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**WORKING GROUP ON THE MODIFICATION OF THE
REGULATIONS UNDER THE LISBON AGREEMENT FOR THE
PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR
INTERNATIONAL REGISTRATION**

Geneva, July 10 – 13, 2000

QUESTIONS TO BE EXAMINED WITH A VIEW TO THE MODIFICATION OF THE
REGULATIONS UNDER THE LISBON AGREEMENT

prepared by the International Bureau

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I. Introduction

1. The WIPO Program and Budget for the 2000-2001 biennium (document A/34/2, page 129) provides for a “review of the Regulations under the Lisbon Agreement, with the help of one or more consultants and of a Committee of Experts to be convened by the Director General, and submission of proposals for amendment of the Regulations to the Assembly of the Lisbon Union in 2001”. It also foresees that “the Committee of Experts will hold two sessions in the biennium”.
2. The present document has been drafted with a view to the first session of that Committee known as the “Working Group on the Modification of the Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration”. It sets out the main problems of application or interpretation encountered by the International Bureau in the administration of the Lisbon system and gives, where appropriate, an overview of possible solutions and the conditions for implementing them. No draft amended provisions have been prepared at this juncture since it would first appear necessary that the Working Group pronounce on the matters set out below. Following discussions within the Working Group and the emergence of principles or approaches, proposals for amendments will be submitted to the Working Group at its second session and then submitted to the Lisbon Union Assembly in 2001, as foreseen by the WIPO Program and Budget for the 2000-2001 biennium.
3. Apart from the amendment of the scale of fees applicable under the Lisbon system, decided by the Lisbon Union Assembly on September 29, 1993 (taking effect on January 1, 1994), the most recent amendments to the Regulations under the Lisbon Agreement were adopted on October 5, 1976, and entered into force on January 1, 1977. Since that date, important changes have taken place in the field of appellations of origin, both at national, regional and international levels.
4. At national level, to begin with, it is to be noted that a definition of appellation of origin that is identical with or very similar to that given in the Lisbon Agreement (Article 2(1)), and which applies to all goods or to some only (wines and spirits for example), is contained in the legislation of over 50 countries. However, these national laws differ in nature from one country to another; they may, for example, be specific laws relating to appellations of origin, laws that relate to both appellations of origin and other geographical indications, laws on wines and spirits or again laws on marks.
5. At regional level, it should be noted that the European Union (of which three Member States are party to the Lisbon Agreement, that is to say France, Italy and Portugal) has set up a system of minimum Community standards for appellation-of-origin wines of the Member States, grouped together in a Community category (quality wines produced in specified regions—quality wines p.s.r.). The European Union has also set up a Community system for the protection of geographical indications and designations of origin for agricultural products and foodstuffs (Council Regulation (EEC) No. 2081/92 of 14 July 1992). This “PDO-PGI” system has led to the registration of several hundreds of appellations of origin. It may also be observed that the Protocol for the Harmonization of the Intellectual Property Rules of MERCOSUR established by the Treaty of Asuncion of March 26, 1991 (binding Argentina, Brazil, Paraguay and Uruguay), Decision No. 344 under the Cartagena Agreement (binding since January 1, 1994, Bolivia, Colombia, Ecuador, Peru and Venezuela) and the Protocol revising the Central American Convention for the Protection of Industrial Property of November 30, 1994 (binding Costa Rica, party to the Lisbon Agreement), El

Salvador, Guatemala and Nicaragua) have adopted the definition of appellation of origin given in Article 2(1) of the Lisbon Agreement.

6. At international level, apart from the bilateral agreements concluded between various countries, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) annexed to the Agreement Establishing the World Trade Organization (WTO) warrants special attention in view of the fact that appellations of origin within the meaning of the Lisbon Agreement are necessarily geographical indications within the meaning of the TRIPS Agreement. That Agreement, of which the provisions became binding on January 1, 1996, for a certain number of countries and on January 1, 2000, for certain developing countries and countries in economic transition that are Members of WTO¹, comprises a Section 3 headed "Geographical Indications" containing three Articles which respectively define geographical indications and their protection (Article 22), provide additional protection for geographical indications for wines and spirits (Article 23) and allow exceptions to the protection as well as dealing with the conduct of international negotiations (Article 24). In particular, Article 23(4) stipulates that negotiations are to be conducted in the TRIPS Council with respect to the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.

7. In the case of the Lisbon Agreement itself, 19 countries are currently bound by the Agreement². Since its entry into force on September 25, 1996, 835 appellations of origin have been registered under the Agreement, of which 766 are still in force. With respect to those registrations, 62 refusals of protection, concerning 51 international registrations, have been entered in the International Register. The grounds most frequently given for refusal by the authorities of the contracting countries are that the appellation of origin for which registration is sought conflicts with an earlier mark that is protected in the country concerned. Wines and spirits are the products most frequently covered by international registrations made under the Lisbon Agreement.

8. The present document lists a number of points to be examined under the proposed review of the Regulations under the Lisbon Agreement. These points are not arranged by order of importance, but are set out in an order that endeavors to follow the chronology of the international procedure. Furthermore, the list of points is in no way exhaustive; any other question which participants in the Working Group would like to deal with can therefore be raised and discussed within the Working Group.

9. In order to facilitate examination of the matters set out below, a general overview of the Lisbon system as it currently operates is given in Annex I to this document.

10. This document has been drawn up with the assistance of Professor Jacques Audier, Legal Advisor to the International Vine and Wine Office (OIV) and an expert for the European Commission.

