

**Questions to be Addressed in Response to the Survey
on the Lisbon System
Response of the United States Patent and Trademark Office**

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?

US Response:

The answer to this question would depend entirely on what the United States hopes to achieve with any amendment of the Lisbon Agreement. Because there are mandated negotiations in other fora that are ongoing and directly relevant to this question, the United States is not in a position to answer this question at this time.

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?

US Response:

See response to question 1.

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?

US Response:

See response to question 1.

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

US Response:

See response to question 1.

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?

US Response:

See response to question 1.

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?

US Response:

The United States notes that limiting the time for objections to 12 months can be detrimental to prior trademark rights and can cause consistency questions with regard to TRIPS trademark provisions as well as Paris Article 6bis on well-known marks. Expanding the refusal period to 18 months or more, in and of itself, will not cure the consistency concerns, absent an explicit provision in the treaty text for cancellation or invalidation during the term of protection.

In other words, the United States would suggest expanding the initial refusal period but in combination with a provision allowing a recognized appellation of origin to be cancelled/invalidated based on prior rights, distinctiveness/genericness, or public order/deception, during the term of the registration/recognition.

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?

US Response:

It is difficult to understand how a country can shield a protected appellation from becoming generic. Under other IP systems, it is the rights holder who is responsible for controlling use of its mark so that unauthorized use does not result in the term becoming generic. A private intellectual property right must be enforced or it is lost. For that reason, from the perspective of the United States, Article 6 should be deleted in its entirety.

Without a requirement of use, it is possible that a Lisbon Member could notify a term which is subsequently accepted by another Member. That appellation is never used by the notifying Member’s industry in the receiving territory and the local authorities do not provide ex officio enforcement of the appellation. In the meantime, the local industry begins using the term. The notifying owner never does anything to enforce. Twenty years go by and only at that point does the original notifier complain about the generic uses. Why should Article 6 preserve these terms for the foreign owner at the expense of the local industry? The principle of acquiescence (also “laches” in US jurisprudence) would not allow these late claims.

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?

US Response:

Rule 16(1)(i) – it is better to require both the international registration number and the AOO because numbers can be transposed and you do not want to invalidate the wrong AOO and then have to reactivate it.

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?

US Response:

Since coexistence of prior trademarks and later in time geographical indications is inconsistent with Article 16 of the TRIPS Agreement, the United States is concerned with the impression that Lisbon Article 5(6) gives vis-à-vis TRIPS compliance. Keeping in mind the need to ensure proper interpretation of international obligations, the United States notes that the phase-out provision in Article 5(6) could give the wrong impression regarding the relationship between trademarks and appellations of origin and could be misleading to Contracting Parties. With that in mind, the United States observes that Article 5(6) should be deleted.

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?

US Response:

Not at this time.