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

Ninth Session
Geneva, June 23 to 27, 2014

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 June 23 to 27, 2014.
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, Republic of Moldova, Peru, Portugal (11).
3. The following States were represented as observers: Argentina, Australia, Bhutan, Chile, Colombia, El Salvador, Fiji, Germany, Greece, Iraq, Kenya, Nepal, Paraguay, Republic of Korea, Romania, Russian Federation, Spain, Switzerland, Ukraine, United States of America, Venezuela (Bolivarian Republic of) (21).
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), Organization of Islamic Cooperation (OIC) (3).
5. Representatives of the following international non-governmental organizations (NGOs) took part in the session in an observer capacity: Association of European Trademark Owners (MARQUES), Brazilian Association of Intellectual Property (ABPI), Centre for International Intellectual Property Studies (CEIPI), Consortium for Common Food Names (CCFN), European Communities Trade Mark Association (ECTA), International Trademark Association (INTA), Knowledge Ecology International Inc. (KEI), Organization for an International Geographical Indications Network (oriGIn) (8).

6. The list of participants is contained in document LI/WG/DEV/9/INF/2 Prov. 2^{*}.

AGENDA ITEM 1: OPENING OF THE SESSION

7. The Director General of the World Intellectual Property Organization (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/9/1 Prov. 2.

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. Alfredo Rendón Algara (Mexico) and Mrs. Ketevan Kiladze (Georgia) 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/9/1 Prov. 2) without modification.

AGENDA ITEM 4: REPORT OF THE EIGHTH 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 June 12, 2014, of the Report of the eighth session of the Working Group, as contained in document LI/WG/DEV/8/7, in accordance with the procedure established at the fifth session of the Working Group.

AGENDA ITEM 5: DRAFT REVISED LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS AND DRAFT REGULATIONS UNDER THE DRAFT REVISED LISBON AGREEMENT

12. Discussions were based on documents LI/WG/DEV/9/2, LI/WG/DEV/9/3, LI/WG/DEV/9/4 and LI/WG/DEV/9/5. The Working Group examined in detail all the provisions of the draft Revised Lisbon Agreement and the draft Regulations.

13. The Chair concluded that the following pending issues would be submitted to the next session of the Working Group:

- (i) the title of the draft Revised Lisbon Agreement;
- (ii) the content of Article 2(2) and Article 5(4) concerning trans-border geographical areas of origin;
- (iii) Article 7(2)(b) and Article 8(3) concerning the possible introduction of maintenance fees;

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

- (iv) Article 7(4) and related provisions concerning the possible introduction of individual fees;
- (v) the question as to whether Article 9(1) should be kept and whether Article 9(2) should be moved to Article 6;
- (vi) the issue as to whether Article 10(3), read in conjunction with Article 15(2), should refer to any other or to more extensive protection;
- (vii) the various options in respect of Article 11(1)(a) and Article 11(3) (see the Annex to the present document);
- (viii) the issue of the Draft Agreed Statement contained in footnote 4 to Article 11 and provisions relating to the same issue;
- (ix) the content of Article 12 concerning protection against acquiring a generic character;
- (x) the content of Article 13(1) concerning safeguards in respect of prior trademark rights;
- (xi) the issues as to whether Article 13(2) to (4) should be kept and whether consequential amendments should be made to Article 17(2) and to footnote 7 relating to that provision;
- (xii) the content of Article 16(2) concerning negotiations following a refusal;
- (xiii) the issue as to whether Article 19(2) should establish an exhaustive or a non-exhaustive list of grounds for invalidation;
- (xiv) the issue as to whether Rule 5(3) should be optional or mandatory; and
- (xv) the issue of the inclusion of Rule 5(4) permitting a Contracting Party to require a declaration of intention to use in respect of a registered appellation of origin or a registered geographical indication.

Future work

14. The Chair recalled that the Lisbon Union Assembly had approved, at its ordinary session in 2013, the convening of a Diplomatic Conference for the Adoption of a Revised Lisbon Agreement on Appellations of Origin and Geographical Indications in 2015, with the exact dates and venue to be decided by a preparatory committee meeting to be held in conjunction with the tenth session of the Working Group in October 2014.

15. He reiterated that, in accordance with paragraph 18 of the Summary by the Chair adopted at the eighth session, the tenth session of the Working Group would focus on technically preparing the texts of the draft Revised Lisbon Agreement and the draft Regulations for the Diplomatic Conference and on reducing the number of pending issues, where possible. At that session, resolved issues would not be re-opened and proposals and discussions should be limited to the pending issues listed in paragraph 13 of the present document.

16. The Chair further recalled that the Lisbon Union Assembly would be in a position to note the progress made in preparing the diplomatic conference at its next session in September 2014.

