

Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration

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NOTES ON THE BASIC PROPOSAL FOR THE REGULATIONS UNDER THE NEW ACT OF THE LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS

Document prepared by the Secretariat

The present document contains the Explanatory Notes on the Basic Proposal for the Regulations under the New Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, as contained in document LI/DC/4. Where a provision appears not to require explanation, no note has been provided.

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NOTES ON RULE 1: ABBREVIATED EXPRESSIONS

R1.01 Rule 1 represents an adapted version of the model of Rule 1 of the Regulations under the Singapore Treaty on the Law of Trademarks of 2006. On substance, the provision is based on Rule 1 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

NOTES ON RULE 2: CALCULATION OF TIME LIMITS

R2.01 The provisions of this rule are based on those contained in Rule 2 of the current Lisbon Regulations.

NOTES ON RULE 3: WORKING LANGUAGES

R3.01 The provisions of this rule largely reproduce those contained in Rule 3 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

NOTES ON RULE 4: COMPETENT AUTHORITY

R4.01 This rule is drafted in accordance with the practice that has developed under Rule 4 of the current Lisbon Regulations.

R4.02 As regards the responsibilities of Competent Authorities, reference is made to Article 3 of the draft New Act. In addition, Rule 4(1) makes clear that the name and contact details of the Competent Authority must be notified at the time of accession.

R4.03 Paragraph (2) should be seen in light of the fact that, unlike in other areas of industrial property, there may be more than one authority in a Contracting Party that is responsible for the grant of protection in respect of appellations of origin. For example, different protection systems may apply in respect of appellations of origin and/or geographical indications in a Contracting Party and different authorities may have been empowered for those different protection systems. In addition, as suggested at the eighth session of the Working Group, under the regional legislation of an intergovernmental organization, certain competencies of the Competent Authority of the intergovernmental organization may have been delegated to other authorities, for example the Competent Authority of a member State of the intergovernmental organization (document LI/WG/DEV/8/7 Prov, paragraph 41).

R4.04 Paragraph (3) has been drafted in recognition of the practical experience of the International Bureau with regard to changes of the name or contact details of a Competent Authority.

NOTES ON RULE 5: REQUIREMENTS CONCERNING THE APPLICATION

R5.01 Paragraph (1) corresponds to Rule 5(1) of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

R5.02 The provisions of paragraphs (2) and (5) correspond to those of paragraphs (2) and (3) of Rule 5 of the current Lisbon Regulations, as adapted in accordance with the provisions of Article 5 of the draft New Act. Under item (vii) of paragraph (2)(a), where a Contracting Party of Origin provides for the registration of appellations of origin or geographical

indications, the application is to indicate the date and registration number under which the appellation of origin or the geographical indication is protected in the Contracting Party of Origin. Where a Contracting Party grants protection by means of, for example, ministerial decrees or court decisions, the application is to indicate the title and date of such decree or decision.

R5.03 In view of the discussions at the ninth session of the Working Group, Rule 5(5) no longer provides for the possibility of including translations of the appellation of origin or the geographical indication in the application other than under Rule 5(2)(a)(iv). However, it should be noted that under Article 11 of the draft New Act – similarly to Article 3 of the current Lisbon Agreement – appellations of origin and geographical indications would be protected, *inter alia*, against their use in translated form.

