

## ANNEX II

### **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 entered into force on September 25, 1966, and is administered by the International Bureau of WIPO, which keeps the International Register of Appellations of Origin and publishes a bulletin entitled *Appellations of Origin*. Registered data are also publicly available through the Lisbon page on the WIPO website, where “Lisbon Express” allows for a structured search on appellations of origin as registered under the Lisbon Agreement, the product to which they apply, their area of production, the holders of the right to use the appellation of origin, any refusals or invalidations notified by member countries, etc.
2. The Agreement is supplemented by Regulations. The latest version of these Regulations was adopted in September 2001, with a date of entry into force of April 1, 2002.
3. 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.
4. Countries adhering to the Lisbon Agreement (Stockholm Act of 1967) become members of the Lisbon Union Assembly. The list of countries party to the Lisbon Agreement is given in Annex III, which shows that all contracting countries except one are members of the Lisbon Union Assembly. The Lisbon Union Assembly has the authority to modify the Regulations.

#### **Objective**

5. In many countries, unfair competition or consumer protection laws contain general provisions dealing, among others, with the misappropriation of indications serving to designate products that originate in a geographical area. In addition, many countries have also put in place special systems aimed at identifying the specific features for which such indications are known to designate the products in question and deserve special protection. Securing protection for such indications in other countries has, however, been complicated due to differences in legal concepts existing from country to country in this regard and developed in accordance with different national legal traditions within a framework of specific historical and economic conditions.
6. The Lisbon Agreement was concluded in response to the need for an international system that would facilitate the protection of a special category of such geographical indications, i.e. “appellations of origin”, in countries other than the country of origin, by means of their registration at the International Bureau of WIPO.

## Recognition and Protection in the Country of Origin

7. Article 1(2) of the Lisbon Agreement lays down that, in order to qualify for registration at the International Bureau of WIPO, an “appellation of origin” must be “recognized” and “protected” in the “country of origin”. Article 2(1) elaborates on this by defining “appellation of origin” and Article 2(2) “country of origin” (see further paragraph 9 below).

8. On this basis, the condition that the appellation of origin must be “recognized” and “protected” in the country of origin means that the appellation of origin must be constituted by a geographical denomination that is protected in the country of origin as the denomination of a geographical area (country, region or locality) recognized as serving to designate a product that originates therein and meets certain qualifications. Such recognition of the denomination must be based on the reputation of the product and protection of the appellation of origin must have been formalized by means of legislative provisions, administrative provisions, a judicial decision or any form of registration. The manner in which recognition takes place is determined by the domestic legislation of the country of origin.

### Definition of an Appellation of Origin<sup>1</sup>

9. Article 2(1) of the Lisbon Agreement defines an “appellation of origin” as the geographical denomination of a country, region or locality which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors. Article 2(2) defines the “country of origin” as “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”.

10. Three elements should be noted in these definitions:

(a) First, the requirement that the appellation of origin should be the *geographical denomination* of a country, region or locality means that the appellation is to consist of a denomination that identifies a geographical entity in the country of origin.

(b) Secondly, the requirement that the appellation of origin must serve to designate a *product* originating in the country, region or locality concerned means that, in addition to identifying a place, the geographical denomination in question must be known as the designation of a product originating in that place – requirement of reputation<sup>2</sup>.

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<sup>1</sup> Acts of the Lisbon Conference, p. 859: “By introducing a definition for appellations of origin into the Agreement itself, such definition could be invoked for the purposes of registration, without prejudicing a national definition, whether broader or more precise in scope.” (Unofficial translation from official French text.)

<sup>2</sup> Acts of the Lisbon Conference, p. 859: “Article 1 was approved with the addition of the term “recognized” before the words “protected as such”. This amendment was considered necessary for bringing the provision into line with the principle that appellations of origin always relate to a product enjoying a certain renown.” (Unofficial translation from official French text.)

(c) The third requirement concerns the quality or characteristics of the product to which the appellation of origin relates, which must be due exclusively or essentially to the geographical environment of the place where the product originates. The reference to the geographical environment means that there is to be a *qualitative connection* between the product and the place in which the product originates. 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 traditional knowledge or know how used in the place where the product originates).

### **Protection to be Accorded**

11. Similar to the Madrid and Hague systems, the Lisbon system facilitates the registration of industrial property rights at the international level on the basis of provisions laying down the procedural rules governing the international registration procedure. However, the Lisbon Agreement also contains a number of provisions laying down the protection to be accorded to internationally registered appellations of origin. Thus, Article 3 defines that the member States are to protect appellations of origin registered at the International Bureau 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” or the like.

12. It should also be mentioned that the protection to be provided under the Lisbon Agreement does not rule out any protection that might already exist in a member country by virtue of other international treaties, such as the Paris Convention, the Madrid Agreement for the Repression of False or Deceptive Indications of Source of Goods or the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), by virtue of bilateral or plurilateral agreements, or by virtue of national legislation or court decisions.

