

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

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Study on the Relationship Between Regional Systems for the Protection of Geographical Indications and the Lisbon System; and on the Conditions for Accession to the Lisbon Agreement by Intergovernmental Organizations

prepared by the Secretariat

1. At its first session, which took place in Geneva from March 17 to 20, 2009, the Working Group on the Development of the Lisbon System (Appellations of Origin) (hereinafter referred to as “the Working Group”) requested the International Bureau of the World Intellectual Property Organization (WIPO), *inter alia*, to conduct a study on the relationship between regional systems for the protection of geographical indications and the Lisbon system, and examine the conditions for, and possibility of, future accession to the Lisbon Agreement by competent intergovernmental organizations. At its twenty-fifth (18th extraordinary) session, the Assembly of the Lisbon Union, when renewing the mandate of the Working Group, took note of this initiative, as reflected in document LI/A/25/3.
2. The Annex to the present document reflects the results of this study by the International Bureau and does so, in accordance with the request for the study, in two parts. The first part (Part A) focuses on questions concerning the actual application of the Lisbon system as it functions today in those of its member States where regional systems for the protection of geographical indications and/or appellations of origin apply*.

* Questions of this kind have also been raised in the context of the survey on the Lisbon system, as reflected in document LI/WG/DEV/2/2.

The second part (Part B) concerns the possible introduction of provisions into the Lisbon Agreement that would allow for the accession by intergovernmental organizations that administer a regional system for the protection of geographical indications and/or appellations of origin and focuses on substantive and formal requirements in that respect. Where the available documentation did not provide all necessary information, the International Bureau has consulted the intergovernmental organizations administering the regional systems addressed in the study.

3. *Working Group is invited to:*

(i) *take note of the results of the study as contained in the Annex to the present document; and*

(ii) *decide on any follow-up action that the Working Group may deem appropriate.*

[Annex follows]

A. THE RELATIONSHIP BETWEEN REGIONAL SYSTEMS FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS AND/OR APPELLATIONS OF ORIGIN AND THE LISBON SYSTEM

I. INTRODUCTION

1. A number of member States of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (hereinafter referred to as “Lisbon Agreement”) are also members of a regional system for the protection of geographical indications and/or appellations of origin. In this regard, questions were raised, at the first session of the Working Group on the Development of the Lisbon System (hereinafter referred to as “Working Group”), as to the relationship between these regional systems for the protection of geographical indications and the Lisbon system, not only in relation to the conditions for, and possibility of, future accession to the Lisbon Agreement by competent intergovernmental organizations, but also independently from such conditions and possibility.
2. Consequently, Part A of this study focuses on questions concerning the actual application of the Lisbon system as it functions today in those of its member States where regional systems for the protection of geographical indications and/or appellations of origin apply. There are three such regional systems which have Lisbon member States among their members, namely the African Intellectual Property Organization (OAPI)¹, the Andean Community² and the European Union (EU)³. OAPI has 16 member States, of which four are party to the Lisbon Agreement: Burkina Faso, Congo, Gabon and Togo. The Andean Community has four member States, of which one is party to the Lisbon Agreement: Peru. The EU has 27 member States, of which seven are party to the Lisbon Agreement: Bulgaria, Czech Republic, France, Hungary, Italy, Portugal and Slovakia.

II. APPLICATION OF THE LISBON SYSTEM IN LISBON MEMBER STATES WHERE A REGIONAL SYSTEM FOR THE PROTECTION OF GEOGRAPHICAL INDICATIONS AND/OR APPELLATIONS OF ORIGIN APPLIES

(i) Andean Community: Domestic Registration in its Member States on the Basis of Common Legislation

3. In effect, an independent or central regional registration office does not exist under the Andean Community regional system; instead the registration procedure (verification of the fulfillment of requirements both under Decision 486 of the Andean Community and under the domestic legislation) is undertaken by the competent national Office of each Andean Community member State.

¹ The member States of OAPI are: Benin, Burkina Faso, Cameroon, Central African Republic, Chad, Congo, Côte d'Ivoire, Equatorial Guinea, Gabon, Guinea, Guinea Bissau, Mali, Mauritania, Niger, Senegal and Togo.

² The member States of the Andean Community are: Bolivia, Colombia, Ecuador and Peru.

³ The member States of the EU are: Austria, Belgium, Bulgaria, the Czech Republic, Cyprus, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the United Kingdom.

Procedure for the Registration of Appellations of Origin

4. As far as the applicable procedure for the acquisition of rights is concerned, an appellation of origin has to be declared protected by the competent national authority of the relevant member State. In practice, Decision 486 provides for a system under which an appellation of origin comes into being by virtue of a “declaration of protection”, which is made by the State, acting through its competent national Office. The declaration of protection may be made either *ex officio* or at the request of a party demonstrating a legitimate interest⁴.

Recognition of Other Andean Community Member States’ Appellations of Origin

5. Once a given appellation of origin is protected in its country of origin, protection may be accorded to that appellation in the other member States upon a request to that effect formulated by interested parties or the relevant public authority.

Decision 486 of the Andean Community:

“Article 218: Competent national offices shall, where the petition is made by producers, extractors, manufacturers, or craftsmen with a legitimate interest in the matter or the respective public authorities, recognize appellations of origin protected in another Member Country.

“Appellations of origin, in order to be eligible for such protection, must have been declared as such in their countries of origin.”

Recognition of Third Countries’ Geographical Indications or Appellations of Origin

“Article 219: Competent national offices shall recognize the protection accorded by third countries to appellations of origin or geographical indications, provided that an agreement to which the member country in question is a part so specifies. To be eligible for such protection, those appellations of origin must have been declared as protected in their countries of origin.”

Application of the Lisbon Agreement in Peru (the Only Andean Community Member State Party to the Lisbon Agreement)

Filing International Applications and Requests for Modification

6. Upon examining the four existing Peruvian registrations under the Lisbon system, it appears that in all cases except for one (“*Pallar de Ica*”), Peru has filed international applications under the Lisbon system for the Protection of Appellations of Origin and their International Registration with reference to its national law and not to the Andean Community legislation (Decision 486). For example, this was done in respect of “*Pisco*” (alcoholic beverage) from Peru (2005); “*Maiz Blanco Gigante Cusco*” (Giant White Maize) from Peru (2006); “*Chulucanas*” (ceramics) from Peru (2006); whereas “*Pallar de Ica*” (bean) from Peru (2008) has been registered with reference to both Decision 486 and Peruvian national law.

⁴ Article 203 of the Andean Community Decision No.486.

7. In any case, Peru has not submitted a formal request, under Rule 13 of the Lisbon Regulations, for modification of the international registrations for its appellations of origin on the ground that the legal basis for their protection in Peru had changed. This may suggest that Peru is of the view that Decision 486 and national legislation supplement each other. Both systems coexist as long as they are not in contradiction with one another. In this sense, both Decision 486 and Peruvian national legislation could be regarded as the legal basis for protection.

Notifying Declarations of Refusal and Related Notifications

8. To the present date, Peru has notified 16 declarations of refusal under the procedures of the Lisbon system. Eight of these refusals were based on the existence of prior trademark rights in Peru preventing Peru from securing protection for the internationally registered appellations of origin in question, with reference to Decision 486. In the eight other cases, declarations of refusal were notified by Peru on the basis of decisions from the Peruvian Intellectual Property Office (*Instituto Nacional de Defensa de la Competencia y de la Protección de la Propiedad Intelectual* (INDECOPI)) that the appellations of origin in question were perceived by Peruvian consumers in general as generic designations for products such as those in respect of which they were registered under the Lisbon system, which prevented Peru from securing their protection. In these cases, reference was made to Decision 486 and complementary norms. However, these latter eight refusals were subsequently withdrawn by Peru.

(ii) OAPI: Regional Registration on the Basis of Unified Legislation

9. The sub-regional legal and regulatory framework established under the Revised Bangui Agreement⁵ enables products of a designated origin to be officially recognized with immediate effect across all the OAPI member States.

Procedure for the Registration of Geographical Indications

10. In order to be protected, the geographical indications must be registered by OAPI or are to be treated as having been registered with OAPI by virtue of an international convention to which the member States are party. If the requirements for registration of geographical indications are fulfilled, the geographical name is entered in a special register of geographical indications administered by OAPI. The same procedures apply in respect of geographical indications of foreign countries. Special provisions apply in respect of appellations of origin registered under the Lisbon Agreement.

“Article 12 (of the Revised Bangui Agreement):

“Registration and Publication of Geographical Indications, and the Effects Thereof

“(1) The Organization shall undertake the examination, registration and publication of geographical indications according to the common procedure provided for in this Agreement and its Annex VI.

“(2) In each of the member States, registered and published geographical indications shall produce their effects in accordance with the provisions of this Agreement and its Annex VI, subject to the provisions of paragraph (3) below.

⁵ Agreement of February 24, 1999 Revising the Bangui Agreement of March 2, 1977 on the Creation of an African Intellectual Property Organization (Bangui, Central African Republic). Annex VI of the Agreement deals with geographical indications (see Appendix III to the Annex to the present document).

“(3) The international registration of a geographical indication effected under the provisions of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and having effect in at least one Member State shall produce the same effects in each of the States party to this Agreement and to the Lisbon Agreement as if the geographical indication had been registered with the Organization.”

“Article 30 (of the Revised Bangui Agreement):
“Implementation of the Lisbon Agreement

“In addition to the functions provided for in Article 29 of this Agreement and, where appropriate, according to the provisions of Article 28 above, the members of the Administrative Council representing States party to this Agreement and to the Patent Cooperation Treaty, the Trademark Registration Treaty, the Hague Agreement Concerning the International Deposit of Industrial Designs, the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, the International Convention for the Protection of New Varieties of Plants or the Budapest Treaty on the International Recognition of the Deposit of Microorganisms for the Purposes of Patent Procedure shall, where necessary, draw up the appropriate regulations deriving from the implementation of the said six Treaties or Agreements with a view to their application on their respective national territories.”

“Article 3 (of the Revised Bangui Agreement):
“Acquisition of Rights by Foreigners

“Foreigners shall enjoy the benefits of this Annex if they fulfill the conditions imposed by it.”

“Article 4 (of the Revised Bangui Agreement):
“Conditions for Protection

“(1) Geographical indications shall be protected as such if they have been registered by the Organization or are to be treated as having been registered by virtue of an international convention to which the Member States are party.

“(2) Geographical indications foreign to the territories of the member States of the Organization may be registered by the Organization only where provided for in an international convention to which the member States are party or in the enforcing legislation.”

11. As reflected on the OAPI Internet website, only “*Champagne*” has been registered in OAPI and is therefore protected on the territory of the 16 countries that are members of OAPI⁶.
12. It should be noted that the appellation of origin “*Champagne*” is already under protection in Burkina Faso, Congo, Gabon and Togo, by virtue of the Lisbon Agreement, as a result of their accession to the Agreement in 1975 (Burkina Faso, Congo and Gabon) and 1977 (Togo), respectively⁷.

⁶ http://www.oapi.wipo.net/fr/OAPI/actualites/indication_geo_champagne.htm.

⁷ The Lisbon Agreement entered into force in Burkina Faso on September 2 1975; in Congo on November 16, 1977; in Gabon on June 10, 1975; and in Togo on April 30, 1975. “*Champagne*” was registered under the Lisbon Agreement on December 20, 1967.

13. Article 30 of the Revised Bangui Agreement has not been followed up by the adoption of specific implementing regulations in respect of the Lisbon Agreement.

Application of the Lisbon Agreement in Burkina Faso, Congo, Gabon and Togo (the four OAPI Member States Party to the Lisbon Agreement)

Filing International Applications and Requests for Modification

14. Since the adoption of common legislation for the protection of geographical indications in OAPI member States, and in the absence of national legislation in the area of geographical indications, any international application under the Lisbon system should be filed by the OAPI member State that is party to the Lisbon Agreement and country of origin for the appellation of origin in question, on the basis of a prior registration of that appellation of origin with OAPI following the common OAPI legislation⁸ for geographical indications.
15. To the present date, no registrations have been recorded under the Lisbon system in respect of any of the four OAPI member States that are party to the Lisbon Agreement.

Notifying Declarations of Refusal and Related Notifications

16. Similarly, the four OAPI member States that are party to the Lisbon Agreement should base themselves on the OAPI common legislation in order to notify declarations of refusal or related notifications under the Lisbon system. In view of the relevant provisions of Annex VI of the Revised Bangui Agreement⁹, declarations of refusal could be based on the ground that the appellation of origin in question does not meet the definition; or on the ground that the appellation of origin is contrary to morality or public policy; or on the ground that the appellation of origin is liable to deceive the public as to the nature, the source, the manufacturing process, the characteristic qualities or the suitability for their purpose of the goods concerned; or on the ground that the appellation of origin is not registered in the name of those that are entitled to file for its registration; or on the ground that the appellation of origin conflicts with a prior right. A question that arises in this regard is what effect a refusal by such an OAPI member State would have in the other three OAPI member States, as Article 12(3) of the Revised Bangui Agreement lays down that an international registration under the Lisbon Agreement “shall produce the same effects in each of the States [in question], as if the geographical indication had been registered with [OAPI]”.
17. As mentioned above, international registrations for appellations of origin under the Lisbon system have the same effect as OAPI registrations for geographical indications, albeit only in those OAPI member States that are party to the Lisbon Agreement. However, none of the four member States in question has identified OAPI as their competent authority for the submission of declarations of refusal or related notifications – nor for the presentation of international applications or other notifications, for that matter. Each of these OAPI member States has identified a national body for these purposes¹⁰.

