

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

Seventh Session  
Geneva, April 29 to May 3, 2013

### REVISED DRAFT REPORT

*prepared by the Secretariat*

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 April 29 to May 3, 2013.
2. The following Contracting Parties of the Lisbon Union were represented at the session: Algeria, Costa Rica, Czech Republic, France, Georgia, Hungary, Iran (Islamic Republic of), Italy, Mexico, Peru, Portugal, Republic of Moldova, Serbia (13).
3. The following States were represented as observers: Angola, Australia, Benin, Brazil, Brunei Darussalam, Chile, Colombia, Germany, Indonesia, Iraq, Lithuania, Madagascar, Myanmar, Pakistan, Republic of Korea, Romania, Russian Federation, Sudan, Switzerland, Thailand, United States of America, Venezuela (Bolivarian Republic of) (22).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: European Union (EU), World Trade Organization (WTO) (2).
5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: Brazilian Association of Intellectual Property (ABPI), Centre for International Intellectual Property Studies (CEIPI), European Communities Trade Mark Association (ECTA), Health and Environment Program (HEP), International Association for the Protection of Intellectual Property (AIPPI), International Trademark Association (INTA), MARQUES (Association of European Trademark Owners), Organization for an International Geographical Indications Network (oriGIn) (8).

<sup>1</sup> Modifications compared to document LI/WG/DEV/7/7 PROV., based on communications from delegations and representatives that participated in the meeting have been introduced in paragraphs 28, 46, 49, 64, 66, 101, 102, 103, 120, 149, 174, 193, 225, 248, 256, 258, 296 and 311.

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6. The list of participants is contained in Annex II.

#### **AGENDA ITEM 1: OPENING OF THE SESSION**

7. The Director General of the World Intellectual Property Organization (WIPO), Mr. Francis Gurry, opened the session, recalled the mandate of the Working Group and introduced the draft agenda, as contained in document LI/WG/DEV/7/1 Prov.

8. He first expressed a warm welcome to Bosnia and Herzegovina, which had deposited, its instrument of accession to the Lisbon Agreement on April 4, 2013, thereby becoming the 28<sup>th</sup> member of the Lisbon Agreement, as from July 4, 2013.

9. He then reported that continuous progress had been made in expanding the use of e-mail for the communication of international applications and notifications under the Lisbon procedures and pointed out that, to date, the competent authorities of 23 contracting parties had agreed to use e-mail as the principal means of communication under the Lisbon procedures. He further indicated that since the previous session of the Working Group, in December 2012, new registrations had been recorded for appellations of origin from Georgia (8) and Iran (the Islamic Republic of) (5).

10. The Director General recalled that at the previous session of the Working Group, in December of the previous year, the Working Group had made considerable progress in the review of the Lisbon system. He further recalled that at the time the Working Group had clarified that the road ahead would be towards a Revised Lisbon Agreement, i.e. not a new treaty and not a protocol to the Lisbon Agreement. In other words, the Lisbon Agreement would be revised so as to confirm its application in respect of both appellations of origin and geographical indications and to allow for accession by intergovernmental organizations. He also indicated that at the end of the previous session the Working Group had worked out a text on the issue of the scope of protection, which would serve as a basis for negotiating the final result on the issue, and had advanced further in refining and modernizing the legal framework of the Lisbon system.

11. He noted, in particular, that the working document for the present session set out a possible future path for the work of the Working Group and the diplomatic conference which could either take place in the second half of 2014 or in the course of 2015.

12. The Director General acknowledged nonetheless that the time path to be established to that end would greatly depend on the further progress that the Working Group would hopefully make at the present meeting, notably on the difficult questions of how the issue of generics and the issue of prior trademarks would be dealt with in the revised instrument.

13. With such a timetable in mind, he further indicated that if the Working Group were to take the view that a diplomatic conference should be convened in the second half of 2014 that would imply that there would be two additional expert meetings after the present meeting, one in December 2013, which would also host a conference on the question of dispute resolution, and one in the spring of 2014 which would be combined with a preparatory committee for the diplomatic conference. The purpose of the preparatory committee would be to settle the draft rules of procedure for the diplomatic conference, the list of invitees, the eligible NGOs and so on. He added that since such preparatory meeting would take place in the spring that would leave at least six months for the distribution of the basic proposal which would then have been established by the spring meeting. The Director General expressed the view that such timetable was feasible. He went on to say that, in order for that to take place, the Working

Group would have to make a recommendation to the Lisbon Union Assembly in September of the present year. The Chair further indicated that if the Working Group would not be in a position to make such a recommendation in September of the present year, then the recommendation could not be taken up by the Assembly until September 2014 and, as a consequence, for a diplomatic conference in 2015.

#### **AGENDA ITEM 2: ELECTION OF A CHAIR AND TWO VICE-CHAIRS**

14. Mr. Mihály Ficsor (Hungary) was unanimously elected as Chair of the Working Group, Mr. Behzad Saberi Ansari (Iran (Islamic Republic of)) and Mr. Miguel Alemán Urteaga (Peru) were unanimously elected as Vice-Chairs.

15. Mr. Matthijs Geuze (WIPO) acted as Secretary to the Working Group.

#### **AGENDA ITEM 3: ADOPTION OF THE AGENDA**

16. The Working Group adopted the draft agenda (document LI/WG/DEV/7/1 Prov.) without modification.

#### **AGENDA ITEM 4: REPORT OF THE SIXTH SESSION OF THE WORKING GROUP ON THE DEVELOPMENT OF THE LISBON SYSTEM (APPELLATIONS OF ORIGIN)**

17. The Working Group took note of the adoption, on April 26, 2013, of the report of the Sixth session of the Working Group, as contained in document LI/WG/DEV/6/7, in accordance with the procedure established at the Fifth session of the Working Group.

#### **AGENDA ITEM 5: DRAFT REVISED LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS AND DRAFT REGULATIONS UNDER THE DRAFT REVISED LISBON AGREEMENT**

18. Discussions were based on documents LI/WG/DEV/7/2 (French and Spanish versions only), LI/WG/DEV/7/2 Rev. (English version only), LI/WG/DEV/7/3, LI/WG/DEV/7/4 and LI/WG/DEV/7/5.

19. The Chair recalled that at the previous session the Working Group had reached agreement on the main directions that the revision would take, and in particular that the revision of the Lisbon Agreement would result in a single instrument covering both appellations of origin and geographical indications and also providing for a high and single level of protection for both, while maintaining separate definitions on the understanding that the same substantive provisions would apply to both categories. He further indicated that the Working Group had also agreed that the new instrument would establish a single international register covering both appellations of origin and geographical indications; and that competent intergovernmental organizations would also be given the possibility of joining the Lisbon system.

20. The Chair then pointed out that for the present session the Secretariat had submitted a new version of the draft Revised Lisbon Agreement following the main directions he had just referred to. He added that he was deeply hopeful that on the basis of that document it would be possible to make significant progress at the present session so that a recommendation could be made to the Lisbon Union Assembly on the convening of a diplomatic conference in accordance with a roadmap as the Director General had just outlined.

21. In view of the advanced stage of the discussions and the maturity of the draft Revised Lisbon Agreement, the Chair said that he would work towards building consensus on as many issues as possible. He clarified that his priority concern would be to make the discussions as focused as possible so as to concentrate the work on the most important aspects of the ongoing revision exercise and the main choices to be made.

22. The Chair announced that he would provide an opportunity during the lunch breaks for interested delegations to convey to him and the Secretariat suggestions for editorial changes of a non-substantive nature in respect of the working documents. In the course of the session, a few delegations made use of this possibility.

#### GENERAL STATEMENTS

23. The Delegation of Iran (Islamic Republic of) supported the roadmap presented by the Chair and emphasized its readiness to work with the other delegations in a constructive manner. The Delegation welcomed the presence of observers, namely States that were not party to the Lisbon Agreement, but also expressed the view that their number was still insufficient and that the Working Group would need to find a way to attract more observer States to the Working Group meetings to be able to hear more from them given that one of the objectives of the revision exercise was precisely to attract more members into the Lisbon system.

24. The Delegation of Peru agreed that the work should be carried out in the most effective and sensible way to achieve satisfactory results not only in the interest of the members of the Lisbon Union but also in the interest of other countries that were not yet members of the Lisbon system given the objective to increase the membership of the Lisbon Agreement.

25. The Delegation of the European Union reiterated its support for the review the international registration system of the Lisbon Agreement with the objective of making the system more attractive for users and prospective new members. In parallel, the Delegation also underlined the need for compatibility of a Revised Lisbon Agreement with the TRIPS Agreement, taking into account the Doha Development Agenda negotiations within the framework of the WTO. Recognizing the efforts made to improve and simplify the text of the draft new instrument and the draft regulations, the Delegation still noted the need to further improve them, especially as regards their internal coherence and their relation to other international agreements, in particular the TRIPS Agreement.

26. The Delegation of Serbia expressed the view that the draft Revised Lisbon Agreement represented a positive advance, and added that it fully supported the concept of a single document covering both appellations of origin and geographical indications that would provide for a high level and a single level of protection for both. The Delegation concluded by saying that it expected fruitful discussions that would lead to further progress and consensus in that regard, at the present session.

27. The Delegation of Australia said that it was grateful for the opportunity to contribute to the discussions of the Working Group as an observer. In particular it welcomed the aim of the ongoing review of the Lisbon Agreement to improve the Lisbon system in order to attract a wider membership. Unfortunately, the Delegation was under the impression that it would be impossible or difficult to achieve the aim of attracting a broader membership on the basis of the current proposals which strengthened or retained provisions that already made the Lisbon Agreement unattractive to many countries and which in some cases were out of step with the established principles and were incompatible with the protection of geographical indications in many countries, including Australia. The Delegation was of the view that it would be a missed opportunity if the Working Group would continue to go down the same path.

28. The representative of CEIPI was of the view that with three Working Group sessions ahead, including the present session, it would be perfectly possible to envisage the convocation of a diplomatic conference already in the second half of 2014. He also expressed his concern in respect of the direction taken by the work in spite of the mandate of the Assembly which provided that one of the main objectives of the revision exercise was ~~precisely~~ to attract more members. In that regard, he was of the view that the text of the draft Revised Lisbon Agreement which had been submitted to the Working Group made it difficult to fully meet that part of the mandate. On the other hand, the earlier option of having two separate levels of protection, one for appellations of origin and one for geographical indications, also posed difficulties. As an interim solution, he reiterated his suggestion made at previous sessions, namely, to plan for a single level of protection for both while also instituting, on a temporary basis, a two level system through reservations or through mechanisms similar to those successfully used in ~~other treaties~~ the framework of the Patent Cooperation Treaty (PCT).

29. The Delegation of Switzerland expressed the view that the new documents represented a real progress towards a positive outcome for the work of the Working Group. In response to the comments made by the Representative of CEIPI, the Delegation said that the progress made thus far would clearly make the Lisbon Agreement more attractive to Switzerland, because it would provide for an effective and high level of protection for geographical indications as well. The Delegation further indicated that to make the Lisbon system attractive an international system should be created that would provide effective protection to geographical indications instead of keeping a dual level of protection which caused a lot of problems internationally. The Delegation concluded by saying that if one ended up creating a mere registration system without any true protection for geographical indications, then Switzerland would see little interest in joining the Lisbon system.

30. The Delegation of Italy viewed the improvements to the revised texts in terms of simplicity and clarity as a step in the right direction, even though further refinements could still be made. The Delegation further indicated that comments from observers were very welcome provided they expressed a genuine interest and willingness in joining the Lisbon system.

31. The Chair noted that the general sentiment in the Working Group was that the new texts submitted by the Secretariat did represent a significant progress, especially in terms of clarity and further simplification of the provisions, although some delegations were of the view that there was still room for further improvement in that regard. He further indicated that his understanding was that most of the delegations that had taken the floor were satisfied with the direction that the new texts had taken and were of the view that the new versions represented a solid basis for further work. On the other hand, concerns had been expressed as to whether the texts would allow the mandate to be met of attracting a much wider membership. In that regard, he encouraged the members of the Working Group to try to find solutions that could pave the way for accession by a significant number of new Contracting Parties, while maintaining the main principles and values of the Lisbon system.

32. The Secretariat highlighted the main changes that had been introduced in the new version of the draft Revised Lisbon Agreement. The Secretariat first pointed out that, contrary to the French and Spanish versions of the working document, the English version of the document contained in document LI/WG/DEV/7/2 Rev. was indeed a revision document in light of the fact that some inaccuracies had been found in the English version after it had been published. Those inaccuracies had been found before the finalization of the French and Spanish translations, which could therefore be finalized as document LI/WG/DEV/7/2. The Secretariat went on to say that those inaccuracies mainly consisted of the omission, in some instances, of the words “and geographical indications”.

33. The Secretariat indicated that a Preamble had been added to reflect the expressed desire to ensure the applicability of the Lisbon system in respect of both appellations of origin and geographical indications. In line with the wish of the Working Group for a single instrument, the provisions of the draft Revised Lisbon Agreement had been amended to reflect that the instrument throughout the document would concern both appellations of origin and geographical indications. Further, in Article 1, the new items (xvi) and (xvii), defining the abbreviated expressions “beneficiary” and “legal entity”, had been added, on the basis of the discussions at the previous session on the definition of “legal entity” in a footnote to what was now Article 5. Referring to Article 2, the Secretariat indicated that the text had been modified on the basis of the substantive discussions that took place at the previous meeting and that it had made an attempt to reflect the points made in respect of the definitions for appellations of origin and geographical indications. In particular, the Secretariat pointed out that some elements of Article 6 concerning applications, as contained in document LI/WG/DEV/6/2, had been incorporated in Article 2. Hence the substantive requirement indicating that in order to be able to apply for registration under the Lisbon system, the appellation of origin or geographical indication first had to be protected in the Contracting Party of Origin, which in turn was based on Article 1(2) of the Lisbon Agreement, had been incorporated in the definitions of Article 2. As regards Article 2(2), the Secretariat indicated that the reason why the second sentence of that provision appeared in square brackets was that at the previous meeting two delegations had strongly requested that anything relating to trans-border appellations of origin or geographical indications be put between brackets. The first sentence of Article 2(2) introduced into the body of the text an element which featured in a footnote in the previous text, namely that the geographical area of origin could either be a locality in a country, a region in a country, or the entire territory of a Contracting Party. The Secretariat further clarified that the footnotes to Article 2 sought to accommodate difficulties that had been put forward by some delegations at the previous meeting, while also adding that Article 7 on fees had been modified on the basis of the outcome of the discussions on those provisions at the previous meeting.

34. As regards Chapter III concerning the substantive requirements for protection, the Secretariat indicated that a new Article 8 had been introduced while clarifying that the provisions in question were similar to those contained in Article 9(1) of the previous text, which in turn was based on Article 1(2) of the current Lisbon Agreement. The provision simply stated that Contracting Parties were required to protect appellations of origin and geographical indications registered under the draft Revised Lisbon Agreement. Then, the Secretariat pointed out that the text of Article 9 already featured in Articles 9 and 5 of the previous text, and recalled in that regard that at the previous meeting a request had been made to merge Article 5 with Article 9. The Secretariat further pointed out that Article 9 also contained a provision concerning the form of legal protection which also appeared in the previous text but which had been slightly modified to clarify that a Contracting Party was free to choose the type of legislation under which it established the protection stipulated in the draft Revised Lisbon Agreement, provided that such legislation met the substantive requirements of the Agreement.

35. As regards Articles 10 and 11 the Secretariat recalled that the text of those provisions had emerged from the discussions that had taken place at the previous session of the Working Group, with one exception, namely, the addition of a footnote to Article 11 which dealt with the protection against becoming a generic term or name. The insertion of such footnote appeared to be necessary, because the TRIPS Agreement used different wording compared to the Lisbon Agreement in respect of that issue. More specifically, the TRIPS Agreement did not use the term “generic”, but referred to “a term customary in common language as the common name for such goods or services” and to “the customary name of a grape variety”. Referring to Article 12 on duration of protection, the general view was that the provision had to deal with two issues, namely, first, the issue that was also addressed in the current Lisbon Agreement, that an international registration would be protected as long as the appellation of origin was protected in the country of origin, without renewal; and, second, the issue was that protection could be limited in time in a given member State following a national Court decision invalidating the effects of an international registration in that particular member State. The Secretariat pointed out, however, that there still was another issue that had to be addressed in Article 12, namely the issue of acquiescence as contained in Article 24(7) of the TRIPS Agreement, which basically stated that if right holders failed to take action within a specific time period, they would lose the right to take action after that period. The Secretariat said that the issue of acquiescence had therefore also been reflected in Article 12.

36. As the Working Group had indicated at the previous session that the provisions dealing with prior rights should not address the issue by a mere reference to the relevant provisions of the TRIPS Agreement, an attempt had been made to reflect the provisions of the TRIPS Agreement in respect of prior trademark rights in Article 13(1). Article 13(2) dealt with overlapping appellations of origin or geographical indications, whereas Articles 13(3) and 13(4) dealt with the issue of personal names also addressed in Article 24(8) of the TRIPS Agreement, as well as with other legitimate rights or signs used in the course of trade along the lines of Article 24(4) of the TRIPS Agreement. Referring to Article 14, the Secretariat indicated that amendments had been made to the text in light of the discussions that had taken place and the suggestions that had been made at the previous meeting. The Secretariat went on to say that the text of Article 15(1) of the previous draft instrument now appeared in a new paragraph (2) of Article 15, namely, that a refusal should not be detrimental to any other protection that may be available in the Contracting Party that issued the refusal. The Secretariat pointed out that the main amendments introduced in Article 17 were reflected in the footnotes, notably the situation of a prior trademark containing a generic term, which raised the issue as to whether the provisions on prior trademarks should prevail or whether those on prior use as a generic should prevail.

37. In Article 19, a new paragraph (2) dealing with the grounds for invalidation had been introduced, on the basis of suggestions to that effect made at the previous meeting. As regards Article 28 which dealt with “Becoming Party to This Act”, the Secretariat indicated that a distinction had been made between States which were members of the Paris Convention and those which were not members of the Convention. The text specified that those States that were not party to the Paris Convention could only become party to the Act if their legislation complied with the provisions of the Paris Convention concerning appellations of origin, geographical indications and trademarks. The Secretariat added that a similar type of provision had been introduced in Article 28(1)(iii) in respect of intergovernmental organizations. Finally, the Secretariat indicated that in paragraph (2) of Article 32, a sentence comparable to the corresponding provisions in the Madrid Protocol and the Geneva Act had been introduced.

38. Referring to the Regulations contained in document LI/WG/DEV/7/3, the Secretariat pointed out that two options had been introduced in Rule 5. These concerned the details that had to be provided, or that could be provided, in respect of an appellation of origin or geographical indication regarding the link between the “quality or characteristics of the good

and the geographical environment” or in the case of a GI “the quality, reputation or other characteristic” of the good and the geographical area of origin. In that regard, the Secretariat recalled that in the previous version of the draft new instrument such details were mandatory items that had to be included in the international application. Following several objections made in that regard at the previous session, the Secretariat decided to go back to the text that was on the table at the fifth session of the Working Group, in which the provision in question was merely optional. The Secretariat further clarified that it had opted for an in-between position which left it to the Working Group to decide whether the provision of such details should be optional or mandatory. The Secretariat recalled that the reason why the provision had been objected to as a mandatory provision was that under the current Lisbon system it was merely optional, while also pointing out that it had only been introduced in the current Lisbon Regulations in January 2012.

#### DISCUSSION OF ARTICLE 13 OF THE DRAFT REVISED LISBON AGREEMENT

39. The Delegation of Hungary sought clarification of the first sentence of Article 13(1) and wondered whether it would not be preferable to either leave that sentence out or to change the sequence of the sentences in Article 13(1). The Delegation also sought further explanations from the Secretariat as regards the wording “each such Contracting Party shall respect such prior trademark right”.

40. As regards the first sentence of Article 13(1), the Delegation of France wondered how that provision would abide by the principle of the territoriality of trademark rights because the text referred to the “prior right in a trademark applied for or registered” in a Contracting Party while also indicating that “each such Contracting Party shall respect such prior trademark right”. In that regard, the Delegation also sought clarification as to whether the terms “each such Contracting Party” would actually imply that a Lisbon member State, in which the trademark had not been registered, would also have to respect the trademark in question. The Delegation also sought additional clarification regarding the scope of Article 13(1). In that regard, the Delegation indicated that, even if it did understand the reference made to the legitimate interests of each of the parties in the first sentence, as it incorporated the reference to the legitimate interests of the owner of the trademark contained in Article 17 of the TRIPS Agreement, it failed to understand the second sentence. With respect to the reference made to “legitimate rights based on other signs” in Article 13(4), the Delegation asked the Secretariat what was meant by “sign” as the term was ambiguous in its view.

41. The Delegation of Switzerland shared the concerns of the Delegations of France and Hungary in respect of Article 13(1) and Article 13(4). As regards the second sentence of Article 13(1), the Delegation wondered whether that sentence was actually intended to tone down what was said in the first sentence of 13(1) and sought clarification from the Secretariat in that regard. The Delegation recalled that it had been recognized in another forum, that the “first in time, first in right” principle did not necessarily always apply and that possibilities for coexistence existed. Such possibility for coexistence should be clearly provided for in the draft Revised Lisbon Agreement.

42. The Delegation of Romania expressed some doubts as regards Article 13(1), even though it was fully aware of the TRIPS Agreement requirement to respect prior trademark rights. The Delegation pointed out that before a specific form of protection for geographical indications and appellations of origin was introduced in Romania, protection was exclusively provided under trademark law. As a result, nowadays it was possible to find in Romania so-called trademarks which actually were geographical indications properly speaking but which were owned by holders located in another geographical area. In respect of such prior trademarks, an additional condition should be added, namely that the prior trademark holders

should come from the geographical area concerned. The Delegation pointed out that Romania was currently faced with various conflicts between registered geographical indications and such prior trademark rights.

43. The Delegation of the European Union welcomed the incorporation of the coexistence principle between a prior trademark and a later geographical indication or appellation of origin in the draft Revised Lisbon Agreement. As regards “other prior rights”, the Delegation recalled that it had previously expressed doubts regarding the introduction of an explicit provision addressing other prior rights in the draft new instrument. In any event, there appeared to be room for improvement as regards the wording of Article 13, in particular as regards the notion of a “legitimate right other than those referred to in paragraphs (1) to (3)” in Article 13(4). The Delegation also requested further explanation on Article 13(2).

44. The Delegation of Peru agreed with other delegations as regards the need to clarify important concepts such as “legitimate rights” in Article 13(1). The Delegation further indicated that it failed to understand the necessity of having a provision such as the one contained in paragraph (2) of Article 13 in the draft Revised Lisbon Agreement. In that regard, the Delegation pointed out that neither the Peruvian nor the Andean legislation incorporated a principle of coexistence between appellations of origin and geographical indications and prior appellations of origin and geographical indications. Instead both legislations applied the “first in time, first in right” trademark law principle. Lastly, the Delegation shared the views expressed by other delegations as regards Article 13(4) and wondered what “other signs” Article 13(4) referred to.

45. The Delegation of Mexico underlined the importance of the questions raised by the Delegations of France and Switzerland.

