

**Lisbon Webinar Series**



# Why and How to use the new Lisbon System (Geneva Act) to Protect your GI abroad?

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**Geneva**  
**March 9, 2021**



- Geneva Act: What's **New** ?
- How to Use Lisbon
- Q&A

# The Geneva Act: What's **New** ?

Extension to Geographical Indications

Accession of Intergovernmental Organizations  
(IGOs)

Flexibility on domestic GI systems

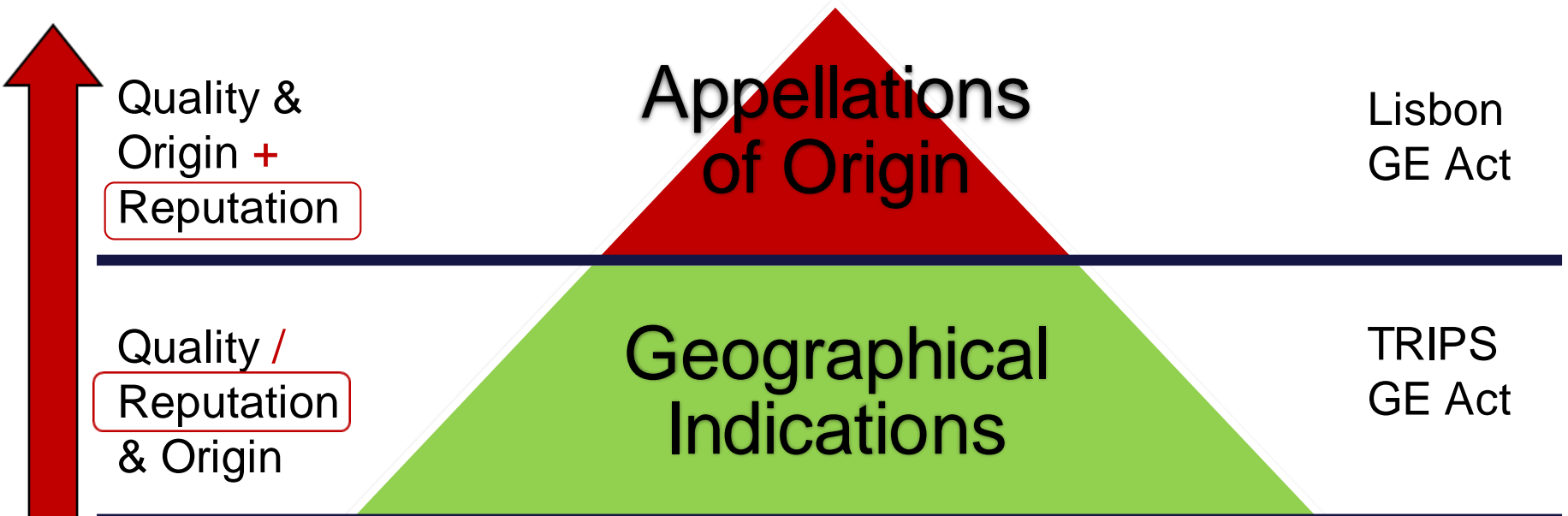
Protection

Generics

Safeguards

New

# Extension to GIs



# Geneva Act: Definitions (Art. 2)

## AO

- Protected **denomination**
- Referring to a geographical area or **known as doing so**
- Designating a **good** as originating therein
- Quality or characteristics
- **+ Reputation**
- **Due to the geographical environment** (*natural factors and human factors*)

## GI **New**

- Protected **indication**
- Referring to a geographical area or **known as doing so**
- Identifying a good as originating therein
- Quality, **reputation or** other characteristics
- **Attributable to its geographical origin**

# Extension to GIs = more products can benefit from the Lisbon System



Alor Islands Vanilla  
(Indonesia)



Jamdani Saree  
(Bangladesh)



Hojari Luban  
(Oman)



Luangprabang Silk  
(Lao PDR)



