

Working Group on the Development of the Lisbon System (Appellations of Origin)

Sixth Session
Geneva, December 3 to 7, 2012

DRAFT SUMMARY BY THE CHAIR

prepared by the Secretariat

1. The Working Group on the Development of the Lisbon System (Appellations of Origin) (hereinafter referred to as "the Working Group") met in Geneva, from December 3 to 7, 2012.
2. The following Contracting Parties of the Lisbon Union were represented at the session: Algeria, Czech Republic, France, Georgia, Hungary, Iran (Islamic Republic of), Italy, Mexico, Peru, Portugal, Serbia, the former Yugoslav Republic of Macedonia (12).
3. The following States were represented as observers: Australia, Benin, Burundi, Chile, Colombia, Germany, Iraq, Libya, Madagascar, Philippines, Romania, Russian Federation, Saudi Arabia, Slovenia, Spain, Sri Lanka, Switzerland, Thailand, Turkey, United States of America (20).
4. Representatives of the following international intergovernmental organizations (IGOs) took part in the session in an observer capacity: African Regional Intellectual Property Organization (ARIPO), European Union (EU), International Vine and Wine Office (IWO) (3).
5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: Brazilian Association of Intellectual Property (ABPI), Centre for International Intellectual Property Studies (CEIPI), International Trademark Association (INTA), MARQUES (Association of European Trademark Owners), Organization for an International Geographical Indications Network (oriGIn) (5).
6. The list of participants is contained in document LI/WG/DEV/6/INF/1 Prov. 2^{*}.

^{*} The final list of participants will be made available as an Annex to the report of the session.

AGENDA ITEM 1: OPENING OF THE SESSION

7. The Director General of WIPO, Mr. Francis Gurry, opened the session, recalled the mandate of the Working Group and introduced the draft agenda, as contained in document LI/WG/DEV/6/1 Prov.

AGENDA ITEM 2: ELECTION OF A CHAIR AND TWO VICE-CHAIRS

8. Mr. Mihály Ficsor (Hungary) was unanimously elected as Chair of the Working Group, Mr. Alberto Monjarás Osorio (Mexico) and Mr. Behzad Saberi Ansari (Iran (Islamic Republic of)) were unanimously elected as Vice-Chairs.

9. Mr. Matthijs Geuze (WIPO) acted as Secretary to the Working Group.

AGENDA ITEM 3: ADOPTION OF THE AGENDA

10. The Working Group adopted the draft agenda (document LI/WG/DEV/6/1 Prov.) without modification.

AGENDA ITEM 4: REPORT OF THE FIFTH SESSION OF THE WORKING GROUP ON THE DEVELOPMENT OF THE LISBON SYSTEM (APPELLATIONS OF ORIGIN)

11. The Working Group took note of the adoption, on November 16, 2012, of the Report of the Fifth Session of the Working Group, as contained in document LI/WG/DEV/5/7, in accordance with the procedure established at the fifth session of the Working Group.

AGENDA ITEM 5: DRAFT NEW INSTRUMENT CONCERNING THE INTERNATIONAL REGISTRATION OF GEOGRAPHICAL INDICATIONS AND APPELLATIONS OF ORIGIN AND DRAFT REGULATIONS UNDER THE DRAFT NEW INSTRUMENT

12. Discussions were based on documents LI/WG/DEV/6/2, LI/WG/DEV/6/3, LI/WG/DEV/6/4 and LI/WG/DEV/6/5. The Working Group examined in detail Chapters I to IV of the Draft New Instrument and also went through the rest of the Draft New Instrument as well as the Draft Regulations, while focusing on issues highlighted by delegations.

13. The Working Group reiterated its general commitment to the two-fold mandate to work:
(i) towards a revision of the Lisbon Agreement that would involve a refinement of the current legal framework and the inclusion of the possibility of accession by intergovernmental organizations, while preserving the principles and objectives of the Lisbon Agreement, and
(ii) towards the establishment of an international registration system for geographical indications.

14. The Chair noted the wide support expressed for one single Draft New Instrument covering both appellations of origin and geographical indications and incorporating separate definitions for each, and also noted that some delegations had expressed flexibility in that regard, while one delegation had favored a separate draft treaty on geographical indications, as contemplated in Annex II, Option B, of document LI/WG/DEV/6/2. He further observed that those in favor of a single Draft New Instrument also supported the establishment of a single International Register which would cover both appellations of origin and geographical indications.

15. The Chair also noted the view of the Working Group that the Draft New Instrument should provide for a single and high level of protection for both appellations of origin and geographical indications.

16. The Chair also noted the renewed plea for clarification of the relationship between the protection of appellations of origin/geographical indications and trademark rights.

17. The Chair noted the comments made on how provisions of other international instruments, such as the Paris Convention or the TRIPS Agreement, should be made applicable under the Draft New Instrument and, in particular, whether this should be achieved by a mere reference to such provisions or whether the substance of such provisions should be taken over in the Draft New Instrument in order to clearly lay down the obligations of the Contracting Parties.

