

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

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NOTES ON THE DRAFT REGULATIONS UNDER THE DRAFT REVISED LISBON AGREEMENT

Document prepared by the Secretariat

1. The Annex to the present document contains Notes on the Draft Regulations under the Draft Revised Lisbon Agreement on Appellations of Origin and Geographical Indications (“Draft Regulations”), as contained in document LI/WG/DEV/8/3. Where a provision appears not to require explanation, no note has been provided.

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NOTES ON THE DRAFT REGULATIONS

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NOTES ON RULE 1: ABBREVIATED EXPRESSIONS

1.01 Rule 1 follows the model of Rule 1 of the Regulations under the Singapore Treaty on the Law of Trademarks of 2006. On substance, the provision is based on Rule 1 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

NOTES ON RULE 2: CALCULATION OF TIME LIMITS

2.01 The provisions of this rule are based on those contained in Rule 2 of the Lisbon Regulations.

NOTES ON RULE 3: WORKING LANGUAGES

3.01 The provisions of this rule largely reproduce those contained in Rule 3 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

NOTES ON RULE 4: COMPETENT AUTHORITY

4.01 This rule is drafted in accordance with the practice that has developed under Rule 4 of the Lisbon Regulations.

4.02 As regards the responsibilities of Competent Authorities, reference is made to Article 3 of the Draft Revised Lisbon Agreement. In addition, Rule 4(1) makes clear that the name the name and contact details of the Competent Authority must be notified at the time of accession.

4.03 Paragraph (2) should be seen in light of the fact that, unlike in other areas of industrial property, there may be more than one authority in a Contracting Party that is responsible for the grant of protection in respect of appellations of origin.

4.04 Paragraph (3) has been drafted in recognition of the practical experience of the International Bureau with regard to changes of the name or of the contact details of a Competent Authority.

NOTES ON RULE 5: REQUIREMENTS CONCERNING THE APPLICATION

5.01 Paragraph (1) corresponds to Rule 5(1) of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

5.02 The provisions of paragraphs (2) and (3) correspond to those of paragraphs (2) and (3) of Rule 5 of the Lisbon Regulations, as adapted in accordance with the provisions of Article 5 of the Draft Revised Lisbon Agreement. Under item (vi) of paragraph (2), where a Contracting Party of Origin provides for the registration of appellations of origin or geographical indications, the application is to indicate the registration number under which the appellation of origin or the geographical indication is protected in the Contracting Party of Origin. Where a Contracting Party grants protection by means of, for example, ministerial decrees or court decisions, the application is to indicate the title of such decree or decision.

5.03 As regards the questions raised in the Working Group concerning Rule 5(2)(iii) and Rule 5(3)(ii), it should be noted that under Article 10 of the Revised Lisbon Agreement – similarly to Article 3 of the current Lisbon Agreement – appellations of origin and geographical indications are to be protected, inter alia, against their use in translated form. The amendments to Rule 5(2)(iii) and Rule 5(3)(ii) were made following the discussions at the seventh session of the Working Group, for clarification of the scope of these provisions.

5.04 The provisions of sub-paragraphs (2)(vii) and (3)(vi) correspond to those of Rule 5(3)(vi) of the Lisbon Regulations, which was adopted by the Lisbon Union Assembly in September 2011 and entered into force on January 1, 2012. They are presented as alternative options in view of the divergent views expressed in previous sessions of the Working Group as to whether the provisions should be mandatory or optional.

NOTES ON RULE 6: IRREGULAR APPLICATIONS

6.01 The provisions of this rule largely reproduce those contained in Rule 6 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

NOTES ON RULE 7: ENTRY OF THE APPELLATION OF ORIGIN IN THE INTERNATIONAL REGISTER

7.01 Paragraph (1) is modeled on Rule 7(1) of the Lisbon Regulations but has been adapted to reflect the fact that the International Register would incorporate the registrations effected under both the Lisbon Agreement and the Draft Revised Lisbon Agreement (see Note 4.01 on the Draft Revised Lisbon Agreement document LI/WG/DEV/7/4). As long as not all States party to the Lisbon Agreement have joined the Revised Lisbon Agreement, the International Register should reflect for which States a registration is governed by the Lisbon Agreement or by the Revised Lisbon Agreement. Of course, to the extent an application originates in a Contracting Party that is party to both Agreements, the International Bureau must examine the application not only on the basis of the requirements of the Revised Lisbon Agreement, but also on the basis of the requirements that apply under the Lisbon Agreement.

7.02 The provisions of paragraphs (2) and (3) of this rule largely reproduce those contained in Rule 7 of the Lisbon Regulations with regard to the contents of registrations, the registration certificate and the notification of new registrations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

7.03 A new paragraph (4) was added though, to address the situation concerning international registrations of appellations of origin already recorded under the Lisbon Agreement, once the mutual relations between two States become governed by the provisions of Article 31(1) of the Draft Revised Lisbon Agreement.

NOTES ON RULE 8: FEES

8.01 The provisions of this rule reproduce those contained in Rule 23 of the Lisbon Regulations.

8.02 In accordance with the provisions of Chapter II of the Draft Revised Lisbon Agreement, the provisions are proposed to be put in the corresponding Chapter of these Draft Regulations.

