

Protection of GIs through their International Registration

- how well advanced is the work in WIPO on the
conclusion of a treaty?

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Geographical Indications (GI) and Appellations of Origin (AO)

WIPO's Role

- Administration of several **international agreements** relevant for the protection of GIs/AOs
- Forum for discussion of possible ways to improve the **international protection** of GIs/AOs
 - *Standing Committee on the Law of Trademarks, Industrial Designs and GIs*
 - *Working Group on the Development of the Lisbon System*
- Provision of **technical assistance**

Distinctive Signs

- Distinctive Signs for **Individual** Use
 - Trademarks (goods & services)

- Distinctive Signs for **Collective** Use
 - Collective marks
 - Certification marks
 - Geographical indications
 - Appellations of origin
 - Indications of source

Overview of the international instruments related to the protection of GIs/AOs

- **Paris Convention** (1883)
- **Madrid Agreement** (1891)
(repression of false and deceptive indications of source)
- **Madrid Agreement and Protocol** (1891, 1989)
(international registration of marks)
- **Lisbon Agreement** (1958)
- **Bilateral Agreements**
- **TRIPS Agreement** (1994)

International Registration

Lisbon Agreement (Appellations of Origin)
*Madrid Protocol (Trademarks, Collective
Marks and Certification Marks)*

Lisbon Union: 27 Member States

Africa (6)

Algeria
Burkina Faso
Congo
Gabon
Togo
Tunisia

Asia (4)

Georgia
Islamic Rep. of Iran
Israel
DPR of Korea

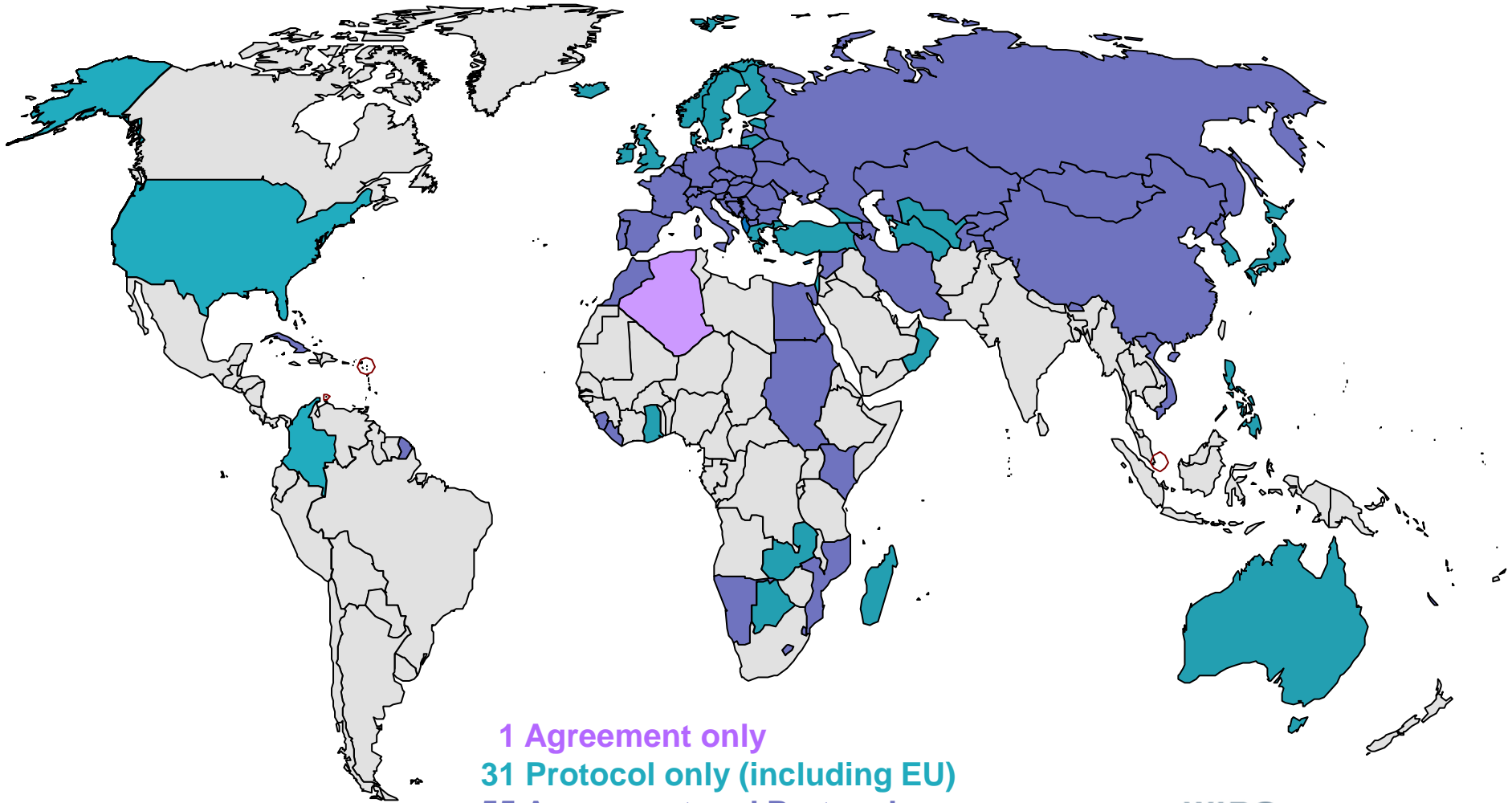
America (6)

