What's shaping up in WIPO's WG on the Development of the Lisbon System?

Matthijs Geuze

WORLDWIDE SYMPOSIUM ON GEOGRAPHICAL INDICATIONS

June 22-24, 2011

Geographical Indications (GI) and Appellations of Origin (AO)

WIPO's Role

- Administration of a number of **international agreements** which deal with the protection of GIs/AOs

- Discussion of new ways of **enhancing international protection** of GIs/AOs

  (work of '*Standing Committee on the Law of Trademarks, Industrial Designs and GIs'* and *'Working Group on the Development of the Lisbon System'*)

- Provision of **technical assistance** to Member States upon request

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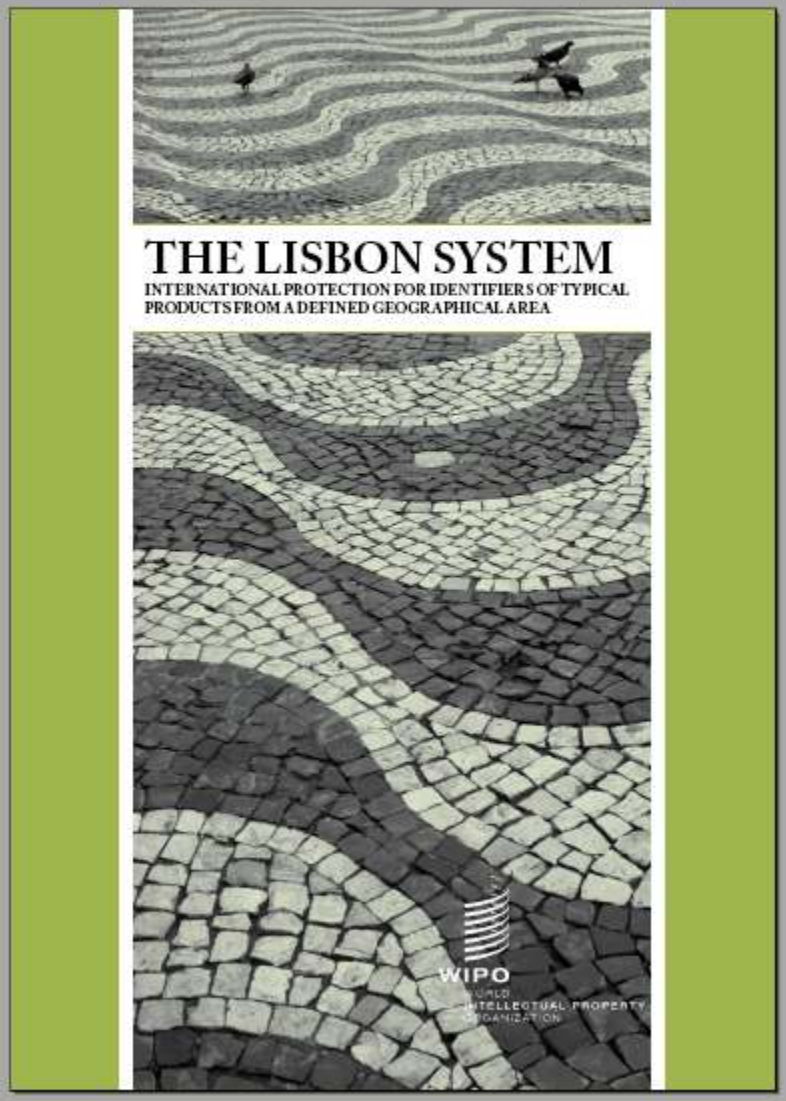

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Appellations of Origin

This map displays information on all the appellations of origin entered, in accordance with the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, in the international register kept by the WIPO International Bureau and which are in force.

Algeria

Local intranet | 100%

Lisbon Union: 27 Member States

Africa (6)

Algeria

Burkina Faso

Congo

Gabon

Togo

Tunisia

Asia (4)

Georgia

Islamic Rep. of Iran

Israel

DPR of Korea

America (6)

Costa Rica

Cuba

Haiti

Mexico

Nicaragua

Peru

Europe (11)

Bulgaria

Czech Rep.