46. Referring to the first sentence of Article 13(1), the Representative of CEIPI sought clarification on the expression “where possible” as no equivalent expression could be found in the TRIPS Agreement, while also pointing out that the French and English terms “*le cas échéant*” and “where possible” did not necessarily correspond to one another. Along the lines of what the Delegation of France had asked regarding the territoriality of rights and the expression “each such Contracting Party”, he wondered whether it would not be preferable to say “~~that in this~~ Contracting Party”, or “~~in such Contracting Party~~”, so as to respect the principle of territoriality. The Representative of CEIPI sought further clarification on Article 13(4). In particular, he noted that paragraph (4) stated that paragraph (3) was applicable in respect of other signs used in the course of trade, and therefore wondered whether that actually meant that paragraph (4) was limited to the right to use a personal name. If that was not the case he wondered why a specific reference was made to paragraph (3).

47. The Delegation of Italy shared the views expressed by the Delegation of Peru as regards Article 13(2), and also sought an explanation from the Secretariat concerning the meaning of *mutatis mutandis* in paragraphs (2) and (4) and what those terms entailed in practice.

48. The Delegation of Moldova welcomed the possibility of coexistence between geographical indications and trademarks provided for in Article 13. However, taking into account its own practice and also what had been mentioned by the Delegation of Romania, the Delegation was of the view that the proposed principle of coexistence had to be made subject to an additional requirement, namely that the prior trademark would be protected only in the absence of any ground for its cancellation or revocation.

49. The Representative of INTA welcomed the insertion of substantive provisions on trademarks rights in the draft Revised Lisbon Agreement, while also recalling that at previous sessions the Representative of INTA had also indicated that another option would be to

combine substantive provisions with language clarifying that the provisions of the Agreement were without prejudice to the provisions of the TRIPS Agreement as far as WTO Members were concerned ~~WTO members not be prejudiced in their obligations under the TRIPS Agreement~~. As far as the title of the provision was concerned, the Representative of INTA wondered whether it would not be more desirable to simply refer to prior rights rather than legitimate rights in order to avoid controversy on what the precise standard for legitimacy should be. Then, as regards the first sentence of Article 13(1) concerning the obligation for Contracting Parties to respect prior trademark rights, she said that INTA would favor the inclusion of an express clause specifying that such provision entailed that trademark owners had to be given an opportunity to request the refusal or invalidation of the appellation of origin or geographical indication in the Contracting Party where they had prior rights in accordance with the principle of “first in time, first in right”. She also expressed doubts on the language “taking into account the legitimate interests” in the second sentence of Article 13(1). In that regard, she stated that it was her understanding that the drafting had been guided by ~~understood the reference to~~ Article 17 of the TRIPS Agreement but ~~added~~ that it appeared somewhat unclear why such a clause would be required in the context of the second sentence of Article 13(1) which did not deal with conducts that the trademark owner would be obliged to tolerate, such as fair descriptive use, but rather about the trademark owner's right to obtain the trademark registration, to maintain the registration or to use the trademark. INTA would have concerns as regards the inclusion of a standard that could be interpreted as limiting trademark rights beyond the usual limitations of fair descriptive use. Then, she stated that she considered it correct for the provision not to be limited to trademarks from the geographical area. Such limitation would be incompatible with the TRIPS obligations to respect prior trademarks and the fundamental rights guarantees. Further, of course, this did not prevent that, if a ground for invalidation existed under national law, for example if the trademark in question would be considered as being descriptive or misleading in a given Contracting Party, the prior trademark ~~could~~ should be invalidated. Altogether, she was of the view that Article 13 should make it crystal clear that the provision concerned exceptions to Article 10, so that Article 10 would not apply in respect of use under a prior trademark. She also suggested spelling out expressly for clarification purposes, as is the case in the EU Regulation on geographical indications for agricultural products and foodstuffs, that the right to renew a prior trademark would not be affected.

50. The Delegation of Romania shared the views expressed by the Representative of INTA and agreed that it would be preferable to amend the title of Article 13 and to replace the term “Other Legitimate Rights” by “Other Prior Rights”.

51. Referring to Article 13(1), the Representative of MARQUES suggested introducing a clearer wording concerning the prior rights based on trademarks so as to cover all the situations that could happen between geographical indications and trademarks. The text as currently drafted only made reference to the respect of prior trademarks that would not be canceled or invalidated “on the basis that such a trademark is identical with, or similar to, the denomination or indication”. However, he wondered what would happen in the case of geographical indications and trademarks that would not be identical or similar but that would still be considered as colliding with one another, for example when a certain design mark would be considered as colliding with a geographical indication that would only consist of one word, or the case of a trademark consisting of a name that would be considered as being somehow linked to a geographical area even if it did not present any similarity with the geographical indication.

52. The Delegation of Georgia also had difficulties with the wording of the first and second sentences of Article 13(1). The Delegation suggested adding two additional sentences to Article 13(1) that would read “The registration of the trademark and its fair use, shall not be terminated if the registration took place before the protection has been granted to the

appellation of origin or the geographical indication in the country of origin, provided that coexistence of the trademark and appellation of origin or geographical indication does not lead the public into confusion as to the true origin of the goods” and “Taking into account their reputation of the registered trademark, its renown and duration of use, the appellation of origin or geographical indication shall not be registered if such a registration leads the public into confusion as to the true origin of the goods”.

53. As regards the relationship between the first and the second sentences of Article 13(1), the Secretariat recalled that the difficulty for drafting that particular provision was the existence of a provision in the TRIPS Agreement, namely Article 24(5), which dealt with conflicts between geographical indications and prior trademarks, while a number of questions related to that provision had been dealt with in the context of a panel procedure in a dispute settlement proceeding in the WTO, which had resulted in a panel report that focused not so much on Article 24(5) in addressing the questions concerning conflicts between geographical indications and prior trademarks, but rather on Article 17 of the TRIPS Agreement, which dealt with exceptions to the rights conferred by a trademark. While it was clear that Article 24(5) dealt with an exception to the protection to be provided by WTO members in respect of geographical indications, the question put to the panel was intended to determine what implications the trademark provisions of the TRIPS Agreement had on how WTO members should address the questions concerning conflicts between trademarks and geographical indications, in particular prior trademarks and geographical indications. The panel had addressed that question in light of the provisions of Article 17 of the TRIPS Agreement, which stipulated that WTO Members “may 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”. The term “legitimate interests” contained in Article 13(1) of the draft Revised Lisbon Agreement had been taken from that provision. The existence of Article 24(5) of the TRIPS Agreement, which dealt with conflicts between geographical indications and earlier trademarks, and of the panel report specifying that Article 17 also played a role in that respect, had required combining those two provisions in draft Article 13(1).

54. The Secretariat went on to say that another aspect that it had to take into account in preparing draft Article 13(1) was the fact that different approaches of the issue applied under national and regional legislation. There were legislations which strictly applied the principle of “first in time, first in right” and under which the later geographical indication could not be granted protection because the prior trademark prevailed. However, there were also legislations which allowed for coexistence. In addition, the Secretariat stressed that the legislation of the European Union combined both systems, as it incorporated a provision which established a coexistence principle in respect of prior trademarks and later geographical indications or appellations of origin, as well as a provision which stated that prior well-known trademarks would prevent the grant of a later geographical indication or appellation of origin. The Secretariat indicated that it had tried to capture both possibilities in draft Article 13(1). The second sentence of Article 13(1) referred to the possibility under Article 15 and Article 19 of the draft Revised Lisbon Agreement for a Contracting Party to issue a refusal or, if a refusal had not been issued, to invalidate the effects of the international registration in its territory later on in time. For this reason, the principle of coexistence had not been expressed more explicitly in draft Article 13(1). Nevertheless, as Article 17(3) of the draft Revised Lisbon Agreement showed, coexistence was the default situation, at least in the case addressed in that provision.

55. The Secretariat indicated that the drafting suggestions presented by the Delegation of Georgia would be looked into. Referring to the question which had been raised as to what the words “where possible” meant in the first sentence of Article 13(1), the Secretariat pointed out that, even though Article 24(5) of the TRIPS Agreement did not mention the words “where possible”, it did say “where rights to a trademark have been acquired through use in good faith”

and also added that under the trademark section of the TRIPS Agreement, in particular the last sentence of its Article 16(1), the provision of trademark rights on the basis of use was merely an option rather than an obligation. In consequence, the Secretariat had introduced the terms “where possible” to indicate that there was no obligation for countries to provide a trademark right on the basis of use, in view of the fact that there were countries which only provided such a right on the basis of registration. Referring to the question concerning the meaning of “shall respect such prior trademark right” in the first sentence of Article 13(1), the Secretariat indicated that those terms had only been used to make a link between the first and the second sentence. Then, referring to a question raised by the Delegation of France and the Representative of CEIPI about the wording “each such Contracting Party shall respect such prior trademark right”, and more particularly whether that would mean that whenever a prior trademark right existed in a specific Contracting Party all the other Contracting Parties would have to respect that prior trademark right, the Secretariat clarified that obviously the prior right would only apply in the jurisdiction where it existed. More precise language might need to be used in that regard. With respect to the question raised about the use of the words “legitimate rights” in the title of Article 13(1), the Secretariat reiterated that the word “legitimate” was taken from Article 17 of the TRIPS Agreement and also pointed out that Article 13(1) did not speak of “legitimate rights” but of “legitimate interests”. The Secretariat further clarified that the term “legitimate rights” was used in the title because Article 13 did not only deal with prior trademark rights but also with other prior rights and personal names. As regards the suggestion that the safeguard for prior trademarks should be limited to prior trademarks for goods from the same geographical area, the Secretariat did not agree, pointing out that often there were also prior trademarks which did not concern at all goods from the geographical area of origin. As regards the suggested limitation of the protection of a prior trademark to situations where no revocation, cancellation or invalidation existed, the Secretariat indicated that that principle had been taken up in Article 17(3), while also indicating that perhaps it should be included in Article 13 as well. The Secretariat duly noted the point raised by the Representative of MARQUES in relation to Article 13(1) but also emphasized that Article 13(1) used text that originated in Article 24(5) of the TRIPS Agreement which used those words on the basis that such a trademark would appear to be “identical with, or similar to, the denomination or the indication”.

56. The Secretariat said that the provision of Article 13(4) indicated that the provisions of Article 13(3) could be applied *mutatis mutandis*, while specifying that such *mutatis mutandis* application had to be limited to prior rights. The specification was necessary in order to distinguish Article 13(4) from Article 13(3), which was not limited to *prior* use of a personal name, in line with Article 24(8) of the TRIPS Agreement. As regards the inquiry concerning the meaning of “another sign” in Article 13(4), the Secretariat pointed out that there were various other legitimate rights such as plant variety denominations or trade names which had to be referred to collectively in the provision and that was the reason why the term “sign” had been chosen. With regard to Article 13(2), the Secretariat recalled that the Delegation of Peru had indicated that under its legislation and the legislation of the Andean Community, the “first in time, first in right” principle applied in respect of appellations of origin and geographical indications, so that two appellations of origin or geographical indications could not coexist if they used the same term. The Secretariat pointed out that the Notes on the draft Revised Lisbon Agreement contained in document LI/WG/DEV/7/4 explained that Article 13(2) was meant to address the situation of overlapping denominations or indications, which did not necessarily involve homonymous denominations or indications. As an example, the Secretariat referred to two registrations in the Lisbon register which used overlapping words and which both concerned wines: one concerned a fortified wine from Portugal, namely *Porto*, while the other concerned a wine from Corsica in France, namely *Porto Vecchio*. In that regard, the Secretariat pointed out that even though they both contained the name “*Porto*” there appeared to be no conflict between the two, as confirmed by the fact that no refusal had been issued. Consequently, the two coexisted in all Lisbon countries. The Secretariat said

that it was precisely that type of situation that Article 13(2) tried to deal with and also pointed out that the suggestion that had been made was to deal with that situation in the same way as Article 13 dealt with conflicts between appellations of origin or geographical indications and prior trademarks.

57. The Chair thanked the Secretariat for the useful explanations. He said that a number of questions remained open, as indicated by the Secretariat, and required guidance from the Working Group.

58. Referring to Article 13(1), the Representative of CEIPI indicated that, even though he did understand the reason why the Secretariat had incorporated the words “where possible” in the provision, he was still of the view that those words were unnecessary, mainly because, if a Contracting Party did not recognize trademark rights based on use, then there would be no conflict at all. However, if considered necessary, he would suggest that the word “possible” be replaced by the word “applicable.”

59. The Chair said that one could perhaps leave out the words “where possible” in the provision because they were not absolutely necessary and their omission would not amount to placing any obligation on Contracting Parties to allow for trademarks acquired through use. As regards the reference to paragraph (3) in Article 13(4), the Chair indicated that his understanding was that such reference had been introduced only to avoiding repeating the first part of paragraph (3). In that regard, he therefore suggested reproducing the same words that were used in the first part of paragraph (3) in the first part of Article 13(4) to avoid any doubt or misunderstanding concerning the *mutatis mutandis* reference to paragraph (3).

60. The Secretariat said that it could also be explained in the Notes that the provisions of Article 13(1) did not imply that there would be an obligation for a country to recognize trademark rights established merely by use.

61. The Delegation of France expressed support for the suggestion by the Chair to reproduce the wording of paragraph (3) in Article 13(4), adding that also the last part of paragraph (3) should be repeated in Article 13(4). As regards the reference to “another sign used in the course of trade”, the Delegation sought further clarification from the Secretariat, all the more since the TRIPS Agreement only referred to “the customary name of a grape variety” while Article 13(4), as currently drafted, potentially covered any plant variety or animal breed.

62. The Chair was of the view that the Delegation of France had made a perfectly valid point concerning the relationship between paragraphs (3) and (4) of Article 13. In particular, the Delegation of France had rightly pointed out that in addition to the introductory part of paragraph (3), the last sentence of paragraph (3) also had to be included in Article 13(4) to address the case where use occurred in such a manner as to mislead the public. As regards the suggestion to establish a list of terms, signs or any other element that would fall under the scope of Article 13(4), the Chair agreed that greater clarity was needed as to the exact scope of the exceptions.

63. The Delegation of the European Union sought further clarification with regard to the relationship between paragraphs (3) and (4) of Article 13. Noticing that paragraph (3) referred to the protection of the right to use one’s personal name in business, the Delegation was of the view that if the provisions of Article 13(4) were simply aligned with the provisions of Article 13(3) then some might understand that what would be protected in that case, for example in respect of names of plant varieties, would only be the right to use the name of such plant variety and not the registration of the name of a specific plant variety.

64. Referring to the Secretariat's response to the comment made by the Representative of MARQUES concerning the terms "identical with" and "similar to" at the end of Article 13(1), namely that those terms merely reflected language from the TRIPS Agreement, the representative of INTA indicated that her earlier statement that it should be made entirely clear that Article 10 did not apply in its entirety to prior trademarks went into a similar direction as the concerns expressed by the Representative of MARQUES. She therefore ~~reiterated~~renewed her request for the introduction of specific language that would make it entirely clear that ~~all situations listed in~~ Article 10 in its entirety would not be applicable in relation to prior trademark rights, which in turn would help clarify that the concepts of identity and similarity that appeared at the end of Article 13(1) were not merely a subset of the situations referred to in Article 10.

65. The Chair asked the Representative of INTA whether she was suggesting that even trademarks that might have the effect of misleading consumers should be safeguarded.

66. The Representative of INTA said that Article 13(1) should have the effect that prior trademark rights would be respected unless there would be a reason to invalidate the trademark because of its descriptiveness, its deceptiveness or because of another ground for its rejection, invalidation or cancellation in the relevant jurisdiction where the trademark is protected.

67. As regards Article 13(2), the Delegation of Peru had noted the explanation given by the Secretariat that the provision did not necessarily deal with cases of homonymy. The Delegation said that it would consult its authorities.

68. The Delegation of the Russian Federation sought further clarification on Article 13(4). It was the understanding of the Delegation that the provision in question tried to regulate the relationship between a number of subjects and objects of protection, and wondered whether a provision of such a general nature would be appropriate. In other words, the Delegation wondered whether it would be appropriate to have a provision which potentially regulated situations concerning rights that had not yet been granted and objects of protection for which protection had not yet been claimed.

69. The Secretariat said that the words "each such Contracting Party" in Article 13(1) would be modified so as to clarify that the provision would only refer to the situation that would exist in the territory of a specific Contracting Party, without any effect on the territory of other Contracting Parties. In response to the point made by the Delegation of France about the relation between Article 13(4) and Article 24.4 of the TRIPS Agreement, the Secretariat said that its understanding was that the situation covered by Article 24.4 of the TRIPS Agreement was also covered by Article 13(4) of the draft Revised Lisbon Agreement, which did not necessarily imply that Article 24.4 had to be applied in respect of any kind of goods. However, in view of the scope of protection and coverage of Article 10 of the draft Revised Lisbon Agreement, it would not be illogical if the provision would be applied in that way. As regards the question raised by the Delegation of the European Union in respect of plant variety denominations and in particular whether the safeguard would also apply to the registration of the plant variety and the denomination in particular, the Secretariat expressed the view that if the plant variety registration would not be safeguarded, then the use would probably not be safeguarded either. As regards the point made by the Delegation of the Russian Federation in respect of Article 13(4), namely that the rights that Article 13(4) aimed to address had to be specified, the Secretariat indicated that it had not done so for two reasons, one was that the current Lisbon system did not specify them either, and the other was that the Secretariat would need further input from delegations to determine which other rights should be covered.

70. Referring to the relation between Article 13(4) and Article 24.4 of the TRIPS Agreement and whether or not the idea was to extend the object of protection beyond what was mentioned in Article 24.4, the Delegation of Switzerland was of the view that the provision in Article 13(4) was very broad. As far as the Delegation understood it, Article 24.4 of the TRIPS Agreement was a means to allow a limited number of individual prior uses to be continued, whereas Article 13(4) seemed to indicate that such individual uses might also be used as a means to invalidate the registration of a given appellation of origin or geographical indication.

71. The Chair invited the Secretariat to further clarify to what extent Article 13(4) actually transposed the provisions of Article 24.4 of the TRIPS Agreement, in light of the fact that not all delegations saw Article 13(4) as a proper implementation of that specific provision of the TRIPS Agreement. The Chair noted the widely shared concern that Article 13(4) would be too broad without any further specification of the signs, terms or names that would be covered.

72. The Representative of CEIPI said that the Working Group would also have to determine whether Article 13(4) should also extend to terms protected by copyright.

73. In light of the fact that Article 13 was one of the most important provisions of the draft Revised Lisbon Agreement, the Delegation of Iran (Islamic Republic of) suggested to ask the Secretariat to prepare a revised version of Article 13 and continue the discussion later on during the present session on the basis of such a revised version.

74. Referring to the issues raised by the Delegation of Switzerland and other delegations in relation to Article 13(4) and its relationship with Article 24.4 of the TRIPS Agreement, the Secretariat pointed out that Article 13(4) established that only "legitimate rights" would be safeguarded, whereas if one looked at Article 24.4 of the TRIPS Agreement one could notice that it did not incorporate the word "rights" but only referred to "prior use". In other words, the provision left it to each country to decide to what extent such prior use would establish a right or not. In consequence, the Secretariat indicated that Article 13(4) did not necessarily mean that the prior use addressed in it did establish a legitimate right. In effect, if prior use did not necessarily mean prior right in a particular country then obviously no legitimate right would have to be safeguarded.

75. The Chair noted that the Working Group supported the suggestion made by the Delegation of Iran (Islamic Republic of) that the Secretariat be requested to prepare a revised version of draft Article 13 that would reflect the drafting suggestions made, with square brackets where necessary.

#### DISCUSSION OF ARTICLE 17

76. The Delegation of the European Union requested the Secretariat to clarify whether, under Article 17(3), the coexistence rule regarding prior rights would be respected. In that regard, the Delegation wondered whether it would not be possible to somehow shorten and simplify that sentence in light of the fact that Article 2 of the draft Revised Lisbon Agreement already incorporated definitions for both appellations of origin and geographical indications. The Delegation also suggested, in respect of Article 17(1), to replace "a denomination constituting an appellation of origin" and "an indication constituting a geographical indication" by "appellation of origin" and "geographical indication".

77. The Delegation of France supported the suggestion made by the Delegation of the European Union to simplify the text in Article 17(1), in particular because Article 1(x) provided a definition of a “registered” appellation of origin, namely “entered in the International Register in accordance with this Act”. The Delegation was therefore of the view that it would be pointless to specify “under this Act” each and every time the text would be dealing with a registered appellation of origin.

78. Regarding the issue of coexistence, the Delegation of France said that, under Article 13(1), prior rights should not be affected and therefore suggested using wording such as “without prejudice to Article 13, where a Contracting Party has refused”, as that might be simpler. The Delegation pointed out that the main problem raised by Article 17 was that the phasing out period might not apply to generic terms, as indicated in footnote 7, and therefore suggested giving additional thoughts to that restriction.

79. The Secretariat indicated that Article 17(3) dealt with those international registrations that a Contracting Party had actually refused, on the ground that a prior right existed in its territory. A Contracting Party where prior rights always prevailed did not need to issue a refusal, as Article 13 would allow it to safeguard prior rights and did not require the notification of a refusal in such a case. However, when a refusal had been issued, the possibility existed that the Contracting Party of Origin had contacted the Contracting Party that had submitted the refusal in order to have the refusal withdrawn. In the case of such a withdrawal by a Contracting Party allowing for coexistence, Article 13 would still apply, so that the prior legitimate right would continue to be safeguarded and result in a situation of coexistence. The Secretariat added, however, that if the refusal would be withdrawn by a Contracting Party following a Court decision pronouncing the invalidity of a prior trademark either because it had not been renewed or because it had been cancelled by the owner, for example, then Article 13 would not apply. This was what Article 17(3) attempted to establish.

80. In respect of the question concerning the phrase “a denomination constituting an appellation of origin registered under this act”, the Secretariat clarified that such a long phrase had been used because if one only used the words “appellation of origin” as suggested by the Delegation of the European Union those words would be defined by Article 2, however, the prior use was not the use of the appellation of origin, it was another use, namely the use by a third party of a term which later on in time had received protection as an appellation of origin.

81. As regards, the difficult question of what to do with the use of a generic term in a trademark or in other rights, the Secretariat pointed out that the issue had already been put forward a few times and therefore requested further guidance from the Working Group on how that should be dealt with. More concretely, the Secretariat indicated that the question that had to be addressed was whether the use of a generic term in a trademark should be phased out or not. In that regard, the Secretariat pointed out that footnote 7 already appeared to suggest that the use of a generic term in a trademark should be phased out.

82. The Chair first sought guidance from the Working Group with respect to exceptions to protection such as the one provided for in Article 24.4 of the TRIPS Agreement, which was an exception in favor of an earlier use under certain conditions. He also sought guidance from the Working Group on the question as to whether exceptions to rights qualified as rights themselves. Did Article 24.4 of the TRIPS Agreement not rather establish an exception to the protection that should otherwise be provided for, without any basis in a specific right that had to be safeguarded? Referring to the particular case of composite trademarks containing a generic term as one of their elements, the Chair indicated that his first reaction would be to deal with those cases under the provisions relating to prior trademark rights rather than under those relating to generic terms.

