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REGULATIONS UNDER THE LISBON AGREEMENT FOR THE
PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR
INTERNATIONAL REGISTRATION**

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NOTES CONCERNING THE PROPOSALS FOR MODIFICATION OF THE
REGULATIONS UNDER THE LISBON AGREEMENT

Document prepared by the International Bureau

INTRODUCTION

This document contains the notes on the draft modified Regulations, which are to be found in document LI/GT/2/2. Where a provision does not seem to require explanation, there is no note on it.

It should be noted that the draft modified Regulations do not contain any provision on the effective date of an international registration in a Contracting State (as had been envisaged at the first session of the Working Group), as it has not yet been possible to reconcile the different approaches to the question adopted by the various Contracting States. The findings of the study conducted on this subject by the International Bureau appear in the Annex to this document.

Notes on Rule 1
“Definitions”

1.01 *Rule 1* is a new provision proposed for inclusion in the Regulations in the interest of convenience and consistency with the Regulations under other international registration treaties administered by the International Bureau of WIPO. It contains definitions of a certain number of common terms or expressions used in the draft modified Regulations.

1.02 *Item (iv)*. The definition of the “International Register” is modelled on that contained in Rule 1(xxiv) of the Common Regulations under the Madrid Agreement and Protocol concerning the international registration of marks. In particular it allows the data on international registrations to be kept on the most suitable medium, for instance paper (as they are at present) or a computer database (as they might be in future).

1.03 *Item (ix)*. The definition of the “competent authority” encompasses any authority that may become involved in the international registration procedure (namely any of those referred to in subparagraphs (a), (b) and (c) of Rule 4(1)). This definition allows the terminology used throughout the draft modified Regulations to denote the authority of a contracting country (instead of the variable terminology contained in the present Regulations¹). In order to ascertain to or from what “competent authority” a particular communication should be sent or received, the reader is referred to the proposed Rule 4 and the corresponding notes.

1.04 *Item (x)*. The expression “holder of the right to use the appellation of origin” is defined solely by reference to Article 5(1) of the Agreement. It is thus the abbreviated expression that, in the draft modified Regulations, according to the actual words of Article 5(1), denotes the “natural persons or legal entities, public or private, having, according to their national legislation, a right to use such appellations.”

1.05 *Item (xii)*. The term “periodical” is defined broadly enough to allow the International Bureau to effect publication on paper or on any other appropriate medium (or for instance in electronic form in the future). It should also be noted that, compared with the present Regulations, the word “recueil” has been substituted in the French version for the word “revue” as the designation of the publication issued by the International Bureau. The purpose of the substitution is to align the terminology of the Regulations on that of the Agreement, which expressly uses the word “recueil” to denote that publication (see Article 5(2) of the Agreement).

¹ In the present Regulations an authority is indeed given names that often vary from one provision to the next, for instance: “the competent Office of the country of origin” (Rule 1(1)), “the Office of the country of origin” (Rule 6(3)), “the Office making the application” (Rules 1(2) and 2(1’), 2(3)(i), 3 and 5(2), “the Office applying for registration” (Rule 1(5), “the Office competent to receive notifications from the International Bureau” (Rules 1(2)(ii) and 4(2)(ii), “any Office which has made a declaration under Article 5(3)” (Rule 5(1), “the Offices of the countries to which the international registration is notified” (Rule 8(2), or, finally, “the Offices of all the countries of the Union” (Rule 6(1) and (2). Incidentally, it should be noted that, in the English version of the draft modified Regulations, it has been considered more suitable to use the term “authority” (instead of “Office” as in the present Regulations) to translate the French word “administration.”

Note on Rule 2
“Calculation of Time Limits”

2.01 The purpose of *Rule 2* is to specify the method of calculating periods mentioned in the draft modified Regulations that are stated in years or months (*paragraphs (1) and (2)*), and also the method of calculating a period that expires on a day that is not a working day for the International Bureau or for a competent authority (*paragraph (3)*). Its formulation follows closely that of *Rule 4* of the Common Regulations under the Madrid Agreement and Protocol concerning the international registration of marks.

Note on Rule 3
“Working Language”

3.01 *Rule 3* is based on the current linguistic regime of the Lisbon system (see *Rules 1(2), 2(3)(i) and 3* of the Regulations in force). It is specified that the International Bureau does not check the translations of the appellation of origin which might be given by the competent authority of the country of origin under *Rule 5(3)(ii)*.

Notes on Rule 4
“Competent Authority”

4.01 *Paragraph (1)* provides that each contracting country has to provide the International Bureau with the name and address of each of its national authorities that may be involved in the international registration procedure (and also any subsequent amendment to the name or address of any of those authorities). This provision contemplates three “categories” of authorities likely to take part in the international registration procedure, which are defined according to their respective roles as:

- authority of the country of origin (*subparagraph (a)*);
- authority of a country to which the international registration is notified (*subparagraph (b)*);
- authority that has informed the International Bureau, under *Article 5(6)* of the Agreement, that third parties established on its territory have been allowed a period within which to discontinue the use of an appellation of origin (*subparagraph (c)*).