France

Hungary

Italy

Moldova

Montenegro

Portugal

Serbia

Slovakia

The FYR of Macedonia

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898 registrations – 793 in force

France	508	Tunisia	7
Czech Rep.	76	DPR of Korea	6
Bulgaria	51	Slovakia	6
Italy	31	Peru	5
Hungary	28	FYR of Macedonia	4
Georgia	20	Montenegro	2
Cuba	19	Moldova	1
Mexico	13	Israel	1
Algeria	7	Serbia	1
Portugal	7		

Total registered since 1995: 168
- of which since 2003: 53

Wines registered since 1995: 92
- of which since 2003: 24

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Assembly of the Lisbon Union (September 2009)

- **Mandated the WG on the Development of the Lisbon System to**
  - **look for improvements of the Lisbon system which would make the system more attractive for States and users, while preserving the principles and objectives of the Lisbon Agreement**

Basis for the Review of the Lisbon System

- **Survey** to explore what changes to the Lisbon system might allow a **wider membership**

- **Study** by WIPO on the:

  - **application of the Lisbon system in countries that are part of a regional protection system for GIs or AOs**

  - the possible introduction of provisions allowing for the **accession to the Lisbon Agreement by IGOs** administering such system

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Questions addressed in the Survey - WIPO document LI/WG/DEV/2/2

- **The basis for protection in the country of origin**
  - does Lisbon require *sui generis* legislation or not?
- **The definition of protectable subject-matter**
  - how should the differences in definitions at the domestic level be dealt with under Lisbon?
- **Scope of protection**
  - what does protection against usurpation and imitation mean?
  - is it adequate?
  - « cannot be deemed to have become generic »?
  - are prior rights sufficiently safeguarded under Lisbon?
- **Is there a need for modifying the procedural requirements**
  - for applications?
  - for refusals?
  - for invalidations?

Results of the Survey
- reasonably representative response

36 Contributions

- **Lisbon Member States (13)**
- **Non-Lisbon States (12)**
- **IGOs (1)**
- **NGOs (5)**
- **AO/GI Producers (1)**
- **Academia (2)**
- **Private Enterprises (2)**

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2nd Session Working Group on the Development of the Lisbon System (August/September 2010)

- The WG requested WIPO to prepare **draft provisions** on various topics, notably:
  - Definitions
  - Scope of protection
  - Prior users
  - Applications for trans-border AOs or GIs
  - Accession criteria for IGOs
- Alternative versions
- Revision Lisbon Agreement? New treaty?
- Study on the possibility of dispute settlement within the Lisbon system

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3rd Session Working Group (May 2011)

- The WG considered the **draft provisions** prepared by WIPO and agreed to submit to the upcoming Session of the Assembly of the Lisbon Union (September 2011):

  - Proposals for amendments to Rules 5(3) and 16(1) of the Lisbon Regulations

  - A request for the Assembly to take note of the considerable progress made, and the planned work ahead, in the review of the Lisbon system

Proposed Amendments Aimed to Serve Transparency

- Rule 5(3), new item (vi):

  option to specify in an international application any information on the AO that could help to better understand on what basis the country of origin has decided to grant protection

- Rule 16(1), new item (v):

  mandatory requirement to indicate in the notification of an invalidation the grounds on the basis of which the invalidation was pronounced

Planned Work Ahead

- Work will continue with a view to further preparing a process that might result in a **revision of the Lisbon Agreement** and/or the conclusion of **a protocol or a new treaty** supplementing the Lisbon Agreement

- WIPO will prepare a **draft new instrument** containing
  - the draft provisions discussed by the Working Group and revised on the basis of comments made
  - any further draft provisions necessary for making the draft new instrument as complete as possible

- The Working Group will **meet more frequently**

Draft Provisions Discussed by the WG

- Basis for Protection and Definitions (A)
- Filing of International Applications (B)
- Accession Criteria for Intergovernmental Organizations (C)
- International Registration (D)
- Scope of Protection (E)
- Prior Use (F)
- Procedures in Contracting Parties (G)
  - Prior to the Issuance of Possible Refusals
  - For Challenging Refusals Issued

