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Mr. Francis Gurry  
Director General  
World Intellectual Property Organisation  
34, Chemin des Colombettes,  
1211 Genève 20  
Suisse

**Subject: Lisbon Agreement for the Protection of Appellation of Origin and their International Registration – Contribution of the European Union to the Survey.**

Dear Mr. Gurry, *Dear Francis,*

Following the Survey launched by the International Bureau of WIPO on the Lisbon System for the Protection of Appellation of Origin and their International Registration, I have the pleasure to provide you with the reply of the European Union.

The European Union would like to thank the WIPO International Bureau for this Survey and appreciates the efforts made to improve the Lisbon system and making it more attractive for users and potential new members.

Over the years, the European Union has established schemes for the registration of geographical indications for wines, aromatized wines, spirits and agricultural products and foodstuffs. For this reason and with a view to contribute to the Survey and its follow up, the European Commission, together with Member States of the European Union, have prepared a contribution that we hope could offer you useful elements for the improvement of the Lisbon Agreement.

My services remain at your disposal for any clarification you might require and will continue to be available to cooperate with the WIPO International Bureau on future initiatives to develop the Lisbon system.

Yours sincerely,

*kindest regards*

*Margot Fröhlinger*  
Margot Fröhlinger

**REPLY OF THE EUROPEAN UNION TO WIPO SURVEY ON THE LISBON AGREEMENT FOR THE PROTECTION OF APPELLATION OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION.**

**Introduction**

The European Union would like to thank the WIPO Secretariat for its questions developed under the survey on the Lisbon system. It is pertinent to recall that only seven Member States of the European Union are members of the Lisbon Agreement.

Over the years, the European Union has established schemes for the registration of geographical indications for wines, aromatized wines, spirits and agricultural products and foodstuffs.

The present document represents the contributions of the European Union to the aforementioned survey. It focuses on key principles and is not intended to enter into detailed technical comments, which may be adduced in the course of the forthcoming work of the Working group on the development of the Lisbon system.

**General comments**

Since the adoption of the Lisbon Agreement, the international legal environment related to the protection of those signs identifying products whose specificity is linked to their geographical origin has considerably evolved. The Lisbon Agreement should therefore both be flexible enough to accommodate this evolution and the development of a variety of national or regional schemes while preserving its own core principles and objectives. While building on its strengths, the adjustment of the Lisbon system should in particular take into account the developments brought by the TRIPS Agreement in relation to geographical indications and the interpretation thereof.

QUESTIONS	REPLY
<p><b><u>Question 1:</u></b>  <b>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</b></p>	<p>It seems that there is no need to revise Article 1(2) of the Agreement and Rule 5(2). However, a broad interpretation of those provisions could be envisaged in order to guarantee the inclusion in the Agreement of all types of protection depending on the tradition in the country of origin (be it <i>sui generis</i> system or not). This protection can take any form <b>provided that</b> such protection guarantees that a denomination complies with the substantive requirements of an Appellation of Origin as specified in Article 3 of the Agreement.</p>

QUESTIONS	REPLY
<p>around the world for geographical indications?</p>	<p>In this context, a clarification of such an interpretation seems to be necessary, also in view of making the Lisbon system more attractive for potential new members.</p>
<p><u>Question 2:</u> Should the definition provisions of Article 2 of the Lisbon Agreement be amended?</p>	<p>Since 1958, developments at international, regional and national level have occurred, leading to the development of a variety of concepts ranging from "geographical indications" to "appellations of origin", those concepts sometimes carrying themselves different meaning. But these concepts are most often encompassed in the broad notion of "geographical indication" as defined in Article 22.1 TRIPS. Such "geographical indications" are clearly differentiated from "indications of source".</p> <p>The Lisbon Agreement could take these developments into account and provide the possibility to protect all those indications that meet the definition of Article 22.1 TRIPS.</p> <p>It could be therefore useful to clarify the definition of "appellation of origin" laid down in the Lisbon Agreement in order to provide for more legal certainty and uniform terminology at international level. It may then be appropriate to adopt a common terminology, i.e. by replacing the term "appellation of origin" with the term "geographical indication" and its definition (as defined in TRIPS).</p> <p>The broadening of the definition will also make the Lisbon system more attractive.</p>
<p><u>Question 3:</u> 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?</p>	<p>Any adjustment of Article 3 of the Lisbon Agreement shall aim at bringing clarifications to or enhancing the protection of appellations of origin.</p> <p>Experience shows that AO representatives seek protection against the use of AO on products that are not of the same kind and may use the Lisbon system to that end. It is therefore considered that a broader protection would be more appropriate provided that certain requirements are met (e.g. when the use of an AO exploits the reputation of the AO, is misleading, false, etc.).</p>
<p><u>Question 4:</u></p>	