AGENDA ITEM 6: PROPOSAL TO UPDATE THE FEE SCHEDULE UNDER RULE 23 OF THE REGULATIONS UNDER THE LISBON AGREEMENT

17. Discussions were based on document LI/WG/DEV/9/6.

18. The Chair noted that, while there appeared to be a need for more time and information to further consider the proposal, the general sentiment towards an increase of the amounts of fees in Rule 23 of the Regulations under the Lisbon Agreement was predominantly positive.

AGENDA ITEM 7: OTHER MATTERS

19. No interventions were made under this item.

AGENDA ITEM 8: ADOPTION OF THE SUMMARY BY THE CHAIR

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

21. 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 and the Working Group will be invited to take note of such adoption at its next session.

AGENDA ITEM 9: CLOSING OF THE SESSION

[22. The Chair closed the session on June 27, 2014.]

[Annex follows]

Article 11⁴

Protection in Respect of Registered Appellations of Origin and Geographical Indications

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

- (a) any use of the appellation of origin or the geographical indication
 - (i) in respect of goods of the same kind as those to which the appellation of origin, or the geographical indication, applies not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin, or the geographical indication; or

Option A

- (ii) which would amount to its usurpation or imitation [or evocation]; or
 - (iii) which would be detrimental to, or exploit unduly, its reputation,

Option B

- (ii) in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies, if such use would indicate or suggest a connection between those goods and the beneficiaries, and is likely to damage the interests of the beneficiaries,

even if the appellation of origin or the geographical indication is used with minor differences; if true origin of the goods is indicated; or if the appellation of origin, or the geographical indication, is used in translated form or accompanied by terms such as "style", "kind", "type", "make", "imitation", "method", "as produced in", "like", "similar", or the like⁵;

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

(2) *[Use in a Trademark]* Without prejudice to Article 13(1), a Contracting Party shall, *ex officio* if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a later trademark if use of the trademark would result in one of the situations covered by paragraph (1).

⁴ Draft Agreed Statement by the Diplomatic Conference: "As the International Bureau is only authorized to refuse applications that do not meet the formal requirements of the Lisbon Agreement or the 1967 Act, or the applicable Regulations under these instruments, applications concerning appellations of origin consisting of or containing a term occurring in an appellation of origin already registered under the Agreement have not been refused by the International Bureau, and will not be refused by the International Bureau under this Act either, as this would amount to a refusal on a substantive ground. It is for each Contracting Party to decide, on the basis of its own legal system and practice, whether such appellations of origin or geographical indications may coexist on its territory or that one of them shall prevail."

⁵ Where certain elements of the denomination or indication constituting the appellation of origin or geographical indication have a generic character in the Contracting Party of Origin, their protection under this subparagraph shall not be required in the other Contracting Parties.]

Option A

(3) *[Alternative for Paragraph (1)(a)(iii)]* Any State or intergovernmental organization may declare, when depositing its instrument of ratification or accession, that the provisions of paragraph (1)(a)(iii) are not compatible with its legal system and practice and that it shall, instead of the protection stipulated in this item, extend to the registered appellation of origin or the registered geographical indication protection against any use thereof in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies, if such use would indicate or suggest a connection between those goods and the beneficiaries, and is likely to damage the interests of the beneficiaries.

Option B

(3) *[Alternative for Paragraph (1)(a) (ii) and (iii)]* Any State or intergovernmental organization may declare, when depositing its instrument of ratification or accession, that the provisions of paragraph (1)(a)(ii) and (iii) are not compatible with its legal system and practice and that it shall, instead of the protection stipulated in these items, extend to the registered appellation of origin or the registered geographical indication protection against any use thereof in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies, if such use would indicate or suggest a connection between those goods and the beneficiaries, and is likely to damage the interests of the beneficiaries.

Option C

(3) *[Alternative for Paragraph (1)(a) (ii) and (iii)]* Any State or intergovernmental organization may declare, when depositing its instrument of ratification or accession, that the provisions of paragraph (1)(a)(ii) and (iii) are not compatible with its legal system and practice and that it shall, instead of the protection stipulated in these items, extend to the registered appellation of origin or the registered geographical indication protection against any use thereof in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies, if such use:

- (i) would indicate a connection between those goods and the beneficiaries of the appellation of origin or the geographical indication, and would be likely to damage their interests;
- (ii) would be likely to impair or dilute in an unfair manner the distinctive character of the appellation of origin or the geographical indication; or
- (iii) would take unfair advantage of the distinctive character of the appellation of origin or the geographical indication.

Option D

(3) *[Alternative for Paragraph (1)(a)]* Any State or intergovernmental organization may declare, when depositing its instrument of ratification or accession, that the provisions of paragraph (1)(a) are not compatible with its legal system and practice and that it shall, instead of the protection stipulated in this subparagraph, extend to the registered appellation of origin or the registered geographical indication protection against any use thereof in respect of goods, if such use would indicate or suggest a connection between those goods and the beneficiaries, and is likely to damage the interests of the beneficiaries.

[End of Annex and of document]