REVISION OF THE LISBON SYSTEM

An Australian Perspective
GIs and Trade Marks

• Valuable marketing tools
• Powerful negative rights, used to exclude others from use
GIs and Trade Marks

• What uses should these exclusive rights prevent, and in what circumstances?
• Unsettled internationally
GIs and Trade Marks

• Australia:
  – Certification and collective trade marks for GIs for all goods
  – *sui generis* GI system for wines
Lisbon – a truly international system?

• Current system - 28 members in 47 years

• Revision –
  – opportunity to modernise
  – accommodate other effective forms of GI protection
Nature of protection

Absolute

vs

Contextual, requirement for confusion
Nature of protection

Lisbon:
Parties shall extend protection against:
• Usurpation
• Imitation
• Evocation

Interpretation and implementation problems
Nature of protection

Existing international rules allow for few exceptions to GI rights:

• respect for prior trade mark rights;
• whether a term is generic;
• safeguards for continued use of a person’s name;
• homonymous indications
Absolute protection - pitfalls

• What happens when a term is a GI as well as having a different meaning in everyday language – depending on the presentation, what is the risk of confusion or harm?
Absolute protection – pitfalls

Cases

HOWLING WOLF
Absolute protection - pitfalls

Cases

FEET FIRST
Absolute protection - pitfalls

ORANGE

- Australian GI
- French GI “Vin de pays de la Principauté d'Orange.”
- Style of wine
- Commune in SE France
- County, California USA
- Type of fruit
- Colour
Absolute protection - pitfalls

• Implementing legislation in Australia had to be amended over the years since the first Wine Agreement.

• AGWA Act now provides reasonable (but limited) exceptions for use that is not likely to mislead.

• Requires publication for objections to new GIs – on grounds of prior trade mark rights; generic terms and grape varieties
Absolute protection - pitfalls

• Some terms are GIs in one part of the world, yet have become generic names in other parts of the world.

• The significance of these terms worldwide is contested.
Lisbon revision - outcome

• Shield against becoming generic (Article 12)
• Is this necessary – discourages/excludes new members
Nature of protection

The best form of protection is .... PROTECTION in the first place.
Thank you