



LI/WG/DEV-SYS/3/3 REV.
ORIGINAL: ENGLISH
DATE: OCTOBER 26, 2020

Working Group on the Development of the Lisbon System

Third Session
Geneva, November 2 and 3, 2020

PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION AND THE GENEVA ACT OF THE LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS

Document prepared by the Secretariat

I. INTRODUCTION

1. The present document proposes amendments to the Common Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (hereinafter referred to as “the Lisbon Common Regulations”). More specifically, this proposal aims at complementing the Lisbon Common Regulations with the introduction of a new Rule *2bis*. The proposed amendments are reproduced in the Annex to this document.

2. The COVID-19 pandemic has resulted in a severe disruption for users of the WIPO Global IP Systems. Those disruptions have made it evident that the safeguards provided for under the Lisbon System for the International Registration of Appellations of Origin and Geographical Indications (hereinafter referred to as “the Lisbon System”) and its Common Regulations present a number of deficiencies.

3. To address the above-mentioned deficiencies, the proposed new Rule *2bis* seeks to provide users of the Lisbon System with safeguards analogous to those found in the Regulations under the Patent Cooperation Treaty (hereinafter referred to as “the PCT Regulations”), with respect to the excuse of a delay in meeting time limits, in case of war, revolution, civil disorder, strike, natural calamity or other *force majeure* event, as well as in case of interruption of postal or delivery services and failure of electronic communication systems.
4. Proposals to align the safeguards of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter referred to as “the Madrid Regulations”) to those found in the PCT Regulations have been submitted to the eighteenth session of the Working Group on the Legal Development of the Madrid System for the International Registration of Marks (hereinafter referred to as “the Madrid Working Group”)¹. It is also envisaged to submit a similar proposal of amendments to the Common Regulations Under the 1999 Act and the 1960 Act of the Hague Agreement (hereinafter referred to as “the Hague Common Regulations”) to the ninth session of the Working Group on the Legal Development of the Hague System for the International Registration of Industrial Designs.
5. It is to be noted that this document has been revised to take into account the fact that the Madrid Working Group, at its eighteenth session held in Geneva from October 12 to 16, 2020, recommended to the Madrid Union Assembly the adoption of the proposed amendments to Rule 5 of the Madrid Regulations, as amended by the Madrid Working Group. The proposed new Rule *2bis* of the Lisbon Common Regulations reproduced in the Annex to this document takes into account the updated formulation of Rule 5 of the Madrid Regulations, as recommended by the Madrid Working Group² (updates are highlighted in the text).

II. BACKGROUND

6. In contrast with the measures foreseen in other WIPO Global IP Systems, the legal framework of the Lisbon System provides a relief limited to the case where a time limit expires on a day, which is not a working day for the International Bureau or a Competent Authority under Rule 2(3) of the Lisbon Common Regulations. However, there is no equivalent provision to Rules 82 and *82quater* of PCT Regulations or Rule 5 of the Madrid Regulations and Hague Common Regulations.
7. Rule 82 of the PCT Regulations, as in force from July 1, 1992³, dealt separately with two distinct situations namely, delay or loss of a communication sent through mail or delivery services (Rule 82.1), and interruptions of postal or delivery services due to war, revolution, civil disorder, strike, calamity or other like reason (Rule 82.2).
8. On July 1, 2012, following the experience with the natural catastrophes in Japan, Rule 82.2 of the PCT Regulations was abolished and a new Rule *82quater* entered into force providing that a delay in meeting a time limit to perform an action shall be excused in cases of war, revolution, civil disorder, strike, natural calamity or other like reason⁴. Under Rule *82quater*

¹ See document MM/LD/WG/18/2 Rev. “Proposed Amendments to the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks” (https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_18/mm_ld_wg_18_2.pdf).

² See document MM/LD/WG/18/9 “Summary by the Chair” (https://www.wipo.int/edocs/mdocs/madrid/en/mm_ld_wg_18/mm_ld_wg_18_9.pdf).

