

Working Group on the Development of the Lisbon System (Appellations of Origin)

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NOTES ON THE DRAFT REGULATIONS UNDER THE DRAFT NEW INSTRUMENT

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The present document contains Notes on the Draft Regulations under the Draft New Instrument on the International Registration of Geographical Indications and Appellations of Origin (“Draft Regulations”), the text of which is contained in document LI/WG/DEV/5/3. Where a provision appears not to require explanation, no note has been provided.

[Annex follows]

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TABLE OF CONTENTS

List of Rules

Chapter I: Introductory and General Provisions

Notes on Rule 1:	Abbreviated Expressions
Notes on Rule 2:	Calculation of Time Limits
Notes on Rule 3:	Working Languages
Notes on Rule 4:	Competent Authority

Chapter II: Application and International Registration

Notes on Rule 5:	Requirements Concerning the Application
Notes on Rule 6:	Irregular Applications
Notes on Rule 7:	Entry of the Geographical Indication or Appellation of Origin in the International Register
Notes on Rule 8:	Fees

Chapter III: Refusal and Other Actions in Respect of International Registration

Notes on Rule 9:	Refusal
Notes on Rule 10:	Irregular Notification of Refusal
Notes on Rule 11:	Withdrawal of Refusal
Notes on Rule 12:	Notification of Grant of Protection
Notes on Rule 13:	Notification of Invalidation of the Effects of an International Registration in a Contracting Party
Notes on Rule 14:	Notification of Transitional Period Granted to Third Parties
Notes on Rule 15:	Modifications
Notes on Rule 16:	Renunciation of Protection
Notes on Rule 17:	Cancellation of an International Registration
Notes on Rule 18:	Corrections Made to the International Register

Chapter IV: Miscellaneous Provisions

Notes on Rule 19:	Publication
Notes on Rule 20:	Extracts From the International Register and Other Information Provided by the International Bureau
Notes on Rule 21:	Signature
Notes on Rule 22:	Date of Dispatch of Various Communications
Notes on Rule 23:	Modes of Notification by the International Bureau
Notes on Rule 24:	Administrative Instructions
Notes on Rule 25:	Entry Into Force

NOTES ON RULE 1: ABBREVIATED EXPRESSIONS

1.01 Rule 1 follows the model of Rule 1 of the Regulations under the Singapore Treaty on the Law of Trademarks of 2006. On substance, the provision is based on Rule 1 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

NOTES ON RULE 2: CALCULATION OF TIME LIMITS

2.01 The provisions of this rule are based on those contained in Rule 2 of the Lisbon Regulations.

NOTES ON RULE 3: WORKING LANGUAGES

3.01 The provisions of this rule largely reproduce those contained in Rule 3 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

NOTES ON RULE 4: COMPETENT AUTHORITY

4.01 This rule is drafted in accordance with the practice that has developed under Rule 4 of the Lisbon Regulations.

4.02 As regards the responsibilities of Competent Authorities, reference is made to Article 3 of the Draft New Instrument. In addition, Rule 4(1) makes clear that the name and contact details of the Competent Authority must be notified at the time of accession.

4.03 Paragraph (2) should be seen in light of the fact that, unlike in other areas of industrial property, there may be more than one authority in a Contracting Party that is responsible for the grant of protection in respect of geographical indications and/or appellations of origin.

4.04 Paragraph (3) has been drafted in recognition of the practical experience of the International Bureau with regard to changes of the name or of the contact details of a Competent Authority.

NOTES ON RULE 5: REQUIREMENTS CONCERNING THE APPLICATION

5.01 Paragraph (1) corresponds to Rule 5(1) of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

5.02 The provisions of paragraphs (2) to (5) correspond to those of paragraphs(2) and (3) of Rule 5 of the Lisbon Regulations, as adapted in accordance with the provisions of Article 7 of the Draft New Instrument.

5.03 The provisions of sub-paragraphs (3)(vi) and (5)(vi) correspond to those of Rule 5(3)(vi) of the Lisbon Regulations, which was adopted by the Lisbon Union Assembly in September 2011 and entered into force on January 1, 2012.

