

WIPO – 7th session, Geneva, April 29 – May 3, 2013
Working Group on the Development of the Lisbon System
(Appellations of Origin)

Report by Volker Schoene

First Day: Monday, April 29, 2013

Opening Remarks by the Secretary.

Goal of this session is to arrive at a point where a diplomatic conference on the revision of the agreement could be recommended to the member states.

Election of Chair

Chief of the Hungarian delegation, Mihály Ficsor (same as before) is elected as chair, chief of the Iranian delegation is Vice-Chair, also chief of the Peruvian delegation.

The draft agenda of the secretary of 28 February 2013 is adopted.

Report on 6th session is adopted.

Main item of the agenda: Discussion of the draft of the revised version

General remarks

Most parties present support the version. The Australian delegate criticizes: this is the wrong road, the working group should not go any further. The draft revised version is in conflict with accepted principles of intellectual property.

The observing delegation from the EU encourages the working group.

Swiss delegation emphasizes that the protection on AOP and GI must have the same level.

Preliminary remarks by the secretary, Mr. Geuze

Discussion of individual provisions

Art. 13

Questions raised by various delegations concern the meaning of

- “each such party” (Art. 13 I. 1.)
- the system of Art. 13 I. 1 – Art. 13 I. 2, IV.

Mr. Geuze explains that the wording has to take into account that there are various legislations in place which partly are guided by the ‘first in time principle’, partly by the ‘coexistence principle’. ‘Each such party’ means that only the specific party where the conflict arises is meant, not all the parties to the agreement. He highlights that Art. 13 III. ‘coexistence with personal names’ requires no priority of the name, the same goes for Art. 13.4 (Coexistence with other signs).

To make the reference in Art. 13 IV clearer it is suggested to replace 'mutatis mutandis' by 'shall in no way prejudice', the wording of Art. 13 III. An example for such a conflict would be the denominations 'Porto' for the strong wine from Portugal and 'Porto Vecchio' (wine from the island of Corsica). If the later application is refused nowhere, the two denominations will coexist.

An example for Art. 13 IV 'signs' (other than trade marks, trade names etc.) would be names of plant varieties.

Art. 13 I

The chair suggest to delete 'where possible' since it creates misunderstanding and is not really necessary.

Art. 13 IV

The Swiss delegation asks for further discussion on this. The paragraph is derived from Art. 24 IV TRIPS, but doesn't really fit in here.

The secretariat will present a revised version of Art. 13 during the session to facilitate further discussion.

Art. 17

Prior use, phasing out.

Art. 17 I. 'under this act' will be deleted because it is superfluous.

Art. 17.3

The discussion is quite heated on the problem of generic terms contained in a trade mark. Can such a generic term be phased out along with the trade mark? The chair explains that in many trade mark laws the trade mark is considered as a whole so that one cannot phase out specific parts of a trade mark and maintain the rest.

Mr. Geuze explains that footnote 6 (footnote 7 in the correct numbering) is a way of deferring the question to the working group, an answer needs to be found but the question is difficult.

The difference between Art. 13 and Art. 17 is that Art. 13 only concerns rights whereas Art. 17 III. deals with generic terms. The problems arose when a generic term is contained in a 'right' (trade mark, trade name).

The European Union wishes to maintain the footnote.

Moldavia, Italy and France emphasize that a generic term, even it is contained in a trade mark, must be phased out. A method may be difficult, but still that is necessary.

The chair suggests that the trade mark may remain in the register but the generic term may no longer be used. This would be a matter of national trade mark legislation.

**Second Day: Tuesday April 30, 2013
Morning Session**

Chapter I Article 1 to Art. 4

Relation Art- 1 – Art. 2

Suggestions to incorporate the definitions in Art. 2 in Art. 1 had been discussed previously. Most delegations were in favour of keeping the definitions in Art 2, so it should stay that way.

Art. 1

ii: Goal should now not be to have a set of common regulations for both the Agreement and the Revised Agreement, that could be done when the time is ripe.

Secretary: Rule 7 hints towards common Regulations, so that way is left open.

Xii Deletion of the definition „Legal entity“ was suggested by various delegations. Chair suggests that this definition is a matter of national legislation, so it could be deleted. However some parties have concerns, so maybe a note or footnote could clarify that “legal entity” is a very wide concept, including the state or the competent authority or individuals.

Art. 2 Definitions

Characteristics „due“ or „attributable“ to the area of origin? “Due” was more widely accepted.

“Non geographical names” are included by “term known as referring to such area”.

Secretariat: It is not a novelty.

Maybe it should be made clearer that also the name of a country can serve as GI or AOP.

Secretariat: This is exactly the intention of the provision. Shall look into the drafting.

It would be good to remove the square brackets.

Most difficult issue “reputation”. Views on “notoriété” and “reputation” (French) were divided: are these synonyms or not? Maybe an interpretative clarification to that effect would be good.

“and which has given the good its reputation” criticized as redundant, also fn 3 “reputation may serve as evidence for reputation”.

Iran reminds of previous drafting suggestion which implemented that. Several delegations called for removal of the footnotes.

Secretariat: Present agreement has this requirement.

Art. 3 Competent Authorities

Can there be more competent authorities for different products or different tasks?

Secretariat: Rule 4: there should be only one Competent Authority, but it allows for several ones, too. Purpose of the provision however is ONLY to determine the Authority which will communicate with the office, nothing more. Surveillance or enforcement is not the issue here. So the provision does not really interfere with the structure of the national protection system.

Art. 4

„the status of“ can be deleted.

Chapter II, Art. 5 – Art. 7

Several remarks come from the plenum.

