps be further clarified by aligning the text of Article 12 more closely with Article 24.5 of the TRIPS Agreement.

181. As regards the comment that no reference was made in the DNI to the possibility for a Contracting Party to refuse the protection of an international registration on the ground that it would conflict with an earlier trademark, the Chair referred to the relevant provisions of the current Lisbon Regulations, which had been reproduced in Rule 9 of the DR, which clearly stated that a refusal could be based on the existence of a prior right. Moreover, if a refusal was based on a prior trademark, the declaration of refusal should contain the essential particulars of that prior trademark, the date and filing number, the priority date, the date and registration number, the name and address of the holder, reproduction of the trademark and the list of relevant goods and services given in the trademark application or registration. The opposite situation was dealt in Article 9(2)(b) of the DNI, which stipulated that an earlier geographical indication could constitute a ground for refusing or invalidating the registration of a trademark.

182. As Article 12 provided for the possibility of coexistence but did not require coexistence, a number of delegations had advocated that the scope of the reference in Article 18 of the DNI to prior use as a generic should be extended to use under a prior trademark. However, there were also a number of delegations strongly opposed to that idea. Furthermore, a number of delegations had suggested deleting the second sentence of Article 12, and a suggestion had also been made to move that sentence to the Notes. Delegations were of the view that the sentence was superfluous, and its inclusion in the article could perhaps lead to more questions than it would resolve. The Representative of the European Union had suggested refinements to the text along the lines of the TRIPS Agreement and EU legislation.

183. The Chair then referred to a question raised by the Delegation of the Republic of Moldova concerning the application by national IP authorities of Article 12, indicating that IP authorities would not have a particular role in that respect, with the possible exception of when enforcement proceedings had been launched. When confronted with an application for a geographical indication or appellation of origin, which would conflict with an earlier trademark, a Contracting Party would have two options, either to issue a declaration of refusal on the basis of the earlier trademark or to grant the geographical indication protection with an exception based on the prior trademark in its territory. The latter would not appear to require the competent authority to submit a specific declaration or decision.

184. Turning to Article 13, the Chair said that there had been repeated calls for defining more precisely what was meant by the concept of "another legitimate prior right" and for deleting the reference to trade names from the title of the provision.

185. As regards Article 18, the Chair said that there had been suggestions for adjustments to the French version. Also, it had been suggested to deal with the length of the time limits in the DR, or by providing for the possibility that amendments to those time limits could be adopted by the Assembly. There had been conflicting views on the length of the phasing-out period. It had also been suggested that the last sentence of Article 18(1) might be drafted in a more normative way. Finally, some delegations had indicated that any time period for phasing out which extended beyond five years as a general rule would not be acceptable, while the legislation of the European Union stipulated a time period of 15 years.

186. The Secretariat said that it would see how the text of Article 12 could be aligned more closely with traditional trademark terminology. It explained that Article 12 had been drafted with a view to reflecting the provisions of Article 24.5 of the TRIPS Agreement, and was meant to allow Contracting Parties to provide for coexistence of a prior trademark with a later geographical indication or appellation of origin without imposing such coexistence. In other words, a Contracting Party could opt for coexistence, and for example, in the case of a well-known mark, could give preference to the well-known earlier mark. In relation to the phrase “corresponds to”, the Madrid Agreement and Protocol had the same wording, albeit not in the same context. Article 3 of the Madrid Agreement used the phrase “the Office of the country of origin of the mark shall certify that the particulars appearing in such application “correspond to” the particulars in the National Register”. That did not seem different from the use of the words “corresponds to” in Article 12 of the DNI. Concerning the question raised about the meaning of the phrase “provided the trademark right extends to that term”, the Secretariat clarified that it was intended to refer to the situation in a Contracting Party in which a trademark contained a word similar to a geographical indication or appellation of origin – i.e., a word that corresponded to a geographical indication or an appellation of origin, or a term of which the geographical indication or appellation of origin consisted – which was considered by that Contracting Party to be a generic term for certain goods or services. Under Article 12, the rules that applied to use as a generic would also apply to use as a generic of a term in a particular trademark.

187. With regard to the comments made as to whether Article 12 allowed for refusals to be based on an earlier trademark, the Secretariat agreed with the explanation given by the Chair with reference to Article 9(2)(b) of the DNI and Rule 9 of the DR. Concerning the suggestion to delete the second sentence of Article 12, the Secretariat noted that the Chair had referred to the suggestions to move the sentence to the Notes. The Secretariat considered the sentence a useful addition to the first sentence of Article 12, because without the second sentence, the question might arise as to whether the beneficiaries of a geographical indication or appellation of origin actually had the right to enter into such negotiations with prior trademark owners. The second sentence served to make it clear that that possibility was envisaged under the DNI.

188. As regards Article 13, the Secretariat, referring to the inquiries made as to what other rights were envisaged, apart from trade names, said that the provision was to a certain extent based on Rule 9 of the current Lisbon Regulations, which specified that a refusal could be based on the existence of a prior right. Although Rule 9 of the Lisbon Regulations addressed in greater detail refusals based on prior trademarks, the provision actually referred more generally to prior rights, without however specifying what other rights were envisaged. As the DNI was not different from the current Lisbon Regulations in that regard, there was perhaps a need to amend Article 9 of the current Lisbon Regulations as well, in view of the inquiries made as to the scope of “other prior right” in Article 13 of the DNI. In any event, the word “legitimate” had been added to “prior rights” in Article 13. Examples of such prior rights might, apart from trade names, be plant variety denominations and personality rights. Homonymous geographical indications were dealt with in a specific provision.

189. On the time limits in Article 18, there had been a suggestion to move those to the DR in order to allow possible future changes to be more easily achieved, and that would be something which the Secretariat would look into when preparing a revised draft. The time limit for notification of the phasing-out period was 15 months upon notification of international registration, and in the case of a new accession, a newly acceding country would be given 15 months plus one year, in accordance with Article 30 of the DNI. The French text would certainly be adapted, as necessary, notably the conditional tense in the first sentence as well as the entire second sentence. In that context, the Secretariat suggested that the phasing-out period might be five years and could only be extended in exceptional cases, as indicated in the Notes.

190. The Delegation of Georgia believed that the last sentence of Article 12 was redundant but would not object if the sentence were retained. The sentence permitted something that was usually accorded in every jurisdiction, being a matter of private law. Turning to the issue of refusal, the Delegation referred to a case that Georgia had experienced under the Lisbon Agreement, concerning the appellation of origin “*Borjomi*”, which had been refused by Israel because of the existence of a prior trademark registered by a private entity. Indicating that “*Borjomi*” was the mineral water of Georgia, as “*Evian*” was for France, she asked the Working Group to imagine a situation whereby “*Evian*” was used by some private entity in another country. The Delegation believed that it was not right that refusals could be based merely on the existence of a prior trademark, and considered that coexistence should be allowed instead. It also suggested that Rule 9 might specify the possible grounds for refusal. A phasing-out period of 15 years, as suggested by the Representative of the European Union, was too long. The Delegation was in favor of a phasing-out period as suggested in Article 18 of the DNI.

191. The Chair said that the current Lisbon system did not provide for an exhaustive list of grounds for refusal and left it to the legislation of each Contracting Party to address the situation. There existed national or regional laws that regarded the existence of an earlier trademark as a ground for refusing the protection of an appellation of origin or geographical indication. Only in certain circumstances, such as in the case of the legislation of the European Union, could there be coexistence.

192. The Representative of CEIPI referred to Article 18(3) and sought clarification from the Secretariat as to whether the provision – which only referred to refusals – should not also refer explicitly to invalidations.

193. The Secretariat clarified that, at the previous session of the Working Group, objections had been put forward against the idea of allowing for invalidations based on use as a generic. The point made had been that there was ample time to submit a refusal based on use as a generic during the one-year period following notification of a new international registration, and that, if no refusal was submitted on the basis of such a ground, there should not be a possibility for invalidation on that basis. The Secretariat agreed, however, that if use as a generic had occurred before the registration took place, it could be argued that that could establish a ground for invalidation in certain circumstances, although it might be difficult to prove. The Secretariat would reflect on the matter when preparing a revised draft.

