

International Trademark Association

Paper

“Recommendations regarding the implementation of the Geneva Act of the Lisbon Agreement”

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The Geneva Act ("Geneva Act") of the Lisbon Agreement on Appellations of Origin and Geographical Indications ("Lisbon Agreement") was adopted on May 20, 2015, and the Common Regulations under the Lisbon Agreement and the Geneva Act were adopted on October 11, 2017. The Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications has officially entered into force, since the European Union's November 26, 2019, accession permitted the Geneva Act's entry into force three months later, on February 26, 2020. INTA would like to make the following comments regarding the implementation of the Geneva Act in the contracting countries.

I. BACKGROUND

The Geneva Act updates the Lisbon Agreement, which protects appellations of origin, by extending protection to geographical indications other than appellations of origin. (See attached WIPO publication: Main Provisions and Benefits of the Geneva Act of the Lisbon Agreement, © WIPO 2018, p. 3, hereinafter "WIPO Publication Benefits of Geneva Act"). Among other goals, the Geneva Act is designed so that prior trademark rights, prior use of generic terms, personal names used in business and rights based on a plant variety or animal breed denomination are all safeguarded (WIPO Publication Benefits of Geneva Act, p. 5). To implement the Geneva Act in a way that effectively achieves these stated goals, INTA makes the following recommendations regarding the implementation of the Geneva Act.

II. GENERAL IMPLEMENTATION

WIPO recognizes that the Geneva Act may be implemented in a number of ways in the Contracting Parties, noting that

"Contracting Parties can use any type of legislation to protect products registered under the Lisbon System [including the Geneva Act], provided that the legislation in question meets the requirements of the Act" (*supra*, p. 5) whether it be "through *sui generis* laws (special laws that apply specifically or exclusively to geographical indications and/or appellations of origin), trademark laws, administrative provisions, or other legal means" (*supra*, p. 5).

With this background, INTA makes the following recommendation regarding the implementing legislation:

⇒ If the Contracting Party has an existing GI registration system that complies with the

requirements of the Geneva Act and other international laws and treaties, and that incorporates the recommended provisions as set forth below in this paper, INTA recommends providing for the registration of GIs under the Geneva Act utilizing the existing GI registration procedures of that Contracting Party.

III. EXAMINATION PROCESS

The Geneva Act, following the procedure established by the Lisbon Agreement, provides for the automatic protection of the GI within a year of notification of the GI to the Contracting Party if no action is taken by the Contracting Party. This can lead to unintended consequences of protecting GIs that might violate prior rights, conflict with generic terms, violate local laws. In order to ensure that such unintended consequences do not occur, it is important when implementing the Geneva Act that the Contracting Party provides for the actual review and examination of the GI in question.

IV. NOTICE OF PROTECTION AND OPPOSITION PROCEDURES

Regardless of the implementation system that is utilized by the Contracting Party, it is imperative that, prior to the commencement of the protection of a GI in that Contracting Party, interested parties be given sufficient notice that protection for a GI is being sought in that Contracting Party.

Just as it would violate due process concerns in the Contracting Party to provide protection that could adversely affect the existing rights of third parties without giving third parties the opportunity to object, it would be an equal violation to provide GI rights that could adversely affect prior rights of third parties without giving third parties the opportunity to object. Consequently, INTA recommends:

- 1) that each and every GI which is being considered for registration in a Contracting Party be published for opposition in that Contracting Party before the GI is protected in that Contracting Party;
- 2) that such GI be published in a way that is open and easily visible and available to the general public at large, such as publishing the details of the proposed GI in a well-recognized online government publication that would typically publish trademark and/or GI related material (e.g., an official online gazette utilized to publish details of trademark applications);
- 3) that, once a GI is published for opposition, a reasonable period of time (i.e., at least 6 months from the publication for opposition) be given to interested third-parties to file the opposition and that the period of time be clearly established in the Contracting Party's laws; and
- 4) that the Contracting Party's laws provide clear guidance as to where oppositions should be filed, the authority to whom it should be addressed and any other specific procedures involved in filing the opposition, including fees, if any, that would be required.

V. GROUNDS FOR REJECTION

Under the Geneva Act, valid grounds for opposition to registration of a GI in a Contracting Party include, but are not limited to, conflicts between the GI and prior trademark rights in that Contracting Party, and conflicts between the GI and generic terms in that Contracting Party. (See WIPO Publication Benefits of Geneva Act, p. 5). Additionally, clear grounds for rejection provide certainty as it relates to the rights of third parties and the GI holders themselves.

INTA therefore recommends:

- 1) that the Contracting Party's laws clearly specify the grounds on which a GI can be refused registration, on which an application to register a GI can be opposed, and on which a GI registration can be cancelled;
- 2) that the Contracting Party clearly specify objective and clear criteria for determining what constitutes a generic term in that Contracting Party; and
- 3) Other grounds for opposition based on local laws, such as unfair competition, should also form grounds for opposition.

VI. SCOPE OF PROTECTION

The Geneva Act gives Contracting Parties significant latitude regarding each GI's scope of protection.

Article 11 of the Geneva Act sets forth the scope of protection for any protected GI. In particular, protection with respect to certain uses shall include, inter alia, use of the appellation of origin or geographical indication amounting to its imitation, even if the true origin of the goods is indicated, or if the appellation of origin or the geographical indication is used in translated form or is accompanied by terms that can evoke the GI.

INTA recognizes that article 13.1 of the Geneva Act – by stating that the Act shall not prejudice a prior trademark applied for or registered in good faith, or acquired through use in good faith, in a Contracting Party – represents a major improvement with respect to article 5.6 of the Lisbon Agreement, which had generated legal uncertainty with respect to such prior trademarks in jurisdictions where GI protection was sought via the Agreement.

In light of the above, INTA recommends that each Contracting Party implements the Geneva Act in a way that prevents the invalidation of an existing, valid trademark registration in that Contracting Party in good faith if the effective date of such registration in that Contracting Party precedes the would-be effective date of the GI in that Contracting Party; or cessation of use of an existing, valid trademark in that Contracting Party if the effective date of such use in that Contracting Party precedes the would-be effective date of the GI in that Contracting Party.

Likewise, INTA recommends that each Contracting Party implements the Geneva Act in a way that does not prevent third party's use of any term which have acquired a generic nature in the Contracting Party where protection is sought. To achieve these objectives, Contracting parties should take into account the options given by article 15.1 of the Geneva Act ("refusal").

VII. CONCLUSION

There are many ways for Contracting Parties to implement the Geneva Act. In doing so, however, it is important that it be done in a fair and transparent way, that also recognizes the rights of third parties. INTA encourages each of the Contracting Parties to take the foregoing into consideration as they proceed on the journey toward the Geneva Act implementation.

Should you wish to further discuss any of the points raised or additional issues, please contact Hadrien Valembos, INTA Policy Officer -Europe at [hvalembois@inta.org](mailto:hvalembos@inta.org).

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