18. Referring to the detailed discussions on Articles 10 and 11 of the Draft Revised Lisbon Agreement contained in Annex I of document LI/WG/DEV/6/2, the Chair clarified that the various non-papers submitted in the course of the discussions on Chapter III would be reflected in the report of the session. He further indicated that the latest version of the non-paper he had submitted, as amended during the discussions (see the Annex to the present document), would be incorporated in the Revised Draft New Instrument that would be prepared by the Secretariat for the next session and would serve as the basis for future discussions on Articles 10 and 11.

Future work

19. The Chair confirmed that two further meetings of the Working Group would be convened in 2013, one before and the other after the session of the Assemblies of the Member States of WIPO in the autumn of 2013.

20. In view of the progress made at the present session, the focus of the next session would be the examination and discussion of a revised version of the Draft New Instrument and Draft Regulations that would be prepared by the Secretariat and distributed well in advance of the next session. In particular, the Secretariat would work on the basis of the comments made at the present session and would make sure that all comments and suggestions be duly reflected in those revised versions.

21. As regards the overall structure of the Revised Draft New Instrument and Draft Regulations, the Working Group requested the Secretariat to prepare a Draft Revised Lisbon Agreement that would take the form of a single instrument covering both appellations of origin and geographical indications and providing for a high and single level of protection for both, while maintaining two separate definitions, on the understanding that the substantive provisions concerning appellations of origin would extend to geographical indications.

22. The Chair encouraged participants to submit comments and drafting suggestions to the Secretariat, between Working Group sessions, on the electronic forum that had been established for that purpose, while also recalling that such comments and suggestions would be posted for information purposes only and without prejudice to the role of the Working Group and the formal discussions therein.

AGENDA ITEM 6: OTHER MATTERS

23. While referring to paragraph 21 of the Summary by the Chair of the Fifth Session of the Working Group (document LI/WG/DEV/5/6), the Delegation of the European Union expressed the wish that the workshop on dispute settlement within the Lisbon system should be organized as a side event in the margins of one of the sessions of the Working Group in 2013.

AGENDA ITEM 7: ADOPTION OF THE SUMMARY BY THE CHAIR

[24. The Working Group approved the Summary by the Chair, as contained in the present document.]

25. A draft of the full report of the session of the Working Group will be made available on the WIPO web site for comments by the delegations and representatives that participated in the meeting. Participants will be informed once the draft report is available on the WIPO web site. Participants can submit comments within one month from its publication date, after which a track-changes version of the document, taking into account all the comments received from participants, will be made available on the WIPO web site. The availability of the comments and the track-changes version will also be communicated to participants, together with a deadline for the submission of final comments on that track-changes version. Thereafter, the report, taking into account the final comments, as appropriate, will be published on the WIPO web site without track changes, indicating the date of such final publication. As of that date, the report will be deemed adopted, which will be noted at the next session of the Working Group.

AGENDA ITEM 8: CLOSING OF THE SESSION

[26. The Chair closed the session on December 7, 2012.]

[Annex follows]

Article 10

Protection Accorded by International Registration

(1) *[Content of Protection]* (a) Subject to the provisions of this Act, each Contracting Party shall, from the date of international registration, extend to a registered appellation of origin protection against:

(i) any use of the appellation of origin

- in respect of goods of the same kind as those to which the appellation of origin applies not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin [which would amount to its usurpation or imitation or evocation];

- which would be detrimental to, or exploit unduly, its reputation,

even if the true origin of the goods is indicated or if the appellation of origin is used in translated form or accompanied by terms such as "style", "kind", "type", "make", "imitation", "method", "as produced in", "like", "similar", or the like;

(ii) any other practice liable to mislead the consumer as to the true origin, provenance, nature, quality or characteristics of the goods.

[Option A: (b) Without prejudice to Article 13(1), Contracting Parties:

(i) shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to goods not originating in the geographical area of origin;

(ii) may refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin with respect to goods that, while originating in the geographical area of origin, do not comply with any other applicable requirements for using the appellation of origin.]

[Option B: (b) Without prejudice to Article 13(1), Contracting Parties shall refuse or invalidate the registration of a trademark which contains or consists of a registered appellation of origin when it corresponds to one of the situations covered by subparagraph (a).]

[(2) *[Presumption in Case of Use by Third Parties]* Each Contracting Party shall provide for a presumption of unlawful use under paragraph (1)(a) in case a registered appellation of origin is used in respect of goods of the same kind as those to which the appellation of origin applies.]

[(3) *[Homonymy]* The provisions of this Act do not prevent the international registration of homonymous appellations of origin. Each Contracting Party shall determine what protection it shall provide in respect of such appellations of origin. Such protection shall be subject to practical conditions taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled*.]

* It is understood that a Contracting Party has the right not to accord protection, as stipulated in this Agreement, in respect of an appellation of origin which would, although literally true as to the geographical area in which the goods designated by the appellation of origin originate, falsely represent to the public that the goods originate in another territory.

Article 11

Shield Against Becoming a Generic Term or Name

A denomination protected as a registered appellation of origin in a Contracting Party cannot [be considered to have] become generic as long as the denomination is protected as an appellation of origin in the Contracting Party of Origin.