Seeking Protection Abroad: The Madrid and Lisbon Systems

Worldwide Symposium on Geographical Indications
Yangzhou, Jiangsu Province, June 29 to July 1, 2017

Alexandra Grazioli
Director, Lisbon Registry
Brands and Designs Sector, WIPO
Presentation

- Why seeking protection abroad?
- Why to use the Madrid System?
- Why to use the Lisbon System?
Experience shows that GI Protection Schemes may have...

**Positive economic effects**
- production, price
- profitability
- income distribution
- tourism

**Positive effects on jobs**
- direct & indirect jobs
- job qualification
- rural exodus

**Positive effects for preserving traditions**
- quality
- traditional know-how

**Positive effects for Environment**
- Biodiversity
- Environment preservation
- Landscape

---

*Images of GI logos and names: Guiping (Puer tea), Darjeeling tea, Kampot pepper, Phu Quoc 1890, Café de Colombia.*
How to get protection of your GIs abroad?
Variety of means to protect geographical indications

- **Sui generis legislation**

- Trademark system (collective/certification marks)

- Administrative systems (labelling, etc.)

- Legislation on unfair competition
How to get protection of GIs abroad?

- Direct applications in third countries
  *Individual application*

- Bilateral or Pluri-lateral Agreements
  *Under such agreements two or more States or trading partners agree to protect each other’s GIs (standard of protection + often GI-list)*

- Multilateral Agreements
  - TRIPS Agreement (WTO) *Protection of GIs*
  - Madrid Protocol/Agreement (WIPO) *Registration of CTM/Coll.TM*
  - Lisbon Agreement and Geneva Act (WIPO) *Protection and registration of AOs and GIs under the Geneva Act*
The Madrid System

- *Madrid Agreement Concerning the International Registration of Mark* (1891)
The Madrid System in a Nutshell…

- To facilitate the registration of trademarks at an international level

- To facilitate the management of trademarks after registration
The Madrid System in a Nutshell…

- One registration covering multiple territories
- Fixed time limit for refusal – 12 or 18 months
- WIPO examines only for formalities
- Expand protection to new export markets (subsequent designations)
- Centralized management of portfolio
How the Madrid System Works

The International Trademark Registration Process

Stage 1
- Applicant
- Basic application/registration “Basic Mark”
- Office of Origin
- Certifies the international application and forwards it to WIPO

Stage 2
- WIPO
- Formal examination; registers the mark in the International Register and publishes the International registration in the Gazette.
- Issues a certificate of registration and notifies the designated Contracting Parties

Stage 3
- Office of the designated Contracting Party
- Scope of protection of the international registration will be determined by substantive examination under domestic law, within 12-18 months
- Office of the designated Contracting Party
Members of the Madrid System

98 members* (including EU and OAPI) covering 114 countries

*All are party to the Protocol, the governing treaty, while 55 are also party to the Agreement
Madrid System and GIs
(CTM / Coll-TM)

- Rule 9(4)(x) of the Common Regulations expressly provides for registration of collective or certification marks
Example of Certification Marks protected under the Madrid System

NAPA VALLEY
# Madrid System: Key Figures (2016)

<table>
<thead>
<tr>
<th>Description</th>
<th>Number</th>
</tr>
</thead>
<tbody>
<tr>
<td>International registrations (2016)</td>
<td>44,726</td>
</tr>
<tr>
<td><strong>Active international registrations (2016)</strong></td>
<td>641,587</td>
</tr>
<tr>
<td><strong>Active collective or certification marks</strong> Under the Madrid System* (29.06.2017)</td>
<td>1,233</td>
</tr>
</tbody>
</table>

* Including but not limited to collective and certification marks identifying quality products linked to origin
Keep Updated on the Madrid System

- Visit the Madrid Website www.wipo.int/madrid/en

- Subscribe to Madrid Notices, our regular legal and news updates

- Sign up for Madrid Highlights
The Lisbon System

- *Lisbon Agreement for the Protection of Appellations of Origin and their International Registration* (1958)
The Lisbon Agreement in a Nutshell…

- Established to facilitate the international protection of appellations of origin (AOs) through a **single registration procedure** ("simple and accessible")

- Administered by WIPO, which keeps the **International Register of Appellations of Origin**
The Lisbon Agreement in a Nutshell...

- **Indefinite protection in all Contracting Parties**
  - exception: refusal, invalidation, enunciation of protection, and
  - as long as the AO is protected in the Contracting Party of Origin

- **High level protection** of the registered AOs in the other Lisbon countries
  (against any *usurpation* or *imitation*)

- Protection of registered AOs **against becoming generic** in the other Lisbon countries

- Provides standing for taking **legal action**
Application for an International Registration
(by Competent Authority of the Country of Origin)

Registration in the International Registry and Publication (WIPO)
&
Notification of the Registration to all Contracting Parties (WIPO)

Refusal of Protection (total/partial) (one year)

Withdrawal of Refusal (total/partial) or Notification of Protection

12 months

Notification of Grant of Protection (optional)

Transitional Period (2 years)

Invalidation or Renunciation
States Party to the Lisbon Agreement
(28 Contracting Parties)
### Lisbon Union: 28 Member States

**Europe (13)**
- Bosnia and Herzegovina
- Bulgaria
- Czech Rep.
- France
- Georgia
- Hungary
- Italy
- Moldova
- Montenegro
- Portugal
- Serbia
- Slovakia
- The FYR of Macedonia

