Why and How to use the new Lisbon System (Geneva Act) to Protect your GI abroad?

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Geneva Act: What’s New?

How to Use Lisbon

Q&A
The Geneva Act: What’s New?

Extension to Geographical Indications

Accession of Intergovernmental Organizations (IGOs)

Flexibility on domestic GI systems

Protection

Generics

Safeguards
Extension to GIs

Appellations of Origin

Geographical Indications

Quality & Origin + Reputation

Quality / Reputation & Origin

Lisbon GE Act

TRIPS GE Act
<table>
<thead>
<tr>
<th><strong>Geneva Act: Definitions (Art. 2)</strong></th>
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</thead>
<tbody>
<tr>
<td><strong>AO</strong></td>
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<tr>
<td>Protected <strong>denomination</strong></td>
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<tr>
<td>Referring to a geographical area or <strong>known as doing so</strong></td>
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<tr>
<td>Designating a <strong>good</strong> as originating therein</td>
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<tr>
<td>Quality or characteristics</td>
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<tr>
<td><strong>+ Reputation</strong></td>
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<td>Due to the geographical environment <em>(natural factors and human factors)</em></td>
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<td><strong>GI</strong></td>
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<td><strong>New</strong></td>
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<td>Protected <strong>indication</strong></td>
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<tr>
<td>Referring to a geographical area or <strong>known as doing so</strong></td>
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<tr>
<td>Identifying a good as originating therein</td>
</tr>
<tr>
<td>Quality, <strong>reputation</strong> or other characteristics</td>
</tr>
<tr>
<td><strong>Attributable to its geographical origin</strong></td>
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</tbody>
</table>
Extension to GIs = more products can benefit from the Lisbon System

- Alor Islands Vanilla (Indonesia)
- Luangprabang Silk (Lao PDR)
- Jamdani Saree (Bangladesh)
- Baked Pryaniks (Russian Federation)
- Hojari Luban (Oman)
- Chuao Cocoa Bean (Venezuela)
The potential of GIs

55,800 GI rights were in force in 2019

8,566 geographical indications
Different national means of GI protection allowed (Art. 9 and 10)

- **Sui generis** legislation
- Trademark system (collective/certification marks)
- Administrative systems
- Unfair competition laws
The Geneva Act opens Lisbon to Intergovernmental Organizations

European Union
27 Member States
Acceded on 26/11/2019

African Organization of Intellectual Property (OAPI)
17 Member States

Accession Criteria (Art. 28)
- At least 1 IGO Member must be a member of the Paris Convention
- IGO grants regional titles of protection for GIs
- Declaration that the IGO is authorized to become party to the Geneva Act
Protection (Art. 11)

- **Same kind goods** not originating in the area of origin or not complying with other AO/GI requirements

- **Different kind goods or services** suggesting connection with AO/GI beneficiaries and likely to damage their interests or impairing, diluting or taking unfair advantage of the AO/GI reputation

- **Against any AO/GI imitation**, even if true origin is indicated or AO/GI is translated, or used with delocalizers (ex Greek style)

- **Any other misleading practice** as to the true origin, provenance or nature of the goods
Generics in the Geneva Act

Protection against becoming generic (Art. 12)

Exceptions (Agreed statements, Rule 5.5):

- Prior use as a generic in a Contracting Party is a possible ground for refusal

- If the AO/GI contains a term considered generic in the Contracting Party of Origin, other Members are not obliged to protect such term
Safeguards (Art. 13)

- Prior good faith trademarks
  (applied for/ registered/ acquired through use in good faith)
  (NB: possible coexistence with later AO/GI)

- Personal names, plant variety or animal breed denominations
  (except if used in such a manner as to mislead the public)
Registration Procedure with the Lisbon System
Who triggers the application procedure? *(Art. 5(2))*

- **Beneficiaries:** those having the right to use the AO/GI

- **Natural person or legal entities** having legal standing to assert the rights of the beneficiaries
Application procedure (Art. 5)

- Application filed by the Competent Authority
Application procedure (Art. 5)

- **Direct application** by interested parties
  - subject to a declaration by their Contracting Party
Application procedure (Art. 5)

- Joint Application for trans-border AOs/GIs
Application form

https://www.wipo.int/lisbon/en/forms/
Application procedure: mandatory requirements (Rule 5(2))