4.02 The functions that are incumbent on each of these categories of competent authority by virtue of the draft modified Regulations are listed exhaustively in each subparagraph concerned. Thus:

– the competent authority referred to in subparagraph (a) is authorized on the one hand to send to the International Bureau the communications specified in item (i) (in particular an application for international registration), and on the other hand to receive the notifications of the International Bureau referred to in Rules 9(3)², 10(1) and (2)³, 11(3)⁴, 12(2)⁵ and 16(2)⁶ (item (ii));

– the competent authority referred to in subparagraph (b) is authorized on the one hand to send to the International Bureau the communications specified in item (i) (in particular a declaration of refusal), and on the other hand to receive the notifications of the International Bureau referred to in Rules 7(1)⁷, 13(3)⁸, 14(2)⁹, 15(2)¹⁰ and 17(2)¹¹ (item (ii));

– the competent authority referred to in subparagraph (c) is authorized to inform the International Bureau that third parties have been allowed a period, which may not exceed two years, under Article 5(6) of the Agreement.

4.03 This new provision has been considered necessary in view of the fact that, according to the legislation or practice of the contracting countries, the above functions may be exercised by a single authority or on the other hand be entrusted to different authorities. The notification of those competent authorities to the International Bureau will thus enable the latter to identify unequivocally the administrative body with which it should deal.

4.04 *Paragraph (2)* aims to allow for the diversity of national situations in this connection, and therefore specifies that one or more different authorities may be notified to the International Bureau. That said, it is provided, in order to avoid a multiplicity of authorities being so notified, with the attendant risk of errors for the International Bureau, that a single authority be specified in relation to each subparagraph.

4.05 It should also be noted that there exists a fourth category of authority concerned by the provisions of the Lisbon system, namely the authority competent to bring the necessary legal action to ensure the protection of appellations of origin on its territory (referred to in Article 8 of the Agreement). However, as that authority is not called upon to intervene in the international registration procedure, or to engage in subsequent correspondence with the International Bureau, it does not seem necessary to provide for the notification of its name and address under the proposed modification of the Regulations.

² Notification of a declaration of refusal.

³ Notification of a declaration of refusal which is irregular (Rule 10(1)) or is not considered as such (Rule 10(2)).

⁴ Notification of the withdrawal of a declaration of refusal.

⁵ Notification of the notice according to which a period has been accorded to third parties under Article 5(6) of the Agreement.

⁶ Notification of an invalidation.

⁷ Notification of the international registration.

⁸ Notification of a modification of the international registration.

⁹ Notification of renunciation of protection.

¹⁰ Notification of the cancellation of an international registration.

¹¹ Notification of a correction made to the International Register.

Notes on Rule 5
“Requirements Concerning the International Application”

5.01 *Rule 5*, the purpose of which is the same as that of Rule 1 of the present Regulations, provides for the presentation and content of international applications. Rule 5 as proposed makes a distinction in particular between the mandatory contents (paragraph (2)) and the optional contents (paragraph (3)) of an international application.

5.02 *Paragraph (2)(a)* specifies the mandatory contents of an international application.

5.03 *Item (ii)*. In relation to the present Regulations (Rule 1(2)(iii)), the words “owner or owners” have been replaced (in the English version) by the words “holder or holders” and have been completed with the phrase “of the right to use the appellation of origin,” in order that the indication given in the international application and in the registration resulting from it may be consistent with what is prescribed by Article 5(1) of the Agreement, which provides expressly that the registration of an appellation of origin is to be effected “in the name of [...] persons [...] having, according to their national legislation, a right to use such appellations.” In addition, item (ii) has itself been completed in such a way as to make it clear, according to the practice observed at present by the authorities of contracting countries,¹² that the holders of the right to use it should in principle be designated collectively¹³ (for instance “producers or groups of producers benefiting from the appellation of origin concerned,” “organizations which, in the region concerned, are engaged in the production of the product mentioned,” etc.), or, “where collective designation is not possible” (for instance if there is only one authorized user), by name.

5.04 *Item (iii)*. It is proposed that, under this provision, the name of the appellation of origin may only be given in the official language of the country of origin or, if the country of origin has a number of official languages, in one or more of those languages, at the discretion of the competent authority. The purpose of this more specific wording in relation to the present Regulations (see Rule 1(2)(iv)) is to change the practice of a certain number of authorities which consists in stating, under the heading intended for the designation of the appellation of origin on the application form, the name of the appellation in the national language *together with translation in a certain number of other, foreign languages*. Such a practice seems not only ambiguous for the authorities of the other contracting countries and for third parties, but also unnecessary in the light of Article 3 of the Lisbon Agreement, which provides that the appellation of origin mentioned in the international registration is protected against any use in translated form. That said, the translation of the appellation of origin is still a piece of information that may appear in an international application; it constitutes an optional indication (distinct from the actual indication of the appellation of origin) by virtue of the draft modified Regulations (see Rule 5(3)(ii) and paragraph 5.09 below).

¹² It should be mentioned that inspection of the International Register shows that, except in very marginal cases in which there is only one or a very small number of users identified by name, the practice observed at present by competent authorities consists in making a collective designation of the owners of the right to use the appellation.