Costa Rica
Cuba
Haiti
Mexico
Nicaragua
Peru

Europe (11)

Bulgaria
Czech Rep.
France
Hungary
Italy
Moldova
Montenegro
Portugal
Serbia
Slovakia
The FYR of Macedonia

Madrid Union



1 Agreement only
31 Protocol only (including EU)
55 Agreement and Protocol

87 Members

The Madrid Protocol

- **Aim:** to facilitate the international protection of trademarks, collective marks and certification marks through a **single notification and registration procedure**
- **Participation:** any country party to the **Paris Convention** may accede
- Administered by **WIPO** – **International Register for Marks**
- **Scope of protection:** « Protection shall be the same as if the mark had been deposited direct with the Office of the Contracting Party»
- No limitation as to **product coverage** and no distinction between categories of products in terms of scope of protection

The Lisbon Agreement

- **Aim:** to facilitate the international protection of appellations of origin (AOs) through a **single notification** and **registration procedure**
- **Participation:** any country party to the **Paris Convention** may accede
- Administered by **WIPO** – **International Register of AOs**
- **Scope of protection:** « Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as ‘kind’, ‘type’, ‘make’, ‘imitation’ or the like »
- No limitation as to **product coverage** and no distinction between categories of products in terms of scope of protection

Legal Effect

Effect of international registration

- **Lisbon**: extension of protection to countries other than the country of origin
- **Madrid**: extension of protection to countries other than the country of origin, as designated
- **Lisbon**: indefinite (in principle)
- **Madrid**: renewable every 10 years

Except in a country that ...

- issued a refusal (within the prescribed time-limit), or
- invalidated the effect of the international registration in its territory

Lisbon Union Assembly (September 2009)

■ Mandated the WG on the Development of the Lisbon System to

- look for improvements of the Lisbon system which would make the system more attractive for States and users, while preserving the principles and objectives of the Lisbon Agreement

Two-fold Mandate

1. Revision of the Lisbon Agreement

- Refinement of the Legal Framework
- Accession Possibility for IGOs
(e.g., EU, OAPI)

2. Establishment International Registration System for GIs

905 registrations – 800 in force

■ France	508	■ Portugal	7
■ Czech Rep.	76	■ Tunisia	7
■ Bulgaria	51	■ DPR of Korea	6
■ Italy	31	■ Slovakia	6
■ Hungary	28	■ FYR of Macedonia	4
■ Georgia	20	■ Serbia	3
■ Cuba	19	■ Montenegro	2
■ Mexico	14	■ Costa Rica	1
■ Peru	8	■ Israel	1
■ Algeria	7	■ Moldova	1

Total registered since 1995: 170
- of which since 2003: 55

Working Group on the Development of the Lisbon System

- ❑ The provisions of the **draft new instrument** concern:
 - Definitions for GIs and AOs
 - Procedures for international applications and registration
 - Scope of protection
 - Prior rights and prior use
 - Applications for trans-border GIs and AOs
 - Accession criteria for IGOs
(e.g., EU, OAPI)

- ❑ Revision Lisbon Agreement? New treaty?

- ❑ Workshop on dispute settlement within the Lisbon system

TRIPS Issues Debated in Doha Round

Multilateral GI Register

- Notification
- Registration
- Legal Effects / Consequences of Registration
- Fees and Costs
- Special and Differential Treatment
- Participation
- Product Coverage?

Extension High Level of Protection Beyond Wines & Spirits

The Lisbon Agreement

- **Aim:** to facilitate the international protection of AOs through a **single notification** and **registration procedure**
- Protection in other Lisbon countries is subject to **refusal** or **invalidation**
- **Participation:** any country party to the **Paris Convention** may accede
- Administered by **WIPO** – **International Register of AOs**
- **Registration costs** 500 SwF and is valid as long as the AO is protected in its country of origin
- **Scope of protection:** « Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as ‘kind’, ‘type’, ‘make’, ‘imitation’ or the like »
- No limitation as to **product coverage** and no distinction between categories of products in terms of scope of protection

Means of Protection

Flexibility

Definitions

- AO: along the lines of Article 2 Lisbon
- GI: along the lines of Article 22.1 TRIPS

- Non-geographical denominations with a traditional geographical connotation
- Concept of « country of origin »
 - Intergovernmental organizations
 - Trans-border areas

Scope of Protection

– the most difficult substantive issue

- Criteria that recognize the existence of different national systems
- Single level of protection for AOs and GIs
- (?) Specifying that protection has to be provided against misuse of reputation of the GI/AO, or misuse of its information-conveying nature,
leaving it to national law how, as long as the protection is effective (?)

Prior Use

- **« A clear split, even though the divide might not be so deep »**
- **Prior trademark rights and other prior rights**
- **Generic terms**

Examples of Lisbon Registrations Not Protected in Some Lisbon Member States (Refused or Invalidated)

- Pilsner
- Budweiser
- Pisco
- Tokaj
- Champagne

Prospects

- 6th Session of the WG: December 3 to 7, 2012
- Diplomatic Conference: within the 2014/15 biennium?

THANK YOU

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