83. The Delegation of the European Union expressed support for footnote 7.
84. The Delegation of the Republic of Moldova said that the use of a generic term in a trademark should not simply fall under the scope of Article 13 because the use of a generic term in a trademark could also result in the dilution of a geographical indication or appellation of origin.
85. In response to a request for clarification of footnote 7, the Secretariat said that the footnote tried to say that, if the prior trademark right did not extend to the generic term, precisely because of the generic character of the term, then use of the generic term should be phased out. Consequently, use of the prior trademark could only be continued if the trademark owner would remove the generic term from the trademark. The Secretariat also pointed out that many trademark offices required a disclaimer in a trademark registration in respect of a generic term, which made it obvious that the term was not covered by the trademark and that it indeed was a generic term covered by Article 17(1) and (2) and subject to phasing out provisions.
86. The Delegation of France was of the view that the registration of a generic term within a trademark did not confer any right over the use of such term and said that it would therefore be convenient to plan for a phasing out of the use of such generic term also when it was registered as an element of the trademark.
87. The Delegation of Hungary said that it would be appropriate to examine the national legislation of Contracting Parties, as well as the national legislation of those countries which might become party to the system, because in certain countries such as Hungary it was not possible to change a trademark after the application for its registration had been submitted. This rule applied in respect of the sign constituting the trademark, but not in respect of the list of goods and services.
88. The Delegation of Italy expressed support for the statement made by the Delegation of France.
89. The Delegation of the Republic of Moldova was of the view that it would be logical to apply the phasing out period to the use of a generic term in a trademark but that an appropriate mechanism to do so still had to be found, all the more since intellectual property officers could not *ex-officio* oblige the trademark holder to amend the registered trademark after the registration had taken place.
90. The Chair was of the view that if a generic term formed part of a registered trademark, and if a phasing out period would apply to the generic term only, it would not mean that there would be a need to change the form or the combination of the trademark as it had been registered. In other words, the trademark could remain in the registry in its original form, but there would be an obligation on the trademark owner not to use the generic element of that trademark. In other words, the provision would only affect the way in which that registered trademark would be used. The Chair added that whether the use of the trademark without the generic term would affect the validity of the trademark, or whether it would lead to its revocation on the grounds of non-use, would be a matter to be dealt with under national legislation.
91. The Delegation of the European Union spoke in favor of the phasing out obligation in the case of a generic term incorporated in a trademark because such obligation would be in line with the provisions of Article 10 of the draft Revised Lisbon Agreement which protected geographical indications against for example any use that would amount to its imitation or usurpation. As regards the comment made by the Chair about the distinction between phasing

out the use and the need to introduce changes in the registered trademark, the Delegation was nonetheless of the view that it would be preferable to also amend the trademark in the trademark register for the sake of legal certainty. In particular, in the case of an opposition for example, the Delegation wondered whether the trademark owner would base its opposition against a third party on the basis of the trademark as it had been registered or not. As regards the concerns expressed about national legislations that would not provide for such changes in the Registry, the Delegation was of the view that since the proposed phasing out clauses would be included in an international agreement, it would be up to the national authorities to implement the necessary changes contained in the international legislation in order to comply with their obligations.

92. Contrary to what some delegations seemed to have understood, the Representative of CEIPI pointed out that Article 17(1) was optional as the text read “the Contracting Party may grant”. He asked the Secretariat whether the Working Group could be given a specific or even theoretical example of a trademark incorporating a generic term, because he could not imagine the case of a trademark holder that would only use one part of the trademark, namely the non-generic part of the mark.

93. In response to the comment made by the Representative of CEIPI, the Chair expressed the view that amending a trademark already registered would be equally difficult. He added that his understanding was that even under the EU Regulation on trademarks the scope for changing a trademark in the trademark register was very limited and only very minor changes could be accepted.

94. The Secretariat said that the issue under discussion actually fell under Article 13. Under Article 17, a country could establish a phasing out period or not. In the second hypothesis, the protection of the appellation of origin or the geographical indication would become immediately effective and the question that would then arise was whether that protection would allow the holders of the right in the appellation of origin or the geographical indication to stop the use of the appellation of origin or the geographical indication as a generic term in the trademark or not. In other words, the issue was in fact an issue concerning the scope of protection under Article 10 and the safeguards under Article 13. Article 17 only allowed a mitigation of the effects of the rights established under the geographical indication or the appellation of origin. The issue under consideration was not procedural but substantive, as it was very much linked to the scope of protection accorded to registered appellations of origin or geographical indications under the draft Revised Lisbon Agreement. As an additional remark, the Secretariat pointed out that Article 17(1) started with the words “Without prejudice to the possibility of refusal under Article 15”, which in practice meant that if in a particular Contracting Party an appellation of origin or geographical indication had already been in use as a generic, that Contracting Party had the possibility of issuing a refusal to solve the issue. The same applied in the case of prior use as a generic in an earlier trademark and, in that regard, the Secretariat pointed out that it was only in the absence of a refusal that the issue under debate would arise.

95. The Chair indicated that the comment made by the Secretariat confirmed his earlier comment that the issue should be addressed under the provisions concerning prior trademark rights. He added that there seemed to be two schools of thought: one of these was based on the view that it would be possible to identify separable elements in a trademark, that could be either changed in the register or the use of which could be stopped, while the other was based on the view that the trademark had to be kept as a whole regardless of whether it contained a generic element or not and that the issue should be governed by the provisions on prior trademark rights.

96. The Delegation of France made an inquiry about the difference of treatment between paragraphs (1) and (2) of Article 17, in light of the fact that the sentence which appeared under paragraph (1), namely “the Contracting Party shall notify the International Bureau of any such period, in accordance with the procedures specified in the Regulations” did not appear in paragraph (2). As regards practical examples of trademarks incorporating a generic element, the Delegation referred to registered trademarks of wine labels or the packaging of goods, which contained an appellation of origin or a geographical indication as a generic term that was the subject of a disclaimer.

97. The Secretariat clarified that paragraph (2) would apply in the same manner as paragraph (1) and indicated that the provision would be amended to reflect this more clearly.

#### DISCUSSION OF CHAPTER I OF THE DRAFT REVISED LISBON AGREEMENT (ARTICLES 1 TO 4) TOGETHER WITH RULE 4 OF THE DRAFT REGULATIONS

98. Referring to the sentence “and which has given the good its reputation” in the last part of Article 2(1)(a)(i), the Delegation of Italy asked whether that was an additional requirement or whether it was merely a clarification of what preceded in the provision. As regards Article 3 and Rule 4, the Delegation was of the view that the International Bureau should also be provided with information that an interested party might need in order to be able to resort to the legal remedies available in a given Contracting Party, in particular since the Competent Authority might not be the same authority to which an interested party should resort for legal remedies in the Contracting Party concerned.

99. The Delegation of Hungary referred to Article 1(iii) and wondered whether this provision should not also refer to the Regulations under the current Lisbon Agreement, as the Lisbon Agreement would continue to be effective as long as not all its member States had joined the Revised Lisbon Agreement. As regards Article 1(xi) and Article 1(xii), the Delegation suggested extending its scope to Article 2(2) which provided some additional information to Article 2(1)(a), namely, that the entire territory of a Contracting Party could also be considered as the “geographical area of origin”. The Delegation further suggested examining the possibility to merge the text of Article 1(xi) and Article 1(xii) into a single provision. The Delegation further expressed the hope that the concerns, which had required the Secretariat to put the provisions concerning trans-border geographical areas of origin in Article 2(2) and Article 5(4) between square brackets, had been accommodated in the amended text under consideration. For Hungary, these provisions were of vital importance. As regards Article 3, it was the understanding of the Delegation that the idea was that each member State would designate a single Competent Authority. However, Rule 4(2) envisaged the possibility to designate different national authorities for different attributions or areas of competence. The Delegation also pointed out that Article 4 conveyed the wrong impression that under the current Lisbon Agreement it was already possible to register geographical indications.

100. The Delegation of Moldova expressed its preference for the term “due” instead of “attributable” in the appellation of origin definition of Article 2(1)(i). Referring to Rule 4(2) of the draft Regulations which stated that the Contracting Parties could designate different Competent Authorities “if different protection systems apply in respect of appellations of origin and geographical indications in the Contracting Party of Origin and different authorities have been empowered for those different protection systems”, the Delegation wondered whether that possibility would only apply in the case specified in Rule 4(2), or whether it would be possible to extend it to the situation of those countries where different authorities were responsible for different kinds of products. In that regard, the Delegation pointed out that, for example, there were countries in which the Ministry of Agriculture was empowered with the

protection of appellations of origin and geographical indications for agricultural products, whereas the Intellectual Property offices were empowered with the protection of the appellations of origin and geographical indications for handicraft products.

101. The Representative of CEIPI referred back to the comment made by the Delegation of Hungary concerning the scope of the "Regulations" in Article 1, and wondered whether it would still be possible or appropriate to establish common regulations such as the ones which existed in other WIPO systems, such as Madrid or the Hague, before the organization of a diplomatic conference for the adoption of a Revised Lisbon Agreement. As regards Article 1(xvii), he indicated that he felt uneasy with the definition provided in respect of "legal entity", for two reasons. First, because "legal entity" was a concept that was already used in other WIPO-administered treaties without any difficulty even though there had never been any attempt to define "legal entity". Second, he was of the view that the definition provided in Article 1(xvii) was either too long or too short. Certain nNational legislations, such as the Swiss legislation, referred to specific types of companies that would not necessarily fall under the proposed definition. In that regard, he expressed the view that it might be dangerous to give such a detailed definition which might in fact turn out to be too restrictive and also perhaps too broad. In sum, he wondered whether such a definition would be necessary and appropriate in the treaty itself and whether it would not be preferable to incorporate it in the Notes to the draft Revised Lisbon Agreement.

102. As regards Article 2(1), the Representative of CEIPI pointed out that the French version of the draft Revised Lisbon Agreement called for a choice between "*notoriété*" and "*réputation*", whereas the English version only used the word "reputation". In that regard, he explained that the term "*notoriété*" in the French version originated in the current Lisbon Agreement which had been concluded only in French. He further indicated that in the English translation of the authentic French text, the word "reputation" had been used. Meanwhile, in the TRIPS Agreement, which had been negotiated in English, the word 'reputation' that was used in the English version had been translated into French as "*réputation*". He added that it was not clear to him what the exact difference between "*notoriété*" and "*réputation*" was. However, since one was dealing with a revision of the Lisbon Agreement, he suggested keeping the word "*notoriété*" in the French version of the draft Revised Lisbon Agreement as well, whereas the word "reputation" would remain in the English version. He further indicated that there could perhaps be an agreed statement by the diplomatic conference stating that for the purposes of the draft Revised Lisbon Agreement "*notoriété*" and/or "*réputation*" in French should be considered synonyms.

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103. The Representative of CEIPI then sought clarification of footnote 4 in Article 2(1)(a)(ii), which stated that "the reputation of the good may serve as evidence of the connection between the quality, reputation or other characteristic of the good and its geographical origin", as he was of the view that the drafting was rather ambiguous in the sense that "reputation" proving the connection between the reputation of the good and its geographical origin did not mean much. He also wondered whether it would not be preferable to transfer subparagraph (1) of Article 2 to Article 1 and to amend the title of Article 1 so that it would read "Abbreviated Expressions and Definitions". Referring to the subtitle in Article 2(2), he suggested removing the "s" after "Area's" in the sentence "Possible Geographical Area's of Origin" replacing "Area's" by "Areas". Finally, he suggested a slight amendment of Article 4, so that the last part of the sentence would read "data relating to such international registrations" instead of "data relating to the status of such international registrations".

104. The Delegation of the European Union expressed the view that Article 1(xii) should read "trans-border geographical area of origin" in order to be coherent with item (xi) of Article 1. As regards Article 2(1), the Delegation noted that the formulation used still deviated from the text of the TRIPS Agreement regarding the definition of geographical indications and

recommended further alignment with that text. As a general remark, the Delegation indicated that it would be appropriate to choose one terminology consistently in Article 2(1)(a)(i), which is to say either “denomination” or “term”. The Delegation also pointed out that the appellation of origin definition under EU legislation did not require reputation. As regards Article 2(2), the Delegation suggested referring to a “Contracting Party of Origin” and replacing “may” by “shall” so that the sentence would read “shall consist of the entire territory of a Contracting Party of Origin or a region or locality in a Contracting Party”. The Delegation then requested further clarification from the Secretariat as to whether a term like “*Reblochon*” - a known geographical name designating an agricultural product - would be covered by the definition of Article 2(1)(a)(i). The Delegation pointed out that according to Article 5 of EU Regulation 1151/2012, the name identifying a product as a designation of origin or geographical indication did not necessarily need to consist of, or contain, the name of a geographical area.

105. The Delegation of Serbia expressed its satisfaction with the appellation of origin and geographical indication definitions provided in Article 2. The Delegation supported the Delegation of the Republic of Moldova regarding the term “due” in the definition of appellation of origin. The term “due” had a stronger meaning than “attributable” and was more in line with the concept of appellation of origin.

106. Referring to the definition of “legal entity” in Article 1(xvii), the Delegation of France wondered why a reference to “individuals” was made given that individuals usually were natural persons. Moreover, if the idea was to refer to individual companies, the Delegation pointed out that those would be covered by the concept of companies or businesses. As regards Article 2, the Delegation expressed a preference for keeping it as a separate provision instead of including it in Article 1 as suggested by the Representative of CEIPI. The Delegation said that it did not have any solution to propose with respect to the difference between “*notoriété*” and “*réputation*” in French or “reputation” in English. The Delegation indicated that some clarification was needed in light of the fact that the French version of the TRIPS Agreement used the word “*réputation*” for “reputation”, whereas the term “*notoriété*” was used whenever a reference was made to well-known trademarks. The Delegation further reiterated the comment it had made at the previous session, namely that the expression “and which has given the good its reputation” was used in plural form in the French version which implied that the expression referred to the qualities that had given the good its reputation, whereas in the current wording of the Lisbon Agreement, the reputation was linked to the name and not to the characteristics of the good. As regards footnote 3 under Article 2(1)(a)(i), concerning appellations of origin, the Delegation expressed great concern, as it seemed to indicate that the reputation of the good could serve as sufficient “evidence of the connection between the quality or characteristics and the geographical environment of the area of production”. Finally, with respect to Article 2(2) which dealt with “Possible Geographical Area of Origin”, the Delegation pointed out that the “area of origin” in French could refer to the entire territory of a Contracting Party in some cases, but also to a territory smaller than a “locality” and therefore suggested replacing the term “locality” by “particular place”.

107. The Delegation from Iran (Islamic Republic of) questioned the necessity of having a definition of legal entity in Article 1(xvii), in particular since the notion of legal entity could be defined in various ways in different national legislations. Along the same lines, the Delegation also expressed doubts about the necessity of defining “geographical area of origin” and “trans-border geographical area” in items (xi) and (xii), all the more since both items contained references to the definitions provided in Article 2. As a general remark, the Delegation renewed its request to delete or reduce the number of footnotes in the draft Revised Lisbon Agreement. Referring to the issue of “reputation”, the Delegation recalled the suggestion it had made at one of the previous sessions to replace any reference to reputation by the expression “traditionally known to be” in the definition of appellation of origin. At the time, its

proposal had been contested by some delegations, but it had been agreed that the Secretariat would come up with some text that would provide the assurance that whenever any new appellation of origin would be submitted to the International Bureau for purposes of registration under the Lisbon system, there would be no fact finding mission to establish whether the characteristics or the quality of the product were really, chemically or physically due to the geographical area or to the human or natural factors in that region. The Delegation was of the view that such objective had been achieved by the Secretariat in footnote 3 of Article 2(1)(a)(i). However, if necessary, the text could be amended so that the last part of the sentence would read “where the quality or characteristics of the good are, or are reputed to be, due exclusively or essentially to the geographical environment...”

108. The Delegation of Venezuela (Bolivarian Republic of) was of the view that the terms “*notoriedad*” and “*reputación*” were synonyms in Spanish.

109. Referring to the comments made by the Representative of CEIPI and the Delegation of Iran (Islamic Republic of) regarding Article 1(xvii), the Delegation of Georgia said that under Georgian legislation a government agency could also be regarded as a legal entity. The Delegation was therefore of the view that Article 1(xvii) should also incorporate a reference to State bodies, public authorities, or government agencies among the list of entities that could be considered as being legal entities.

110. The Delegation of Switzerland agreed with the suggestion to delete the definition of legal entity in Article 1(xvii). As regards Article 1(xvi), the Delegation sought clarification as to why the term “beneficiary” had replaced the expression “holder of the right to use” that was used in the current Lisbon Regulations. Referring to Article 2(1), the Delegation wondered whether the provision could not be somehow simplified by merging subparagraphs (a) and (b) into a single paragraph, to be followed by items (i) and (ii). As regards geographical indications, the Delegation also suggested using the TRIPS definition to avoid different interpretations between the two instruments. Following the intervention made by the Delegation of Iran (Islamic Republic of), the Delegation had a better understanding of the aim of footnotes 3 and 4 but was also under the impression that an attempt was being made to reinterpret the definitions of “notoriety” and “reputation” established under the Lisbon Agreement and the TRIPS Agreement. The Delegation supported the suggestion made by the Representative of CEIPI for an agreed statement in respect of the notions “*réputation*” and “*notoriété*”.

111. The Delegation of Romania shared the doubts expressed by the Representative of CEIPI and other delegations with respect to the proposed definition of legal entity. As regards the French terms “*réputation*” and “*notoriété*”, the Delegation was of the view that the two terms were not synonyms and added that since the word “*notoriété*” was most commonly used under trademark law, it had a preference for the word “*réputation*” in Article 2(1)(a)(ii) of the French version of the draft Revised Lisbon Agreement.

112. As regards the structure of Article 2, the Delegation of Peru suggested that the last part of Article 2(1) be moved to the beginning of Article 2(1)(a) so as to read “This Act applies to appellations of origin and geographical indications: (i) appellation of origin means any denomination [...]; (ii) geographical indication means any indication [...]”. Referring to the proposed definition of appellation of origin, the Delegation was under the impression that the proposed wording seemed to suggest that the name of a country could no longer be used as an appellation of origin and that only the name of a geographical area situated in that country could be recognized as an appellation. The Delegation therefore suggested reverting back to the wording of the Lisbon Agreement. As regards the use of the terms “*notoriedad*” or “*reputación*”, the Delegation was of the view that the word “*reputación*” should be used in the Spanish version, as it had already indicated at the previous session.

113. The Delegation of Portugal agreed that the definition of legal entity could be deleted in Article 1. As regards the definition of appellation of origin, the Delegation expressed a preference for the term “due” rather than “attributable” in Article 2(1)(a)(i). The Delegation also agreed with the Delegation of France to keep Article 2 separate from Article 1.

114. The Delegation of the Russian Federation supported the suggestion made by other delegations to delete the definition of legal entity. Under Russian legislation, there was a possibility of carrying out entrepreneurial activities not only as a legal entity but also as an individual that did not qualify as a legal entity. Hence, the Delegation was of the view that the definition of legal entity as currently drafted was not satisfactory and therefore supported the proposal to delete the text completely and to leave it to the national legislation of each Contracting Party. Regarding the definitions of “appellation of origin” and “geographical area of origin”, the Delegation was of the view that those definitions had to be further aligned with the definition of appellation of origin which already existed in the current Lisbon Agreement. Lastly, the Delegation also expressed a preference for the term “due” instead of “attributable” in Article 2(1)(a)(i).

115. The Delegation of Costa Rica agreed with the suggestion made by the Delegation of Peru regarding the structure of Article 2. As regards the definition of legal entity in Article 1(xvii), the Delegation agreed with other delegations to leave it to the domestic legislation of each Contracting Party to deal with the issue.

116. The Delegation of Iraq shared the view that the terms “*notoriété*” and “*réputation*” were not synonyms in French. “*Réputation*” derived from the fact that the public at large was aware of the product or of a given denomination, whereas the term “*notoriété*” was rather a philosophical concept that was not related to the public awareness or ignorance of the existence of a given product or name.

117. Summarizing the discussions, the Chair said that the suggestion to take up the definitions of Article 2 in Article 1 had not obtained sufficient support, as many delegations had spoken in favor of keeping Article 2 separate from Article 1. As regards Article 1(iii), for the time being, the Working Group would work on the assumption that there would be two separate sets of Regulations, one under the current Lisbon Agreement and the other under the draft Revised Lisbon Agreement. However, as had happened in the case of the Madrid Agreement and the Madrid Protocol, the Working Group did not exclude the possibility of merging those Regulations into Common Regulations when the time would appear to be ripe. There had been strong support for the deletion of the definition of legal entity. The notion of legal entity was a horizontal concept that was not specific to appellations of origin or geographical indications and that was also widely used in other WIPO instruments without being defined therein. Furthermore, as it was a concept which was widely used even outside the intellectual property context, the notion of legal entity had to be defined under the legal system of each Contracting Party anyway. However, as this might not accommodate the concerns expressed by some delegations in that respect, he suggested that the Secretariat would look into the possibility of including an explanation either in the Notes, or in a footnote, or in a statement by the diplomatic conference, in order to clarify that the concept of legal entity should be interpreted as broadly as possible.

118. The Chair noted that most delegations seemed to prefer the term “due” instead of “attributable” in Article 2(1)(a)(i). He also noted that there had been repeated calls for bringing the definition of Article 2(1)(a)(ii) still closer to the definition of geographical indication contained in the TRIPS Agreement. As to the question whether the name of a country could qualify as an appellation of origin or as a geographical indication, he referred to the first sentence in Article 2(2) where reference was made to “the entire territory of a Contracting Party” which would appear to confirm that the name of a country could constitute a

geographical indication or an appellation of origin. There had also been a suggestion to remove the square brackets in the second sentence of Article 2(2) concerning trans-border areas. Referring to the issue of “reputation” in Article 2, irrespective of whether “*notoriété*” and “*réputation*” were synonyms or not in French, the Chair was of the view that the best way of settling the problem would be to include an interpretative agreed statement in the Revised Lisbon Agreement indicating that “*notoriété*” and “*réputation*” were synonyms for purposes of the agreement. It had also been pointed out that the English and French texts of Article 2 did not fully correspond.

119. The Chair noted that different questions had been raised on Article 3, in particular whether there could be different competent authorities for different product categories, or different competent authorities based on the different functions to be fulfilled in the application of the Agreement. He further noted that there had been a suggestion that a Contracting Party also should notify the name of the authority, as indicated in Article 14. Lastly, he noted the suggestion to delete the words “the status of” in Article 4.

120. The Representative of CEIPI supported the idea of having an agreed statement that would indicate that the terms “*notoriété*” and “*réputation*” should be regarded as synonyms for purposes of the draft Revised Lisbon Agreement so that the interpretation or those notions in the context of trademarks would not be affected.

121. Responding to the questions raised, the Secretariat first referred to the last sentence of Article 2(1)(a)(i) which read “and which has given the good its reputation”, as some delegations had asked whether this was an additional requirement. The Secretariat recalled that Article 2(2) of the current Lisbon Agreement already contained that requirement and, in that sense, it was clearly not an additional requirement. As regards Article 1(iii), the Secretariat said that Rule 7 which dealt with “Entry in the International Register” already hinted in the direction of common regulations because the provision dealt with registrations in the International Register under the Lisbon Agreement or under the Revised Lisbon Agreement. As regards the possibility to identify different competent authorities, the Secretariat pointed out that Rule 4 of the Lisbon Agreement and of the draft Revised Lisbon Agreement already provided for that possibility. As regards the request to have different authorities responsible for different kinds of products, the Secretariat clarified that the purpose of the provision concerning the “competent authority” was really to identify which Government agency would be competent for purposes of communicating with the International Bureau under the procedures of the Lisbon system and nothing more than that. Unlike in the area of trademarks and patents, in the area of geographical indications and appellations of origin, there could be different agencies at the national level competent for granting protection. Therefore, there was a need for each Contracting Party to indicate which would be the competent agency, Ministry or office, which would communicate with the International Bureau under the procedures of the Agreement. However, the fact that a Contracting Party identified a particular authority for purposes of communicating with WIPO under the procedures of the Lisbon system did not mean that such would be the only competent authority in that Contracting Party for the protection of geographical indications and appellations of origin. In Article 2(2), “Possible Geographical Area’s of Origin” was a typographical error and should read “Possible Geographical Areas of Origin”. As the Chair had already pointed out, the purpose of Article 2(2) was to respond to a request made at a previous meeting to clarify that the entire territory of a Contracting Party could also constitute an appellation of origin or geographical indication. As regards the sentence “or a term known as referring to such area” in Article 2(1)(a)(i), the Secretariat clarified that it had been introduced in the text to make it clear that non-geographical terms which had acquired a geographical connotation could also be registered under the draft Revised Lisbon Agreement. In that regard, the Secretariat reiterated that such a possibility already existed under the current Lisbon Agreement, as confirmed by the Lisbon Union Assembly in 1970, in particular in the case of the appellation of origin “*Reblochon*”. The

Secretariat also clarified that the same phrase had not been taken up in Article 2(1)(a)(ii), in the definition of geographical indication, because there had been some differences of view among delegations in that respect at the previous session of the Working Group. More particularly, some had been of the view that the word “indication” was broad enough to also extend to those terms which were not strictly speaking geographical, while other delegations had expressed a different view on the matter.