Basis for Protection and Definitions

- **Flexibility as to the Means of Protection**
  - i.e., not necessarily *sui generis* legislation

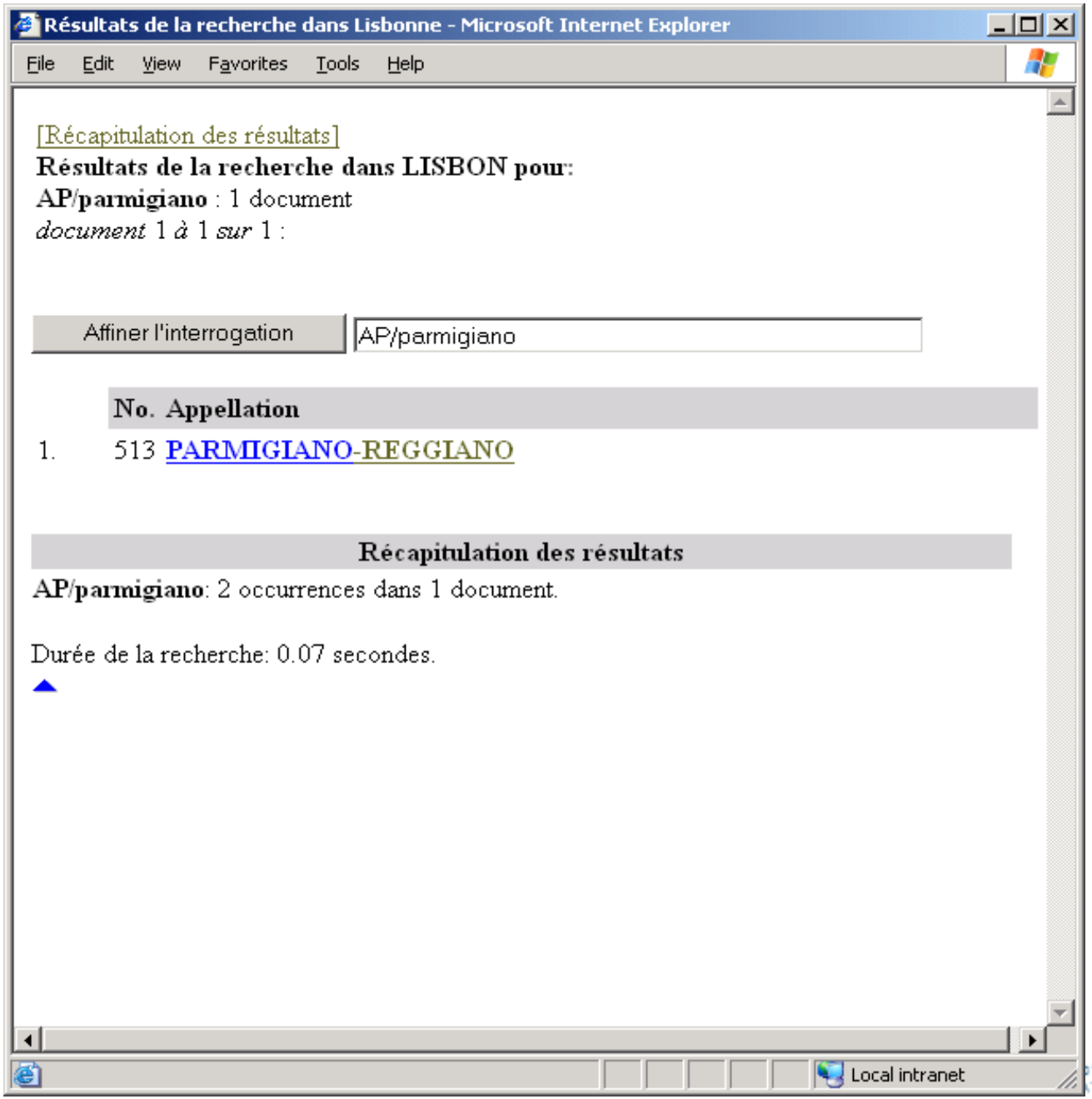
Different systems of protection worldwide