194. The Chair said that it would be beneficial to incorporate the suggestion by the Representative of CEIPI in the provision. Those wishing to invoke prior use as a generic by third parties, who would currently not have a remedy against the decision of their competent authority not to grant them a phasing-out period under that provision, would be able to challenge such a decision and initiate proceedings for invalidation. The Chair added that, in the event that no refusal was issued and no decision was made to grant a phasing-out period, the only way out would be to initiate invalidation proceedings challenging the international registration.

195. The Secretariat reiterated that delegations objecting to that would argue that one year was enough to file a refusal based on prior use as a generic, so that such a ground should not be permitted subsequently.

196. The Chair wondered whether it would be right to leave the ultimate decision in that regard to the competent authority.

197. The Delegation of Cuba reiterated its question about whether Articles 12 and 18 were related to Article 5(6) of the current Lisbon Agreement. Considering that the State was the right holder of appellations of origin, the State had the right to establish the regulations for use of the appellations of origin. The Delegation was concerned that in Article 12, which stipulated that

right holders could sign coexistence agreements, the State or the competent authority would not have any say in the matter. The Delegation believed that either the State or the competent authority should be able to decide on whether or not use under a prior trademark could be continued, and ensure that nothing was or would be acquired in bad faith. The competent authority was mentioned in Article 18 concerning prior use as a generic, and the Delegation was of the view that the competent authority should also have certain rights in relation to the second sentence in Article 12, as was the case in Article 5(6) of the Lisbon Agreement. In other words, Article 5(6) of the Lisbon Agreement seemed to have completely changed, while none of the elements had really been retained in Articles 12 and 18 of the DNI.

198. The Chair indicated that due note had been taken of the suggestion by the Delegation of Cuba – to involve, in one way or another, the competent authority of a Contracting Party of origin in any negotiation or agreement on coexistence under Article 12. As to why Article 18 departed from Article 5(6) of the Lisbon Agreement, he referred to the discussion at the previous session of the Working Group, which had concluded that Article 5(6) was one of the major stumbling blocks for countries to accede to the Lisbon system. It was regarded as one of the most problematic provisions of the Lisbon Agreement and as expropriation of trademark rights without proper justification. Consequently, the Secretariat had limited the scope of Article 18 of the DNI to prior use as a generic, rather than having an extended scope of any possible use, including prior use under a trademark. Although the second sentence of Article 12 might be deleted in a revised draft, in view of the comments made at the present session of the Working Group, the Chair observed that the suggestion made by the Delegation of Cuba should perhaps be borne in mind, as the Delegation had expressed the importance that it attached to allowing the competent authority of the Contracting Party of origin to be involved in any agreement on coexistence.

199. The Chair further noted that the Secretariat would consider bringing the terminology used in Article 12 closer to so-called traditional trademark terminology. The Secretariat had clarified that that provision was intended to allow Contracting Parties to provide for coexistence. Furthermore, the Secretariat had indicated that the fact that earlier trademarks could indeed constitute a ground for refusal could perhaps be reflected more clearly in a future draft. In view of the discussion on Article 18, the Working Group might go along with the idea of limiting the scope of that provision to prior use as a generic, while noting the concerns expressed by the Delegation of Cuba and others. On Article 13, the Working Group had noted the explanation by the Secretariat. On the time limits, such as those contained in Article 18, there would appear to be an emerging consensus on the suggestion to specify them in the DR or by providing in the DNI for the possibility that amendments of the provisions relating to time limits be adopted by the Assembly in certain circumstances. The Working Group had noted that the Secretariat would improve the French version of Article 18 and that the last sentence of Article 18(1) would be reworded to make it clear that the five-year term was the general norm but could be extended in exceptional circumstances. A discussion had taken place on the need to include a reference to grounds for invalidation in Article 18(3), but that would be subject to further consideration and examination.

#### OTHER SUBSTANTIVE PROVISIONS (ARTICLES 10, 11 AND 15)

200. In its introduction, the Secretariat said that Articles 10, 11 and 15 of the DNI corresponded to Articles 6, 7(1) and 8 of the Lisbon Agreement. A minor change had, however, been reflected in Article 15(1), which provided that enforcement action could be taken by “the Public Prosecutor or, where applicable, another public authority”. In comparison, Article 8(1) of the Lisbon Agreement provided that such action could be taken “at the instance of the competent authority or at the request of the Public Prosecutor”. When in contact with a country that was not party to the Lisbon Agreement, the Secretariat had been informed that the competent authority in that country would never have the possibility of taking such legal action.



201. The Delegation of Costa Rica wondered why, in Article 15, the order in mentioning the authorities referred to had been reversed compared to Article 8 of the Lisbon Agreement. In addition, the Delegation believed that it would facilitate interpretation if Article 15 were to clarify the kind of legal action to which it was intended to relate. The Delegation also expressed the view that Article 15 was too vague as to what it actually legitimized. Under the national legislation of Costa Rica, legal proceedings could only be initiated by, or on behalf of, persons who had the authority to do so. The Delegation was of the view that Article 15 did not provide the necessary legitimacy in that respect. For example, the Public Prosecutor's Office would only act in cases of a criminal offense. A violation or usurpation of a geographical indication or an appellation of origin would not necessarily be a crime.

202. Concerning Article 10, the Representative of the European Union said that it would appear to be more appropriate to lay down an absolute rule, stipulating that a registered geographical indication or appellation of origin could not become generic.

203. The Delegation of France addressed Article 10 along the lines of the statement made by the Representative of the European Union. In that connection, the Delegation also referred to WIPO Publication No. 264, concerning the text of the Lisbon Agreement, its Regulations and Administrative Instructions, in particular the title of Article 6 of the Lisbon Agreement in that Publication, which corresponded to Article 10 of the DNI. In a previous version of Publication No. 264, the title of Article 6 had read "Generic Appellations", which had been a strange title in view of the fact that Article 6 was meant to prevent appellations of origin from becoming generic. Consequently, following discussions at a previous session of the Working Group, the Secretariat had decided to change the title. In the Delegation's view, however, the new title did not accurately reflect the meaning of the provision. Moreover, although the title of Article 6 in WIPO Publication No. 264 was only indicative, i.e., it was not part of the text adopted at the Diplomatic Conference where the Lisbon Agreement had been concluded, that would be different in respect of Article 10 of the DNI. As a result, Article 10 would lay down a presumption that a geographical indication or an appellation of origin could not become generic. Even though, as mentioned in the Notes on Article 10, the intention was that it would be for each Contracting Party to decide whether such presumption would be rebuttable or irrebuttable, an irrebuttable presumption was not the same as laying down an absolute rule that geographical indications and appellations of origin could not become generic.

204. The Delegation of Chile requested clarification on the reference in Article 10 to Article 3(3).

205. The Delegation of Italy supported the statement made by the Representative of the European Union concerning Article 10.

206. The Representative of INTA suggested deleting the comma after "generic" in Article 10 and referred to the statement of the Delegation of France on the title of that Article. With regard to Article 15, the Representative noted that the reference to "national legislation" was not appropriate, given that one of the objectives of the DNI was to allow regional organizations to become Contracting Parties.

207. With regard to Article 10, the Delegation of Romania sought clarification as to why it was necessary to indicate "as long as it is protected as a geographical indication".

208. The Chair said that protection under the DNI – as under the current Lisbon Agreement – to the effect that a geographical indication or appellation of origin could not become generic was based on a rebuttable presumption, and that their protection was, moreover, dependent on their protection in the country of origin. The same principle was enshrined in Article 24.9 of the TRIPS Agreement, which provided that there was no obligation to protect a geographical indication which was not or ceased to be protected in its country of origin, or even which had

fallen into disuse in that country. Thus, the general rule was that, if an appellation of origin or a geographical indication was no longer protected in its country of origin, then the presumption that it could not be deemed to have become generic would no longer stand. Protection was dependent on the protection existing in the country of origin or, in the case of the DNI, in the Contracting Party of origin.

