

BUREAUX INTERNATIONAUX
RÉUNIS POUR LA PROTECTION
DE LA PROPRIÉTÉ INTELLECTUELLE
GENÈVE, SUISSE

BIRPI

UNITED INTERNATIONAL
BUREAUX FOR THE PROTECTION
OF INTELLECTUAL PROPERTY
GENEVA, SWITZERLAND

**CONSEIL INSTITUÉ PAR L'ARRANGEMENT DE LISBONNE
CONCERNANT LA PROTECTION DES APPELLATIONS D'ORIGINE
ET LEUR ENREGISTREMENT INTERNATIONAL**

CINQUIÈME SESSION

(Genève, 26 et 29 septembre 1970)

**COUNCIL ESTABLISHED BY THE LISBON AGREEMENT
FOR THE PROTECTION OF APPELLATIONS OF ORIGIN
AND THEIR INTERNATIONAL REGISTRATION**

FIFTH SESSION

(Geneva, September 26 and 29, 1970)

PROBLEMS ARISING FROM THE PRACTICAL
APPLICATION OF THE LISBON AGREEMENT

1. At the fourth ordinary session of the Council set up by the Lisbon Agreement, which was held at Geneva on September 25 and 26, 1969, it was pointed out that divergences sometimes occurred in the interpretation of the Lisbon Agreement, and that it would be advisable to take steps to ensure its uniform application, especially with regard to the actual concept of the appellation of origin itself.
2. BIRPI said that it could carry out an investigation on this subject among member States of the Lisbon Union, before the next session of the Council.
3. By Circular No. 987 of March 6, 1970, addressed to the Ministries of Foreign Affairs of countries party to the Lisbon Agreement, the Director of BIRPI asked each member State to inform him of the problems arising, as far as it was concerned, from the application of the Lisbon Agreement, and to communicate its proposed solutions to such problems. On July 1, 1970, two countries, Czechoslovakia and Portugal, had replied to this request (see Annexes).

4. One of the problems mentioned was that of the interpretation of the concept of the appellation of origin when it does not correspond exactly to a geographical name. The Portuguese Administration declared itself to be in favor of an interpretation of the concept of the appellation of origin which would extend protection to names corresponding to geographical areas, even if the names themselves are not, properly speaking, geographical names, but serve to designate products originating in a country, region or locality, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors (see Annex I).

5. With regard to registration formalities, it has been pointed out that, in practice, there may be several natural persons or legal entities using the same appellation of origin in the same place or region. The opinion of the Czechoslovak Administration is that, in such cases, it should be possible for all parties fulfilling the conditions prescribed by the Agreement to be registered in the international register, at any time, as having the right to use the appellation of origin (see Annex II).

6. Appellations of origin corresponding to a territory comprising several States give rise to problems which are difficult to solve, in that the Administrations of the States concerned may each apply for the international registration of the same appellation of origin. In the opinion of the Czechoslovak Administration, the Lisbon Agreement should facilitate the registration of one and the same appellation of origin in the name of applicants from two or more countries, if the appellation of origin satisfies the conditions prescribed by the Lisbon Agreement, and if the Administrations of the countries concerned agree on this question (see Annex II).

