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PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION AND THE GENEVA ACT OF THE LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS

Document prepared by the Secretariat

I. INTRODUCTION

1. The present document proposes amendments to the Common Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (hereinafter referred to as “the Common Regulations”).

2. More specifically, these proposals concern amendments to Rule 9(1) (Refusal) and Rule 15(1) (Modifications) of the Common Regulations. It is also proposed to amend the procedure relating to the failure to meet a requirement based on a notification made under Rule 5(3) or (4) of the Common Regulations, or on a declaration made under Article 7(4) of the Geneva Act, which is regulated in the Common Regulations (proposed amendments to Rule 5(3), Rule 5(4), Rule 6(1), Rule 7(3), Rule 7(4), Rule 8(1), Rule 9(1), Rule 16(2), and proposed introduction of a new Rule 7*ter*).

3. The entry into force of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (hereinafter referred to as “the Geneva Act”) has brought to light the need to consider amendments to the Common Regulations to simplify and streamline the procedures under the Lisbon System for the International Registration of Appellations of Origin and Geographical Indications (hereinafter referred to as “the Lisbon System”), also with the aim of providing greater clarity to the users of the Lisbon System.

4. The proposed amendments are reproduced in the Annex to this document.

II. PROPOSED AMENDMENTS

(A) REFUSAL (PROPOSED AMENDMENTS TO RULE 9(1))

5. Subparagraph (c) under Rule 9(1) of the Common Regulations was introduced to facilitate the identification of the start date of the refusal period with respect to Competent Authorities and interested third parties through the implementation of a common standard, thereby providing greater legal certainty.

6. In that regard, further explanations are provided under the Notes on Rule 9 in the “Notes on the Draft Common Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications” (document LI/WG/PCR/2/3 Rev., page 8). Reference is also made to the statement reproduced in paragraph 55 of the “Report of the First Session of the Working Group for the Preparation of Common Regulations under the Lisbon Agreement and the Geneva Act of the Lisbon Agreement” (document LI/WG/PCR/1/6).

7. The reason for the proposed amendment in Rule 9(1)(c) of the Common Regulations is to correct an ambiguity that still exists in Rule 9(1), as currently drafted. The objective is to clarify that the general principle introduced in subparagraph (c) applies to all refusals received in accordance with subparagraph (b), and that subparagraph (b) should be read in conjunction with subparagraph (c), rather than separately.

(B) MODIFICATIONS (PROPOSED AMENDMENTS TO RULE 15(1))

8. Rule 15(1) of the Common Regulations lists the modifications that may be recorded in the International Register. Currently, two subparagraphs under Rule 15(1) of the Common Regulations refer to modifications concerning the beneficiaries, namely:

- Rule 15(1)(i) relating to the addition or deletion of a beneficiary or some beneficiaries; and
- Rule 15(1)(ii) relating to a modification of the names or addresses of the beneficiaries or of the natural person or legal entity referred to in Article 5(2)(ii) of the Geneva Act.

The distinction between these two types of modification is often a source of error for the users of the Lisbon System.

9. In order to streamline the procedure concerning the request for entry of a modification presented to the International Bureau, it is hereby proposed to amend Rule 15(1) by merging the two subparagraphs (i) and (ii) under Rule 15(1) into a single subparagraph (i).

(C) FAILURE TO MEET A REQUIREMENT BASED ON A NOTIFICATION MADE UNDER RULE 5(3) OR (4) OF THE COMMON REGULATIONS, OR ON A DECLARATION MADE UNDER ARTICLE 7(4) OF THE GENEVA ACT (PROPOSED AMENDMENTS TO RULE 5(3), RULE 5(4), RULE 6(1), RULE 7(3), RULE 7(4), RULE 8(1), RULE 9(1), RULE 16(2), AND PROPOSED INTRODUCTION OF A NEW RULE 7TER)

10. Currently, Rule 6(1)(d) of the Common Regulations prescribes that, in the case of an irregularity with respect to a requirement based on a notification made under Rule 5(3) or Rule 5(4) of the Common Regulations or on a declaration made under Article 7(4) of the Geneva Act, the protection resulting from the international registration shall be considered to be renounced in the Contracting Party that has made the notification or the declaration, if the correction of the irregularity is not received by the International Bureau within the three-month period indicated in the invitation to remedy the irregularity.