¹³ That is, in the name of the economic agencies, public or private, invested by their legislation with the right to affix, or to authorize or designate persons authorized to affix, the appellation of origin concerned on the product concerned, and/or to ensure that those persons abide by the applicable production conditions.

5.05 *Item (vi)*. The wording of this provision has been completed to include among the legal bases underlying protection in the country of origin a reference to “the date and number of the registration” (where such a registration exists¹⁴). The wording proposed for Rule 5(2)(a)(vi) thus makes it possible to include clearly all existing national situations.

5.06 *Item (vii)*. Insofar as a number of contracting countries have an alphabet in other than Latin characters, it seems necessary to require that certain information (that constituting a proper name) be given in transliterated Latin characters. It is thus provided that three kinds of information may be transliterated, that is, the name of the holder or holders of the right to use the appellation of origin, the designation of the appellation of origin and the area of production of the product.

5.07 *Paragraph (3)* deals with the optional contents of the international application.

5.08 *Item (i)* provides expressly for a competent authority to give the address of the holder or holders of the right to use the appellation of origin: it constitutes information likely to be useful to the authorities of contracting countries or third parties (wishing for instance to contact the holder or holders), which moreover is already supplied in practice by many authorities in their international applications.

5.09 *Item (ii)*. In spite of what is said paragraph 5.04 above, there is no denying that a translation of the name of the appellation of origin can be important information for users of the Lisbon system and third parties in general, above all where it differs greatly from one language to another. Consequently, in order to preserve that information in the framework of an international registration, this provision offers the possibility to the competent authority of the country of origin to supply a translation of the appellation of origin in as many languages as it wishes. If such translations are provided, they will appear under a heading expressly provided for this purpose (which presupposes a change in the application form), and will not be checked in any way by the International Bureau (see Rule 3(2) and Note 3.01).

5.10 *Item (iii)* allows the inclusion of a statement in the international application to the effect that protection is not claimed for certain elements of the appellation. This statement could be included by the competent authority of the country of origin on the one hand in order to give third parties precise details of the extent of the protection sought, and on the other hand in order to prevent refusal (for instance relating to a generic element contained in the appellation of origin¹⁵) on the part of the competent authority of another Contracting Party.

¹⁴ Where such a registration has indeed been made under legislative or regulatory provisions, the authority concerned may state not only the date and number of that registration but also, if it sees fit, the title and date of the legislative or regulatory provisions under which the registration was made.

¹⁵ It should indeed be borne in mind that international applications sometimes give as the appellation of origin not only the geographical name constituting the appellation of origin in the strict sense, but also a generic term associated with it (for instance, “Trojanska Keramica,” “Vjatovski Kaolin,” “Dentelle de Vamberk,” “Beurre de Charentes.” This practice reflects an everyday use consisting in giving as the “appellation of origin” the full name under which the goods concerned are labelled and marketed.

5.11 *Item (v)*. It is proposed that the competent authority of the country of origin should be allowed to include in its international application a copy in the original language of the documents referred to in Rule 5(2)(a)(vi) (namely the provisions or decisions or the registration by virtue of which the appellation is protected in the country of origin). The (optional) filing of these documents at the same time as the international application is intended to make it easier for the International Bureau to communicate them to any person who so requests in accordance with Rule 19(2) as proposed (see that Rule and the corresponding notes).

Notes on Rule 6
“Irregular Applications”

6.01 *Rule 6*, which corresponds to Rule 2 of the present Regulations, has to do with the procedure applicable in the case of a defective international application. Two types of irregularity are contemplated, namely on the one hand those that are capable of being corrected in the time allowed (paragraph (1)) and on the other hand those that result in the international application not being considered such (paragraph (2)).

6.02 *Paragraph (1)*. At present, in the case of a defective international application, the competent authority of the country of origin is allowed a total period of six months, consisting of two successive periods of three months, within which to correct the irregularity (see Rule 2(2) of the present Regulations). The International Bureau has found in that, in the vast majority of cases, such a long period is not necessary in practice, and so it is proposed that the second three-month period be abolished (*subparagraph (a)*). Nevertheless, in order to limit the effects of such a modification in relation to the present Regulations, it is provided that, if the competent authority has not remedied the reported irregularity within two months of the date on which the International Bureau invited it to do so, the latter will send to the said authority a reminder (*subparagraph (b)*). The second sentence of subparagraph (b) makes clear that the sending of such a reminder would not have the effect of starting a *new* three-month period to allow the competent authority to remedy the reported irregularity.

6.03 In the absence of correction within the prescribed three-month period, the application would be rejected by the International Bureau (*subparagraph (c)*), and the fees payable for the application would be refunded, subject the retention of an amount corresponding to half the registration fee¹⁶ (*subparagraph (d)*). It goes without saying, however, that such rejection would not prevent the competent authority of the country of origin from filing a new application for international registration in respect of the same appellation of origin.

6.04 *Paragraph (2)*. It is proposed that, if an international application is not drawn up in French or if it is not filed by the competent authority of the country of origin, it should not be considered an international application by the International Bureau. That means that it would be returned to the sender without there being any possibility of putting it in order by remedying the reported irregularity. There too, however, the competent authority of the country of origin is free to file a new international application to secure protection for the appellation of origin concerned.

¹⁶ This charge is intended to cover the expenditure incurred by the International Bureau for the handling of the international application.

