

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

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NOTES ON THE DRAFT REVISED LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS

Document prepared by the Secretariat

1. The Annex of the present document contains Notes on the Draft Revised Lisbon Agreement on Appellations of Origin and Geographical Indications, as contained in document LI/WG/DEV/8/2. Where a provision appears not to require explanation, no note has been provided.

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NOTES ON THE DRAFT REVISED LISBON AGREEMENT

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NOTES ON ARTICLE 1: ABBREVIATED EXPRESSIONS

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

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

1.03 Item (xi) concerns the geographical area where the good designated by the appellation of origin or identified by the geographical indication originates.

1.04 Item (xii): in respect of a good from a geographical area of origin situated in, or covering, more than one Contracting Party, reference is made to Article 2(2), second sentence.

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

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

1.07 Item (xv): the term “Competent Authority” also applies to the authority jointly designated by two or more Contracting Parties in each of which parts of a geographical area of origin are situated – see Article 5(4)(a)(ii) –, if such Contracting Parties have established an appellation of origin or geographical indication jointly in respect of a good originating in a trans-border geographical area of origin, as referred to in Article 2(2), second sentence.

1.08 Item (xvi) defines the term “beneficiary”, following the concerns expressed in paragraph 199, fourth sentence, of the Report of the sixth session of the Working Group (LI/WG/DEV/6/7).

1.09 Item (xviii): as the Revised Lisbon Agreement would be open to certain types of intergovernmental organizations, the accession criteria for intergovernmental organizations have been set out in Article 28(1)(iii).

NOTES ON ARTICLE 2: SUBJECT-MATTER

2.01 The subject-matter to which the Revised Lisbon Agreement would apply, as drafted, namely appellations of origin and geographical indications, is defined in several different ways under national and regional laws. Moreover, these laws do not all identify the subject-matter by the terms appellation of origin and geographical indication. Article 2(1)(a) would establish common denominators for these titles of protection, while taking account of these differences. The provision does this on the basis of the definitions of Article 2 of the Lisbon Agreement and Article 22.1 of the TRIPS Agreement. The prerequisite “protection in the Contracting Party of Origin” is based on Article 1(2) of the Lisbon Agreement.

2.02 In order to accommodate those who have expressed a need to provide some leeway in respect of the cumulative requirements “natural and human factors” in the definition of an appellation of origin, footnote 1 has been introduced in the Draft Revised Lisbon Agreement.

2.03 The phrases “or another denomination known as referring to such area” and “or another indication known as referring to such area” concern denominations and indications that are strictly speaking not geographical, but which have obtained a geographical connotation. Such possibility also exists under the Lisbon Agreement, as confirmed by the Lisbon Union Council in 1970 (see the document entitled “Problems Arising from the Practical Application of the Lisbon Agreement” (AO/V/5 of July 1970) and the Report of the fifth session of the Lisbon Union Council (document AO/V/8 of September 1970)).

2.04 The term “good” has been used throughout the English version of the Revised Lisbon Agreement, notably in Articles 2, 5 and 10, to align the terminology used there under with the one contained in the TRIPS Agreement.

2.05 Following the concern expressed by several delegations at the fifth session of the Lisbon Working Group as regards the geographical coverage of the notion of “geographical area of origin”, paragraph (2) makes it clear that the geographical area in question may consist of the entire territory of a Contracting Party or a region, locality or place in such territory. In addition, the second sentence of paragraph (2) specifies that appellations of origin or geographical indications for goods originating in trans-border areas could also be the subject of international registrations under the Revised Lisbon Agreement, without requiring Contracting Parties concerned, however, to establish such appellations of origin or geographical indications jointly. In this regard, see further Note 5.03.

2.06 At the seventh session of the Working Group, it was proposed that an interpretative statement might be adopted at the Diplomatic Conference where the Revised Lisbon Agreement would be concluded, indicating that “*notoriété*” and “*réputation*”, in the French version of the Agreement, and “*notoriedad*” and “*reputación*”, in the Spanish version of the Agreement, should be considered synonyms for the purposes of the Revised Lisbon Agreement.