5.04 Reference is made to Notes 7.02 and 8.03 on Articles 7(1)(a)(ii) and 8(5) of the Draft New Instrument, as contained in document LI/WG/DEV/5/4.

NOTES ON RULE 6: IRREGULAR APPLICATIONS

6.01 The provisions of this rule largely reproduce those contained in Rule 6 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

NOTES ON RULE 7: ENTRY OF THE GEOGRAPHICAL INDICATION OR APPELLATION OF ORIGIN IN THE INTERNATIONAL REGISTER

7.01 Paragraph (1) is modeled on Rule 7(1) of the Lisbon Regulations. However, for the reasons explained in Note 5.02 to the Draft New Instrument, as contained in document LI/WG/DEV/5/4, the same indication may be protected by some Contracting Parties as a geographical indication and in other Contracting Parties as an appellation of origin. It would be preferable for the International Register to reflect the indication in both Part A and Part B of the International Register, if only for reasons of transparency. In addition, it is proposed that the International Register should reflect in respect of which Contracting Party the registration of the indication in Part A applies and in respect of which other Contracting Parties the registration in Part B applies. Also, as long as not all States party to the Lisbon Agreement have joined the new instrument (see Note 7.04), Part B should reflect for which States a registration is governed by the Lisbon Agreement.

7.02 The provisions of paragraphs (2) and (3) of this rule largely reproduce those contained in Rule 7 of the Lisbon Regulations with regard to the contents of registrations, the registration certificate and the notification of new registrations, as adapted in accordance with the provisions of the Draft New Instrument.

7.03 A new paragraph (4) was added though, to address the situation concerning international registrations of appellations of origin already recorded under the Lisbon Agreement, once the mutual relations between two States become governed by the provisions of Article 30(1) of the Draft New Instrument.

7.04 As reflected in Article 4 of the Draft New Instrument, it is suggested that the International Bureau record the appellations of origin recorded under the Lisbon Agreement also under the New Instrument, in consultation with the Competent Authority concerned. It should be noted that, as long as not all States that are party to the Lisbon Agreement have become party to the New Instrument, depending on the nature of the New Instrument, either two international registration systems will apply or one system based on two treaties. In drafting paragraph (4), the International Bureau has attempted not to prejudge the question whether the New Instrument would be an Act revising the Lisbon Agreement, a Protocol supplementing the Lisbon Agreement or a new Treaty.

NOTES ON RULE 8: FEES

8.01 The provisions of this rule reproduce those contained in Rule 23 of the Lisbon Regulations.

8.02 In accordance with the provisions of Chapter II of the Draft New Instrument, the provisions are proposed to be put in the corresponding Chapter of these Draft Regulations.

NOTES ON RULE 9: REFUSAL

9.01 The provisions of this rule reproduce those contained in Rule 9 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

9.02 As reflected in the Draft Report of the fourth session of the Working Group (document LI/WG/DEV/4/7 Prov., paragraph 199, the Chair concluded from the discussion on Article 18 of the previous version of the Draft New Instrument (document LI/WG/DEV/4/2), that the time limit for the notification of refusals should be presented in the Draft Regulations. In this regard, reference is made to Articles 15(1) and 28(4) of the Draft New Instrument as well as the Notes on those provisions (Notes 15.03 and 28.02).

9.03 Further, a new subparagraph (Rule 9(2)(iv)) is proposed, aimed to address the specific situation of international registrations refused in part by a Contracting Party because of the possible coexistence under the legislation of such Contracting Party with a prior right, notably a homonymous geographical indication or appellation of origin. By way of example, reference is made in this regard to paragraph 135 of the Draft Report of the fourth session of the Working Group (document LI/WG/DEV/4/7 Prov.).

NOTES ON RULE 10: IRREGULAR NOTIFICATION OF REFUSAL

10.01 The provisions of this rule reproduce those contained in Rule 10 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

NOTES ON RULE 11: WITHDRAWAL OF REFUSAL

11.01 The provisions of this rule reproduce those contained in Rule 11 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

11.02 Compared to the provisions of Rule 11 of the Lisbon Regulations, a new subparagraph is proposed, requiring the reason for the withdrawal to be mentioned in the statement, in particular in case of partial withdrawals corresponding to partial refusals, as referred to in Rule 9(2)(iv) of these Draft Regulations.