⁸ Initially, the *Uniform Law on Appellations of Origin*, added, in 1969, as an Annex to the Libreville Agreement of September 13, 1962, by virtue of the Convention of January 10, 1969. Subsequently, the Annex on Appellations of Origin of the Bangui Agreement of March 2, 1977. Currently, the Annex on Geographical Indications of the Revised Bangui Agreement of February 24, 1999.

⁹ Annex VI of the Revised Bangui Agreement is reproduced in Appendix III to the Annex to the present document.

¹⁰ Burkina Faso: National Directorate of Industrial Property, Ministry of Trade, Promotion of Companies and Handicraft; Congo: Permanent Mission of the Republic of Congo to the United Nations and other International Organizations in Geneva; Gabon: Center of Industrial Property of

18. To date, none of the competent authorities of these countries, as identified in accordance with Rule 4 of the Lisbon Regulations, has submitted any declaration of refusal or related notification under the procedures of the Lisbon system. As a consequence, all 818 Lisbon registrations that are currently in force are protected in the four OAPI member States that are party to the Lisbon Agreement, albeit some still subject to the one-year time-limit for refusal under Article 5(3) of the Agreement.

(iii) European Union

19. The previous sections address the application of the Lisbon Agreement in a regional system in which the protection of geographical indications/appellations of origin is governed by common legislation for the member States of a regional organization, but has to be effected either (1) by registration in each of these member States separately (Andean Community), or (2) by registration with the regional organization itself (OAPI). In the first instance, the application of the Lisbon Agreement in a Lisbon member State that is also a member State of the regional organization (in this case, Peru) is not different from the application of the Agreement in a country that is not party to such a regional organization. In the second situation, the application of the Lisbon Agreement in member States of the regional organization that are party to the Lisbon Agreement (in this case, Burkina Faso, Congo, Gabon and Togo) is expressly provided for, as an exception to registration with the regional organization itself, to the effect that Lisbon registrations have the same effect in those four OAPI member States as OAPI registrations.
20. At first sight, the current situation in the EU would appear to be comparable to the situation in OAPI (i.e. to the extent that the EU has established common legislation for its member States). Protection at the regional level in the EU, however, is subject to different specific regimes for certain specific categories of products, while geographical indications and appellations of origin for products not covered by any of these specific regimes only benefit from certain general regimes, concerning certain misleading and other unfair business practices, as established under EU legislation and to be implemented by its member States. Unlike in OAPI, under the Revised Bangui Agreement, however, the EU legislation establishing the different specific regimes referred to above does not contain provisions governing the application of international registrations effected under the Lisbon Agreement in those member States of the EU that are party to the Lisbon Agreement.

Application of the Lisbon Agreement in Those EU Member States Which Are Party to the Lisbon Agreement

Filing International Applications and Requests for Modification

21. EU member States that are party to the Lisbon Agreement continue to file international applications under the Lisbon system for appellations of origin protected on the basis of national laws and not on the basis of their protection under EU legislation. Most recently, this was done in respect of “*Prosciutto di Parma*” (ham) from Italy (2001); “*Prosciutto di San Daniele*” (ham) from Italy (2004); “*Douro*” (wine) from Portugal (2007); “*Barbaresco*” (wine) from Italy (2009); “*Barolo*” (wine) from Italy (2009); and “*Brunello di Montalcino*” (wine) from Italy (2009).

[Footnote continued from previous page]

Gabon; Togo: National Institute for Industrial Property and Technology (INPIT), Ministry of Trade, Industry, Transport and Development of the Free Zone.

22. Moreover, none of these EU member States has submitted a request, under Rule 13 of the Lisbon Regulations, for modification of the international registrations for their appellations of origin on the ground that the legal basis for their protection in the country of origin had changed. Although they may still do so, this may also suggest that the EU member States in question are of the view that, even though many of the appellations of origin in question have since been registered under EU Regulations, their initial legal basis for protection as an appellation of origin – i.e., under the domestic law of the EU member State in question – has not changed.

Notifying Declarations of Refusal and Related Notifications

23. Similarly, the EU member States in question continue to notify refusals under the Lisbon system on the basis of their domestic law. Most recently, this was done by Slovakia, in 2007, in respect of the appellation of origin “*Devin natural mineral water*”, which has Bulgaria as its country of origin and was recorded in the International Register in 2006¹¹; by Hungary, in August 2004, in respect of the appellation of origin “*Soto*” (alcoholic beverage), which has Mexico as its country of origin and was recorded in the International Register in 2003¹²; by Portugal, in 2004, in respect of the appellation of origin “*Café Veracruz*” (coffee), which has Mexico as its country of origin.
24. However, this has been different in the case of the appellation of origin “*Pisco*” from Peru. Prior to the international registration of this appellation of origin under the Lisbon system, in 2005, the EU had concluded an association agreement with Chile¹³ – which is not a Lisbon member State – requiring the EU to protect the appellation of origin “*Pisco*” for products originating in Chile. The agreement in question, however, also specified Peru’s entitlement to possible future rights in the EU for similar protection of its appellation of origin “*Pisco*” for products originating in Peru. The question thus arose as to what would be the most appropriate action for the seven EU member States that are party to the Lisbon Agreement – Bulgaria, Czech Republic, France, Hungary, Italy, Portugal and Slovakia – to take in reaction to the Lisbon registration for “*Pisco*” by Peru.
25. As explained by the International Bureau during the first session of the Working Group on the Development of the Lisbon System¹⁴, consultations were held in the context of the EU, and advice sought from WIPO on certain procedural aspects of the Lisbon system, after which the EU member States in question all notified declarations recognizing Peru’s rights under Lisbon with regard to “*Pisco*”, with one exception: Peru would not be entitled in these countries to stop the use of the denomination “*Pisco*” in respect of products originating in Chile and protected as an appellation of origin in conformity with the free trade agreement concluded by the EU with Chile.

Notes in Relation to the Previous Subsection

26. As regards the application of EU law, it is important to note the following:
- (a) Article 307 of the Treaty establishing the European Community reads as follows:
- “The rights and obligations arising from agreements concluded before 1 January 1958 or, for acceding States, before the date of their accession, between one or more Member States on the one hand, and one or more third countries on the other, shall not be affected by the provisions of this Treaty.

¹¹ Bulgaria acceded to the EU in January 2007.

¹² Hungary acceded to the EU in May 2004.

¹³ Agreement of 18 November 2002 establishing an Association between the European Communities and its member States, of the one part, and the Republic of Chile, of the other part.

¹⁴ The first session of the Working Group took place from March 17 to 20, 2009.

“To the extent that such agreements are not compatible with this Treaty, the Member State or States concerned shall take all appropriate steps to eliminate the incompatibilities established. Member States shall, where necessary, assist each other to this end and shall, where appropriate, adopt a common attitude.

“In applying the agreements referred to in the first paragraph, Member States shall take into account the fact that the advantages accorded under this Treaty by each Member State form an integral part of the establishment of the Community and are thereby inseparably linked with the creation of common institutions, the conferring of powers upon them and the granting of the same advantages by all the other Member States.”

- (b) In Case C-478/07 *Budvar v. Ammersin*, the European Court of Justice ruled that
- (i) the Community system of protection laid down by Council Regulation (EC) No. 510/2006 of 20 March 2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs is exhaustive in nature, with the result that that Regulation precludes the application of a system of protection laid down by agreements between two EU member States, which confers on a designation, which is recognized under the law of a member State as constituting a designation of origin, protection in another member State where that protection is actually claimed, despite the fact that no application for registration of that designation of origin has been made in accordance with that Regulation.
 - (ii) The Czech appellation of origin “*Bud*” is not registered under Council Regulation (EC) No. 510/2006 and is, as a consequence of the ruling in Case C-478/07 *Budvar v. Ammersin*, since the accession of the Czech Republic to the EU, no longer protected as a designation of origin under the Agreement concluded, on June 11, 1976, between the Republic of Austria and the Czechoslovak Socialist Republic on the protection of indications of source, designations of origin and other designations referring to the source of agricultural and industrial products.
 - (iii) According to the same ruling, in order to determine whether the designation “*Bud*” can be considered to constitute a simple and indirect indication of geographical provenance, protection of which under the bilateral instruments at issue is capable of being justified on the basis of the criteria laid down in Article 30 of the Treaty establishing the European Community, the national court must ascertain whether, according to factual circumstances and perceptions prevailing in the Czech Republic, that designation, even if it is not in itself a geographical name, is at least capable of informing the consumer that the product bearing that indication comes from a particular place or region of that member State.
 - (iv) Case C-478/07 does not contain rulings concerning the designation “*Bud*”, as covered by bilateral agreements applicable between the Czech Republic and third countries on the protection of indications of source, designations of origin and other designations referring to the source of agricultural and industrial products, nor on the protection of “*Bud*” as registered as an appellation of origin under the Lisbon Agreement. The European Court of Justice explicitly indicated, as preliminary observations in the ruling, that Article 307 EC did not apply in the case at hand and that the question, whether the fact that Regulation No 510/2006 was exhaustive in nature precluded protection of the designation at issue in the main proceedings under the Lisbon Agreement, did not arise in those proceedings.

B. CONDITIONS FOR ACCESSION TO THE LISBON AGREEMENT BY COMPETENT INTERGOVERNMENTAL ORGANIZATIONS

I. INTRODUCTION

27. Part B of this study focuses on questions concerning the conditions for, and possibility of, future accession to the Lisbon Agreement by intergovernmental organizations that administer a regional system for the protection of geographical indications and/or appellations of origin.
28. The methodology used for addressing these questions has been to: (i) list the elements contained in the provisions of the Lisbon Agreement or its Regulations establishing substantive and formal criteria relevant for determining whether accession by such intergovernmental organizations might be possible; and (ii) examine whether the intergovernmental organizations administering the regional systems that were the subject of Part A of the study – i.e., the OAPI, the Andean Community and the EU – are in a position to meet these criteria.

II. MODIFICATION OF THE LISBON AGREEMENT AND ITS REGULATIONS SO AS TO ALLOW FOR ACCESSION BY INTERGOVERNMENTAL ORGANIZATIONS AND IDENTIFICATION OF CRITERIA FOR THEIR POSSIBLE ACCESSION

Modifications to the Provisions of the Agreement and its Regulations

29. Throughout the Agreement and its Regulations, the terms “country”, “contracting country” and “countries” should be replaced by “contracting party” and “contracting parties”. In addition, the term “national” should be replaced by “domestic”.
30. Provisions should be stipulated concerning the eligibility of intergovernmental organizations to become party to the Agreement, as well as provisions concerning the effective date of their instrument of ratification or accession and provisions concerning their voting rights in case of decision-making by voting. Appendix I to this Annex contains corresponding provisions in treaties administered by WIPO and UPOV.
31. In order to cover both geographical indications and appellations of origin, either a definition for geographical indications should be added to Article 2(1) or the current definition should be adapted. In this regard, reference is made to suggestions made in this respect in the context of the survey on the Lisbon system, as reflected in Section II of the Annex to document LI/WG/DEV/2/2. The terms “appellation of origin”, “appellations of origin” and “appellation” should be modified accordingly, throughout the Agreement and its Regulations.

Criteria for Determining the Entitlement of an Intergovernmental Organization to Accede

32. The terms “recognized and protected” in Article 1(2)¹⁵ would require intergovernmental organizations administering a regional system for the protection of geographical indications and/or appellations of origin to provide for titles of protection effective in the territory of the regional system.

¹⁵ Article 1(2) of the Lisbon Agreement requires member States to “undertake to protect on their territories, in accordance with the terms of this Agreement, the appellations of origin of products of the other countries of the Special Union, recognized and protected as such in the country of origin and registered at the International Bureau of WIPO”.

33. This requirement would appear to mean that those intergovernmental organizations must: (1) provide protection in respect of appellations of origin and/or geographical indications on the basis of criteria corresponding to the criteria under the Lisbon Agreement regarding (a) product coverage, (b) definition of the object of protection and (c) scope of protection; and (2) have the ability to grant titles of protection in respect of appellations of origin and/or geographical indications.

Notes on Criteria Regarding Definition

34. Titles of protection granted on the basis of a definition corresponding to the current definition of the Lisbon Agreement should, in principle, be able to satisfy definition provisions under domestic systems – whether national or regional – that are less restrictive. However, the alternative might not be true. In other words, a geographical indication that would qualify for registration under such a domestic system might not qualify for the more restrictive requirements for the protection of appellations of origin under the Lisbon Agreement.
35. The history of the negotiations of the Lisbon Agreement shows that the current definition for appellations of origin was already incorporated in the Agreement back in 1958. As reflected in the Acts of the Diplomatic Conference (p.859), the Fourth Commission of the Diplomatic Conference that adopted the Lisbon Agreement in Lisbon in 1958 confirmed the view that, where the laws of numerous countries did not distinguish between appellations of origin and indications of source, these countries could only adhere to the Agreement if the Agreement would give a clear indication as to what was an appellation of origin meeting the requirements of the Agreement. “By introducing a definition for appellations of origin into the Agreement itself, such definition could be invoked for the purposes of registration, without prejudicing a national definition, whether broader or more precise in scope.” Such a definition could be invoked by authorities of countries refusing protection in their territories and would also serve as a yardstick for national courts to assess whether any given geographical denomination, even when registered as an appellation of origin, did actually fall under the terms of the Lisbon Agreement.
36. Moreover, in this regard, reference should also be made to the suggestions made in the context of the survey on the Lisbon system, as reflected in Section II of the Annex to document LI/WG/DEV/2/2, in order for the Lisbon Agreement to be amended to the effect that it would henceforth cover both geographical indications and appellations of origin¹⁶.