209. Continuing, the Chair said that a substantive issue raised was whether Article 10 should be reworded along the lines suggested by the Representative of the European Union, and supported by some delegations: to read “a geographical indication or appellations of origin cannot become generic”. That would change the legal nature of the provision from a presumption to an absolute prohibition. A question had also been raised on whether the presumption was rebuttable or not. In addition, suggestions had been made for refining the text. For example, the Delegation of Costa Rica had suggested looking at the order in which authorities were mentioned in Article 15 under item 1, and whether reference could be made to the legitimacy for taking enforcement action. In that context, the Chair wondered whether the reference to “any interested party” could be regarded as wording reflecting that element. Finally, he reiterated a number of requests for clarification that had been made.

210. The Secretariat said that the comma in Article 10 after the word “generic” also existed in the current text of Article 6 of the Lisbon Agreement. In Article 15, the order proposed under item 1 would provide flexibility as to the authority that a Contracting Party could identify for such purposes. The Public Prosecutor was mentioned first, as it would be illogical to refer first to “any other public authority”. As regards the issue of legitimacy, the Secretariat said that that simply followed the current Lisbon Agreement. It was left up to the national law of a Contracting Party to apply that as it deemed appropriate. In response to the question posed by the Delegation of Chile, the Secretariat confirmed that the reference to Article 3(3) in Article 10 was correct, as it referred to the law of the country, which laid down how geographical indications and appellations of origin should be protected in the Contracting Party concerned. In that regard, the Secretariat referred to the discussion on Article 3 that had taken place previously at the present session of the Working Group. Finally, the Secretariat confirmed that the term “national legislation” would be replaced by a broader term.

211. Turning to the suggestions made on the wording of Article 10 and the comment that Article 10 was related to Article 6 of the current Lisbon Agreement, as both read “cannot be deemed to have become generic”, the Secretariat referred to the second session of the Working Group when that question had been discussed. During that discussion, divergent views had been expressed between Lisbon member States as to how Article 6 should be interpreted, notably whether it laid down an absolute rule or a presumption. Following the discussion, the Chair had concluded that the provision did not require a change, as countries could implement it either as a rebuttable presumption or as an irrebuttable presumption. In light of the discussion, however, the Secretariat had considered how the title of Article 6 could be adjusted when preparing a reprint of Publication No. 264 in 2010 and had come to the conclusion that Article 6 could safely refer to “presumption that a protected appellation cannot become generic”, on the understanding that the presumption could be rebuttable or irrebuttable. Moreover, Lisbon member States had been consulted on the draft text to be contained in that reprint, as the text also contained a number of corrections to the English and Spanish translations of the Lisbon Agreement. Changes compared to the previous version of Publication No. 264 had been clearly indicated. Furthermore, the titles were not part of the text adopted by the Diplomatic Conference, as mentioned in a footnote at the beginning of Publication No. 264. In addition, the Secretariat underlined that the suggested change in the wording of Article 10 of the DNI would preclude a whole range of countries from ever acceding to either the Lisbon Agreement or the DNI, notably common law countries, as alluded to by the Delegation of Australia during the present session of the Working Group.

212. The Chair said that much depended on how the DNI would be structured. If a two-tier approach were to be followed, as suggested in the discussion under Article 9, issues of substantive law, such as those relating to Article 10, might become less problematic. On the clearly expressed wish to reword Article 10 of the DNI, the Chair suggested that the next draft of Article 10 might reflect, in square brackets, an alternative to that provision. Article 15, which closely followed Article 8 of the Lisbon Agreement, was a somewhat archaic provision, when viewed against the background of the enforcement provisions of the TRIPS Agreement and the enforcement provisions included in some WIPO-administered treaties. Moreover, it was difficult to conclude whether items 1 and 2 of Article 15 were alternative or cumulative requirements. In addition, Article 23.1 of the TRIPS Agreement contained a footnote indicating that WTO Member States may provide for enforcement by administrative action. Would that option still be open to those WTO members that were also Contracting Parties to the Lisbon Agreement, or would they be under an obligation to provide for private enforcement? The normative nature of Article 15 also seemed open to question, as the provision stated that “legal action required for ensuring protection may be taken”. To whom was that “may” addressed? Were Contracting Parties obliged to provide for that possibility, or were they free to decide?

213. The Delegation of France could not agree that the title of Article 10 would be drafted in a way that tilted the provision in favor of a presumption.

214. The Chair suggested that, if the revised version of the DNI would include two alternative options for Article 10, it could also have two alternative titles. Moreover, the provision had perhaps better be included in Article 9. Finally, following a query from the Delegation of France on the title of Article 6 of the Lisbon Agreement, as contained in WIPO Publication No. 264, the Chair suggested that the Delegation of France contact the Secretariat. He indicated, however, that the titles in that Publication were not binding and were included only for information purposes, as confirmed in a footnote to the Publication.

#### FILING INTERNATIONAL APPLICATIONS (ARTICLES 5 AND 7 AND RULES 5, 6 AND 8)

215. Introducing the provisions, the Secretariat said that, as stated in the Notes to Article 5, the provisions were based on the current provisions of the Lisbon Agreement and its Regulations, and adapted in accordance with Article 3 of the DNI, which dealt with the basis of protection in a different way compared to the Lisbon Agreement. Consequently, reference was no longer made to the country of origin on the basis of the geographical area whose name constituted the geographical indication or appellation of origin, but to the legal instrument under which protection had been granted in respect of a given geographical indication or appellation of origin in a particular Contracting Party. Thus, international applications would have to be filed by the Contracting Party under whose law protection had actually been granted. That change of practice compared to the Lisbon Agreement was particularly important in connection with the possibility under the DNI for intergovernmental organizations to become Contracting Parties. For example, if the European Union and Germany, as a Member State of the European Union, were both Contracting Parties to the DNI, then, in respect of a geographical indication or appellation of origin that had been granted protection under German law, the competent authority of Germany would have to file the international application. However, if protection had been granted under the law of the European Union, then the competent authority of the European Union would have to file the international application. In addition, the possibility for the holders or beneficiaries of a geographical indication or appellation of origin to file directly with WIPO had been reflected in the DNI, as discussed at previous sessions of the Working Group. The beneficiaries would nevertheless be required to keep the competent authority of the Contracting Party of origin informed, whenever they would file an international application directly with WIPO. Furthermore, they would be required to provide proof of protection obtained for the geographical indication in the Contracting Party of origin concerned. Finally, Article 7(1) of the DNI and Rule 5(2)(d) of the DR required that applications be accompanied by a fee, the

amount of which was specified in Rule 8 of the DR. The provisions were the same as those applying under the current Lisbon system. No change had been proposed in that regard, as the Secretariat had not received any guidance in that respect from the Working Group.

216. The Delegation of the Republic of Moldova expressed a reservation on Article 5(3), as it did not see the point of introducing such a revolutionary provision if the applicant would be asked anyway to submit proof that the particulars specified in the international application corresponded to the particulars in the legislative or administrative act, judicial decision or registration referred to in Article 5(2).

217. The Delegation of Peru expressed doubts regarding the drafting of Article 5(2), as it seemed that the competent authority would have to first receive a request from the holders of the right to use a geographical indication or appellation of origin before it could file an international application. In the case of Peru, the State was the owner of the appellation of origin. For that reason, the Delegation proposed the following wording: "The international application for the registration of a geographical indication or an appellation of origin shall be presented by the competent authority, in the name of any natural person or legal entity, public or private, owner of the geographical indication or the appellation of origin, or at the request of the holders of the right to use a geographical indication or appellation of origin, according to the legislative or administrative act, judicial decision or registration referred to". The same would be applicable to Article 5(3).

218. The Representative of ORIGIN indicated that ORIGIN had, in its response to the Survey and at previous sessions of the Working Group, pushed for the insertion of the possibility for the beneficiaries to file international applications directly with WIPO. In certain jurisdictions, for instance in countries where geographical indications were protected by trademarks, the State would not legally be entitled to file an application on behalf of the holder of a privately owned right. Moreover, especially in developing countries, the State, or the competent authority, might not have the resources or desire to do so. He further noted the optional nature of Article 5(3). Finally, he requested clarification concerning the relationship between Article 5(6) of the DNI and Rule 5(2)(a) of the DR.