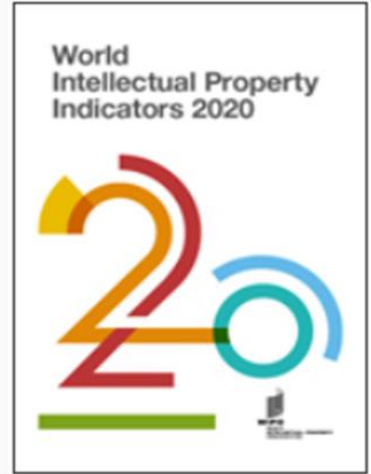
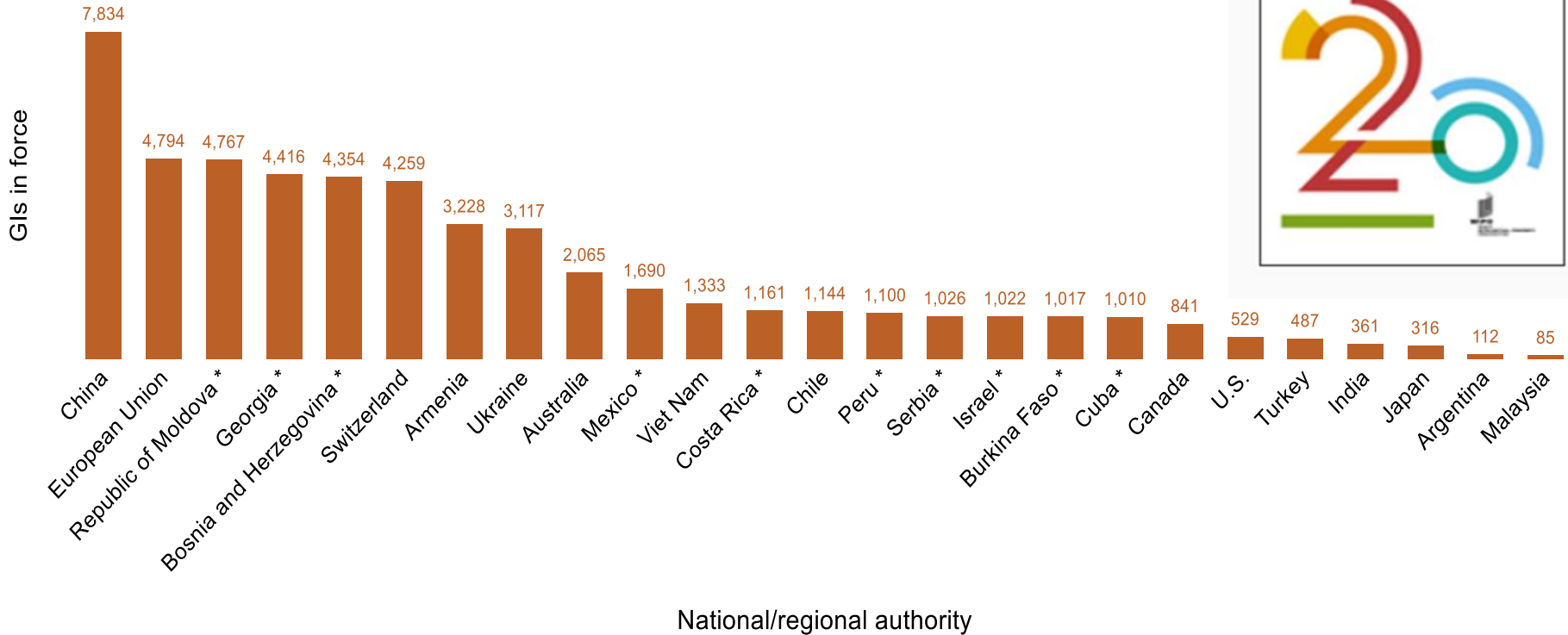
Baked Pryaniks  
(Russian Federation)



Chuao Cocoa Bean  
(Venezuela)

# The potential of GIs

55800 GI rights were in force in 2019



**oriGIn**

Organization for an International Geographical Indications Network

8566 geographical indications

oriGIn Worldwide GIs Compilation

**WIPO**  
WORLD  
INTELLECTUAL PROPERTY  
ORGANIZATION

# Different national means of GI protection **allowed** (Art. 9 and 10)

## ■ *Sui generis* legislation



## ■ Trademark system (collective/certification marks)



## ■ Administrative systems

## ■ Unfair competition laws



New

# The Geneva Act opens Lisbon to Intergovernmental Organizations

European Union  
27 Member States  
Acceded on 26/11/2019



African Organization of  
Intellectual Property (OAPI)  
17 Member States



## Accession Criteria (Art. 28)

- At least 1 IGO Member must be a member of the Paris Convention
- IGO grants regional titles of protection for GIs
- Declaration that the IGO is authorized to become party to the Geneva Act

