

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

Sixth Session
Geneva, December 3 to 7, 2012

NOTES ON THE DRAFT NEW INSTRUMENT

Document prepared by the Secretariat

1. The Annexes of the present document contains Notes on the Draft New Instrument on the International Registration of Geographical Indications and Appellations of Origin, as contained in document LI/WG/DEV/6/2, which is now presented in the form of two draft instruments, namely a Revised Lisbon Agreement (Annex I) and a Draft Protocol/Treaty on Geographical Indications (Annex II). Where a provision appears not to require explanation, no note has been provided.

[Annexes follow]

NOTES ON THE DRAFT REVISED LISBON AGREEMENT

TABLE OF CONTENTS

List of Articles

Chapter I: Introductory and General Provisions

Notes on Article 1:	Abbreviated Expressions
Notes on Article 2:	Subject-Matter
Notes on Article 3:	Competent Authority
Notes on Article 4:	International Register
Notes on Article 5:	Applicability of Other Protection Accorded by Laws of Contracting Parties and by Certain International Treaties

Chapter II: Application and International Registration

Notes on Article 6:	Application
Notes on Article 7:	International Registration
Notes on Article 8:	Fees

Chapter III: Effects of International Registration

Notes on Article 9:	Protection of Registered Appellations of Origin
Notes on Article 10:	Protection Accorded by International Registration
Notes on Article 11:	Shield Against Becoming a [Generic] [Customary] Term or Name
Notes on Article 12:	Duration of Protection
Notes on Article 13:	Prior Rights
Notes on Article 14:	[Legal Proceedings] [Legal Remedies]

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

Notes on Article 15:	Refusal
Notes on Article 16:	Withdrawal of Refusal
Notes on Article 17:	Prior Use
Notes on Article 18:	Notification of Grant of Protection
Notes on Article 19:	Invalidation
Notes on Article 20:	Modifications and Other Entries in the International Register

Chapter V: Administrative Provisions

Notes on Article 21: Membership of the Lisbon Union
Notes on Article 22: Assembly of the Special Union
Notes on Article 23: International Bureau
Notes on Article 24: Finances
Notes on Article 25: Regulations

Chapter VI: Revision and Amendment

Notes on Article 26: Revision
Notes on Article 27: Amendment of Certain Articles by the Assembly

Chapter VII: Final Provisions

Notes on Article 28: Becoming Party to This Act
Notes on Article 29: Effective Date of Ratifications and Accessions
Notes on Article 30: Prohibition of Reservations
Notes on Article 31: Application of the Lisbon Agreement
Notes on Article 32: Denunciation
Notes on Article 33: Languages of This Act; Signature
Notes on Article 34: Depositary

NOTES ON ARTICLE 1: ABBREVIATED EXPRESSIONS

1.01 Following the example of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (hereinafter referred to as “the Geneva Act”), Article 1 explains a certain number of abbreviated expressions and defines several terms used throughout the Draft Revised Lisbon Agreement. While several abbreviated expressions and definitions contained in Article 1 are similar to those contained in the Regulations under the Lisbon Agreement, others have been added whenever it appeared necessary as in the case of the provisions below.

1.02 The rules applying to the adoption procedure of a revised Act of the Lisbon Agreement, as in the case of the present Draft Revised Lisbon Agreement, specify that only States party to the Lisbon Agreement will have the right to call a revision conference – see Article 13(2) of the Lisbon Agreement – and only those States will have a right to vote at such a conference. As regards the rules on amendment and modification of multilateral treaties, reference is made to Part IV of the Vienna Convention on the Law of Treaties.

1.03 Item (xv): the term “Competent Authority” also applies to the authority jointly designated by two or more Contracting Parties in each of which parts of a geographical area of origin are situated – see Article 6(5)(a)(ii) –, if such Contracting Parties have established an appellation of origin jointly in respect of products originating in a trans-border geographical area delimited jointly by adjacent Contracting Parties as referred to in Article 2(2).

1.04 Item (xiii) defines the term “Contracting Party”, which is used instead of the term “countries” in the Lisbon Agreement, as the Draft Revised Lisbon Agreement is aimed to be open for accession by States as well as intergovernmental organizations.

1.05 Item (xiv) defines the term “Contracting Party of Origin”. The notion of “Contracting Party of Origin” is used to determine which is the Contracting Party that is eligible to register a given appellation of origin. The determining factors in this respect are 1) the geographical area of origin of the product – and 2) the legislation under which the appellation of origin is protected in the territory of the Contracting Party where the geographical area of origin is situated – see Article 6(1) –, which is also important for determining which Contracting Party should be regarded as the Contracting Party of Origin in the case of a Contracting Party that is a member State of an intergovernmental organization.

1.06 Item (xvi): as the Draft Revised Lisbon Agreement would be open both to States and to certain types of intergovernmental organizations, the accession criteria for intergovernmental organizations have been set out in Article 28(1)(ii).

1.07 Item (xii): as regards the possible registration of an appellation of origin in respect of a product from a geographical area of origin situated in more than one Contracting Party, reference is made to Articles 2(2) and 6(5).