NOTES ON ARTICLE 3: COMPETENT AUTHORITY

3.01 As the competence for granting or registering rights in appellations of origin or geographical indications varies among national and regional systems for their protection, it is important for the Revised Lisbon Agreement to require each Contracting Party to designate an entity responsible for the administration of the Agreement in its territory and for communications with the International Bureau under the procedures of the Revised Lisbon Agreement and its

Regulations. Rule 4 of the Draft Regulations would require each Contracting Party to notify the name and contact details of the designated entity upon accession to the Revised Lisbon Agreement.

3.02 Although it is preferable that a Contracting Party designates a single Competent Authority, there may be reasons for a Contracting Party to designate more than one, as indicated in Rule 4(2). In such a case, the International Bureau may face difficulties in determining to which of these Competent Authorities it should communicate a given notification. Rule 4(2) would therefore require the Contracting Party to provide clear indications in that respect. Failing such clarity, the International Bureau will be obliged to send its notifications to all the Competent Authorities the Contracting Party may have designated and leave it to them to determine which of them is responsible in respect of a given notification. By the same token, the International Bureau would be obliged to accept an application from such Contracting Party irrespective of which of the Competent Authorities presents it.

3.03 Following the discussion at the seventh session of the Working Group, a second sentence was added to Rule 4(1), for the benefit of the necessary transparency in regard to the applicable enforcement procedures in a Contracting Party in respect of appellations of origin and geographical indications.

NOTES ON ARTICLE 4: INTERNATIONAL REGISTER

4.01 Article 4 would make it clear that the International Register of the Revised Lisbon Agreement, to be kept by the International Bureau, would not only incorporate the registrations effected under the Revised Lisbon Agreement, but also the registrations effected under the Lisbon Agreement. Rule 7 elaborates on this.

NOTES ON ARTICLE 5: APPLICATION

5.01 Article 5(2) and Article 5(3) determine that international applications are to be presented to the International Bureau and are filed in the name of the beneficiaries of the appellation of origin or geographical indication in question. As regards the entitlement to present an international application, reference is made to Note 1.06. The text of Article 5(2)(ii) emerged from the discussions at the fifth and sixth sessions of the Working Group¹. Following the discussions at the seventh session of the Working Group, the term “legal entity” will not be defined in the Revised Lisbon Agreement. However, the term should be understood broadly and cover, in any event, legal entities having legal standing to assert rights in a given appellation of origin or geographical indication, such as federations and associations representing holders of a right to use the appellation of origin or geographical indication. The phrase “or other rights in the appellation of origin or geographical indication” aims to make it clear that the term “legal entity” also extends to holders of certification marks or collective marks.

5.02 Article 5(3) is an optional provision. It allows Contracting Parties who so desire to permit international applications to be presented directly to the International Bureau by natural persons or legal entities, as referred to in Article 5(2), as an alternative to submission by the Competent Authority. This option was included in view of the conclusion of the Chair of the Working Group, as reflected in of paragraph 176, final sentence, of the Report of the second

¹ See, in particular, document LI/WG/DEV/5/7, paragraphs 168 and following, as well as document LI/WG/DEV/6/7, paragraphs 199, 211 and 220.

session of the Working Group (document LI/WG/DEV/2/5) concerning a suggestion made in response to the Survey on the Lisbon System. In light of the various comments made at the third, fourth and fifth sessions of the Working Group, as regards the requirement of proof of protection in the Contracting Party of Origin, the current text would require that such direct international applications also simply be subject to the provisions in the Regulations concerning mandatory and optional particulars. Following the discussions at the seventh session of the Working Group, paragraph (3)(b) was added, making the application of paragraph (3)(a) subject to the deposit by a Contracting Party of a declaration indicating that it permits direct applications by the beneficiaries.

