



European Communities Trade Mark Association

8 January 2010

Questions and answers to WIPO survey on the Lisbon System

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?

As a disagreement seems to exist as to whether *sui generis* legislation in the country of origin is necessary for protection under the Lisbon System, it should be made clear in the corresponding provisions that protection through any other legal means in the country of origin is sufficient.

It cannot be expected from every country member or those willing to join the Lisbon system to adopt specific *sui generis* legislation on geographical indications; however the national rules must be identifiable.

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

In order to harmonize with TRIPS and EU Regulations, the wider words "*geographical indication*" should be substituted by the words "*appellation of origin*", and the definition should be modified accordingly.

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?

The TRIPS Agreement should be taken into consideration in this regard.

However, on this specific question, there is no special indication on the question of goods. Looking at Article 22.2 of TRIPS, it might appear that the goods must be identical or similar as the rule of the game appears to be "*if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin*".

Looking at the trade mark law, Articles 8.1, 2.c and 5 of the EU Regulation could be taken over. This would allow extending the protection of a GI for goods which are not identical or similar, but for which a link can be established. Furthermore, the more the GI is reputed, the broader its protection.

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

No answer.



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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?

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?

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?

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?

Due to a lack of experience regarding the questions 5, 6, 7 and 8, which are in the hands of the Member Countries, we will refrain from giving answers.

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?

Article 5.6 is the most critical Article of the Lisbon Agreement. This Article allows that a later coming appellation of origin can stop the use of a prior used trade mark without any compensation, only allowing a two year fading out period. This is simply a non-acceptable expropriation. It is not because a Member Country does not notify a declaration of refusal on basis of such prior right that its existence and use should be simply removed. This Article is certainly the major stumbling block for which so few new countries adhere to the Lisbon Agreement. It is interesting to follow the change of the wording of the EU foodstuff Regulation, which has drastically changed throughout the years and which provides for, even if there has not been an objection, that the prior sign and the appellation should coexist.

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?

No comment.