¹ Under Article 66(1) of the TRIPS Agreement, the least-developed country members of WTO are not required to apply certain provisions of the TRIPS Agreement (in particular, those relating to geographical indications) during a period of 10 years, which ends on January 1, 2006.

² Algeria, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, France, Gabon, Haiti, Hungary, Israel, Italy, Mexico, Portugal, Slovakia, Togo, Tunisia and Yugoslavia.

II. Principal measures to be envisaged in the framework of the review of the Regulations under the Lisbon Agreement

Definitions

11. For ease of use and to harmonize with the other international registration treaties administered by the International Bureau of WIPO, it would seem useful to include in the Regulations a (new) Rule 1 headed “Definitions” which would define a certain number of terms and expressions used in the Regulations.

12. Those definitions would mainly concern terms or expressions frequently used in the international procedure, such as “Lisbon Agreement”, “International Bureau”, “application” or “International Register”.

13. Other expressions, such as “owners of the right to use” (see paragraphs 18 to 25), “requesting Office” or “Office competent to receive notifications from the International Bureau” (see paragraphs 14 to 17), could also be defined in this new Rule, subject to the discussions held on those issues.

Concept of “Office”

14. The term “Office” is used frequently in the Lisbon Agreement and in its Regulations³; a look at the provisions shows that there exist three possible “categories” of authority liable to act under the international procedure. These are:

- the authority that requests international registration (see in particular Article 5(1) and Rule 1(1));
- the authority that is competent to receive notifications from the International Bureau (particularly the notification of international registration; see in particular Article 5(2) and Rule 1(2)(ii)). It would seem that this authority is also the authority competent to issue a refusal of protection (Article 5(3));
- the authority that has the right to grant to third parties established on its territory a period to terminate the use of an appellation of origin that has been afforded protection in that country (see Article 5(6)).

15. Depending on the laws or practice in the contracting countries, these functions may be exercised by one and the same authority or, on the contrary, be entrusted to differing institutions. It is indeed for each contracting country to decide, on grounds specific to it, which national authorities

³ It should be noted that the English version of the Lisbon Agreement and Regulations always uses the term “Office” to translate the original French term “administration”; a different term, such as “authority” would seem more appropriate.

are to be involved in the application of the provisions of the Lisbon system. The experience of the International Bureau is that there are generally a number of such authorities. In France, for example, the authority empowered to request an international registration under the Lisbon Agreement is the General Directorate for Competition, Consumers and Prevention of Fraud (DGCCRF), whereas the authority competent to receive notifications from the International Bureau is the National Institute of Industrial Property (INPI) and the authority able to grant to third parties established on its territory a maximum period of two years in accordance with Article 5(6) referred to above is the National Institute of Appellations of Origin (INAO).

16. The diversity in the national situations raises a number of difficulties for the International Bureau when it needs to identify its administrative counterpart, particularly since the authorities concerned may change as the result of a national decision. In order to remove any ambiguity, the Regulations should contain a provision inviting Contracting States to notify to the International Bureau the name of the national Office or Offices concerned (as well as any subsequent changes).

17. Moreover, each “category” of authority is referred to in the Regulations by terms that vary from one provision to the other. For example, in order to designate the authority that requests an international registration, the Regulations refer to “the competent Office of the country of origin” (Rule 1(1)), to “the Office making the application” (Rules 1(2), 2(1), 2(3)(i), 3 and 5(2)), to “the Office applying for registration” (Rule 1(5)), to “the Office” (Rule 2(2)), or again to “Office which has applied for international registration” (Rules 5(1) and 6(1)). This fluctuating terminology will have to be harmonized in the Regulations to ensure that, wherever possible, each category of authority is designated by the same expression.

Ownership of appellations of origin and their international registration

Terminology

18. Article 5(1) of the Lisbon Agreement stipulates that “the registration of appellations of origin shall be effected at the International Bureau, at the request of the Offices of the countries of the Special Union, in the name of any natural persons or legal entities, public or private, having, according to their national legislation, *a right to use* such appellations”.

19. In the Regulations (Rules 1(2)(iii), 4(2)(v) and 5(4),⁴) the word “owner” is used by itself (that is to say without adding the words “of the right to use”), but it is understood that it can only be interpreted in compliance with the Agreement. It would therefore be necessary:

– to add after the word “owner”, each time it appears in the Regulations, the words “of the right to use” and, where appropriate,

⁴ In the English version of these Rules, the use of the word “owner” would seem incorrect since the term does not correspond with the terminology used in Article 5(1) (“any natural persons or legal entities, public or private, having, according to their national legislation, a right to use such appellations”). It would therefore seem necessary to make certain drafting changes to the English version only, in order to adapt the terminology in the Regulations to that in the Agreement.

– to define the expression “owner of the right to use” in the new Rule 1 (“definitions”; see paragraphs 11 to 13, above) with reference to the aforementioned Article 5(1) and taking into account the explanations given below.

Identification of the owner or owners of the right to use an appellation of origin

20. To begin with, it is necessary to point out that the property right deriving from the international registration of an appellation of origin normally belongs to the public authorities of the country of origin. In other words, it is the State itself or one of its subsidiary organs (a State administration) that is the owner of the *right of disposal* of the registration and which is therefore exclusively competent to request an international registration (in accordance with Article 5(1) of the Agreement) or to request the cancellation of a registration (in accordance with Rule 5(1) of the Regulations). However, neither the Lisbon Agreement nor its Regulations contain a requirement that the owner of the “right of disposal” of the appellation of origin be identified in the application for international registration; only the owner or owners of the *right to use* have to be mentioned in the application as a result of Article 5(1) and Rule 1(2)(iii).