11. Rule 6(1)(d) of the Common Regulations applies *mutatis mutandis* not only in the case of applications for the international registration of an appellation of origin or a geographical indication, but also in the case of a ratification of, or an accession to, the Geneva Act by a Contracting Party to the Lisbon Agreement with international registration(s) in force under the Lisbon Agreement (see Rule 7(4)(d) of the Common Regulations), and in the case of a ratification of, or an accession to, the Geneva Act by a Contracting Party to the Geneva Act that makes a notification under Rule 5(3) or (4), or a declaration under Article 7(4) of the Geneva Act with respect to international registrations in force under the Geneva Act.

12. With the development of the Lisbon System in terms of membership and number of international registrations, there is a high probability that the renunciations under Rule 6(1)(d) of the Common Regulations will drastically increase given the short time limit for Competent Authorities to meet a requirement based on a notification made under Rule 5(3) or (4) of the Common Regulations, or on a declaration made under Article 7(4) of the Geneva Act. This would result in a significant increase not only in the number of entries made in the International Register, but also in the number of notifications to be issued by the International Bureau and their subsequent treatment by Competent Authorities.

13. It is therefore proposed to amend the Common Regulations to specify that international registrations will have no effect in a Contracting Party to the Geneva Act that has made a notification under Rule 5(3) or (4) of the Common Regulations, or a declaration under Article 7(4) of the Geneva Act in that Contracting Party, until the date on which the registered appellation of origin or geographical indication fulfils the additional requirement(s) under Rule 5(3) or (4) of the Common Regulations, or under Article 7(4) of the Geneva Act. Relevant information will be entered in the International Register and published in accordance with Rule 19. This would be somewhat similar to the mechanism which already exists under the Madrid System for the International Registration of Marks, which is also known to as a “designation subsequent to the international registration” (see Rule 24 of the Regulations under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks).

14. The proposed amendments to Rule 5(3) and (4), Rule 6(1), Rule 7(3) and (4), Rule 8(1), Rule 9(1) and Rule 16(2) of the Common Regulations, as well as the proposed introduction of a new Rule 7ter, will streamline the procedure under the Lisbon System and make the System more user-friendly. With the proposed amendments, Competent Authorities and beneficiaries of registered appellations of origin and geographical indications will be in a position to decide when to request the extension of the protection of their international registration with respect to those Contracting Parties that have made the notifications or declaration referred to in paragraph 13, above, instead of being put under the obligation to meet those requirements at the moment of

accession of those new Contracting Parties in order to prevent the renunciation mechanism from automatically coming into play under the existing provisions (see Rule 16(2) in combination with Rule 15(1)(vi) of the Common Regulations).

III. DATE OF ENTRY INTO FORCE

15. It is suggested that the Working Group recommend to the Lisbon Union Assembly that the proposed amendments enter into force on January 1, 2023.

16. *The Working Group is invited to:*

(i) consider and comment on the proposals made in this document; and

(ii) recommend to the Assembly of the Lisbon Union the adoption of some or all of the proposed amendments to the Common Regulations under the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration and the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, as presented in the Annex to this document or in amended form, for their entry into force on January 1, 2023.

[Annex follows]

PROPOSED AMENDMENTS TO THE COMMON REGULATIONS UNDER THE LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION AND THE GENEVA ACT OF THE LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS

Common Regulations Under the Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration and the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications

as in force on [January 1, 2023](#) ~~December 8, 2024~~

[...]