13. 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 Lisbon Agreement does not define the terms “usurpation” and “imitation”. 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.

### Effects of Registration<sup>3</sup>

14. Subject to refusal or invalidation (see below), an appellation of origin which has been the subject of an international registration is to be ensured protection from the date of the international registration in each contracting country which has not issued a refusal. However, a contracting country may declare that protection is ensured in that country from a different date, which may not be later than the date of expiry of the one-year refusal period<sup>4</sup>.

15. 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 in the country of origin<sup>5</sup>. The appellation also has to be shielded against becoming a generic denomination<sup>6</sup>.

16. However, the competent authorities of the contracting countries that have received notice of the registration of an appellation of origin have the right to refuse to protect it in their territory, in part or in whole. Such a refusal of protection has to be the subject of a declaration to that effect, which has to meet two requirements:

(a) 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 by that contracting country of the notice of registration.

(b) The second is a requirement regarding content: the declaration of refusal has to specify the grounds for refusal. For instance, a contracting country may refuse to protect an appellation of origin because it considers that the appellation has already 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 or because the appellation would conflict with a trademark or other right already protected in the country concerned.

17. When the International Bureau receives a declaration of refusal from the competent authority of a contracting country and within the prescribed period, it notifies it to the competent authority of the country of origin, enters it in the International Register and publishes it in the Bulletin<sup>7</sup>. The competent authority of the country of origin 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<sup>8</sup>.

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<sup>3</sup> According to the Acts of the Lisbon Conference, pp. 816/817, the purpose of registration is to: “(1) provide the other countries of the Lisbon system with precise information regarding the appellation of origin to be protected; (2) prompt position-taking by these countries with regard to the appellation of origin; (3) prevent any transformation of the appellation of origin into a generic denomination.” (Unofficial translation from official French text.)

<sup>4</sup> Rule 8(3) of the Regulations under the Lisbon Agreement.

<sup>5</sup> Article 7 of the Lisbon Agreement and, for newly acceding contracting countries, Article 14(2)(b) of the Lisbon Agreement.

<sup>6</sup> Article 6 of the Lisbon Agreement.

<sup>7</sup> Articles 5 and 14(2)(c) of the Lisbon Agreement and Rules 9 and 10 of the Lisbon Regulations.

<sup>8</sup> Article 5 of the Lisbon Agreement.

18. Refusal can be based on any situation of fact or law. However, the grounds on the basis of which the country decides not to grant protection constitute a possible basis for discussion for the purpose of reaching an understanding<sup>9</sup>. Such an understanding may result in the withdrawal of a refusal, in whole or in part. Under Rule 11 of the Regulations, a procedure is available for the notification of such withdrawals and their recording in the International Register.

19. 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 competent 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<sup>10</sup>.

20. And, if no declaration of refusal is submitted but the effects of an international registration are, subsequently, invalidated in a contracting country and the invalidation is no longer subject to appeal, the competent authority of the country concerned is to notify the International Bureau accordingly. Following such a notification, the International Bureau enters the invalidation in respect of the notifying country in the International Register and sends a copy of the notification to the competent authority of the country of origin<sup>11</sup>.

### **Cancellation and Amendment of Registration**

21. The international registration of an appellation of origin may be cancelled at any time at the request of the competent authority of the country of origin<sup>12</sup>.

22. That authority 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<sup>13</sup>.

23. The competent authority of the country of origin may also request the entry in the International Register of one or more of the following:

- (a) a change in the holder of the right to use the appellation of origin;
- (b) a modification to the names or addresses of the holders of the right to use the appellation of origin;

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<sup>9</sup> Acts of the Lisbon Conference, p. 817: “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 understanding.” (Unofficial translation from the official French text.)

<sup>10</sup> Article 5(6) of the Lisbon Agreement and Rule 12 of the Lisbon Regulations.

<sup>11</sup> Rule 16 of the Lisbon Regulations.

<sup>12</sup> Rule 15 of the Lisbon Regulations.

<sup>13</sup> Rule 14 of the Lisbon Regulations.

(c) a modification to the limits of the area of production of the product to which the appellation of origin applies;

(d) a modification relating to the titles and dates of legislative or administrative provisions or of court decisions recognizing protection in the country of origin;

(e) a modification relating to the country of origin that does not affect the area of production of the product to which the appellation of origin applies<sup>14</sup>.

24. On the other hand, an amendment of the appellation of origin itself or the product to which it relates require the filing of a new application for international registration.

### **Present Status of the Lisbon System**

25. The Lisbon Agreement currently has 26 contracting countries. Since its entry into force in 1966, 887 appellations of origin were recorded in the International Register, of which 813 are currently in force.

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<sup>14</sup> Rule 13 of the Lisbon Regulations.