³ See document PCT/A/XVIII/2 “Proposed Amendments to the Regulations Under the PCT” (https://www.wipo.int/edocs/mdocs/govbody/en/pct_a_xviii/pct_a_xviii_2.pdf).

⁴ See document PCT/A/42/2 “Proposed Amendments of the PCT Regulations” (https://www.wipo.int/edocs/mdocs/govbody/en/pct_a_42/pct_a_42_2.pdf).

of the PCT Regulations, the party concerned must provide relevant evidence, to the satisfaction of the International Bureau, and take the relevant action no later than six months from the date on which the time limit expired.

9. Rule 82*quater* was introduced in the PCT legal framework in order to provide a general provision allowing the receiving office to excuse delays in meeting PCT time limits due to circumstances beyond the control of the applicant. On July 1, 2016, an amended version of this Rule entered into force specifying a general unavailability of electronic communication services as another reason for excusing a delay in meeting a time limit⁵.

10. In contrast with the former, current Rule 5 of the Madrid Regulations and the Hague Common Regulations⁶, respectively provide that a delay in meeting a time limit for a communication addressed to the International Bureau shall be excused only if it is due to irregularities in postal and delivery services resulting from *force majeure* events. Rules 5(1) and (2) require that the interested party meet certain conditions and provide evidence to the satisfaction of the International Bureau that *force majeure* events caused the interruption of the postal and delivery services. The same applies for communications sent electronically where there is a failure in the electronic communications with the International Bureau, or which affects the locality of the interested party (Rule 5(3)).

III. PROPOSAL

11. It is hereby proposed to introduce a new Rule 2*bis* in the Lisbon Common Regulations, entitled “Excuse of Delay in Meeting Time Limits” to give users of the Lisbon System relief equivalent to that provided for in Rules 82 and 82*quater* of the PCT Regulations and in the proposals for revision of Rule 5 of the Madrid Regulations (see recommendations agreed by the Madrid Working Group on the proposed amendments in paragraph 5 of the present document).

12. The proposed paragraph (1) of new Rule 2*bis* of the Lisbon Common Regulations would introduce the general principle that failure to meet a time limit specified in the Lisbon Common Regulations for performing an action before the International Bureau may be excused where the Competent Authority or, in the case of Article 5(3) of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (hereinafter referred to as “the Geneva Act”), the beneficiaries or the natural person or legal entity referred to in Article 5(2)(ii) of that Act provides evidence, to the satisfaction of the International Bureau, that such failure was due to a *force majeure* event. In addition, paragraph (1) would apply to any action before the International Bureau for which the Lisbon Common Regulations prescribe a time limit, such as, for example, sending a communication, remedying an irregularity or paying a prescribed fee. The proposed new provision would require the submission of evidence in principle. However, the International Bureau could waive the evidential requirement for widely recognized instances of *force majeure*, as it has done in respect of the COVID-19 pandemic.

13. In addition, paragraph (1) of the proposed Rule 2*bis* of the Common Regulations would specify that irregularities in postal, delivery and electronic communication services beyond the control of the Competent Authority or, in the case of Article 5(3) of the Geneva Act, the beneficiaries or the natural person or legal entity referred to in Article 5(2)(ii) of that Act, and preventing the Competent Authority, beneficiaries, natural person or legal entity from meeting a time limit are

⁵ See document PCT/A/47/4 “Proposed Amendments to the PCT Regulations” (https://www.wipo.int/edocs/mdocs/govbody/en/pct_a_47/pct_a_47_4_rev.pdf).

⁶ As in force, respectively, from February 1, 2020 (see document MM/A/52/2; https://www.wipo.int/edocs/mdocs/govbody/en/mm_a_52/mm_a_52_2.pdf) and January 1, 2017 (see document H/A/36/1; https://www.wipo.int/edocs/mdocs/govbody/en/h_a_36/h_a_36_1.pdf).

deemed *force majeure* events. Paragraph (1) would apply regardless of the place in which the said irregularities occur. It could apply, for example, during disruptions in global postal, delivery or electronic communication services.

