

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

Second Session Geneva, August 30 to September 3, 2010

Summary by the Chair

approved by the Working Group

1. The Working Group on the Development of the Lisbon System (Appellations of Origin) (hereinafter referred to as "the Working Group") met in Geneva from August 30 to September 3, 2010.
2. The following Contracting Parties of the Lisbon Union were represented at the session: Algeria, Burkina Faso, Congo, Costa Rica, Cuba, Democratic People's Republic of Korea, France, Georgia, Hungary, Iran (Islamic Republic of), Israel, Italy, Mexico, Nicaragua, Peru, Portugal, Republic of Moldova, The former Yugoslav Republic of Macedonia*, Tunisia (19).
3. The following States were represented as observers: Belgium, Chile, Germany, Iraq, Morocco, Romania, Slovenia, Spain, Switzerland, Thailand, Turkey, Ukraine, United States of America, Zimbabwe (14).

* On July 6, 2010, the Government of the former Yugoslav Republic of Macedonia deposited its instrument of accession to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration. The Lisbon Agreement will enter into force with respect to the former Yugoslav Republic of Macedonia on October 6, 2010.

4. Representatives of the following international intergovernmental organizations took part in the session in an observer capacity: Economic Community of West African States (ECOWAS), European Union (EU), Food and Agriculture Organization of the United Nations (FAO), International Olive Oil Council (IOOC), World Trade Organization (WTO) (5).
5. Representatives of the following international non-governmental organizations took part in the session in an observer capacity: Brazilian Intellectual Property Association (ABPI), Centre for International Intellectual Property Studies (CEIPI), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), MARQUES (Association of European Trademark Owners), Organization for an International Geographical Indications Network (OriGIn) (6).
6. The list of participants is contained in document LI/WG/DEV/2/INF/1 Prov. 2.

Agenda Item 1: Opening of the Session

7. Mr. Francis Gurry, Director General, opened the session, recalled the mandate of the Working Group and introduced the draft agenda, as contained in document LI/WG/DEV/2/1 Prov. 2.

Agenda Item 2: Election of a Chair and two Vice-Chairs

8. Mr. Mihály Ficsor (Hungary) was unanimously elected as Chair of the Working Group, Mrs. Patricia Victoria Gamboa Vilela (Peru) and Mr. Howard Poliner (Israel) were elected as Vice-Chairs.
9. Mr. Matthijs Geuze (WIPO) acted as Secretary to the Working Group.

Agenda Item 3: Adoption of the Agenda

10. The Working Group adopted the draft agenda (document LI/WG/DEV/2/1 Prov. 2) without modification. It was nonetheless agreed that item 6 of the agenda (Results of the Survey on the Lisbon System) would be discussed before item 5 (Study on the Relationship Between Regional Systems for the Protection of Geographical Indications and the Lisbon System and the Conditions for, and Possibility of, Future Accession to the Lisbon Agreement by Competent Intergovernmental Organizations).

Agenda Item 4: Adoption of the Report of the First Session of the Working Group

11. The Working Group adopted the Revised Draft Report of the First Session of the Working Group (document LI/WG/DEV/1/4 Prov. 2) without modification.

Agenda Item 5: Study on the Relationship Between Regional Systems for the Protection of Geographical Indications and the Lisbon System and the Conditions for, and Possibility of, Future Accession to the Lisbon Agreement by Competent Intergovernmental Organizations

12. Discussions were based on document LI/WG/DEV/2/3.
13. The Chair concluded that the Working Group was of the view that Part A of the document provided a correct analysis of the current application of the Lisbon system within the regional systems concerned.
14. As far as part B was concerned, although there were still a number of issues to be clarified, the Chair observed that there was wide support for opening up the Lisbon system to the accession of competent intergovernmental organizations.
15. The Chair concluded that the criteria identified by the study to determine whether a given intergovernmental organization was in a position to accede to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (hereinafter referred to as the "Lisbon Agreement") were appropriate, relevant and acceptable to the Working Group. The Chair added that it will have to be examined on an individual basis whether and how the intergovernmental organization concerned meets these criteria.
16. The Chair also noted that internal issues surrounding the possible accession by an intergovernmental organization would have to be dealt with by the intergovernmental organization itself.
17. The Chair concluded that the Working Group had agreed that, in accordance with paragraphs 14 to 16, above, the draft provisions referred to in paragraph 38, below, should also deal with the possible accession by competent intergovernmental organizations.

Agenda Item 6: Results of the Survey on the Lisbon System

18. Discussions were based on document LI/WG/DEV/2/2. In these discussions, in particular, the following observations were made:

Question 1: The Basis for Protection in the Country of Origin (paragraphs 1 to 9)

19. The Chair observed that, while Contracting Parties were of the view that it can be inferred from the current legal framework that Article 1(2) of the Lisbon Agreement and Rule 5(2)(a)(vi) of its Regulations allow for flexibility, as long as the requirements of Articles 2 and 3 of the Agreement are met, observers would rather prefer such flexibility to be formalized, for example by deletion of the words "as such" from Article 1(2).