5.03 Appellations of origin or geographical indications for goods originating in trans-border geographical areas could also be the subject of international registrations under the Revised Lisbon Agreement, without the adjacent Contracting Parties concerned being required to establish such appellations of origin or geographical indications jointly. Article 5(4)(a) and (b) lists the three possibilities for applications in respect of such appellations of origin. Article 5(4)(a)(i) makes it clear that each Contracting Party may file an individual separate application only for the part of the trans-border area situated in its territory, and not for the entire trans-border area. The same applies under Article 5(4)(b) in respect of direct applications by the beneficiaries, subject to the adjacent Contracting Parties having deposited jointly the declaration referred to in Article 5(3)(b). Article 5(4)(a)(ii) is applicable if the adjacent Contracting Parties have established the appellation of origin or geographical indication jointly and would require them to designate a common Competent Authority for the appellation of origin or geographical indication concerned.

5.04 Article 5(5) makes a distinction between two types of mandatory particulars in respect of international applications, namely the particulars that are necessary for the application to obtain a filing date (see Article 6(3)) and other mandatory requirements (see Rule 5(2)).

NOTES ON ARTICLE 6: INTERNATIONAL REGISTRATION

6.01 The provisions presented in Article 6 are based on the premise that an internationally registered appellation of origin or geographical indication, in order to be protectable in all Contracting Parties, should, at least, meet the definition requirements of Article 2(1).

NOTES ON ARTICLE 7: FEES

7.01 The Articles of the Draft Revised Lisbon Agreement have been divided over seven different Chapters, for ease of reference. For the sake of consistency and to make the proposed Chapter II concerning the application and the international registration as complete as possible, a stand-alone article concerning the registration fee and other fees to be paid has been included as Article 7. As far as the nature and the amount of such fees are concerned, reference is made to Rule 8, as well as to Article 24(4)(a) and (b).

7.02 Following the views expressed by several delegations at the fifth and sixth session of the Working Group (paragraphs 207-209 of document LI/WG/DEV/5/7, and paragraphs 200, 213-217, 221-226 of document LI/WG/DEV/6/7), a new paragraph (3) has been introduced in the Draft Revised Lisbon Agreement which provides that reduced fees may be established for certain international registrations, in particular for those from developing countries or least-developed countries. Such fee reductions can be established by virtue of a decision of the Assembly amending Rule 8.

NOTES ON ARTICLE 8: COMMITMENT TO PROTECT

8.01 Article 8(1) establishes an obligation for Contracting Parties to protect registered appellations of origin or geographical indications along the lines of Article 1(2) of the Lisbon Agreement, unless protection has been renounced in respect of a given Contracting Party or the Contracting Party has submitted a refusal declaration or the effects of a given international registration have been invalidated by a court in the Contracting Party and this invalidation is no longer subject to appeal.

8.02 In respect of the phrase “within its own legal system and practice but in accordance with the terms of this Act”, reference is made to Note 2.01. In addition, the phrase aims to clarify that, for example, any possible limitation to the enforcement of rights in a geographical indication or appellation of origin due to acquiescence will be subject to the national or regional law of the Contracting Party concerned.

NOTES ON ARTICLE 9: PROTECTION UNDER LAWS OF CONTRACTING PARTIES AND OTHER INSTRUMENTS

9.01 The provisions of Article 9 confirm that the Revised Lisbon Agreement, which would stipulate the level of protection to be accorded in respect of appellations of origin and geographical indications, would not itself be an obstacle to the possibility for Contracting Parties to establish more extensive protection than required under the Revised Lisbon Agreement. Obviously, such other protection should not diminish or interfere with the enjoyment of the rights afforded by the Revised Lisbon Agreement. Moreover, international registration would not prejudice any other protection that the appellation of origin or geographical indication in question may benefit from in a Contracting Party. Reference is also made to Article 15(2) in this regard.