7. The Council is requested to express its views on the present document.

End of document.
Two Annexes follow

Annex I to document AO/V/5

P O R T U G A L

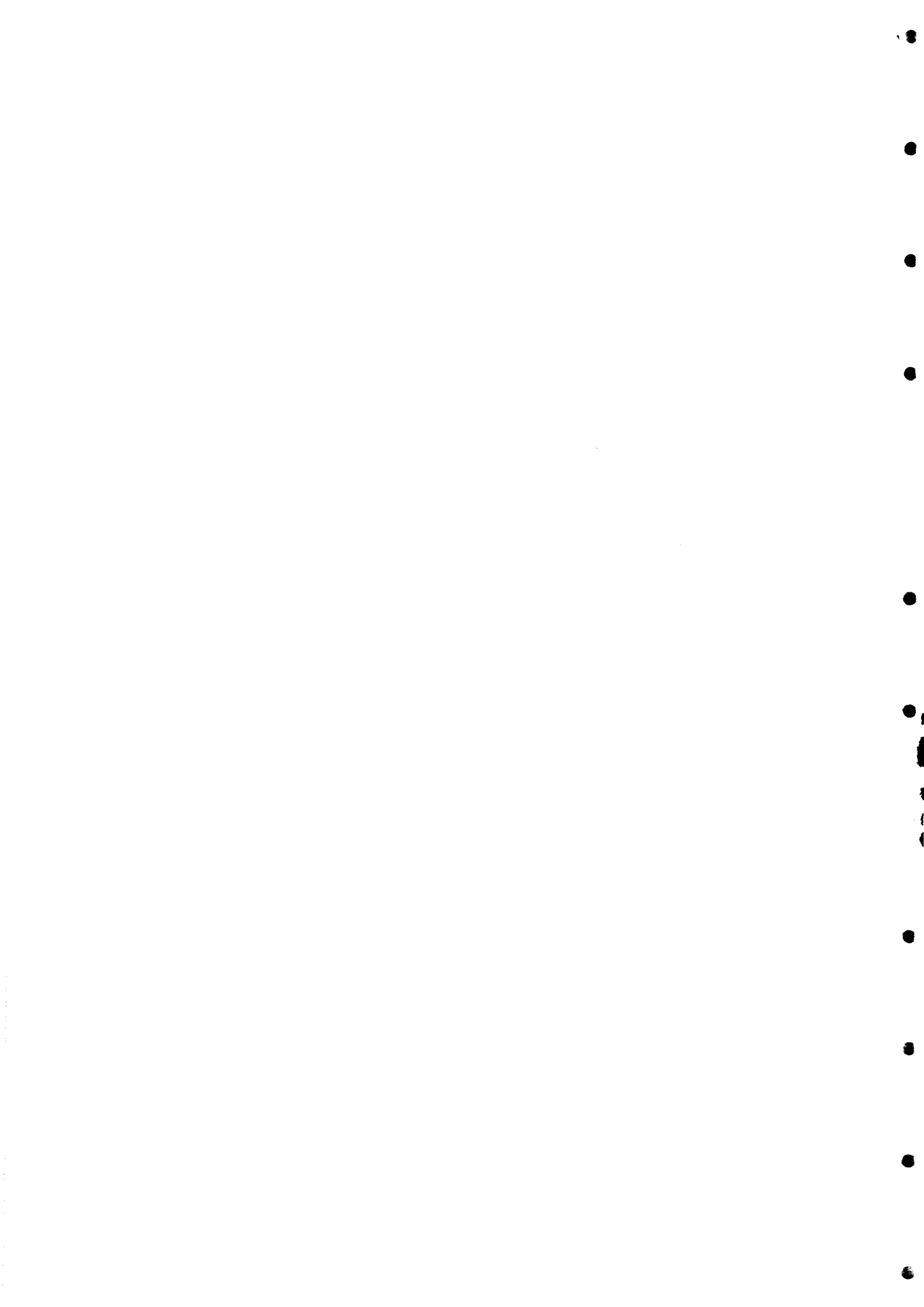
(Extract from the letter of the Portuguese
Administration of June 16, 1970)

The application of the Lisbon Agreement has given rise to difficulties concerning the interpretation of the concept of an appellation of origin.

Some of the appellations notified to the Portuguese Administration did not correspond exactly to the geographical concept as defined in Article 2 of the Lisbon Agreement.

The solution which we have adopted in such cases consisted in broadening the scope of the relevant appellation of origin in such a way as to include names relating to geographical areas (even if these were not actual geographical names) serving "to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors."

End of the Annex



C Z E C H O S L O V A K I A

(Extract from the letter of the Czechoslovak
Administration of June 16, 1970)

I have the honor to bring to your notice certain problems which, in our opinion, should be discussed at the next session of the Council of the Lisbon Union:

Article 5 of the Lisbon Agreement stipulates that "the registration of appellations of origin shall be effected at the International Bureau for the Protection of Industrial Property, at the request of the Administrations of the countries of the Special Union, in the name of any individual person or legal entity, public or private, having, according to their national legislation, a right to use such appellations."

It is true that this provision governs the international registration of new appellations of origin recognized in their country of origin. However, it is not unusual, in practice, to encounter situations where, in the same region or locality, there are several individual persons or legal entities using the same appellation, only one of them having filed an application for registration. Consequently, the appellation of origin is registered in one name only. We are of the opinion that it should be possible for other persons--in so far as they fulfill the prescribed conditions--to be registered in the international register, at any later date, as having the right to use the registered appellation of origin, and that the procedure mentioned in "Actes de la Conférence réunie à Lisbonne du 6 au 31 octobre 1958" page 816-III, could be applied:

"This registration shall be effected by the competent Administration in each country, which may decide which individual person or legal entity has the right, according to its national legislation, to the appellation of origin. This rule shall, as far as possible, determine the owners of the right in the interests of the country requesting registration. If changes in the ownership of the right occur after registration, nothing, in such exceptional cases, shall prevent a second registration of the same appellation of origin. The purpose of this registration shall be to establish who are the new owners of the appellation of origin." (1)

(1) Unofficial translation.

At the same time, there should be a study of the steps to be taken in situations where a territory or region extends beyond the frontier of one or several States. Individual persons or legal entities using the relevant appellation of origin may apply for its registration in accordance with their national legislation, but as soon as the Administration of one of the countries concerned applies for international registration of the same appellation of origin, a conflict of interests may occur. In our opinion, the Lisbon Agreement should facilitate the registration of the same appellation of origin with the United International Bureaux for the Protection of Intellectual Property--if it satisfies the conditions laid down by the Lisbon Agreement, and if the Administrations of the countries concerned agree on this question--in the name of applicants from one or several countries, whom their respective Administrations shall declare to be "individual persons or legal entities having, according to their national legislation, a right to use such appellations."

The Lisbon Agreement should therefore make it possible to effect a joint international filing of an appellation of origin, on condition that the countries concerned agree to do so.

/End of the Annex/