219. The Chair said that there was a difference between those elements to be included in an international application for establishing the filing date and those that were mandatory requirements. As a condition for registration, Rule 5(2)(a) stipulated that an international application could only be registered if all mandatory requirements contained in that provision were met. Article 5(6), however, listed the requirements for establishing the filing date of an international application. Such a distinction was usual in intellectual property laws. The minimum elements should be sufficient for establishing a filing date, and if there were, later on in time, missing mandatory elements, the applicant would then be invited to remedy those deficiencies before the registration was finalized.

220. The Delegation of Switzerland supported the inclusion of Article 5(3) in the DNI. The Delegation recalled that, in the Hague system, the possibility for holders to file international applications directly with WIPO already existed. The option would make the Lisbon system more flexible. However, such direct filing should respect the definition of geographical indication or appellation of origin. For that reason, it would be important for the Working Group to agree on a level of protection for geographical indications and appellations of origin. Article 3(2) of the DNI and the related draft provisions in document LI/WG/DEV/3/2 prepared for the third session contained references to substantiate that sort of direct filing.

221. Concerning Article 5(3), the Representative of INTA wondered whether the phrase "a federation or association having legal standing to assert that right" also covered holders of a certification mark. He suggested replacing "federation or association" with a wider concept such

as “entity”, so that the phrase would read “an entity having legal standing to assert that right”. He also requested clarification as to what proof the direct applicant would have to bring in support of an international application. Presumably, he would have to comply with each of the six items listed in Rule 5(2)(a) of the DR. However, although a copy of the document referred to in Rule 5(2)(a)(vi) might be submitted, under Rule 5(3)(v), as such proof, the Representative was not sure that such a document would always necessarily reflect all six items required under Rule 5(2)(a). He therefore suggested that the Working Group take another look at the possibility contained in Draft Provision B in document LI/WG/DEV/3/2, which required direct applicants to have their international application certified by the competent authority of the Contracting Party of origin. That might also facilitate the work of WIPO and reduce the volume of translation work in respect of international registrations.

222. The Delegation of Iran (Islamic Republic of) requested clarification as to how, under the DNI, international applications would be dealt with that concerned appellations of origin for which protection had been refused in the Contracting Party of origin.

223. The Chair indicated that Article 5(3) was of an optional nature, i.e., a Contracting Party had a choice whether or not to allow the filing of direct applications in respect of geographical indications and appellations of origin for products originating in their territory. That was the meaning of the phrase “if the legal instrument referred in Article 3(3) so permits”. Some Lisbon member States saw the role of the competent authority as a guarantee. However, such a guarantee was also incorporated in Article 5(3), as direct applicants would be required to provide proof that the particulars specified in the international application corresponded to those in the act or decision by virtue of which the geographical indication or appellation of origin had been granted protection in the Contracting Party of origin. Applicants could also submit a certified copy of that act or decision, as obtained from the competent authority concerned. Thus, there would be an element of guarantee enshrined in this optional provision.

224. The Delegation of the Republic of Moldova said that in Moldova, there existed a sophisticated procedure for obtaining protection and recognition of geographical indications. The country had two competent authorities, one dealing with the certification of products to be in conformity with the applicable standards and the other dealing with the national registration system for geographical indications. The Delegation wondered from which authority the beneficiaries should obtain proof under Article 5(3) of the DNI.

225. In response to the various comments made, the Secretariat first referred to the interventions by the Chair as regards the optional nature of Article 5(3) and the relationship between Article 5(6) and Rule 5(2)(a). Turning to the question raised about the information or proof to be provided when filing direct applications to WIPO, the Secretariat said that the information to be supplied with the international application should be provided in a working language applicable under the DR and show that the particulars specified in the international application corresponded to the particulars in the registration, judicial decision, ministerial decree or other act by virtue of which the geographical indication or appellation of origin had been granted protection in the Contracting Party of origin, i.e., the Contracting Party under whose national or regional law that registration, judicial decision, ministerial decree or other act had been effected. When a competent authority submitted an international application, that fact in itself would certify that the particulars in the international application corresponded to the particulars on the basis of which protection had been granted in the Contracting Party of origin. However, the filing of direct applications under Article 5(3) would require evidence to show that those particulars corresponded to the particulars in the national registration, judicial decision, ministerial decree or other legislative or administrative act.

226. Continuing, the Secretariat referred to the suggestion by the Delegation of Peru for an addition to Article 5(2) designed to cover cases where the State was the owner of geographical indications or appellations of origin. That would be necessary in view of the text of Article 5(2), as the State would submit international applications on its own behalf. However, Article 5(2) focused on the holders of the right to use and not on the issue of ownership, which was a different issue. International applications received by WIPO under the Lisbon system often indicated the owner of the appellation of origin but not, as required, the holders of the right to use the appellation of origin, so that WIPO had to follow up with an irregularity letter. An attempt had been made, in Article 5(2), to avoid that problem in the future.

227. On the suggestion made by the Representative of INTA concerning the phrase “federation or association having legal standing to assert that right” in Article 5(3), the Secretariat recalled that the phrase had been taken from the footnote to Article 42 of the TRIPS Agreement, which specified that the right could be asserted by a federation or association having legal standing to assert that right in respect of a geographical indication. In addition, Article 10<sup>ter</sup> of the Paris Convention referred to the same, while specifying these entities as “federations and associations representing interested industrialists, producers, or merchants”.

228. The Delegation of Iran (Islamic Republic of) expressed a concern that under Article 5(3), appellations of origin would not first need to be registered and protected in the Contracting Party of origin before they could be registered at WIPO.

229. The Secretariat said that Article 5(3) was not meant to say that holders would file directly with WIPO without having first obtained protection in the Contracting Party of origin. Protection first had to be established in the Contracting Party of origin. The Secretariat then reiterated the reason why the possibility for direct applications was proposed as well as why Article 5(3) required certain assurances in respect of applications filed directly by the beneficiaries. The Secretariat also reiterated that Article 5(3) was of an optional nature. In cases where the relevant national law would not allow the beneficiaries to file directly with WIPO, they would have to go through the competent authority of the Contracting Party of origin.

230. The Delegation of Italy proposed that, for the sake of consistency, the phrase “or a federation or association having legal standing to assert that right” could also be reflected in Article 5(2).

231. The Representative of the European Union referred to Rule 5(2)(a)(ii), which required international applications to indicate the holder or holders of the right to use the geographical indication or appellation of origin. However, as there could be many right holders, it might be problematic to indicate those holders in certain cases. Therefore, she expressed the view that that provision should not be mandatory. Further, Rule 5(2)(a)(iv) should specify that the product be clearly described, so that it could easily be identified. The European Union regularly encountered problems with third country applications in that regard, as it was not possible to understand to what kind of product the application related. As regards Rule 5(3)(ii) – “the international application may contain one or more translations of the geographical indication or appellation of origin in as many languages as the presenter(s) of the application wish(es)” – the Representative sought clarification as to the legal effect of those translations. Under EU law, only the terms as registered in the country of origin could be registered. It would appear important to uphold that principle as well in the context of the DNI. Finally, she referred to Rule 5(3)(vi), which stipulated that any further information could be provided concerning the protection granted to the geographical indication or appellation of origin in the relevant Contracting Party, such as a description of the connection between the quality or characteristics of the product and its geographical environment or between the quality, reputation or other characteristic of the product and its origin. In that connection, she put forward the view that

information about the link between the product and the geographical environment was crucial and should be made mandatory. Otherwise, it would be difficult to ensure that all requirements of the definition of geographical indication or appellation of origin were met.

232. The Representative of INTA agreed with the proposal from the Delegation of Italy, while adding that in countries where geographical indications could be protected by means of certification marks or collective marks, the owner of the mark controlled use of the mark but would not be entitled to use the mark himself. Article 5(2), as currently drafted, would, in effect, exclude owners of certification marks or collective marks. The Representative therefore suggested adding the phrase “or an entity having legal standing to assert rights in the geographical indication or appellation of origin” towards the end of Article 5(2). Alternatively, the suggestion could be incorporated in Article 2 of the DNI, which dealt with definitions.

