



Ministero dello Sviluppo Economico

DIPARTIMENTO PER L'IMPRESA E L'INTERNAZIONALIZZAZIONE
DIREZIONE GENERALE PER LA LOTTA ALLA CONRAFFAZIONE
Ufficio Italiano Brevetti e Marchi – Divisione XIII – MARCHI
VIA MOLISE N. 19 – 00187 ROMA

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?

Answer 1: **NO, there is no need to change Art. 1(2) of the Agreement and Rule 5(2) of the Regulations. The efforts to revitalize the Lisbon System should be done by adopting a gradual approach: firstly, the existent provisions should be properly interpreted and discussed and after, eventually, the suitable amendments to the text of the Agreement should be adopted; only in case such amendments are not considered appropriate, a revision of the Agreement itself must be taken into account.**

It can be underlined that being a Contracting Party of the Lisbon Agreement means not only to apply for international registration and protection of national appellations of origin, but also to give protection to foreign appellations. Anyway, it could be useful to work in order to reach a convergence in national laws, for example preparing a “Model Law” on GIs.

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?

Answer 2: YES, the "*Appellation of Origin*" as named in Art. 2 is not sufficient in any case to assure an efficient and complete protection to all GIs; in fact, it would be better to specify the two definitions "*Designation of Origin*" and "*Geographical Indication*" as stated in the (EC) Regulation n. 510/2006) at Art. 2. 2), for GIs other than wines and spirits. It has also to be considered that similar provisions are contained in (EC) Reg. n.479/2008 for GIs wines (see in particular art.34) and in (EC) Reg. n.110/2008, for GIs spirits (see art.15).

Even if the concept of appellation of origin has been very useful over the years to protect GIs, it would be important to establish more convergence in the international agreements framework on IPR and, in particular on GIs. For this reason, Italy suggests some changes on the legal text of the agreement, in particular in the art. 2(1) using the wording of Art. 22 of TRIPs Agreement, which states:
"Art.22 TRIPS

1. Geographical indications are, for the purposes of this Agreement, indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin."

In particular, it is very important to allow registration on the ground of reputation, under the Lisbon Agreement, as in Art. 22 of the TRIPs Agreement, in order to assure a stronger protection of product quality in the international markets.

As a consequence, in the future it would be possible a better coordination between the Lisbon Agreement and the TRIPs Agreement, in order to establish common and shared grounds at an international level, considering that all the 26 Member States of the Lisbon Agreement are also parties of the WTO.

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?

Answer 3: YES, it would be better to be in line with the already mentioned Council (EC) Reg. n. 510/2006) at Art. 13, and specifically with regard to points a), b), c) and d) (evocation, false or misleading indication).

As mentioned above, the same principle - inspired to a wide and strong protection of Geographical Indications - is also contained in (EC) Reg. n. 479/2008 (art.45) and in (EC) Reg. n. 110/2008 (art.16).

It would be important to make more clear which are the relevant categories of misleading use of GIs in the Lisbon Agreement, according to the model of Art.13 of Reg. (EC) n.510/2006. In particular, it is important to protect GIs against evocation, which is the most dangerous form of abuse that can be found on the international markets.

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

Answer 4: Article 3 should be amended as to reproduce what stated in the Council Regulation (EC) n. 510/2006) at Art. 13 (Protection).

In particular, as mentioned above, we could refer to the concept of evocation as explained by the European Court of Justice (see, for example, ECJ, C-87/97, *Gorgonzola vs Cambozola*, par.25: *'Evocation, as referred to in Article 13(1)(b) of Regulation No 2081/92, covers a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected'*).

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?

Answer 5: NO: the requirements of the application are widely provided.

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?

Answer 6: NO: no other element is necessary.

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?

Answer 7: NO: there is no need to amend Art. 6 of the Lisbon Agreement. Article 6 is clear as it stands and provides for legal certainty and predictability. There is no need to provide exceptions in this respect.

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?

Answer 8: NO: no other element is necessary.

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?

Answer 9: YES: Article 5(6) should be more clear, because it seems too muddled, in particular it should be to clarify the relationship and the form of the coexistence between trademarks and geographical indications, according to the principles of the above mentioned EU regulations on GIs. In particular, with specific regard to (EC) Reg. n. 510/2006, it needs to clear up:

- a) if **prior use** from third parties, in a particular Country of the Union, is based on an already granted TM, GI or PDO or PGI in that Country; or GI in that Country;
- b) if **prior use is legitimated** (because of its protection in that Country), why the Office of that Country must give a two-year period to terminate such use and cannot allow the coexistence of both protected names as provided in the Council Regulation (EC) n. 510/2006 at Art. 13.4);

- c) the coexistence is allowed when the prior use is made in good faith (see Council Regulation (EC) n. 510/2006 - Art. 14.2);
- d) in the last case we need to provide an homonymous regime, as the one set forth in Art. 3.3) of the abovementioned Regulation.

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?

Answer 10: An important issue for the Italian Patent and Trademark Office would be the possibility to add the Italian language as a new working language of the Agreement, specifically taking into consideration the great number of PGI and PDO protected in the European Community that could be interested to claim protection also through the Lisbon Agreement.

Moreover, it could also be useful to perform an accurate recognition of all Italian GIs not yet registered also under the Lisbon System, in order to encourage them to join the System.

Furthermore the use of the Italian language would be attractive for many Italian producers that want to claim protection for their products. Moreover, it could also be useful to perform an accurate recognition of all Italian GIs not yet registered also under the Lisbon System, in order to encourage them to join the System.

A serious consideration may concern the exiguous number of Contracting Parties (26) of the Lisbon Agreement and in view of enlarging this number, we should be wondering why so many Countries are not members of the Agreement even if they seems to be "GIs friends" in the WTO framework (such as: Turkey, Switzerland, China, India, Brazil) in the Doha Round under the TRIPS Agreement. In this regard the promotion of bilateral negotiations with these Countries would be very useful.

*Ms. Stefania BENINCASA
Head of Trademark Office
Italian Patent and Trademark Office*

Rome, January 21st, 2010