NOTES ON ARTICLE 2: SUBJECT-MATTER

2.01 Paragraph (1) of Article 2 defines the object of protection under the Draft Revised Lisbon Agreement, namely appellations of origin. This provision is based on the definition of Article 2 of the Lisbon Agreement. Following the concern expressed by several delegations at the fifth session of the Lisbon Working Group as regards the geographical coverage of the notion of “geographical area situated in a Contracting Party”, a footnote has been inserted in the text to make it clear that the geographical area in question may consist of the entire territory of a

Contracting Party. Along the same lines, for purposes of further addressing the concerns of those opposed to the use of the cumulative requirements “natural and human factors”, an exception to such cumulative requirements has been envisaged in a separate footnote. For the same reason, the option between brackets for the phrase “traditionally known to be” has been introduced.

2.02 As reflected in paragraphs 98 to 101 of the adopted Report of the fourth session of the Working Group (LI/WG/DEV/4/7), paragraph (1)(a) aims to make it clear that international protection as an appellation of origin is also available for indications that are strictly speaking not geographical, but which have obtained a geographical connotation. Such possibility also exists under the Lisbon Agreement, as confirmed by the Lisbon Union Council in 1970 (see the document entitled “Problems Arising from the Practical Application of the Lisbon Agreement” (AO/V/5 of July 1970) and the Report of the fifth session of the Lisbon Union Council (document AO/V/8 of September 1970)).

2.03 Paragraph (2) specifies that appellations of origin for products originating in trans-border areas could also be the subject of international registrations under the Draft Revised Lisbon Agreement, without requiring Contracting Parties concerned, however, to establish such appellations of origin jointly. In this regard, see further Note 6.04.

2.04 The term “product” has been used throughout the Draft Revised Lisbon Agreement, notably in Articles 2, 11 and 17, to align the terminology used thereunder with the one contained in the Lisbon Agreement in relation to appellations of origin. Meanwhile, the term “good” has been used throughout the Draft Protocol on Geographical Indications and the Draft Treaty on Geographical Indications contained in Annex II of the present document to align the terminology used thereunder with the one contained in the TRIPS Agreement.

NOTES ON ARTICLE 3: COMPETENT AUTHORITY

3.01 As the competence for granting or registering rights in appellations of origin varies among national and regional systems for their protection, it is important for the Draft Revised Lisbon Agreement to require each Contracting Party to designate an entity responsible for the administration of the Agreement in its territory and for communications with the International Bureau under the procedures of the Draft Revised Lisbon Agreement and its Regulations. Rule 4 of the Draft Regulations would require each Contracting Party to notify the name and contact details of the designated entity upon accession to the Draft Revised Lisbon Agreement.

NOTES ON ARTICLE 4: INTERNATIONAL REGISTER

4.01 Article 4 would make it clear that the International Register of the Draft Revised Lisbon Agreement, to be kept by the International Bureau, would incorporate the registrations contained in the International Register of the Lisbon Agreement.

4.02 The International Register referred to above would also incorporate the registrations effected under the Draft Protocol on Geographical Indications Supplementing the Revised Lisbon Agreement, which is presented as an Option A in Annex II of the present document. This has been made explicit in Rule 2 of the Draft Regulations under the Draft Protocol on Geographical Indications Supplementing the Revised Lisbon Agreement as contained in Annex II, Option A, of document LI/WG/DEV/6/3.

NOTES ON ARTICLE 5: APPLICABILITY OF OTHER PROTECTION ACCORDED BY LAWS OF CONTRACTING PARTIES AND BY CERTAIN INTERNATIONAL TREATIES

5.01 The provisions of Article 5 confirm that the Draft Revised Lisbon Agreement, which would set up a centralized procedure for obtaining in each Contracting Party the protection which that party affords to appellations of origin, would not itself be an obstacle to the possibility for Contracting Parties to establish more extensive protection than required under the Draft Revised Lisbon Agreement. Obviously, such other protection should not diminish or interfere with the enjoyment of the rights afforded by the Draft Revised Lisbon Agreement. Moreover, international registration would not prejudice any other protection that the appellation of origin in question may benefit from in a Contracting Party. Reference is also made to Article 15(1)(c) in this regard.

5.02 The provisions of paragraph (3) establish the obligation for Contracting Parties to comply with certain provisions of the Paris Convention in view of the discussions at the fifth session of the Working Group, two options are provided in this respect (see related discussion in paragraphs 58-73 of document LI/WG/DEV/5/7).

NOTES ON ARTICLE 6: APPLICATION

6.01 Article 6(1) establishes the obligation to specify in the application the legal or administrative means by virtue of which protection had been granted in the Contracting Party of Origin in respect of a given appellation of origin. The prerequisite is based on Article 1(2) of the Lisbon Agreement while the formal requirements are based on Rule 5(2)(a)(vi) of the Regulations under the Lisbon Agreement.

6.02 Article 6(2) and Article 6(3) determine that international applications are to be presented to the International Bureau and are filed in the name of the beneficiaries of the appellation of origin in question. As regards the entitlement to present an international application, reference is made to Note 1.05. The text of Article 6(3)(ii) emerged from the discussions at the fifth session of the Working Group¹. An all-embracing notion of “legal entity”² has been introduced to make it clear that the Competent Authority may present an international application not only in the name of holders of the right to use an appellation of origin (natural persons), but also in the name of holders of certification marks or collective marks and other legal entities having legal standing to assert rights in a given appellation of origin, such as federations and associations representing holders of a right to use the appellation of origin.