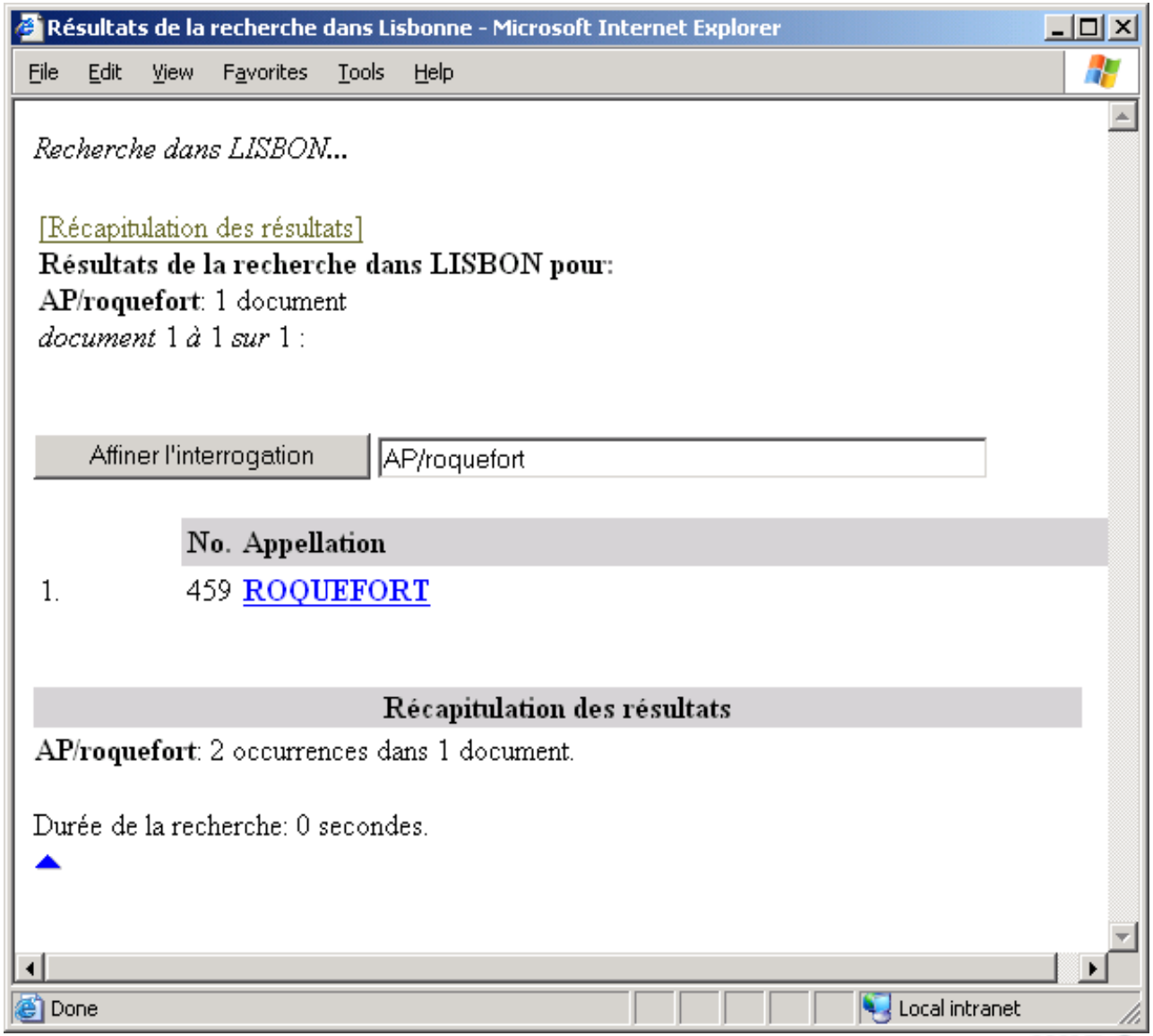
- **Multilateral Agreements**
  - Protection of GIs under TRIPS
  - Protection of AOs under the Lisbon Agreement
    - Legal protection they provide is based on various means of protection on the national level: an act of public law (law, decree, administrative decision, ordinance), or a judicial decision
- **Regional Systems of Protection (EU, OAPI…)**
- **Bilateral Agreements**
  - Under such agreements two States or two trading partners agree to protect each other's GIs or AOs