- Contracting party of origin
- Competent Authority or applicants
- Beneficiaries or their representatives
- The AO/GI
- The good to which the AO/GI applies
- The geographical area of origin of the good
- Details of the registration, or legislative or administrative provision, or judicial decision, by virtue of which the AO/GI is protected in the Country of Origin
- Registration fee
Application procedure: declaration-based requirements

- Further information on the connection between the characteristics of the AO/GI and its geographical origin (Rule 5(3))
- Signature and/or intention to use (Rule 5(4))
- Payment of an individual fee (Art. 7(4))

Non-compliance with DBR → protection renounced
Application procedure: registration (Art. 6)

- **Formal Examination:**
  - Mandatory requirements
  - Payment of fees

- **Date International registration:** when application is received by the International Bureau

- **Irregular Applications:**
  - Chance to remedy
  - Three months limit
Application procedure: registration

- **Records** the AO/GI in the Lisbon Registry
- **Issues** Certificate of Registration, and
- **Notifies** the AO/GI to Contracting Parties (Rule 7)
Application procedure: registration (Art. 6(5))

- **Protection** in each Contracting Party is granted if:
  - grant of protection is notified
  - no refusal is notified (silence procedure)

- From the date of the international registration
  - or different date as indicated in a declaration
Application procedure: refusal (art. 15)

- Requirements:
  - **Time** → within 12 months
  - **Content** → explain the grounds

- **Notification** *ex officio* or at the request of an interested party
- **Total or partial**
- Judicial or administrative **remedies**
Manage your application

- Withdrawal of Refusal *(Art. 16)*
- Invalidation *(Art. 19)*
- Modification *(Rule 15)*
- Renunciation *(Rule 16)*
- Cancellation *(Rule 17)*
How the Lisbon System works (1)

Stage 1

**Title of Protection in the Contracting Party of Origin (CPO)**

Stage 2

** WIPO **

**WIPO**

**Formal examination;**

**Registers the AO/GI in the International Register and publishes in the Bulletin/Lisbon Express Database.**

**Issues a Certificate of Registration to the CPO and notifies the Registration to the other CPs**

Stage 3

**Protection of the International Registration determined by substantive examination under domestic law, within 12 months**

**Beneficiaries or Users**

**Competent Authority of CPO or direct application**

**Notify International Application based on the title of protection in the CPO**

**Competent Authority of Contracting Party (CP)**

**Competent Authority of Contracting Party (CP)**

**Competent Authority of Contracting Party (CP)**
How the Lisbon System works (2)

Protection of the International Registration determined by substantive examination under domestic law, within 12 months

Stage 3

- Refusal of Protection (total/partial)
  - Withdrawal of Refusal (total/partial) or Grant of Protection
  - Invalidation
    - Renunciation

- Notification of Grant of Protection (optional)
  - Transitional Period (2-15 years)
  - Invalidation
    - Renunciation

- “Silence Procedure” (= Protection)
  - Transitional Period (2-15 years)

WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION
With the Geneva Act, Lisbon is

Extension to GIs = +Accessible
Any means of GI protection = +Flexible
Accession of IGOs = +Global
Protection = +Effective
Individual Fees = +Inclusive
Safeguards = +Modern
Lisbon System website

WIPO | LISBON

Lisbon – The International System of Geographical Indications

Covid-19 update – Important information

The Lisbon System for the International Registration of Geographical Indications offers a means of obtaining protection for a geographical indication in the 30 contracting parties to the Lisbon Agreement through a single registration and one set of fees.

Registrations are published in the official Bulletin and can be searched through the Lisbon Express Database.
WIPO IP PORTAL
Lisbon News

https://www3.wipo.int/newsletters/en/

Email updates

Lisbon News – Information notices, news and updates on developments in the Lisbon System.

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Lisbon System Webinars

Meetings by topic | Webinars

1 - 2 / 2 items

Why and How to use the new Lisbon System (Geneva Act) to Protect your Gi abroad?
March 9, 2021 Virtual (English)
10:00 - 12:00 Geneva time

Online registration

Introduction to Geographical Indications (GIs) and the Benefits of the Lisbon System
February 16, 2021 Virtual (English)
10:00 - 12:00 Geneva time
Questions?

Thank you!

More info
Lisbon Express Database:
www.wipo.int/ipdl/en/search/lisbon/search-struct.jsp

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