122. The Delegation of Peru had noted the explanation given by the Secretariat that an appellation of origin or a geographical indication could also include the name of the country itself, but nonetheless suggested that this be more clearly reflected in the definitions provided in Article 2(1).

#### DISCUSSION OF CHAPTER II OF THE DRAFT REVISED LISBON AGREEMENT (ARTICLES 5 TO 7) TOGETHER WITH RULES 5 TO 8 OF THE DRAFT REGULATIONS

123. Referring to Article 6(1), the Delegation of Thailand suggested that the phrase “as specified in the Regulations” be inserted after “in due form” so that the text would read “Upon receipt of an application for the international registration of an appellation of origin or a geographical indication in due form as specified in the Regulations [...]”.

124. As regards Article 5(2)(ii), the Delegation of Mexico wondered whether a mere reference to “a federation or association representing the beneficiaries” was enough or whether examples of such beneficiaries or users should also be given.

125. Referring to Article 5(3), the Delegation of the Republic of Moldova sought clarification as to whether the Contracting Parties to the Revised Lisbon Agreement had to make a declaration regarding their position as regards the possibility of filing direct applications upon accession, or whether the International Bureau would have to check each and every time it would receive an application filed directly by the beneficiaries whether the legislation of the Contracting Party of Origin did offer or not such possibility to the beneficiaries. As regards Rule 5(2)(a)(v) of the draft Regulations, the Delegation pointed out that in the case of an appellation of origin “a geographical area of production of the good” would be the geographical area of origin. In consequence, the Delegation suggested keeping only the term “the geographical area of origin” in Rule 5(2)(a)(v). Lastly, the Delegation expressed its preference for Option B in Rule 5.

126. Referring to Rule 5(2)(a)(iii) which required to indicate “the appellation of origin or the geographical indication for which registration is sought, in the official language of the Contracting Party of Origin or, where the Contracting Party of Origin has more than one official language, in one or more of those official languages”, the Delegation of the European Union pointed out that the European Union would not be in a position to fulfill such requirement and therefore suggested to only require that the international application reflect the appellation of origin or geographical indication in the linguistic version or versions as contained in the registration, act or decision by virtue of which protection was granted in the Contracting Party of Origin. As regards Rule 5(2), the Delegation expressed a preference for Option A, as the Delegation was of the view that the information establishing the link between the product and its geographical origin was crucial and therefore had to be made mandatory in order to be able to verify that all the requirements of the definition of the geographical indication or appellation of origin were met. As regards Rule 5(3)(ii) which read “The application for the international registration [...] may indicate or contain: (ii) translations of the appellation of origin of geographical indication in such languages as the applicant may choose”, the Delegation sought clarification from the Secretariat as to what would be the legal effect of those additional translations of geographical indications or appellations of origin. In that regard, the Delegation pointed out that, in the case of the European Union, only the terms registered in the country of

origin could be registered for agricultural products and foodstuffs. The Delegation further indicated that the specifications had to incorporate such terms only in the language used to describe a specific product in the defined geographical area. In conclusion, the Delegation expressed the view that it would be important to uphold the same principles in the draft Regulations and to only accept the international registration of a term as registered in the Contracting Party of Origin.

127. As regards Rule 8, the Representative of CEIPI noted that the sub-titles were missing in paragraphs (1) and (2). Regarding Rule 8(2), he sought clarification as to whether that meant that the International Bureau would have to decide whether and up to which amount or percentage the applicable fee would be reduced.

128. Referring to Article 5(4)(a) and the issue of trans-border geographical areas, the Delegation of Romania was of the view that the application of items (i) and (ii) might lead to disputes, and therefore suggested to simplify the text by limiting the provision to Article 5(4)(a)(i).

129. The Delegation of Hungary, on the contrary, reiterated its strong view for deletion of the square brackets in Article 5(4).

130. As regards Rule 5, the Delegation of France expressed the view that Option A might lead to a lot of administrative work, because the data attesting to the existence of such link would then have to be translated by the International Bureau, and therefore preferred Option B.

131. The Delegation of Italy also expressed its preference for Option B in Rule 5

132. The Delegation of Thailand sought further clarification about Article 7 and Rule 8 concerning the registration fee, in particular as to what fees had to be paid to the other Contracting Parties and to the International Bureau.

133. Summarizing the discussions, the Chair confirmed that Article 5(3) contained an optional provision. The possibility for the beneficiaries to file applications directly with the International Bureau only existed if the legislation of a given Contracting Party allowed it. Hence, in the absence of an explicit provision providing for such possibility, only the provision of Article 5(2) would apply. Referring to the question raised by the Delegation of the Republic of Moldova as to whether Contracting Parties would be required to make a declaration or to send a notification to the International Bureau to indicate whether their legislation provided for the possibility for direct filing by the beneficiaries or not, the Chair invited the Secretariat to shed some light on the matter. He then referred to a question that was raised about the exact meaning of the non-exhaustive list contained in Article 5(2)(ii), and whether it was appropriate to single out federations and associations as examples of the legal entities that might be covered under that provision. The Chair noted that one delegation had reiterated its concern about the issue of trans-border geographical areas in Article 5(4), while another delegation had strongly recommended keeping and removing the square brackets from paragraph (4). It was the understanding of the Chair that the concerns that had been raised with respect to Article 5(4) were mainly related to the risk of litigation between private beneficiaries coming from Contracting Parties that shared a trans-border geographical area and acting in a somewhat unilateral manner. However, he pointed out that following internal discussions on the matter it appeared that the misunderstanding was largely due to a drafting issue which related to the French version of Article 5(4) and further indicated that the text would be amended so as to accommodate the concerns of that particular delegation. As regards Article 7, the Chair recalled the question that had been raised by the Delegation of Thailand as to whether specific designation fees per Contracting Party would have to be paid. Referring to the two Options proposed in Rule 5, the Chair indicated that the Delegation of the European Union had

expressed its preference for Option A, while all the other delegations that had expressed their preference in that regard had spoken in favor of Option B. He went on to say that one of the delegations that had expressed its preference for Option B had also enquired about the exact meaning and purpose of the text contained in Option A which referred to “the identifying details of the protection granted”. The Chair also recalled that a question was raised as to the legal effects of the translations referred to in Rule 5(3)(ii) in particular. In that regard he pointed out that the Delegation of the European Union had objected to the possibility to submit an application that would contain the appellation of origin or the geographical indication in more than one language. Finally, he referred to the question raised in respect of Rule 8(2).

134. As regards the relationship between paragraphs (2) and (3) of Article 5, while confirming the explanation given by the Chair, the Secretariat pointed out that the words at the beginning of Article 5(2) clarified that the provision in paragraph (2) was subject to paragraph (3). As regards the issue raised by the Delegation of the Republic of Moldova, and in the light of the experience of the International Bureau under the Madrid and Hague systems, the Secretariat indicated that a Contracting Party could make a declaration either at the time of its accession to the revised treaty or later on in time. Referring to the question raised by the Delegation of Mexico concerning the listing of certain legal entities in Article 5(2)(ii), the Secretariat recalled that in previous meetings a mere reference to “legal entities” had been considered as being insufficiently clear by certain delegations, which had suggested to explicitly clarify that a “federation or association representing the beneficiaries” would also be in a position to file applications. Moreover, the terms “or other rights in the appellation of origin or the geographical indication” had been added in order to clarify that owners of certification marks, in those countries which protected geographical indications through certification marks, would also be in a position to file applications. The Secretariat went on to say that the last part of the sentence which referred to a group of producers representing the beneficiaries “whatever their composition and regardless of the legal form in which they present themselves” had been added to address a concern raised by the Delegation of the European Union, namely that there might also be groups or legal entities which did not qualify as a federation or as an association.

135. As regards the issue raised by the Delegation of Romania concerning Article 5(4), the Secretariat was under the impression that a misunderstanding had appeared because of a drafting issue in the French version of Article 5(4)(b) which had been drafted in a slightly different manner than the English text. In any event, the intention of that provision was such that if, for example, there were two Contracting Parties sharing a trans-border area and one of the two did not allow its nationals to file applications directly, then the beneficiaries that were from the other Contracting Party which did allow direct applications would not be entitled to file an application for the trans-border area as a whole, but only for that part of the area situated in the territory of their own Contracting Party.

136. As regards the question put forward by the Delegation of Thailand concerning the registration fees, namely whether additional fees, such as designation fees, would have to be paid to the Contracting Parties themselves in addition to those mentioned in Rule 8, the Secretariat indicated that that was not the case under the current Lisbon system, which required the payment of only one single fee of CHF500, to be paid to the International Bureau. Regarding the question concerning the last part of Rule 8(2), namely whether it would be up to the International Bureau to determine whether a fee would be reduced up to 50 per cent or less, the Secretariat indicated that if the Working Group preferred to leave that competence to the Assembly of the Lisbon Union the text could be amended accordingly.

137. As regards Options A and B in Rule 5, the Secretariat agreed with the point made by the Delegation of France that if the transmission of the “identifying details of the protection granted” were made mandatory that would definitely put an extra burden on the International

Bureau, in particular as far as the translation of the registrations was concerned. Referring to the issue raised by the Delegation of the European Union concerning translations in Rule 5(2)(a)(iii) and Rule 5(3)(ii), the Secretariat pointed out that both provisions were similar to those which currently applied under the Lisbon system. More specifically, the Lisbon system allowed countries which had more than one official language to register an appellation of origin in both official languages, if they wished to do so. The Secretariat further pointed out that under Rule 5(3)(ii) any country would be allowed to add to its application additional translations into any other language of its choice. In that regard, the Secretariat indicated that the purpose of those translations into other languages was to facilitate enforcement actions in the countries in which such languages applied. The Secretariat went on to say that the issue raised by the Delegation of the European Union in that regard was not entirely clear and therefore sought an additional explanation from the Delegation of the European Union to better understand their objection to the possibility to register an appellation of origin or a geographical indication in more than one official language, or to the possibility of adding several translations of the appellation of origin or geographical indication in an application.

138. The Delegation of France was of the view that the question raised by Option A really concerned the scope of that obligation. If adopted, Option A would make it mandatory for the International Bureau to examine the “identifying details of the protection granted” to make sure that the application was complete. Moreover, the Delegation wondered on which basis the International Bureau would consider the data, or the identifying details, as being complete or not.

139. The Delegation of the European Union indicated that it was mainly concerned about the legal effect of the additional translations of the appellation of origin or geographical indication that would be submitted in the application. In that regard, the Delegation further recalled that under European Union legislation protection was given to the appellation of origin or geographical indication as registered in the country of origin.

140. As regards the legal effect of the translations that would be submitted, the Secretariat pointed out that the scope of protection specified in Article 10 extended the protection to the appellation of origin or the geographical indication in its translated form.

141. Referring to Rule 8(2), the Representative of CEIPI was of the view that the possibility to decide on the waiver of 50 per cent of the fee should be left to the Lisbon Union Assembly, as suggested by the Secretariat.

142. Concluding the discussions, the Chair said that it would be preferable to leave the possibility to decide either on the waiver of the fee or on a fee reduction to the Assembly of the Lisbon Union, particularly in light of the fact that the Assembly had the competence to amend the Regulations and the fees as per Article 22 of the draft Revised Lisbon Agreement. Further, Article 5(3) would be amended, so as to require a Contracting Party wishing to avail itself of this Option to submit a declaration. The question of Article 5(4)(b) remained unresolved, for the time being, so that the square brackets would be retained. Options A and B in Rule 5 would also be retained.

#### DISCUSSION OF ARTICLES 8, 9, 12 AND 14 OF THE DRAFT REVISED LISBON AGREEMENT

143. Referring to Article 8 of the draft Revised Lisbon Agreement, the Delegation of the Republic of Moldova requested the insertion of a specification clarifying that a Contracting Party would be obliged to protect an appellation of origin or a geographical indication if it had not refused the international registration or invalidated its effects, and, of course, only in the absence of a declaration that protection was renounced in respect of its territory.

144. Referring to Article 12, the Delegation of Hungary was of the view that it would be preferable to separate the duration of the international registration and the cancellation in the first part of the sentence which stated that “the protection of an appellation of origin or a geographical indication shall not be limited in time unless cancelled”. In other words, the separation of those two elements would help clarify that it was not the lack of cancellation in itself that made the protection unlimited in time. As regards the introduction of the notion of acquiescence in the last part of Article 12, the Delegation pointed out that the corresponding rule in the TRIPS Agreement, namely Article 24.7, appeared in the “exceptions” section of the Agreement. In that regard, he was of the view that the drafting of Article 12 seemed to turn the exception into a mandatory rule. Furthermore, the scope of Article 24.7 of the TRIPS Agreement was limited to trademarks while Article 12 was broader and consequently went beyond Article 24.7 of the TRIPS Agreement.

145. The Delegation of the European Union sought clarification on the impact of Article 12 as the provision did not provide any criteria or period of time needed to allow acquiescence to occur. Furthermore, the Delegation was of the view that ‘acquiescence’ was a trademark notion which had no place in an instrument dealing with appellations of origin and geographical indications.

146. The Delegations of France and Italy shared the views expressed by the Delegation of Hungary and suggested to simply provide that protection would be unlimited in time. The Delegations also expressed concern with respect to the introduction of the notion of acquiescence in Article 12.

147. The Representative of CEIPI suggested that the word “national” be deleted in the last line of Article 14, as the Revised Lisbon Agreement would allow for the possible accession by intergovernmental organizations.

148. The Representative of ABPI expressed support for Article 12 and indicated that the fact that the notion of acquiescence was more often used in relation to trademarks did not mean that it could not be used in respect of geographical indications and appellations of origin. However, the required time limit for acquiescence was currently missing from the text.

149. The Representative of INTA shared the views expressed by the Representative of ABPI [in respect of the applicability of acquiescence in the context of relation to](#) Article 12.

150. Referring to Article 14, the Delegation of Italy was of the view that the term “*ex officio*” was missing after “public authority” in the sentence “the protection of such registered appellations of origins and geographical indications may be brought by a public authority”. The Delegation then sought clarification as to whether the reference to “legal system” was broad enough to cover both legislative and administrative measures.

151. The Chair noted that Article 12 had not found sufficient support in its current form within the Working Group for different reasons. One of the reasons was that certain delegations were of the view that the provision should simply state that the protection was unlimited in time and not subject to renewal, as in the case of the Lisbon Agreement. Another reason was that some delegations were opposed to the idea of combining the duration of protection with issues that were perhaps not directly related to the duration of the protection, such as cancellation, renunciation or acquiescence. The Chair wondered whether a reference to acquiescence in the draft Revised Lisbon Agreement was really called for by Article 24.7 of the TRIPS Agreement.

152. The Secretariat said that the idea behind the reference to acquiescence in Article 12 was not that all the Contracting Parties would be required to provide for acquiescence. Like Article 24.7 of the TRIPS Agreement, Article 12 would only mean to say that, if a geographical indication or an appellation of origin could no longer be invoked due to acquiescence in a particular Contracting Party, then obviously the protection would no longer exist in that particular country with respect to whatever had been acquiesced. Equally, the reference to invalidation or renunciation did not mean that all Contracting Parties had to invalidate or renounce. The Secretariat agreed that the provision could certainly be split into two paragraphs, namely one dealing with the duration of protection as such and the other dealing with the possible limitation in time of the protection following renunciation, invalidation, or acquiescence. The Secretariat clarified that the issue of renewal had not been taken up in the provision deliberately as there were some countries which required renewal fees for appellations of origin or geographical indications, under their national law and which could perhaps be refrained from acceding to the treaty because they would no longer be able to collect renewal fees and thereby would lack the necessary funds for maintaining their national system of appellations of origin or geographical indications. In that regard, the Assembly of the Lisbon Union should have the possibility of establishing renewal fees in the future, if necessary.

153. The Chair indicated that acquiescence did not lead to loss of protection, at least under European Union and Hungarian trademark law. In other words, the protection was there but the trademark owner could no longer enforce his rights against the third party that had been using his trademark in the Contracting Party in which acquiescence had occurred. As regards the issue of renewal, the Chair was of the view that if the text contained a provision dealing with "Duration of Protection", the issue of renewal also had to be addressed in it. The Chair did not see the need to refer to cancellation, renunciation or invalidation in Article 12.

154. The Delegation of Italy sought further clarification as to what acquiescence actually meant: would the holder of an appellation of origin or a geographical indication registered under the Lisbon system, who did not enforce his rights in the appellation of origin or geographical indication in all the Contracting Parties, lose protection in all those Contracting Parties?

155. The Chair said that, under the principle of acquiescence, if the holder of a geographical indication or an appellation of origin had tolerated the unauthorized use of his geographical indication or appellation of origin for a certain period of time by a third party, then such holder would not be in a position to enforce his rights after the expiration of a specific period of time with regard to that third party. In that regard, he pointed out that in the case of trademarks, the period of time usually was five years.

156. The Representative of AIPPI expressed the view that the use of the concept of acquiescence in the context of appellations of origin and geographical indications would be rather complicated, as, unlike in the case of trademarks, there were multiple beneficiaries. Would all the beneficiaries have to know that their denomination was being misused and would they have to act upon it collectively? Or would it be sufficient for one of them to take action to avoid losing the right over an appellation of origin or a geographical indication in the Contracting Party in which the infringement took place? The Representative of AIPPI further pointed out that, even if the rights to enforce the protected denomination were lost as per the concept of acquiescence, under unfair competition law, the use of the appellation or indication by third parties might still be regarded as misleading. In that sense, the introduction of the concept of acquiescence in the Revised Lisbon Agreement would not really solve the problem. In any event, if the Working Group ultimately decided to allow for acquiescence, that possibility should be clearly stated in the Agreement, as was the case in the TRIPS Agreement.

157. The Representative of MARQUES agreed with the Representative of AIPPI regarding the nature of the concept of acquiescence, and also shared the view expressed by the Secretariat that a provision regarding acquiescence had to be included in the draft Revised Lisbon Agreement. In that regard, she inquired as to whether a possible solution would be to include a provision after Article 13 that would give Contracting Parties the option to recognize a limitation of rights on the basis of acquiescence.

158. The Delegation of Iran (Islamic Republic of) indicated that the notion of acquiescence did not exist under the Iranian law on geographical indications and appellations of origin and therefore expressed a preference for deleting that notion from the draft Revised Lisbon Agreement.

159. Upon recalling that Article 7(1) of the current Lisbon Agreement stated that the registration effected with the International Bureau ensured protection without renewal, the Delegation of Peru suggested reproducing that sentence in Article 12. The Delegation then sought clarification as to whether, besides dealing with a possible termination of the protection in another Contracting Party, the text of Article 12 was also referring to a possible cancellation of the international registration if the right would not be renewed in the Contracting Party of Origin. In that regard, the Delegation pointed out that the legislation of some countries stated that the duration of the registration of an appellation of origin or geographical indication could last 10 years. Consequently, the fact that a registration could lapse after a certain period of time in some legislations also had to be reflected in Article 12. Lastly, the Delegation pointed out that neither the Peruvian nor the Andean Community legislation on geographical indications incorporated the concept of acquiescence.

160. The Representative of oriGIn said that, in view of the risks for the beneficiaries of geographical indications and appellations of origin, who were often small producers with limited financial resources, the introduction of the concept of acquiescence should be carefully examined.

161. The Delegation of Hungary supported the suggestion made by the Delegation of Iran (Islamic Republic of) to delete the concept of acquiescence from the draft Revised Lisbon Agreement, in particular as it would simply not be applicable in most cases. As far as the issue of renewal was concerned, the Delegation was of the view that the input of non-member States that had shown some interest in joining the Revised Lisbon Agreement would be very important in that regard.

162. The Delegation of Australia indicated that Article 12 was a provision that could potentially exclude members who might be interested in joining the system because there were quite a few countries which protected geographical indications through systems which provided for renewal. In other words, if the provision would prevent a Contracting Party from protecting geographical indications through a system which provided for renewal, that could be a potential problem for obtaining a broader membership of the Lisbon system.

163. The Chair indicated that a consensus seemed to be emerging for dealing with the issue of the duration and renewal of protection separately from the issue of the legal effects of cancellation, renunciation and invalidation. As regards acquiescence, the majority view seemed to be that, if the issue were to be dealt with in the Revised Lisbon Agreement, this should be done through a provision that would refer to acquiescence as a possible limitation to enforcing the rights in a geographical indication or an appellation of origin, while leaving the issue further to national legislations.

164. The Representative of CEIPI was not at all sure that the mere fact of not referring to acquiescence would necessarily mean that it could not be applied in a Contracting Party.

165. The Chair confirmed that if the issue of acquiescence was not addressed in the Agreement, that would simply mean that, subject to compliance with other provisions of the Agreement, the issue of whether or not to provide for acquiescence would be left to the national legislation of the Contracting Parties.

166. Referring to the question as to whether or not the possibility of renewal had to be mentioned in Article 12, the Delegation of France recalled that the aim of the Working Group was to open up the system to all kinds of national legal systems for the protection of geographical indications and appellations of origin. The Delegation was of the view that the insertion of a provision that would specify that in some Contracting Parties geographical indications or appellations of origin could be subject to renewal would once again raise the question of the applicable national legislation. In that regard, the Delegation recalled that a State which used the trademark system to protect its geographical indications could decide whether or not to maintain such certification or collective trademarks under a renewal system. The Delegation further pointed out that, if a geographical indication protected as a trademark was not renewed in the Contracting Party of Origin, the national competent authority would simply have to notify the International Bureau and send a request for cancellation of the international registration of the geographical indication or appellation of origin in question. Hence, the Delegation of France was of the view that the text of the Revised Lisbon Agreement should not be rendered unnecessarily complex by introducing specific aspects of national protection systems, such as those concerning renewal.

167. As regards the legal effects of a cancellation or renunciation, the Delegation of France was also of the view that it could complicate things to address those issues in Article 12, all the more since they were already covered in the Regulations. With respect to the notion of acquiescence, the Delegation noted that most delegations seemed to be opposed to the introduction of that principle in the Revised Lisbon Agreement. As regards Article 14, the Delegation was of the view that the question raised by the Delegation of Italy regarding a specific mention of the available remedies had to be addressed because the protection of appellations of origin as well as the protection of other intellectual property rights did not only involve judicial authorities, but also administrative authorities, such as, for example, customs authorities.