21. The owner or owners of the *right to use* may be indicated in two ways only: either indication by name or a generic or collective indication.

22. Where there are a number of owners of the right to use, it would not seem feasible to give a list of the names of the owners in the framework of the administration of the Lisbon system, since there may exist thousands of users of an appellation of origin (that is the case, for example, of the wine appellation of origin “Bordeaux”) and Rule 5(4) requires, as it is currently worded, that any modification relating to owners necessitates a new international registration (cf. paragraphs 62 to 64). It may also be noted that the “Council established by the Lisbon Agreement” (whose functions have been exercised by the Lisbon Union Assembly since the entry into force of the Stockholm Act) unanimously agreed at its fifth session on September 26, 1970, that, with regard to the designation of the owners of the right in an appellation of origin, it was not necessary that they be identified by name, but it was sufficient, following the practice already adopted by several Offices, that the circle of owners be clearly specified (see document AO/V/8, paragraph 20).

23. Except for the very marginal cases where there is a single user identified by name, the practice adopted currently by all the requesting authorities is to identify the owners of the right to use in a collective manner (“producers or groups of producers entitled to use the appellation of origin”, “association of producers entitled to use the appellation of origin”, “association for the defense of the appellation of origin”, “organizations which, in the region concerned, are engaged in the production of the product referred to”, “syndicates”, “product control association” or “Government”⁵).

⁵ In such case the owner of the right to use is the same as the owner of the right of disposal (see paragraph 20). This situation is possible since the State or its organ is itself the user of the appellation of the origin within the meaning of Article 5(1) of the Agreement.

24. It would thus seem that the owners of the right to use indicated in the application for international registration by the requesting authorities are those economic operators, whether public or private, to whom their domestic legislation has given the prerogative of authorizing or designating those persons entitled to affix the appellation of origin concerned on the product concerned and/or to verify that such persons comply with the applicable conditions of production, or any natural or legal person who complies with the conditions of protection as defined by the applicable texts.

25. Consequently, it is suggested that the Regulations under the Lisbon Agreement be modified in such a way that it is clearly stipulated that the owner or owners of the right to use are to be indicated in the application for international registration not by name (except where that is the only possibility) but in a generic or collective manner.

Contents of the application for international registration

Identification of the product to which the appellation of origin applies

26. Rule 1(2)(v) of the Regulations provides that the application must indicate “the product to which the appellation applies” for which registration is sought. In that respect, the International Register shows that the indication of the product concerned is sometimes given with precision (e.g. “full fat hard cheese” or “white wine”), and sometimes worded in a general manner in order to cover the family of products (e.g. “craft articles of wood” or “alcoholic beverage”).

27. The International Bureau is not authorized to question the way in which the product to which an appellation of origin applies is indicated in the application for international registration (only in the case of *failure to indicate* the product is there an irregularity). Nevertheless, the precise identification of the product to which the appellation of origin applies constitutes significant information not only for the authorities of the contracting countries but also for others active in the economic sector concerned. To avoid possible difficulties of interpretation for those parties, Rule 1(2)(v) could be supplemented in order to provide that an application must contain a “*precise*” indication of the product to which the appellation of origin applies. In such case, the Working Group’s attention is drawn to the fact that it would be for the International Bureau to raise an irregularity where it considered that the indication of the product in question was not adequate to identify it with precision. The question would then arise as to the criteria to be applied by the International Bureau in determining what constitutes a precise indication.

28. On the other hand, it is not proposed that the requesting authority be required (or permitted) to furnish in its application for international registration a *description* of the product concerned since, in the view of the International Bureau, that would unnecessarily complicate the procedure. It may be noted, however, that under the community PDO-PGI system (see paragraph 5, above) a description of the product is prescribed as a mandatory element.

Translation of the appellation of origin

29. Rule 1(2)(iv) of the Regulations provides that the application must contain “the appellation of origin whose registration is requested”. Under the corresponding heading of the application form, requesting authorities frequently give the name of the appellation of origin in the national language *together with its translation into a certain number of other languages*. The International Bureau, which is not authorized to check the exactness or to limit the number of such translations, enters the appellation of origin *as it stands* in the International Register, notifies it to the authorities of the other contracting countries and publishes it in the periodical *Les appellations d’origine*.

30. The practice referred to in the preceding paragraph seems pointless, however, in view of Article 3 of the Lisbon Agreement which stipulates that “protection shall be ensured against any usurpation or imitation, even if (...) the appellation is used in translated form (...)”. In other words, Article 3 of the Agreement means that an appellation of origin contained in an international registration is protected against any use in translation, *even if that translation is not referred to in the international registration*. Consequently, it is suggested that it should only be possible for the indication of the appellation of origin, as referred to in Rule 1(2)(iv) of the Regulations, to be provided in the official language or languages of the country of origin.

31. Nevertheless, it is undeniable that the translation of the name of the appellation of origin may constitute useful information for users of the Lisbon system and for third parties in general, particularly where the translation differs considerably from one language to another. In order to maintain such information in the framework of an international registration, the Regulations could provide the possibility for requesting authorities to furnish one or more translations of the appellation of origin, not as part of the indication of the appellation of origin as referred to in Rule 1(2)(iv), but as additional (optional) information. Such translations would appear under a *separate* heading on the application form. They would in no way be checked by the International Bureau.