R5.04 As regards the pending issue referred to in paragraph 4, item (xiv), of document LI/DC/5, reference is made to the draft Report of the tenth session of the Working Group (document LI/WG/DEV/10/7 Prov., paragraphs 33 to 37). Following the discussion at that session, Rule 5(3) is presented with three Alternatives. The provision is based on Rule 5(3)(vi) of the current Lisbon Regulations, which is an optional provision, adopted by the Lisbon Union Assembly in September 2011 and in force only since January 1, 2012. In view of the crucial nature of the information concerned under the national or regional legislation of a number of delegations, these delegations have proposed that the provision should be mandatory (Alternative A). Other delegations take the view that the information is not required under the legislation of many other countries and that the provision should therefore remain optional (Alternative B). At the eighth and ninth sessions of the Working Group, reference was made to Rule 7(2) of the Common Regulations under the Madrid Agreement and Protocol as a model. This suggestion could be combined with the model of Article 7(5) of the draft New Act. Thus, Alternative C provides that a Contracting Party could notify a declaration to the Director General stating that the information referred to in paragraph (3) is required under its legislation and should be notified to it together with the notification of the international registration. Failure to provide the information would then have the effect of a renunciation under Rule 16. In addition, paragraph (3) also specifies that the information can be provided later, in the context of a withdrawal of the renunciation under Rule 16(2).

R5.05 Rule 5(4) aims to accommodate those countries where the protection of registered appellations of origin and geographical indications would be subject to a use requirement. In this regard, reference is made to the discussions at the eighth session of the Working Group. Along the same lines, following a concern raised at the ninth session of the Working Group, Rule 5(4) also allows Contracting Parties which require an application to be signed by the owner, or the one entitled to use the appellation of origin or the geographical indication, to notify such requirement to the Director General. Thus, for example, in respect of certification marks, the certifying body may be the owner signing the application, while declaring that the mark is intended to be used *bona fide* by persons authorized by the certifying body. In respect of a Contracting Party of Origin where appellations of origin and geographical indications are owned by the State, the question has arisen whether the Competent Authority would be entitled to sign the application on behalf of the State, in order to meet such a signature requirement in another Contracting Party. As regards the pending issue referred to in paragraph 4, item (xv), of document LI/DC/5, reference is made to the draft Report of the tenth session of the Working Group (document LI/WG/DEV/10/7 Prov., paragraphs 28 to 32 and 38).

R5.06 As regards the pending issue referred to in paragraph 4, item (xvi), of document LI/DC/5, reference is made to the draft Report of the tenth session of the Working Group (document LI/WG/DEV/10/7 Prov., paragraphs 39 to 51). Following the discussion at that session, Rule 5(5) reflects two Alternatives. There may be situations in which disclaimers should be mandatory, for example in the situation referred to in footnote 2 to Article 11, if so specified in the registration or other protection-granting instrument in the Contracting Party of Origin. Alternative A was proposed at the tenth session of the Working Group as a possible

solution to the issue that the International Bureau will not be in a position to check whether an application should contain such a disclaimer. Alternative B would leave it to the applicant whether to present such a disclaimer or not.

NOTES ON RULE 6: IRREGULAR APPLICATIONS

R6.01 The provisions of this rule largely reproduce those contained in Rule 6 of the Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

NOTES ON RULE 7: ENTRY OF THE APPELLATION OF ORIGIN IN THE INTERNATIONAL REGISTER

R7.01 Paragraph (1) is modeled on Rule 7(1) of the Lisbon Regulations but has been adapted to reflect the fact that the International Register would incorporate the registrations effected both under the Lisbon Agreement and the 1967 Act and under the draft New Act (see Note 4.01 on the draft New Act, document LI/WG/DEV/7/4). As long as not all States party to the Lisbon Agreement or the 1967 Act have joined the New Act, the International Register should reflect for which States a registration is governed by the Lisbon Agreement and the 1967 Act or by the New Act. Of course, to the extent an application originates in a Contracting Party that is party to both the Lisbon Agreement or the 1967 Act and the New Act, the International Bureau must examine the application not only on the basis of the requirements of the New Act, but also on the basis of the requirements that apply under the Lisbon Agreement and the 1967 Act.

R7.02 The provisions of paragraphs (2) and (3) of this rule largely reproduce those contained in Rule 7 of the Lisbon Regulations with regard to the contents of registrations, the registration certificate and the notification of new registrations, as adapted in accordance with the provisions of the draft New Act.

R7.03 Paragraph (4) addresses the situation concerning international registrations of appellations of origin already recorded under the Lisbon Agreement or the 1967 Act, once the mutual relations between two States become governed by the provisions of Article 31(1) of the draft New Act.

