Opening up new perspectives for the international protection of geographical indications – The review of the Lisbon system

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Introduction

Focus: on the development of the Lisbon system.

Lisbon system: the system established under WIPO’s Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.

Background: recent decision of the Lisbon Union Assembly to convene a diplomatic conference for the revision of the Lisbon Agreement.
Outline

• considerations underlying the review of the Lisbon system

• specific developments triggering the revision process

• activities of the WIPO Working Group on the Development of the Lisbon System

• the legal form and main objectives of the development of the Lisbon system

• envisaged refinements of the legal framework

• outstanding issues and next steps
Why revise the Lisbon Agreement?

- limited membership, narrow geographical coverage
- no possibility for IGOs to become members
- divergent approaches and a plethora of different concepts and definitions
- a track record of failed negotiations within WIPO
- concerns about TRIPS compatibility
- no agreement in WTO on the multilateral register
Developments triggering the revision process

*Pisco*: the need to lay down procedures for notifying acceptance of protection (also partially) and cater for the coexistence of homonymous appellations of origin.

Establishment of Administrative Instructions – to determine the conditions and modalities of electronic communications.
Establishment of the Working Group


Mandate: to explore possible improvements to the procedures under the Lisbon Agreement.

First session (March 2009): amendments to the Regulations (statement of grant of protection + Administrative Instructions to cover e-business tools) and conclusions on future work.
Renewed and extended mandate for the WG

With the approval of the 2009 session of the Lisbon Union Assembly:

"the work embarked upon should continue, in particular in view of the need to look for improvements of the Lisbon system which would make the system more attractive for states and users, while preserving the principles and objectives of the Lisbon Agreement".
Renewed and extended mandate for the WG

With the approval of the 2009 session of the Lisbon Union Assembly:

• the International Bureau to conduct a survey on possible improvements to the Lisbon system;

• the International Bureau to conduct a study the conditions for, and the possibility of, future accession to the Lisbon Agreement by competent intergovernmental organizations;

• the WG should continue its work and further meetings should be convened for that purpose.
Activities of the Working Group

Second session (August/September 2010):

• discussions about the results of the survey and about the study with detailed conclusions as to the directions of the revision process;

• requesting the International Bureau to “prepare draft provisions on the various topics addressed ... in order for the work on the development of the Lisbon system to become more focused”;

• while stressing that those draft provisions should “leave open the question as to the legal instrument by which they might be formalized”.
Activities of the Working Group

Third session (March 2011):

• further amendments to the Regulations (option to provide in the international application further information about the protection in the country of origin + mandatory requirement to indicate the grounds for invalidation);

• recommendation that a process should be prepared “*that might result in a revision of the Lisbon Agreement and/or the conclusion of a protocol or a new treaty supplementing the Lisbon Agreement*”;

• and asking the International Bureau for a complete draft new instrument to that effect as well as for an acceleration of the work through convening meetings more frequently (i.e. twice a year);

• with full endorsement by the Lisbon Union Assembly.
Activities of the Working Group

Seventh session (April/May 2013): recommendation on convening a diplomatic conference for revising the Lisbon Agreement and on a roadmap leading to it.

2013 session of the Lisbon Union Assembly: approves
- the convening of a diplomatic conference for the adoption of a Revised Lisbon Agreement in 2015, with the exact dates and venue to be decided by a preparatory committee meeting,
- and also that two or possibly three further Working Group sessions should be convened until the diplomatic conference (with the eighth session already held in December 2013).
The legal form a possible new instrument

Options considered (but not favoured) by the WG:

- an “orphan”: a new instrument on GIs without any institutional link to the (revised) Lisbon Agreement;

- “twins”: a revised Lisbon Agreement supplemented with a protocol (an instrument institutionally linked to the revised Agreement) concerning GIs;

WIPO’s General Assembly – competent to call a diplomatic conference for adopting a new treaty going beyond a revision of the Lisbon Agreement.
The legal form a possible new instrument

The approach chosen: a single instrument covering both appellations of origin and geographical indications in the form of a new Act of the Lisbon Agreement.

The Assembly of the Lisbon Union – competent to convene a Diplomatic Conference for the adoption of a Revised Lisbon Agreement.

See Articles 9(2)(a)(ii) and 13(2) of the current Lisbon Agreement: the Agreement “may be revised by conferences held between delegates of the countries of the [Lisbon] Union”, and the Assembly of this Union is empowered to “give directions to the International Bureau concerning the preparation for revision conferences”.
The legal form a possible new instrument

The Lisbon Union Assembly’s decision is not uncontested.