168. The Chair pointed out that, in respect of renewal, another issue was whether a Contracting Party other than the Contracting Party of Origin could make the protection of an international registration subject to renewal in their territory. The current Lisbon Agreement would not appear to provide for such a possibility, as protection had to be provided for as long as the appellation of origin was protected in the Contracting Party of Origin.

169. The Delegation of France agreed that the Contracting Parties had an obligation to protect the appellation of origin or a geographical indication registered under Lisbon for as long as it was protected in the Contracting Party of Origin, irrespective of whether or not a renewal system existed under the national legislation of a Contracting Party.

170. Referring to the case of a geographical indication registered as a certification trademark in a given Contracting Party that would not be renewed at the national level, and in respect of which a request for cancellation of the international registration under the Lisbon system would be subsequently issued by the national competent authority, the Representative of CEIPI asked whether in practice that would amount to establishing a system of dependency. In that case, he wondered whether, as under the Madrid system for the international registration of marks, the Contracting Party of Origin should be obliged to request the cancellation of such international registration under the Revised Lisbon Agreement. Was it the intention of the Working Group to create a fully fledged dependency system between the international registration and the protection in the Contracting Party of Origin?

171. The Secretariat said that, to date, there had been 105 cancellations in the Lisbon system. In that regard, Rule 15 of the current Lisbon Regulations required the Contracting Party requesting the cancellation to specify the particulars that had led to the cancellation. Unlike the Madrid system, there was no requirement under the current Lisbon system for a Contracting Party in which the protection had lapsed to submit a request for cancellation. The Secretariat also stressed the fact that the Lisbon Agreement only referred to the case where the protection had lapsed because the appellation of origin had become generic in the Contracting Party of Origin without mentioning any other situation. For the sake of transparency, as regards the legal situation in the Contracting Party of Origin, the Secretariat was of the view that it might be appropriate to introduce a requirement whereby a Contracting Party of Origin would have an obligation to submit a request for cancellation of the international registration should the protection in that Contracting Party of Origin lapse.

172. The Chair recalled that Article 6 of the Lisbon Agreement stated that, if an appellation of origin had been granted protection in one of the Contracting Parties of the Lisbon Agreement, then, such appellation of origin could not be deemed to have become generic in the other Contracting Parties, as long as it was still protected in the Contracting Party of Origin. Article 6 did not state that the protection could only cease in the Contracting Party of Origin because the term had become generic. As regards Article 14, the Chair said that the current text of the Lisbon Agreement referred to “legal action” and expressed the view that the word “legal” was not to be construed in a restrictive manner so as to exclude administrative measures. Referring to a comment made by the Delegation of the Republic of Moldova on Article 8, the Chair indicated that the meaning of the term “in accordance with the terms of this Act” was that, in the absence of a renunciation, cancellation or invalidation, there would be an obligation to protect the international registration.

#### DISCUSSION OF ARTICLES 10 AND 11 OF THE DRAFT REVISED LISBON AGREEMENT

173. The Chair informed the Working Group that the Secretariat had made available the requested non-paper on Article 13 while indicating that he would open the discussion on it following the discussion of Articles 10 and 11.

174. As regards Article 10, the Representative of CEIPI first noticed that, in the two indents under Article 10(1)(a)(i), the French version used the present tense, as was for example the case in the expressions “*qui constitue une usurpation*” and “*qui porte prejudice...ou tire indument avantage*”, whereas the English used the conditional “which would amount to its usurpation” and “which would be detrimental to, or exploit unduly, its reputation”, and expressed the view that both linguistic versions had to be aligned. He then asked whether the provisions in the two indents under Article 10(1)(a)(i) were cumulative or alternative, expressed the view that they were probably alternative and suggested that the text be clarified in that respect. He by adding the terms “either”, “or”, or “and” at the end of the first indent. He then noted that Article 10(1)(a)(ii) incorporated a slightly different listing of terms in French and in English and also wondered what the difference was between “*origine*” and “*provenance*”. He pointed out that, in the French version, the term “*origine*” was used twice in the same sentence and therefore suggested deleting the one which appeared between “*provenance*” and “*nature*”. He also noted that the term “characteristics” had been translated in French by “*caractéristiques essentielles*” and suggested aligning the French and English texts with the definitions of Article 2(1) so as to simply say “quality or characteristics of the goods”. Then, as regards Option B in Article 10(1)(b) of the English text, he wondered what the word “it” in the third line referred to, while also pointing out that in the French text the

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term “it” had been translated by “*la situation*”. As regards Article 11 in the French text, he was of the view that it would be wise to stick as much as possible to the wording used in the current Lisbon Agreement, and to say “[...] *ne peut pas pourra être considérée comme devenu générique* [...]”.

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175. The Delegation of France suggested to clearly state in Article 10(1)(a)(i) that appellations of origin and geographical indications would not only be protected against their use in exactly the same wording, but also against use of wording that was not identical, but nevertheless evoked the appellation of origin. Referring to the comment made by the Representative of CEIPI concerning the link between the first and the second indents, the Delegation expressed the view that it would be important for the two indents to be linked by the term “or” as those were not cumulative provisions but rather two different independent options. As regards Article 10(1)(b)(ii), the Delegation said that the differences between the French and the English version should first be clarified. The Delegation further expressed a preference for Option B, as it not only dealt with cases where trademarks would cover products not originating from the region but also with products which would not fulfill the required conditions to use a particular appellation or indication. As regards Article 10(2) entitled “Presumption in Case of Use by Third Parties”, the Delegation indicated that such a title continued to raise questions. First, it was difficult to understand the “third parties” concept used and, second, usually when someone filed a complaint because of a third-party infringement of his rights on a geographical indication or appellation of origin, he had to prove that there had been an actual infringement of his rights. Reversing this burden of proof would require an amendment of national legislation. As regards Article 10(3), the Delegation noted that the provision seemed to convey the idea that the Revised Lisbon Agreement could prevent international registration, while international registration of an appellation of origin could in fact only be prevented because of non compliance with a formal requirement. Finally, concerning Article 11, the Delegation pointed out that the French version contained two options “ne peut pas [être considérée comme ayant] [avoir] acquis”, whereas the English version contained just one option, namely “be considered to have”. The Delegation therefore suggested reproducing as much as possible the text as it currently stood in the Lisbon Agreement, namely “cannot be considered to have become generic”.

176. The Delegation of the European Union was of the view that the first indent of Article 10(1)(a)(i) had to be divided into two separate indents, so as to clarify that the provision referred to three alternative situations. In that regard, the Delegation specified that the first indent would begin with “in respect of goods of the same kind”, whereas the second indent would begin with the sentence between square brackets which read “[which would amount to its usurpation or imitation [or evocation]]” and finally the third indent would begin with “which would be detrimental to, or exploit unduly, its reputation”. The Delegation noted that Options A and B for Article 10(1)(b) were probably inspired by the relevant provisions of the TRIPS Agreement regarding prohibition of the registration by third parties of trademarks consisting of or containing an appellation of origin or a geographical indication. However, in the Delegation’s view, they did not faithfully reproduce the corresponding TRIPS provisions. The Delegation expressed its preference for Option B, because it covered all the cases corresponding to the level of protection foreseen in subparagraph (a). As regards Article 11, the Delegation was still of the view that it would be more appropriate to simply state that a registered appellation of origin or geographical indication could not become generic.

177. The Delegation of Switzerland was of the view that the wording put forward by the Delegation of France would be very useful for Article 10(1)(a)(i), as it would be a good way to extend the protection to those cases where a geographical indication or an appellation of origin was not reproduced identically.

178. The Delegation of Italy also agreed with the wording proposed by the Delegation of France in respect of Article 10(1)(a)(i). Further, the Delegation expressed a preference for Option B in Article 10(1)(b). The Delegation had some doubts concerning Article 10(2) and indicated in particular that the sentence “is used in respect of goods of the same kind as those to which the appellation of origin, or the geographical indication, applies” seemed problematic and therefore proposed to use the previous language which read “is used by a person who is not authorized to do so in the international registration”. As regards Article 10(3) on homonymy, the Delegation expressed doubts as to whether a provision of that kind should appear in the agreement at all and also shared the concerns raised by the Delegation of France in that regard. Concerning Article 11, the Delegation suggested removing the current *mutatis mutandis* expression and adding a full reference to both appellations of origin and geographical indications. As regards the terms between brackets “[be considered to have]”, the Delegation agreed with the suggestion made by the Delegation of France to go back to the current text of the Lisbon Agreement.

179. The Delegation of Peru expressed a preference for Option B Article 10(1)(b). Concerning Article 10(3), the Delegation recalled that it had expressed its position on that matter at a very early stage and renewed its request for removing the provision from the text, all the more since the current Lisbon Agreement had no a provision of that kind either.

180. The Delegation of Serbia was of the view that Article 10(1)(a)(i) would be easier to understand if it would explicitly stipulate that the two indents presented alternative situations. The Delegation further indicated that it agreed with the proposal made by the Delegation of the European Union to have three alternatives instead of two, while also expressing a preference for Option B in Article 10(1)(b).

181. As regards Article 10(1)(a)(i), the Representative of INTA reiterated INTA’s concern voiced at previous meetings about the use of the term “evocation”, which was not sufficiently clear and predictable. She also deplored the fact that the priority principle was only indirectly incorporated in Article 10(1)(b), through a reference to Article 13(1). For greater clarity, she suggested that a reference to the priority principle be expressly inserted in Article 10(1)(b). She then suggested combining the issues covered by Article 10(1)(b) and Article 13 in a single article that would comprehensively deal with the relationship between appellations of origin, geographical indications and trademarks. She noted that Option A had not met much support from Delegations, but nonetheless reiterated, as regards item (ii) of Option A, INTA’s concerns about the practicability of incorporating a reference to the “requirements for using the appellation of origin or geographical indication”, as it would be difficult for Trademark Offices to check the compliance with such requirements in the context of trademark application proceedings.

182. The Representative of oriGIn sought clarification about the expression “in respect of goods of the same kind” in Article 10(1)(a)(i), and more particularly wished to know if the term “same kind” referred to identical or comparable goods. With respect to the second indent which read “which would be detrimental to, or exploit unduly, its reputation”, he wondered whether that formulation also included cases in which the name was used with respect to different kinds of goods. As an illustration, he indicated that on the basis of the experience of geographical indications producers, more and more cases of imitation or undue use of the geographical indication concerned different kinds of goods or even services. As regards Article 10(1)(b), he expressed a preference for Option B, while suggesting the addition of a sentence that would read “Trademarks registered in breach of this paragraph shall be invalidated” at the end of the paragraph. Finally, he expressed a preference for deleting Article 10(3).

183. Referring to the sentence reading “Contracting Parties shall refuse or invalidate the registration of a trademark” in Article 10(1)(b), the Delegation of Switzerland pointed out that not all countries had provided for invalidation procedures before their Trademark Office and suggested identifying first the different cases which existed before proposing a common mechanism for invalidation.

184. Referring to Article 10(3), the Delegation of Chile said that its understanding was that, although the present Lisbon Agreement did not have an express provision on homonymy, the existence of homonymous appellations of origin or geographical indications had been recognized in practice under the Lisbon Agreement. Therefore, the proposed Article 10(3) simply intended to codify a norm that already applied under the current Lisbon Agreement. Moreover, Article 23.3 of the TRIPS Agreement had to be respected anyway.

185. As a preliminary summary of the discussions, the Chair said that, as regards both Article 10(1)(a)(i) and Article 10(1)(a)(ii), one could take on board the suggestions from the Representative of CEIPI to align the French and English versions. The alternative nature of the two indents in Article 10(1)(a)(i) could be clarified by using the word “or” at the end of the first indent. If it were ultimately decided to have three indents instead of two, as suggested by the Delegation of the European Union, the same word “or” would also have to be included at the end of the second indent. The Chair considered it obvious that the second indent applied to different kinds of goods. The Chair recalled the suggestion made by the Delegation of France to add the words “or evocation” after “any use” in the chapeau of Article 10(1)(a)(i) and to delete the text between square brackets at the end of the first indent.

186. The Chair then concluded that there was an emerging consensus for Option B Article 10(1)(b), even though it might be clarified that the provision would only apply with regard to trademarks with a priority date that was later than the date on which the appellation of origin or the geographical indication had obtained protection in the Contracting Party concerned. Referring to the suggestion made by the Representative of oriGIn to add the sentence “Trademarks registered in breach of this paragraph shall be invalidated” at the end of Article 10(1)(b), the Chair expressed the view that oriGIn’s concern was already covered because the text already indicated that “Contracting Parties shall refuse or invalidate the registration of a trademark”. As regards the comment made by the Delegation of Switzerland that in certain countries invalidation might not occur *ex officio*, the Chair eluded to the possibility of borrowing the formulation of the TRIPS Agreement, which stated that there was an obligation to refuse or invalidate the registration of a trademark *ex officio*, if the legislation of the Contracting Party so permitted, or at the request of an interested party. Since no one had expressed support for Option A, the Chair said that the Working Group would continue to work on the basis of Option B only.

187. The Chair noted that some delegations had expressed a preference for deleting Article 10(2), while others had suggested deleting the reference to third party in the subtitle of the paragraph. In that regard, the Chair was of the view that the subtitle could simply read “[*Presumptions of Unlawful Use*]”. As regards Article 10(3), the Chair suggested keeping the provision between square brackets for the time being, since one of the delegations was clearly opposed to a provision on homonymy, whereas another delegation had strongly spoken in favor of keeping such a provision in the draft Revised Lisbon Agreement, and as there were some other delegations that were still hesitating. As regards Article 11, the first sentence could be modified so as to start off with the phrase “A denomination protected as a registered appellation of origin or an indication protected as a registered geographical indication”, while noting the view expressed for keeping the current text of the Lisbon Agreement, namely “cannot be deemed to have become generic”.

188. The Delegation of Peru indicated that the Lisbon system was structured in such a way that it ultimately was for each Contracting Party to decide on the protection in its territory, upon receiving the notification of a new registration effected with the International Bureau. In other words, it was for each Contracting Party to decide, on the basis of its national legislation, whether or not to provide protection to a particular appellation of origin or geographical indication. That being so, the Delegation was of the view that it would not be necessary to have a provision on homonymy in the Agreement, all the more since it might be contrary to the legislation of some Contracting Parties. Furthermore, homonymy was only regulated in the TRIPS Agreement in the case of wines.

189. The Chair reiterated that in view of the different views expressed on Article 10(3), the provision would remain between square brackets for the time being. He further expressed the view that nothing prevented the international registration of an appellation of origin or geographical indication with the International Bureau and that, instead, the issue concerned the protection that would be ultimately granted in the Contracting Parties. In that regard, the Chair was of the view that the text between brackets could be slightly amended by the introduction of a sentence that would read “in the case of an international registration of homonymous appellations of origin or geographical indications each Contracting Party shall determine what protection it shall provide”, as that would make it clear that it would be up to each Contracting Party to decide what protection it would provide in respect of such appellations of origin or geographical indications.

190. The Delegation of Italy reiterated its reservation regarding Article 10(3) and sought further clarification as regards the proposal made by the Delegation of the European Union in the case of Article 10(1)(a)(i).

191. The Chair recalled that the Delegation of the European Union had proposed to have three indents instead of two in Article 10(1)(a)(i). The first indent would be the current one without the text in square brackets which would then be moved to a second indent, while the current second indent would thus become the third indent of the subparagraph under consideration. It was the understanding of the Chair that the proposed new structure would mean that if a given use amounted to usurpation, or imitation, or evocation, there would be protection against those infringing uses both with respect to goods of the same kind and with respect to goods of a different kind.

192. The Delegation of France supported the proposal made by the Delegation of the European Union to have three indents in Article 10(1)(a)(i).

193. Commenting on a query from the Delegation of France, the Representative of CEIPI pointed out that in Article 10(3) the English phrase “~~shall~~ determine what protection” had been translated into French by “*determine le type de protection*”. In that regard, he suggested a slight amendment to the French version, as the word “*type*” was rather vague in French, to say “*determine quelle protection*”.

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194. Referring to the request for clarification from the Representative of CEIPI, the Secretariat indicated that the difference between “*origine*” and “*provenance*” could be explained in the sense that, if goods came from a certain source or had a certain provenance, they could still have their origin in another place. As an illustration, the Secretariat referred to the case of a product assembled in one country, while its components partly or entirely originated in another country. As regards the question raised by the Representative of CEIPI concerning the meaning of the word “it” in Option B of Article 10(1)(b), and in particular whether that word referred back to the registration of the trademark or whether it referred back to a situation which existed under Article 10(1)(a), the Secretariat indicated that the provision simply reproduced the text agreed at the previous session of the Working Group, but agreed that

more precise language would have to be found. Referring to the question raised by some delegations concerning the meaning of “goods of the same kind” in the first indent in Article 10(1)(a)(i), and whether this term was strictly related to exactly the same kind of goods or whether it could also refer to goods which were not exactly the same, the Secretariat recalled the explanation given at the previous session of the Working Group, that goods could not be identical if someone used the appellation of origin or the geographical indication in relation to a good which did not come from the geographical area of origin of the appellation of origin or the geographical indication. As to whether the text referred to “kind of goods” as a category, the Secretariat recalled that no classification system existed in this area of intellectual property, while suggesting that there was perhaps reason to develop one. As regards the proposal to introduce the notion of “evocation” in the chapeau of Article 10(1)(a)(i), the Secretariat pointed out that the notion of “evocation” was very close to what was now addressed in the second indent of Article 10(1)(a)(i), namely “which would be detrimental to, or exploit unduly, its reputation”. In that regard, the Secretariat further pointed out that Article 22.2(a) of the TRIPS Agreement used the word “designate” or “suggest” in the sentence “the use of any means in the designation or presentation of a good that indicates or suggests”, which might also reflect a form of evocation. The Secretariat further recalled that Article 22.2(b) of the TRIPS Agreement provided protection against acts of unfair competition in addition to those dealt with in Article 22.2(a).

195. Referring to the question raised by the Delegation of France about the notion of “third parties” in the subtitle of Article 10(2), the Secretariat clarified that “third parties” referred to those parties which did not have the right to use the geographical indication or the appellation of origin. The Secretariat further observed that the paragraph as such did not refer to third parties but to the use “in respect of goods of the same kind”, which would be presumed to be unlawful. In that regard, the Secretariat referred to an explanation contained in the Notes in document LI/WG/DEV/7/4, which clarified that the use of trademarks containing the geographical indication or the appellation of origin would not be presumed to be unlawful if those trademarks were owned by persons entitled to use the geographical indication or the appellation of origin in question. Referring to Article 10(3), the Secretariat indicated that the first sentence simply confirmed the current practice under the Lisbon Agreement that whenever an application was filed, the International Bureau would only conduct a formal examination of such application and would not examine whether or not the application concerned an appellation of origin or geographical indication that would be homonymous with another one. He added that the issue of homonymy would only come up if the International Bureau were to receive a declaration of refusal from a Contracting Party in respect of a registered appellation of origin or geographical indication on the basis of homonymy or, on the contrary, whenever a Contracting Party would decide to grant protection to the appellation of origin in spite of the existence of a homonymous appellation of origin or geographical indication. The Secretariat pointed out that the second and third sentences of Article 10(3) as well as the footnote reflected the provisions of the TRIPS Agreement addressing issues related to homonymy.

196. As regards Article 11, the Secretariat confirmed that the difference between the English and the French versions would be corrected. As regards the square brackets containing the words “be considered to have” in the English text, the Secretariat clarified that the sentence had been drafted that way because at the previous meeting the point had been made that the words contained in the current Lisbon Agreement, namely “cannot be deemed to have become generic” were not a faithful reflection of the original French text of the Lisbon Agreement. Referring to the question that had been raised about the way in which the second sentence of Article 11 had been drafted, the Secretariat indicated that the TRIPS Agreement and the Lisbon Agreement dealt with generics in a different way. Consequently, the Secretariat believed that it was more appropriate to somehow reflect the wording of Article 24.6 of the

TRIPS Agreement in Article 11 instead of inserting the words “or geographical indication” in its first sentence, as that gave the wrong impression that the issue of generics was dealt with in the same manner in both Agreements.

197. The Delegation of Australia expressed great concern about Article 10 which, to a large degree, dictated the level of protection in Contracting Parties, which represented a significant departure from treaties such as the Madrid Protocol, the Hague Agreement or the PCT, which appeared to be more focused on granting procedures rather than on imposing national standards of protection. As regards Article 10(2), the Delegation pointed out that under the Australian legal system innocence was presumed and that it was quite far reaching to reverse the burden of proof so as to have a presumption of unlawful use. The Delegation further indicated that it was fully aware of some precedents where the burden of proof had been reversed under certain circumstances, as in the case of Article 16 of the TRIPS Agreement, which provided that “a likelihood of confusion shall be presumed”. However, in the view of the Delegation, such presumption did not go as far as the proposed presumption of unlawfulness. Noting that concerns had already been expressed by some delegations about the extraterritorial effects of certain provisions, the Delegation was of the view that Article 11 did have an extraterritorial effect as it overrode national sovereignty in Contracting Parties in relation to generics. In that regard, the Delegation referred to previous discussions that had taken place in other contexts in WIPO about the importance of the need to protect the public domain and urged the members of the Working Group to give some thought to the practical impact that such a provision might have.

198. As a general comment, the Chair pointed out that the draft Revised Lisbon Agreement reflected the shared view expressed by the Working Group at previous meetings to work towards an instrument that would incorporate substantive requirements with respect to the protection provided not only to appellations of origin but also to geographical indications. As regards Article 11, the Chair pointed out that, as far as the interference with national sovereignty was concerned, that accession to an international treaty ultimately was subject to the decision of a sovereign nation. In view of the support expressed by several delegations to the suggestion made by the Delegation of the European Union, the Chair said that three indents would be included in Article 10(1)(a)(i). The Chair further noted that, in spite of the explanations provided by the Secretariat, most Delegations would prefer to delete Article 10(2). There also seemed to be agreement to take on board the suggestion from the Delegation of Switzerland to make it clear that refusal or invalidation could take place either at the request of an interested party or *ex officio*. Concerning Article 11, the Chair recalled that the Secretariat had clarified that the terms “deemed to have” had been replaced by “considered to have” in the revised version to take on board comments made at previous sessions.

199. In spite of the alternative wording suggested by the Chair for Article 10(3) on homonymy, the Delegation of Peru reiterated its request to remove Article 10(3) from the draft Revised Lisbon Agreement.

200. The Delegation of Italy also reiterated its preference for removing Article 10(3) from the text, on the understanding, however, that the current practice under the Lisbon system with regard to homonymy would be continued.

201. In light of the fact that two delegations had requested the deletion of Article 10(3), the Chair asked the other delegations whether it would be acceptable for them to remove that paragraph on the understanding that the Notes to the revised version of the draft Revised Lisbon Agreement would make it clear that the current practice under the Lisbon Agreement concerning homonymy would also be maintained under the draft Revised Lisbon Agreement.

202. The Delegation of Chile recalled that the aim of the Working Group was to bring improvements to the current Lisbon Agreement and not to simply leave it as it currently stood. In consequence, the Delegation expressed its preference for keeping Article 10(3) in the draft Revised Lisbon Agreement.

203. The Chair first noted that no one had contested the current practice under the Lisbon Agreement, which was that homonymous appellations of origin could be registered. However, as there was no agreement on the fate of draft Article 10(3) between two members of the Lisbon Agreement and another member of the Working Group, the Chair reiterated his proposed solution.

204. The Representative of CEIPI suggested reflecting the current practice not only in the Notes, but also in an Agreed Statement to be adopted by the diplomatic conference.