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

9.03 The provisions of paragraph (3) establish a safeguard clause in respect of other forms of protection that may be available in a Contracting Party than the protection to be accorded under the Revised Lisbon Agreement. In light of the discussions which took place at the sixth session of the Working Group, paragraph (3) now uses the terms “the protection stipulated in this Act” instead of the former “protection established under this Act” (see paragraph 183 of the Report of the sixth session of the Working Group contained in document LI/WG/DEV/6/7). Reference is also made to Article 15(2) in this regard.

NOTES ON ARTICLE 10: PROTECTION ACCORDED BY INTERNATIONAL REGISTRATION

10.01 As regards the phrase “from the date of international registration” in paragraph (1)(a), attention is drawn to current Rule 8(3) of the Lisbon Regulations, which provides for protection from the date of international registration, subject to the right of a Lisbon member State to declare in a notification addressed to the Director General that, under its national legislation, a later date applies, as specified in the declaration, provided that that date is not later than the expiry date of the period within which a refusal can be validly submitted in respect of a given international registration. To date, no Lisbon Member State has submitted such a notification.

10.02 At its sixth session, the Working Group agreed on the basic approach in respect of Article 10(1)(a). At the seventh session of the Working Group, the text was further refined. As a result, the bracketed phrase "[which would amount to its usurpation or imitation [or evocation]]" has been separated from the first indent of Article 10(1)(a) and is now presented as a new second indent – still bracketed, as the terms "usurpation or imitation" and "evocation" do not belong to the usual legal terminology of several countries. Moreover, in the final part of Article 10(1)(a), a phrase has been added in order to clarify that, when the appellation of origin or geographical indication is not reproduced in exactly the same way, such use is also covered by the provisions of Article 10(1)(a), if the differences are immaterial.

10.03 The purpose of Article 10(1)(b) is to prevent the registration of trademarks that consist of or contain an appellation of origin or a geographical indication by someone not authorized to use the appellation of origin or geographical indication. However, such registrations of trademarks containing an appellation of origin or geographical indication by someone who is authorized to use the appellation of origin or the geographical indication would be acceptable, unless the person in question does so in a way that conflicts with any of the provisions of Article 10(1)(a). In Contracting Parties that protect appellations of origin or geographical indications through trademark legislation, the appellation of origin or geographical indication will by definition be incorporated in a trademark. Moreover, holders of the right to use an appellation of origin or a geographical indication may own a trademark that contains the appellation of origin or the geographical indication as part of the trademark.

10.04 The relevant provisions of the TRIPS Agreement provide as follows:

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

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

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

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

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

(iv) Article 17 of the TRIPS Agreement would appear to allow WTO members to provide, similarly, 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.

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

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

10.05 The issue of prior trademark rights is addressed in Article 13(1).

10.06 Following the discussions at the seventh session of the Working Group, Article 10 no longer contains provisions explicitly dealing with homonymous appellations of origin and geographical indications. A footnote has been added to Article 10 explaining that the existing practice under the Lisbon Agreement in respect of homonymous appellations of origin would be continued in respect of international registrations under the Revised Lisbon Agreement.

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

11.01 At its sixth session, the Working Group agreed on the basic approach in respect of Article 11. The square brackets around “[be considered to have]” reflect the difference of view as to whether the wording of Article 6 of the Lisbon Agreement should be used or more straightforward wording.

11.02 The footnote defines the term “generic” along the lines of the provisions of Article 24.6 of the TRIPS Agreement.

NOTES ON ARTICLE 12: DURATION OF PROTECTION

12.01 Article 2(1)(a) specifies, inter alia, that international registrations effected under the Revised Lisbon Agreement are dependent upon the protection of the appellation of origin or geographical indication in its Contracting Party of Origin. In view of the discussions at the seventh session of the Working Group, the draft Revised Lisbon Agreement, unlike the current Lisbon Agreement, does not preclude the application of renewal fees. As a result, these could be established by the Assembly under Article 22(2)(a)(iii), by virtue of an amendment of Rule 8.