In the opponents’ view, under Article 9(2)(b) of the Lisbon Agreement, the Lisbon Union Assembly should have consulted the Coordination Committee of WIPO before deciding on the Diplomatic Conference, as, at least for budgetary and financial reasons, such a conference is of interest to other Unions administered by WIPO.
The legal form a possible new instrument

An issue still to be addressed – the right to vote in the Diplomatic Conference:

- under the current Lisbon Agreement: only contracting countries with the right to vote (and other WIPO members invited to participate as observers – like in the WG); or

- all WIPO members participating with voting rights (precedents: Geneva Act of the Hague Agreement, STLT).
The main goals of the revision process

Two main objectives of revising the Lisbon Agreement:

• establishment of an international register for all geographical indications whether or not they qualify as appellations of origin;

• opening up the Lisbon system for intergovernmental organizations and allowing of their membership.
The main goals of the revision process

Principles of the extended international register:

• there would be a single, unified international register for both appellations of origin and other categories of GIs, with the register indicating whether a certain denomination was entered as an appellation of origin or as a GI;

• the register would comprise registrations effected under, and governed by, both the current Lisbon Agreement and its new Act, again with the respective indications included in the register;

• the procedures for international registration would be based on the model of the current Lisbon Agreement and its Regulations with the introduction of some improvements for the benefit of users (such as the optional provision allowing beneficiaries to file their applications directly with the International Bureau).
The main goals of the revision process

The revised Lisbon Agreement would continue to lay down substantive minimum requirements as to the content of protection accorded by international registration.

Current membership – setting the goal of providing for a “high and single level of protection” for both appellations of origin and other GIs, while maintaining two separate definitions, on the understanding that the same substantive provisions would apply to both categories.

Why have two definitions if the same provisions apply to both?

This approach may run the risk of not reaching the ultimate goal of expanding the membership of the Lisbon system.
The main goals of the revision process

A two-tier approach – a possible way-out currently blocked:

Chapter 1 (mandatory for all contracting parties): a mere registration system along the lines of the Madrid and Hague systems;

Chapter 2 (optional): substantive requirements that would provide for a high level of protection for both geographical indications and appellations of origin.
The main goals of the revision process

Accession by competent intergovernmental organizations:

• potential candidates: the African Intellectual Property Organization and the European Union;

• eligibility criteria [Article 28 of the draft Revised Lisbon Agreement (“DRLA”)]:
  ▪ at least one member state of the IGO concerned is party to the Paris Convention;
  ▪ a declaration to be made by the IGO that it has been duly authorized, in accordance with its internal procedures, to become party to the new Act;
  ▪ the same declaration to confirm that, under the constituting treaty of the intergovernmental organization, legislation applies for the protection of appellations of origin and/or geographical indications in accordance with the new Act.
The main goals of the revision process

Questions surrounding the EU’s accession:

• the Lisbon system covers all product categories, while there is no protection at EU level for non-agri GIs;

• the majority of EU Member States are not contracting countries of the Lisbon Agreement;

• for certain product categories – no coexistence of national and EU titles (unlike in the case of trademarks and designs).
Refining the current legal framework – some examples

• Article 9 DRLA: each Contracting Party would be free to choose the type of legislation under which it establishes the protection stipulated in the new Act, provided that such legislation meets the substantive requirements of that Act (enough to accommodate trademark law approaches?).

• Clarifying definitions:

- denominations and indications that are strictly speaking not geographical, but which have obtained a geographical connotation, could also qualify as appellations of origin or as GIs;
- the geographical area in question may consist of the entire territory of a Contracting Party and not only of a region, locality or place within such territory;
- “notoriété” and “réputation”, in the French version of the Agreement, and “notoriedad” and “reputación”, in the Spanish version of the Agreement, should be considered synonyms for the purposes of the Agreement.
Refining the current legal framework – some examples

• Article 5(4) DRLA: provisions on trans-border areas (≠ homonyms) providing the Contracting Parties concerned with two options:
  - each of them could file an application separately but only concerning those goods that originate in the part of the trans-border area situated in its own territory; or
  - they could act as a single Contracting Party of Origin by filing an application jointly and through a commonly designated Competent Authority.