¹⁶ Article 2(1) of the Lisbon Agreement defines “appellation of origin” as the “geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors”. Article 2(2) defines “country of origin” as the “country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin which has given the product its reputation”. Article 22.1 of the TRIPS Agreement defines “geographical indications” as “indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin”.

Notes on the Ability to Grant Titles of Protection

37. The requirements under Article 5 of the Agreement and Rule 4 of its Regulations would require intergovernmental organizations administering a regional system for the protection of geographical indications and/or appellations of origin to notify, upon accession, the name and address of its authority competent to communicate with the International Bureau under the procedures of the Lisbon system, as specified in Rule 4(1)¹⁷. As stipulated in Rule 4(2), while there may be different authorities, only one authority may be designated with respect to each of subparagraphs (a) to (c) of Rule 4(1)¹⁸.
38. There is no requirement under the Lisbon system for a central registration authority to be necessarily the competent authority for communication with the International Bureau under the procedures of the Lisbon system, as stipulated in Rule 4 of the Lisbon Regulations¹⁹.

III. APPLICATION OF THE CRITERIA FOR DETERMINING THE ENTITLEMENT OF AN INTERGOVERNMENTAL ORGANIZATION TO ACCEDE

(i) Andean Community: Domestic Registration in its Member States on the Basis of Common Legislation

39. In the Andean Community, geographical indications are regulated in Title XII of Decision 486, Common Regime on Industrial Property. Decision 486 of the Andean Community, which entered into force on December 1, 2000, amended the common regime for the protection of industrial property for all member States

¹⁷ Under Rule 4(1) of the Lisbon Regulations:
"Each contracting country shall notify to the International Bureau the name and address, as well as any change concerning the name or address,
 "(a) of its authority competent
 "(i) to file an international application in accordance with Rule 5, to remedy an irregularity contained in the international application in accordance with Rule 6(1), to request the entry in the International Register of a modification to an international registration in accordance with Rule 13(2), to notify the International Bureau that it renounces protection in one or more contracting countries in accordance with Rule 14(1), to request the International Bureau to cancel an international registration in accordance with Rule 15(1), to request correction of the International Register in accordance with Rule 17(1) and to communicate to the International Bureau, in accordance with Rule 19(2)(b), the documents referred to in Rule 5(3)(v), and
 "(ii) to receive the notifications of the International Bureau referred to in Rules 9(3), 10(1) and (2), 11(3), 12(2) and 16(2),
 "(b) of its authority competent
 "(i) to notify a declaration of refusal, to notify the withdrawal of a declaration of refusal in accordance with Rule 11, to send a statement of grant of protection in accordance with Rule 11*bis*¹⁷, to notify an invalidation in accordance with Rule 16(1), to request correction of the International Register in accordance with Rule 17(1) and to declare, in accordance with Rule 17(3), that it cannot ensure the protection of a corrected international registration and
 "(ii) to receive the notifications of the International Bureau referred to in Rules 7(1), 13(3), 14(2), 15(2) and 17(2), and
 "(c) of its authority competent to give notice to the International Bureau that a period, which may not exceed two years, has been granted to third parties in accordance with Article 5(6) of the Agreement."

¹⁸ Of the current Lisbon member States, only one has identified two competent authorities, namely Mexico, for which the competent authority under Rule 4(1)(a) is the Ministry of Foreign Affairs and the competent authority under Rule 4(1)(b) and (c) is the Mexican Industrial Property Institute (IMPI).

¹⁹ Most member States have nonetheless identified their central registration authority for appellations of origin as competent authority – see the list available on the Lisbon pages of the WIPO website.

of the Andean Community with a view to incorporating the parameters established by the Agreement on Trade-Related Aspects of Intellectual Property (hereinafter referred to as the "TRIPS Agreement") in the framework of the World Trade Organization (WTO). Title XII lays down provisions concerning the definition, use, scope of protection and procedure for the acquisition of geographical indications in the Andean Community and is divided over two Chapters, one dealing with appellations of origin (Chapter I, Articles 201 to 220) and the other with indications of source (Chapter II, Articles 221 to 223), respectively. Chapter I concerns a specific regime for the registration of appellations of origin. Chapter II concerns a general regime in respect of certain misleading and other unfair business practices regarding the source or provenance of goods²⁰.

Compatibility of the Protection Criteria with Those of the Lisbon Agreement

Product Coverage Under Andean Community Decision 486

40. In respect of appellations of origin, it is explicitly stipulated that protection is available for natural, agricultural, handicraft or industrial products, subject to the general conditions of protection²¹.

Definitions

41. Article 201 of Decision 486 lays down the following definition:
- "An appellation of origin shall be understood to be a geographical indication consisting of the name of a particular country, region, or locality, or of a name which, without being that of a particular country, region, or locality, refers to a specific geographical area, which name is used to identify a product originating therein, the qualities, reputation, or characteristics of which are exclusively or essentially attributable to the geographical environment in which it is produced, including both natural and human factors."
42. This definition clearly presents appellations of origin as a special type of geographical indications. Moreover, the definition combines elements of the definition of Article 2 of the Lisbon Agreement and the definition of Article 22 of the TRIPS Agreement. It incorporates into the definition of Article 2 of the Lisbon Agreement two elements of the definition of Article 22 of the TRIPS Agreement, by explicitly specifying that non-geographical names serving to designate a product originating in a specific geographical area are also covered, and by introducing "reputation" as a third alternative requirement next to "quality" and "characteristics". Finally, the term "attributable" has replaced the term "due" in the final phrase of the provision. In this regard, reference is made to paragraphs 34, 35 and 36, above.
43. Article 221 of Decision 486 stipulates that "an indication of source shall be understood to be a name, expression, image, or sign that indicates or evokes a particular country, region, locality, or place". Also in this regard, reference is made to paragraphs 34, 35 and 36, above.

²⁰ Title XII of Decision 486 is reproduced in Appendix II to the present Annex.
²¹ Article 212 of Andean Community Decision No.486.

Scope of Protection for Appellations of Origin

44. The provisions of Articles 214 and 215 of Andean Community Decision 486²² use other criteria than Article 3 of the Lisbon Agreement²³ to define the scope of protection for appellations of origin. In this regard, reference is made to the suggestions made, in respect of Article 3 of the Lisbon Agreement, in the context of the survey on the Lisbon system, as reflected in Section III of the Annex to document LI/WG/DEV/2/2.
45. Article 220 of Andean Community Decision 486 lays down provisions corresponding to those of Article 6 of the Lisbon Agreement²⁴.
46. There are no provisions in Title XII of Andean Community Decision 486 specifically addressing the relationship between geographical indications/appellations of origin and earlier trademarks. However, as mentioned above, Peru has refused a number of Lisbon registrations on the basis of the existence of earlier trademarks²⁵.

Ability to Grant Titles of Protection

47. In spite of the existence of common legislation for the protection of geographical indications for the four member States of the Andean Community, the Andean Community is not in a position to meet both criteria mentioned under paragraphs 32 and 33, above. While this common legislation covers subject-matter corresponding to the subject-matter covered by the Lisbon Agreement, titles of protection are granted by each of the member States of the Andean Community separately and individually, and there is no central regional registration authority and no registration procedure leading to the grant of Andean Community titles of protection²⁶.
48. Even though there is no requirement under the Lisbon system for a central registration authority to necessarily be the competent authority for communication with the International Bureau under the procedures of the Lisbon system, as stipulated in Rule 4 of the Lisbon Regulations, fact of the matter remains that, under the regional system of the Andean Community, no region-wide Andean Community titles of protection are available.

(ii) OAPI: Regional Registration on the Basis of Unified Legislation

49. The African Intellectual Property Organization (OAPI) has had unified legislation for geographical indications since 1969 when a new law (*Uniform Law on Appellations of Origin*) was added as an Annex to the Libreville Agreement of September 13, 1962²⁷, by virtue of the Convention of January 10, 1969, which amended the Agreement.

²² Title XII of Andean Community Decision 486 is reproduced in Appendix II to the present Annex.

²³ Article 3 of the Lisbon Agreement reads as follows:

“Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as ‘kind’, ‘type’, ‘make’, ‘imitation’, or the like”.

²⁴ Article 6 of the Lisbon Agreement reads as follows:

“An appellation which has been granted protection in one of the countries of the Special Union pursuant to the procedure under Article 5 cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.”

²⁵ See paragraph 8 above.

²⁶ As far as Peru is concerned, the competent authority is the Peruvian Intellectual Property Office (INDECOPI).

²⁷ Libreville Agreement establishing the African and Malagasy Intellectual Property Organization (OAMPI).

50. The Libreville Agreement was later replaced by the Bangui Agreement establishing OAPI that was first signed in Bangui on March 2, 1977, and subsequently revised on February 24, 1999 with a view to bringing it into line with the TRIPS Agreement, through the addition of an Annex VI covering geographical indications instead of appellations of origin. The first Bangui Agreement entered into force on February 8, 1982, while the Revised Bangui Agreement entered into force on February 28, 2002.
51. Applications for the registration of geographical indications under the Revised Bangui Agreement must be filed either with OAPI or through the Minister responsible for industrial property of the OAPI member State, who is under an obligation to forward the application to OAPI within five working days²⁸. Prior to the entry into force of the Revised Bangui Agreement in February 2002, applications for the registration of appellations of origin with OAPI had to be filed with the Minister responsible for industrial property of the OAPI member State concerned, who was under an obligation to forward the application to OAPI, provided the Minister had not made any objection to it²⁹.

Compatibility of the Protection Criteria with Those of the Lisbon Agreement

Product Coverage under the Revised Bangui Agreement

52. The definition for geographical indications under the Revised Bangui Agreement explicitly stipulates that the product identified by a geographical indication can be any natural, agricultural, craft or industrial product³⁰.

Definition

53. Article 1 of Annex VI of the Revised Bangui Agreement lays down the following definition:

“For the purposes of this Annex,

“(a) ‘geographical indication’ means an indication that serves to identify a product as originating from a territory, a region, or a locality within that territory, in those cases where the quality, reputation or other specific characteristic of the product may be essentially attributed to such geographical origin;

“(b) ‘product’ means any natural, agricultural, craft or industrial product;

“(c) ‘producer’ means any producer of agricultural products or any other person exploiting natural products, any manufacturer of products of craft or industry, any trader dealing in such products.”

54. The definition under subparagraph (a) of this provision corresponds to the definition of Article 22.1 of the TRIPS Agreement.
55. Reference is made to paragraphs 34, 35 and 36, above.

²⁸ Articles 7 and 8 of Annex VI of the Revised Bangui Agreement.

²⁹ Articles 6 and 7 of Annex VI of the Bangui Agreement.

³⁰ Article 1(b) of Annex VI of the Revised Bangui Agreement.

Scope of Protection

56. Under Article 15(3) of Annex VI of the Revised Bangui Agreement³¹, “it shall be unlawful to use, for commercial purposes, a registered geographical indication, or a similar designation, with respect to the products specified in the Register or similar products, even if the true origin of the products is indicated or if the geographical indication is in the form of a translation or is accompanied by terms such as ‘kind’, ‘type’, ‘make’, ‘imitation’ or the like.”
57. The scope of protection under this provision would appear to meet the minimum requirements of Article 3 of the Lisbon Agreement³².
58. This is different for Article 15(6), which lays down that “the owner of an earlier mark that is identical with or similar to a geographical indication may continue to use his mark, except where such mark concerns wine or spirits”. However, in that regard, reference is made to the suggestions made, in respect of Article 5(6) of the Lisbon Agreement³³, in the context of the survey on the Lisbon system, as reflected in Section VIII of the Annex to document LI/WG/DEV/2/2.
59. Annex VI of the Revised Bangui Agreement does not appear to contain a provision corresponding to Article 6 of the Lisbon Agreement³⁴. It may be noted, though, that strict implementation of the provisions of Article 15(1), (4) and (5) of Annex VI may well lead to the same effect³⁵.

Ability to Grant Titles of Protection

60. Article 2(1)(a) of the Revised Bangui Agreement stipulates that OAPI is responsible for “implementing and applying the common administrative procedures deriving from a uniform system for the protection of industrial property, as well as the provisions of international agreements in this field to which the member States of the Organization have acceded, and providing services related to industrial property”. In addition, as reflected in paragraphs 10 to 13, above, OAPI administers a central geographical indication registry and a single registration confers automatic protection in all OAPI member States.
61. Thus, there is no doubt that OAPI has the ability to grant titles of protection in respect of geographical indications, as indicated in paragraphs 32 and 33, above.

³¹ Annex VI of the Revised Bangui Agreement is reproduced in Appendix III to the Annex to the present document.

³² Article 3 of the Lisbon Agreement reads as follows:

“Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as ‘kind’, ‘type’, ‘make’, ‘imitation’, or the like.”

³³ Article 5(6) of the Lisbon Agreement reads as follows:

“If an appellation which has been granted protection in a given country pursuant to notification of its international registration has already been used by third parties in that country from a date prior to such notification, the competent Office of the said country shall have the right to grant to such third parties a period not exceeding two years to terminate such use, on condition that it advise the International Bureau accordingly during the three months following the expiration of the period of one year provided for in paragraph (3), above.”

³⁴ Article 6 of the Lisbon Agreement reads as follows:

“An appellation which has been granted protection in one of the countries of the Special Union pursuant to the procedure under Article 5 cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.”

³⁵ Annex VI of the Revised Bangui Agreement is reproduced in Appendix III to the Annex of the present document.