New

## Protection (Art. 11)

- **Same kind goods** not originating in the area of origin or not complying with other AO/GI requirements
- **Different kind goods or services** suggesting connection with AO/GI beneficiaries and likely to damage their interests or impairing, diluting or taking unfair advantage of the AO/GI reputation
- **Against any AO/GI imitation**, even if true origin is indicated or AO/GI is translated, or used with delocalizers (ex Greek style)
- **Any other misleading practice** as to the true origin, provenance or nature of the goods

# Generics in the Geneva Act

## ■ Protection against **becoming generic** (Art. 12)

## ■ Exceptions (Agreed statements, Rule 5.5):

- **Prior use as a generic** in a Contracting Party is a possible **ground for refusal**
- If the AO/GI contains a term **considered generic in the Contracting Party of Origin**, other Members are **not obliged to protect such term**

New

New

## Safeguards (Art. 13)

### ➤ **Prior good faith trademarks**

(applied for/ registered/ acquired through use in good faith)

(NB: possible coexistence with later AO/GI)

### ➤ **personal names, plant variety or animal breed denominations**

(except if used in such a manner as to mislead the public)

# Registration Procedure with the Lisbon System

# Who triggers the application procedure? (Art. 5(2))

- **Beneficiaries:** those having the right to use the AO/GI
- **Natural person or legal entities** having legal standing to assert the rights of the beneficiaries

# Application procedure (Art. 5)

- **Application** filed by the Competent Authority



# Application procedure (Art. 5)

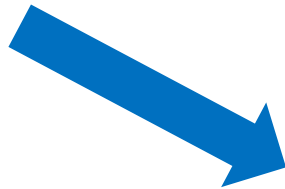
- **Direct application** by interested parties
  - subject to a declaration by their Contracting Party





# Application procedure (Art. 5)

## ■ Joint Application for trans-border AOs/GIs



# Application form

■ <https://www.wipo.int/lisbon/en/forms/>

**LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF  
ORIGIN AND THEIR INTERNATIONAL REGISTRATION  
AND  
GENEVA ACT OF THE LISBON AGREEMENT ON APPELLATIONS OF  
ORIGIN AND GEOGRAPHICAL INDICATIONS  
APPLICATION FOR INTERNATIONAL REGISTRATION<sup>1</sup>**

To be submitted to the International Bureau  
of the World Intellectual Property Organization (WIPO)  
34, ch. des Colombettes, CH-1211 Geneva 20 (Switzerland)  
Tel: + 41 22 338 91 11  
E-mail: [lisbon.system@wipo.int](mailto:lisbon.system@wipo.int) – Internet: <https://www.wipo.int/lisbon>

**1. Contracting Party of Origin:**  
*(See Rule 5(2)(a)(i))*

**2(a) Competent Authority presenting the application:**  
*(Indicate name and address of the Authority; see Rule 5(2)(a)(ii))*

**2(b) In the case of an application filed directly under Article 5(3) of the Geneva Act, beneficiaries entitled to use an appellation of origin or a geographical indication, or natural person or legal entity having legal standing to assert the rights of the beneficiaries or other rights in the appellation of origin or geographical indication:**  
*(Indicate name, address and contact details of the beneficiaries, natural person or legal entity; see Rule 5(2)(a)(ii))*

**2.c) Commonly designated Competent Authority that files the application, in the case of a joint application concerning a trans-border geographical area:**  
*(Indicate name, address and contact details of the Authority; see Article 5(4) of the Geneva Act and Rule 5(2)(a)(ii))*

# Application procedure: mandatory requirements (Rule 5(2))

- **Contracting party** of origin
- **Competent Authority** or applicants
- **Beneficiaries** or their representatives
- The **AO/GI**
- The **good** to which the AO/GI applies
- The geographical **area of origin** of the good
- Details of the registration, or legislative or administrative provision, or judicial decision, by virtue of which the AO/GI is protected in the Country of Origin
- **Registration fee**