Title and date of legislative or administrative provisions or of judicial decisions recognizing protection in the country making the application

32. Rule 1(2)(vii) of the Regulations stipulates that the application should contain “the title and date of legislative or administrative provisions or of judicial decisions recognizing protection in the country making the application.”

33. The legal bases for protecting an appellation of origin differ depending on the national system involved. There may be legislative or administrative provisions *specifically* relating to the appellation of origin concerned, judicial decisions or again a registration made with a national authority. Obviously, such registration is always made pursuant to legislative or administrative provisions, meaning that the requirement of Rule 1(2)(vii) is satisfied, in any event, by the countries concerned.

34. The wording of Rule 1(2)(vii) could nevertheless be improved in order clearly to include all the existing situations and thus permit an improved identification of the legal basis for protection in the requesting country. For that purpose, the expression “the title and date of legislative or administrative provisions or of judicial decisions recognizing protection in the country making the application” could be supplemented, in particular, by a reference to the date and the number of the national registration where it exists.

35. Moreover, Rule 8(2) of the Regulations stipulates that the authorities of the countries to which the international registration is notified may request, through the International Bureau, copies in the original language of the documents referred to in Rule 1(2)(vii). From a practical point of view, it would be useful to provide that the documents concerned be systematically communicated to the International Bureau and that the latter be empowered to send a copy, against payment of a fee, to any person so requesting. Rule 8(2) in its present wording would become superfluous and could therefore be deleted.

Irregularities in an international application

Irregularities affecting the date of an international registration

36. While any irregularity notified by the International Bureau to an authority has to be corrected in order to avoid rejection of the application, Rules 2(3) and 3 would warrant adaptation in order to set out with more clarity which irregularities affect the date of international registration (since the international registration bears the date on which the correction of the last such irregularity is received by the International Bureau). According to Rule 3, there are five irregularities that lead to a later date of international registration; these are the cases in which the application does not contain the following indications or elements: the requesting country; the owner or owners of the appellation of origin; the appellation of origin for which registration is sought; the product to which the appellations applies; the full amount of the registration fee. The wording of Rule 3 could probably be improved in the framework of a review of the Regulations.

37. Moreover, the fact that lack of the full amount of the registration fee constitutes an irregularity that affects the date of the international registration could be reconsidered. Indeed, under the Madrid system for the international registration of marks and the Hague system concerning the international registration of industrial designs, such an irregularity does not affect the international registration date.

Time limit for correcting an irregularity

38. Rule 2(1) and (2) of the Regulations lays down the following:

“(1) Where the International Bureau finds that an application for registration contains irregularities as to form, it shall defer registration and invite the Office making the application to put the application in order.

(2) If the Office making the application does not reply in writing to the invitation referred to in paragraph (1) within three months from the date of that invitation, the International Bureau shall allow it a further period of the same duration in which to put the application in order.”

39. Thus, the national authorities of the contracting countries currently enjoy a total period of six months for correcting irregular applications (without it being necessary to request a second three-month period, since the International Bureau automatically extends it if the authority concerned has not corrected an irregularity within the first three-month period).

40. The International Bureau’s experience shows that such a long time limit does not prove necessary in practice. Indeed, the irregularities raised by the International Bureau have always been corrected within the (first) three-month period by the authorities concerned. Consequently, without in any way prejudicing the authorities, the deletion of the second three-month period could be envisaged. However, in order to alleviate the effects of such a modification, the Regulations could provide that, if the authority concerned has not corrected the irregularity within two months as from the date of the notification by the International Bureau, the latter would communicate to the Office concerned a reminder of its invitation to correct the application.

Declaration of refusal and procedure subsequent to refusal

Contents of a declaration of refusal

41. Under Article 5(3) of the Agreement, a national authority that declares, within the prescribed time limit of one year, that it cannot ensure the protection of an appellation of origin is required to state the grounds in the corresponding declaration. Since no provision in the Regulations provides that other information must be given in a declaration of refusal, the examination carried out by the International Bureau prior to entering a refusal in the International Register is limited to checking that the declaration of refusal contains a statement of the grounds invoked to support the refusal⁶.

42. In practice, all declarations of refusal are notified to the International Bureau on an unofficial form drawn up by the International Bureau (reproduced in Annex II of the present document), which sets out the other information to be furnished in addition to the grounds for refusal. However, the Regulations should list the particulars that must—or may—be given in a declaration of refusal in order to provide the most accurate and most complete information possible with regard to the refusal in question.

⁶ Furthermore, the International Bureau does not have competence to check the relevance of the alleged grounds or, more generally, to intervene in any manner whatsoever in settling the substantive issues raised by such a refusal (any action to contest a refusal of protection has to be addressed directly to the competent authorities of the country that has issued the refusal, in accordance with the time limits and requirements prescribed by the legislation of that country).

43. It would also be feasible to supplement the content of declarations of refusal, by providing for example that they should contain or state, where the grounds for refusal are based on the existence of an earlier mark with which the appellation of origin conflicts, the essential data concerning such mark (such as the date and filing number and the list of relevant goods or services).

44. Should such a provision be inserted in the Regulations, it would then be necessary for the Regulations to set out how the International Bureau is to deal with irregular refusals. In such case, the main elements to be decided would be, firstly, the period of time given to national authorities to correct irregularities ascertained and, secondly, whether the absence of prescribed information (other than the grounds for refusal) would prevent the entry of the refusal concerned in the International Register or not.