Possible Accession by OAPI

62. It should be noted that, if provisions concerning accession by intergovernmental organizations would be introduced into the Lisbon Agreement and OAPI would make use of the possibility thus created to accede, a number of questions would have to be dealt with. In view of the fact that OAPI administers a regional system for the protection of geographical indications on the basis of unified legislation for its member States, it is presumed that international registrations under the Lisbon system would have effect as OAPI registrations, throughout the territories of all OAPI member States, subject to the possible refusal within the prescribed one-year time-limit, or to invalidation by a tribunal thereafter. This would also apply in respect of all international registrations existing at the moment of OAPI's accession. As these international registrations will already be under protection from a prior date in those OAPI member States that had already become party to the Lisbon Agreement, the question arises as to whether Article 12(3) of the Revised Bangui Agreement would need to be amended so as to ensure that rights acquired in those OAPI member States in respect of those international registrations prior to OAPI's accession be respected, or would a refusal by OAPI prevail over such acquired rights?
63. Another question to be clarified, in view of OAPI's unified legislation and central procedure for the registration of geographical indications, concerns the effect of Lisbon registrations inscribed after OAPI's accession in OAPI member States that are themselves also party to the Lisbon Agreement. Would these have effect both as OAPI registrations and as registrations under Article 12(3) of the Revised Bangui Agreement in the OAPI member States that are party to the Lisbon Agreement, or just as OAPI registrations?

(iii) European Union

64. Protection at the regional level in the EU is subject to different specific regimes for certain specific categories of products.
65. Geographical indications and appellations of origin for products not covered by any of these specific regimes only benefit, at the regional level in the EU, from certain general regimes concerning certain misleading and other unfair business practices, as established under EU legislation and to be implemented by the EU member States.

Compatibility of the Protection Criteria with Those of the Lisbon Agreement

Product Coverage

66. The following product categories are the subject of different specific regimes for the protection of geographical indications and/or appellations of origin under EU legislation:
- (a) wine, liqueur wine, sparkling wine, quality sparkling wine, quality aromatic sparkling wine, semi-sparkling wine, aerated semi-sparkling wine, partially fermented grape must, wine from raisined grapes and wine of overripe grapes³⁶,
 - (b) aromatized wines, aromatized wine-based drinks and aromatized wine-product cocktails³⁷,

³⁶ Article 33 of Council Regulation (EC) No. 479/2008.

³⁷ Article 6 of Council Regulation (EEC) No. 1601/91.

- (c) spirit drinks³⁸,
- (d) agricultural products intended for human consumption listed in Annex I to the Treaty establishing the European Community, foodstuffs listed in Annex I to Council Regulation (EC) 510/2006 and agricultural products listed in Annex II to the same Council Regulation, with the exception of wine-sector products (except wine vinegars) and spirit drinks³⁹.

Definitions

67. In respect of geographical indications and/or appellations of origin for products, referred to as categories (a) to (d) in the previous subsection, the following definitions apply:
- (a) In respect of products in this category, two definitions apply under Article 34(1) of Council Regulation (EC) No. 479/2008:
 - (i) **“Designation of origin”** means the name⁴⁰ of a region, a specific place or, in exceptional cases, a country used to describe a product referred to in Article 33(1) that complies with the following requirements – including traditionally used names designating a wine and referring to a geographical name: (i) its quality and characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors; (ii) the grapes from which it is produced come exclusively from this geographical area; (iii) its production takes place in this geographical area; (iv) it is obtained from vine varieties belonging to *Vitis vinifera*.
 - (ii) **“Geographical indication”** means an indication referring to a region, a specific place or, in exceptional cases, a country, used to describe a product referred to in Article 33(1) which complies with the following requirements: (i) it possesses a specific quality, reputation or other characteristics attributable to that geographical origin; (ii) at least 85 % of the grapes used for its production come exclusively from this geographical area; (iii) its production takes place in this geographical area; (iv) it is obtained from vine varieties belonging to *Vitis vinifera* or a cross between the *Vitis vinifera* species and other species of the genus *Vitis*.
 - (iii) Transitional safeguard provisions apply⁴¹ in respect of wine names protected as **“geographical indications”** under the regime applicable prior to Council Regulation (EC) No. 479/2008, i.e., “as indications identifying a product as originating in the territory of a third country which is a member of WTO, or in a region or locality of that territory, where a quality, reputation or other specific characteristic of that product can essentially be attributed to that geographical origin”.

³⁸ Article 9 of Regulation (EC) No. 110/2008 of the European Parliament and of the Council
³⁹ Article 1 of Council Regulation (EC) 510/2006.

⁴⁰ In addition, paragraphs 2 and 3 of Article 34 provide as follows:
“2. Certain traditionally used names shall constitute a designation of origin where they:
“(a) designate a wine;
“(b) refer to a geographical name;
“(c) meet the requirements referred to in paragraph 1(a)(i) to (iv);
“(d) undergo the procedure conferring protection on designations of origin and geographical indications laid down in this Chapter.
“3. Designations of origin and geographical indications, including those relating to geographical areas in third countries, shall be eligible for protection in the Community in accordance with the rules laid down in this Chapter.”

⁴¹ As specified in Article 51 of Council Regulation (EC) No. 479/2008.

- (b) In respect of products in this category:
- (i) Article 6(1) of Council Regulation (EEC) No. 1601/91 prescribes the use of descriptions as specified in the Regulation. However, Article 6(2) allows “geographical designations” listed in Annex II to the Regulation to replace these descriptions, or supplement them, forming composite descriptions. Such “**geographical designations**” shall be reserved for drinks in respect of which the production stage during which they acquired their character and definitive qualities took place in the geographical area indicated, provided that the consumer is not misled as to the raw material used.
 - (ii) With a view to bringing this Regulation into line with the TRIPS Agreement, the following definition was added, by virtue of the introduction of Article 10a: “**geographical designation**’ shall mean any indication identifying a product as originating in the territory of a third country which is a member of the World Trade Organization, or in a region or locality of that territory, where a quality, reputation or other specific characteristic of that product can essentially be attributed to that geographical origin”.
- (c) In respect of products in this category, a “**geographical indication**” shall be an indication which identifies a spirit drink as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of that spirit drink is essentially attributable to its geographical origin⁴².
- (d) In respect of products in this category, two definitions apply under Article 2 of Council Regulation (EC) 510/2006. :
- (i) “**Designation of origin**” means the name⁴³ of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff – including traditional geographical or non-geographical names designating an agricultural product or a foodstuff:
 - originating in that region, specific place or country, and
 - the quality or characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and
 - the production, processing and preparation of which take place in the defined geographical area.

⁴² Article 15 of Regulation (EC) No. 110/2008 of the European Parliament and of the Council.

⁴³ In addition, paragraphs 2 and 3 of Article 2 provide as follows:

“2. Traditional geographical or non-geographical names designating an agricultural product or a foodstuff which fulfil the conditions referred to in paragraph 1 shall also be considered as designations of origin or geographical indications.

“3. Notwithstanding paragraph 1(a), certain geographical designations shall be treated as designations of origin where the raw materials for the products concerned come from a geographical area larger than, or different from, the processing area, provided that:

“(a) the production area of the raw materials is defined;

“(b) special conditions for the production of the raw materials exist; and

“(c) there are inspection arrangements to ensure that the conditions referred to in point (b) are adhered to.

“The designations in question must have been recognised as designations of origin in the country of origin before 1 May 2004.”

- (ii) “**Geographical indication**” means the name⁴² of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff – including traditional geographical or non-geographical names designating an agricultural product or a foodstuff:
- originating in that region, specific place or country, and
 - which possesses a specific quality, reputation or other characteristics attributable to that geographical origin, and
 - the production and/or processing and/or preparation of which take place in the defined geographical area.

68. Also in regard of these definitions, reference is made to paragraphs 34, 35 and 36, above.

Scope of Protection

69. The provisions of the EU legislation mentioned above⁴⁴ uses other criteria than Article 3 of the Lisbon Agreement⁴⁵ to define the scope of protection for appellations of origin. In this regard, reference is made to the suggestions made, in respect of Article 3 of the Lisbon Agreement, in the context of the survey on the Lisbon system, as reflected in Section III of the Annex to document LI/WG/DEV/2/2.
70. The scope of protection under these provisions would appear to meet the minimum requirements of Article 3 of the Lisbon Agreement.
71. The same applies in respect of Article 6 of the Lisbon Agreement⁴⁶. EU legislation contains corresponding provisions⁴⁷.
72. This is, however, different for the provisions under the EU legislation in question concerning the relationship between geographical indications/appellations of origin and earlier trademarks⁴⁸. However, in that regard, reference is made to the suggestions made, in respect of Article 5(6) of the Lisbon Agreement⁴⁹, in the context of the survey on the Lisbon system, as reflected in Section VIII of the Annex to document LI/WG/DEV/2/2.

⁴⁴ See, in particular, the provisions of EU legislation reproduced in Appendix IV to the Annex to the present document.

⁴⁵ Article 3 of the Lisbon Agreement reads as follows:

“Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as ‘kind’, ‘type’, ‘make’, ‘imitation’, or the like.”

⁴⁶ Article 6 of the Lisbon Agreement reads as follows:

“An appellation which has been granted protection in one of the countries of the Special Union pursuant to the procedure under Article 5 cannot, in that country, be deemed to have become generic, as long as it is protected as an appellation of origin in the country of origin.”

⁴⁷ Such provisions are explicitly contained in Article 45(3) of Council Regulation (EC) No. 479/2008; Article 15(3) of Regulation (EC) No. 110/2008 of the European Parliament and of the Council; and Article 13(2) of Council Regulation (EC) 510/2006. See Appendix IV to the present Annex.

⁴⁸ See, in particular, the provisions of EU legislation reproduced in Appendix V to the Annex to the present document.

⁴⁹ Article 5(6) of the Lisbon Agreement reads as follows:

“If an appellation which has been granted protection in a given country pursuant to notification of its international registration has already been used by third parties in that country from a date prior to such notification, the competent Office of the said country shall have the right to grant to such third parties a period not exceeding two years to terminate such use, on condition that it advise the International Bureau accordingly during the three months following the expiration of the period of one year provided for in paragraph (3), above.”

Products not Covered by the Specific Regimes Mentioned Above

73. One of the main conclusions reflected in document LI/WG/DEV/2/2 – Results of the Survey on the Lisbon System – reads as follows⁵⁰:

“Many contributions to the survey indicate that, if Article 2 of the Lisbon Agreement would be amended by the addition of a definition for geographical indications along the lines of Article 22.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), as many have suggested in response to question 2 of the survey’s questionnaire, a corresponding amendment of Article 1(2) of the Lisbon Agreement might be appropriate. In this regard, the issue would appear to be that such an amendment of Article 1(2) should take into account that some domestic laws may have one definition – for geographical indications – and other domestic laws two definitions – one for geographical indications and another for appellations of origin. Recognition and protection in a country of origin on the basis of a single definition, as contained in a domestic law of the first mentioned type, may not necessarily provide sufficient information for determining on the basis of domestic laws that contain two definitions, whether both these definitions are met or just one of them. This issue is, of course, of particular importance if the scope of protection for an appellation of origin under domestic law is broader than for a geographical indication. These contributions also point out that the issue is all the more relevant if the recognition and protection under domestic law take place on the basis of a collective, certification or guarantee mark, or on the basis of an unfair competition law or a consumer protection law. Another contribution advances the view that, if these various titles of protection can all be the basis of a Lisbon registration, their scope of protection should be brought in line with each other.”

74. In this connection, two questions might be explored with regard to geographical indications and appellations of origin for products not covered by any of the product-specific regimes of the EU, as addressed in the previous sub-sections. As mentioned in paragraph 65 above, such geographical indications and appellations of origin do benefit, at the regional level in the EU, from certain general regimes concerning certain misleading and other unfair business practices, as established under EU legislation and to be implemented by the EU member States. The first question to be explored in this regard is whether protection under these general regimes might provide a sufficient basis for international registrations under the Lisbon Agreement. And, secondly, the question could be examined as to whether protection on the basis of a collective, certification or guarantee mark is available for such geographical indications and appellations of origin in the EU and, if so, whether such protection might provide a sufficient basis for international registrations under the Lisbon Agreement. In connection with the latter question, it should be noted though, that, unlike the general regimes concerning certain misleading and other unfair business practices, protection by virtue of collective, certification or guarantee marks has not been taken up in the notifications from the EU to WTO concerning its implementing legislation, at the regional level, of its obligations under the TRIPS Agreement concerning the protection of geographical indications. Such protection has been the subject of such notifications from a number of EU member States, though⁵¹.

⁵⁰ Paragraph 7 of the Annex to document LI/WG/DEV/2/2.

⁵¹ Reference is made to WTO documents IP/C/W/117/Add.10 and IP/C/W/253/Rev.1, Table I.