233. The Delegation of Peru referred to its drafting proposal for Article 5(2), and reiterated its concern that the Article did not cover cases where the State was the holder of appellations of origin. The Delegation also suggested inverting the order of Articles 5(6) and Article 5(7), so that Article 5(6) would deal with the applications that fully complied with all the requirements and Article 5(7) with incomplete applications.

234. The Delegation of Switzerland supported the statement made by Italy about the need to add a reference to international associations that were holders of the right to use a geographical indication or appellation of origin in Article 5(2). The holders of the right to use were very often represented by associations, so that it was important to ensure that they were also covered by Article 5(2). In connection with the suggestions put forward by the Representative of the European Union, the Delegation said that, although it would not always be easy to identify all holders of the right to use a particular geographical indication or appellation of origin, it was possible to refer to them collectively, for example, through a reference to an association representing them. Moreover, in any event it should be possible to identify the beneficiaries in the context of direct applications filed under Article 5(3). Finally, the Delegation referred to the comments made on transforming certain obligatory elements into optional ones, expressing the view that, in order to make the system more attractive and flexible, the Working Group should not make the filing of international applications more rigid and strict than it already was under the current Lisbon system.

235. The Delegation of France requested clarification on the scope of Rule 5(3)(ii). There were various appellations of origin, which could be translated, for example, “*Parmigiano-Reggiano*” or “*Bourgogne*”. When protecting the appellation of origin “*Bourgogne*”, could the protection apply to the translated form “*Burgundy*”? Should it be submitted as part of the application? Would the protection only then apply or would it be automatic? On the suggestion made to include a reference to “federations and associations” in Article 5(2), the Delegation indicated that, in France, there also existed a system of collective representation of operators in the area of geographical indications and appellations of origin, even though the French system was perhaps not the same as the Italian one. The Delegation believed that such collective representation was already covered by the phrase “any natural persons or legal entities” in Article 5(2), as associations of producers could either be private or public entities. At least, that was the case under the Lisbon Agreement. However, if there was a need to be more specific, the Delegation could support the suggestion of the Delegations of Italy and Switzerland.

236. Offering a preliminary summary of the comments made, and sharing a few observations on the issues raised during the session, the Chair first said that the Working Group could take note that Article 5(3) was an optional provision, from which opting out was possible. In other words, Contracting Parties would be free to exclude application of the provision in respect of geographical indications and appellations of origin for which they were the Contracting Party of origin. Second, Article 5(3) would not change the general rule that protection in the Contracting Party of origin was a prerequisite for international registration. That was borne out by the

phrase “legislative or administrative act, judicial decision or registration”, which referred to the legal means by which protection had been granted in respect of a given geographical indication or appellation of origin in the Contracting Party of origin. Third, the Secretariat had clarified what was meant by the condition that the particulars specified in an international application should correspond to the particulars in the legal means by which protection had been granted in the Contracting Party of origin. However, a number of delegations had pointed out that it might be difficult for beneficiaries to provide the necessary proof for all the particulars, and a certification system had been proposed as an alternative, whereby the competent authority would certify that those particulars corresponded.

237. Continuing, the Chair said that several proposals had been made to align Article 5(2) and Article 5(3) so that both provisions would refer as broadly as possible to entities having legal standing to assert the right in a geographical indication or appellation of origin. On the other hand, it had also been pointed out that the current wording of Article 5(2), which followed that of the Lisbon Agreement, seemed broad enough to cover all kinds of entities, as it referred to natural persons or legal entities, public or private. The Chair added that he could not think of any broader term, and believed that it was not the way in which reference was made to the legal personalities in question that mattered, but rather whether the phrase “the right to use the geographical indication or appellation of origin” was mentioned with or without the expression “having legal standing to assert that right”. That seemed to be the basic difference. The formulation of “natural persons or legal entities, public or private” was, at least under Hungarian law, sufficiently broad to cover all kinds of bodies, including the State. In cases where the State was the owner of a right or a right holder, the State would act as a legal entity, and not in its capacity as a subject of international or public law.

238. Turning to Rule 5(2)(a)(ii) and the difficulties involved in identifying and naming the holders of the right to use a geographical indication or appellation of origin, the Chair indicated that the general rule was that those holders should be designated collectively and that collective designation was possible by referring to federations or associations representing them or having the right to assert the right in the geographical indication or appellation of origin. The provision seemed clear enough on the issue, but perhaps an even clearer formulation was possible. Divergent views had been expressed on turning that mandatory requirement into an optional one. The Chair said that there had also been an interesting exchange of views on the issue of translation, adding that in any event, protection would extend to the translated forms of an appellation of origin under both the Lisbon Agreement and Article 9(2) of the DNI. Another issue raised concerned the link between the quality or characteristics of a product and its geographical origin. It had been proposed that the optional requirement of Rule 5(3)(vi) of the DR be made mandatory. On the other hand, it had been pointed out that, for the purpose of making the Lisbon system more attractive, currently optional requirements should not be made mandatory. The Chair believed that that was a very important consideration to take into account. The Delegation of Peru had suggested switching Articles 5(6) and 5(7). In that regard, the Chair observed that those provisions followed the wording and structure of the current Lisbon Regulations. Article 5(7), however, started with the phrase “in all other cases”, whereas there could only be one other case, as in the other cases, those particulars were contained in the application.

239. The Secretariat referred to the question posed by the Delegation of Peru as to whether the State could be mentioned in Article 5(2), as well as the comments made by the Representative of INTA and the Chair in that regard. The Secretariat reiterated that both the current Lisbon system and the DNI focused on the holders of the right to use. In other words, the users were being addressed, not the owners. There was a difference between the issue of ownership and the issue of users’ rights. Referring to the practice under the Lisbon system, the Secretariat said that under the Lisbon system, applicants had to indicate, in an international application, who the users of an appellation of origin were. The issue to clarify was how to refer to them in an application in a collective way, as there could be many users of a particular geographical



indication or appellation of origin. Rule 5(2)(a)(ii) of the Lisbon Regulations and the corresponding provision in the DNI stipulated that holders of the right to use could be designated collectively, and only in case such collective designation would not be possible, they had to be designated by name. At a previous session of the Working Group, the Representative of an observer delegation had mentioned that the problem with that provision was that collective designations as applied in practice under the Lisbon system were often not useful. When looking at registrations under the Lisbon Agreement, such collective designation was often simply phrased as “producers from the area”. If there was a need to address those users for reasons of legal procedures, for example, such an indication would not serve any purpose. The suggestion made to have a stricter provision for collective designation was, therefore, useful and, perhaps, the inclusion in Article 5(2) of the phrase “federation or association having legal standing to assert the right” could help.

240. On the issue of translation, the Secretariat agreed with the Chair that both the Lisbon Agreement and the DNI provided protection against translated forms of a geographical indication or appellation of origin. In other words, translations were covered by the rights. In order to allow others to know that a particular term in another language was a translation of a geographical indication or appellation of origin, the possibility was offered to indicate such translations in an international application. The protection would nonetheless exist even if such translations were not indicated, subject of course to an exception that might be applicable in respect of the translation of a geographical indication or an appellation of origin. In any event, under the Lisbon system, WIPO should not translate any appellation of origin.

241. Finally, the Secretariat turned to Rule 5(3)(vi), which the Representative of the European Union had proposed to move to Rule 5(2), which laid down the mandatory requirements for international applications. However, that provision had been adopted by the Assembly in September 2011, as an optional provision, and would enter into force under the Lisbon Agreement as of January 2012. The Secretariat had also copied the provision in the DNI as an optional provision, because no consensus had been reached in the Working Group on recommending a mandatory provision to the Lisbon Union Assembly.

242. The Chair sought clarification on the issue of ownership, as it was his understanding that there was normally no owner, apart from cases where an appellation of origin was protected through a collective mark or certification mark. The Lisbon Agreement referred to persons who collectively had the right to use an appellation of origin. Would it matter to know who the owner was? In respect of geographical indications or appellations of origin, one could think of associations and federations that would act on their behalf or in their name, but what really mattered were the persons who had the right to use. It was normal that they could not always be named, because any individual producer that complied with the requirements concerning a product, its characteristics and the geographical origin would be entitled to use the geographical indication or appellation of origin. The Chair therefore wondered whether the Working Group should deal at all with the issue of ownership. The fact that the Lisbon Agreement did not address the issue of ownership was not by mistake or by chance. There might be an issue in so far as geographical indications could be protected through collective or certification marks, as the owners of such trademarks were not allowed to use those trademarks. However, that was another issue. There was no reason to bring the issue of ownership as such into the discussion.