Partial refusal

45. It is quite feasible that a refusal pronounced by a national authority could be partial, that is to say that it concerns only a part of the goods to which the appellation of origin applies. However, that possibility does not formally appear in the Lisbon Agreement or its Regulations and it could be useful to include a provision to that effect.

46. Moreover, it is also conceivable that a refusal could be partial in that it applies to a part only of the appellation of origin. Such a situation could result from the fact that the practice of a number of authorities is to state in the application for international registration, as an appellation of origin, a geographical name associated with the nature of the product to which the appellation applies (for example, “Trojanksa Keramica”, “Vjatovski Kaolin”, “Dentelle de Vamberk”, “Beurre des Charentes”, etc. ...). In other words, the International Register shows that an appellation of origin for which protection is sought may comprise both a generic term (the common name of a product in everyday language) and a geographical name constituting an appellation of origin in the strict sense.

47. This situation would seem acceptable; indeed, it is already accepted by the national authorities (there is no refusal of protection—whether full or partial—entered in the International Register based on such grounds). It reflects the usual practice which is to designate as a “appellation of origin” the full name under which the products concerned are labelled and marketed. It may also be noted that the European Commission, which keeps the Community register of protected designations of origin, has made similar registrations while specifying in a footnote that the Member State did not request protection for the generic element.

48. In the case of the Regulations under the Lisbon Agreement, and in view of what has been said before, it would be necessary to decide whether a provision should expressly mention the possibility of partial refusal with regard to a part only of the name of the appellation of origin. Alternatively or additionally, the Working Group could also envisage the usefulness of permitting an authority requesting international registration to make a declaration in its application to the effect that protection was not claimed for certain elements of the appellation (a disclaimer).

Time limits

Date of expiry of the one-year period referred to in Article 5(3) of the Agreement (for notifying a refusal of protection to the International Bureau)

49. Article 5(3) of the Agreement provides that national authorities may declare that they cannot ensure the protection of an appellation of origin whose registration has been notified to them, provided that the declaration is notified to the International Bureau “within a period of one year from receipt of the notification of registration”.

50. The starting point for that period (“within a period of one year *from the receipt of the notification of registration*”) is known to the International Bureau since international registrations are notified to the Offices concerned by registered mail with advice of delivery.

51. On the other hand, no provision in the Agreement or its Regulations states exactly how the expiry date of that period is to be calculated (the date on which the declaration of refusal by the Office concerned was *sent* or the date on which that declaration was *received* by the International Bureau). The Regulations should deal with this matter since, although it would seem that no such situation has yet arisen in practice, it could happen in future that a refusal of protection is notified by an Office within the one-year period for refusal, but that it reaches the International Bureau after that period. In that case, determining the date on which the one-year period expires would be of decisive importance by reason of the fact, in particular, that it is for the International Bureau to ensure that a declaration of refusal of protection has been made in accordance with Article 5(3) of the Agreement—and therefore in particular that the applicable time limit has been complied with—in order for it to be entered in the International Register (Rule 4(2)(xi) of the Regulations).

52. Under the Madrid system for the international registration of marks and the Hague system for the international registration of industrial designs, the operative date is the *date of dispatch* of the declaration of refusal by the Office concerned (Article 5(2) of the Madrid Agreement and Article 5(2)(a) of the Madrid Protocol; Article 8 of the 1960 Act of the Hague Agreement). That solution seems the most advantageous for the Offices of the designated Contracting Parties since, as long as the declaration had been notified within the time limit, it would no longer matter whether the declaration of refusal was received by the International Bureau subsequent to the prescribed period.

Date of expiry of the three-month period referred to in Article 5(6) of the Agreement (period for advising the International Bureau that a period of time has been granted to third parties for terminating use of an appellation of origin)

53. Article 5(6) of the Agreement provides the faculty for the authority of a country in which an appellation of origin accepted for protection is already used by a third party in that country, to afford such third party a maximum period of two years for terminating his use of the appellation of origin concerned. However, that faculty is subject to the requirement that the authority should advise the International Bureau thereof “during the three months following the expiration of the period of one year provided for in paragraph (3)”.

54. As for the one-year time limit for refusal referred to in Article 5(3), the question arises whether the operative date is the *date of dispatch* of the declaration by the Office concerned or the *date of receipt* of that declaration by the International Bureau. It would also be necessary for the Regulations to determine which of those dates is to be taken into consideration for the purposes of applying this provision.

Determination of the starting point for the maximum two-year time limit referred to in Article 5(6) of the Agreement (for terminating use of an appellation of origin)

55. Article 5(6) of the Lisbon Agreement stipulates that “if an appellation which has been granted protection in a given country pursuant to notification of its international registration has already been used by third parties in that country from a date prior to such notification, the competent Office of the said country shall have the right to grant to such third parties a period not exceeding two years to terminate such use ...”.

56. However, neither the Agreement nor the Regulations determine what is the starting point for that maximum two-year period. Nevertheless, it would seem that such a starting point could not be later than the expiry date of the three-month time limit referred to in Article 5(6). The Regulations should specify the latest date as from which the period would begin.

57. The Regulations would also have to specify that the authorities concerned must state, in the notification sent to the International Bureau, the date as from which the period they have granted to third parties will begin. Determination of that starting point would be at the discretion of each contracting country, within the limits referred to in the preceding paragraph.