QUESTIONS	REPLY
<p><b>What amendments would be necessary to Article 3</b> in connection with the answer to questions 1 and 2 above?</p>	<p>Certain amendments are recommended in view of greater clarity and legal certainty. In particular, it may be made clear that usurpation and imitation cover not only the situation where the product/good does not have the true origin indicated by the AO, but also where the product/good does not meet the requirements associated with the appellation of origin (specifications). For instance, existing EU provisions can be used as guidance, e.g.: Article 3 should be adjusted in accordance with Article 13 of Council Regulation 510/2006 and should include protection against 'evocation' (ECJ case-law).</p>
<p><i>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.</i></p> <p><b>Question 5:</b> As regards point (a) above, are there elements in the application and registration procedures requiring improvement and, if so, which are these</p>	<p>No improvement is required. However, taking into account the replies brought under Questions 1 and 2, it could be useful to analyse the opportunity that the notification and the registration entail information not only on the product/good concerned and the area of production, but also on the relation between the product/good</p>

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<p>elements?</p>	<p>and the area of production, in particular the quality (or) characteristic (or) reputation of the product. Such information may be entered in the International Register.</p>
<p><b>Question 6:</b> 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?</p>	<p>The issue of grounds for refusal is a key one as regards the attractiveness of the Lisbon Agreement. There are two-fold concerns that may be addressed:</p> <ol style="list-style-type: none"> <li>1) the absence of any guidance as regards grounds for refusal, hence legal uncertainty. In this framework, several options could be explored, such as: <ul style="list-style-type: none"> <li>- Defining grounds for refusal in the Lisbon Arrangement itself.</li> <li>- Providing that the refusal of a notified AO should be based on the grounds of refusal enshrined in domestic laws.</li> </ul> </li> <li>2) a declaration of refusal shall specify the grounds for such refusal, but there is currently no requirement in terms of substantiation (with the possible exception of the refusal based on the existence of a prior right, as laid down in Rule 9). It should be considered to provide explicitly that a declaration of refusal shall be substantiated.</li> </ol>
<p><b>Question 7:</b> 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?</p>	<p>The issue of the generic character of an indication is another key element of the Lisbon system. It seems that there is no need to amend article 6.</p>
<p><b>Question 8:</b></p>	

QUESTIONS	REPLY
<p>Are there elements in the procedures of <b>Rule 16</b> of the Regulations under the Lisbon Agreement concerning the <b>notification</b> by a member country of an <b>invalidation of the effects of an international registration</b> and its recording in the International Register requiring amendment and, if so, <b>which are these elements?</b></p>	<p>No amendment is needed.</p>
<p><b>Question 9:</b>  Would there be a need to amend <b>Article 5(6)</b> of the Lisbon Agreement, or does the fact that <b>Article 5(6)</b> of the Lisbon Agreement and <b>Rule 12</b> of the Regulations under the Agreement <b>only apply in case a member country</b> does not notify a declaration of refusal <b>provide sufficient leeway</b> in this respect?</p>	<p>Article 5(6) should be amended in order to take into account the developments regarding the co-existence of AO with prior intellectual property rights, in particular with trade marks. In the case of intellectual property rights protection in a given country, prior to the date of notification of AO international registration under Article 5(2) of the Lisbon Agreement, which is accepted in the territory of this country, neither the prior intellectual property rights nor their associated uses may be terminated.</p> <p>As regards appellations which are not protected under intellectual property but have already been used by third parties in that country from the date prior to such notification, Article 5(6) should define a more appropriate period (i.e. longer than the current 2-year period) that could be granted to third parties to terminate use of such appellations.</p>
<p><b>Question 10:</b>  <b>What other issues</b> concerning law or practice directly or indirectly related to the functioning of the Lisbon system <b>do you consider require amendment or modification</b> of the existing Lisbon Agreement and <b>would you like to bring to the attention of the Working Group</b></p>	<p>The WIPO web page with the Lisbon AO database may be made more user-friendly and the access to information in the databases of WIPO should be improved, particularly information on the grounds for refusal of an appeal of origin indicated by any contracting country and on the legal status of the application/granted files in each country should be more easily available.</p> <p>The EU has taken due note that the WIPO Secretariat has been mandated to prepare a study that will serve as a basis for discussions amongst members as regards possible membership of "competent intergovernmental</p>

<b>QUESTIONS</b>	<b>REPLY</b>
<p>on the Development of the Lisbon System?</p>	<p>organizations". The EU considers that the introduction of the possibility of accession of such organizations could contribute to making the Lisbon system more attractive.</p> <p>Moreover, the issue of the establishment of a dispute mechanism might be examined by the Working Group on the Development of the Lisbon System to address a need for efficient way of settling disputes between contracting countries of the Lisbon System, e.g. via the WIPO Mediation and Arbitration Centre.</p> <p>Finally, the possibility of trans-border applications that can be lodged jointly by several groups from a trans-border geographical area might be considered in order to make the Lisbon system more flexible in future.</p>