General Regimes Concerning Misleading and Other Unfair Business Practices

75. In its contribution⁵², submitted in November 1998, in response to a Checklist of Questions⁵³ drawn up by the TRIPS Council of the World Trade Organization in the context of the review under Article 24.2 of the TRIPS Agreement of the application of the provisions of the Section of the TRIPS Agreement on geographical indications, the European Commission listed among the means of protection available for geographical indications in the EU, at the regional level, in addition to the legislation establishing the specific regimes mentioned above, two legal instruments concerning general regimes which were available to protect geographical indications, namely Council Directive No. 79/112/EEC of 18 December 1978 on the approximation of the laws of the member States relating to the labeling, presentation and advertising of foodstuffs for sale to the ultimate consumer and Council Directive No. 84/450/EEC of 10 September 1984 relating to the approximation of laws, regulations and administrative provisions of member States concerning misleading advertising.
76. Since then, Council Directive No. 79/112/EEC has been replaced by Directive 2000/13 of the European Parliament and of the Council of 20 March 2000 on the approximation of the laws of the member States relating to the labeling, presentation and advertising of foodstuffs which, nonetheless, contains the same provision referred to by the European Commission in its above-mentioned contribution, namely that the labeling and methods used must not be such as could mislead the purchaser to a material degree, *inter alia*, as to the characteristics of the foodstuff and, in particular, as to its nature, identity, properties, composition, quantity, durability, origin or provenance, method of manufacture or production.
77. Council Directive No. 84/450/EEC of 10 September 1984, as amended⁵⁴, provides for a definition of misleading advertising which may result in unfair competition by reason of its deceptive nature (Article 2); considers, in particular, any information it contains concerning geographical or commercial origin as relevant criterion in determining whether advertising is misleading (Article 3); and deals with the legal means member States shall provide for the control of misleading advertising in the interest of consumers as well as competitors and the general public.
78. In addition, the Unfair Commercial Practices Directive (Directive 2005/29/EC of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to-consumer commercial practices in the internal market) contains a definition of misleading commercial practice which may result in unfair competition due to its false or deceptive nature (Article 6.1), while considering, *inter alia*, any information it contains concerning geographical or commercial origin as relevant criteria in determining whether a commercial practice is misleading.
79. Even apart from the questions referred to above, at the beginning of the present section "Products not Covered by the Specific Regimes Mentioned Above", with reference to the Results of the Survey on the Lisbon System, it should be noted that protection on the basis of these common legal instruments is a matter for each of the member States of the EU separately and individually. Moreover, titles of protection could only be granted as a result of court procedures in each of these member States.

⁵² WTO document IP/C/W/117/Add.10.

⁵³ WTO documents IP/C/13 and Add.1.

⁵⁴ Amendments took place by virtue of Directive 97/55/EC of the European Parliament and of the Council of 6 October 1997 (so as to include comparative advertising) and the Unfair Commercial Practices Directive (Directive 2005/29/EC of the European Parliament and of the Council of 11 May 2005 concerning unfair business-to-consumer commercial practices in the internal market).

Collective, Certification or Guarantee Marks?

80. Council Regulation (EC) No. 207/2009 on the Community Trademark provides for the possibility of registering a Community collective mark which may contain signs or indications with a geographical connotation. The Community collective mark is a trademark registered with the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), which grants an exclusive right across all EU member States. However, the Regulation in question does not define geographical indications or appellations of origin and, consequently, does not provide for titles of protection necessarily indicating a link between quality or characteristics and geographical origin.
81. Moreover, as specified in paragraph 2 of Article 66, a Community collective mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.
82. Article 66 of Council Regulation (EC) No 207/2009 reads as follows:

“Article 66

“Community collective marks

“1. A Community collective mark shall be a Community trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings. Associations of manufacturers, producers, suppliers of services, or traders which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued, as well as legal persons governed by public law, may apply for Community collective marks.

“2. In derogation from Article 7(1)(c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute Community collective marks within the meaning of paragraph 1. A collective mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.

“3. The provisions of this Regulation shall apply to Community collective marks, unless Articles 67 to 74 provide otherwise.”

83. The provisions of Article 66 have their parallel in Council Directive (EC) 2008/95, which seeks to harmonize the laws of the member States relating to trade marks⁵⁵, authorizing EU member States to establish collective, guarantee or certification marks containing indications or signs serving to designate the geographical origin.

⁵⁵ EC Directive 2008/95 replaced First Council Directive 89/104/EEC of 21 December 1988, without substantial modifications.

84. Article 15(2) of Council Directive (EC) 2008/95 reads as follows:

“Article 15

“Special provisions in respect of collective marks, guarantee marks and certification marks

“2. By way of derogation from Article 3(1)(c), Member States may provide that signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective, guarantee or certification marks. Such a mark does not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.”

85. Collective, guarantee or certification marks are being used by producers of geographical indications and appellations of origin from EU member States as a complementary tool in order to ensure additional protection in respect of elements, such as logos, symbols or other figurative elements that, while containing a geographical indication or appellation of origin, cannot be registered as geographical indications or appellations of origin. In addition, producers use these marks to inform consumers of their affiliation to a specific producer association or consortium⁵⁶.

Ability to Grant Titles of Protection

86. Even though the procedure under EU Regulations involves both EU member States and the European Commission, there is no doubt that the EU has the ability to grant titles of protection in respect of appellations of origin and/or geographical indications, as indicated in paragraphs 32 and 33, above.
87. However, this ability only exists in respect of certain categories of products, as specified above.

Possible Accession by the EU

88. It should be noted that the situation in the EU, as described above, would appear to require clarification of a number of questions prior to the introduction of provisions concerning accession by intergovernmental organizations into the Lisbon Agreement.
89. In particular, clarification is called for as to whether accession by an intergovernmental organization would be permitted that, while being competent to grant titles of protection for appellations of origin and/or geographical indications under a regional system for the protection of such intellectual property rights, only has such competence in respect of products falling in certain specific product categories.

⁵⁶ For example, “*Roquefort*” cheese benefits from both an EU designation of origin (PDO) and a Community trademark that includes the designation of origin (OHIM Registration No. 001514124). Likewise, “*Parmigiano Reggiano*” benefits from an EU designation of origin (PDO) and has five related Community collective marks (OHIM Registrations Nos. 001126481, 005882394, 005882444, 005882469, 006103899).

90. Another question to be clarified concerns the effect that accession by the EU as an intergovernmental organization administering a regional system for the protection of geographical indications and appellations of origin would have. To the extent that such accession would take place on the basis of unified legislation for its member States, can it be presumed that the same questions would need to be dealt with as described in paragraphs 62 and 63, above in respect of OAPI?
91. To the extent that the EU legislation is not unified but common legislation applying in parallel with the domestic legislation of its member States, could its accession be modeled after its accession to the Madrid Protocol and the Geneva Act of the Hague Agreement, to both of which treaties establishing international registration systems for intellectual property rights – i.e., trademarks and industrial designs, respectively – the EU has acceded, in 2004 and 2008, respectively?

[Appendices follow]

**Provisions in WIPO-Administered Treaties and the UPOV Convention Addressing Accession
by Intergovernmental Organizations**

GLOBAL PROTECTION SYSTEM TREATIES

Geneva Act of the Hague Agreement
Concerning the International Registration of Industrial Designs

ARTICLE 27(1) – ELIGIBILITY FOR BECOMING PARTY

“[...] Any intergovernmental organization which maintains an Office in which protection of industrial designs may be obtained with effect in the territory in which the constituting treaty of the intergovernmental organization applies may sign and become party to this Act, provided that at least one of the member States of the intergovernmental organization is a member of the Organization and provided that such Office is not the subject of a notification under Article 19.”

ARTICLE 27(3)(b) – DEPOSIT INSTRUMENT OF RATIFICATION OR ACCESSION

“The effective date of the deposit of the instrument of ratification or accession of any State in respect of which protection of industrial designs may be obtained only through the Office maintained by an intergovernmental organization of which that State is a member shall be the date on which the instrument of that intergovernmental organization is deposited if that date is later than the date on which the instrument of the said State has been deposited.”

ARTICLE 21(4)(b) – TAKING DECISIONS IN THE ASSEMBLY

“Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such case, each Contracting Party that is a State shall have one vote and shall vote only in its own name, and any Contracting Party that is an intergovernmental organization may vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Act, and no such intergovernmental organization shall participate in the vote if any of its Member States exercises its right to vote, and vice versa.”

Protocol Relating to the Madrid Agreement
Concerning the International Registration of Marks

ARTICLE 14(1) – ELIGIBILITY FOR BECOMING PARTY

“[...] Any intergovernmental organization may also become party to this Protocol where the following conditions are fulfilled:
“(i) at least one of the Member States of that organization is a party to the Paris Convention for the Protection of Industrial Property;
“(ii) that organization has a regional Office for the purposes of registering marks with effect in the territory of the organization, provided that such Office is not the subject of a notification under Article 9^{quater}.”

* Article 19 of the Geneva Act and Article 9^{quater} of the Madrid Protocol allow Contracting States to participate in, respectively, the Hague system or the Madrid system with a common Office, replacing national Offices, provided they have unified their domestic legislation on, respectively, industrial designs or trademarks and the whole of their respective territories shall be deemed to be a single State for the purposes of the application of the procedures under, respectively, the Hague system or the Madrid system.

Provisions in WIPO-Administered Treaties and the UPOV Convention Addressing Issues Specific to Intergovernmental Organizations

INTELLECTUAL PROPERTY PROTECTION TREATIES

Trademark Law Treaty (TLT)
Singapore Treaty on the Law of Trademarks

ARTICLE 19(1) TLT – ELIGIBILITY FOR BECOMING PARTY
ARTICLE 26(1) SINGAPORE – ELIGIBILITY FOR BECOMING PARTY

“[...] (ii) Any intergovernmental organization which maintains an Office in which marks may be registered with effect in the territory in which the constituting treaty of the intergovernmental organization applies, in all its Member States or in those of its Member States which are designated for such purpose in the relevant application, provided that all the Member States of the intergovernmental organization are members of the Organization;
“[...] (iv) Any State member of the Organization in respect of which marks may be registered only through the Office maintained by an intergovernmental organization of which that State is a member;
“(v) Any State member of the Organization in respect of which marks may be registered only through an Office common to a group of States members of the Organization “

ARTICLE 19(3) TLT – DEPOSIT INSTRUMENT OF RATIFICATION OR ACCESSION
ARTICLE 26(3) SINGAPORE – DEPOSIT INSTRUMENT OF RATIFICATION OR ACCESSION

“[...] The effective date of the deposit of an instrument of ratification or accession shall be,
[...] (ii) In the case of an intergovernmental organization, the date on which the instrument of that intergovernmental organization is deposited;
“(iv) In the case of a State referred to in paragraph (1)(iv), the date applicable under (ii), above;
“(v) In the case of a State member of a group of States referred to in paragraph (1)(v), the date on which the instruments of all the States members of the group have been deposited.”

Singapore Treaty on the Law of Trademarks

ARTICLE 21(4)(b) – TAKING DECISIONS IN THE ASSEMBLY

“Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such case, each Contracting Party that is a State shall have one vote and shall vote only in its own name, and any Contracting Party that is an intergovernmental organization may vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Treaty. No such intergovernmental organization shall participate in the vote if any of its Member States exercises its right to vote, and vice versa. In addition, no such intergovernmental organization shall participate in the vote if any one of its Member States party to this Treaty is a Member State of another such intergovernmental organization and that other intergovernmental organization participates in that vote.”

Provisions in WIPO-Administered Treaties and the UPOV Convention Addressing Issues Specific to Intergovernmental Organizations

Patent Law Treaty (PLT)

ARTICLE 20 – ELIGIBILITY FOR BECOMING PARTY

“(1) [States] Any State which is party to the Paris Convention or which is a member of the Organization, and in respect of which patents may be granted, either through the State’s own Office or through the Office of another State or intergovernmental organization, may become party to this Treaty.

“(2) [Intergovernmental Organizations] Any intergovernmental organization may become party to this Treaty if at least one member State of that intergovernmental organization is party to the Paris Convention or a member of the Organization, and the intergovernmental organization declares that it has been duly authorized, in accordance with its internal procedures, to become party to this Treaty, and declares that:

“(i) it is competent to grant patents with effect for its member States; or

“(ii) it is competent in respect of, and has its own legislation binding on all its member States concerning, matters covered by this Treaty, and it has, or has charged, a regional Office for the purpose of granting patents with effect in its territory in accordance with that legislation.

Subject to paragraph (3), any such declaration shall be made at the time of the deposit of the instrument of ratification or accession.

“(3) [Regional Patent Organizations] The European Patent Organization, the Eurasian Patent Organization and the African Regional Industrial Property Organization, having made the declaration referred to in paragraph (2)(i) or (ii) in the Diplomatic Conference that has adopted this Treaty, may become party to this Treaty as an intergovernmental organization, if it declares, at the time of the deposit of the instrument of ratification or accession that it has been duly authorized, in accordance with its internal procedures, to become party to this Treaty.”

ARTICLE 17(4)(b) – TAKING DECISIONS IN THE ASSEMBLY

“Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such case, each Contracting Party that is a State shall have one vote and shall vote only in its own name, and any Contracting Party that is an intergovernmental organization may vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Treaty. No such intergovernmental organization shall participate in the vote if any of its Member States exercises its right to vote, and vice versa. In addition, no such intergovernmental organization shall participate in the vote if any one of its Member States party to this Treaty is a Member State of another such intergovernmental organization and that other intergovernmental organization participates in that vote.”

Provisions in WIPO-Administered Treaties and the UPOV Convention Addressing Issues Specific to Intergovernmental Organizations

WIPO Copyright Treaty (WCT)

ARTICLE 17 – ELIGIBILITY FOR BECOMING PARTY

“(1) Any Member State of WIPO may become party to this Treaty.

“(2) The Assembly may decide to admit any intergovernmental organization to become party to this Treaty which declares that it is competent in respect of, and has its own legislation binding on all its Member States on, matters covered by this Treaty and that it has been duly authorized, in accordance with its internal procedures, to become party to this Treaty.

“(3) The European Community, having made the declaration referred to in the preceding paragraph in the Diplomatic Conference that has adopted this Treaty, may become party to this Treaty.”