6.03 Article 6(4) is an optional provision. It allows Contracting Parties who so desire to permit international applications to be presented directly to the International Bureau by natural persons or legal entities, as referred to in Article 6(3), as an alternative to submission by the Competent Authority. This option was included in view of the conclusion of the Chair of the Working Group, as reflected in of paragraph 176, final sentence, of the Report of the second session of the Working Group (document LI/WG/DEV/2/5) concerning a suggestion made in response to the Survey on the Lisbon System. In light of the various comments made at the third, fourth and fifth sessions of the Working Group, as regards the requirement of proof of protection in the Contracting Party of Origin, it is now proposed that such direct international applications also simply be subject to the provisions in the Regulations concerning mandatory and optional particulars.

¹ See, in particular, document LI/WG/DEV/5/7 Prov., paragraphs 168 and following.

² Source : <http://www.businessdictionary.com/definition/legal-entity.html>.

6.04 As mentioned in Note 2.03, appellations of origin for products originating in trans-border areas could also be the subject of international registrations under the Draft Revised Lisbon Agreement, without the Contracting Parties concerned being required to establish such appellations of origin jointly. Article 6(5)(a) and (c) lists the three possibilities for applications in respect of such appellations of origin. Article 2(2) would require them to establish the appellation of origin and delimit the geographical area of origin. Following the concerns expressed by some delegations at the fifth session of the Working Group, Article 6(5)(a)(i) makes it clear that each Contracting Party may file an individual separate application only for the part of the trans-border area situated in its territory, and not for the entire trans-border area. The same applies under Article 6(5)(b) in respect of direct applications by the beneficiaries. Whereas, in the case of a joint application, Article 6(5)(a)(ii) would require the Contracting Parties to designate a common Competent Authority for the appellation of origin concerned.

6.05 Articles 6(6) and 6(7) refer to the Regulations under the Draft Revised Lisbon Agreement for the mandatory and optional particulars in respect of international applications.

NOTES ON ARTICLE 7: INTERNATIONAL REGISTRATION

7.01 The provisions presented in Article 7 are based on the premise that an internationally registered appellation of origin, in order to be protectable in all Contracting Parties, should, at least, meet the definition requirements of Article 2(1).

NOTES ON ARTICLE 8: FEES

8.01 The Articles of the Draft Revised Lisbon Agreement have been divided over seven different Chapters, for ease of reference. For the sake of consistency and to make the proposed Chapter II concerning the application and the international registration as complete as possible, a stand-alone article concerning the registration fee and other fees to be paid has been included in Article 8. As far as the nature and the amount of such fees are concerned, reference is made to the Regulations under the Draft Revised Lisbon Agreement.

8.02 Following the views expressed by several delegations at the fifth session of the Working Group (paragraphs 207-209 of document LI/WG/DEV/5/7 Prov.), a new paragraph (3) has been introduced in the Draft Revised Lisbon Agreement which provides for the possibility of a reduced fee for international applications from developing countries.

NOTES ON ARTICLE 9: PROTECTION OF REGISTERED APPELLATIONS OF ORIGIN

9.01 Article 9(1) establishes an obligation to protect registered appellations of origin along the lines of Article 1(2) of the Lisbon Agreement.

9.02 Protection under paragraph (1) is subject to the provisions of paragraph (2) which leaves Contracting Parties free as regards the form of legal protection under which they provide protection in respect of appellations of origin. In addition to the form of protection, Contracting Parties would also remain free to determine the name of the title of protection granted under their own legal system – for example, the English term under EU law for “*appellation d’origine*” is not “appellation of origin”, but “designation of origin”.

NOTES ON ARTICLE 10: PROTECTION ACCORDED BY INTERNATIONAL REGISTRATION

10.01 Paragraph (1) specifies a minimum level of protection to be granted in respect of appellations of origin registered under the Draft Revised Lisbon Agreement. Further changes to these subparagraphs were made in light of the comments made during the fourth session of the Working Group on Article 9(2) of an earlier version of the draft new instrument contained in document LI/WG/DEV/4/2. The square-bracketed Options in subparagraphs (a)(i) and (a)(ii) are based on: (1) the various suggestions reflected in paragraphs 35 to 44 of the Results of the Survey on the Lisbon System, as contained in document LI/WG/DEV/2/2 and discussed at the Second Session of the Working Group; (2) the discussions at the third session of the Working Group on Draft Provisions E(1) and E(2), as contained in document LI/WG/DEV/3/2; (3) the input from delegations at the fourth session of the Working Group with regard to Article 9(2)(a), as contained in document LI/WG/DEV/4/2; and (4) the input from delegations at the fifth session of the Working Group with regard to Article 10, as contained in the previous version of the draft new instrument (document LI/WG/DEV/5/2).

