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The WIPO Lisbon System – EU accession to the Geneva Act

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Abstract –

The EU has been following an effective policy of protection of Geographical Indications (GIs) for over 20 years, mainly for agricultural products, both on the internal market and in third countries. In addition to bilateral and regional agreements with third countries that have the sole purpose of protecting GIs or provide for such protection in a separate section, international GI protection through multilateral agreements plays an increasingly important role. The Lisbon System, administered by the World Intellectual Property Organization (WIPO), is one of the two major multilateral tracks for GI protection, the other being the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement) of the World Trade Organization (WTO). The Lisbon System is based on the Lisbon Agreement of 1958 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, which entered into force recently. This article gives a brief overview of the Lisbon System and its review, the Geneva Act and the EU as a Contracting Party to the Geneva Act.

Keywords – WIPO Lisbon System, Lisbon review, Geneva Act, EU implementation of the Geneva Act

HISTORY OF THE LISBON SYSTEM

The Paris Convention of 1883 for the Protection of Industrial Property was the basic instrument for international intellectual property regulation before the WIPO Treaties and the WTO TRIPS Agreement. Its principles are national treatment for foreigners, priority given to registered IP rights, and minimum substantive standards of protection. It established a union of which each contracting State is a member. The Paris Convention was the first multilateral agreement that included "indications of source or appellations of origin" as objects for protection by national industrial property laws. Both GIs and appellations of origin (AOs) can be considered to be a species of the genus "indication of source" in the sense of the Paris Convention. The Madrid Agreement of 14 April 1891 for the Repression of False or Deceptive Indications of Source of Goods extended the scope of protection for indications of source. Also in 1891, the Madrid Agreement Concerning the International Registration of Marks was signed, which since has been used by many countries to protect GIs as collective, certification, or guarantee trade marks. Since then, the world has been divided between those countries that protect GIs through an ad hoc system, and those that use their trade mark law.

The "Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration" of 1958 was established as a Special Union under Art.19 of the Paris Convention in reaction to the failure to strengthen the rules under the Paris Convention and the Madrid Agreement of 1891. It entered into force in 1966. It was revised at Stockholm in 1967, and amended in 1979. It has been administered by the World Intellectual Property Organization (WIPO) since the creation of this organization (a self-funding agency of the United Nations) in 1967.

The parties to the Lisbon Agreement undertake to protect on their territories AOs, as defined in Art.2, of products of the other signatories of the Agreement provided they have been registered at WIPO. In order to qualify for international registration, the protection of the AO must have been formalised first in the country of origin by means of either legislative provisions, or administrative provisions, or a judicial decision or any form of registration. The parties are required to protect AOs, recognised as such in their country of origin and registered at the International Bureau of the WIPO, unless they declare, within one year of receiving the notice of registration, that they cannot ensure the protection of a registered appellation within their territory.

There are currently 30 contracting parties to the Lisbon Agreement, seven of which are Member States of the EU: Bulgaria (since 1975), Czech Republic (since 1993), Slovakia (since 1993), France (since 1966), Hungary (since 1967), Italy (since 1968) and Portugal (since 1966).

The original Lisbon Agreement of 1958 presented a number of problems diminishing its effectiveness as an instrument of effective multilateral protection. In particular, it does not cover all GIs, but is limited to AOs, which are more narrowly defined than GIs are. Moreover, only states can join so that international organisations like the EU cannot become members. In September 2008, the Assembly of the Lisbon Union established a Working Group on the Development of the Lisbon System. From 2009, the Working Group engaged in a full revision of the Lisbon Agreement involving: (i) the refinement of its legal framework; (ii) the extension of the Lisbon System to all GIs; and (iii) the possibility of accession by intergovernmental organisations. A Diplomatic Conference completing the revision process took place in Geneva from 11–21 May 2015 and adopted the "Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications" on 20 May 2015. The Geneva Act entered into force on 26 February 2020, three months after the EU as the fifth eligible party deposited its instrument of accession.

THE GENEVA ACT

The Geneva Act responds to the EU's objectives for the review: it extends the scope of the Lisbon System beyond AOs to all GIs; it is compatible with the TRIPS Agreement and the relevant EU legislation on the protection of GIs for agricultural products; and it allows international organisations (such as the EU) to become contracting parties.

