

## **Special Union for the Protection of Appellations of Origin and their International Registration (Lisbon Union)**

### **Assembly**

**Twenty-Seventh (19<sup>th</sup> Ordinary) Session**  
**Geneva, September 26 to October 5, 2011**

### **PROPOSED AMENDMENTS TO THE REGULATIONS UNDER THE LISBON AGREEMENT**

*Document prepared by the International Bureau*

#### **I. INTRODUCTION**

1. At its third session (May 23 to 27, 2011), the Working Group on the Development of the Lisbon System (hereinafter referred to as “the Working Group”) agreed to recommend that the Assembly of the Lisbon Union amend the Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (hereinafter referred to as “the Regulations”) (document LI/WG/DEV/3/3, paragraph 13).
2. The purpose of the present document is to submit the amendments referred to above for adoption by the Assembly.
3. It is proposed that, if adopted, the amendments would take effect on January 1, 2012.
4. The proposed amendments, which aim at serving transparency, are reflected in the Annex to the present document and explained below.

## II. NOTES ON THE PROPOSED AMENDMENTS

### Proposed Amendment to Rule 5(3) on Optional Contents of the International Application

5. Rule 5(3) of the Regulations specifies particulars that international applications may contain or indicate, next to the mandatory contents of international applications stipulated in Rule 5(2). The Working Group agreed at its third session that further optional elements should be allowed. In particular, the application form should allow the country of origin the option to indicate factual information that had permitted the grant of protection in respect of the appellation of origin in question, notably particulars that had helped in ascertaining that definition requirements were met and that the link between the product in question and a precise geographical area had been established. Such factual information would be helpful for competent Authorities of other member States to better understand the merits or legitimacy of the protection granted. Moreover, it would allow the public and possibly affected traders and trademark holders to be informed properly of the particulars on which protection of the appellation of origin in question is based.

6. It is, therefore, proposed that Rule 5(3) of the Lisbon Regulations be amended by the addition of an item (vi), as shown in the Annex to the present document.

### Proposed Amendment to Rule 16(1) on Notifications of Invalidation

7. Rule 16(1) of the Regulations lists the mandatory requirements for the contents of notifications of invalidation. The Working Group agreed at its third session that an additional requirement should be added. As a result of the requirement in Rule 16(1) that a copy of the decision to invalidate the effects of an international registration be contained in the notification of invalidation, the ground(s) on which such a decision was based will only be available in the language of the notifying country. It would serve transparency if the notifying country would indicate the ground(s) in the notification, so that the ground(s) would be recorded in the International Register in the three working languages of the Lisbon system.

8. It is, therefore, proposed that Rule 16(1) of the Lisbon Regulations be amended by the addition of a new item (v) and the transformation of the current item (v) into a new item (vi), as shown in the Annex to the present document.

9. *The Assembly of the Lisbon Union is invited to adopt the proposed amendments to Rules 5(3) and 16(1), as set out in the Annex hereto, with effect from January 1, 2012.*

[Annex follows]

PROPOSED AMENDMENTS TO THE REGULATIONS

*Rule 5*  
*Requirements Concerning the International Application*

[...]

(3) [*Optional Contents of the International Application*] The international application may indicate or contain:

(i) the addresses of the holders of the right to use the appellation of origin;  
(ii) one or more translations of the appellation of origin, in as many languages as the competent authority of the country of origin wishes;

(iii) a statement to the effect that protection is not claimed for certain elements of the appellation of origin;

(iv) a declaration that protection is renounced in one or more contracting countries, designated by name;

(v) a copy in the original language of the provisions, decisions or registration referred to in paragraph (2)(a)(vi);

**(vi) any further information the competent authority of the country of origin wishes to provide concerning the protection granted to the appellation of origin in that country, such as additional particulars of the area of production of the product and a description of the connection between the quality or characteristics of the product and its geographical environment.**

*Rule 16*  
*Invalidation*

(1) [*Notification of Invalidation to the International Bureau*] Where the effects of an international registration are invalidated in a contracting country and the invalidation is no longer subject to appeal, the invalidation shall be notified to the International Bureau by the competent authority of that contracting country. The notification shall indicate or contain:

(i) the number of the international registration concerned, preferably accompanied by other information enabling the identity of the international registration to be confirmed, such as the name of the appellation of origin;

(ii) the authority that pronounced the invalidation;

(iii) the date on which the invalidation was pronounced;

(iv) where the invalidation concerns certain elements only of the appellation of origin, the elements concerned;

**(v) the grounds on the basis of which the invalidation was pronounced;**

**(vi) a copy of the decision that invalidated the effects of the international registration.**

[End of Annex and of document]