NOTES ON RULE 8: FEES

R8.01 The provisions of Rule 8(1) are modeled on those contained in Rule 23 of the current Lisbon Regulations. However, in view of the discussions at the eighth, ninth and tenth sessions of the Working Group, the amounts appear in square brackets. For the reasons outlined in the Notes on Article 7, notably Note 7.02, the income from registration fees is unlikely ever to be sufficient to cover the cost of the operations under the Lisbon system. As reflected in Annex III, Table 12, of the WIPO Program and Budget for 2014/15, 98 per cent of the income of the Lisbon Union is from other sources than fees – namely, as the same table shows, from its share in general income features of WIPO – and the estimated income for the Lisbon Union is some 700,000 Swiss francs. Although this is not enough to cover the current staff cost of the Lisbon Registry, it should be borne in mind that the main activities of the Lisbon Registry currently to a large extent consist of the services it provides in respect of the revision of the Lisbon system and related promotion activities. In addition, the Lisbon Registry is engaged in a project aimed at automating its operations under the registration and notification procedures as much as possible.

R8.02 Rule 8(1)(v), 8(2) and 8(3) implement Article 7(5) and (6), which was added to the draft New Act so as to reflect the view expressed at the eighth session of the Working Group by a number of delegations representing countries that are not party to the Lisbon Agreement, that Contracting Parties should have the option to require a fee to cover the cost of their substantive examination of international registrations notified to them. Rule 8(2) and (3) are modeled on the corresponding provisions in the Common Regulations that apply in the context of the Madrid and Hague systems.

R8.03 Paragraphs (4) to (9) of Rule 8 are also modeled on the corresponding provisions applying in the context of the Madrid and Hague systems. They reflect the practice that also applies under the current Lisbon system.

NOTES ON RULE 9: REFUSAL

R9.01 The provisions of this rule reproduce those contained in Rule 9 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

R9.02 Rule 9(2)(v) is proposed in order to address the specific situation of international registrations refused in part by a Contracting Party because of the possible coexistence under the legislation of such Contracting Party with a prior right, notably a homonymous geographical indication or appellation of origin. By way of example, reference is made in this regard to paragraph 135 of the Report of the fourth session of the Working Group (document LI/WG/DEV/4/7).

R9.03 As discussed at the ninth session of the Working Group, Rule 9(2)(v) and (vi) would not create any obligation for a Contracting Party to provide for the possibility of partial refusals. These provisions only apply where a Contracting Party is in a position, under its own legislation, to issue a partial refusal.

NOTES ON RULE 10: IRREGULAR NOTIFICATION OF REFUSAL

R10.01 The provisions of this rule reproduce those contained in Rule 10 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

NOTES ON RULE 11: WITHDRAWAL OF REFUSAL

R11.01 The provisions of this rule reproduce those contained in Rule 11 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

R11.02 Compared to the provisions of Rule 11 of the current Lisbon Regulations, a new provision (paragraph (2)(ii)) is proposed, requiring the reason for the withdrawal to be mentioned in the statement, in particular in case of partial withdrawals corresponding to partial refusals, as referred to in Rule 9(2)(v) or (vi) of these draft Regulations.

NOTES ON RULE 12: NOTIFICATION OF GRANT OF PROTECTION

R12.01 The provisions of this rule reproduce those contained in Rule 11*bis* of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

R12.02 Compared to the provisions of Rule 11*bis* of the current Lisbon Regulations, a new provision (paragraph (2)(b)(iii)) is proposed, requiring the reason for the withdrawal to be mentioned in the statement, in particular in case of partial statements of grant of protection corresponding to partial refusals, as referred to in Rule 9(2)(v) or (vi) of these draft Regulations.