Calculation of time limits

58. The Lisbon Agreement and its Regulations contain a certain number of time limits which, depending on the case, are calculated in years or in months. However, the Regulations do not set out the method of calculating those time limits (for example, the fact that a time limit expressed in months normally expires, in the subsequent month to be taken into consideration, on the day having the same number as the day of the event that starts the period). Likewise, no provision deals with the calculation of a time limit where its date of expiry falls on a day on which the International Bureau is not open to the public.

59. In order to remedy that situation, a general provision would need to be inserted in the Regulations, which could be based on the corresponding provisions in the Common Regulations under the Madrid Agreement and Protocol (Rule 4); that provision is reproduced in Annex III of the present document.

Starting point for the protection of an international registration

60. In contrast to the Madrid system for the international registration of marks and the Hague system for the international registration of industrial designs, no provision in the Lisbon Agreement or its Regulations mentions what is the starting point for the protection of an international registration of an appellation of origin. Such information, which is of vital importance for the authorities of the contracting countries and for third parties, could be specified in the Regulations.

61. If such was the case, account would of course have to be taken of what was provided for in such respect under the domestic laws of the contracting countries.

Modifications to a registration requiring a new international registration

62. Rule 5(4) of the Regulations stipulates that certain modifications to an international registration (those relating to the country of origin, the owners, the appellation of origin or the product to which it applies) “shall necessitate a new international registration”. That provision raises a certain number of formal and substantive questions.

63. As far as substance is concerned, the question arises of the justification for carrying out a new international registration in view of the modifications referred to in Rule 5(4). Although it would seem justified that a modification relating, for example, to the appellation of origin should require a new international registration (with the consequence, in particular, that a new one-year period would begin to run for notifying a refusal of protection), such a solution would not appear necessary in the case of a modification relating, for example, to the owners of the right to use the appellation of origin (cf. paragraphs 20 to 25). It would therefore be opportune to reconsider the type of modification which is liable to give rise to a new international registration and, where appropriate, to determine the impact of the entry of a new registration on the earlier international registration by examining, for example, those cases in which the latter would have to be cancelled from the International Register.

64. As far as form is concerned, rather than listing those modifications that necessitate—or not—a new international registration, it would seem more appropriate to adopt a different approach to this Rule, which would be to specify exhaustively those modifications that could be made to an international registration. It would follow, *a contrario*, that no other modification could be made and, consequently, any other modification would necessarily require a new registration. That is the approach adopted in the Madrid system for the international registration of marks (Rule 25(1)(a)) and in the Hague system for the international registration of industrial designs (Rule 21).

Corrections made to the International Register

65. No provision in the Lisbon Agreement or its Regulations explicitly provides the possibility of correcting the International Register in the event of it containing an error. Nevertheless, there have already been cases (although a relatively rare happening) where the International Bureau, notified by a national authority, has held that the International Register did indeed contain an error with respect to an international registration; in all such cases, the error concerned either the name of the owners or the references to national provisions recognizing protection of the appellation of origin in the

country of origin, and was ascribable to the requesting authority that had incorrectly entered data when drawing up the application for international registration.

66. The correction of inaccurate data contained in the International Register would not only seem legitimate, but also necessary (particularly for the information of authorities of the other Contracting States and of third parties in general) and therefore the practice of the International Bureau has been to enter such corrections in the International Register, to notify them to the Offices of the contracting countries and to publish them in the periodical *Les appellations d'origine*.

67. In view of the above remarks, it would be necessary to insert in the Regulations a provision defining precisely the procedure to be applied by the International Bureau in the event of an error contained in the International Register. In particular, it would seem useful to determine those particulars capable of being corrected, under what conditions and according to what procedures. As an example, the question arises whether all errors, whatever their nature, may be corrected or whether it is necessary to define those particulars that may be corrected (where the liability for the error lies with an authority⁷).

68. Irrespective of the solution chosen for those latter points, any authority must be in a position to refuse the effects of a correction. This faculty would appear necessary where, with respect to the international registration as corrected, there exist grounds for refusal which did not apply to the international registration as initially notified to the authority concerned. The relevant provisions of the Lisbon Agreement and its Regulations on refusal of protection would apply *mutatis mutandis* to refusal of the effects of a correction and, in particular, to the applicable time limits for notifying such refusal.

69. With a view to taking a stance on these various issues, an examination of the equivalent provision in the Common Regulations under the Madrid Agreement and the Protocol (Rule 28) could form a useful basis for discussion in the Working Group. The relevant provision is reproduced in Annex IV of the present document.

Entry of an invalidation in the International Register

70. It has been brought to the attention of the International Bureau that a certain number of decisions given by courts in the contracting countries (in particular in Portugal and Italy) have “invalidated”⁸, on their territory, the effects of an international registration of an appellation of origin that had not been subject to a refusal of protection under Article 5(3).

⁷ If an error contained in the International Register is ascribable to the International Bureau, it must be possible to correct it at any time (whatever its nature).

⁸ The word “invalidated”, taken from the terminology of the Madrid system for the international registration of marks, is intended to cover all decisions, administrative or judicial, taken by the competent authorities of a contracting country and which lead to termination of the effects of an international registration of the appellation of origin in their territory.

71. In one case, the national Office concerned requested the International Bureau to enter such an invalidation in the International Register. It is obviously not for the International Bureau of WIPO to pronounce on the justified nature of decisions taken by the administrative or judicial authorities of the countries party to the Lisbon Agreement concerned with the application of the Agreement on their territory, but the International Bureau was not able to accede to that request due to the absence of any provision in the Lisbon Agreement or its Regulations that would permit the entry of such decisions in the International Register.