10.02 Paragraph (1)(b) of Article 10 is a redraft of Article 10(2)(b) of the previous version of the draft new instrument (document LI/WG/DEV/5/2). The main purpose of the provision is to prohibit the registration by third parties of trademarks that consist of or contain an appellation of origin. The previous draft represented an attempt to stipulate explicitly that the provision would not prevent such registrations by holders of the right to use the appellation of origin. In Contracting Parties that protect appellations of origin through trademark legislation, the appellation of origin will by definition be incorporated in a trademark. Moreover, holders of the right to use an appellation of origin may own a trademark that contains the appellation of origin as part of the trademark. However, in view of the discussion at the fourth session of the Working Group on this matter, paragraph (1)(b) of Article 10 simply refers to the relevant provisions of the TRIPS Agreement. In this regard, notably the following should be mentioned:

(i) Both Article 22.3 (any good) and Article 23.2 (wines and spirits only) of the TRIPS Agreement stipulate that the registration of a trademark which contains or consists of a geographical indication with respect to products not originating in the territory indicated shall be refused or invalidated (*ex officio* if the WTO member's legislation so permits or at the request of an interested party).

(ii) Article 22.3 of the TRIPS Agreement, further, adds as a condition that "use of the indication in the trademark for such goods in that WTO member is of such a nature as to mislead the public as to the true place of origin".

(iii) Article 24.5 of the TRIPS Agreement lays down the following exception: "Where a trademark has been applied for or registered in good faith, or where rights have been acquired through use in good faith either:

(a) before the date of application of these provisions in that Member as defined in Part VI; or

(b) before the geographical indication is protected in its country of origin; measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication".

(iv) Article 24.7 of the TRIPS Agreement lays down an acquiescence provision, allowing a WTO member to provide that any request made in connection with the use or registration of a trademark must be presented within five years after the adverse use of the

protected indication has become generally known in that WTO member or after the date of registration of the trademark in that WTO member provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in that WTO member, provided that the geographical indication is not used or registered in bad faith.

(v) Article 17 of the TRIPS Agreement allows WTO members to provide limited exceptions to the rights conferred by a trademark, such as fair use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trademark and of third parties.

10.03 Paragraph (2) establishes a presumption of unlawful use in case of use by persons not entitled or authorized to use the internationally registered appellation of origin. As the implementation of Article 10 of the Draft Revised Lisbon Agreement is intended to be possible not only in the context of *sui generis* legislation, but also in the context of other legislation, such as trademark legislation, as indicated in Article 9(2), reference can be made to both Article 23.1 and Article 16.1, second sentence, of the TRIPS Agreement, which would appear to be based on a similar presumption.

10.04 Paragraph (3) leaves it to Contracting Parties how they wish to deal with unlawful use of an appellation of origin by someone who is, in principle, entitled to use the appellation of origin.

10.05 Paragraph (4) clarifies that the issue of homonymous appellations of origin must be dealt with in the national or regional legislation of Contracting Parties through provisions as stipulated in the TRIPS Agreement, notably Articles 22.4 and 23.3 of that Agreement.

10.06 As regards the phrase “from the date of international registration”, attention is drawn to current Rule 8(3) of the Lisbon Regulations, which provides for protection from the date of international registration, subject to the right of a Lisbon member State to declare in a notification addressed to the Director General that, under its national legislation, a later date applies, as specified in the declaration, provided that that date is not later than the expiry date of the period within which a refusal can be validly submitted in respect of a given international registration. To date, no Lisbon Member State has submitted such a notification.

10.07 Paragraph (5) specifies that protection of a registered appellation of origin extends to its use as a [generic] [customary] term or name. Consequently, use as a [generic] [customary] term or name in a given Contracting Party prior to the date on which the appellation of origin was registered will no longer be allowed after that date, unless that Contracting Party issues a refusal under Article 15 or grants a transitional period for terminating such use under Article 17.

NOTES ON ARTICLE 11: SHIELD AGAINST BECOMING A [GENERIC] [CUSTOMARY] TERM OR NAME

11.01 Article 11 has been drafted along the lines of Article 6 of the Lisbon Agreement which states that “*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*”. As reflected in paragraph 32 of the Summary by the Chair of the Second Session of the Working Group in document LI/WG/DEV/2/4, delegations were of the view, although for different reasons, that an amendment of Article 6 of the Lisbon Agreement was not necessary. Discussions in the Working Group have shown that some delegations would consider such a provision to establish a rebuttable presumption, while others consider it to establish an absolute ban.

NOTES ON ARTICLE 12: DURATION OF PROTECTION

12.01 This provision corresponds to Article 7 of the Lisbon Agreement, which provides that the only fee to be paid for the international registration of an appellation of origin is the registration fee and that the validity of an international registration shall not be subject to renewal. The Draft Revised Lisbon Agreement deals with fees in Article 8. Article 12 establishes that the validity of an international registration effected under the Draft Revised Lisbon Agreement is dependent upon the protection of the appellation of origin concerned in its Contracting Party of Origin.