243. The Secretariat agreed with the Chair but reiterated that competent authorities of Lisbon member States had been filing international applications in which the State or an association was indicated as the owner without indicating who the holders of the right to use the appellation of origin were.

244. The Chair concluded that it was useful to clarify the issue, and invited the Working Group to deliberate thereon.

245. The Delegation of Mexico expressed its concern about a provision that would require its competent authority to indicate the names of all the holders of the right to use. In Mexico, an application for protection could only be made by one person, and users had to be authorized before they were allowed to use the appellation of origin.

246. The Chair reiterated that, under both the current Lisbon system and the DNI, the general rule was that holders of the right to use an appellation of origin or geographical indication should be designated collectively and not individually. For example, if an individual holder of the right to use an appellation of origin or geographical indication were to file, on behalf of all holders, an international application under Article 5(3) of the DNI, the holders of the right to use the appellation of origin or geographical indication should nevertheless be designated collectively in the application. Such a collective designation would not necessarily have to be done by listing the names of all users, but could be done collectively. That kind of provision would prevent the expropriation of the right by an individual holder of the right to use through the filing of an application.

247. The Secretariat agreed with the Chair but recalled that Mexico was referring to its national situation in which there existed a system of authorized users. Apparently, users were recorded in the Register of Appellations of Origin as authorized users, and if that was indeed the case, it would appear to be possible to indicate in an international application those recorded as authorized users in that Register.

248. The Chair added that the persons in question could in that case be indicated by name or by a reference to the Mexican Register.

249. The Delegation of Italy reiterated its suggestion to align Article 5(2) with Article 5(3).

250. The Delegation of Peru recalled that Article 5(1) of the Lisbon Agreement, unlike Article 5(2) of the DNI, did not contain the phrase “and upon request from”. That change would affect the specific case of Peru, as the competent authority in Peru would not need a request from the users of an appellation of origin to register an appellation of origin.

251. The Chair said that Article 5(2) of the DNI in that regard indeed contained a new element. The question was whether the competent authority of the Contracting Party of origin should only be entitled to file an international application, if that it had been requested by the holders of the right to use a geographical indication or appellation of origin to do so.

252. The Delegation of Switzerland referred to the preliminary conclusions of the Chair about associations representing holders of the right to use, and while indicating that the phrase “natural persons, legal entities, public or private” was indeed sufficiently broad, said that the problem was that the current wording of Article 5(2) seemed to require that those persons or entities had to be holders of the right to use. However, producer associations were not holders of the right to use but representatives of the holders of the right to use. For that reason, the Delegation suggested amending Article 5(2) and Article 5(3) as well as Rule 5 by adding a reference to representatives of the holders of the right to use. Further, the Delegation agreed with the Delegation of Peru to delete the phrase “and upon request from” in Article 5(2).

253. The Delegation of Portugal expressed the view that, in view of the differences in national systems, the issue of ownership was to be solved by the national legal order.

254. The Representative of INTA said that his understanding was that Article 5(2) and Article 5(3) only determined who was entitled to file an international application in respect of an appellation of origin or geographical indication, i.e., those provisions did not deal with the issue of ownership. For INTA, it was important that the text also cover holders of certification marks as well as the membership of collective marks, i.e., owners who controlled the use of the mark but were not entitled to use it themselves.

255. The Chair indicated that the discussion had boiled down to the question of how to identify the persons in whose name the competent authority would file the international application under Article 5(2), as well as how to identify the persons who could file directly with WIPO under Article 5(3). It was the wish of the Working Group that those persons be defined in a uniform manner with respect to both paragraphs. The Working Group had so far worked on the assumption that the phrase "having legal standing to assert the right" was broad enough to cover cases where the holder of, in particular, a collective or certification mark was not entitled to use the appellation of origin or geographical indication, but had the right to assert that right, in other words, to represent the holders. As a possible solution for adding the concept of "representing holders of the right to use" to Article 5(2), the text could perhaps refer to "federations or associations having legal standing to assert that right", as under the TRIPS Agreement and the Paris Convention. There had also been a request to remove the phrase "and upon request from", as that was regarded as an unnecessary restriction. Article 5(2) could then perhaps be worded as follows: "The international application for the registration of a geographical indication or appellation of origin shall be presented by the competent authority in the name of any natural persons or legal entities, public or private, being, according to the legislative or administrative act, judicial decision or registration referred to in Article 3(2), the holder or holders of the right to use the geographical indication or appellation of origin in question, or a federation or association having legal standing to assert that right". The reference to "that right" would be the same as in Article 5(3), which was the right to use the geographical indication or appellation of origin.

256. The Delegations of Peru, Romania and The former Yugoslav Republic of Macedonia expressed support for the proposed text.

257. The Representative of INTA suggested that it would be more appropriate to state "legal entities having legal standing to assert rights in the geographical indication or appellation of origin".

258. In response, the Chair said that the text of Article 5(3) would also have to be changed in that regard.

259. For greater precision, the Delegation of Italy proposed an addition to the proposed text, in order to also cover the situation that associations represented users when defending their rights. It suggested that the text might refer to "a federation or association having legal standing to assert and represent that right".

260. The Chair indicated that the suggestion of the Delegation of Italy could be taken on board, perhaps with a slight modification, as the phrase "representing a right" would not be proper wording. The Chair concluded that there was consensus on the principle and noted that the Working Group agreed to request the Secretariat, taking into account the proposals made on Article 5(2) and Article 5(3), to present appropriate wording for the text at the next session of the Working Group.

## FUTURE WORK

261. Ms. Wang Binying, Deputy Director General of WIPO, said that she was impressed and encouraged by the quality and the constructive nature of the discussion, which provided a good basis for progress in the work of the Working Group and augured well for the future. Referring to the intervention of the Delegation of Thailand, she informed the Working Group that, for the 2012-2013 Biennium and within budgetary constraints, the Secretariat had planned to enhance its activities on the Lisbon system and on geographical indications in general. The Lisbon Union was the smallest among the Unions of the registration treaties administered by WIPO, and the Working Group was looking for a way to expand its membership. In doing so, the subject matter it had to address went beyond issues concerning only appellations of origin. In particular, ways had to be found for extending the international registration system to geographical indications and for allowing intergovernmental organizations administering regional systems to accede to such an international registration system. In that connection, the Working Group was not only confronted with questions of a technical nature, but also with issues of national interest and economic growth. She expressed the hope that the Working Group would carry on in the same spirit and would be able to bring diverging views closer together so as to find a way to conclude an agreement that would benefit the interests of all.

262. The Chair thanked Ms. Wang on behalf of the Working Group for her encouraging statement and for the information concerning WIPO's technical cooperation activities in respect of geographical indications and appellations of origin.

263. As regards the future work of the Working Group, the Chair suggested that, on the basis of the discussions held, the Secretariat would prepare a revised version of the DNI for the next session of the Working Group. That would mean that the Secretariat would redraft the articles and related rules, as necessary on the basis of the discussions held, including consequential amendments to other articles and rules, even if not yet discussed. The Secretariat would work on the basis of the Summary by the Chair to be adopted by the Working Group, and the draft report to be prepared and published for comments, to ensure that all contributions by the members of the Working Group were duly taken into account when preparing the revised drafts of the DNI and the DR.

264. Continuing, the Chair said that his suggestion would be that the Summary by the Chair would not contain a detailed and lengthy summary reflecting all the comments made during the present session. While those comments would be reflected in the draft report, the Summary by the Chair would highlight the most important issues and conclusions, if any, that the Working Group had arrived at in the course of its discussions. Where necessary, the Summary would also indicate divergences of views on the important issues.