**Asia (3)**
- Islamic Rep. of Iran
- Israel
- DPR of Korea

**Africa (6)**
- Algeria
- Burkina Faso
- Congo
- Gabon
- Togo
- Tunisia

**America (6)**
- Costa Rica
- Cuba
- Haiti
- Mexico
- Nicaragua
- Peru
### 1063 registrations – 958 in force

<table>
<thead>
<tr>
<th>Country</th>
<th>Registrations</th>
</tr>
</thead>
<tbody>
<tr>
<td>Algeria</td>
<td>7</td>
</tr>
<tr>
<td>Bulgaria</td>
<td>51</td>
</tr>
<tr>
<td>Costa Rica</td>
<td>1</td>
</tr>
<tr>
<td>Cuba</td>
<td>20</td>
</tr>
<tr>
<td>FYR of Macedonia</td>
<td>5</td>
</tr>
<tr>
<td>France</td>
<td>509</td>
</tr>
<tr>
<td>Georgia</td>
<td>28</td>
</tr>
<tr>
<td>Hungary</td>
<td>28</td>
</tr>
<tr>
<td>Iran (Islamic Rep.)</td>
<td>32</td>
</tr>
<tr>
<td>Israel</td>
<td>1</td>
</tr>
<tr>
<td><strong>Italy</strong></td>
<td><strong>143</strong></td>
</tr>
<tr>
<td>Mexico</td>
<td>15</td>
</tr>
<tr>
<td>Montenegro</td>
<td>2</td>
</tr>
<tr>
<td>Peru</td>
<td>8</td>
</tr>
<tr>
<td>Portugal</td>
<td>7</td>
</tr>
<tr>
<td>Rep. of Moldova</td>
<td>1</td>
</tr>
<tr>
<td>DPR of Korea</td>
<td>6</td>
</tr>
<tr>
<td><strong>Czech Rep.</strong></td>
<td><strong>76</strong></td>
</tr>
<tr>
<td>Serbia</td>
<td>3</td>
</tr>
<tr>
<td>Slovakia</td>
<td>8</td>
</tr>
<tr>
<td>Tunisia</td>
<td>7</td>
</tr>
</tbody>
</table>

(May, 2017)
Examples of Appellations of Origins (AO) in the Lisbon Registry

- **TEQUILA** (669 / Mexico)
- **CAFÉ VERACRUZ** (840 / Mexico)
- **BANANO DE COSTA RICA** (900 / Costa Rica)
- **PROSCIUTTO DI PARMA** (843 / Italy)
- **SAROUGH HANDMADE CARPET** (956 / Iran)
- **CHULUCANAS** (869 / Peru)
- **HEREND** (737 / Hungary)
Registered Appellations of Origin

The LISBON EXPRESS database

The AO Bulletin

The Bulletin “Appellations of origin” is the official publication of the Lisbon System. It is issued by WIPO for the publication of new registrations and other recordings in the International Register as well as information concerning changes in the legal framework of the Lisbon System. In addition, the Bulletin contains statistical information concerning registered appellations of origin.

More information on the Lisbon System:
www.wipo.int/lisbon/en/
Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications

- Adopted on May 20, 2015
- 54 signatories of the final Act (including China, Colombia, France, Italy, Mexico, Peru, Russian, Switzerland, Tunisia, OAPI, EU)
- 15 signatories (Bosnia and Herzegovina, Burkina Faso, Congo, Costa Rica, France, Gabon, Hungary, Italy, Mali, Nicaragua, Peru, Portugal, Republic of Moldova, Rumania, Togo)
- Will enter into force with five ratifications or accessions
Origin of the Revision

Improve the Lisbon System to make it more attractive for users and prospective new Members, while preserving the principles and objectives of the Lisbon Agreement.

(See LI/A/25/3, paragraph 19(i))
Variety of means to protect geographical indications

- Sui generis legislation
- Trademark system (collective/certification marks)
- Administrative systems (labelling, etc.)
- Legislation on unfair competition
The New Features of the Geneva Act

- Enhanced recognition of the different means of protection of AOs and GIs at national and regional level (*sui generis*, trademarks, etc.)

- Allow the accession of intergovernmental organizations that administer regional systems for the registration of GIs (*e.g.* EU, OAPI)

- Inclusion of geographical indications in the scope of protection (*TRIPS definition*)
The New Features of the Geneva Act

- **Flexibility** as to the **type of legislation** under which a Contracting Party protects registered AOs/GIs *(sui generis, trademarks, etc.)* (Art.10)

- **Direct filings** by “right holders” (Art.5)

- Possibility to request an **intention to use** *(declaration based requirement)* (Rule 5.4)

- New definition of the **scope of protection** (Art.11)
The New Features of the Geneva Act

- Opportunity for interested Parties to request the refusal of protection (Art. 15)

- Safeguards to:
  - prior trademarks rights (Art. 13.1)
  - personal names used in business (Art. 13.2)
  - plant variety or animal breed denominations (Art. 13.3) and
  - generic terms (agreed statements, Rule 5.5)
The Madrid and Lisbon Systems are also two complementary ways of protection for origin products brands.
Lisbon - Madrid: Complementary protection

**Lisbon Registration**
- LIS - 1059 CHIANTI CLASSICO
- LIS - 459 ROQUEFORT

**Madrid Registration**
- MM - 902976 Coll-TM (logo)
- MM - 877636 Col-TM
- MM - 477479 Coll-TM (logo)
Concluding Remarks

- Valuable intellectual property rights
  - multifunctional
- Means for product differentiation and identification
- Need for
  - active marketing and promotion
  - positive protection nationally and abroad in accordance with existing mechanisms and specific needs and requirements of all stakeholders

⇒ MADRID & LISBON SYSTEMS
Thank you!

alexandra.grazioli@wipo.int