

Questions to be Addressed in Response to the Survey on the Lisbon System

The Basis for Protection in the Country of Origin

Some have interpreted the phrase “recognized and protected as such” in Article 1(2) of the Lisbon Agreement as restricting eligibility for registration and protection under the Agreement to appellations of origin recognized and protected under *sui generis* legislation in the country of origin. Others take the view that this phrase does not impose a means by which an appellation of origin should be protected in the country of origin, nor the specific legal form of protection, as long as the geographical denomination in question meets the definition provisions of Article 2 of the Agreement. Rule 5(2)(a)(vi) of the Regulations under the Lisbon Agreement broadly refers to protection in the country of origin by virtue of legislative provisions, administrative provisions, judicial decisions or registration.

Question 1: Should the basis for protection in the country of origin in Article 1(2) of the Agreement and Rule 5(2)(a)(vi) of the Regulations be revised, in view of the different means of protection existing around the world for geographical indications?

Yes. In order to enlarge the Lisbon system and to fit this agreement to TRIPS, there should be allowed other basis for the protection of geographical indications, besides *sui generis* legislation.

However, there must be certainty about the existence in the country of origin of the correspondent intellectual property right.

Appellations of origin and geographical indication do not “live” in the international arena independently from the national regime of protection. This means that is not possible to register internationally an appellation of origin or a geographical indication that is not protected in the country of origin.

Nevertheless, the Lisbon agreement should allow the country of origin to choose – according to its national regime – the best mechanism to protect appellations of origin and geographical indications as long as it protects in the same way appellations of origin and geographical indications from other countries; that is, it is necessary to take into account the “free rider” country (this is a difficult issue).

Finally, the country of origin must recognize appellations of origin and geographical indications as an autonomous intellectual property right (IPR) and not throw other IPR.

Proposal for article 1:

1.1. The countries to which this Agreement applies constitute a Special Union within the framework of the Union for the Protection of Industrial Property.

1.2. They undertake to protect on their territories, in accordance with the terms of this Agreement, appellations of origin or geographical indications of goods or services of the other countries of the Special Union, protected as intellectual property rights in the country of origin and registered at the International Bureau of Intellectual Property (hereinafter designated as "the International Bureau" or "the Bureau") referred to in the Convention establishing the World Intellectual Property Organization (hereinafter designated as "the Organization").

Terminology and Definitions

A number of domestic laws exist under which protection is available for appellations of origin on the basis of a definition that corresponds to the definition provisions of Article 2 of the Lisbon Agreement. Other domestic laws provide protection for geographical indications on the basis of the definition provisions of Article 22.1 of the TRIPS Agreement. Domestic legislation also exists with both a definition for appellations of origin and a definition for geographical indications or variations of those terms. Moreover, there are also domestic laws dealing with the same subject matter without defining the term "appellation of origin" or the term "geographical indication".

Question 2: Should the definition provisions of Article 2 of the Lisbon Agreement be amended?

Article two should be amended in several items:

- a) The requirement of "geographical denomination" should be deleted. Any geographical reference (traditional geographical name or traditional geographical reference), that is any name with a geographical connotation (any geographical indication) should be allowed. We could also think of allowing other types of geographical references besides names, like designs or images.
- b) The definition should allow goods and services.
- c) Reputation should not be a requirement. It could be an alternative requirement as it is on the TRIPS agreement definition of GIs.
- d) Concerning the qualitative connection there should be a difference between appellations of origin (AO) and geographical indications (GI). AO could maintain a level of connection with the *terroir* very strong, but allowing an alternative between human factors and natural factors (and not a cumulative demand). GI should have the same definition as it is on TRIPS agreement.
- e) Finally, the number 2 of the article 2 should be deleted.

Proposal for article 2:

2.1. In this Agreement, "appellation of origin" means any indication which identify a good or service as originating in the country, region, or locality of a Member, where a given quality and characteristics of the good or service are due exclusively or essentially to the geographical environment, including natural or human factors.

2.2. In this Agreement, "geographical indication" means any indication which identify a good or service as originating in the country, region, or locality of a Member, where a given quality, reputation or other characteristic of the good or service is attributable to its geographical origin.

Scope of Protection

The Lisbon Agreement does not define the terms “usurpation” and “imitation”, as contained in its Article 3, but the negotiating history would appear to indicate that these terms are aimed to prevent use of an internationally registered appellation of origin on a product of the same kind not originating from the area to which the appellation of origin refers or a product of the same kind that, while originating in that area, does not meet the quality or characteristics on which protection for the appellation of origin is based.