• Fixing Article 5(6) of the current Lisbon Agreement by changing its scope significantly:
  - it would only apply to prior use as a generic term or name;
  - and the length of the phasing-out period would be extended significantly as the relevant Rule [Rule 14(2) under the DRLA] would specify that “the duration of the period granted to a third party shall [not be shorter than [five] years and] not be longer than [15] years, it being understood that the period may depend on the specific situation of each case”.
Main outstanding issues

Outstanding issues of the revision process:

• content of protection (Articles 10 and 11 DRLA);

• safeguarding prior trademark and other rights (Article 13 DRLA).
Article 10
Protection Accorded by International Registration

(Content of Protection) (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to the registered appellation of origin, or the registered geographical indication, protection against:

(i) any use of the appellation of origin or the geographical indication

– in respect of goods of the same kind as those to which the appellation of origin, or the geographical indication, applies not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin, or the geographical indication; or

– [which would amount to its usurpation or imitation [or evocation]]; or

– which would be detrimental to, or exploit unduly, its reputation,

even if the appellation of origin or the geographical indication is used with minor differences; if true origin of the goods is indicated; or if the appellation of origin, or the geographical indication, is used in translated form or accompanied by terms such as “style”, “kind”, “type”, “make”, “imitation”, “method”, “as produced in”, “like”, “similar”, or the like;

(ii) any other practice liable to mislead the consumer as to the true origin, provenance or nature of the goods.

(b) Without prejudice to Article 13(1), a Contracting Party shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin, or a registered geographical indication, if use of the trademark would result in one of the situations covered by subparagraph (a).

Draft Agreed Statement by the Diplomatic Conference: “The existing practice under the Lisbon Agreement with respect to homonymous appellations of origin shall be continued under this Act with respect to appellations of origin and geographical indications.”
Article 11

Shield Against Becoming a Generic Term or Name

A denomination protected as a registered appellation of origin, or an indication protected as a registered geographical indication, in a Contracting Party cannot [be considered to have] become generic as long as the denomination is protected as an appellation of origin, or the indication is protected as a registered geographical indication, in the Contracting Party of Origin.

Footnote to Article 11:
A “generic term or name” shall be understood to mean the customary term in common language as the common name of the good or service or the customary name of a grape variety.
A conflict zone: TMs vs AOs/GIs under the DRLA

• protection of registered AOs or GIs could be invoked against the registration (or validity) of later trademarks [Article 10(b)] where their use would result in one of the situations covered by the protection of a registered AOs or GIs [Article 10(a)];

• an earlier trademark – a basis for refusing the effects of an international registration [Article 15(1), Rule 9(2)(iv)], with a reasonable opportunity to be provided for trademark owners to request refusal;

• where no refusal is notified: safeguard for prior trademark rights [Article 13(1)];

• coexistence where a refusal is withdrawn or a statement of grant of protection is issued [Article 17(3)];

• main question: do these cases of coexistence constitute a permitted or acceptable exception to trademark rights, especially in a TRIPS context?
Article 13
Safeguards in Respect of Other Rights

(1) [Prior Trademark Rights] Without prejudice to Articles 15 and 19, where a registered appellation of origin or a registered geographical indication conflicts with a prior trademark applied for or registered, or acquired through use, in good faith in a Contracting Party, the protection of that appellation of origin or geographical indication in that Contracting Party shall not prejudice the eligibility for, or the validity of, the registration of the trademark, or the right to use the trademark, [taking into account] [provided that] the legitimate interests of [the owner of the trademark as well as those of] the beneficiaries of the rights in respect of the appellation of origin or the geographical indication [are taken into account] and provided that the public is not misled.

Article 17

(3) [Coexistence] Where a Contracting Party that has refused the effects of an international registration under Article 15 on the ground of use under a prior right, as referred to in Article 13, notifies the withdrawal of that refusal under Article 16 or a grant of protection under Article 18, the resulting protection of the appellation of origin or geographical indication shall not prejudice the prior right or its use, unless the protection was granted following the cancellation, non-renewal, revocation or invalidation of the prior right.
The roadmap until the Diplomatic Conference

Conclusions of the eighth session of the WG:

• ninth session of the WG (first half of 2014)

• tenth session of the WG (second half of 2014)

- to be held in conjunction with the meeting of the preparatory committee;
- to focus on technically preparing the texts for the DC and on reducing the number of pending issues;
- resolved issues would not be re-opened and proposals and discussions should be limited to pending issues.

• the Lisbon Union Assembly to note progress in the second half of 2014.
Please visit the web-page of the Review of the Lisbon System on WIPO’s website:

http://www.wipo.int/lisbon/en/review.html

Thank you for your kind attention!