*Notes on Rule 7**“Entry of Appellations of Origin in the International Register”*

7.01 *Rule 7* corresponds to Rule 4 of the present Regulations.

*Notes on Rule 8**“Date of International Registration”*

8.01 *Rule 8* reproduces the essence of Rule 3 of the present Regulations, but aims to make it clearer just what irregularities have implications for the date of international registration (in the sense that the international registration bears the date on which the most recent correction of an irregularity is received by the International Bureau).

8.02 *Paragraph (1)* lists four particulars the absence of which can cause the date of international registration to be deferred.¹⁷ This is information which allows the extent of the protection sought and the beneficiaries of that protection to be ascertained, in other words it is information considered sufficiently important that no registration date can be assigned as long as it has not been provided. It should moreover be made quite clear that such irregularities, even if they are described as regularities affecting the date of the international registration, have to be corrected (like any irregularity other than those mentioned in Rule 6(2)) within the prescribed three-month period referred to in Rule 6(1)(a), failing which the international application is rejected.

8.03 Compared with the present Regulations, there are two things that no longer constitute irregularities affecting the date of the international registration, namely on the one hand failure to pay the full amount of the registration fee and on the other hand the absence of the signature of the competent authority of the country of origin in the international application. There seems indeed to be nothing against these two details being provided later, under Rule 6(1)(a), without the date being affected. It should in addition be mentioned that, in the Madrid system concerning the international registration of marks and also in the Hague system concerning the international registration of industrial designs, such irregularities do not affect the date of the international registration.

*Notes on Rule 9**“Notification of a Declaration of Refusal”*

9.01 *Rule 9* is a new provision designed to specify more accurately the procedure applicable in the event of a declaration of refusal being notified to the International Bureau by a competent authority. At present this question is governed solely by Article 5(3) of the Agreement, which allows the authorities of contracting countries to declare that they cannot ensure the protection of an appellation of origin, “but only in so far as its declaration is notified to the International Bureau, *together with an indication of the grounds therefor*, within a period of one year from the receipt of the notification of registration.”

¹⁷ Namely the mention of the country of origin (item (i)), the naming of the holder or holders of the right to use the appellation of origin (item (ii)), the designation of the appellation of origin (item (iii)) or the naming of the product to which the appellation applies (item (iv)).

9.02 *Paragraph (2)*. In order to ensure accurate information on the subject of the refusal concerned, this provision lists a certain number of particulars (in addition to the grounds for refusal) that have to appear in a declaration of refusal.¹⁸ The general purpose of these requirements is to allow the competent authority of the country of origin or the holders of the right to use the appellation of origin to have the necessary elements at their disposal with a view to the possibility of lodging an appeal with the competent national authorities.

9.03 *Item (iii)* provides that, if the refusal is based on the existence of a prior right, the declaration of refusal has to indicate or contain the essential information concerning that prior right. In view of the fact that the ground for refusal most frequently cited by the authorities of contracting countries is the fact that the appellation of origin conflicts with a prior mark (in about half of all cases), it seemed useful to specify what essential particulars of that prior mark have to be indicated or contained in the declaration of refusal.

9.04 *Item (iv)* expressly contemplates the possibility of partial refusal, in the sense that a declaration of refusal may concern only certain elements of the appellation of origin (for instance a generic term; see paragraph 5.10 and footnote 15).

9.05 *Item (v)*. According to Article 5(5) of the Agreement, interested parties have to have at least the same judicial or administrative remedies available to them as are available to the nationals of the country whose authority has notified the declaration of refusal. The mention of such remedies in the declaration of refusal should in particular include the applicable period for appeal and the competent authority with which it should be lodged.

9.06 A new unofficial form corresponding to the contents of the new Rule 9 will be drawn up by the International Bureau and made available to national authorities.

9.07 *Paragraph (3)*. Except where a declaration of refusal is affected by one of the irregularities referred to in Rule 10(1)(a) as proposed (see paragraphs 10.01 to 10.04), the International Bureau will enter the refusal in the International Register for the purposes of third-party information and forward a copy of the declaration of refusal to the competent authority of the country of origin.

Notes on Rule 10
“Irregular Declaration of Refusal”

10.01 *Rule 10* is intended to cover the handling of an irregular declaration of refusal by the International Bureau. In doing so, it makes a distinction between irregularities that result in the declaration of refusal not being considered such and therefore prevent the entry of the refusal in the International Register (*paragraph (1)*) and other irregularities that do not prevent such entry (*paragraph (2)*).

¹⁸ It should be mentioned that, in practice, the vast majority of declarations of refusal are notified to the International Bureau on an unofficial form which already mentions other information to be provided in addition to the grounds for refusal.

10.02 *Paragraph (1)(a)* specifies four cases in which a declaration of refusal would not be considered such by the International Bureau.¹⁹ They involve irregularities that would prejudice either the possibility of the International Bureau identifying the international registration concerned (*item (i)*) or the right of the authority of a contracting county to notify that declaration under Article 5(3) of the Agreement (*items (ii) to (iv)*).