NOTES ON ARTICLE 13: SAFEGUARDS IN RESPECT OF OTHER LEGITIMATE RIGHTS

13.01 In view of the discussion at the sixth and seventh session of the Working Group on Article 13, Article 13 of the present Draft Revised Lisbon Agreement specifies how the provisions of the TRIPS Agreement in respect of prior trademark rights and other legitimate rights would apply under the Revised Lisbon Agreement.

13.02 The relevant provisions of the TRIPS Agreement in respect of prior trademark rights are contained in Articles 17 and 24.5 of the Agreement. Article 24.5 of the TRIPS Agreement lays down an exception to the rights accorded to a geographical indication, by stipulating: “Where a trademark has been applied for or registered in good faith, or where rights have been acquired through use in good faith either:

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

(b) before the geographical indication is protected in its country of origin; measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication". Article 17 of the TRIPS Agreement provides for 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. According to the WTO Panel Reports on the disputes initiated by Australia and the United States of America, respectively, against the European Union concerning EC Regulation 2081/92, the coexistence provisions in respect of, on the one hand, protected appellations of origin and geographical indications and, on the other hand, prior trademarks can be regarded as such limited exceptions.

13.03 Article 13(2) deals with the situation of appellations of origin and geographical indications that contain overlapping denominations or indications, for example, the appellations of origin "*Porto*" for a generous wine (liqueur wine) from Porto in Portugal and "*Porto Vecchio*" for wines from Porto Vecchio on the French island of Corsica.

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

13.05 Article 13(3) is based on Article 24.8 of the TRIPS Agreement: "The provisions of this Section shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public".

13.06 Article 13(4) does not specify all legitimate prior rights. Such rights may include trade names, plant variety denominations, etc. Under Article 24.4, WTO members are not required to prevent continued and similar use of a particular geographical indication of another WTO member identifying wines or spirits in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that Member either (a) for at least 10 years preceding 15 April 1994 or (b) in good faith preceding that date.

NOTES ON ARTICLE 14: LEGAL REMEDIES AND LEGAL PROCEEDINGS

14.01 Article 14 is based on the provisions contained in Article 8 of the Lisbon Agreement. This article has been slightly re-worded to take into account the concerns expressed by some delegations at the sixth session of the Working Group (in particular, paragraphs 97 and 163 of the Report contained in document LI/WG/DEV/6/7). This provision would simply require national or regional legislation to provide for and make available effective legal remedies and legal proceedings for the protection and enforcement of internationally-registered appellations of origin and geographical indications. The word "legal" is not meant to exclude the application of administrative measures.

NOTES ON ARTICLE 15: REFUSAL

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

15.02 As suggested during the fourth session of the Working Group, time limits are now specified in the Regulations, so that modifications can be adopted by the Assembly of the Special Union and would not require a Diplomatic Conference, as would be the case if time limits were specified in the Draft Revised Lisbon Agreement itself. The provision is a redrafted version of Article 5(5) of the Lisbon Agreement.

15.03 In respect of paragraph (5), the Working Group might wish to address the question as to whether the provision should also specify that interested parties affected by refusal would, alternatively, have the opportunity to resort to arbitration or mediation. Following the discussions at the seventh session of the Working Group, the time-limit of “one year” has been put between square brackets.

NOTES ON ARTICLE 16: WITHDRAWAL OF REFUSAL

16.01 The possibility to negotiate the withdrawal of a refusal is explicitly mentioned in paragraph (2). As mentioned in the Acts of the 1958 Diplomatic Conference where the Lisbon Agreement was concluded, “the procedure envisaged provides countries, which receive the notification of an appellation of origin via the International Bureau, with the possibility to oppose any situation that exists *de facto* or *de jure* that would prevent protection being granted on all or part of the territory of the restricted Union. The period of one year from the time the notification is received is easily sufficient to allow such opposition. A refusal must be accompanied by the grounds on which the country decides not to grant protection. These grounds constitute a possible basis for discussion for the purpose of reaching an understanding²”.