NOTES ON RULE 13: NOTIFICATION OF INVALIDATION OF THE EFFECTS OF AN INTERNATIONAL REGISTRATION IN A CONTRACTING PARTY

R13.01 The provisions of this rule reproduce those contained in Rule 16 of the current Lisbon Regulations, including the amendment adopted by the Assembly in September 2011, as adapted in accordance with the provisions of the draft New Act.

R13.02 Compared to the provisions of Rule 16(1) of the current Lisbon Regulations, it is proposed to mirror in item (iv) of paragraph (1) not only the situations covered by Rule 9(2)(vi) of these draft Regulations, but also the specific case of homonymous geographical indications and appellations of origin, as covered by Rule 9(2)(v).

NOTES ON RULE 14: NOTIFICATION OF TRANSITIONAL PERIOD GRANTED TO THIRD PARTIES

R.14.01 The provisions of this rule reproduce those contained in Rule 12 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act. Following the discussions at the seventh session of the Working Group, Rule 14(1)(iii) was amended by the introduction of the phrase concerning the submission of information on the scope of the transitional use.

NOTES ON RULE 15: MODIFICATIONS

R15.01 The provisions of this rule are modeled on those contained in Rule 13 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

R15.02 In Rule 15(1), a new item (vi) was added, so as to align the provision with those of Rule 16.

NOTES ON RULE 16: RENUNCIATION OF PROTECTION

R16.01 The provisions of this rule are modeled on those contained in Rule 14 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

R16.02 As regards the phrase “in whole or in part” in Rule 16(1) and (2), the question arose at the seventh session of the Working Group as to whether it would be possible to issue a renunciation in respect of only some of the products covered by the international registration. However, at the ninth session of the Working Group, the Chair concluded that the phrase, as contained in Rule 16, relates to the number of Contracting Parties in respect of which protection is renounced.

R16.03 Paragraphs (2) and (4) were added in view of the possibility that the reason why protection was renounced may disappear subsequently. In that case, the renunciation can be withdrawn, subject to payment of the fee that applies in respect of modifications.

R16.04 Rule 16 will also apply in case of non-payment of an individual fee under Article 7(6) or subsequent payment of such a fee.

NOTES ON RULE 17: CANCELLATION OF AN INTERNATIONAL REGISTRATION

R17.01 The provisions of this rule largely reproduce those contained in Rule 15 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

NOTES ON RULE 18: CORRECTIONS MADE TO THE INTERNATIONAL REGISTER

R18.01 The provisions of this rule reproduce those contained in Rule 17 of the current Lisbon Regulations, as adapted in accordance with the provisions of the draft New Act.

NOTES ON RULE 19: PUBLICATION

R19.01 Compared to Rule 18 of the current Lisbon Regulations, the reference to the Bulletin has not been retained, as publication may, in the future, take place on the WIPO web site.

NOTES ON RULE 20: EXTRACTS FROM THE INTERNATIONAL REGISTER AND OTHER INFORMATION PROVIDED BY THE INTERNATIONAL BUREAU

R20.01 The provisions of this rule reproduce those contained in Rule 19 of the current Lisbon Regulations.

NOTES ON RULE 21: SIGNATURE

R21.01 This rule reproduces Rule 20 of the current Lisbon Regulations.

NOTES ON RULE 22: DATE OF DISPATCH OF VARIOUS COMMUNICATIONS

R22.01 The provisions of this rule largely reproduce those contained in Rule 21 of the current Lisbon Regulations. As regards the additional phrase referring to the Administrative Instructions, reference is made to Section 9 of the Administrative Instructions that apply under the current Lisbon Agreement.

NOTES ON RULE 23: MODES OF NOTIFICATION BY THE INTERNATIONAL BUREAU

R23.01 The provisions of this rule are modeled on those contained in Rule 22 of the current Lisbon Regulations.

Notes on Rule 24: Administrative Instructions

R24.01 The provisions of this rule largely reproduce those contained in Rule 23*bis* of the current Lisbon Regulations. However, the reference to the Bulletin has not been retained, for the reason mentioned in Note 19.01.

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