10.03 It should be pointed out in particular that *item (iii)* of paragraph (1)(a) serves to close a gap in the present Regulations, which do not make it clear whether the one-year period for refusal expires on the *date of dispatch* of the declaration of refusal by the competent authority or on the *date of receipt* of the declaration by the International Bureau. The use of term “sent” in this provision makes it clear that the reference date is that of the dispatch of the declaration by the authority concerned. The solution recommended seems the most advantageous for the competent authorities of contracting countries; it is of little importance whether the declaration of refusal is received by the International Bureau after the prescribed one-year period in so far as the declaration has been notified before that period expires. It should also be noted that this solution corresponds to the one adopted for the Madrid system concerning the international registration of marks (see Rule 18(1)(a)(iii) of the Common Regulations under the Madrid Agreement and Protocol).

10.04 If a declaration of refusal is not considered such by virtue of Rule 10(1)(a), that means that it would not be possible to correct the declaration by remedying only the irregularity reported; the competent authority could however send the International Bureau a further declaration of refusal, but only if it is sent within the prescribed one-year period (which of course rules out the case provided for in *item (iii)* of paragraph (1)(a)).

10.05 *Paragraph 1(b)*. Even where a declaration of refusal is not considered such and therefore no refusal is entered in the International Register, it is proposed that the International Bureau should nevertheless send a copy of the declaration of refusal to the competent authority of the country of origin. It does indeed seem useful for the latter to receive such a communication. Should it be possible for a new declaration of refusal to be notified within the prescribed period of one year, the authority concerned and, where applicable, the holder or holders of the right to use the appellation of origin will have more time in which to consider the grounds for refusal and the wisdom of entering into negotiations or filing an administrative or judicial appeal. Apart from that, even where the declaration of refusal is not considered such because it has been sent after the one-year time limit, it is useful to the authority of the country of origin and the holder or holders of the right to use the appellation of origin to know of the existence of grounds for refusal that might eventually lead to the invalidation of the effects of the international registration in the contracting country concerned.

¹⁹ Namely if the declaration of refusal does not give the number of the international registration concerned, except where other information in the declaration allows the registration to be unequivocally identified (*item (i)*), if it does not give any ground for refusal (*item (ii)*), if it is sent to the International Bureau after the expiry of the prescribed period of one year (*item (iii)*) and if it is not notified to the International Bureau by the competent authority (*item (iv)*).

10.06 *Paragraph (2)* provides that, if the declaration of refusal is irregular in respects other than those provided for in paragraph (1)(a), the International Bureau will nevertheless enter the refusal in the International Register. In other words, the absence of one of the indications referred to in Rule 9(2) other than the grounds for refusal does not prevent the entry of a refusal in the International Register. That said, at the request of the competent authority of the country of origin, the International Bureau will invite the authority that notified the declaration of refusal to provide the missing information without delay.

Notes on Rule 11
“Withdrawal of a Declaration of Refusal”

11.01 In so far as a refusal may be eventually reversed, either partly or totally, by the competent national authorities (for instance as a result of an administrative or judicial appeal), *Rule 11* provides that that fact has to be notified to the International Bureau in the form of a withdrawal of the declaration of refusal (*paragraph (1)*), and that the International Bureau will enter the withdrawal in the International Register, in particular for the purposes of third-party information (*paragraph (3)*).

11.02 It is understood that a withdrawal of a declaration of refusal would have to be notified to the International Bureau where the decision totally or partly reversing the original refusal has become final, that is to say when it can no longer be appealed and therefore has become *res judicata*.

Notes on Rule 12
“Period Granted to Third Parties”

12.01 *Paragraph (1)*. Under Article 5(6) of the Agreement, the competent authority of a contracting country may grant third parties established on its territory a period (not exceeding two years) within which to terminate the use of an appellation of origin that has been accorded protection in that contracting country, but “on condition that it advise the International Bureau accordingly during the three months following the expiration of the period of one year provided for in paragraph (3).”

12.02 The periods and the conditions on which such a period is granted may be of vital importance to the authorities of contracting countries and third parties in general. That is why it is proposed that paragraph (1) specify the contents of the notice sent to the International Bureau. With that in mind it is provided in particular that the identity of the third parties concerned (item (ii)), the period allowed them (item (iii)) and the date as from which the period runs (item (iv)) have to appear in the notice.

12.03 On the subject of item (iv) in particular, it should be made clear that the date on which the period accorded to third parties starts to run is left to the discretion of the competent authority of each contracting country, provided however that it is not later than the expiry date of the three-month period provided for in Article 5(6) of the Agreement. If a competent authority were to grant a two-year period that could start for instance six months or a year after the expiry of the three-month period for sending the notice to the International Bureau, the third parties in question would in practice be allowed a longer period than the maximum two years prescribed by Article 5(6).

12.04 *Paragraph (2)*. In the same way as for the calculation of the expiry of the one-year period for refusal (see paragraph 10.03), the use of the word “sent” in Rule 12(2) means that, for the calculation of the expiry of the three-month period mentioned in Article 5(6), the reference date is that of the dispatch of the notice to the International Bureau by the competent authority.