ARTICLE 15(3) – TAKING DECISIONS IN THE ASSEMBLY

“Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such case, each Contracting Party that is a State shall have one vote and shall vote only in its own name, and any Contracting Party that is an intergovernmental organization may vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Treaty. No such intergovernmental organization shall participate in the vote if any of its Member States exercises its right to vote, and vice versa.”

WIPO Performances and Phonograms Treaty (WPPT)

ARTICLE 26 – ELIGIBILITY FOR BECOMING PARTY

“(1) Any Member State of WIPO may become party to this Treaty.

“(2) The Assembly may decide to admit any intergovernmental organization to become party to this Treaty which declares that it is competent in respect of, and has its own legislation binding on all its Member States on, matters covered by this Treaty and that it has been duly authorized, in accordance with its internal procedures, to become party to this Treaty.

“(3) The European Community, having made the declaration referred to in the preceding paragraph in the Diplomatic Conference that has adopted this Treaty, may become party to this Treaty.”

ARTICLE 24(3) – TAKING DECISIONS IN THE ASSEMBLY

“Where a decision cannot be arrived at by consensus, the matter at issue shall be decided by voting. In such case, each Contracting Party that is a State shall have one vote and shall vote only in its own name, and any Contracting Party that is an intergovernmental organization may vote, in place of its Member States, with a number of votes equal to the number of its Member States which are party to this Treaty. No such intergovernmental organization shall participate in the vote if any of its Member States exercises its right to vote, and vice versa.”

Provisions in WIPO-Administered Treaties and the UPOV Convention Addressing Issues Specific to Intergovernmental Organizations

Washington Treaty on Intellectual Property in Respect of Integrated Circuits

ARTICLE 15 – ELIGIBILITY FOR BECOMING PARTY

“(b) Any Intergovernmental Organization which meets the requirements of Article 2(x) may become party to this Treaty. The Organization shall inform the Director General of its competence, and any subsequent changes in its competence, with respect to the matters governed by this Treaty. The Organization and its member States may, without, however, any derogation from the obligations under this Treaty, decide on their respective responsibilities for the performance of their obligations under this Treaty.”

ARTICLE 9(3) – TAKING DECISIONS IN THE ASSEMBLY

“Any Contracting Party that is an Intergovernmental Organization shall exercise its right to vote, in place of its member States, with a number of votes equal to the number of its member States which are party to this Treaty and which are present at the time the vote is taken. No such Intergovernmental Organization shall exercise its right to vote if any of its member States participates in the vote.”

International Convention for the Protection of new Varieties of Plants (1991 Act)

ARTICLE 34(1) – ELIGIBILITY FOR BECOMING PARTY

“(a) Any State may, as provided in this Article, become party to this Convention.
“(b) Any intergovernmental organization may, as provided in this Article, become party to this Convention if it
 “(i) has competence in respect of matters governed by this Convention,
 “(ii) has its own legislation providing for the grant and protection of breeders' rights binding on all its member States and
 “(iii) has been duly authorized, in accordance with its internal procedures, to accede to this Convention.”

ARTICLE 26(6) – TAKING DECISIONS IN THE COUNCIL

“(a) Each member of the Union that is a State shall have one vote in the Council.
“(b) Any Contracting Party that is an intergovernmental organization may, in matters within its competence, exercise the rights to vote of its member States that are members of the Union. Such an intergovernmental organization shall not exercise the rights to vote of its member States if its member States exercise their right to vote, and vice versa.”

[Appendix II follows]

ANDEAN COMMUNITY DECISION 486

**“TITLE XII
“GEOGRAPHICAL INDICATIONS**

**“CHAPTER I
“Appellations of Origin**

“Article 201. An appellation of origin [*denominación de origen*] shall be understood to be a geographical indication consisting in the name of a particular country, region or place or a name which, without being that of a particular country, region or place, refers to a particular geographical area, and is used to designate a product originating therein the quality, reputation or other characteristics of which are exclusively or essentially due to the geographical environment in which it is produced, including both natural and human factors.”

“Article 202. Those appellations of origin may not be declared such that:

“(a) do not conform to the definition contained in Article 201;

“(b) are common or generic terms to distinguish the product concerned, that is, terms considered such both by persons with knowledge of the area concerned and by the general public;

“(c) are contrary to proper practice or public policy; or

“(d) are liable to mislead the public as to the geographical origin, nature, method of manufacture or quality, reputation or other characteristics of the products concerned.”

“Article 203. The declaration of protection of an appellation of origin shall be made ex officio or at the request of persons who can prove a legitimate interest, understood as being natural persons or legal entities directly engaged in the extraction, production or processing of the product or products to be covered by the appellation of origin, and also associations of producers. State, departmental, provincial or municipal authorities shall likewise be considered interested where the appellations of origin refer to their own areas of concern.”

“Article 204. The application for the declaration of protection of an appellation of origin shall be filed in writing with the competent national office, and the following shall be specified:

“(a) name, domicile, residence and nationality of the applicant or applicants, and also proof of lawful interest;

“(b) the appellation of origin in respect of which the declaration is applied for;

“(c) the limited geographical area of production, extraction or processing of the product to be identified by the appellation of origin;

“(d) the products designated by the appellation of origin; and

“(e) an account of the qualities, reputation or other essential characteristics of the products designated by the appellation of origin.”

“Article 205. Where the application has been accepted for consideration, the competent national office shall, within the following 30 days, ascertain whether it complies with the requirements laid down in this Title and with those of the domestic legislation of the member countries, whereupon it shall observe the procedure for the examination as to form of a mark, as appropriate.”

“Article 206. The validity of the declaration of protection of an appellation of origin shall be subject to the continuing existence of the conditions on which it was based, as determined by the competent national office. This office may declare that validity terminated if the said conditions no longer obtain. Nevertheless, the persons concerned may apply for renewal of the said validity where they consider that the conditions on which protection was based have been restored, without prejudice to the administrative appeals provided for in the domestic legislation of each member country.

“The declaration of protection of the appellation of origin may be amended at any time where any of the elements referred to in Article 204 changes. The amendment shall be subject to the procedure for the declaration of protection, as appropriate.”

“Article 207. Authorization to use a protected appellation of origin shall be applied for by persons who:

“(a) are directly engaged in the extraction, production or processing of the products identified by the appellation of origin;

“(b) conduct the said activity within the demarcated geographical area specified in the declaration of protection; or

“(c) comply with other requirements imposed by competent national offices.”

“Article 208. The competent national office may grant the corresponding authorization of use. Authorization of use may also be granted by the public or private bodies that represent the beneficiaries of the appellations of origin, if national legislation so provides.”

“Article 209. Where the authorization of use is within the jurisdiction of the competent national office, it shall be granted or denied within a period of 15 days following the filing date of the application.”

“Article 210. Authorization to use a protected appellation of origin shall have a term of 10 years, which term may be renewed for equal periods in accordance with the procedure laid down in this Decision for the renewal of marks.”

“Article 211. Authorization to use a protected appellation of origin shall lapse if the renewal thereof is not applied for within the periods laid down in this Decision for the renewal of marks.

“Failure to pay fees shall likewise be a cause of lapse, under the conditions specified in the national legislation of each member country.”

Article 212. The use of appellations of origin in connection with natural, agricultural, craft or industrial products originating in member countries shall be reserved exclusively for producers, manufacturers and craftsmen who have their production or manufacturing establishments in the locality or region of the member country that is designated in or evoked by the said appellation. Only the producers, manufacturers or craftsmen authorized to use a registered appellation of origin may use the expression "appellation of origin" in connection with it.

"The provisions of Articles 155, 156, 157 and 158 shall be applicable to protected appellations of origin as appropriate."

Article 213. Public or private bodies that represent the beneficiaries of appellations of origin, or bodies designated for the purpose, shall have at their disposal such machinery as permits effective control over the use of protected appellations of origin."

Article 214. The protection of appellations of origin shall be initiated by the declaration that the competent national office issues to that end.

"Any use of appellations of origin by an unauthorized person that creates confusion shall be considered an infringement of industrial property rights and punishable, including in cases where the appellations are used in conjunction with terms such as 'variety' [*género*], 'type' [*tipo*], 'imitation' [*imitación*] or other similar terms that mislead the consumer."

Article 215. Member countries shall prohibit the use of an appellation of origin that identifies wines or spirits as products of that type which do not originate from the place designated by the said appellation of origin, even where the true origin of the product is stated or the geographical designation is given in translation or together with expressions such as 'class' [*clase*], 'type' [*tipo*], 'style' [*estilo*], 'imitation' [*imitación*] or other similar qualifiers.

"Member countries may not prevent the continuous and similar use of an appellation of origin of another country that identifies wines or spirits in relation to goods or services by any of their nationals who have been using that appellation continuously for the same or other similar goods or services on the territory of the member country concerned for a minimum of 10 years prior to April 15, 1994 or, in good faith, prior to that date."

Article 216. The competent national authority may, either ex officio or at the request of a party, invalidate its authorization to use a protected appellation of origin if it has been granted in breach of this Decision. The provisions of this Decision on the invalidation of registrations of marks shall be applicable as appropriate."

Article 217. The competent national office may, either ex officio or at the request of a party, cancel the authorization of use where it is shown that the appellation of origin is being used in trade in a manner inconsistent with the specification in the declaration of protection concerned. The provisions of this Decision on the cancellation of registrations of marks shall be applicable as appropriate."

Article 218. Competent national offices may recognize appellations of origin protected in another member country where an application is filed by its producers, extractors, manufacturers or craftsmen who have a legitimate interest, or by the public authorities of that member country.

"For such protection to be applied for, the appellations of origin must have been declared such in their countries of origin."

“**Article 219.** In the case of appellations of origin or geographical indications that are protected in other countries, the competent national offices may accord them protection where it is provided for in any treaty to which the member country is party. In order to apply for such protection, the appellations of origin have to have been declared such in their countries of origin.”

“**Article 220.** Appellations of origin protected under the provisions of this Decision shall not be considered the common or generic designations of the product that they identify for as long as they remain protected in the country of origin.”

“CHAPTER II “Indications of Source

“**Article 221.** An indication of source [*indicación de procedencia*] shall be understood to be a name, expression, image or sign that designates or evokes a particular country, region, locality or place.”

“**Article 222.** An indication of source may not be used in trade in relation to a product or service where it is false or deceptive with respect to its origin, or where its use might mislead the public as to the origin, source, quality or any other characteristic of the product or service.

“For the purposes of the provisions of the foregoing paragraph, use of a geographical indication in trade shall also be constituted by such use as is made in advertising or in any business literature relating to the sale, display or offering for sale of goods or services.”

“**Article 223.** Any person may mention his name or domicile on the goods that he markets, even where they come from a different country, provided that it is accompanied by a specific mention, in sufficiently prominent characters, of the country or place of manufacture or production of the goods, or another statement sufficient to avoid any error as to their true origin.”

[Appendix III follows]

**AGREEMENT REVISING THE BANGUI AGREEMENT OF MARCH 2, 1977,
ON THE CREATION OF AN AFRICAN INTELLECTUAL PROPERTY ORGANIZATION**
(Bangui (Central African Republic), February 24, 1999)

**“ANNEX VI
“GEOGRAPHICAL INDICATIONS**

**“TITLE I
“GENERAL PROVISIONS**

*“Article 1
“Definitions*

“For the purposes of this Annex,

- “(a) ‘geographical indication’ means an indication that serves to identify a product as originating from a territory, a region, or a locality within that territory, in those cases where the quality, reputation or other specific characteristic of the product may be essentially attributed to such geographical origin;
- “(b) ‘product’ means any natural, agricultural, craft or industrial product;
- “(c) ‘producer’ means
- any producer of agricultural products or any other person exploiting natural products,
 - any manufacturer of products of craft or industry,
 - any trader dealing in such products.”

*“Article 2
“Marks Containing a Geographical Indication*

“(1) Registration of a trademark containing a geographical indication or constituted by such indication shall be refused or invalidated if the use of such indication in the trademark for such products is liable to mislead the public as to the true place of origin.

“(2) Likewise, registration of a geographical indication which, although literally exact with respect to the territory, region or locality from which the products originate, shall also be refused or invalidated if it suggests to the public that the products originate from a different territory.”

*“Article 3
“Acquisition of Rights by Foreigners*

“Foreigners shall enjoy the benefits of this Annex if they fulfill the conditions imposed by it.”

**“TITLE II
“CONDITIONS FOR PROTECTION**

*“Article 4
“Conditions for Protection*

“(1) Geographical indications shall be protected as such if they have been registered by the Organization or are to be treated as having been registered by virtue of an international convention to which the member States are party.

“(2) Geographical indications foreign to the territories of the member States of the Organization may be registered by the Organization only where provided for in an international convention to which the member States are party or in the enforcing legislation.”

“Article 5

“*Geographical Indications Excluded from Protection*

“The following shall not be protected as geographical indications:

- “(a) indications which do not correspond to the definition in Article 1(a);
- “(b) indications which are contrary to morality or public policy or those which, in particular, are liable to deceive the public as to the nature, the source, the manufacturing process, the characteristic qualities or the suitability for their purpose of the goods concerned;
- “(c) indications which are not protected in their country of origin or have ceased to be protected or have fallen into disuse in that country.”

“TITLE III

“REGISTRATION PROCEDURE

“Article 6

“*Entitlement to File an Application*

“Natural or legal persons carrying on an activity as a producer in the geographical area specified in the application, with respect to the products specified in the application, as well as groups of such persons, groups of consumers and any competent authority shall be entitled to file an application for registration of a geographical indication.”