205. The Chair suggested leaving the issue on the understanding that Article 10(3) would disappear from the new version of the draft Revised Lisbon Agreement but that the Secretariat would include an explanation in the Notes. On the basis of that explanation the Working Group could then work on a possible Agreed Statement in due course.

206. The Delegation of Chile first sought a clarification from the Secretariat regarding the exact role of WIPO Member States which were also members of the Lisbon Working Group, without being a party to the current Lisbon Agreement. The Delegation went on to say that it was quite clear from the document under consideration that the provision in question was in square brackets and added that it had received clear instructions from its capital to support the retention of Article 10(3) in the draft Revised Lisbon Agreement. Moreover, the Delegation failed to see a general agreement on the deletion of that paragraph among the members of the Working Group. Instead, there appeared to be different views in that regard. The Delegation indicated that it would have to contact its capital for further instructions in respect of any decision that would involve a deletion of Article 10(3) from the text under consideration.

207. The Chair said that any conclusion on Article 10(3) would be postponed until after the Delegation of Chile would have had the opportunity to receive further instructions from its capital. As to the role of observer delegations in the Lisbon Working Group, the Chair confirmed that observers had a slightly different status than current members of the Lisbon Agreement and the Lisbon Union, while also recalling that the purpose of the ongoing revision exercise was to come up with a text that would pave the way for widening the membership of the Lisbon Agreement. The Chair recalled that, as a possible compromise solution, there was a proposal on the table to the effect that Article 10(3) would, for the time being, disappear from the text, but that there would be an explanation in the Notes and in a possible Agreed Statement so as to clarify that the practice under the current Lisbon Agreement in respect of homonymous appellations of origin would be maintained also under the Revised Lisbon Agreement. The Chair further recalled that he had asked the members of the Working Group whether they would support the request to delete Article 10(3) put forward by Peru and seconded by Italy and that there had been no objection in that regard. The Chair concluded by saying that the Working Group would wait to hear from the delegation of Chile to see whether delegations would be in a position to accept the compromise proposal put forward by the Chair on the basis of the suggestion from the Representative of CEIPI.

208. The Delegation of Peru said that it reserved its right to object to the wording of the explanatory text in the Notes or in a draft Agreed Statement, as proposed by the Chair as a possible compromise solution.

## DISCUSSION OF ARTICLE 13 (CONTINUED)

209. The Chair indicated that the non-paper on Article 13, dated May 1, 2013, that had been prepared and distributed by the Secretariat, represented an attempt to accommodate the various comments made in that regard<sup>2</sup>.

210. The Chair said that at the editorial session that he had held during the lunch break just prior to the present discussion, some editorial suggestions had also been made with regard to the non-paper from the Secretariat. The Chair read these editorial changes out to the Working Group, while indicating that they would be reflected in the next version of the non-paper.

211. In response to a query from the Delegation of Switzerland, the Chair said that Article 13(1) would apply to a trademark that existed in a Contracting Party other than the Contracting Party of Origin.

212. The Delegation of Iran (Islamic Republic of) first cautioned that, if not carefully drafted, Article 13 had the potential all by itself to jeopardize the entire draft Revised Lisbon Agreement. The Delegation said that it still failed to understand what was meant by “taking into account the legitimate interests”, and wondered whether the intention was to leave it entirely to national jurisdictions to deal with the matter. In addition, the Delegation wondered why no time requirements had been included in the provision, while pointing out that Article 24.4 of the TRIPS Agreement did incorporate a specific time requirement.

213. The Chair said that the phrase “taking into account the legitimate interests” was based on the text of Article 17 of the TRIPS Agreement. The Chair said that the Delegation of Iran (Islamic Republic of) had rightly pointed out that the TRIPS Agreement contained several timelines, not only in Article 24.4, but also in Articles 24.5 and 24.7. However, in the context of the draft Revised Lisbon Agreement, one would have to deal with entirely different dates or timelines, because no link could be established with the date of application of these provisions of the TRIPS Agreement in a given Contracting Party. In the context of Article 13(1) of the draft Revised Lisbon Agreement, such timeline could be found in the sentence “before the date on which a registered appellation of origin or geographical indication is protected in that Contracting Party”.

214. The Delegation of the Republic of Moldova renewed its request to incorporate at the end of Article 13(1) a similar restriction as the one contained in Article 13(4), namely that coexistence between a prior trademark and a geographical indication or appellation of origin could be allowed as long as the public was not misled.

215. The Delegation of the European Union sought further clarification about the notion of “legitimate interests” in Article 13(1) and also about the sentence “a right other than those referred to in paragraphs (1) to (3)” in Article 13(4), as it was still not clear to them what the scope of Article 13(4) would be.

216. The Delegation of France said that the phrase at the end of Article 13(1) reading “or the right to use the trademark [...] or the geographical indication” should be maintained, as it helped clarifying that the various different interests at stake would be taken into account and that no one would be considered more important than the other. Moreover, this wording also allowed the draft provision to echo the exceptions to exclusive trademark rights contained in Article 17 of the TRIPS Agreement. The Delegation was of the view that Article 13(1) rather

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<sup>2</sup> The non-paper is reproduced in Annex III

referred to Article 24.5 than to Article 24.4 of the TRIPS Agreement and was therefore of the view that a reference only to the date of protection was sufficient. The Delegation recalled that a number of delegations had suggested that “renewal” be added to the interests of the trademark owner in Article 13. As regards the suggestion from the Delegation of the Republic of Moldova to include a requirement that coexistence should only be allowed as long as the public was not misled, the Delegation wondered whether such a recognition of the prior right in a trademark would prevent any further examination of the validity of the trademark. In this connection, the Delegation indicated that a trademark could become misleading over time. Turning to Article 13(4), the Delegation expressed particular concern about the words between square brackets in the phrase “the right of any person to use [a term or name] [a plant variety denomination or trade name]”, as the Delegation was of the view that those terms were very vague and imprecise. Regarding the second set of square brackets in particular, the Delegation sought clarification as to what the notion of “trade name” actually referred to. The Delegation wondered at what point in time one should consider that a trade name had been acquired and under which statutes or legal regimes were such trade names supposed to be protected.

217. Regarding the compatibility of Article 13(1) with Article 24.5 of the TRIPS Agreement, the Representative of oriGIn said that, in Article 24.5 of the TRIPS Agreement, the crucial date was the date of protection of the geographical indication or appellation of origin in the country of origin. As regards Article 13(2), he sought further clarification as to what that provision actually referred to and whether it referred, for example, to cases of homonymous appellations of origin and geographical indications, as discussed previously at the present session of the Working Group. He further expressed his discomfort about the use of a *mutatis mutandis* formulation in Article 13(2), because the provisions of Article 13(1) concerned prior trademarks, whereas Article 13(2) dealt with the case of an appellation of origin or geographical indication which might be identical or similar to a prior one.

218. The Delegations of Georgia and Romania as well as the Representative of CEIPI supported the suggestion made by the Delegation of the Republic of Moldova regarding Article 13(1).

219. The Delegations of Italy, Serbia and Switzerland shared the views expressed by the Representative of oriGIn in relation to Article 13(2).

220. The Delegations of Italy and Switzerland shared the concerns expressed by the Delegation of France about the actual scope of Article 13(4).

221. The Delegation of the European Union referred back to its earlier request for clarification about the notion of “legitimate interests” in Article 13(1) as it was of the view that in addition to being rather vague, the way in which the provision was drafted seemed to imply that the entire protection regime for an appellation of origin or geographical indication was subject to the consideration of the legitimate interests of all the interested parties, namely the prior trademark owners and the beneficiaries of the rights in the appellation of origin and geographical indication. Under such circumstances, the Delegation sought clarification as to whether the beneficiary of a geographical indication or an appellation of origin would then be able to claim that his legitimate interests had not been taken into account for purposes of obtaining the refusal or the cancellation of a prior trademark right.

222. In the event that Article 13(2) also applied to cases of homonymy, the Delegation of Peru requested that the provision be placed between square brackets.

223. The Chair pointed out that Article 13(2) was already between square brackets and also indicated that Note 13.03 in the Notes to the draft Revised Lisbon Agreement made it clear that the provision was necessary in order to deal with the issue of “overlapping denominations or indications”.

224. The Delegation of Peru pointed out that its earlier intervention was based on the fact that Note 13.03 referred to ‘overlapping denominations or indications that do not necessarily have to be homonymous’.

225. The Representative of INTA noted that the first sentence of Article 13(1) which appeared in document LI/WG/DEV/7/2/Rev. had had a useful function, as it **implied a right forgave** trademark holders **the right** to request a refusal or the invalidation of the effects of a given appellation or origin or geographical indication. She also expressed doubts about the reference to “legitimate interests” in Article 13(1).

226. The Representative of CEIPI noted that the two alternative expressions between brackets in Article 13(4) only referred to verbal expressions, thereby excluding, for example, figurative signs that might be protected by copyright. By way of illustration, he referred to the case of a figurative sign that would not only incorporate a logo but also an appellation of origin or a geographical indication and asked whether Article 13(4) would mean that the logo should no longer be used.

227. The Chair said that valuable guidance had been provided towards further refinement of Article 13(1). The provision did not stand in the way of Contracting Parties respecting their obligations under the TRIPS Agreement. He noted the request made by several delegations to also refer to the interest of the general public at the end of Article 13(1), as proposed by the Delegation of the Republic of Moldova. In light of the little support expressed for Article 13(2) and the use of the “*mutatis mutandis*” expression, the Chair invited the Secretariat to come up with an amended version of that provision. As regards Article 13(4), the Chair noted the suggestions made, while clarifying that Article 8 of the Paris Convention required the protection of trade names.

228. The Delegation of the European Union expressed some discomfort with replacing, in Article 13(1), “taking into account the legitimate interests [...]” by “provided that the legitimate interests [...] are taken into account”, as had been suggested during the editorial session that the Chair had held during the lunch break and from which he had reported to the Working Group.

229. The Chair said that the suggested wording was actually based on the wording of Article 17 of the TRIPS Agreement.

230. Responding to a comment from the Delegation of France, the Chair recalled that, when Article 13(4) had been discussed, the main concern expressed was to have a more precise definition of the rights that would be covered under that provision. This was exactly what the phrase “a plant variety denomination or trade name” attempted to achieve.

231. The Delegation of the European Union expressed a preference for keeping, in Article 13(4), for the time being, the brackets around “a plant variety denomination or trade name” as well as around the phrase “term or name”. As regards Article 13(1), the Delegation agreed that the provision used text that also appeared in Article 17 of the TRIPS Agreement, but expressed doubts as to whether the situation under draft Article 13(1) was fully comparable with the situation foreseen in Article 17 of the TRIPS Agreement.

232. The Chair concluded by saying that a revised version of Article 13(1) would be prepared containing two options between brackets, namely “[taking into account the legitimate interests [...]” and “[provided that the legitimate interests [...] are taken into account]”. In Article 13(4), the first option between brackets would be deleted and the second option would be kept in the text between square brackets, to indicate that the issue had not been settled yet.

233. The Delegation of Italy requested that the bracketed phrase in Article 13(4) not only refer to a “plant variety denomination”, but to a “plant or animal variety denomination”.

234. The Representative of CEIPI referred back to the issue of how the current Lisbon system dealt with international registrations of appellations of origin that were no longer protected in the Contracting Party of Origin. Referring to Article 1(2) of the current Lisbon Agreement, which stated that the Contracting Parties “undertake to protect in 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”, he expressed the view that this could be interpreted as laying down an obligation to protect for as long as the appellation of origin was protected in the country of origin. In other terms, if the protection ceased in the country of origin for one reason or another, then protection under the international registration would automatically cease as well. However, one could also argue that the cessation of protection would depend on a formal request for cancellation of the international registration submitted by the country of origin. Article 24.9 of the TRIPS Agreement provided that “there shall be no obligation under this Agreement to protect geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country”. Under such a provision, some flexibility was left to Contracting Parties to decide whether to abolish protection or not.

235. The Delegation of Romania agreed that the problem raised by the Representative of CEIPI had to be carefully considered. In that connection, the Delegation wondered what the solution would be in respect of a geographical indication originating in a country that no longer existed.

236. Referring back to the example provided by the Delegation of Romania, the Delegation of Peru assumed that when a country ceased to exist and was succeeded by another, the newly constituted State would inherit all the obligations of the previous State.

237. The Secretariat said that the situation had actually occurred fairly recently in the context of the Lisbon system, namely when Serbia and Montenegro split up into two countries. At that time, there were two international registrations for which Serbia and Montenegro was the country of origin, in respect of products originating in geographical areas which were situated in Montenegro. Serbia was the continuation of Serbia and Montenegro as a sovereign State, whereas Montenegro became a new independent State. When separating, Montenegro had made a declaration indicating that it would continue to apply all the treaties previously acceded to by the former Serbia and Montenegro. Consequently, the membership of the former Serbia and Montenegro to the Lisbon Agreement had been taken over not only by Serbia, but also by Montenegro. As the two existing international registrations concerned products originating in Montenegro, Montenegro was henceforth recorded in the International Register as the country of origin of those two international registrations.

#### DISCUSSION OF ARTICLES 15, 16, 18, 19 AND 20 AND CHAPTER III OF THE DRAFT REGULATIONS

238. As regards Rule 9(1)(b) which provided that the refusal “shall be notified within a period of one year from the receipt of the notification of international registration under Article 6(4)”, the Delegation of the European Union drew the attention of the Working Group to the fact that

the European Union might have difficulties in complying with that provision in some cases under its current legislation. As regards Rule 9(2)(iv), the Delegation sought a confirmation that the aim of the proposal was to address the specific situation of international registrations refused in part by a Contracting Party because of the possible coexistence with a prior right under the legislation of such Contracting Party, notably in the case of homonymous geographical indications or appellations of origin. As regards Rule 9(2)(vi), the Delegation sought further clarification of the reference to “the judicial or administrative remedies available to contest the refusal, together with the applicable time limits” as that was unclear to them and therefore wondered whether in the case of the European Union that would simply mean an indication that the Commission decision to refuse a given registration could be challenged before the General Court of Justice in accordance with the relevant provisions of the EU treaties. The Delegation further noted that Article 15(3) laid down that interested parties had to be provided a reasonable opportunity to present “requests for the competent authority to notify a refusal in respect of an international registration”, while Article 16(2) provided interested parties with an opportunity to negotiate the possible withdrawal of a refusal. In that regard, the Delegation sought clarification from the Secretariat as to who exactly would be understood as an interested party, and suggested that perhaps such clarification could also be provided in the Notes to the draft Revised Lisbon Agreement.

239. The Delegation of the Republic of Moldova wondered whether the name of the competent authority of the Contracting Party notifying a declaration of refusal should not also be indicated in such declaration. Referring to Rule 9(3) which provided for the communication of a copy of the notification of refusal to the competent authority of the Contracting Party of Origin in cases of direct filings by the beneficiaries, the Delegation expressed the view that for greater clarity the corresponding Article 15(4) from the draft Revised Lisbon Agreement had to be adjusted accordingly. The Delegation also sought further clarification in respect of Rule 9(2)(iv) from the Secretariat to make sure they understood it correctly. In respect of Rule 10(1)(b), the Delegation suggested changing the sequence of information, as they were of the view that it would be more logical to inform first the competent authority that had submitted an irregular notification before informing the competent authority of the Contracting Party of Origin. As regards Rule 14, the Delegation was of the view that the provision should also indicate the type of products to which the transitional period would apply to make sure that the object of protection of the appellation of origin or geographical indication was fully covered. In respect of Rule 16, the Delegation asked whether it would also be possible to issue a partial renunciation not only in respect of certain Contracting Parties but also in respect of some products.

240. As regards Article 19(2), the Delegation of Hungary was of the view that the way in which the provision had been drafted seemed to limit the grounds for invalidation of registered geographical indications or appellations of origin to earlier conflicting rights only. In other words, it meant that the protection of a geographical indication or appellation of origin could not be challenged later on in time on the basis that such appellation or indication would no longer be in line with the basic requirements for protection such as the definition for instance. The Delegation went on to say that a provision of that kind would be somewhat unusual in the area of industrial property rights as there was no precedent, in the case of other intellectual property titles, where the granted protection would not be open for a later invalidation on the basis that the granted protection would not be in line with the basic protection requirements. The Delegation further pointed out that, since the protection of an appellation of origin or a geographical indication was not limited in time the granted protection could last forever in spite of the fact that the basic definition of the appellation of origin or geographical indication would not be met. The Delegation went on to say that such a provision might also be in conflict with the already existing legal framework within the European Union, because geographical indications protected in the European Union could still be invalidated later on, whenever the product on the market appeared not to be in conformity with the requirements contained in the

product specifications, as per Article 12(1) of European Union Regulation 510/2006. By way of conclusion, the Delegation expressed the view that such provision might perhaps be an obstacle to the accession of the European Union to the Revised Lisbon Agreement.

241. The Delegation of Peru expressed its disagreement with the contents of Rule 9(2)(iv) and therefore requested that the provision remain in square brackets, for the time being.

242. Regarding the desirable duration of the transition period in Rule 14(2), the Delegation of France noted that the duration in question appeared in square brackets and wondered why one would want to set a minimum duration in that respect. The Delegation went on to say that the indication of a maximum duration seemed logical, but failed to see the reason behind the indication of a minimum duration, in particular because there could be cases where the issue would be resolved quickly and others in respect of which a longer period could be required. As regards Article 19, the Delegation said that, if a country had supposedly taken a full year to examine the validity of an appellation of origin or a geographical indication before granting protection, it failed to understand why it would be necessary to extend the grounds for invalidation to the non-respect of the basic appellation of origin or geographical indication definition, in Article 19(2). The Delegation went on to say that, under the legislation of the European Union, a cancellation could be pronounced whenever a product on the market no longer respected the terms of reference or requirements for the use of a protected denomination of origin or protected geographical indication. In that regard, the Delegation expressed the view that such a situation slightly differed from the situation under consideration in Article 19, as the cancellation under the European Union Regulation did not concern the protection of the denomination or indication itself, but rather the basic requirements that the appellation of origin or geographical indication had to respect. In other terms, the legislation of the European Union rather concerned the monitoring and the verification by the national authorities of the production processes and their conformity with the basic requirements.

243. As regards Article 16(2), the Representative of INTA reiterated INTA's concerns about the reference to possible negotiations in order to obtain the withdrawal of a refusal, as she was of the view that prior trademark rights should not be a matter for negotiations between Contracting Parties. She further pointed out that, since the case of third parties affected by a refusal was already addressed under Article 15(5) and since the general rules of public international law always allowed for negotiations between countries to solve their disputes, she was of the view that Article 16(2) was not necessary. As regards Article 19(2) and in light of the concerns raised by the Delegation of Hungary, she agreed that the provision could perhaps be framed more broadly to clarify that the invalidation on the basis of a prior right was only one of the possible scenarios covered by that provision.

244. The Delegation of Romania shared the views expressed by the Delegation of Hungary in respect of Article 19, as well as the views expressed by the Delegation of Peru in respect of Rule 9(2).

245. As regards Rule 9(1)(b) and the comment made by the Delegation of the European Union that it would have some difficulties in meeting the prescribed time limits, the Secretariat sought further clarification from the Delegation of the European Union. Referring to Articles 15(3) and 16(2) and to the requests for clarification concerning the term "interested parties", the Secretariat indicated that that term already appeared both in Article 5 of the current Lisbon Agreement and in the TRIPS Agreement, while also pointing out and that no definition of the term had been provided under any of those two Agreements. As regards the suggestion made by the Delegation of the Republic of Moldova in respect of Rule 9(2), namely that such Rule should also require that the name of the competent authority also be mentioned in the Notification of Refusal, the Secretariat pointed out that in practice that was already the case, since the form that was used for Refusals did require that the name of the competent

authority be provided. The Secretariat further indicated that Rule 12 concerning the Notification of Grant of Protection also required that the name of the competent authority be provided and added that, since the procedure for a grant of protection was basically comparable to a refusal notification because a country could either submit a refusal or a grant of protection within the one-year period, there was a certain logic to align Rule 9 with Rule 12. As regards Rule 9(3) and Article 15(4), the Secretariat expressed the view that those provisions should be aligned by expressly indicating in Article 15(4) that in the case of direct applications, the notification of refusal should also be sent to the competent authority. Referring to Rule 9(2)(iv), the Secretariat pointed out that the reference to subparagraph (ii) was wrong and that the provision should instead make reference to subparagraph (iii). As regards the suggestion to reverse the order of the notifications to be made in Rule 10(1)(b) so as to first list “the competent authority that submitted the notification of refusal”, before “the beneficiaries or the legal entity” or “the competent authority of the Contracting Party of Origin”, the Secretariat indicated that such change could certainly be made in the text. As regards Rule 14, the Secretariat had noted the suggestion made by the Delegation of the Republic of Moldova to also include information on the scope of the transitional use, or more specifically on the type of use that would be allowed during the transitional period, in the requirements of the notification to be made under Rule 14. With respect to “Renunciations” in Rule 16 and the question raised by the Delegation of the Republic of Moldova as to whether it would be possible to submit a partial renunciation that would only concern certain products or certain uses, the Secretariat expressed the view that Moldova was actually referring to a limitation rather than to a renunciation. In that regard, the Secretariat clarified that, contrary to the Madrid system, such limitations were not provided for under the Lisbon system. The possibility of allowing for such limitations under the Revised Lisbon Agreement might be examined by the Working Group. As regards Article 19(2) and the question raised by the Delegation of Hungary as to whether that provision would actually limit the grounds on the basis of which an invalidation could be pronounced, and in particular whether it would strictly limit the possibility of pronouncing an invalidation only to cases of a non-conformity with a geographical indication or an appellation of origin definition, the Secretariat referred to the comments made by the Delegation of France as to whether what was referred to by “invalidation” also included “cancellation”. In that regard, the Delegation of France had indicated that under European Union law, if a product did not meet the product specifications, or if it no longer met them, the Commission could “cancel” rather than “invalidate” the corresponding registration. The Secretariat noted the request made by the Delegation of Peru to put Rule 9(2)(iv) between brackets. As regards the question raised by the Delegation of France as to why it would be necessary to have a minimum duration instead of only having a maximum duration in Rule 14(2), the Secretariat recalled that the suggestion to indicate a minimum duration had been made at one of the previous sessions. With respect to the concern expressed by the Representative of INTA about Article 16(2), the Secretariat recalled that the earlier discussions on the matter had not been conclusive and therefore it had been decided to leave the text as is, for the time being. The Secretariat further clarified that the purpose of Article 16(2) was to make it absolutely clear that it was still possible to enter into negotiations once a refusal had been submitted. In that regard, the Secretariat pointed out that in some instances refusals had been withdrawn later on in time as a result of bilateral negotiations between the Contracting Parties concerned.

246. The Chair concluded that, following a proposal from the Delegation of the Republic of Moldova, Article 15(4) would be amended so as to include the competent authority among those that would receive a notification of refusal from the International Bureau in the case of direct applications. Regarding Article 16(2), he noted the concerns expressed by the Representative of INTA and of the explanation provided by the Secretariat in that regard. In respect of Article 19, he expressed the view that further work was needed, especially with regard to Article 19(2). In light of the concerns expressed by the Delegation of the European Union with respect to Rule 9(1)(b) and the period within which a refusal had to be notified, the

Chair suggested putting the indication “one year” between square brackets, for the time being. As regards Rule 9(2), the Chair indicated that item (iv) would be placed between square brackets at the request of the Delegation of Peru. With respect to Rule 10(1)(b), the Chair confirmed that the order of the addressees of the communication by the International Bureau would be reversed. As regards the question that had been raised as to whether Rule 14 should also require the submission of information on the scope of the transitional use and whether this requirement should be optional or mandatory, the Chair invited the Secretariat to include text to that effect in a revised version of Rule 14 that would be prepared for the next session of the Working Group. Still on Rule 14, the Chair also noted the concerns expressed by the Delegation of France about the minimum duration of the transitional period. In that regard, the Chair suggested adding another square bracket that would indicate two years next to the current proposed duration of five years which appeared between square brackets. In respect of Rule 16, the Chair noted that a question had been raised as to whether a partial renunciation was or would be possible under such provision.