Notes on Rule 13
“Modifications”

13.01 *Rule 13* has to do with the modification of an international registration, and it partly reproduces the substance of Rule 5 of the present Regulations. However, unlike the present Rule 5, which makes a distinction between modifications that either do or do not call for a new international registration, *paragraph (1)* gives an exhaustive list of the modifications that may be made to an international registration; it follows, *a contrario*, that any other modification could not be made and consequently would necessitate a new international registration.²⁰

13.02 *Items (i) and (ii)*. In the present Regulations, the concept of “modifications relating to the owners” mentioned in Rule 5(4) covers two hypothetical cases:

- that of a change regarding the holder of the right to use the appellation of origin (implying that the right to use has been transferred to a *separate entity*), and
- that of a change in the name of the holder (implying that, as a result of the amendment, the person named as the holder continue to be the *same entity*).

13.03 As these two situations are different in nature, and to allow the International Register to reflect as accurate and precise a situation as possible, it is proposed that a distinction be made between the case of a change of holder and that of a change in the name of the holder by providing a separate provision for each of them.

13.04 What is more, Rule 5(4) of the present Regulations provides that “modifications relating to the [...] owners [...] shall necessitate a new international registration.” This solution has been reconsidered in items (i) and (ii) of Rule 13(1), under which any amendment relating to the holder of the right to use the appellation of origin could be entered in the International Register without a new registration having to be made. Inasmuch as a change of holder of the right to use or a change in the name of the holder or holders of the right to use does not affect the content of the protection afforded, there seems to be no justification for requiring a new registration in either case.

²⁰ Under the modified Regulations the following modifications, which are not mentioned in Rule 13(1), would therefore require a new international registration: one concerning the country of origin and affecting the area of production of the product to which the appellation of origin applies (see paragraph 13.06), a change in the name of the appellation of origin and a change in the product to which the appellation of origin applies.

13.05 *Item (iii)* contemplates only the possibility of entering a modification to the “limits” of the area of production in the International Register. A complete change of production area (in other words without any part of it being in common with the area of production specified earlier) would be bound to be construed as a new appellation of origin — given in particular the definition of the appellation of origin contained in Article 2(1) of the Agreement — and should therefore give rise to a new international registration.

13.06 *Item (v)* provides for the entry in the International Register of a modification relating to the country of origin, but on condition that the modification does not affect the area of production of the product to which the appellation of origin applies. This provision is intended to cover in particular the case of succession of States, but it also applies to a simple modification to the name of the country of origin. It should be noted however that where a territorial modification alters the boundaries of the area of production to which the appellation of origin applies, that could give rise to the entry of the modification under Rule 13(1)(iii) (see paragraph 13.05 above).

13.07 *Paragraph (3)*. Any amendment referred to in items (i) to (v) of paragraph (1) that is requested by the competent authority of the country of origin will be entered in the International Register and notified by the International Bureau to the competent authorities of all contracting countries.

*Note on Rule 14 “Renunciation of Protection” and
Rule 15 “Cancellation of an International Registration”*

14.01 *Rules 14 and 15* correspond for the most part to Rule 5(1) (first sentence) and (2) of the present Regulations. It seemed desirable, for the sake of clarity and simplicity, to have separate provisions dealing with renunciation of protection (*Rule 14*) and with cancellation of the international registration (*Rule 15*).

*Notes on Rule 16
“Invalidation”*

16.01 *Rule 16* has to do with the entry in the International Register of an invalidation of the effects of the international registration in a contracting country. The word “invalidation” is borrowed from the terminology of the Madrid system concerning the international registration of marks; it is intended to cover any decision (whether administrative or judicial) taken by the competent authorities of a contracting country that leads to the cessation, on its territory, of the protection of the international registration of an appellation of origin,²³ whether through the cancellation of the protection (*ab initio*) or its revocation (*pro futuro*).

²³ The concept of invalidation has to be clearly distinguished from that of refusal of protection. While a declaration of refusal has to be notified in the course of the prescribed period of one year, there is no time limit for notifying the International Bureau of an invalidation of the effects of an international registration.

16.02 Even if the competent authority of a contracting country has not filed a declaration of refusal with the International Bureau within the prescribed period of one year, it is possible for interested third parties subsequently to contest the protection so granted before the competent courts of that country — subject of course to there being provision for such an action in the national legislation concerned — and (if the action is successful) for that protection to be terminated.

16.03 It may indeed happen that, by mistake, the protection of an appellation of origin has not been refused by the competent authority concerned (for instance if the authority was not aware of a prior right or if, while aware of it, it wrongly discounted it). In that case it seems right and proper that the appellation of origin in question, in so far as it does not (and never did) meet the conditions of protection provided for in the national legislation concerned, should cease to be protected on the territory of that country.

16.04 What is more, the wording of Article 6 of the Agreement argues in favor of the possibility of invalidating the effects of an international registration inasmuch as it places a restriction on the grounds on which the protection given to an international registration may be revoked. It provides that an appellation of origin that has been granted protection in a contracting country “cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.” Consequently, by providing that the protection of an appellation of origin cannot be revoked “on the ground of its having become generic,” Article 6 implies that, conversely, invalidation based on other grounds is possible. If it were totally impossible to invalidate the effects of an international registration, Article 6 would be without object.