Question 3: Should Article 3 of the Lisbon Agreement be amended so as to address the protection of appellations of origin against use on products that are not of the same kind and, if so, on the basis of what criteria?

Yes. My proposition is the following:

- a) Distinction between identical or comparable goods or services and non comparable products and services. This distinction is different from the one known on trade marks (identical or similar and non similar), taking into account the different legal functions of these two industrial property rights.
- b) The protection of appellations of origin (AO) and geographical indications (GI) against use on non comparable goods or services demands the fulfillment of the following conditions:
 - a. AO or GI with reputation;
 - b. Association between the signs by the relevant sector of the public;
 - c. Danger of blurring, tarnishment or exploitation of the reputation (*Rufausbeutung*).

Question 4: What amendments would be necessary to Article 3 in connection with the answer to questions 1 and 2 above?

Article 3 should be rewritten completely. Here is a proposal:

3.1. Protection shall be ensured against any usurpation or imitation on identical or comparable goods or services, even if the true origin of the product or service is indicated or if the appellation or indication is used in translated form or accompanied by terms such as "kind," "type," "make," "imitation," or the like.

3.2. Protection shall be ensured against any use of an appellation or indication on non comparable goods or services if there is a risk of association between the signs by the relevant sector of the public and if there is a risk of damaging the reputation or distinctive force of the appellation or indication or taking advantage of that reputation or distinctive force.

Effects of Registration

The negotiating history of the Lisbon Agreement shows that the Lisbon system is meant to: (a) require a country of origin to provide information in international applications allowing the other member countries proper examination as to whether they can protect the internationally registered appellations of origin concerned; (b) require these other countries to take position within a period of one year from receipt of the notification of an international registration and, in case they submit a declaration of refusal, to specify the grounds for such refusal; and (c) shield such an appellation of origin against becoming a generic denomination.

Question 5: As regards point (a) above, are there elements in the application and registration procedures requiring improvement and, if so, which are these elements?

No.

Question 6: As regards point (b) above, are there elements in the procedures for the notification of refusals, withdrawals of refusals and statements of grant of protection requiring improvement and, if so, which are these elements?

No.

Question 7: As regards point (c) above, would there be a need to amend Article 6 of the Lisbon Agreement, in order to allow for certain exceptions, or does the phrase “cannot, in that country, be *deemed* to have become generic” provide sufficient leeway in that respect?

Article 6 is fine.

Question 8: Are there elements in the procedures of Rule 16 of the Regulations under the Lisbon Agreement concerning the notification by a member country of an invalidation of the effects of an international registration and its recording in the International Register requiring amendment and, if so, which are these elements?

The invalidation of the effects of an international registration of a GI or AO should only take place if that invalidation was declared (by a court, for example) in the country of origin and not in another Member country.

Prior Users

Question 9: Would there be a need to amend Article 5(6) of the Lisbon Agreement, or does the fact that Article 5(6) of the Lisbon Agreement and Rule 12 of the Regulations under the Agreement only apply in case a member country does not notify a declaration of refusal provide sufficient leeway in this respect?

This is a very difficult issue.

Considering the *Freihaltebedürfnis* German doctrine applied to geographical names – with which I agree – and the consequent necessity of non-monopolization of geographical names, it seems to me that the referred article of the Lisbon Agreement may be improved, but its main objective is accomplished.

This means that geographical names should not be monopolized by trademarks; should be left free to be used by those located on the place indicated by the geographical name; the secondary meaning theory should not apply to geographical names; only in very special cases should geographical names become generic or be considered arbitrary.

Usually, prior users benefit from the reputation of the geographical name (*Rufausbeutung* theory) or its appellative meaning (we must bear in mind that usually geographical names are connected with agro-food products – in these products geographical names are always appellative to the decision of the consumer).

Taking into account all of these considerations, we rather wish – at this stage – not to change article 5.6.

Other Issues

Question 10: What other issues concerning law or practice directly or indirectly related to the functioning of the Lisbon system do you consider require amendment or modification of the existing Lisbon Agreement and would you like to bring to the attention of the Working Group on the Development of the Lisbon System?

It should be considered the following issues:

- a) WIPO could be an international basis for the resolution of conflicts between AO or GI and prior users of those names.
- b) Renewal of the registration.
- c) Distinction between owners of the AO or GI (communal property) and users of those rights.
- d) National control authorities over the use of the AO or GI.
- e) Enforcement of these Intellectual Property Rights.

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