# Application procedure: declaration-based requirements

- **Further information on the connection** between the characteristics of the AO/GI and its geographical origin (Rule 5(3))
- Signature and/or **intention to use** (Rule 5(4))
- Payment of an **individual fee** (Art. 7(4))

Non-compliance with DBR → protection renounced

# Application procedure: registration (Art. 6)

## ■ Formal Examination:

- Mandatory requirements
- Payment of fees

■ **Date International registration:** when application is received by the International Bureau

## ■ Irregular Applications:

- Chance to **remedy**
- **Three months** limit

# Application procedure: registration

- **Records** the AO/GI in the Lisbon Registry
- **Issues** Certificate of Registration, and
- **Notifies** the AO/GI to Contracting Parties (**Rule 7**)



# Application procedure: registration (Art. 6(5))

- **Protection** in each Contracting Party is granted if:
  - **grant of protection** is notified
  - no refusal is notified (**silence procedure**)
  
- **From the date of the international registration**
  - or different date as indicated in a **declaration**

# Application procedure: refusal (art. 15)

## ■ Requirements:

- **Time** → within 12 months
- **Content** → explain the grounds



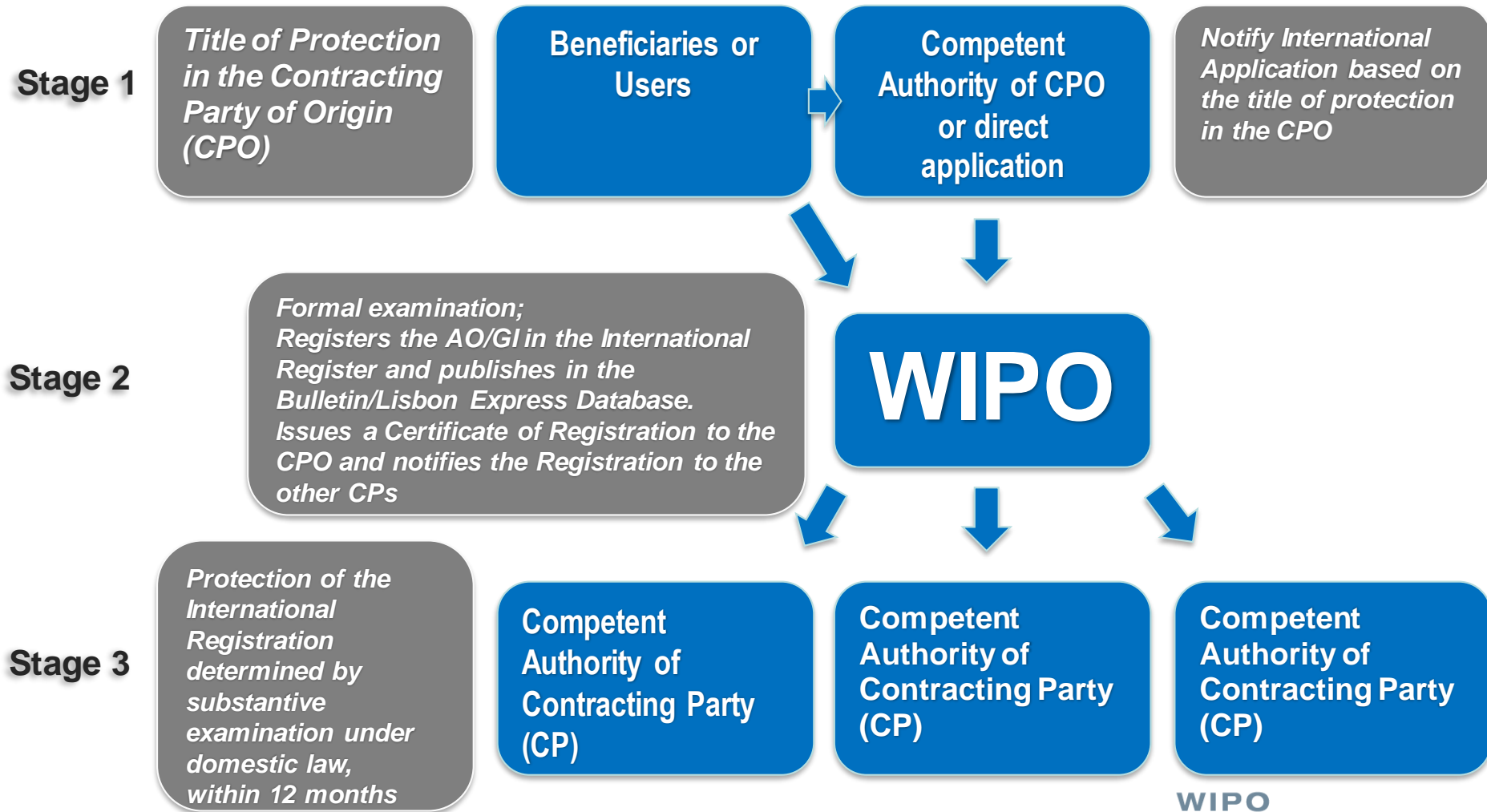
- **Notification** *ex officio* or at the request of an interested party
- **Total or partial**
- Judicial or administrative **remedies**