72. In view of what has been said above, and to the extent that such invalidations are compatible with Articles 6 and 7 of the Agreement (from which it follows that, if the authority of a country of the Special Union has not notified to the International Bureau a declaration of refusal in accordance with Article 5(3), an appellation of origin covered by an international registration enjoys protection in that country for as long as it is protected as such in its country of origin), a mechanism entitling the International Bureau to enter such invalidations in the International Register (particularly with a view to providing information for third parties) would have to be explicitly provided for in the Regulations.

[Annexes follow]

ANNEX I

**General Overview of the Lisbon Agreement for the Protection
of Appellations of Origin and Their International Registration**

Introduction

1. The Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration (hereinafter referred to as “the Lisbon Agreement”) was adopted in 1958 and revised at Stockholm in 1967. It is administered by the International Bureau of WIPO, which keeps the International Register of Appellations of Origin and publishes a periodical entitled “Les Appellations d’origine.”
2. The Lisbon Agreement is a *Special Agreement* under Article 19 of the Paris Convention for the Protection of Industrial Property. Any country party to the Convention may accede to the Agreement.
3. The countries party to the Lisbon Agreement make up the Lisbon Union. Every member of the Lisbon Union is also a member of its Assembly, which among other things adopts the program and budget of the Union and modifies the Regulations.

Objective

4. The Lisbon Agreement was concluded in response to the need for a system that would facilitate the recognition and protection of appellations of origin in various countries. Protection is obtained by the registration of appellations at the International Bureau of WIPO.

Definition of an Appellation of Origin

5. Article 2(1) of the Lisbon Agreement defines an appellation of origin as
“the geographical name of a country, region or locality which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.”
6. Three things should be noted in this definition:
 - (a) First, the appellation has to be the *geographical name* of a country, region or locality. The appellation therefore has to exist as the name of a recognized geographical entity in a given country.
 - (b) Secondly, the appellation has to serve to designate a *product* originating in the country, region or locality concerned. In that respect the appellation has a twofold significance: in addition to

being the name of a place it designates a product originating in that place.

(c) Thirdly, there has to be a *qualitative connection* between the product and the place in which the product originates. The quality and characteristics of the product have to be exclusively or essentially attributable to the geographical environment. The geographical environment is determined on the one hand by a set of *natural factors* (such as soil and climate), and on the other hand by a set of *human factors* (for instance the method of production or manufacture used by the producers or craftsmen of the locality).

Registration Procedure and Option of Refusal

7. In order to qualify for registration at the International Bureau of WIPO, an appellation of origin has to be recognized and protected *as such* in the country of origin. According to Article 2(2) of the Lisbon Agreement, country of origin means “the country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin that has given the product its reputation”.

8. The condition set forth in the foregoing paragraph implies that it is not sufficient for the appellation of origin to be protected in the country of origin in a general way (for instance by virtue of unfair competition laws or general legal provisions). It is necessary in that country for the concept of the appellation of origin to be expressly recognized and also for the appellation of origin whose protection via the Lisbon Agreement is sought to have been given specific and express recognition, which is the prerequisite of protection in that country. Recognition may take place by virtue of legislative or administrative provisions or by virtue of a judicial decision or an official entry in a special register. The manner in which recognition takes place is determined by the domestic legislation of the country of origin.

9. When an appellation of origin has been recognized and protected as such in the country of origin, it is possible to seek its registration with the International Bureau of WIPO. The application for registration has to be filed by the competent national authority of the country of origin. Registration is in the name of the natural persons or legal entities, public or private, having, according to their national legislation, the right to use the appellation in the country of origin.

10. The application has to be filed in French and be accompanied by the registration fee (500 Swiss francs). The International Bureau does not carry out a substantive examination of the application for registration, but it does undertake an examination as to form. If the application contains a defect of form, a period of three months (which may be extended by another period of the same duration) is allowed for the defect to be remedied. If the application meets all the requirements as to form, the International Bureau records the appellation of origin in the International Register of Appellations of Origin and notifies the registration to the national authorities of the countries of the Lisbon Union. The registration is also published in the periodical “Les Appellations d’origine.”

11. The authorities of the member countries that have been received notice of the registration of an appellation of origin have the option of refusing to protect it in their territory. The declaration of refusal of protection has to meet two requirements. The first is a time requirement: the refusal has to be notified to the International Bureau within a period of *one year* from the date of receipt of the

notice of registration. The second is a requirement regarding content: the declaration of refusal has to specify the grounds for refusal. So, for instance, a country may refuse to protect an appellation of origin because it considers that the appellation has acquired a generic character in its territory in relation to the product to which it refers, or because it considers that the geographical designation does not conform to the definition of an appellation of origin in the Lisbon Agreement.

12. When the International Bureau receives a declaration of refusal within the prescribed period, it notifies it to the national authority of the country of origin and publishes it in “Les Appellations d’origine.” The national authority communicates it in turn to the parties concerned, who may avail themselves of the same administrative and legal remedies against the refusal as nationals of the country that pronounced it.

13. A member country that does not refuse protection to an appellation of origin that was being used by a third party on its territory prior to the date of notification of the international registration has the option of allowing that third party a period not exceeding two years within which to terminate such use. In that case, the authority of the country in question has to inform the International Bureau accordingly within the three months following the expiry of the period of one year provided for the refusal of protection.