16.05 Moreover, in practice, it should be noticed that there have already been a certain number of decisions by the courts of contracting countries (in particular Portugal and Italy) that have invalidated the effects of the international registration of an appellation of origin on their territory where no declaration of refusal had been made in respect of it. However, it has not been possible to enter those decisions in the International Register, in the absence of any provision in the Lisbon Agreement or its Regulations allowing such entry. And yet it is important that the information according to which an international registration no longer enjoys protection in a contracting country should be brought to the notice of the authorities of the contracting countries and third parties in general.

16.06 The procedures for invalidation on the territory of a contracting country are determined entirely by the law and practice of that country, and are conducted directly between the parties concerned, without the International Bureau being involved in any way in administrative or judicial actions of that kind.

16.07 *Paragraph (1)*. Where the effects of an international registration are invalidated in a contracting country, this provision on the one hand requires that the fact be notified to the International Bureau, in particular in order to ensure that third parties are informed, and on the other hand specifies the contents of the notice of invalidation.

16.08 *Paragraph (2)* expressly authorizes the International Bureau to enter an invalidation in the International Register, and provides that it shall send a copy of the notice of invalidation to the competent authority of the country of origin.

Notes on Rule 17
“Corrections Made to the International Register”

17.01 *Rule 17* is a new provision that provides an explicit possibility for the International Bureau to correct the International Register where it contains an error (resulting, for example, from erroneous information, attributable to a competent authority, contained in an international application or from the incorrect entry, attributable to the International Bureau, of data in the International Register).

17.02 *Paragraph (1)* specifies that a correction may be made either on the initiative of the International Bureau or at the request of a competent authority. In this provision the term competent authority covers all the competent authorities referred to in Rule 4(1), since an error may affect a communication addressed by any of these authorities.

17.03 The proposed wording does not place any limit on the types of error that may be corrected or impose any time limit for requesting correction, since one of the basic principles of the Lisbon Agreement is that the appellation of origin to which the international registration relates must be identical to the appellation of origin protected in the country of origin; correction of incorrect information contained in the International Register would therefore seem legitimate, whatever the nature of the error or the date on which correction is requested, for the purposes of informing third parties, and necessary to ensure the smooth operation of the Lisbon system.

17.04 Nevertheless, the competent authority of any contracting country should be able to refuse the effects of correction. This possibility would seem necessary where, with respect to the international registration as corrected, there exist grounds for refusal that did not apply to the international registration as initially notified to the competent authority concerned.

17.05 To that end, it is provided that the International Bureau will notify the correction made in the International Register to the competent authority of every contracting country (*paragraph (2)*) and that the competent authority of a contracting country should have the right to declare that a correction has no effect in that country (*paragraph (3)*).

17.06 *Paragraph (3)*. The declaration that a correction has no effect must be addressed to the International Bureau by the competent authority within one year from the date of notification by the International Bureau of the correction. Once again, the use of the word “sent” in this provision means that the decisive date for calculating the expiry of the one-year period is that of the dispatch of the declaration by the competent authority to the International Bureau.

17.07 In addition, the *mutatis mutandis* application of Rules 9 to 11 referred to in paragraph (3) means, in particular:

– that the declaration that a correction has no effect must be notified to the International Bureau and must state, in particular, the corresponding grounds (Rule 9(2)(ii)) and the administrative or judicial remedies that can be exercised against it (Rule 9(2)(v)),

- that the declaration will not be considered as such by the International Bureau if, in particular, it gives no grounds for refusal (Rule 10(1)(a)(ii)) or if it is sent to the International Bureau after the prescribed period of one year (Rule 10(1)(a)(iii)),
- that if the authority concerned goes back on its declaration and the decision to do so is final, it must notify the fact to the International Bureau in the form of a withdrawal (Rule 11(1)) and
- that a declaration that a correction has no effect or the withdrawal of such a declaration must be notified to the International Bureau by the competent authority referred to in Rule 4(1)(b), item (i) of which expressly refers to notification of a declaration of refusal (Rule 9) and of the withdrawal of such a declaration (Rule 11).

17.08 A request for correction by a national authority will not be subject to payment of a fee.

Note on Rule 18
“Publication”

18.01 Rule 18 corresponds to Rule 7 of the present Regulations. However, the words “and all cancellations” have been omitted, since cancellations are included in the phrase “all entries.” Furthermore, it would not seem necessary to specify the title of the periodical in the Regulations.

Notes on Rule 19
“Extracts from the International Register and Other Information
Provided by the International Bureau”

19.01 *Rule 19* replaces Rule 8 of the present Regulations and provides that any person may obtain from the International Bureau extracts from the International Register or any other information on the contents of the Register on payment of a fee, the amount of which is specified in Rule 23.

19.02 *Paragraph (2)* deals specifically with the communication to third parties of the provisions or decisions or the registration by virtue of which the appellation of origin is protected (the references of which will have been given in the international application in accordance with Rule 5(2)(a)(vi)).

19.03 *Subparagraph (b)* provides that if the documents have “already” been communicated to the International Bureau (that is, either together with the international application in accordance with Rule 5(3)(iv) or subsequently, for example under subparagraph (c)), the International Bureau will transmit without delay a copy to any person so requesting.