“Article 7

“*Filing of the Application*

“Any person wishing to obtain the registration of a geographical indication shall file with the Organization or with the Ministry responsible for industrial property, or send to it by registered mail with a request for acknowledgment of receipt,

- “(a) an application to the Director General of the Organization in a sufficient number of copies;
- “(b) a document proving payment to the Organization of the filing fee;
- “(c) the geographical area to which the indication applies;
- “(d) the products for which the indication is used;
- “(e) the quality, reputation or other characteristic of the products for which the indication is used.”

“Article 8

“*Statement of Filing*

“(1) A statement drawn up by the Organization or by the Ministry responsible for industrial property shall note each filing and specify the date and time of submission of the documents.

“(2) A copy of the statement shall be issued to the applicant.

“(3) The Ministry responsible for industrial property shall forward the documents to the Organization within a period of five working days from the date of filing.”

*“Article 9
“Examination and Registration of Applications*

“(1) For every application for registration of a geographical indication, the Organization shall examine whether the applicant is entitled to apply for registration, whether the application contains the particulars required under Articles 5(b) and 7 and whether the prescribed fees have been paid.

“(2) Where the applicant is not entitled to apply for registration, where the prescribed fees have not been paid or where the geographical indication is contrary to public policy or morality, the application shall be rejected.

“(3) Where the application does not contain the particulars required under Article 7, with the exception of the requirement under letter (b), the application shall be deemed irregular. The irregularity shall be notified to the applicant or his agent with an invitation to regularize the elements within a period of three months as from the date of notification. That period may be extended by 30 days in a case of proven necessity at the request of the applicant or his agent. An application thus put in order within the said period shall retain the date of the original application. Failing regularization of the application within the prescribed time limits, the application shall be rejected.

“(4) Where the requirements of paragraph (1) are fulfilled, the geographical indication shall be registered in the Special Register of Geographical Indications.

“(5) No filing may be rejected under paragraph (3) of this Article unless an opportunity has been given to the applicant or his agent to correct such application to the extent and in accordance with the prescribed procedures and form.”

*“Article 10
“Unacceptability Due to Non-Payment*

“No filing shall be acceptable if the application is not accompanied by a document attesting payment to the Organization of the prescribed fees.”

*“Article 11
“Publication*

“(1) The Organization shall publish the registration and issue to the owner of the registration a certificate containing, in particular, the following particulars as they appear in the Register:

- “(a) serial number of the geographical indication;
- “(b) filing date of the application for registration;
- “(c) geographical area to which the indication applies;
- “(d) products to which the indication applies;
- “(e) identity of the applicant.

“(2) As from publication referred to in paragraph (1) above, any person may obtain an official copy and an extract of entries at his own expense.”

*“Article 12
“Opposition*

“(1) Any interested party may oppose the registration of a geographical indication by sending to the Organization, within a period of six months from the publication mentioned in Article 11 above, a written statement setting out the reasons for his opposition, which reasons must be based on an infringement either of the provisions of Articles 5 and 6 of this Annex, or of a prior right belonging to the opposing party.

“(2) The Organization shall send a copy of the statement of opposition to the applicant or to his agent, who may reply, setting out his reasons, within a once-renewable period of 3 months. The reply shall be forwarded to the opponent or to his representative. If his reply does not reach the Organization by the prescribed time limit, the applicant shall be deemed to have withdrawn his application for registration and the registration shall be cancelled.

“(3) Before taking a decision on the opposition, the Organization shall, on request, hear each or either of the parties or their agents.

“(4) An appeal from the Organization’s decision on canceling the opposition shall lie to the High Commission of Appeal within a period of three months from the date of receipt of notice of the decision by the interested parties.

“(5) The Organization shall only cancel the registration in so far as the aforementioned opposition is valid.

“(6) The final decision on cancellation shall be published in the official Bulletin of the Organization.”

“Article 13

“Access to Information in the Special Register

“(1) Any person may, at any time, against payment of the prescribed fee, consult the Special Register or request, at his own expense, information, extracts or copies of such information.

“(2) The consultation, information, extracts or copies referred to above may relate to one geographical indication only.”

“Article 14

“Cancellation and Modification of Registrations

“(1) Any interested person or competent authority may request the court of a member State to order:

- “(a) cancellation of the registration of a geographical indication on the grounds that, with respect to Article 5, the indication may not as such enjoy protection;
- “(b) modification of the registration of a geographical indication on the grounds that the geographical area referred to in the registration does not correspond to the geographical indication or that the mention of the products for which the geographical indication is used or the mention of the quality, reputation or other characteristic of the products has been omitted or is not justified.”

“(2) In any action instituted under this Article, a notification of the request for cancellation or modification shall be made to the person who has filed the application for registration of the geographical indication or to his successor in title and shall be communicated, by publication in the manner laid down by the Implementing Regulations relating to this Annex, to all persons entitled to use the geographical indication in accordance with Article 15 hereafter.

“(3) The persons referred to in paragraph (2) and any other interested person may submit a petition to intervene within the time limit laid down by the court of the member State in the aforementioned notification and publication.”

“TITLE IV
“RIGHT TO USE
A GEOGRAPHICAL INDICATION;
UNLAWFUL USE

“Article 15
“Use of a Geographical Indication

“(1) Subject to paragraphs (2) and (3) hereafter, only producers carrying on their activity for commercial purposes in the geographical area specified in the Register shall have the right to use a registered geographical indication with respect to the products specified in the register, provided that such products possess the essential characteristic qualities specified in the register.

“(2) Where products have been put into circulation under the conditions defined in the preceding paragraph, under a registered geographical indication, any person shall have the right to use the geographical indication for those products.

“(3) Apart from the cases referred to in the preceding paragraphs (1) and (2), it shall be unlawful to use, for commercial purposes, a registered geographical indication, or a similar designation, with respect to the products specified in the Register or similar products, even if the true origin of the products is indicated or if the geographical indication is in the form of a translation or is accompanied by terms such as ‘kind’, ‘type’, ‘make’, ‘imitation’ or the like.

“(4) The competent national authority of the member State concerned may decide by regulation that the quality of products put on sale or used under a registered geographical indication shall be subjected to control or that the use of such geographical indication shall be prohibited.

“(5) It shall be unlawful to use in the designation or presentation of a product any means that infers or suggests that the product concerned originates in a geographical area other than its true place of origin in a manner likely to mislead the public as to the geographical origin of the product.

“(6) The owner of an earlier mark that is identical with or similar to a geographical indication may continue to use his mark, except where such mark concerns wines or spirits.”

“Article 16
“Civil Action

“(1) Any interested person or any interested group of producers or consumers may bring actions to obtain the relief provided for in paragraph (2) against persons making unlawful use, within the meaning of Article 15(3) and (5), of a registered geographical indication and against persons contributing to such use.

“(2) Without prejudice to paragraph (3), the actions shall be to enjoin the unlawful use, within the meaning of Article 15(3) and (5), of a registered geographical indication, or to prohibit such use where it is imminent, and to destroy the labels and other documents which have contributed or are likely to contribute to such unlawful use.

“(3) Any person who has suffered damage as a result of the unlawful use, within the meaning of Article 15(3) and (5), of a registered geographical indication may require compensation from the person making unlawful use of the indication and persons who have contributed to such use.”

*“Article 17
“Penal Action*

“Any person intentionally making unlawful use, within the meaning of Article 15(3) and (5), of a registered geographical indication shall be liable to a term of imprisonment of not less than three months and not more than one year and to a fine of from 1,000,000 to 6,000,000 CFA francs, or one only of these penalties.”

“TITLE V
“TRANSITIONAL AND FINAL PROVISIONS

*“Article 18
“Acquired Rights*

“(1) This Annex shall apply to applications for protection of geographical indications filed as from the date of its entry into force, subject to the rights acquired under Annex VI of the Bangui Agreement of March 2, 1977.

“(2) Applications for registration of appellations of origin filed prior to the date of entry into force of this Annex shall remain subject to the provisions that were applicable on the filing date of the said applications.

“(3) However, the exercise of the rights deriving from appellations of origin registered under the provisions referred to in paragraph (2) above shall be subject to the provisions of this Annex as from the date of its entry into force, subject to acquired rights, which shall be maintained.

“(4) Annex VI of the Bangui Agreement of March 2, 1977, is repealed.”

[Appendix IV follows]

**PROVISIONS ON THE SCOPE OF PROTECTION OF DESIGNATIONS OF ORIGIN AND
GEOGRAPHICAL INDICATIONS IN EUROPEAN UNION LEGISLATION**

COUNCIL REGULATION (EC) NO 479/2008

OF 29 APRIL 2008

ON THE COMMON ORGANISATION OF THE MARKET IN WINE, AMENDING REGULATIONS
(EC) NO 1493/1999, (EC) NO 1782/2003, (EC) NO 1290/2005, (EC) NO 3/2008 AND
REPEALING REGULATIONS (EEC) NO 2392/86 AND (EC) NO 1493/1999

[...]

“Article 45

“Protection

“1. Protected designations of origins and geographical indications may be used by any operator marketing a wine which has been produced in conformity with the corresponding product specification.

“2. Protected designations of origins and geographical indications and the wines using those protected names in conformity with the product specification¹ shall be protected against:

“(a) any direct or indirect commercial use of a protected name:

“(i) by comparable products not complying with the product specification of the protected name; or

“(ii) in so far as such use exploits the reputation of a designation of origin or a geographical indication;

¹ As regards homonyms, Article 42 reads as follows:

“1. A name, for which an application is lodged, wholly or partially homonymous with that of a name already registered under this Regulation shall be registered with due regard for local and traditional usage and the risk of confusion.

“A homonymous name which misleads the consumer into believing that products come from another territory shall not be registered even if the name is accurate as far as the actual territory, region or place of origin of the products in question is concerned.

“The use of a registered homonymous name shall be subject to there being a sufficient distinction in practice between the homonym registered subsequently and the name already on the register, having regard to the need to treat the producers concerned in an equitable manner and not to mislead the consumer.

“2. Paragraph 1 shall apply *mutatis mutandis* if a name, for which an application is lodged, is wholly or partially homonymous with a geographical indication protected as such under the legislation of Member States.

“Member States shall not register non-identical geographical indications for protection under their respective legislation on geographical indications if a designation of origin or geographical indication is protected in the Community by virtue of the Community law relevant to designations of origin or geographical indications.

“3. Save as otherwise provided for in Commission implementing measures, where the name of a wine grape variety contains or consists of a protected designation of origin or geographical indication that name shall not be used for purposes of labeling the products covered by this Regulation.

“4. The protection of designations of origin and geographical indications for products covered in Article 34 shall be without prejudice to protected geographical indications applying in relation to spirit drinks within the meaning of Regulation (EC) No 110/2008 of the European Parliament and of the Council of 15 January 2008 on the definition, description, presentation, labeling and the protection of geographical indications of spirit drinks and vice versa.”

“(b) any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’, ‘flavour’, ‘like’ or similar;

“(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the wine product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;

“(d) any other practice liable to mislead the consumer as to the true origin of the product.

“3. Protected designations of origin or protected geographical indications shall not become generic in the Community within the meaning of Article 43(1).²

“4. Member States shall take the steps necessary to stop unlawful use of protected designations of origin and geographical indications as referred to in paragraph 2.”

[...]

² Article 43(1) reads as follows:

“1. Names that have become generic shall not be protected as a designation of origin or geographical indication.

“For the purposes of this Chapter, a ‘name that has become generic’ means the name of a wine which, although it relates to the place or the region where this product was originally produced or marketed, has become the common name of a wine in the Community.

“To establish whether or not a name has become generic, account shall be taken of all relevant factors, in particular:

“(a) the existing situation in the Community, notably in areas of consumption;

“(b) the relevant national or Community legal provisions.”

COUNCIL REGULATION (EEC) NO 1601/91

OF 10 JUNE 1991

LAYING DOWN GENERAL RULES ON THE DEFINITION, DESCRIPTION AND PRESENTATION OF
AROMATIZED WINES, AROMATIZED WINE-BASED DRINKS AND AROMATIZED WINE-PRODUCT
COCKTAILS

[...]

“Article 6

“1. The use of the descriptions referred to in Article 2 and in this Article shall be restricted to the drinks defined therein, account being taken of the requirements laid down in Articles 2 and 4. The descriptions in question must be used to describe the said drinks in the Community.

“Drinks which do not meet the requirements laid down for the drinks defined in Article 2 may not bear the descriptions assigned to the latter therein.

“2. (a) The geographical designations listed in Annex II may replace the descriptions referred to in paragraph 1 or supplement them, forming composite descriptions.

“(b) These geographical designations shall be reserved for drinks in respect of which the production stage during which they acquired their character and definitive qualities took place in the geographical area indicated, provided that the consumer is not misled as to the raw material used.

“3. The sales descriptions referred to in paragraph 1 may not be supplemented by geographical ascriptions allowed for wine products.”

[...]

“Article 7

“1. The sales description of aromatized drinks containing wine products and flavourings and with a minimum alcohol strength by volume of 1,2 % vol which do not comply with this Regulation shall contain no reference to wine-sector products.

“2. Aromatized drinks which do not comply with this Regulation may not be marketed for human consumption by associating words or phrases such as ‘like’, ‘type’, ‘style’, ‘make’, ‘flavour’ or any other similar indications with any of the descriptions mentioned in this Regulation.”

[...]

“Article 8

“1. In addition to complying with national rules adopted in accordance with Directive 79/112/EEC, the labelling, presentation and advertising of the drinks referred to in Article 2 shall comply with this Article.

"2. The sales description of the products referred to in Article 2 shall be one of the descriptions to be used exclusively for such products under Article 6.

[...]

"5. The geographical designations listed in Annex II may not be translated."

[...]