NOTES ON ARTICLE 13: PRIOR RIGHTS

13.01 In view of the discussion at the fourth session of the Working Group on Articles 12 and 13 of an earlier version of the draft new instrument contained in document LI/WG/DEV/4/2, paragraphs (1) and (2) of Article 13 of the present Draft Revised Lisbon Agreement simply refer to the applicable provisions of the TRIPS Agreement in the case of prior trademark rights and other prior rights.

13.02 As regards the relevant provisions of the TRIPS Agreement in respect of prior trademark rights, reference is made to Note 10.03.

13.03 In addition, as regards the relevant provisions of the TRIPS Agreement in respect of other prior rights, notably the following provisions of the TRIPS Agreement should be mentioned:

(i) Under Article 24.4, WTO members are not required to prevent continued and similar use of a particular geographical indication of another WTO member identifying wines or spirits in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that Member either (a) for at least 10 years preceding 15 April 1994 or (b) in good faith preceding that date.

(ii) Article 24.8 of the TRIPS Agreement: "The provisions of this Section shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public".

13.04 The fact that Article 13 no longer mentions the possibility, for right holders of prior trademarks and holders of the right to use an appellation of origin, to negotiate the modalities of a possible termination of use under the prior trademark, as contained in Article 12 of an earlier version of the draft new instrument contained in document LI/WG/DEV/4/2, does not mean to indicate that such possibility would not exist under Article 13 of the present draft. The sentence has been removed because of the comments made during the fourth session of the Working Group, that the existence of such a possibility is obvious and its specification in the Draft Revised Lisbon Agreement, therefore, unnecessary.

13.05 Like Rule 9 of the current Lisbon Regulations, Article 13(2) does not specify all possible prior rights. Legitimate prior rights may include trade names, plant variety denominations, personality rights, etc.

NOTES ON ARTICLE 14: [LEGAL PROCEEDINGS] [LEGAL REMEDIES]

14.01 The first Option between brackets largely reproduces the provisions contained in Article 8 of the Lisbon Agreement.

14.02 The second Option between brackets would simply require national or regional legislation to specify the applicable legal procedures for the enforcement of internationally-registered appellations of origin.

NOTES ON ARTICLE 15: REFUSAL

15.01 Article 15 concerns the procedure for issuing refusals following the receipt of a notification of international registration and introduces, in particular, the obligation for Contracting Parties to establish procedures enabling interested parties to present possible grounds for refusal to the Competent Authority. The provision is based on Draft Provision G of document LI/WG/DEV/3/2, Annex II.

15.02 In respect of paragraph (4), the Working Group might wish to address the question as to whether the provision should also specify that interested parties affected by refusal would, alternatively, have the opportunity to resort to arbitration or mediation.

15.03 As suggested during the fourth session of the Working Group, time limits are now specified in the Regulations, so that modifications can be adopted by the Assembly of the Special Union and would not require a Diplomatic Conference, as would be the case if time limits were specified in the Draft Revised Lisbon Agreement itself.

NOTES ON ARTICLE 16: WITHDRAWAL OF REFUSAL

16.01 The possibility to negotiate the withdrawal of a refusal is explicitly mentioned in paragraph (2). As mentioned in the Acts of the 1958 Diplomatic Conference where the Lisbon Agreement was concluded, "the procedure envisaged provides countries, which receive the notification of an appellation of origin via the International Bureau, with the possibility to oppose any situation that exists *de facto* or *de jure* that would prevent protection being granted on all or part of the territory of the restricted Union. The period of one year from the time the notification is received is easily sufficient to allow such opposition. A refusal must be accompanied by the grounds on which the country decides not to grant protection. These grounds constitute a possible basis for discussion for the purpose of reaching an understanding³".

16.02 A reference is also made to Article 24.1 of the TRIPS Agreement, which provides that WTO members agree to enter into negotiations aimed at increasing the protection of individual geographical indications under Article 23 and that the exception provisions of Article 24.4 through 24.8 shall not be used by a WTO member to refuse to conduct negotiations or to conclude bilateral or multilateral agreements. In the context of such negotiations, WTO members shall be willing to consider the continued applicability of these provisions to individual geographical indications whose use was the subject of such negotiations.

³ Unofficial translation of the official French text.

NOTES ON ARTICLE 17: PRIOR USE

17.01 Unlike Article 5(6) of the Lisbon Agreement, Article 17 of the Draft Revised Lisbon Agreement limits the provisions allowing Contracting Parties to provide for adaptation periods in connection with the termination of prior use to prior use of a registered appellation of origin as a [generic] [customary] term or name. The alternative formulation for generic indications is based on Article 24.6 of the TRIPS Agreement.

17.02 As suggested during the fourth session of the Working Group, time limits are now specified in the Regulations, so that modifications can be adopted by the Assembly of the Special Union and would not require a Diplomatic Conference, as would be the case if time limits were specified in the Draft Revised Lisbon Agreement itself.

17.03 In view of the safeguards under Article 13 in respect of prior use under legitimate prior rights, the Draft Revised Lisbon Agreement does not contain phasing out periods in respect of such uses, except to the extent that such trademarks incorporate a registered appellation of origin as a [generic] [customary] term or name.

17.04 Paragraph (2) clarifies that the defined period for the termination of prior use referred to in paragraph (1) may also apply for terminating prior use as a [generic] [customary] term or name in case a refusal is withdrawn or in case a statement of grant of protection is notified following a refusal.