247. The Delegation of France clarified that it had not requested that an additional square bracket be included in Rule 14(2), but that the terms “shall not be shorter than” be put between square brackets.

248. Regarding Article 19, the Representative of INTA said that INTA certainly welcomed the reference to prior rights, but would be opposed to establishing any limits to the grounds for invalidation. In consequence, and in light of the discussion on that issue, she strongly favored broadening the current wording so as to ensuremake it entirely clear without any room for doubts that the subsequent cancellation of terms or denominations that should have never obtained protection in a given country in the first place remained possible.

249. As regards the title of Article 14, the Delegation of Venezuela (Bolivarian Republic of) suggested replacing the term “*Subsanación*” by “*Subsanar*” in the Spanish version of the text.

#### DISCUSSION OF ARTICLE 13 (CONTINUED)

250. The Chair indicated that the Secretariat had produced a revised version of Article 13 in an attempt to reflect the outcome of the earlier discussions of the Working Group in that respect<sup>3</sup>. The Chair then invited the members of the Working Group to share their first comments on the revised text of Article 13 and to provide their views as to whether the proposed text for Article 13 could be included in the Chair’s summary as an Annex, on the understanding that the proposed text would also be incorporated in the revised version of the Revised Lisbon Agreement that would be prepared by the Secretariat for the next session and that it would serve as the basis for future discussions on that issue.

251. As regards Article 13(1), the Delegation of Iran (Islamic Republic of) sought clarification as to whether the sentence “where a registered appellation of origin or a registered geographical indication conflicts with a prior trademark applied for or registered” only applied to trademarks applied for or registered before the date of registration of the appellation of origin or geographical indication. Further, the Delegation suggested deleting the terms “the legitimate interest of the owner of the trademark as well as those of the beneficiaries” from Article 13(1), as it was of the view that the protection of the legitimate interests of the owner of the trademark was already addressed earlier on in the provision. As regards the last sentence

<sup>3</sup> The non-paper is reproduced in Annex IV

of Article 13(3), the Delegation suggested replacing the phrase “in such a manner as to mislead the public” by “in such a manner misleading the public” as it was of the view that the expression “as to mislead the public” meant that the act of misleading the public had to be intentional.

252. As regards Article 13(4), the Representative of CEIPI recalled that there had been some reservations concerning plant variety denominations, but failed to recall whether those reservations also extended to trade names. Concerning plant variety denominations, he pointed out that according to the UPOV Convention such denominations had to be made available to everyone and therefore no rights could be acquired in respect of plant variety denominations.

253. The Delegation of the European Union supported the proposal made by the Chair to annex the revised text of Article 13 to the Chair’s Summary and to include it in a new version of the Revised Lisbon Agreement so as to serve as the basis of their future discussions on that issue.

254. The Delegation of Italy renewed its request to also include a reference to animal variety in the square brackets contained in Article 13(4).

255. Referring to the request made by the Delegation of Italy, the Delegation of the European Union suggested using the terms “animal breed” rather than “animal variety” to be in line with the legislation of the European Union.

256. The Representative of INTA expressed some doubts regarding the phrase “and provided that the public is not misled” at the end of Article 13(1). She went on to say that, even if she understood the rationale for the inclusion of such wording, she was of the view that it should be formulated in a different way, as the current wording might create some bias against trademarks and trademark applications, in particular as there were also cases in which the appellation of origin or geographical indication could be misleading. In other words, the principle in question should not only be used against a prior trademark but should also serve as a possible cause for refusal or invalidation of a geographical indication or appellation of origin so that the object of refusal or invalidation would always be the actual application/registration that is misleading for the consumers in the country of protection. As regards the phrase “the legitimate interests of the owner of the trademark”, she expressed the view that these should be kept in Article 13(1), not only because they also appeared in Article 17 of the TRIPS Agreement, but also because Article 13 not only dealt with limited exceptions which the trademark owner had to tolerate but with the very right of the trademark to its continued existence. Finally, in respect of the priority situation, she noted that the revised version of Article 13 had been shortened and, in particular, that the previous language which clarified how the priority situation would be determined had been omitted. In that regard, she suggested reintroducing the original language to make it entirely clear that the priority situation should always be determined with reference to the existing protection for both geographical indications and trademarks, in the Contracting Party of protection, in line with the principle of territoriality.

257. Referring to the statement made by the Representative of INTA that the situation should always be determined on the basis of the date that applied in the Contracting Party where protection was sought, the Secretariat wondered how the Representative of INTA reconciled this with Article 24(5)(b) of the TRIPS Agreement, which stated that the trademark rights should exist “before the geographical indication is protected in its country of origin”.

258. The Representative of INTA said that Article 24(5)(b) of the TRIPS Agreement should ~~probably rather~~ be interpreted as a grandfathering rule in the context of the implementation of the section on geographical indications of the TRIPS Agreement rather than as a general co-existence rule.

259. The Delegation of Iran (Islamic Republic of) renewed its request for clarification regarding the scope of the word “prior” in the sentence “conflicts with a prior right in a trademark applied for or registered”.

260. The Chair indicated that each Contracting Party would have to define “prior trademark” in its legislation, even if the general understanding would be that “prior trademark” referred to a trademark applied for, registered, or acquired through use prior to the international registration of the appellation of origin or geographical indication concerned.

261. Regarding the suggestion to put the “legitimate interests of the owner of the prior trademark” in square brackets in Article 13(1), the Representative of the WTO pointed out that under the WTO jurisprudence on the meaning of “legitimate interests”, such interests were not the same as legal interests.

262. The Delegation of Iran (Islamic Republic of) reiterated its request to put the phrase concerning the legitimate interests of the trademark owner between square brackets.

263. The Chair said that the phrase would be put in square brackets, in the absence of clear guidance from the Working Group on the matter.

#### DISCUSSION OF ARTICLE 10 (CONTINUED)

264. Upon consulting its capital, the Delegation of Chile confirmed its interest in keeping Article 10(3) in the draft Revised Lisbon Agreement.

265. The Chair recalled that, in the course of the discussions on Article 10, the Working Group had agreed to remove Article 10(3) from the draft Revised Lisbon Agreement at the request of two delegations, on the understanding that the Secretariat would prepare Notes explaining the current legal situation under the Lisbon Agreement and also pointing out that that situation would not change under the Revised Lisbon Agreement and that an Agreed Statement clarifying this issue would be added to the draft Revised Lisbon Agreement later in time. The Chair also noted the fact that the Delegation of Peru was not in a position to agree to an Agreed Statement or Notes without first having had the opportunity to examine the proposed texts.

266. The Delegation of Chile sought some clarification as to the situation of observers in the Lisbon Working Group and, in particular, how their interests and opinions would be reflected in the ongoing revision exercise. The Delegation further pointed out that some of the proposals made at the present session by other observer delegations had been incorporated in the text of the draft Revised Lisbon Agreement, even though such proposals had not been explicitly supported by any other delegation.

267. The Chair indicated that proposals put forward by delegations were taken on board whenever any such proposal, either from an observer or from a current member of the Lisbon Agreement, found sufficient support in the Working Group. In that regard, the Chair recalled that the Working Group had worked in a collective spirit for purposes of improving the legal framework for the protection of appellations of origin and geographical indications. He further indicated that, whenever there was a suggestion or a proposal coming from an observer that

was not objected to or even supported expressly by the Working Group, it would nonetheless be taken on board. If the issue of Article 10(3) had come up between current members of the Lisbon Agreement, the matter would have been settled in the same manner. The Chair recalled that following a clear disagreement regarding homonymy, he had come up with the compromise solution to clarify the issue in an Agreed Statement that would be added to the draft Revised Lisbon Agreement. The Agreed Statement would explicitly clarify that the current legal situation under the Lisbon Agreement would not be changed under the Revised Lisbon Agreement.

268. The Delegation of Chile pointed out that whenever there had been a lack of consensus in the Working Group on the relevance of including a provision or not, such disagreement had been reflected by putting the said provision in square brackets rather than by deleting it. The Delegation therefore failed to understand the reason why the situation should be any different in the present case. Lastly, the Delegation requested that it be made clear in the report that there had been no consensus at the present session of the Working Group on the deletion of Article 10(3) and that the Delegation of Chile had misgivings as to the way in which the interests and the positions of observers in the discussions of the Working Group were being dealt with.

269. The Delegation of Peru requested that the reservations it had expressed with respect to the compromise solution proposed by the Chair also be reflected in the report of the present session.

270. Referring to the introductory words of the Director General at the beginning of the present session, the Delegation of Venezuela recalled the importance of attracting a greater membership of the Lisbon system. In that light, the Delegation supported the request made by the Delegation of Chile to keep the text of Article 10(3) between square brackets in the draft Revised Lisbon Agreement, all the more as the Working Group was not yet producing a final text at the present session.

271. In an attempt to overcome the difficulties with respect to Article 10(3), the Chair proposed to add a footnote to Article 10 that would indicate that paragraph (3) had been deleted on the understanding that there would be an Agreed Statement that would be drafted by the Secretariat on the issue of homonymy previously covered by Article 10(3). The Chair further confirmed that it would be duly reflected in the Report of the present session that among the delegations that participated in the Working Group, including the observers, there had been no consensus on the issue.

272. The Delegation of Chile recalled that it had been instructed to request that Article 10(3) be maintained in the text. In light of the new proposal made by the Chair, the Delegation requested some additional time to look into it and to get in contact with its capital.

273. The Delegation of Hungary pointed out that the practice followed by other Working Groups in similar cases, to accommodate various concerns, was to refer to the existing situation in a footnote and to open the possibility for delegations to discuss the issue in future meetings. In consequence, the Delegation fully supported the compromise solution put forward by the Chair.

274. The Delegation of France first recalled that the Working Group had begun its work with a view to be open, to listen to the point of view of the observers, and to take their contributions into account. In that context, the Delegation indicated that the proposal made by the Chair appeared to be a perfectly acceptable compromise solution.

275. In the absence of any particular objection, the Chair assumed that his compromise solution was supported by the Working Group with the exception of one delegation that had requested some additional time to consider it.

## **FUTURE WORK**

276. Referring to future work, the Chair recalled that he had already drawn the attention of the members of the Working Group to paragraphs 4 and 6(iii) of the Working Document LI/WG/DEV/7/2/Rev. where it was stated that subject to the progress made at the present session it might be possible to foresee a revision conference in 2014 or 2015, which might in turn require a decision by the Lisbon Union Assembly already in the year 2013. He added that the Working Document also referred to the possibility that the Lisbon Working Group designed “a possible time path towards the conclusion of the review of the Lisbon system at such a revision conference”. He went on to say that paragraph 6(iii) also invited the Working Group where possible to “make recommendations on the directions that the Lisbon Union Assembly might give” to the International Bureau concerning the preparation of the revision conference. In view of the progress made at the present session, the Chair referred to the two possible scenarios he had previously outlined. Under the first scenario, the Working Group would find itself in a position to make a recommendation to the Lisbon Union Assembly that a diplomatic conference be convened in 2014 or in 2015 and that the Lisbon Union Assembly take that decision in the autumn of 2013. In that case, there would be two more Working Group meetings, one in December 2013 and the other in the first half of 2014, plus a preparatory meeting for preparing the ground for the diplomatic conference and for deciding issues relating to convening the diplomatic conference. The Chair indicated that his understanding was that such a preparatory meeting would take place back to back with the ninth session of the Working Group that would take place in the first half of 2014. The alternative scenario would be to agree on a roadmap at the present session of the Working Group. The roadmap would include the following elements: submit the roadmap, if any, to the Lisbon Union Assembly in the autumn of 2013, ask the Lisbon Union Assembly to take note of such roadmap and to mandate the Working Group to work along the lines of the roadmap. Then, there would be the two sessions already envisaged, namely the eighth session in December and the ninth session some time in the first half of next year. The Chair indicated that on the basis of the results of the ninth session in the first half of next year, the Working Group would be in a position to agree on a recommendation to the Lisbon Union Assembly on convening a diplomatic conference in 2015, while the formal decision to convene a diplomatic conference would be taken by the Lisbon Union Assembly in the autumn of 2014. After that, there would be another Working Group meeting, presumably in November or December 2014, plus a preparatory committee meeting back to back with that meeting. Lastly, the diplomatic conference would then take place in 2015 depending on the decision that the Assembly might take in 2014. The Chair invited the members of the Working Group to provide their views on those two scenarios so as to have a clear picture of the position of the members of the Working Group in that regard and to be able to come up with clear cut conclusions on future work.

277. The Deputy Director General, Ms. Wang Binying, expressed her appreciation for the hard working atmosphere, the team spirit, and the substantial progress made by the Working Group. She further indicated that she agreed with the Chairman’s summary of the work carried out so far and said that it was in the hands of delegations to decide what should be the outcome of the efforts made over the last few years. She further expressed the view that a revision of the Lisbon Agreement was necessary and that a Revised Lisbon Agreement as was shaping up would be of great interest to all, not only to the current Contracting Parties but also to the potential new member States.

278. The Delegation of the Republic of Moldova was of the view that the Working Group would need at least two more Working Group sessions to achieve a draft Revised Lisbon Agreement that would be satisfactory to the majority of interested parties and therefore expressed a clear preference for the second scenario proposed by the Chair.

279. The Delegation of Romania expressed a preference for the first scenario as it was of the view that the text was ripe enough.

280. The Delegation of Hungary shared the view expressed by the Delegation of Romania and also indicated its preference for the first scenario proposed by the Chair. Nevertheless, if other delegations were of the opinion that more time was needed to discuss outstanding issues, the Delegation was prepared to accept the second scenario.

281. The Delegation of Italy shared the view expressed by the Delegation of the Republic of Moldova and also believed that more time was needed. Hence, the Delegation also expressed its support for the second scenario.

282. The Delegation of Iran (Islamic Republic of) shared the views expressed by the Delegations of Italy and the Republic of Moldova. The second scenario would be a better option especially in view of the need to share the results of the progress made by the Working Group with those non-Member States that had not participated to the ongoing revision exercise. The Delegation therefore suggested trying to find a way to better communicate with the WIPO Member States at large, so as to bring to their attention the work that had been done so far by the Working Group and thereby try to receive their contributions and feedback.

283. The Delegation of Switzerland expressed the view that the Working Group had reached a level of maturity which would make it possible to move towards a diplomatic conference sooner rather than later and therefore supported the first scenario proposed by the Chair.

284. The Delegation of France expressed the view that the next two sessions of the Working Group could be used to resolve other important issues on which certain difficulties remained, as in the case of prior rights. In any event, the Delegation was of the view that two sessions of the Working Group would be enough to resolve any outstanding issue. Hence, the Delegation was of the view that it would be useful to recommend the convening of a Diplomatic conference to the Assembly of the Lisbon Union in the autumn of 2013.

285. The Delegation of Peru shared the view expressed by the Delegations of the Republic of Moldova and Italy and expressed its support for the second scenario proposed by the Chair.

286. The Delegations of Georgia, Portugal and Serbia shared the view expressed by the Delegation of Romania, as it would be possible, in their view, to achieve a clear and satisfying text within the next two sessions of the Working Group. The Delegations therefore supported the first scenario proposed by the Chair.

287. Referring to the suggestion made by the Delegation of Iran (Islamic Republic of) to find a way to better communicate with non-Lisbon member States, the Delegation of Australia indicated that if the working documents were previously circulated for comments among WIPO Member States at large, the Working Group might get some valuable input on the various draft texts.

288. In response to the comment made by the Delegation of Australia, the Chair clarified that the working documents were always circulated well in advance of each session, while an electronic forum had been established for sharing comments.

289. The Delegation of Italy clarified its position and said that it actually supported the first scenario proposed by the Chair.

290. The Delegation of Iran (Islamic Republic of) also clarified its position and indicated that it could support the first scenario, on the understanding that a diplomatic conference would not be held until 2015.

291. The Delegation of the Republic of Moldova agreed with the Delegation of Iran (Islamic Republic of) and supported the idea of having a diplomatic conference in 2015.

292. The Chair noted that quite a few delegations were in favor of making a recommendation to the Lisbon Union Assembly in 2013, while some delegations were of the view that in order to appropriately prepare the ground for a diplomatic conference some more time would perhaps be needed. The Chair wondered whether those views could be reconciled by indicating the year 2015 as the tentative date for the diplomatic conference in the recommendation to the Lisbon Union Assembly, while giving the Lisbon Union Assembly the possibility to review, in 2014, the progress made, and while also envisaging the possibility of having a third Working Group session in the second half of 2014, if necessary.

#### DISCUSSION OF OUTSTANDING ISSUES

293. The Chair invited delegations to take the floor on any outstanding issue.

294. The Delegation of the European Union expressed concern about the provision in Article 28(1)(iii) which read “under the constituting treaty of the intergovernmental organization, legislation applies for the protection of appellations of origin and/or geographical indications in accordance with this Act”. More specifically, the Delegation was of the view that the provision set a strong condition for intergovernmental organizations to join the Revised Lisbon Agreement and therefore requested that the sentence be put between brackets to also allow further reflection and perhaps a comparison with the corresponding provisions in other international instruments to determine the wording that would be appropriate in the case of Article 28(1)(iii).

295. As regards the possibility of comparing the provision of Article 28 with similar provisions contained in other WIPO Treaties, as mentioned by the Delegation of the European Union, the Secretariat pointed out that the study on the conditions for accession to the Lisbon Agreement by Intergovernmental Organizations, as contained in document LI/WG/DEV/2/3, provided that type of information in an annex.

296. Referring to Rule 25, which stated that “these Regulations shall enter into force on ...”, the Representative of CEIPI said that his understanding was that the Regulations would be adopted at the same time as the Revised Lisbon Agreement. In consequence, at the diplomatic conference one would not yet be in a position to know when the Revised Lisbon Agreement or the corresponding Regulations would enter into force and therefore suggested deleting Rule 25 altogether.

297. The Delegation of Italy sought clarification from the Secretariat as regards the meaning of the expression “and vice versa” at the end of the sentence in Article 22(4)(b)(ii).

298. The Chair pointed out that the same language was used in other WIPO treaties such as the Beijing Treaty or the Singapore Trademark Law Treaty.

299. The Secretariat clarified that the meaning of the terms “and vice versa” was that intergovernmental organizations would not be able to vote if one or more of its member States had already voted whereas, on the contrary, if none of its member States had voted, then the inter-governmental organization would be able to vote.

300. Referring to Article 28, the Delegation of Peru pointed out once again that the Andean Community legislation did not contemplate the possibility for intergovernmental organizations to be holders of appellations of origin.

301. The Delegation of Thailand sought clarification concerning the registration procedure under the draft Revised Lisbon Agreement. Should Thailand become a party to the Revised Lisbon Agreement, the Delegation indicated that its understanding of the registration procedure was that if Thailand submitted an application for registration to WIPO, the International Bureau would then register the geographical indication in the International Register. If none of the Contracting Parties of the Lisbon system refused the protection to Thailand's international registration that would mean that their geographical indication would be protected under the Lisbon system in all the Contracting Parties. The Delegation raised two questions in that regard. First, the Delegation pointed out that Thailand only had a law on the protection of geographical indications, while some other Contracting Parties had laws on the protection of appellations of origin. The Delegation therefore asked what would happen in the situation that the extent of protection of a geographical indication and an appellation of origin was not the same. The second question raised by the Delegation was whether Thailand would have to pay fees in all the Contracting Parties to the Revised Lisbon Agreement. The law on geographical indications in Thailand provided that, if someone wanted to obtain geographical indication protection in Thailand, he or she would have to pay an application fee. The Delegation wondered what would be the amount of the fees that Thailand would have to pay to the other Contracting Parties to secure the protection of its geographical indications should over one hundred countries become party to the Revised Lisbon Agreement. In that regard, the Delegation suggested designing a system similar to the Madrid or PCT systems, which allowed for the designation of one or more Contracting Parties where protection was sought. Lastly, the Delegation suggested that WIPO prepared a flow chart explaining the registration procedure under the draft Revised Lisbon Agreement and that it be posted on WIPO's website.

302. The Secretariat said that, while there were countries that distinguished between appellations of origin and geographical indications in their national law, it had always been the assumption in the Working Group that the fact that the Revised Lisbon Agreement would have two definitions, one for appellations of origin and the other for geographical indications, would not mean that all countries would have to provide for both in their national law. In other words, countries would be able to continue to provide only for geographical indications or for appellations of origin and geographical indications, separately. The Secretariat clarified nonetheless that those countries which only had a law on geographical indications would have to provide protection for appellations of origin also under that geographical indication law. In the reverse situation, namely where a country had two definitions in its national law, it could request an international registration for both appellations of origin and geographical indications under the Revised Lisbon Agreement, under those separate titles. The Secretariat further specified that those countries which only provided for geographical indications in their national law as in the case of Thailand would in principle only have the opportunity to register their geographical indications under the Revised Lisbon Agreement as geographical indications. These would then be protected in all other Contracting Parties as geographical indications. Referring to the question about fees, the Secretariat pointed out that the wording of the draft Revised Lisbon Agreement was the same as the one contained in the current Lisbon Agreement as far as the required fees were concerned, namely, that only a single fee of 500CHF would have to be paid to the International Bureau for the international registration of an appellation of origin or a geographical indication. The Secretariat went on to say that the Revised Lisbon Agreement did not incorporate a provision concerning designation fees simply

because under the Lisbon system international registrations were automatically protected in all the other Contracting Parties to the Agreement. The Lisbon system was different from the Madrid system, under which applicants not only had to pay a fee to the International Bureau but also to the Contracting Parties they had designated in their international registration of a trademark.

303. The Chair recalled that the Working Group was also working on the basis that the Revised Lisbon Agreement would provide for the same level of protection for both appellations of origin and geographical indications.

304. Referring to Article 9(1), the Representative of INTA wondered whether the provision actually meant that, if a Contracting Party chose to provide more extensive protection than the one provided under the Agreement, such protection would have to be provided for both appellations of origin and geographical indications, or whether Article 9(1) should be interpreted as allowing a Contracting Party to provide a different level of protection to appellations of origin as opposed to geographical indications.

305. The Chair pointed out that there seemed to be no restriction under Article 9(1) that would prevent Contracting Parties from providing a different level of protection to appellations of origin and geographical indications and therefore expressed the view that it was an issue that would be worth looking into at the next session.

306. The Chair indicated that there was still an unresolved issue concerning Article 10(3) and in that regard recalled that the Working Group had supported his proposal to delete Article 10(3) on the understanding that in the next version of the draft Revised Lisbon Agreement, a footnote would be added to Article 10 setting out that nothing in the draft Revised Lisbon Agreement would alter the current practice under the Lisbon Agreement with respect to homonymous appellations of origin and geographical indications.

307. The Delegation of Chile said that it would be able to go along what had been proposed by the Chair as regards Article 10, namely, that an Agreed Statement would be prepared by the Secretariat which would reflect the practice of the Lisbon Agreement with regard to homonymous geographical indications and appellations of origin. The Delegation added that its understanding was that such Agreed Statement would be included in the draft Revised Lisbon Agreement as a footnote to Article 10 and that it would be discussed at the next session.