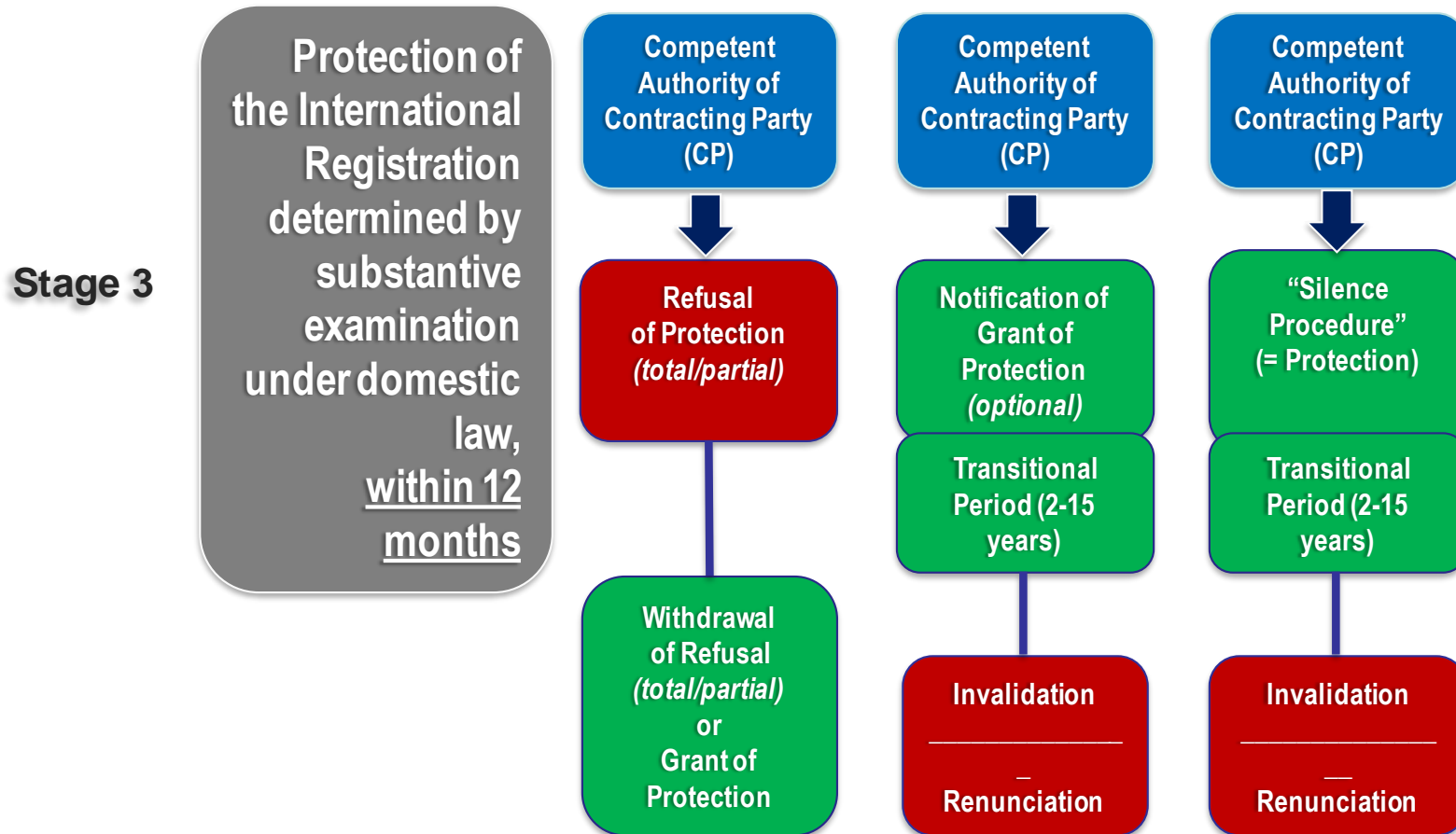
# Manage your application

- Withdrawal of Refusal (Art. 16)
- Invalidation (Art. 19)
- Modification (Rule 15)
- Renunciation (Rule 16)
- Cancellation (Rule 17)

# How the Lisbon System works (1)



# How the Lisbon System works (2)



## With the Geneva Act, Lisbon is

Extension to GIs = +Accessible

Any means of GI protection = +Flexible

Accession of IGOs = +Global

Protection = +Effective

Individual Fees = +Inclusive

Safeguards = +Modern

# Lisbon System website

WIPO | LISBON

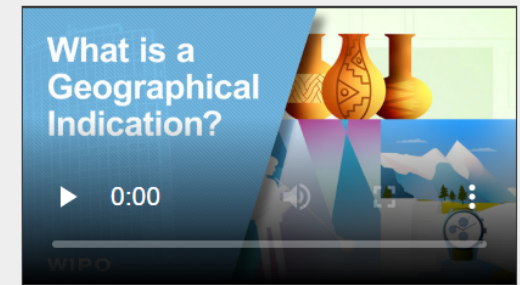
## Lisbon – The International System of Geographical Indications

**Covid-19 update** – [Important information](#)

The Lisbon System for the International Registration of Geographical Indications offers a means of obtaining protection for a [geographical indication](#) in the [30 contracting parties](#) to the [Lisbon Agreement](#) through a single registration and [one set of fees](#).

Registrations are published in the [official Bulletin](#) and can be searched through the [Lisbon Express Database](#).

FEATURED



Explainer video: Geographical indications and WIPO's Lisbon System

# WIPO IP PORTAL


WIPO IP PORTAL MENU HELP ENGLISH LOGIN WIPO

ALL  
PATENTS  
MARKS  
DESIGNS  
**GEOGRAPHICAL INDICATIONS**  
TRADE SECRETS  
CREATIVE WORKS  
RESEARCH AND DATA  
DIGITAL EVIDENCE  
IP ALTERNATIVE DISPUTE RESOLUTION  