NOTES ON RULE 12: NOTIFICATION OF GRANT OF PROTECTION

12.01 The provisions of this rule reproduce those contained in Rule 11*bis* of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

12.02 Compared to the provisions of Rule 11*bis* of the Lisbon Regulations, a new subparagraph is proposed, requiring the reason for the withdrawal to be mentioned in the statement, in particular in case of partial statements of grant of protection corresponding to partial refusals, as referred to in Rule 9(2)(iv) of these Draft Regulations.

NOTES ON RULE 13: NOTIFICATION OF INVALIDATION OF THE EFFECTS OF AN INTERNATIONAL REGISTRATION IN A CONTRACTING PARTY

13.01 The provisions of this rule reproduce those contained in Rule 16 of the Lisbon Regulations, including the amendment adopted by the Assembly in September 2011, as adapted in accordance with the provisions of the Draft New Instrument.

13.02 Compared to the provisions of Rule 16 of the Lisbon Regulations, it is proposed to mirror in subparagraph (iv) not only the situations covered by Rule 9(2)(v) of these Draft Regulations, but also the specific case of homonymous geographical indications and appellations of origin, as covered by Rule 9(2)(iv).

NOTES ON RULE 14: NOTIFICATION OF TRANSITIONAL PERIOD GRANTED TO THIRD PARTIES

14.01 The provisions of this rule reproduce those contained in Rule 12 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

14.02 In view of paragraph 18 of the Summary by the Chair of the fourth session of the Working Group (document LI/WG/DEV/4/6), the possible length of the time limits for terminating prior use has been put in square brackets.

NOTES ON RULE 15: MODIFICATIONS

15.01 The provisions of this rule reproduce those contained in Rule 13 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

NOTES ON RULE 16: RENUNCIATION OF PROTECTION

16.01 The provisions of this rule reproduce those contained in Rule 14 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

NOTES ON RULE 17: CANCELLATION OF AN INTERNATIONAL REGISTRATION

17.01 The provisions of this rule reproduce those contained in Rule 15 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

NOTES ON RULE 18: CORRECTIONS MADE TO THE INTERNATIONAL REGISTER

18.01 The provisions of this rule reproduce those contained in Rule 17 of the Lisbon Regulations, as adapted in accordance with the provisions of the Draft New Instrument.

NOTES ON RULE 19: PUBLICATION

19.01 This rule largely reproduces Rule 18 of the Lisbon Regulations. However, as publication may, in the future, take place on the WIPO web site, the reference to the Bulletin has not been retained.

NOTES ON RULE 20: EXTRACTS FROM THE INTERNATIONAL REGISTER AND OTHER INFORMATION PROVIDED BY THE INTERNATIONAL BUREAU

20.01 The provisions of this rule reproduce those contained in Rule 19 of the Lisbon Regulations.

NOTES ON RULE 21: SIGNATURE

21.01 This rule reproduces Rule 20 of the Lisbon Regulations.

NOTES ON RULE 22: DATE OF DISPATCH OF VARIOUS COMMUNICATIONS

22.01 The provisions of this rule largely reproduce those contained in Rule 21 of the Lisbon Regulations. As regards the additional phrase referring to the Administrative Instructions, reference is made to Section 9 of the Administrative Instructions for the Application of the Lisbon Agreement.

NOTES ON RULE 23: MODES OF NOTIFICATION BY THE INTERNATIONAL BUREAU

23.01 The provisions of this rule reproduce those contained in Rule 22 of the Lisbon Regulations.

NOTES ON RULE 24: ADMINISTRATIVE INSTRUCTIONS

24.01 The provisions of this rule largely reproduce those contained in Rule 23*bis* of the Lisbon Regulations. However, the reference to the Bulletin has not been retained, for the reason mentioned in Note 19.01.

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