308. The Delegation of Peru sought further clarification as regards the compromise solution proposed by the Chair and asked in particular whether it would be an Agreed Statement as such or a footnote which would be added to the draft Revised Lisbon Agreement. In any event, the Delegation recalled that it reserved its position on the matter until it would be in a position to examine the contents of such footnote or Agreed Statement.

309. The Chair clarified that the footnote to Article 10 would set out the main elements of a possible Agreed Statement that might be annexed to the draft Revised Lisbon Agreement.

310. The Delegation of Chile said that its understanding was that the Secretariat would prepare the text of an Agreed Statement which would be discussed at the next session. In any event, the contents of such Agreed Statement would reflect the practice under the current Lisbon Agreement in respect of homonymous appellations of origin and geographical indications.

311. ~~The Delegation of Peru pointed out that some amendment to the current practice under the Lisbon Agreement would be involved, as the Lisbon Agreement only dealt with homonymous appellations of origin and not with homonymous geographical indications.~~ The Delegation further specified that the question it had asked earlier was whether the Agreed Statement would take the form of a footnote or of an annex to the Revised Lisbon Agreement.

312. The Chair indicated that, for the time being, one could opt for a footnote that would indicate that, at the request of the Working Group, the Secretariat had prepared the text for a possible Agreed Statement.

313. Finally, the Chair recalled that, at the previous session, the Working Group had taken note of the wish expressed by the Delegation of the European Union that a workshop on dispute settlement within the Lisbon system be organized as a side event in the margins of one of the sessions of the Working Group in 2013. The Chair confirmed that in the first week of December 2013, in the margins of the eighth session of the Working Group, a half-day conference on dispute settlement within the Lisbon system would be organized and that the Secretariat would prepare a factual document on the issue of dispute settlement to facilitate discussions at the conference.

#### **AGENDA ITEM 6: OTHER MATTERS**

314. No statements were made under this item.

#### **AGENDA ITEM 7: ADOPTION OF THE SUMMARY BY THE CHAIR**

315. The Working Group approved the Summary by the Chair as contained in Annex I to the present document.

316. A draft of the full report of the seventh session of the Working Group will be made available on the WIPO web site for comments by the delegations and representatives that participated in the meeting. Participants will be informed once the draft report is available on the WIPO web site. Participants can submit comments within one month from its publication date, after which a track-changes version of the document, taking into account all the comments received from participants, will be made available on the WIPO web site. The availability of the comments and the track-changes version will also be communicated to participants, together with a deadline for the submission of final comments on that track-changes version. Thereafter, the report, taking into account the final comments, as appropriate, will be published on the WIPO web site without track changes, indicating the date of such final publication. As of that date, the report will be deemed adopted, which will be noted at the next session of the Working Group.

#### **AGENDA ITEM 8: CLOSING OF THE SESSION**

317. The Chair closed the session on May 3, 2013.

[Annexes follow]



**E**

LI/WG/DEV/7/6  
ORIGINAL: ENGLISH  
DATE: MAY 3, 2013

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

### **SUMMARY BY THE CHAIR**

*adopted 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 April 29 to May 3, 2013.
2. The following Contracting Parties of the Lisbon Union were represented at the session: Algeria, Costa Rica, Czech Republic, France, Georgia, Hungary, Iran (Islamic Republic of), Italy, Mexico, Peru, Portugal, Republic of Moldova, Serbia (13).
3. The following States were represented as observers: Angola, Australia, Benin, Brazil, Brunei Darussalam, Chile, Colombia, Germany, Indonesia, Iraq, Lithuania, Madagascar, Myanmar, Pakistan, Republic of Korea, Romania, Russian Federation, Sudan, Switzerland, Thailand, United States of America, Venezuela (Bolivarian Republic of) (22).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: European Union (EU), World Trade Organization (WTO) (2).
5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: Brazilian Association of Intellectual Property (ABPI), Centre for International Intellectual Property Studies (CEIPI), European Communities Trade Mark Association (ECTA), Health and Environment Program (HEP), International Association for the Protection of Intellectual Property (AIPPI), International Trademark Association (INTA), MARQUES (Association of European Trademark Owners), Organization for an International Geographical Indications Network (oriGIn) (8).

6. The list of participants is contained in document LI/WG/DEV/7/INF/1 Prov. 2\*.

#### **AGENDA ITEM 1: OPENING OF THE SESSION**

7. The Director General of the World Intellectual Property Organization (WIPO), Mr. Francis Gurry, opened the session, recalled the mandate of the Working Group and introduced the draft agenda, as contained in document LI/WG/DEV/7/1 Prov.

#### **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, Mr. Behzad Saberi Ansari (Iran (Islamic Republic of)) and Mr. Miguel Alemán Urteaga (Peru) were unanimously 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/7/1 Prov.) without modification.

#### **AGENDA ITEM 4: REPORT OF THE SIXTH SESSION OF THE WORKING GROUP ON THE DEVELOPMENT OF THE LISBON SYSTEM (APPELLATIONS OF ORIGIN)**

11. The Working Group took note of the adoption, on April 26, 2013, of the Report of the sixth session of the Working Group, as contained in document LI/WG/DEV/6/7, in accordance with the procedure established at the fifth session of the Working Group.

#### **AGENDA ITEM 5: DRAFT REVISED LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS AND DRAFT REGULATIONS UNDER THE DRAFT REVISED LISBON AGREEMENT**

12. Discussions were based on documents LI/WG/DEV/7/2 Rev., LI/WG/DEV/7/3, LI/WG/DEV/7/4 and LI/WG/DEV/7/5. The Working Group examined in detail Chapters I to IV of the Draft Revised Lisbon Agreement and the corresponding Rules in the Draft Regulations, and also addressed the remaining Chapters focusing on issues highlighted by delegations.

13. Following a detailed discussion on Article 13 of the Draft Revised Lisbon Agreement contained in Annex I of document LI/WG/DEV/7/2 Rev., the Chair concluded that the non-paper submitted by the Secretariat, as amended during the discussions (see the Annex to the present document), would be incorporated in the Revised Draft Lisbon Agreement that would be prepared by the Secretariat for the next session and would serve as the basis for future discussions on Article 13.

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\* The final list of participants will be made available as an Annex to the report of the session.

#### Future work

14. The Chair confirmed that the next session of the Working Group would be convened in December 2013, while also recalling that a half-day conference on dispute settlement within the Lisbon system would be organized as a side event in the margins of that meeting and that a factual document on the issue of dispute settlement would be prepared by the Secretariat to facilitate discussions at the conference.

15. He reiterated that the focus of the next session would be the examination and discussion of a revised version of the Draft Revised Lisbon Agreement and Draft Regulations that would be prepared by the Secretariat and distributed well in advance of the next session. In particular, the Secretariat would work along the lines of the guidance provided by the Working Group at the present session and would make sure that all comments and suggestions be duly reflected in those revised versions.

16. As regards the overall structure of the Draft Revised Lisbon Agreement and Draft Regulations, the Chair confirmed that the Secretariat would continue to work on the basis of a single instrument covering both appellations of origin and geographical indications and providing for a high and single level of protection for both, while maintaining two separate definitions, on the understanding that the same substantive provisions would apply to both appellations of origin and geographical indications.

17. The Chair encouraged all participants to submit comments and drafting suggestions to the Secretariat on the electronic forum that had been established for that purpose, while also recalling that such comments and suggestions would be posted for information purposes only and without prejudice to the role of the Working Group and the formal discussions therein.

18. The Chair concluded that, in view of the progress made at the present session, the Working Group agreed that a recommendation be made to the Lisbon Union Assembly to approve, at its session in 2013, the convening of a diplomatic conference for the adoption of a Revised Lisbon Agreement in 2015, with the exact dates and venue to be decided by a preparatory committee meeting. The Chair indicated that, at its session in 2014, the Lisbon Union Assembly would be in a position to note the progress made in the Working Group.

19. The Chair further clarified that the roadmap that would be followed until then would include two further Working Group sessions, one in December 2013 and one in the first half of 2014, which might be followed by an additional session of the Working Group in the second half of 2014 if considered necessary by the Working Group.

20. The Chair noted the wish of the Working Group that the Secretariat should further promote the activities of the Working Group as well as the Draft Revised Lisbon Agreement and its Draft Regulations in order to raise awareness, and to stimulate discussions among the current membership of the Lisbon Union and other WIPO Member States.

**AGENDA ITEM 6: OTHER MATTERS**

21. No interventions were made under this item.

**AGENDA ITEM 7: ADOPTION OF THE SUMMARY BY THE CHAIR**

22. The Working Group approved the Summary by the Chair, as contained in the present document.

23. A draft of the full report of the session of the Working Group will be made available on the WIPO web site for comments by the delegations and representatives that participated in the meeting. Participants will be informed once the draft report is available on the WIPO web site. Participants can submit comments within one month from its publication date, after which a track-changes version of the document, taking into account all the comments received from participants, will be made available on the WIPO web site. The availability of the comments and the track-changes version will also be communicated to participants, together with a deadline for the submission of final comments on that track-changes version. Thereafter, the report, taking into account the final comments, as appropriate, will be published on the WIPO web site without track changes, indicating the date of such final publication. As of that date, the report will be deemed adopted, which will be noted at the next session of the Working Group.

**AGENDA ITEM 8: CLOSING OF THE SESSION**

24. The Chair closed the session on May 3, 2013.

### Article 13

#### Safeguards in Respect of Other Rights

(1) *[Prior Trademark Rights]* Without prejudice to Articles 15 and 19, where a registered appellation of origin or a registered geographical indication conflicts with a prior trademark applied for or registered, or acquired through use, in good faith in a Contracting Party, the protection of that appellation of origin or geographical indication in that Contracting Party shall not prejudice the eligibility for, or the validity of, the registration of the trademark, or the right to use the trademark, [taking into account] [provided that] the legitimate interests of [the owner of the trademark as well as those of] the beneficiaries of the rights in respect of the appellation of origin or the geographical indication [are taken into account] and provided that the public is not misled.

[(2) *[Prior Rights in Respect of Another Appellation of Origin or Geographical Indication]* Without prejudice to Articles 15 and 19, where a registered appellation of origin or a registered geographical indication contains a denomination or indication that is also contained in another appellation of origin or geographical indication already protected in a Contracting Party, that Contracting Party may protect both appellations of origin or geographical indications, [taking into account] [provided that] the legitimate interests of the beneficiaries of either appellation of origin or geographical indication [are taken into account] and provided that the public is not misled.

(3) *[Personal Name Used in Business]* The provisions of this Act shall not 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.

(4) *[Rights Based on [Plant Variety or Animal Breed Denominations, or Trade Names] Used in the Course of Trade]* The provisions of this Act shall not prejudice the right of any person to use [a plant variety or animal breed denomination, or trade name] in the course of trade, in respect of which a right other than those referred to in paragraphs (1) to (3) has been acquired in good faith in a given Contracting Party before the date on which a registered appellation of origin or geographical indication is protected in that Contracting Party, except where such [plant variety or animal breed denomination, or trade name] is used in such a manner as to mislead the public.]

[Annex II follows]



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**LI/WG/DEV/7/INF/1 PROV. 2**  
**ORIGINAL: FRANCAIS/ENGLISH**  
**DATE: 3 MAI 2013 / MAY 3, 2013**

## **Groupe de travail sur le développement du système de Lisbonne (appellations d'origine)**

**Septième session**  
**Genève, 29 avril – 3 mai 2013**

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

**Seventh Session**  
**Geneva, April 29 to May 3, 2013**

**DEUXIEME LISTE PROVISOIRE DES PARTICIPANTS\***  
**SECOND PROVISIONAL LIST OF PARTICIPANTS\***

*établie par le Secrétariat*  
*prepared by the Secretariat*

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\* Les participants sont priés d'informer le Secrétariat, en modifiant la présente liste provisoire, des modifications qui devraient être prises en considération lors de l'établissement de la liste finale des participants.  
4 Participants are requested to inform the Secretariat of any changes which should be taken into account in preparing the final list of participants. Changes should be requested by making corrections on the present provisional list.

I. MEMBRES/MEMBERS

(dans l'ordre alphabétique des noms français des États/in the alphabetical order of the names in French of the States)

ALGÉRIE/ALGERIA

Ahlem CHARIKHI (Mme), attachée, Mission permanente, Genève

COSTA RICA

Luís PAL, Director, Junta Administrativa, Registro Nacional de Costa Rica, Ministerio de Justicia y Paz, San José

FRANCE

Véronique FOUKS (Mme), chef du Service juridique et international, Institut national de l'origine et de la qualité (INAO), Paris

GÉORGIE/GEORGIA

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HONGRIE/HUNGARY

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Imre GONDA, Deputy Head, Trademark, Model and Design Department, Hungarian Intellectual Property Office (HIPO), Budapest

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Behzad SABERI, Acting Head, Private International Law Division, Ministry of Foreign Affairs, Tehran

Nabiollah AZAMI SARDOUEL, First Secretary, Permanent Mission, Geneva

ITALIE/ITALY

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PÉROU/PERU

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PORTUGAL

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RÉPUBLIQUE DE MOLDOVA/REPUBLIC OF MOLDOVA

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Jan WALTER, Third Secretary, Permanent Mission, Geneva

SERBIE/SERBIA

Mirela BOŠKOVIĆ (Ms.), Assistant Director, Trademark Sector, Intellectual Property Office, Belgrade

II. ÉTATS OBSERVATEURS/OBSERVER STATES

ALLEMAGNE/GERMANY

Pamela WILLE (Ms.), Counsellor, Permanent Mission, Geneva

AUSTRALIE/AUSTRALIA

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Mark Jason HUBER, Intern, Permanent Mission to the World Trade Organization (WTO), Geneva

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Charlemagne DEDEWANOU, attaché, Mission permanente, Genève

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BRUNÉI DARUSSALAM/BRUNEI DARUSSALAM

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COLOMBIE/COLOMBIA

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Eduardo MUÑOZ GÓMEZ, Embajador, Representante Permanente, Misión Permanente ante la Organización Mundial del Comercio (OMC), Ginebra

Juan Camilo SARETZKI, Consejero, Misión Permanente, Ginebra

ÉTATS-UNIS D'AMÉRIQUE/UNITED STATES OF AMERICA

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FÉDÉRATION DE RUSSIE/RUSSIAN FEDERATION

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R. Syaifullah HADIYANTO, Trademarks Examiner, Directorate of Trademarks, Directorate General of Intellectual Property Rights, Ministry of Law and Human Rights, Jakarta

IRAQ

Abbas AL ASADI, Director General, Legal Directorate, Trademark Registrar, Ministry of Industry and Minerals, Baghdad

Thanaa AL NAEB (Mrs.), Head, Trademark Department, Ministry of Industry and Minerals, Baghdad

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Marija MARKOVA (Mrs.), Attaché, Permanent Mission, Geneva

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Haja Nirina RASOANAIVO, conseiller, Mission permanente, Genève

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Lynn Marlar LWIN (Ms.), First Secretary, Permanent Mission, Geneva

Mya SANDAR (Ms.), Attaché, Permanent Mission, Geneva

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PAKISTAN

Ahsan NABEEL, Second Secretary, Permanent Mission, Geneva

RÉPUBLIQUE DE CORÉE/REPUBLIC OF KOREA

Shi-Hyeong KIM, Attaché, Intellectual Property Department, Permanent Mission, Geneva

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ROUMANIE/ROMANIA

Liviu BULGĂR, Director, Legal and International Affairs Department, State Office for Inventions and Trademarks (OSIM), Bucharest

Liliana DRAGNEA (Ms.), Legal Advisor, Legal and International Affairs Department, State Office for Inventions and Trademarks (OSIM), Bucharest

SOUDAN/SUDAN

Osman MOHAMMED, Counsellor, Permanent Mission, Geneva

SUISSE/SWITZERLAND

Alexandra GRAZIOLI (Mme), conseiller, Mission permanente, Genève

THAÏLANDE/THAILAND

Voravut POSAGANONDH, Director, Legal Affairs Bureau, Intellectual Property Department, Ministry of Commerce, Nonthaburi

VENEZUELA (RÉPUBLIQUE BOLIVARIENNE DU)/VENEZUELA (BOLIVARIAN REPUBLIC OF)

Oswaldo REQUES OLIVEROS, Primer Secretario, Misión Permanente, Ginebra

III. ORGANISATIONS INTERNATIONALES INTERGOUVERNEMENTALES/  
INTERNATIONAL INTERGOVERNMENTAL ORGANIZATIONS

ORGANISATION MONDIALE DU COMMERCE (OMC)/WORLD TRADE  
ORGANIZATION (WTO)

Thu-Lang TRAN WASESCHA (Mrs.), Counsellor, Intellectual Property Division, Geneva

Wolf MEIER-EWERT, Counsellor, Intellectual Property Division, Geneva

UNION EUROPÉENNE (UE)/EUROPEAN UNION (EU)

Delphine LIDA (Mrs.), Counsellor, Permanent Delegation, Geneva

Óscar MONDÉJAR, Legal Advisor, International Cooperation and Legal Affairs Department,  
Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), Alicante

Nicolas PULIK, Intern, Permanent Delegation, Geneva

IV. ORGANISATIONS INTERNATIONALES NON GOUVERNEMENTALES/  
INTERNATIONAL NON-GOVERNMENTAL ORGANIZATIONS

Association brésilienne de la propriété intellectuelle (ABPI)/Brazilian Association of Intellectual  
Property (ABPI)

Carlos Henrique de Carvalho FRÓES, Counsellor, Rio de Janeiro

Association communautaire du droit des marques (ECTA)/European Communities Trade Mark  
Association (ECTA)

Michele ELIO DE TULLIO, Member, ECTA Geographical Indications Committee, Rome

Association des propriétaires européens de marques de commerce (MARQUES)/Association of  
European Trademark Owners (MARQUES)

Miguel Ángel MEDINA, Chair, MARQUES Geographical Indications Team, Madrid

Ortrun GÜNZEL (Mrs.), Member, MARQUES Geographical Indications Team, Munich

Sébastien VITALI, Member, MARQUES Geographical Indications Team, Vevey

Association internationale pour la protection de la propriété intellectuelle (AIPPI)/International  
Association for the Protection of Intellectual Property (AIPPI)

Volker SCHOENE, Member of Q220, Geographical Indications, Zurich

Centre d'études internationales de la propriété intellectuelle (CEIPI)/Centre for International  
Intellectual Property Studies (CEIPI)

François CURCHOD, chargé de mission, Genolier

Health and Environment Program (HEP)

Pierre SCHERB, Member, Geneva

Madeleine SCHERB (Mrs.), Member, Yaoundé

International Trademark Association (INTA)

Bruno MACHADO, Geneva Representative, Rolle  
Constanze SCHULTE (Mrs.), Member, INTA Geographical Indications Subcommittee, Madrid

Organisation pour un réseau international des indications géographiques (oriGIn)/Organization for an International Geographical Indications Network (oriGIn)

Massimo VITTORI, Managing Director, Geneva  
Ida PUZONE (Mrs.), Project Manager, Geneva  
Daniela LIZARZABURU (Ms.), Consultant, Geneva

V. BUREAU/OFFICERS

Président/Chair: Mihály FICSOR (Hongrie/Hungary)

Vice-présidents/Vice-chairs: Behzad SABERI (Iran (République islamique d’)/Iran (Islamic Republic of))  
Miguel ALEMÁN URTEAGA (Pérou/Peru)

Secrétaire/Secretary: Matthijs GEUZE (OMPI/WIPO)

VI. SECRÉTARIAT DE L’ORGANISATION MONDIALE DE LA PROPRIÉTÉ INTELLECTUELLE (OMPI)/SECRETARIAT OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)

Francis GURRY, directeur général/Director General

WANG Binying (Mme/Mrs.), vice-directrice générale/Deputy Director General

Matthijs GEUZE, chef du Service d’enregistrement Lisbonne, Secteur des marques et des dessins et modèles/Head, Lisbon Registry, Brands and Designs Sector

Florence ROJAL (Mlle/Miss), juriste, Service d’enregistrement Lisbonne, Secteur des marques et des dessins et modèles/Legal Officer, Lisbon Registry, Brands and Designs Sector

[Annex III follows]

May 1, 2013

Non-Paper from the Secretariat

**Article 13**

Safeguards in Respect of Other Rights

(1) *[Prior Trademark Rights]* Subject to Articles 15 and 19, where a denomination constituting a registered appellation of origin, or an indication constituting a registered geographical indication, conflicts with a right in a trademark applied for or registered, or acquired through use, in good faith in a Contracting Party before the date on which a registered appellation of origin or geographical indication is protected in that Contracting Party, the protection of that appellation of origin or geographical indication in the Contracting Party shall be without prejudice to the eligibility for, or the validity of, the registration of the trademark, or the right to use the trademark, taking into account the legitimate interests of the owner of the prior trademark as well as those of the beneficiaries of the rights in the appellation of origin or the geographical indication.

[(2) *[Prior Rights in Respect of Another Appellation of Origin or Geographical Indication]* The provisions of paragraph (1) shall apply *mutatis mutandis* where a denomination constituting a registered appellation of origin, or an indication constituting a registered geographical indication, conflicts with a prior right in another appellation of origin or geographical indication.]

(3) *[Personal Name Used in Business]* The provisions of this Act 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.

(4) *[Rights Based on Other Terms or Names Used in the Course of Trade]* The provisions of this Act shall in no way prejudice the right of any person to use [a term or name] [a plant variety denomination or trade name] in the course of trade, in respect of which a right other than those referred to in paragraphs (1) to (3) has been acquired in good faith in a given Contracting Party before the date on which a registered appellation of origin or geographical indication is protected in that Contracting Party, except where such term or name is used in such a manner as to mislead the public.

[Annex IV follows]

May 2, 2013

Non-Paper from the Secretariat

**Article 13**

Safeguards in Respect of Other Rights

(1) *[Prior Trademark Rights]* Without prejudice to Articles 15 and 19, where a registered appellation of origin, or a registered geographical indication, conflicts with a prior trademark applied for or registered, or acquired through use, in good faith in a Contracting Party, the protection of that appellation of origin or geographical indication in that Contracting Party shall not prejudice the eligibility for, or the validity of, the registration of the trademark, or the right to use the trademark, [taking into account] [provided that] the legitimate interests of the owner of the trademark as well as those of the beneficiaries of the rights in respect of the appellation of origin or the geographical indication [are taken into account] and provided that the public is not misled.

[(2) *[Prior Rights in Respect of Another Appellation of Origin or Geographical Indication]* Without prejudice to Articles 15 and 19, where a registered appellation of origin or a registered geographical indication contains a denomination or indication that is also contained in another appellation of origin or geographical indication already protected in a Contracting Party, that Contracting Party may protect both appellations of origin or geographical indications, [taking into account] [provided that] the legitimate interests of the beneficiaries of either appellation of origin or geographical indication [are taken into account] and provided that the public is not misled.

(3) *[Personal Name Used in Business]* The provisions of this Act shall not 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.

(4) *[Rights Based on [Plant Variety Denominations or Trade Names] Used in the Course of Trade]* The provisions of this Act shall not prejudice the right of any person to use [a plant variety denomination or trade name] in the course of trade, in respect of which a right other than those referred to in paragraphs (1) to (3) has been acquired in good faith in a given Contracting Party before the date on which a registered appellation of origin or geographical indication is protected in that Contracting Party, except where such [plant variety denomination or trade name] is used in such a manner as to mislead the public.]

[End of Annex IV and of document]