Second Day: Tuesday April 30, 2013
Afternoon Session

Chapter II, Art. 5 – Art. 7

Art 5 II ii also entities which represent producers may file applications, not only producers

Art. 5 IV transborder indication: under a) b) says inter alia that where the area is situated in countries A and B and A allows for entities to apply for a GI whereas B does not, there the entities from A may file the application but only for the part of the area situated in country A.

Rule 5

EU Option a), Rest: option b).

Rule 5 II a vi Legal effect of translation “the identifying details” (option a): after alignment with option b will read sth. like “particulars”

II a iii: Already contained in Agreement now. Countries with more than 1 language may register the respective versions.

III: Any Country may add translations of the denomination as they wish. Scope: Give an idea what the beneficiaries see as their denominations. EU is skeptical about that. Will look into it further.

Application may or may not contain the denomination in more than one language

Rule 8 drafting: subtitles include

International may waive 50% of the fees

Chapter III, Art. 8-12 , 14 (13 was discussed in session of 29 April

Art. 12

The mentioning of acquiescence is extensively discussed. Chair points out that it is a trade mark law concept. Believes it should not be in the agreement, even more because it is not defined in the agreement.

But is it called for by Art 24 VII TRIPS? Chair: Art 24 VII relates to acquiescence of trade mark right, not of GI, AOP. Even if it were the other way round, it is an optional provision. So no conflict with that. Chair suggests not to mention acquiescence in the agreement.

Secretariat: The provisions means that if the national law knows acquiescence then acquiescence is a legitimate reason for termination of protection of a GI/AOP. The provision does not mean that all countries are obliged to recognize acquiescence as a concept pertaining to rights from a GI/AOP.

AIPPI points out that acquiescence needs to be defined more precisely because under trade mark law it requires that the right holder is aware of the infringement and does not take action against it for a certain amount of time. With GI/AOP it needs to be determined whose knowledge would be sufficient to start that term.

France believes that acquiescence need not be mentioned in the agreement but it should be left to the national law to find solutions for the issue. France claims that French court had found such solutions.

Iran and Hungary plead for deleting acquiescence from the agreement because it does not fit as a concept since GI/AOP do not have an individual holder. Option: leave it out? Would that mean that the concept would be inadmissible on national level? No.

Requirement of **Renewal** on the Agreement level is discussed. Australia is for it, many delegations are against it. In the current text renewal neither on the international nor national (=states where the designation does not originate from) is required nor admitted.

Secretariat: There have been 90-100 cancellations in the Lisbon System. In the current system, there is no requirement that the country of origin, when the protection has lapsed, must communicate this to the bureau (such obligation persists under the Madrid Agreement). For the future it may be better to set a requirement to submit lapse of national protection but that is for the working group to decide.

Art. 14 Legal Remedies

France: Does that include administrative measures?

Chair suggests to add „legal and administrative system”. Delete “national” system because of IGO like EU.

Third Day: Wednesday May 1, 2013 Morning Session

Article 10 Protection Accorded

10 I b) Option b) is preferred by most delegations. Chair recommends to follow Switzerland’s suggestion to make clear that refusal may happen also ex officio.

10 I a) i: France calls for „evocation“ being included in the „chapeau“.

EU calls for three indents. The bracket in first indent should be second indent. Meaning “use (for similar or different goods) would amount to usurpation” is an alternative infringement, additional to “(any use) which would be detrimental, or exploit its reputation”. EU explains that the new second indent covers cases not yet covered.

Most delegations, so summarizes the chair, that para 2 (obligation for establishment of legal presumption) can be deleted. Since the opinions on para 3 (Homonyms) are divided the chair suggests to keep it in square brackets.

Peru and Italy want it deleted on the understanding that the current practice can be continued. Chile wants to keep para 3 in the text. Chair suggests that explanations in the notes could suffice because the legal situation would not change: homonymous denominations can be registered now, and that will be the same. Ceita suggests an agreed statement by the future diplomatic conference. Chair: para 3 will be deleted, but there will be an explanation in the notes and work will continue for further clarification on the basis of that. Chile protests, will have to contact their authorities.

Secretariat explains difference between “origin” and “provenance”. “Provenance” is the place where a product e.g. is assembled, that product however does not have its origin at that place.

Secretariat explains „goods of the same kind“. It is not the same as “similar goods”, it is less. But whether “wine” is “of the same kind” as “sparkling wine”, the secretariat does not know and suggests clarification in the regulations.

Secretariat points out that „evocation“ is very close to the notion in the (now) second tiret of 10 I a. It is also very close to Art 22 II a “use that ‘suggests’”.

Secretariat Art. 10 II „third party“ refers to a party who does not have the right to use the denomination, however „third party“ is not mentioned in II itself but only in its heading. Secretariat believed that the presumption Was desired by some delegations, bit if it is not then it may be deleted.

Secretariat Art. 10 III is meant to confirm the present practice under the Lisbon Agreement.

Article 11 Shielded against genericness

Wording of English and French versions must be brought in line.

Chair summarizes that some delegations prefer to keep the wording .

Third Day: Wednesday May 1, 2013

Afternoon Session

Secretariat distributes new version of Art 13 as non-paper. Further amendments to this non-paper are explained by chair orally. which is discussed extensively.

Para 1: Several delegations want „the interest of the general public“ to have considered.

Para 2: Several delegations want it deleted or kept in square brackets.

Para 3: what about copyrighted signs which include a GI or AOP.

Emissary of AIPPI must leave at afternoon coffee break, cannot attend sessions on Thursday and Friday.

Report written by:

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