The revised Agreement sets out the modalities, conditions and procedures under which the parties may request protection for registered AOs and GIs, providing for appropriate guarantees and transitional periods.

Each contracting party should protect registered AOs and GIs in its territory within its own legal system and practice, but in accordance with the provisions of the Geneva Act. The level of protection under the Geneva Act is essentially equivalent to the relevant EU rules. Registered AOs and GIs cannot be considered to have become generic in a Contracting

Party. AOs or GIs may coexist with prior trade marks, in line with relevant EU legislation on the relationship between GIs and trade marks and, in particular, with the WTO Panel's findings in the dispute between the EU and the USA/Australia (DS174/DS290), according to which coexistence is based on Art.17 of TRIPS. Moreover, the Geneva Act provides for the possibility of a period for phasing out older uses.

As of 12 April 2022, there were 11 Contracting Parties to the Geneva Act.

THE EU IN THE GENEVA ACT

For the EU as the major exporter of products benefiting from GIs, the possibility for accession to the Geneva Act was an essential element of the Lisbon review. In 2017, GI exports to non-EU countries accounted for €17 billion, representing 15.5 per cent of extra-EU trade of food and beverages (a total of €110 billion). EU law on the protection of GIs for agricultural products and foodstuffs (Regulation 1151/2012), wine (Regulation 1308/2013), spirits (Regulation 2019/787) and aromatised wine products (Regulation 251/2014) has created an exclusive protection system at EU level. EU Member States are therefore not supposed to have agricultural product GI protection systems of their own nor themselves to protect agricultural GIs of third country members of the Lisbon System under such GI systems. A proposal for an EU-wide protection system for craft and industrial product GIs is currently in the legislative process. More broadly, the ruling of the European Court of Justice (ECJ) of 25 October 2017 (C-389/15, *European Commission v Council of the European Union*) clarified that the EU has exclusive competence for the Geneva Act since the revised Lisbon Agreement is covered by the EU's common commercial policy (trade aspects of intellectual property). The ECJ found that it is essentially intended to facilitate and govern trade between the EU and third states and, secondly, that it is such as to have direct and immediate effects on such trade. To be able to exercise its exclusive competence in this domain, the EU had to accede to the Geneva Act. On 7 September 2019, the Council adopted Decision (EU) 2019/1754 authorising the EU's accession to the Geneva Act as well as Regulation (EU) 2019/1753 of the European Parliament and of the Council on the action of the Union following its accession to the Geneva Act, thus enabling the EU to deposit its instrument of accession to the Geneva Act before the end of 2019.

Regulation (EU) 2019/1753 lays down rules allowing the Union to exercise the rights and to fulfil the obligations set out in the Geneva Act. In particular, it provides that, as a rule, Member States may request the Commission to register in the International Register under the Geneva Act GIs that originate in their territory if these are protected and registered under EU law. Such requests can be based on a request by GI holders or their own initiative. This gives GI holders a lead role in deciding which GIs should be protected under the Geneva Act. The Commission as Competent Authority under the Ge-

neva Act shall file applications with the WIPO International Bureau. The Regulation also sets out a procedure for GIs of third country origin that will have to be assessed for protection in the EU under the Geneva Act. Moreover, it contains complex transitional provisions for AOs originating in EU Member States and already registered under the Lisbon Agreement, contemplating various scenarios, essentially depending on the eligibility of the respective AO for protection under EU law. There are also rules for transitional protection for AOs originating in a third country and registered under the Lisbon Agreement before the accession of the Union to the Geneva Act.

OUTLOOK

The new Geneva Act is a potentially significant tool in the strategy of any country or region – including the EU – that wants to improve multilateral protection of GIs, for the benefit of its producers and consumers. In view of the current lack of progress at the WTO in respect of the establishment of an effective and efficient multilateral register for GIs and the extension of high level protection to all products, the Geneva Act is currently the only viable option for protecting GIs in a multilateral forum.

The Geneva Act offers new members a modern multilateral instrument, enabling them to take advantage of the significant benefits stemming from the unique features of the producers' territory and assisting them in transforming these features into marketable products. The establishment of an international registration and protection system for AOs and GIs will have positive effects for – particularly small and medium sized and rural – producers worldwide in obtaining protection for their designations abroad at affordable costs. Moreover, it can be a boost for private and public investment, with positive effects for the economy, sustainable development, increased competitiveness, export diversification and job creation.