265. The Chair then referred to item (ii) of paragraph (6) of document LI/WG/DEV/4/2 and sought the advice of the Working Group on the further preparation of a process that might result in a revision of the Lisbon Agreement and/or a protocol or a new treaty supplementing the Lisbon Agreement. The Chair invited delegations to also express their views on any follow-up action that the Working Group might call for in that context, including a possible factual document that the Secretariat might prepare reflecting current levels of protection for geographical indications under national laws.

266. In that connection, the Chair recalled the proposal made by the Representative of CEIPI for a two-tier approach under which the DNI would have two chapters, i.e., one chapter laying down a mere registration system and without provisions of substantive law and another chapter addressing issues of substantive law and providing for a high level of protection for both appellations of origin and geographical indications, along the lines of the current Lisbon

Agreement but with a number of refinements. Upon acceding to such a treaty, Contracting Parties, whether individual States or intergovernmental organizations would have the possibility of opting out from the chapter dealing with substantive requirements. The expectation would, however, be that those opting out would eventually withdraw such a reservation, in view of the attractiveness of the higher level of protection.

267. The Delegations of France, Italy, Portugal, Spain and Switzerland as well as the Representative of the European Union expressed their preference for the Secretariat to focus on the preparation of a revised text of the DNI for the next session of the Working Group, rather than spend time on the preparation of a background document, as proposed.

268. The Delegation of Switzerland expressed the view that the proposal for a two-tier approach might be borne in mind for possible future deliberations in the Working Group, but should not be taken up in the revised DNI to be prepared for its next session. The Delegation further said that it was in favor of a protocol to the Lisbon Agreement that would respect the objective and principles of the Agreement.

269. The Chair, noting the comments made by Switzerland, wished to clarify that the two-tier approach, as he understood it, would comprise, in the chapter on substantive law, provisions laying down a specific level of protection for both appellations of origin and geographical indications.

270. The Delegation of France had not yet determined its position on the two-tier approach. In view of the terms of reference of the Working Group, the Delegation believed that the focus should not be on a mere registration system, but on provisions of substantive law.

271. The Delegation of Peru expressed its preference for a revision of the Lisbon Agreement rather than a new treaty supplementing the Lisbon Agreement.

272. The Representative of the European Union had not yet determined its position on the issue of what form the DNI should take. For the time being, the European Union preferred to work on the basis of a revised version of the DNI, which should preferably incorporate the various options and alternatives put forward by delegations. However, regardless of the form the DNI would eventually take, the text should contain a clause about the accession of intergovernmental organizations.

273. The Delegation of Costa Rica emphasized the importance of the Lisbon review exercise. Like Peru, the Delegation preferred a protocol to the Lisbon Agreement rather than a new treaty supplementing the Lisbon Agreement.

274. The Delegation of Romania said that it would be acceptable if the two-tier approach were taken up in the revised DNI to be prepared for the next session of the Working Group. The Delegation reserved its position as to the form by which the DNI might be formalized. However, a revised version of the Lisbon Agreement would appear to be more appropriate than a new treaty. The Delegation also expressed support for the statement of the European Union concerning the insertion of a clause that would allow accession by intergovernmental organizations.

275. The Delegation of Cuba also reserved its position on the form that the DNI might eventually take while expressing its preference for a protocol to the Lisbon Agreement. It further requested clarification on the current practice of WIPO in examining international applications, in particular in respect of Rule 5(2)(a)(iv) of the current Lisbon Regulations.

276. Summarizing the discussion, the Chair said that the message was quite clear, namely, that the next session of the Working Group should focus on revised versions of the DNI and the DR. Therefore, there was no urgent need for a comparative paper on the scope of protection in the various jurisdictions, at least not at the present stage. Furthermore, there had been some support for the two-tier approach, but a clear majority preferred to work along the lines of the current DNI, without necessarily rejecting a possible two-tier approach in the future. In other words, more time was needed to reflect on the appropriate structure that the DNI might eventually take. A number of delegations had indicated a preference for not replacing the Lisbon Agreement while signaling that they could go along with a protocol to the Lisbon Agreement. Other delegations had mentioned the possibility of a revision of the Lisbon Agreement, which was not entirely the same as a protocol. In essence, the preference of the Working Group was to have a legal instrument related to the Lisbon Agreement, not one replacing it. Concerning the remark to include a clause on the accession by intergovernmental organizations, the Chair said that such a clause was already included in the DNI, and noted that there was consensus among the Working Group members on the need to include such a clause in the DNI. The Chair also concluded from the discussions at the present session of the Working Group that there was a need to simplify the text of the DNI, *inter alia*, by avoiding cross-references as much as possible.

277. As regards the question asked by the Delegation of Cuba, concerning Rule 5(2)(a)(iv) of the current Lisbon Regulations, the Secretariat said that WIPO examined international applications purely on the basis of formalities. One of the formalities to be checked was whether the application contained an indication of the “product to which the appellation applied”. International registrations contained product indications as indicated in the application. If one looked at the various international registrations, one would see that some products were indicated in a single word, while others were indicated using complex descriptions. There existed no harmonized way of doing so. The official publication of the Lisbon system, the *Bulletin Appellations of Origin*, contained statistics about products that had been the subject of international registrations. In that regard, the International Bureau had made an attempt to categorize the products without changing the indications themselves. The products had been divided into three categories, namely, beverages and related products, food products and related products, and non-food products. The Lisbon Express Database on the WIPO web site also reflected the products as they were mentioned in the international registrations, while categorizing them into the three main categories as well as a number of subcategories. That was intended to facilitate searches. In conclusion, WIPO only examined on formalities, and not on substance. So when a competent authority had indicated a product in the international application, that product would be reflected in the international registration as received by WIPO.

#### **AGENDA ITEM 7: OTHER MATTERS**

278. No statements were made under the item in question.

#### **AGENDA ITEM 8: ADOPTION OF THE SUMMARY BY THE CHAIR**

279. The Working Group approved the Summary by the Chair, as contained in Annex I of the present document.

**AGENDA ITEM 9: CLOSING OF THE SESSION**

280. The Chair closed the session on December 16, 2011.

[Annexes follow]



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**LI/WG/DEV/4/6**  
**ORIGINAL: ENGLISH**  
**DATE: DECEMBER 16, 2011**

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

**Fourth Session**  
**Geneva, December 12 to 16, 2011**

### SUMMARY BY THE CHAIR

*approved 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 12 to 16, 2011.
2. The following Contracting Parties of the Lisbon Union were represented at the session: Costa Rica, Cuba, Czech Republic, France, Georgia, Hungary, Iran (Islamic Republic of), Italy, Mexico, Peru, Portugal, Republic of Moldova, Serbia, Slovakia, The former Yugoslav Republic of Macedonia (15).
3. The following States were represented as observers: Australia, Chile, Germany, Indonesia, Malaysia, Romania, Saudi Arabia, Spain, Sri Lanka, Switzerland, Thailand, Turkey, United States of America, Viet Nam (14).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: European Union (EU), World Trade Organization (WTO) (2).



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), European Communities Trade Mark Association (ECTA), 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) (7).

6. The list of participants is contained in document LI/WG/DEV/4/INF/1 Prov. 2\*.

#### **AGENDA ITEM 1: OPENING OF THE SESSION**

7. Mr. Francis Gurry, Director General, opened the session, recalled the mandate of the Working Group and introduced the draft agenda, as contained in document LI/WG/DEV/4/1 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. Hossein Gharibi (Iran (Islamic Republic of)) and Mr. Alberto Monjaras Osorio (Mexico) were 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/4/1 Prov.) without modification.

#### **AGENDA ITEM 4: ADOPTION OF THE DRAFT REPORT OF THE THIRD SESSION OF THE WORKING GROUP**

11. The Working Group adopted the Revised Draft Report of the Third Session of the Working Group (document LI/WG/DEV/3/4 Prov. 2) without modification.

#### **AGENDA ITEMS 5 AND 6: 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/4/2, LI/WG/DEV/4/3, LI/WG/DEV/4/4 and LI/WG/DEV/4/5.

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

### Basis for Protection and Definitions (Articles 2 and 3)

13. The Chair concluded that the Working Group was of the view that Article 3 should be drafted in a less complex manner and should follow more closely the current definition for appellations of origin of the Lisbon Agreement and the definition for geographical indications of the TRIPS Agreement, and thus avoid the negative formulation in Article 3(5)(a) and (b).