Content of Protection

14. The Lisbon Agreement contains not only procedural rules but also rules of substantive law. Thus Article 3 defines the content of the protection that the member States undertake to accord to appellations of origin registered at the International Bureau. According to that Article, protection is ensured against any usurpation or imitation of the appellation of origin, even if the true origin of the product is stated or if the appellation is used in translated form or accompanied by terms such as “kind,” “type,” “make,” “imitation” and the like.

15. It should also be mentioned that the protection provided under the Lisbon Agreement does not rule out any protection that might exist in a member country by virtue of other international treaties, such as the Paris Convention and the Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods.

16. The member countries are under the obligation to provide a means of defense against any usurpation or imitation of an appellation of origin in their territory. The necessary action has to be taken before the competent authorities of each of the countries of the Union in which the appellation is protected, according to the procedural rules laid down in the national legislation of those countries.

Duration of Registration

17. The international registration of an appellation of origin assures it of protection, without any need for renewal, for as long as the appellation is protected as such in the country of origin.

Cancellation and Amendment of Registration

18. The international registration of an appellation of origin may be cancelled at any time at the request of the authorities of the country of origin. Those authorities may likewise renounce protection in one or more countries party to the Lisbon Agreement, either in the actual application for registration or in a request filed later. The authorities of the country of origin may also request the amendment of one or more of the following data: the authority competent to receive notifications from the International Bureau; the area in which the product is produced; the titles and dates of legislative or administrative provisions or of court decisions recognizing protection in the country of origin, and the country or countries in which protection has been renounced. On the other hand, data concerning the country of origin, the owners of the right to use the appellation in the country of origin, the appellation of origin itself and the product to which it relates may not be the subject of amending entries in the International Register. Amendment of any of those data can be affected only by filing a new application for international registration.

Present Status of the Lisbon System

19. At present 19 States are party to the Lisbon Agreement. 835 appellations of origin have been recorded in the International Register, of which 766 are currently in force.

[Annex II follows]

ANNEX II

**Unofficial for for a declaration of refusal
under the Lisbon Agreement**

**LISBON AGREEMENT
FOR THE PROTECTION OF APPELLATIONS OF ORIGIN
AND THEIR INTERNATIONAL PROTECTION**

**DECLARATION OF REFUSAL OF PROTECTION
under Article 5(3) of the Lisbon Agreement**

to be submitted in two copies to the International Bureau
of the World Intellectual Property Organization (WIPO)
34, chemin des Colombettes, P.O. Box 18, CH-1211 Geneva 20 (Switzerland)
‡ (41-22) 338 91 11 – Telefacsimile (International Trademark Registry): (41-22) 740 14 29
e-mail: intreg.mail@wipo.int – Internet: <http://www.OMPI.int>

The Office of
(name of State)

declares that it is unable to ensure the protection of the appellation of origin described below.

Appellation of origin:

Country of origin:

Number of international registration:

Date of receipt of the notification of international registration:

Grounds for refusal:

Remedies:

(in particular time limit and appeals body):

Place:

Date:

Signature:

[Annex III follows]

ANNEX III

**Extract from the Common Regulations under the Madrid Agreement and
Protocol Relating to the Madrid Agreement Concerning the
International Registration of Marks**

*Rule 4
Calculation of Time Limits*

(1) [Periods Expressed in Years] Any period expressed in years shall expire, in the relevant subsequent year, in the month having the same name and on the day having the same number as the month and the day of the event from which the period starts to run, except that, where the event occurred on February 29 and in the relevant subsequent year February ends on the 28th, the period shall expire on February 28.

(2) [Periods Expressed in Months] Any period expressed in months shall expire, in the relevant subsequent month, on the day which has the same number as the day of the event from which the period starts to run, except that, where the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month.

(3) [Periods Expressed in Days] The calculation of any period expressed in days shall start with the day following the day on which the relevant event occurred and shall expire accordingly.

(4) [Expiry on a Day on Which the International Bureau or an Office Is Not Open to the Public] If a period expires on a day on which the International Bureau or the Office concerned is not open to the public, the period shall, notwithstanding paragraphs (1) to (3), expire on the first subsequent day on which the International Bureau or the Office concerned is open to the public.

(5) [Indication of the Date of Expiry] The International Bureau shall, in all cases in which it communicates a time limit, indicate the date of the expiry, according to paragraphs (1) to (3), of the said time limit.

[Annex IV follows]

ANNEX IV

**Extract from the Common Regulations under the Madrid Agreement and
Protocol Relating to the Madrid Agreement Concerning the
International Registration of Marks**

Rule 28

Corrections in the International Register

(1) [Correction] Where the International Bureau, acting ex officio or at the request of the holder or of an Office, considers that there is an error concerning an international registration in the International Register, it shall modify the Register accordingly.

(2) [Notification] The International Bureau shall notify accordingly the holder and, at the same time, the Offices of the designated Contracting Parties in which the correction has effect.

(3) [Refusal of Effects of Correction] Any Office referred to in paragraph (2) shall have the right to declare in a notification to the International Bureau that it refuses to recognize the effects of the correction. Article 5 of the Agreement or Article 5 of the Protocol and Rules 16 to 18 shall apply *mutatis mutandis*, it being understood that the date of sending the notification of the correction shall be the date from which the time limit for pronouncing a refusal is counted.

[End of Annex IV and of document]