**Chapter II
Application and International Registration**

**Rule 5
Requirements Concerning the Application**

[...]

(3) *[Application Governed by the Geneva Act – Particulars Concerning the Quality, Reputation or Characteristic(s)]*

[...]

(c) [Subject to Article 6\(5\)\(b\) of the Geneva Act, where an](#) ~~An~~ application ~~that~~ is not in accordance with a requirement as notified by a Contracting Party under subparagraph (a), [the appellation origin or geographical indication that is the subject of an international registration](#) shall [be considered](#), subject to Rule 6, [as having no](#) ~~have the effect that protection is renounced~~ in respect of that Contracting Party.

(4) *[Application Governed by the Geneva Act – Signature and/or Intention to Use]*

[...]

(c) [Subject to Article 6\(5\)\(b\) of the Geneva Act, where an](#) ~~An~~ application governed by the Geneva Act ~~that~~ is not signed in accordance with subparagraph (a), or ~~that~~ is not accompanied by [the a](#) declaration indicated in subparagraph (b), [the appellation origin or geographical indication that is the subject of an international registration](#), shall [be considered](#), subject to Rule 6, [as having no](#) ~~have the effect that protection is renounced~~ in respect of the Contracting Party requiring such signature or declaration, as notified under subparagraphs (a) and (b).

[...]

Rule 6 Irregular Applications

(1) *[Examination of the Application and Correction of Irregularities]*

[...]

(d) In the case of an irregularity with respect to a requirement based on a notification made under Rule 5(3) or (4), or on a declaration made under Article 7(4) of the Geneva Act, if the correction of the irregularity is not received by the International Bureau within the three-month period referred to in subparagraph (a), the protection resulting from the international registration shall be considered ~~as having no effect to be renounced~~ in the Contracting Party that has made the notification or the declaration, subject to Article 6(5)(b) of the Geneva Act. The International Bureau shall enter relevant information in the International Register.

[...]

Rule 7 Entry in the International Register

[...]

(3) *[Certificate and Notification]*

(a) The International Bureau shall:

[...]

(ii) notify the international registration to the Competent Authority of each Contracting Party, subject to Rule 6(1)(d).

(b) In the case referred to in Rule 6(1)(d), the International Bureau shall notify the international registration to the Competent Authority of the Contracting Party that has made a notification under Rule 5(3) or (4), or a declaration under Article 7(4) of the Geneva Act, upon fulfilment of the requirement based on the notification under Rule 5(3) or (4), or the declaration under Article 7(4) of the Geneva Act, and payment of the fee specified in Rule 8(1)(ii).

(4) *[Implementation of Articles 29(4) and 31(1) of the Geneva Act]*

(a) In case of the ratification of, or accession to, the Geneva Act by a State that is party to the 1967 Act, Rules 5(2) to (4) shall apply *mutatis mutandis* with regard to international registrations or appellations of origin effective under the 1967 Act in respect of that State. The International Bureau shall verify with the Competent Authority concerned any modifications to be made, in view of the requirements of Rules 3(1) and 5(2) to (4), for the purpose of their registration under the Geneva Act and shall notify international registrations thus effected to all other Contracting Parties that are party to the Geneva Act, subject to Rule 6(1)(d). Modifications shall be subject to payment of the fee specified in Rule 8(1)(ii) or (iii), as applicable.

[...]

Rule 7ter

Date of Effects of International Registration Notified under the Rule 7(3)(b)

In the case referred to in Rule 7(3)(b), a registered appellation of origin or geographical indication shall be protected, in the Contracting Party that has made a notification under Rule 5(3) or (4), or a declaration under Article 7(4) of the Geneva Act, from the date on which the additional element required under Rule 5(3) or (4), or under Article 7(4) of the Geneva Act, is received by the International Bureau with respect of the registered appellation of origin or geographical indication, subject to Article 6(5)(b) of the Geneva Act.