- **General laws focusing on business practices** (unfair competition and consumer protection provisions)
- **Specific protection systems** for GIs and AOs (sui generis)
- **Trademark law provisions** devoted to collective marks and/or certification and guarantee marks
- **Administrative schemes** of label control

Basis for Protection and Definitions

- Distinctive Signs for **Collective** Use
  - Geographical indications
  - Appellations of origin
  - Collective marks
  - Certification marks
- Distinctive Signs for **Individual** Use
  - Trademarks (goods & services)





Basis for Protection and Definitions

Indication of a Connection between Characteristics of Products and their Geographical Origin

- Informs consumers of the uniqueness of the products derived from this connection **(typicality)**
- Represents the collective goodwill derived from this uniqueness **(reputation)**
- **Value-added**

Basis for Protection and Definitions

- Definition GI: along the lines of Article 22.1 TRIPS
- Definition AO: along the lines of Article 2 Lisbon
  - AO a sub-category of GI
  - the term "geographical" in these two definitions does not only cover geographical names, but also indications and denominations traditionally known as referring to a product originating in a given geographical area

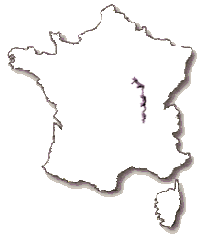
- No obligation to provide for separate titles of protection
  - i.e., CPs providing only for GI are to protect AOs as GIs

Basis for Protection and Definitions

- **AOs (Lisbon, Art.2)**
- Geographical **denomination**
- Refers to a specific product known for its quality or characteristics
- Due exclusively or essentially to the geographical **environment** (natural factors, human factors)

- AO= **Special category** of GI

- **GIs (TRIPS, Art.22.1)**
- **Indication**
- Refers to quality, **reputation**, or other characteristic
- Essentially attributable to its geographical **origin**



GI can also be a symbol referring to or associated with a particular geographical area (the cartographic outline of France with a red itinerary for Burgundy wines)

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Basis for Protection and Definitions

- Concept of « country of origin »
  - Intergovernmental organizations
  - Trans-border areas

Filing of International Applications

- Three Options Discussed
- Special Cases
  - Intergovernmental organizations
  - Trans-border areas

Accession Criteria for Intergovernmental Organizations

- Ability to grant titles of protection in respect of geographical indications, or geographical indications and appellations of origin
- Provide protection in accordance with the terms of the treaty in respect of geographical indications, or geographical indications and appellations of origin

- EU
- OAPI

Scope of Protection

- Use in respect of products of the same kind
  - Art. 3 Lisbon: Protection against « usurpation and imitation », even if accompanied by terms such as « type » or the like
  - Responses to the survey: various other criteria advanced
- Use in respect of products not of the same kind
  - Great diversity in criteria advanced in response to the survey
- Discussion on Draft Provision E

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Prior Use

« A clear split, even though the divide might not be so deep »

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Prior Use

- Can be a ground for refusal or invalidation

- Safeguards for use in good faith
  - under an earlier trademark
  - of a homonymous AO or GI
- Prior use as a generic
  - time-limit for phasing out (if not used as a ground for refusal)

Procedures in Contracting Parties

- Prior to the Issuance of Possible Refusals
  - Draft Provision G(3)

    "Interested parties shall be afforded a reasonable opportunity to file petitions for the competent authority to issue a refusal"

- For Challenging Refusals Issued
  - Draft Provision G(5)

    "Interested parties shall be afforded a reasonable opportunity to negotiate the withdrawal of a refusal or to resort, in a Contracting Party whose competent authority has issued a refusal, to all judicial and administrative remedies open to the nationals of that Contracting Party"

THANK YOU

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