Question 2: Terminology and Definitions (paragraphs 10 to 27)

20. The Chair noted that most delegations were in favor of a system in which there would be two separate definitions, one on appellations of origin along the lines of Article 2 of the Lisbon Agreement and the other on geographical indications along the lines of Article 22.1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). He also noted that, for some participants, two separate definitions would imply differences in the scope of protection.
21. The Chair also observed that with two separate definitions, for appellations of origin and geographical indications, there would be no need to change the way in which Article 2 of the Lisbon Agreement refers to "reputation".
22. The Chair observed that no opposition was expressed against extending the protection conferred by the Lisbon Agreement to traditional non-geographical denominations.
23. The Chair noted that there was support for a definition of "country of origin" which is not limited to "countries", but also allows for international registrations by intergovernmental organizations. There was also support for the introduction of an option concerning joint international registrations by two or more countries which share the territory of the production area.

Question 3 and 4: Scope of Protection (paragraphs 28 to 47)

24. The Chair concluded that a number of Contracting Parties were of the view that the expression "usurpation or imitation" in Article 3 of the Lisbon Agreement was clear enough, but noted that other delegations had requested further clarification and modernization of those terms.
25. The Chair also noted that there was growing support in the Working Group for an extension of the protection to products that were not of the same kind, but that diverse opinions had been expressed concerning the criteria that could be used in that regard.

Question 5: Application and Registration Procedures (paragraphs 48 to 57)

26. The Chair concluded that the prevailing view was that the application and registration procedures did not require any particular improvement.
27. The Chair concluded that the Working Group seemed almost unanimously opposed to the idea of adding additional mandatory requirements for international applications, but noted the suggestion that optional elements might be added instead (for example those that would help ascertain whether definition requirements were met, or whether the link between the product and a precise geographical area had been established).
28. The Chair also noted that the idea to allow for the registration of designs or images as appellations of origin did not gain particular support.

Question 6: Declarations of Refusal (paragraphs 58 to 77)

29. The Chair concluded that many Contracting Parties were of the view that an amendment of the current legal framework was not necessary.
30. The Chair noted that the time limit under Article 5(3) of the Lisbon Agreement needed not be extended in respect of new international registrations, but that there might be a need to establish a longer time limit under Article 14(2)(c) for newly acceding countries, although Article 14(5)(b) may already provide sufficient flexibility in that regard.
31. As far as the admitted grounds for refusal were concerned, the Chair observed that important guarantees were already given to prior rights under the Lisbon Regulations given the fact that, contrary to other grounds for refusal, earlier rights and earlier trademark rights were explicitly mentioned in Rule 9(2)(iii) of the Lisbon Regulations.

Question 7: Generic Appellations (paragraphs 78 to 86)

32. The Chair concluded that delegations were of the view, although for different reasons, that an amendment to Article 6 of the Lisbon Agreement was not necessary.

Question 8: Invalidation (paragraphs 87 to 98)

33. The Chair noted the fact that some delegations were of the view that no particular amendment to Rule 16 under the Lisbon Regulations seemed necessary, while others were, on the contrary, calling for certain refinements in the text.
34. The Chair concluded that there was support for the proposal that the grounds for invalidation should be indicated in notifications of invalidation.
35. The Chair also noted that most delegations did not believe that the rules and procedures allowing for invalidation of the effects of an international registration at the national level had to be dealt with in the Agreement itself and took the view that the rules and procedures in question had to be dealt with at the domestic level.

Question 9: Prior Users (paragraphs 99 to 110)

36. The Chair noted that there was a clear split on this issue, even though the divide might not be so deep. In consequence, the Chair indicated that Article 5(6) should be among the issues to be dealt with.

Question 10: Other Issues (paragraphs 111 to 127)

37. The Chair concluded that the suggestions made under Question 10 might be taken up at a later stage.

Further Work

38. The Chair concluded that the Working Group had agreed that, for its next session, the International Bureau prepare draft provisions on the various topics addressed under Questions 1 to 9, taking into account all comments made in the current session, in order for the work on the development of the Lisbon system to become more focused. These draft provisions should contain alternative versions and leave open the question as to the legal instrument by which they might be formalized, while preserving the principles and objectives of the Lisbon Agreement.
39. The Chair also concluded that the Working Group had agreed to invite the Secretariat to prepare a study on the possibility of dispute settlement within the Lisbon system, as it might be useful to explore in which situations dispute settlement might be appropriate and in what form. He further indicated that the study could also include information on the existing dispute settlement systems in the intellectual property area and the legislative history in that regard.

Agenda Item 7: Summary by the Chair

40. The Working Group approved the Summary by the Chair as contained in the present document.
41. A draft of the full report of the session of the Working Group will be distributed for comments among the delegations and representatives that participated in the meeting. Any such comments can be submitted within two months from the distribution date, after which the draft report will be amended, as required, and made available to delegations on the WIPO website, for its formal adoption in due course.

Agenda Item 8: Closing of the Session

42. The Chair closed the session on September 3, 2010.

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