14. In addition, the Chair noted that some delegations preferred, in a definition for appellations of origin in the Draft New Instrument, the reference to “natural and human factors”, as contained in the definition for appellations of origin of the Lisbon Agreement, while other delegations preferred to refer to “natural and/or human factors”. Furthermore, the Chair noted the request from some delegations to better reflect the notion of reputation in that definition.

### Scope of Protection (Articles 4 and 9)

15. The Chair noted the desire of a large number of delegations for an international instrument laying down a high and uniform level of protection for both geographical indications and appellations of origin. He also noted that, on the other hand, some delegations had underlined the objective of the review of the Lisbon system to allow for a much larger membership.

16. With a view to reconciling these views, a suggestion was made for a two-tier approach consisting of a Chapter 1 dealing with a mere registration system along the lines of the Madrid and Hague systems, combined with a Chapter 2 addressing substantive requirements that would provide for a high level of protection for both geographical indications and appellations of origin, on the understanding that contracting parties would be free to opt for such Chapter 2.

### Prior Use (Articles 12, 13, 14 and 18)

17. The Chair noted that some delegations had expressed their preference for bringing the wording of Article 12 closer to traditional trademark terminology. In that context, the Secretariat confirmed that Article 12 would allow Contracting Parties to provide for the coexistence of a prior trademark and an appellation of origin or a geographical indication. In addition, suggestions were made for removing the last sentence of Article 12 concerning possible agreements between the right holders concerned and for including the sentence in the Notes.

18. The Chair noted the conflicting views on the length of the phasing-out period in Article 18.

### Other Substantive Provisions (Articles 10, 11 and 15)

19. The Chair noted the concerns expressed by some delegations that in their view the title of Article 10 did not reflect the contents of the provision itself.

20. On the basis of the discussion of Article 15, the Chair concluded that the provision would require an overall revision.

### Filing International Applications (Articles 5 and 7 and Rules 5, 6 and 8)

21. The Chair noted the confirmation by the Secretariat that Article 5(3) was optional and that such provision did not change the rule that the basis for an international registration should be the protection in the country of origin or the Contracting Party of origin.

22. The Chair also noted the various proposals to align the wording of paragraphs (2) and (3) of Article 5, in the sense that a reference had to be made in both paragraphs either to a legal entity or a federation or association having legal standing to assert rights in a geographical indication or appellation of origin, as well as to represent legitimate users thereof. The Chair noted the divergent views on the optional or mandatory nature of certain provisions in Rule 5.

### Future Work

23. The Chair concluded that a majority of members of the Working Group had expressed the view that the focus of the next session of the Working Group should be the examination and discussion of a revised version of the Draft New Instrument and the related Draft Regulations, as contained in documents LI/WG/DEV/4/2 and LI/WG/DEV/4/3, respectively.

24. As regards the legal instrument by which the Draft New Instrument and the related Draft Regulations might be formalized, the Chair observed that several delegations would prefer to maintain the Lisbon Agreement in combination with a Protocol to it. Meanwhile, he also noted that some other delegations were not opposed to a revision of the Lisbon Agreement itself.

25. The Chair noted two specific requests expressed by different delegations, namely, that the revised Draft New Instrument should still contain a clause on the accession by intergovernmental organizations, and that the text of the revised Draft New Instrument and the related Draft Regulations should be simplified by avoiding an excessive use of cross-references between the various Articles and Rules.

26. On the basis of the discussions that took place, the Chair concluded that the Working Group had agreed to the following:

- (i) the Secretariat would prepare a revised version of the Draft New Instrument and the related Regulations which would also require a redraft of the articles and rules discussed at the present meeting as well as the necessary consequential amendments to the remaining articles and rules. Moreover, where appropriate, alternative provisions and different options between brackets would be introduced in the revised version;
- (ii) the Secretariat would work on the basis of the present Summary by the Chair and also on the basis of the Draft Report of the fourth session of the Working Group to make sure that all contributions are duly reflected in the revised version of the Draft New Instrument and the related Draft Regulations.

### **AGENDA ITEM 7: OTHER MATTERS**

27. No interventions were made under this item.

### **AGENDA ITEM 8: SUMMARY BY THE CHAIR**

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

29. 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. Any such comments can be submitted within two months from its publication date, after which the draft report will be amended, as required, and made available to delegations on the WIPO web site, for its formal adoption in due course.

**AGENDA ITEM 9: CLOSING OF THE SESSION**

30. The Chair closed the session on December 16, 2011.

[Annex II follows]



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**LI/WG/DEV/4/INF/1 PROV.2**  
**ORIGINAL: FRANÇAIS/ENGLISH**  
**DATE: 15 DÉCEMBRE 2011 / DECEMBER 15, 2011**

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

**Quatrième session**  
**Genève, 12 – 16 décembre 2011**

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

**Fourth Session**  
**Geneva, December 12 to 16, 2011**

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

*établie par le Secrétariat*  
*prepared by the Secretariat*

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\* 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.

‡ 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)

COSTA RICA

Luis PAL, Director, Junta Administrativa, Registro Nacional de Costa Rica, Ministerio de Justicia y Paz, San José

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Imre GONDA, Deputy Head, Trademark, Model and Design Department, Hungarian Intellectual Property Office, Budapest

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Hossein GHARIBI, Deputy Director, International Legal Department, Ministry of Foreign Affairs, Tehran

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PÉROU/PERU

Miguel ALEMÁN URTEAGA, Ministro Consejero, Dirección General para Asuntos Económicos, Ministerio de Relaciones Exteriores, Lima

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II. ÉTATS OBSERVATEURS/OBSERVER STATES

ALLEMAGNE/GERMANY

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Sattamayad AL-OTAYBY, Riyadh

AUSTRALIE/AUSTRALIA

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Pierre HEUZÉ, Intern, Permanent Mission, Geneva



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Hashita DE ALWIS, Director, Sri Lanka Tea Board, Colombo

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VIET NAM

TRAN Huu Nam, Deputy Director General, National Office of Intellectual Property (NOIP), Hanoi

III. ORGANISATIONS INTERNATIONALES INTERGOUVERNEMENTALES/  
INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

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Wolf MEIER-EWERT, Counsellor, Intellectual Property. Division, Geneva

UNION EUROPÉENNE (UE)/EUROPEAN UNION (EU)

Zuzana SLOVAKOVA (Mrs.), Policy Officer, European Commission, DG Markt, Brussels

Oscar MONDEJAR, Legal Advisor, Operations Department, Office for Harmonization in the Internal Market (Trade Marks and Designs) Alicante

Delphine LIDA (Mrs.), Counsellor, Permanent Delegation of the European Union, Geneva

Lore GENAND (Mrs.), European Commission, Brussels

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

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

Ana Lúcia BORDA (Mrs.), Rio de Janeiro

Association communautaire du droit des marques (ECTA)/European Communities Trade Mark Association (ECTA)

Florent GEVERS, Chair, ECTA Geographical Indications Committee, Brussels

Jan WREDE, Vice-chair, ECTA Geographical Indications Committee, Rome

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

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

Ortrun GÜNZEL, Member, MARQUES Geographical Indications Team, Munich

Peter MUNZIGER, Member, MARQUES Geographical Indications Team, Munich

Association internationale pour la protection de la propriété intellectuelle (AIPPI)/International Association for the Protection of Intellectual Property (AIPPI)

Laura COLLADA (Ms.), Member, Geographical Indications, Mexico

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

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International Trademark Association (INTA)

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Massimo VITTORI, Secretary General, Geneva

Ida PUZONE (Mrs.), Project Manager, Geneva

Daniela LIZARZABURU (Ms.), Intern, Geneva

V. BUREAU/OFFICERS

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Vice-présidents/Vice-chairs: Hossein GHARIBI (Iran (République islamique d')/Iran (Islamic Republic of))

Alberto MONJARAS OSORIO (Mexique/Mexico)

Secrétaire/Secretary: Matthijs GEUZE (OMPI/WIPO)

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

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[End of Annex II and of document]