



REPORT ON THE WIPO SESSION IN GENEVA

AIPPI Q 220 - GEOGRAPHICAL INDICATIONS

Special Committee on Geographical Indications

1. The Fourth Session of the Working Group on the Development of the Lisbon System was held in Geneva on December 12 to 16, 2011.
2. It was very well organized and the registration was very easy. My badge and documents were ready at the time I arrived. I attended all the days to the complete sessions.
3. The attendance was scarce 15 countries as contracting parties of the Lisbon Agreement and 14 countries as observers. (According to WIPO there are 27 counteracting parties of the agreement). I want to stress out that many of the delegates were technocrats with no experience of GI in real life, they sometimes neglect to understand the impact of new rules in real life.
4. Some international intergovernmental organizations were present in their observer capacity: European Union and World Trade Organization.
5. Also, some international non-governmental organizations were represented: ABPI, CEIPI, ECTA, AIPPI, INTA, MARQUES, OriGIN. In this issue it is important to comment that Ms Matthijs Geuze told me that he was surprised (in a good way) and delighted that AIPPI attended the sessions of the working group.
6. Also, I want to highlight that CEIPI (2), ECTA (2), INTA (3), MARQUES (3) and OriGIN (4) sent several representatives, not just a single one. Moreover, the representatives have been attending all the sessions of the working group for the sake of continuity and understanding.
7. The discussions were based on documents LI/WG/DEV/4/2, LI/WG/DEV/4/3, LI/WG/DEV/4/4, LI/WG/DEV/4/5. The discussions were thorough as it was discussed each and every article of the last version of the documents mentioned before.
8. Obviously, they were issues that were discussed longer and deeper, for example:
 - ✓ The basis for protection and the definitions (articles 2 and 3) were fully discussed. The attendees want a less complex way of defining both the terms of Appellations of origin and geographical indications and avoid a negative formulation. Here was discussed deeply if the Appellations should include the reference natural AND human or natural AND/OR human

factors. Also the scope and meaning of the word reputation was discussed and agreed that in further sessions will be defined.

- ✓ The scope of protection (articles 4 and 5) was an issued also deeply discussed basically the intention was of granting a high and uniform level of protection for both juridical figures. A suggestion (CEIPI) was made consisting for a two tier approach, one a mere system of registration and other involving substantive requirements.
- ✓ Concerning prior use (articles 12, 13, 14 and 18) many delegations want to change the wording to a more traditional trademark terminology. It was discussed that article 12 of the discussed document would allow contracting parties to provide for the coexistence of prior trademark and AO and GI. This issue was firmly sustained by INTA, and AIPPI representative, we had a completely coincidental point of view.
- ✓ Other issues were discussed, but basically the above mentioned are the most important ones.

9. In line with AIPPI's endorsement of the "*first in time, first in right*" rule as the guiding principle for settling conflicts between trademarks and geographical indications (Resolution Q191, section 4), we took the floor and asked for a reasonable balance in case of conflicts between trademarks and AO and GI. At the document called Summary of the Chair it is noted that article 12 of the discussed document will compel the contracting parties to provide for the coexistence of prior trademark rights and an AO or a GI. I believe that with this set in the document it will acknowledge the rights deriving from a prior trademark, subject to acquisition in good faith, therefore applying the "*first in time, first in right*".

10. The main issues to be highlighted, in my own personal opinion, are:

- ✓ The instrument to be drafted a revision and improvement to Lisbon including all discussions and/ or the existence of a Protocol, just like Madrid or Hague, (revised act, protocol or treaty) that may attract new contracting parties.
- ✓ The new instrument must have a harmonization or minimum protection standard for both legal figures.
- ✓ Contracting parties may have definitions that are not identical as Lisbon and may have different instruments to protect (legislation, administrative act, judicial decision, etc.)
- ✓ A positive definition of both AO and GI. (That will be discussed in the next WIPO session). Also the concept of reputation must be included in Lisbon.
- ✓ There were discussions about phasing out as well as fair descriptive use (fair use), that will be taken also in the next session for analysis. Additionally it was also discussed to accept protection but exception the protection based on a prior trademark. Also, it is a task to define precisely what a legitimate prior right is. The goal of this discussion is an exception to protection of AO and GI in order to safeguard the protection of prior trademarks.

11. To finalize basically my intervention when I took the floor was as follows:

AIPPI endorses the first in time, first in right rule as a guiding principle for settling conflicts between trademarks and geographical indications. This principle endorses the rights deriving from a prior or famous trademark, subject to acquisition in good faith, therefore we

suggest applying the first in time, first in right principle not as an absolute rule but taking into consideration good faith, reputation, length of time and extent of use.

Moreover, we emphasize that the significance of the treaties is that they will be used, meaning that registrations will be made, enforcements will take place, conflicts will appear and that it should be worded in a easy, non ambiguous way, flexible for all jurisdictions, but taking into account that it is an instrument that will be used in real life.

I asked the secretariat to include in the discussions my interventions in representation of AIPPI.

Report written by:

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