17.05 Paragraph (3) clarifies that withdrawal of a refusal that was based on use under a prior trademark or other prior right would not mean that Article 13 would no longer apply. At the same time, the provision clarifies that withdrawal of such a refusal because of the cancellation, revocation or invalidation of the prior trademark or other prior right makes Article 13 inapplicable. Consequently, a situation of coexistence would be established following the withdrawal of such a refusal, except when the withdrawal was the result of the cancellation, revocation or invalidation of the prior trademark or other prior right.

NOTES ON ARTICLE 18: NOTIFICATION OF GRANT OF PROTECTION

18.01 Article 18 concerns the notification of grant of protection to a registered appellation of origin, and its subsequent publication by the International Bureau. Such a notification can be presented within the one-year period after receipt of the notification of international registration – in case within that period it has become clear that no refusal will be issued – or following a refusal; if a decision has been taken to withdraw the refusal, a statement of grant of protection can be notified instead of a withdrawal of refusal. The procedures are specified in the Draft Regulations.

NOTES ON ARTICLE 19: INVALIDATION

19.01 Article 19 deals with invalidation of the effects of an international registration in a given Contracting Party. Invalidation, which occurs after effect has been given to an international registration (and may result, for example, from a court decision in invalidity or infringement proceedings), is to be distinguished from refusal of the effects of an international registration, as refusals prevent the entry into force of such effects.

19.02 Before an invalidation is pronounced, the natural persons and legal entities referred to in Article 6(3)(ii) of the Draft Revised Lisbon Agreement must have been granted an opportunity to defend their rights, which in turn implies that they must first be informed that their registration is being challenged in a given Contracting Party.

NOTES ON ARTICLE 20: MODIFICATIONS AND OTHER ENTRIES IN THE INTERNATIONAL REGISTER

20.01 A specific provision addressing the issue of modifications of international registrations and other entries in the International Register has been incorporated in the Draft Revised Lisbon Agreement.

NOTES ON ARTICLE 21: MEMBERSHIP OF THE LISBON UNION

21.01 This provision clarifies that the Contracting Parties to the Draft Revised Lisbon Agreement shall be members of the same Assembly as the States party to the Lisbon Agreement.

NOTES ON ARTICLE 22: ASSEMBLY OF THE SPECIAL UNION

22.01 The provisions of Article 22 are based, to a great extent, on those contained in Article 9 of the Lisbon Agreement. However, whenever it appeared necessary, as in the case of the voting rights of intergovernmental organizations, such provisions have been supplemented by those contained in Article 21 of the Geneva Act.

NOTES ON ARTICLE 23: INTERNATIONAL BUREAU

23.01 The provisions of this article largely reproduce those contained in Article 10 of the Lisbon Agreement.

NOTES ON ARTICLE 24: FINANCES

24.01 The provisions of this Article reproduce those contained in the Geneva Act.

NOTES ON ARTICLE 25: REGULATIONS

25.01 This Article makes an express reference to the Regulations and defines the procedure for the amendment of certain provisions of the Regulations.

25.02 Paragraph (2) has been drafted along the lines of the corresponding provisions of the Singapore Treaty and the Patent Cooperation Treaty which require the same threshold of a three-fourths majority.

25.03 Paragraph (3) establishes the superiority of the provisions under the Draft Revised Lisbon Agreement over those contained in the Regulations so that, in the event of conflict between the two sets of provisions, the provisions of the Draft Revised Lisbon Agreement shall prevail.

NOTES ON ARTICLE 26: REVISION

26.01 This provision, which confirms the standard rule that a treaty may be revised by a conference of the Contracting Parties, has been drafted along the lines of the provisions contained in the Singapore Treaty and the Geneva Act.

NOTES ON ARTICLE 27: AMENDMENT OF CERTAIN ARTICLES BY THE ASSEMBLY

27.01 The provisions of this Article are largely derived from those contained in the Geneva Act.

NOTES ON ARTICLE 28: BECOMING PARTY TO THIS ACT

28.01 The provisions of this article have been drafted along the lines of Article 27 of the Geneva Act, as adapted in order to reflect accession criteria for intergovernmental organizations that would appear to take account of the conclusions of the Working Group on the Study contained in document LI/WG/DEV/2/3 and discussed at the second session of the Working Group.

28.02 The last sentence of paragraph (3)(b) should be read in conjunction with Article 31 and would allow current member States of the Lisbon Agreement that are also a member State of an intergovernmental organization to apply the Draft Revised Lisbon Agreement instead of the Lisbon Agreement before the intergovernmental organization accedes.

NOTES ON ARTICLE 29: EFFECTIVE DATE OF RATIFICATIONS AND ACCESSIONS

29.01 This provision has been drafted along the lines of Article 28 of the Geneva Act to reflect the fact that both States and intergovernmental organizations may accede to the new instrument.

29.02 The first sentence of paragraph (4), which deals with the effects of accession, has been drafted along the lines of Article 14(2)(b) and 14(2)(c) of the Lisbon Agreement. A possibility to extend the time periods referred to in Article 15(1) and Article 17 of the Draft Revised Lisbon Agreement has been introduced in the last part of paragraph (4), in view of suggestions made in response to the Survey on the Lisbon system and the discussions at the second session of the Working Group.