19.04 *Subparagraph (c)*. If the documents have never been communicated to the International Bureau, the latter will request copies from the competent authority of the country of origin and transmit them, on receipt, to the person so requesting.

Note on Rule 20
“Signature”

20.01 Rule 20 corresponds to Rule 1(3) of the present Regulations.

Notes on Rule 21
“Date of Dispatch for Various Communications”

21.01 The draft modified Regulations contain three periods the expiry of which is calculated from the date of dispatch of the communication concerned by the competent authority to the International Bureau, that is:

- the one-year period for notifying a declaration of refusal (referred to in Rule 10(1)(a)(iii)),
- the one-year period for notifying a declaration that a correction made to the International Register has no effect (referred to in Rule 17(3)) and
- the three-month period for notifying that a period has been afforded to third parties under Article 5(6) of the Agreement (referred to in Rule 12(2)).

21.02 In view of the potential importance of that date, *Rule 21* specifies that it is determined, where the communication is sent by mail, by the postmark, if legible; failing that, the communication will be deemed to have been sent 20 days before the date on which the International Bureau received it. Where the communication has been sent by means of a delivery service, the date of dispatch is determined by the information provided by the delivery service on the basis of the details of mailing as recorded by it.

21.03 These provisions have been taken from the Common Regulations under the Madrid Agreement and Protocol concerning the international registration of marks (Rule 18(1)(a)(iii)).

Notes on Rule 22
“Modes of Notification by the International Bureau”

22.01 Under Article 5(3) of the Agreement, the one-year period during which a competent authority may notify a declaration of refusal begins to run on the date on which that authority receives the notification of the international registration. To enable the International Bureau to establish that date without ambiguity, paragraph (1) of Rule 22 provides that notification of an international registration must be addressed by the International Bureau to the competent authority of each contracting country by registered mail with advice of receipt. This mode of notification is indeed that already used in practice by the International Bureau.

22.02 Since no other period referred to in the Agreement or in the draft modified Regulations begins to run on the date of receipt of a communication by a competent authority, it is proposed in paragraph (2) that any other notification should be addressed by the

International Bureau to the competent authorities by means of ordinary registered mail (without advice of receipt).

22.03 Rule 22 also envisages the possibility of notifications “by any other means” (for instance electronic) if such other means give the International Bureau the possibility of confirming that the notification has been received and, in the case of a notification of international registration, of establishing the date on which it was received.

Notes on Rule 23

“Fees”

23.01 Rule 23 concerns the fees applicable under the Lisbon system and replaces Rule 9 of the present Regulations. In relation to the latter Rule, it is proposed that the possibility of the International Bureau collecting a fee in the following cases be eliminated:

- where information is given orally (under Rule 9(v) of the present Regulations), for which a fee seems manifestly inappropriate, and indeed none has ever actually been charged by the International Bureau;
- where photocopies are provided (under Rule 9(vi) of the present Regulations), since the photocopies can only be of an extract from the International Register, an attestation or other information given in writing on the contents of the International Register, for which a fee is already charged under items (iii) and (iv) of Rule 23, there seems to be no justification for charging an additional fee for the provision of such photocopies.

23.02 Neither the structure of this provision nor the amounts of the fees payable have been changed.

Note on Rule 24

“Entry into Force”

24.01 It is proposed that the entry into force of the Regulations as modified should be on April 1, 2002, so that the International Bureau may have sufficient time, on the one hand, to inform in good time the authorities of the contracting countries and third parties in general of the modifications made and, on the other hand, to be able to implement the changes necessary for the administration of the modified Lisbon system.

[Annex follows]

ANNEX

In accordance with what was envisaged at the first session of the Working Group (see document LI/GT/1/3, paragraphs 69 to 71), the International Bureau put in hand a study with the national authorities of the member countries of the Lisbon Union, in the form of a questionnaire on the effective date of the international registration of an appellation of origin. The International Bureau received replies from 17 contracting countries, based in most cases on the interpretation by the national authority concerned of the legislative provisions applicable.¹

The outcome of this study may be summarized as follows: where no declaration of refusal is notified to the International Bureau under Article 5(3) of the Agreement, protection of an appellation of origin starts

- on the date of the international registration, for ten contracting countries (Algeria, Bulgaria, Burkina Faso, Cuba, Czech Republic, Gabon, Hungary, Slovakia, Togo and Tunisia);
- on the date of receipt of the notification of international registration, for two contracting countries (Mexico and Yugoslavia);
- on the date of publication of the appellation of origin in the periodical *Les Appellations d'origine*, for one contracting country (France);
- on the date of entry of the appellation of origin in the national register, for two contracting countries (Israel and Portugal);
- on the date of expiry of the one-year period for refusals, for one contracting country (Costa Rica).

The Italian authority replied to the questionnaire by stating that the date was not specified either by its legislation or by its case law (and without giving any particular date).

Thus, in view of the various national situations referred to above, it has seemed preferable not to prescribe in the draft modified Regulations the date that constitutes the starting point for protection of an international registration. In the absence of such provision, that date will continue to be determined by the legislation or case law of each contracting country for that country.

[End of Annex and of document]

¹ No contracting country seems to have legislation that expressly determines what date constitutes the starting point for the protection, on its territory, of the international registration of an appellation of origin.