NOTES ON RULE 9: REFUSAL

9.01 The provisions of this rule reproduce those contained in Rule 9 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

9.02 As reflected in the adopted Report of the fourth session of the Working Group (document LI/WG/DEV/4/7, paragraph 199, the Chair concluded from the discussion on Article 18 of the Draft New Instrument contained in document LI/WG/DEV/4/2, that the time limit for the notification of refusals should be presented in the Draft Regulations. In this regard, reference is made to Articles 15(1) and 29(4) of the Draft Revised Lisbon Agreement as well as the Notes on those provisions (Notes 15.03 and 29.02).

9.03 Further, Rule 9(2)(iv) is proposed in order to address the specific situation of international registrations refused in part by a Contracting Party because of the possible coexistence under the legislation of such Contracting Party with a prior right, notably a homonymous geographical indication or appellation of origin. By way of example, reference is made in this regard to paragraph 135 of the adopted Report of the fourth session of the Working Group (document LI/WG/DEV/4/7).

NOTES ON RULE 10: IRREGULAR NOTIFICATION OF REFUSAL

10.01 The provisions of this rule reproduce those contained in Rule 10 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

NOTES ON RULE 11: WITHDRAWAL OF REFUSAL

11.01 The provisions of this rule reproduce those contained in Rule 11 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

11.02 Compared to the provisions of Rule 11 of the Lisbon Regulations, a new subparagraph is proposed, requiring the reason for the withdrawal to be mentioned in the statement, in particular in case of partial withdrawals corresponding to partial refusals, as referred to in Rule 9(2)(iv) of these Draft Regulations.

NOTES ON RULE 12: NOTIFICATION OF GRANT OF PROTECTION

12.01 The provisions of this rule reproduce those contained in Rule 11*bis* of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

12.02 Compared to the provisions of Rule 11*bis* of the Lisbon Regulations, a new subparagraph is proposed, requiring the reason for the withdrawal to be mentioned in the statement, in particular in case of partial statements of grant of protection corresponding to partial refusals, as referred to in Rule 9(2)(iv) of these Draft Regulations.

NOTES ON RULE 13: NOTIFICATION OF INVALIDATION OF THE EFFECTS OF AN INTERNATIONAL REGISTRATION IN A CONTRACTING PARTY

13.01 The provisions of this rule reproduce those contained in Rule 16 of the Lisbon Regulations, including the amendment adopted by the Assembly in September 2011, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

13.02 Compared to the provisions of Rule 16 of the Lisbon Regulations, it is proposed to mirror in subparagraph (iv) not only the situations covered by Rule 9(2)(v) of these Draft Regulations, but also the specific case of homonymous geographical indications and appellations of origin, as covered by Rule 9(2)(iv).

NOTES ON RULE 14: NOTIFICATION OF TRANSITIONAL PERIOD GRANTED TO THIRD PARTIES

14.01 The provisions of this rule reproduce those contained in Rule 12 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement. Following the discussions at the seventh session of the Working Group, Rule 14(1)(iii) was amended by the introduction of the phrase concerning the submission of information on the scope of the transitional use. The word “preferably” has been put between square brackets, in view of the question raised at that session whether the submission of that information should be optional or mandatory.

14.02 In view of paragraph 18 of the Summary by the Chair of the fourth session of the Working Group (document LI/WG/DEV/4/6), the possible length of the time limits for terminating prior use has been put in square brackets.

NOTES ON RULE 15: MODIFICATIONS

15.01 The provisions of this rule reproduce those contained in Rule 13 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

NOTES ON RULE 16: RENUNCIATION OF PROTECTION

16.01 The provisions of this rule reproduce those contained in Rule 14 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

16.02 The square bracketed phrase “[in whole or in part]” was introduced as a result of the question raised at the seventh session of the Working Group as to whether it would also be possible to issue a renunciation – or rather a limitation – in respect of only some of the products covered by the international registration.

NOTES ON RULE 17: CANCELLATION OF AN INTERNATIONAL REGISTRATION

17.01 The provisions of this rule reproduce those contained in Rule 15 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

NOTES ON RULE 18: CORRECTIONS MADE TO THE INTERNATIONAL REGISTER

18.01 The provisions of this rule reproduce those contained in Rule 17 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft Revised Lisbon Agreement.

NOTES ON RULE 19: PUBLICATION

19.01 This rule largely reproduces Rule 18 of the Lisbon Regulations. However, as publication may, in the future, take place on the WIPO web site, the reference to the Bulletin has not been retained.

NOTES ON RULE 20: EXTRACTS FROM THE INTERNATIONAL REGISTER AND OTHER INFORMATION PROVIDED BY THE INTERNATIONAL BUREAU

20.01 The provisions of this rule reproduce those contained in Rule 19 of the Lisbon Regulations.

NOTES ON RULE 21: SIGNATURE

21.01 This rule reproduces Rule 20 of the Lisbon Regulations.

NOTES ON RULE 22: DATE OF DISPATCH OF VARIOUS COMMUNICATIONS

22.01 The provisions of this rule largely reproduce those contained in Rule 21 of the Lisbon Regulations. As regards the additional phrase referring to the Administrative Instructions, reference is made to Section 9 of the Administrative Instructions for the Application of the Lisbon Agreement.

NOTES ON RULE 23: MODES OF NOTIFICATION BY THE INTERNATIONAL BUREAU

23.01 The provisions of this rule reproduce those contained in Rule 22 of the Lisbon Regulations.

NOTES ON RULE 24: ADMINISTRATIVE INSTRUCTIONS

24.01 The provisions of this rule largely reproduce those contained in Rule 23*bis* of the Lisbon Regulations. However, the reference to the Bulletin has not been retained, for the reason mentioned in Note 19.01.

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