NOTES ON ARTICLE 30: PROHIBITION OF RESERVATIONS

30.01 This Article, which excludes any reservation to the Draft Revised Lisbon Agreement, has been drafted along the lines of Article 29 of the Geneva Act.

NOTES ON ARTICLE 31: APPLICATION OF THE LISBON AGREEMENT

31.01 Paragraph (1) deals with relations between States that are party both to the Draft Revised Lisbon Agreement and the Lisbon Agreement. The principle set out is that the Draft Revised Lisbon Agreement alone applies to the relations between those States. Thus, with respect to persons who derive their right to file an international application from a State bound

both by the Draft Revised Lisbon Agreement and the Lisbon Agreement and who wish to obtain protection in other States party both to the Draft Revised Lisbon Agreement and the Lisbon Agreement, only the provisions of the Draft Revised Lisbon Agreement will be applicable.

31.02 Paragraph (2) deals with relations between States party both to the Draft Revised Lisbon Agreement and to the Lisbon Agreement, on the one hand, and States party only to the Lisbon Agreement without being at the same time party to the Draft Revised Lisbon Agreement, on the other.

31.03 Reference is also made to Note 28.02.

NOTES ON ARTICLE 32: DENUNCIATION

32.01 This is a usual provision. To enable those who have organized their activities as a function of the accession of a Contracting Party to the Draft Revised Lisbon Agreement to carry out the necessary adjustments in the event of that Contracting Party denouncing the Agreement, a minimum period of one year is provided in paragraph (2) for a denunciation to take effect. Additionally, paragraph (2) ensures that the Draft Revised Lisbon Agreement will continue to apply to any international application that is pending and to any international registration that is in force with respect to the Contracting Party that has denounced the Agreement at the time the denunciation takes effect.

NOTES ON ARTICLE 33: LANGUAGES OF THIS ACT; SIGNATURE

33.01 Article 33 provides, in particular, that the Draft Revised Lisbon Agreement is to be signed in a single original in the six official languages of the United Nations and that all those texts will be equally authentic.

NOTES ON ARTICLE 34: DEPOSITARY

34.01 Article 34 states that the Director General is the depositary of the Draft Revised Lisbon Agreement. The nature of the duties of the depositary of a treaty is defined, and a list of those duties is given, in Articles 76 and 77 of the Vienna Convention on the Law of Treaties. Those duties consist, in particular, in keeping the original text of the Draft Revised Lisbon Agreement, in establishing certified copies of the original text and in receiving the instruments of ratification or accession that are deposited.

[Annex II follows]

**NOTES ON THE DRAFT PROTOCOL ON GEOGRAPHICAL INDICATIONS
SUPPLEMENTING THE REVISED LISBON AGREEMENT**

OPTION A

TABLE OF CONTENTS

List of Articles

Preamble

Article 1: Subject-Matter

Article 2: Application of the Provisions of the Revised Lisbon Agreement

Article 3: Membership of the Lisbon Union

Article 4: Assembly of the Special Union

Article 5: International Bureau

Article 6: Finances

Article 7: Regulations

Article 8: Revision

Article 9: Amendment of Certain Articles by the Assembly

Article 10: Becoming Party to This Protocol

Article 11: Effective Date of Ratifications and Accessions

Article 12: Prohibition of Reservations

Article 13: Denunciation

Article 14: Languages of This Protocol; Signature

Article 15: Depositary

NOTES ON ARTICLE 1: SUBJECT-MATTER

1.01 Paragraph (1) of Article 1 defines the object of protection under the Draft Protocol on Geographical Indications supplementing the Revised Lisbon Agreement (hereinafter referred to as “Draft Protocol on Geographical Indications”), namely geographical indications. This provision is based on the definition of Article 22.1 of the TRIPS Agreement.

1.02 As reflected in paragraphs 98 to 101 of the adopted Report of the fourth session of the Working Group (LI/WG/DEV/4/7), paragraph (1)(c) aims to make it clear that international protection as a geographical indication is also available for indications that are strictly speaking not geographical, but which have obtained a geographical connotation.

1.03 Paragraph (2) specifies that geographical indications for products originating in trans-border areas could also be the subject of international registrations under the Draft Protocol on Geographical Indications, without requiring Contracting Parties concerned, however, to establish such geographical indications jointly.

NOTES ON ARTICLE 2: APPLICATION OF THE SUBSTANTIVE PROVISIONS OF THE REVISED LISBON AGREEMENT

2.01 Article 2 specifies the provisions of the Draft Revised Lisbon Agreement that shall apply to the present Draft Protocol on Geographical Indications, as well as the relevant application modalities.

2.02 Depending on whether the Draft Protocol on Geographical Indications is considered to be an instrument amending the Draft Revised Lisbon Agreement or is considered to be a new treaty, Part IV of the Vienna Convention on the Law of Treaties either applies or not – see Notes 1.02 in Annex I and 1.01 in Annex II, Option B.