14. Proposed Rule 2*bis* would be helpful for users of the Lisbon System who are faced with any *force majeure* situation preventing them from taking the required action within the specified time limit. During the previous decade, the proposed new Rule could have been invoked, for example, in relation to the eruption of the Eyjafjallajökull volcano in 2010; the earthquake and tsunami in Japan, in 2011; the northern Italy earthquakes and hurricane Sandy, in 2012; the typhoons Hagupit, in 2014; and, hurricane María, in 2017.

15. Finally, paragraph (2) of the proposed Rule 2*bis* of the Lisbon Common Regulations would require that the action be performed and the evidence be submitted as soon as reasonably possible and not later than six months from the expiry of the time limit concerned.

IV. DATE OF ENTRY INTO FORCE

16. As indicated earlier, the COVID-19 pandemic has resulted in severe disruptions for users of the WIPO Global IP Systems that are likely to continue for some time in several regions of the world. At the time this document was drafted, numerous countries still had measures in place to protect the population from the effects of the pandemic; other countries were lifting restrictions, but continued to face a possible second wave of infections and the reintroduction of such restrictions.

17. In view of the foregoing, there is a need for the proposed amendments to enter into force without delay, with a view to protecting the interests of the users of the Lisbon System. Therefore, it is suggested that the Working Group recommend to the Lisbon Union Assembly that the proposed new Rule 2*bis* enter into force two months following its adoption.

18. *The Working Group is invited to:*

(i) consider and comment on the proposals made in this document; and

*(ii) recommend to the Assembly of the Lisbon Union the adoption of the proposed amendments to the Common Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications with respect to the inclusion of a new Rule 2*bis*, as presented in the Annex to this document*

*or in amended form, for their
entry into force two months
following their adoption.*

[Annex follows]

Common Regulations
Under the Lisbon Agreement for the Protection of Appellations of Origin and
Their International Registration and the Geneva Act of the Lisbon Agreement on
Appellations of Origin and Geographical Indications

(as in force...)

[...]

CHAPTER I
Introductory and General Provisions

[...]

Rule 2bis
Excuse of Delay in Meeting Time Limits

(1) [~~Excuse in Delay in Meeting Time Limits due to Force Majeure Reasons~~ War, Revolution, Civil Disorder, Strike, Natural Calamity or Other Force Majeure Reason] Failure by a Competent Authority or, in the case of Article 5(3) of the Geneva Act, beneficiaries or a natural person or legal entity referred to in Article 5(2)(ii) of that Act to meet a time limit specified in the Regulations to perform an action before the International Bureau shall be excused if the Competent Authority or, in the case of Article 5(3) of the Geneva Act, the beneficiaries or the natural person or legal entity referred to in Article 5(2)(ii) of that Act submits evidence showing, to the satisfaction of the International Bureau, that such failure was due to war, revolution, civil disorder, strike, natural calamity, irregularities in postal, delivery or electronic communication services owing to circumstances beyond the control of a Competent Authority or, in the case of Article 5(3) of the Geneva Act, beneficiaries or a natural person or legal entity referred to in Article 5(2)(ii) of that Act or other *force majeure* reason.

~~(2) [Irregularities in Postal, Delivery or Electronic Communication Services] Irregularities in postal, delivery or electronic communication services owing to circumstances beyond the control of a Competent Authority or, in the case of Article 5(3) of the Geneva Act, beneficiaries or a natural person or legal entity referred to in Article 5(2)(ii) of that Act and preventing such Competent Authority, beneficiaries, natural person or legal entity from meeting a time limit specified in the Regulations to perform an action before the International Bureau are deemed *force majeure* reasons in accordance with the preceding paragraph.~~

~~(23)~~ [Limitation on Excuse] Failure to meet a time limit shall be excused under this Rule only if the evidence and action referred to in paragraph (1) are received by and performed before the International Bureau as soon as reasonably possible and not later than six months after the expiry of the time limit concerned.

[...]

[End of Annex and of document]