16.02 The term “interested parties” refers to the same persons referred to in Article 15(5). The term also appears in Articles 22 and 23 of the TRIPS Agreement.

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

² Unofficial translation of the official French text.

NOTES ON ARTICLE 17: PRIOR USE

17.01 Unlike Article 5(6) of the Lisbon Agreement, Article 17 of the Draft Revised Lisbon Agreement limits the provisions allowing Contracting Parties to provide for adaptation periods, in connection with the termination of prior use, to prior use as a generic term or name of a registered appellation of origin or geographical indication. The footnote to Article 11 defines the term “generic”.

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

17.03 In view of the safeguards under Article 13 in respect of legitimate prior rights, the Draft Revised Lisbon Agreement does not contain phasing out periods in respect of prior uses under such rights, except to the extent that such prior rights incorporate a registered appellation of origin or geographical indication as a generic term or name, as specified in the footnote to Article 17.

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

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

NOTES ON ARTICLE 18: NOTIFICATION OF GRANT OF PROTECTION

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

NOTES ON ARTICLE 19: INVALIDATION

19.01 Article 19 deals with invalidation of the effects of an international registration in a given Contracting Party. In view of the discussion at the sixth session of the Working Group, it is now proposed that no limitation applies as to the grounds on the basis of which invalidation can be pronounced. Instead, a requirement is introduced, that the grounds on the basis of which invalidation can be pronounced must include the existence of a prior right.

19.02 Before an invalidation is pronounced, the natural persons and legal entities referred to in Article 5(2)(ii) of the Draft Revised Lisbon Agreement must have been granted an opportunity to defend their rights, which in turn implies that they must first be informed that their registration is being challenged in a given Contracting Party.

19.03 As regards Article 19(4), please refer to Article 15(2).

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

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

NOTES ON ARTICLE 21: MEMBERSHIP OF THE LISBON UNION

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

NOTES ON ARTICLE 22: ASSEMBLY OF THE SPECIAL UNION

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

NOTES ON ARTICLE 23: INTERNATIONAL BUREAU

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

NOTES ON ARTICLE 24: FINANCES

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

NOTES ON ARTICLE 25: REGULATIONS

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

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

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

NOTES ON ARTICLE 26: REVISION

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

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

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

NOTES ON ARTICLE 28: BECOMING PARTY TO THIS ACT

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

28.02 Upon clarifying that the accession to the Revised Lisbon Agreement is not limited to States party to the Paris Convention, paragraph (1)(ii) lays down the accession criteria in respect of States that are not party to the Paris Convention.

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

NOTES ON ARTICLE 29: EFFECTIVE DATE OF RATIFICATIONS AND ACCESSIONS

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

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

NOTES ON ARTICLE 30: PROHIBITION OF RESERVATIONS

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

NOTES ON ARTICLE 31: APPLICATION OF THE LISBON AGREEMENT

31.01 Paragraph (1) deals with relations between States that are party both to the Revised Lisbon Agreement and the Lisbon Agreement. The principle set out is that the Revised Lisbon Agreement alone applies to the relations between those States. Thus, with respect to persons who derive their right to file an international application from a State bound both by the Revised Lisbon Agreement and the Lisbon Agreement and who wish to obtain protection in other States party both to the Revised Lisbon Agreement and the Lisbon Agreement, only the provisions of the Revised Lisbon Agreement will be applicable.

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

31.03 Reference is also made to Note 28.03.

NOTES ON ARTICLE 32: DENUNCIATION

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

NOTES ON ARTICLE 33: LANGUAGES OF THIS ACT; SIGNATURE

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

NOTES ON ARTICLE 34: DEPOSITARY

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

[End of Annex and of document]