DOMAIN NAME DISPUTE RESOLUTION  
PAYMENTS

Lisbon  
▶ Lisbon Express

Statistics  
▶ Geographical indication Statistics

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for your intellectual assets.



Digital Evidence  
▶ WIPO PROOF

Legal Texts  
▶ WIPO Lex

Others  
▶ WIPO IP Portal  
▶ WIPO Academy

# Lisbon News

<https://www3.wipo.int/newsletters/en/>

## Email updates

**Lisbon News** – Information notices, news and updates on developments in the Lisbon System.

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**NEW**

# Lisbon Webinar Series

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1 - 2 / 2 items

[Why and How to use the new Lisbon System \(Geneva Act\) to Protect your GI abroad?](#)

March 9, 2021 **Virtual** (English)

10:00 - 12:00 Geneva time

[Online registration](#)

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[Introduction to Geographical Indications \(GIs\) and the Benefits of the Lisbon System](#)

February 16, 2021 **Virtual** (English)

10:00 - 12:00 Geneva time



# Questions?



# Thank you!

## More info

[www.wipo.int/lisbon/en/index.html](http://www.wipo.int/lisbon/en/index.html)

Lisbon Express Database:

[www.wipo.int/ipdl/en/search/lisbon/search-struct.jsp](http://www.wipo.int/ipdl/en/search/lisbon/search-struct.jsp)

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*[michele.evangelista@wipo.int](mailto:michele.evangelista@wipo.int)*