Rule 8 Fees

(1) *[Amount of Fees]* The International Bureau shall collect the following fees, payable in Swiss francs:

[...]

(ii) [fee for the fulfillment of requirements under Rule 5\(3\) or \(4\), or Article 7\(4\), subsequent to international registration or subsequent to accession to the Geneva Act³ – 500](#)

(iii) fee for each modification of an international registration³ – 500

(iv) fee for providing an extract from the International Register – 150

(v) fee for providing an attestation or any other written information concerning the contents of the International Register – 100

(vi) individual fees as referred to in paragraph (2).

[...]

Chapter III Refusal and Other Actions in Respect of International Registration

Rule 9

Refusal

(1) *[Notification to the International Bureau]*

[...]

(b) The refusal shall be notified within a period of one year from the receipt of the notification of the international registration under Article 5(2) of the 1967 Act or under ~~the~~ Article 6(4) of the Geneva Act, [or under Rule 7\(3\)\(b\)](#). In the case of Article 29(4) of the Geneva Act, this time limit may be extended by another year.

(c) Unless demonstrated to the contrary by the Competent Authority referred to in subparagraph (a), the notification of an international registration [referred to in subparagraph \(b\)](#) shall be deemed to have been received by the Competent Authority 20 days after the date indicated in the notification.

[...]

³ For an international registration referring to a geographical area located in a least developed country (LDC), in accordance with the lists established by the United Nations, the fee is reduced to 50 per cent of the prescribed amount (rounded to the nearest full figure). In such case, the fee will amount :
= to 500 Swiss francs for an international registration referring to a geographical area of origin located in an LDC;
= [to 250 Swiss francs for the fulfillment of requirements under Rule 5\(3\) or \(4\), or Article 7\(4\), subsequent to international registration or subsequent to accession to the Geneva Act](#); and
= to 250 Swiss francs for each modification of an international registration referring to a geographical area of origin located in an LDC.
These fee reductions will apply three years after the entry into force of the Geneva Act.

Rule 15 Modifications

(1) *[Permissible Modifications]* The following modifications may be recorded in the International Register:

(i) a modification of the beneficiaries consisting in the addition or deletion of a beneficiary or some beneficiaries; or

~~(ii)~~ a modification of the names or addresses of the beneficiaries or of the natural person or legal entity referred to in Article 5(2)(ii) of the Geneva Act;

(iii) a modification of the limits of the geographical area of production or the geographical area of origin of the good or goods to which the appellation of origin, or the geographical indication, applies;

~~(iii)~~ a modification relating to the legislative or administrative act, the judicial or administrative decision, or the registration referred to in Rule 5(2)(a)(vii);

(iv) a modification relating to the Contracting Party of Origin that does not affect the geographical area of production or the geographical area of origin of the good or goods to which the appellation of origin, or the geographical indication, applies;

(vi) a modification under Rule 16.

[...]

Rule 16 Renunciation of Protection

[...]

(2) *[Withdrawal of a Renunciation]*

(a) Any renunciation, ~~including a renunciation under Rule 6(1)(d),~~ may be withdrawn, in whole or in part, at any time by the Competent Authority of the Contracting Party of Origin or, in the case of Article 5(3) of the Geneva Act, the beneficiaries or the natural person or legal entity referred to in Article 5(2)(ii) of that Act or the Competent Authority of the Contracting Party of Origin, subject to payment of the fee for a modification ~~and, in the case of a renunciation under Rule 6(1)(d), the correction of the irregularity.~~

(b) Subject to Article 6(5)(b) of the Geneva Act, in each Contracting Party in which a renunciation has effect, a registered appellation of origin or geographical indication shall be protected from the date on which:

(i) the withdrawal of renunciation is received by the International Bureau in the case of a renunciation referred to in paragraph (1); ~~and~~

~~(ii) the correction of the irregularity is received by the International Bureau in the case of a renunciation referred to in Rule 6(1)(d).~~

[...]

[End of Annex and of document]