NOTES ON ARTICLE 3: MEMBERSHIP OF THE LISBON UNION

3.01 This provision clarifies that the Contracting Parties to the Draft Protocol on Geographical Indications shall be members of the same Assembly as the Contracting Parties of the Draft Revised Lisbon Agreement and the States party to the Lisbon Agreement.

NOTES ON ARTICLE 4: ASSEMBLY OF THE LISBON UNION

4.01 Please refer to note 22.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 5: INTERNATIONAL BUREAU

5.01 Please refer to Note 23.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 6: FINANCES

6.01 Please refer to Note 24.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 7: REGULATIONS

7.01 Please refer to the Notes on Article 25 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 8: REVISION

8.01 Please refer to Note 26.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 9: AMENDMENT OF CERTAIN ARTICLES BY THE ASSEMBLY

9.01 Please refer to Note 27.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 10: BECOMING PARTY TO THIS PROTOCOL

10.01 Please refer to Note 28.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 11: EFFECTIVE DATE OF RATIFICATIONS AND ACCESSIONS

11.01 Please refer to the notes on Article 29 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 12: PROHIBITION OF RESERVATIONS

12.01 Please refer to Note 30.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 13: DENUNCIATION

13.01 Please refer to Note 32.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 14: LANGUAGES OF THIS PROTOCOL; SIGNATURE

14.01 Please refer to Note 33.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON ARTICLE 15: DEPOSITARY

15.01 Please refer to Note 34.01 on the Draft Revised Lisbon Agreement in Annex I.

NOTES ON THE DRAFT TREATY ON GEOGRAPHICAL INDICATIONS

[OPTION B]

TABLE OF CONTENTS

List of Articles

Preamble

Chapter I: Introductory and General Provisions

- Article 1: Abbreviated Expressions
- Article 2: Subject-Matter
- Article 3: Competent Authority
- Article 4: International Register
- Article 5: Applicability of Other Protection Accorded by Laws of Contracting Parties and by Certain International Treaties

Chapter II: Application and International Registration

- Article 6: Application
- Article 7: International Registration
- Article 8: Fees

Chapter III: Effects of International Registration

- Article 9: Protection of Registered Geographical Indications
- Article 10: Protection Accorded by International Registration
- Article 11: Shield Against Becoming a [Generic] [Customary] Term or Name
- Article 12: Duration of Protection
- Article 13: Prior Rights
- Article 14: [Legal Proceedings] [Legal Remedies]

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

- Article 15: Refusal
- Article 16: Withdrawal of Refusal
- Article 17: Prior Use
- Article 18: Notification of Grant of Protection
- Article 19: Invalidation
- Article 20: Modifications and Other Entries in the International Register

Chapter V: Administrative Provisions

- Article 21: Special Union; Assembly
- Article 22: International Bureau
- Article 23: Finances
- Article 24: Regulations

Chapter VI: Revision and Amendment

- Article 25: Revision
- Article 26: Amendment of Certain Articles by the Assembly

Chapter VII: Final Provisions

- Article 27: Becoming Party to This Treaty
- Article 28: Effective Date of Ratifications and Accessions
- Article 29: Prohibition of Reservations
- Article 30: Denunciation
- Article 31: Languages of This Treaty; Signature
- Article 32: Depositary

The relevant notes on the Draft Revised Lisbon Agreement in Annex I of the present document also apply with respect to the corresponding Articles of the present Draft Treaty on Geographical Indications (subject to the replacement of the terms “appellations of origin” by “geographical indications”, and “Draft Revised Lisbon Agreement” by “Draft Treaty on Geographical Indications”, where appropriate) unless specifically provided otherwise in the notes below.

NOTES ON ARTICLE 1: ABBREVIATED EXPRESSIONS

1.01 As the Draft Treaty on Geographical Indications is presented as a new treaty, Part IV of the Vienna Convention on the Law of Treaties is not applicable in respect of its negotiation and conclusion.

NOTES ON ARTICLE 2: SUBJECT-MATTER

2.01 Paragraph (1) of Article 2 defines the object of protection under the Draft Treaty on Geographical Indications, namely geographical indications. This provision is based on the definition of Article 22.1 of the TRIPS Agreement.

2.02 As reflected in paragraphs 98 to 101 of the adopted Report of the fourth session of the Working Group (LI/WG/DEV/4/7), paragraph (1)(c) aims to make it clear that international protection as a geographical indication is also available for indications that are strictly speaking not geographical, but which have obtained a geographical connotation.

2.03 Paragraph (2) specifies that geographical indications for products originating in trans-border areas could also be the subject of international registrations under the Draft Treaty on Geographical Indications, without requiring Contracting Parties concerned, however, to establish such geographical indications jointly.

NOTES ON ARTICLE 4: INTERNATIONAL REGISTER

4.01 A separate International Register for the recording of international registrations of geographical indications effected under the Draft Treaty on Geographical Indications is established under Article 4.

NOTES ON ARTICLE 21: SPECIAL UNION; ASSEMBLY

21.01 Article 21 establishes a new Special Union with a new Assembly consisting of the Contracting Parties to the Draft Treaty on Geographical Indications.

[End of Annex II and of document]