



Australian Government  
IP Australia

# REVISION OF THE LISBON SYSTEM

## An Australian Perspective



Delivering a world leading IP system

Polymer  
Bank Notes



Australian Government

IP Australia

# GIs and Trade Marks

- Valuable marketing tools
- Powerful negative rights, used to exclude others from use



Australian Government

IP Australia

# GIs and Trade Marks

- What uses should these exclusive rights prevent, and in what circumstances?
- Unsettled internationally



Australian Government

IP Australia

# GIs and Trade Marks

- Australia:
  - Certification and collective trade marks for GIs for all goods
  - *sui generis* GI system for wines



Australian Government

IP Australia

# Lisbon – a truly international system?

- Current system - 28 members in 47 years
- Revision –
  - opportunity to modernise
  - accommodate other effective forms of GI protection



Australian Government

IP Australia

# Nature of protection

Absolute

VS

Contextual, requirement for confusion



Australian Government

IP Australia

# Nature of protection

Lisbon :

Parties shall extend protection against:

- Usurpation
- Imitation
- Evocation

Interpretation and implementation problems



Australian Government

IP Australia

# 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





Australian Government

IP Australia

# 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?



Australian Government  
IP Australia

# Absolute protection – pitfalls

## Cases

### HOWLING WOLF





Australian Government  
IP Australia

# Absolute protection - pitfalls

Cases

## FEET FIRST





Australian Government  
IP Australia

# 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



Australian Government

IP Australia

# 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



Australian Government

IP Australia

# 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



Australian Government  

---

IP Australia

# Nature of protection

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





Australian Government  
IP Australia

# Thank you



Delivering a world leading IP system

Polymer  
Bank Notes