"Article 10

"In order to be marketed for human consumption within the Community, imported drinks defined by this Regulation and bearing a geographical ascription may, subject to reciprocal arrangements, qualify for the supervision and protection referred to in the second subparagraph of Article 9 (1).

"The first subparagraph shall be implemented by agreements to be negotiated and concluded with the third countries concerned under the procedure laid down in Article 113 of the Treaty.

"The implementing rules and the list of products referred to in the first subparagraph shall be adopted in accordance with the procedure laid down in Article 14."

"Article 10a

"1. Member States shall adopt all measures necessary to permit those concerned to prevent, under the conditions laid down in Articles 23 and 24 of the Agreement on Trade-Related Aspects of Intellectual Property Rights, the use within the Community of a geographical designation identifying products covered by this Regulation for products which do not originate in the place referred to by the geographical designation in question, including in cases where the actual origin of the product is indicated or where the geographical designations given in translation or accompanied by expressions such as 'like', 'type', 'style', 'imitation' or other.

"For the purposes of this Article, 'geographical designation' shall mean any indication identifying a product as originating in the territory of a third country which is a member of the World Trade Organization, or in a region or locality of that territory, where a quality, reputation or other specific characteristic of that product can essentially be attributed to that geographical origin.

"2. Paragraph 1 shall apply notwithstanding Article 10 of this Regulation and other provisions of Community legislation laying down rules for the description and presentation of products covered by this Regulation."

[...]

"Article 11

"Other than in the case of exceptions to be decided in accordance with the procedure laid down in Article 13, aromatized wines, aromatized wine-based drinks and aromatized wine-product cocktails intended for export must comply with the provisions of this Regulation."

[...]

REGULATION (EC) NO 110/2008 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL
OF 15 JANUARY 2008

ON THE DEFINITION, DESCRIPTION, PRESENTATION, LABELLING AND THE PROTECTION
OF GEOGRAPHICAL INDICATIONS OF SPIRIT DRINKS AND REPEALING COUNCIL
REGULATION (EEC) NO 1576/89

[...]

“Article 9

“Specific rules concerning sales denominations

“1. Spirit drinks which meet the specifications for the products defined in categories 1 to 46 of Annex II shall bear in their description, presentation and labeling the sales denomination assigned therein.

“2. Spirit drinks which meet the definition laid down in Article 2 but which do not meet the requirements for inclusion in categories 1 to 46 of Annex II shall bear in their description, presentation and labeling the sales denomination ‘spirit drink’. Without prejudice to paragraph 5 of this Article, that sales denomination shall not be replaced or altered.

[...]

“5. Sales denominations may be supplemented or replaced by a geographical indication registered in Annex III and in accordance with Chapter III, or supplemented in accordance with national provisions by another geographical indication, provided that this does not mislead the consumer.”

[...]

“Article 10

“Specific rules concerning the use of sales denominations and geographical indications

“1. Without prejudice to Directive 2000/13/EC, the use of a term listed in categories 1 to 46 of Annex II, or of a geographical indication registered in Annex III in compound term or the allusion in the presentation of a foodstuff to any of them shall be prohibited unless the alcohol originates exclusively from the spirit drink(s) referred to.”

[...]

“Article 14

“Use of language in the description, presentation and labeling of spirit drinks

[...]

“2. The terms in italics in Annex II and the geographical indications registered in Annex III shall not be translated on the label nor in the presentation of the spirit drink.”

[...]

“Article 15

“Geographical indications

[...]

“3. The geographical indications registered in Annex III may not become generic.

“Names that have become generic may not be registered in Annex III.

“A name that has become generic means the name of a spirit drink which, although it relates to the place or region where this product was originally produced or placed on the market, has become the common name of a spirit drink in the Community.”

[...]

“Article 16

“Protection of geographical indications

“Without prejudice to Article 10, the geographical indications, the geographical indications registered in Annex III³ shall be protected against:

“(a) any direct or indirect commercial use in respect of products not covered by the registration in so far as those products are comparable to the spirit drink registered under that geographical indication or insofar as such use exploits the reputation of the registered geographical indication;

“(b) any misuse, imitation or evocation, even if the true origin of the product is indicated or the geographical indication is used in translation or accompanied by an expression such as ‘like’, ‘type’, ‘style’, ‘made’, ‘flavour’ or any other similar term;

“(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities on the description, presentation or labeling of the product, liable to convey a false impression as to its origin;

“(d) any other practice liable to mislead the consumer as to the true origin of the product.”

[...]

³

As regards homonyms, Article 19 reads as follows:

“A homonymous geographical indication meeting the requirements of this Regulation shall be registered with due regard for local and traditional usage and the actual risk of confusion, in particular:

“— a homonymous name which misleads the consumer into believing that products come from another territory shall not be registered even if the name is accurate as far as its wording is concerned for the actual territory, region or place of origin of the spirit drink in question;

“— the use of a registered homonymous geographical indication shall be subject to there being a clear distinction in practice between the homonym registered subsequently and the name already on the register, having regard to the need to treat the producers concerned in an equitable manner and not to mislead consumers.”

COUNCIL REGULATION (EC) NO 510/2006

OF 20 MARCH 2006

ON THE PROTECTION OF GEOGRAPHICAL INDICATIONS AND DESIGNATIONS OF ORIGIN
FOR AGRICULTURAL PRODUCTS AND FOODSTUFFS

[...]

“Article 13

“Protection

- “1. Registered names⁴ shall be protected against:
- “(a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration in so far as those products are comparable to the products registered under that name or in so far as using the name exploits the reputation of the protected name;
- “(b) any misuse, imitation or evocation, even if the true origin of the product is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’ or similar;

⁴ As regards “generic nature”, “conflicts with names of plant varieties”, “animal breeds” and “homonyms”, Article 3 of the Regulation reads as follows:

“1. Names that have become generic may not be registered.

“For the purposes of this Regulation, a ‘name that has become generic’ means the name of an agricultural product or a foodstuff which, although it relates to the place or the region where this product or foodstuff was originally produced or marketed, has become the common name of an agricultural product or a foodstuff in the Community.

“To establish whether or not a name has become generic, account shall be taken of all factors, in particular:

“(a) the existing situation in the Member States and in areas of consumption;

“(b) the relevant national or Community laws.

“2. A name may not be registered as a designation of origin or a geographical indication where it conflicts with the name of a plant variety or an animal breed and as a result is likely to mislead the consumer as to the true origin of the product.

“3. A name wholly or partially homonymous with that of a name already registered under this Regulation shall be registered with due regard for local and traditional usage and the actual risk of confusion. In particular:

“(a) a homonymous name which misleads the consumer into believing that products come from another territory shall not be registered even if the name is accurate as far as the actual territory, region or place of origin of the agricultural products or foodstuffs in question is concerned;

“(b) the use of a registered homonymous name shall be subject to there being a sufficient distinction in practice between the homonym registered subsequently and the name already on the register, having regard to the need to treat the producers concerned in an equitable manner and not to mislead the consumer.”

“(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;

“(d) any other practice liable to mislead the consumer as to the true origin of the product.

“Where a registered name contains within it the name of an agricultural product or foodstuff which is considered generic, the use of that generic name on the appropriate agricultural product or foodstuff shall not be considered to be contrary to points (a) or (b) in the first subparagraph.

“2. Protected names may not become generic.

“3. In the case of names for which registration is applied for under Article 5, provision may be made for a transitional period of up to five years under Article 7(5), solely where a statement of objection has been declared admissible on the grounds that registration of the proposed name would jeopardise the existence of an entirely or partly identical name or the existence of products which have been legally on the market for at least five years preceding the date of the publication provided for in Article 6(2).

“A transitional period may also be set for undertakings established in the Member State or third country in which the geographical area is located, provided that the undertakings concerned have legally marketed the products in question, using the names concerned continuously for at least five years preceding the date of the publication referred to in Article 6(2) and have noted that point in the national objection procedure referred to in the first and second subparagraphs of Article 5(5) or the Community objection procedure referred to in Article 7(2). The combined total of the transitional period referred to in this subparagraph and the adjustment period referred to in Article 5(6) may not exceed five years. Where the adjustment period referred to in Article 5(6) exceeds five years, no transitional period shall be granted.

“4. Without prejudice to Article 14, the Commission may decide to allow, under the procedure provided for in Article 15(2), the coexistence of a registered name and an unregistered name designating a place in a Member State or in a third country where that name is identical to the registered name, provided that all the following conditions are met:

“(a) the identical unregistered name has been in legal use consistently and equitably for at least 25 years before 24 July 1993;

“(b) it is shown that the purpose of its use has not at any time been to profit from the reputation of the registered name and that the consumer has not been nor could be misled as to the true origin of the product;

“(c) the problem resulting from the identical names was raised before registration of the name.

“The registered name and the identical unregistered name concerned may co-exist for a period not exceeding a maximum of 15 years, after which the unregistered name shall cease to be used.

“Use of the unregistered geographical name concerned shall be authorised only where the country of origin is clearly and visibly indicated on the label.”

[...]

[Appendix V follows]

**PROVISIONS IN EUROPEAN UNION LEGISLATION CONCERNING THE RELATIONSHIP
BETWEEN TRADEMARKS, DESIGNATIONS OF ORIGIN AND GEOGRAPHICAL
INDICATIONS**

COUNCIL REGULATION (EC) NO 479/2008

OF 29 APRIL 2008

ON THE COMMON ORGANISATION OF THE MARKET IN WINE, AMENDING REGULATIONS
(EC) NO 1493/1999, (EC) NO 1782/2003, (EC) NO 1290/2005, (EC) NO 3/2008 AND
REPEALING REGULATIONS (EEC) NO 2392/86 AND (EC) NO 1493/1999

"Article 43

"Grounds for refusal of protection

[...]

"2. A name shall not be protected as a designation of origin or geographical indication where, in the light of a trademark's reputation and renown, protection is liable to mislead the consumer as to the true identity of the wine."

"Article 44

"Relationship with trademarks

"1. Where a designation of origin or a geographical indication is protected under this Regulation, the registration of a trademark corresponding to one of the situations referred to in Article 45(2) and relating to a product falling under one of the categories listed in Annex IV shall be refused if the application for registration of the trademark is submitted after the date of submission of the application for protection of the designation of origin or geographical indication is subsequently protected.

"Trademarks registered in breach of the first subparagraph shall be invalidated.

"2. Without prejudice to Article 43(2), a trademark the use of which corresponds to one of the situations referred to in Article 45(2)¹, which has been applied for, registered or established by use, if that possibility is provided for by the legislation concerned, in the territory of the Community before the date on which the application for protection of the designation of origin or geographical indication is submitted to the Commission, may continue to be used and renewed notwithstanding the protection of a designation of origin or geographical indication, provided that no grounds for the trademark's invalidity or revocation exist as specified by the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks or Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.

"In such cases the use of the designation of origin or geographical indication shall be permitted alongside the relevant trademarks."

¹ Article 45(2) is reflected in Appendix IV above.

REGULATION (EC) NO 110/2008 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL
OF 15 JANUARY 2008

ON THE DEFINITION, DESCRIPTION, PRESENTATION, LABELLING AND THE PROTECTION
OF GEOGRAPHICAL INDICATIONS OF SPIRIT DRINKS AND REPEALING COUNCIL
REGULATION (EEC) NO 1576/89

“Article 23

“Relation between trade marks and geographical indications

“1. The registration of a trade mark which contains or consists of a geographical indication registered in Annex III shall be refused or invalidated if its use would lead to any of the situations referred to in Article 16².

“2. With due regard to Community law, a trade mark the use of which corresponds to one of the situations referred to in Article 16 which has been applied for, registered, or established by use, if that possibility is provided for by the legislation concerned, in good faith within the territory of the Community, before either the date of protection of the geographical indication in the country of origin or before 1 January 1996, may continue to be used notwithstanding the registration of a geographical indication, provided that no grounds for its invalidity or revocation exist as specified by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks or Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.

“3. A geographical indication shall not be registered where, in the light of a trade mark’s reputation and renown and the length of time it has been used in the Community, registration is liable to mislead the consumer as to the true identity of the product.”

² Article 16 is reflected in Appendix IV above.

COUNCIL REGULATION (EC) NO 510/2006

OF 20 MARCH 2006

ON THE PROTECTION OF GEOGRAPHICAL INDICATIONS AND DESIGNATIONS OF ORIGIN
FOR AGRICULTURAL PRODUCTS AND FOODSTUFFS

[...]

“Article 3

**“Generic nature, conflicts with names of plant varieties,
animal breeds and trademarks**

[...]

“4. A designation of origin or geographical indication shall not be registered where, in the light of a trademark’s reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product.”

[...]

“Article 14

**“Relations between trademarks, designations of origin
and geographical indications**

“1. Where a designation of origin or a geographical indication is registered under this Regulation, the application for registration of a trademark corresponding to one of the situations referred to in Article 13³ and relating to the same class of product shall be refused if the application for registration of the trademark is submitted after the date of submission of the registration application to the Commission.

“Trademarks registered in breach of the first subparagraph shall be invalidated.

“2. With due regard to Community law, a trademark the use of which corresponds to one of the situations referred to in Article 13 which has been applied for, registered, or established by use, if that possibility is provided for by the legislation concerned, in good faith within the territory of the Community, before either the date of protection of the designation of origin or geographical indication in the country of origin or before 1 January 1996, may continue to be used notwithstanding the registration of a designation of origin or geographical indication, provided that no grounds for its invalidity or revocation exist as specified by First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks or Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.”

[...]

[End of Appendix V and of document]

³ Article 13 is reflected in Appendix IV above.