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Jen Cleary *Editors*

The Importance of Place: Geographical Indications as a Tool for Local and Regional Development

Ius Gentium: Comparative Perspectives on Law and Justice

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Editors

The Importance of Place: Geographical Indications as a Tool for Local and Regional Development

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About the Editors

William van Caenegem is a professor of Law at the Faculty of Law, Bond University. He specializes in intellectual property law and comparative law. William wrote some of the first articles in Australia concerning the legal protection of geographical indications of origin, in the context of the WTO/TRIPS negotiations on the subject. He is a co-author with Jen Cleary and Peter Drahos of the RIRDC Report ‘Provenance of Australian food products: is there a place for Geographical Indications?’ (2015) and with Jen Cleary, Madeline Taylor and Brenda Marshall of the RIRDC Report ‘Collective Bargaining in the Agricultural Sector’ (2015). He has published on many areas of intellectual property law, including IP and innovation and also IP and the protection of commercial reputation.

Jen Cleary is a human geographer with research interests in regional development and agricultural value chain analysis. Jen is based within the Centre for Global Food Studies at the University of Adelaide and holds an honorary position as adjunct associate professor at the Institute for Governance and Policy Analysis at the University of Canberra. Jen has served as chair of Regional Development Australia, Far North (RDAFN) from 2009–14 and was appointed in 2015 as chair of the RDA National Reference Group, established by former Deputy Prime Minister Warren Truss. In 2013, Jen joined the National Steering Committee of SEGRA (Sustainable Economic Growth for Regional Australia), a national, independent body that fosters collaboration and formulates policy advice across rural, regional and remote Australia.

Abbreviations

ACCC	Australian Competition and Consumer Commission
AFPQCA	Agricultural and Fishery Products Quality Control Act
AOC	Controlled denomination of origin
ASEAN	Association of Southeast Asian Nations
CAP	European Union Common Agricultural Policy
CECA	Comprehensive Economic Cooperation Agreement
ChAFTA	China–Australia Free Trade Agreement
CIRAD	French Agricultural Research and International Cooperation Organization
CJEU	Court of Justice of the European Union
COFRADEP	French Committee for the defence and qualitative promotion of AOC wines and spirits
EC	European Union Council
ECJ	European Court of Justice
EU	European Union
FITFIR	First in time, first in right
FTA	Free Trade Agreement
GATT	General Agreement on Trade and Tariffs
GI	Geographical Indications
INAO	National Institute for Signs of Origin and Quality
INAO (<i>fr.</i>)	National Institute of Quality and Origin (<i>fr.</i>)
INTA	International Trademark Association
IP	Intellectual Property
JICEPA	Japan–Republic of India Comprehensive Economic Partnership Agreement
JPEPA	Japan–Peru Free Trade Agreement
KOREU	European Union–Korea Free Trade Agreement
KORUS	USA–Korea Free Trade Agreement
NGO	Non-governmental Organization
OAPI/AIPO	African Intellectual Property Organization

OHIM	Office for Harmonization in the Internal Market
OP	Origin Product
PCT	Patent Cooperation Treaty
PDO	Protected Designation of Origin
PGI	Protected Geographical Indication
TLT	Trademark Law Treaty
TM	Trade Mark
TPP	Trans Pacific Partnership
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights
TSG	Traditional Specialty Guaranteed
TTIP	Transatlantic Trade and Investment Partnership
UNESCO	United Nations Educational, Scientific and Cultural Organization
US/USA	United States of America
VCLT	Vienna Convention on the Law of Treaties
VDQS	Delimited wine of superior quality
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

Introduction

Geographical indications of origin may be the poor relation of intellectual property law, but it is a subject that continues to grow in interest and importance. In international trade terms, it remains high on the agenda, in particular in agreements and negotiations to which the European Union is a party. National registration schemes for GIs have proliferated around the world, including Asia.

The motivation for this new book arose out of the research conducted by the editors on the role, potential and place of GIs in the Australian agricultural context. In undertaking this research, we concluded that the domestic debate on GIs has been framed almost exclusively in terms of gains and losses in international trade. It ignored the question of the potential for GIs to serve as rural and regional development tools in Australia, something we highlighted in our research. This led us to speculate about the perceived role of GIs as rural policy instruments globally. What has been the expectation and experience with GIs as agricultural development tools in both the Old World and the New? Are GIs seen to contribute to the protection of high-value products for smaller countries whose volume production is increasingly under threat by larger producing nations? How significant is rural economic impact compared to other GI policy goals? We found that in the Old World, for instance, cultural and historical dimensions are more central to the consideration of GIs than in Australia. However, rural economic impact has always been a significant theme in debates around the world.

Although our Australian work focused on the rural development potential of GIs, we also understood that our conclusions would have implications for Australia's international trade negotiation stance. The rural development question cannot be considered in isolation because Australian agricultural policy is inescapably linked to global trade and treaty systems. Therefore, in Part I of this volume we consider recent developments in international agreements and their implications on our rural development question. The chapters by Geuze and Gervais et al. in this part provide contrasting perspectives on the Geneva revision of the Lisbon Agreement, which aimed to increase the number of participating countries. O'Connor focuses on the positionality of the EU and the USA in trade negotiations with South Korea and the impact that entrenched positions on GIs continue to have.

This is important, because what policy analysis might suggest with regard to the adoption of GI registration schemes is readily discounted at the negotiating table. Taylor and Taylor show, however, that with smart negotiation, the rural development promise of GIs could be delivered domestically.

Part II of this book then considers our rural development conclusions in specific national and local settings, both in the Old World and the New. Cleary and van Caenegem firstly present what they learned from the Australian research and frame this in the context of both agricultural policy and broader rural social policy. The chapter by Teil then examines 150 years of winemaking in place, the contentuality of constructed *versus* natural links to *terroir*, and their impact on the development in France. Donner et al. use France and Morocco to contrast GIs with collective place brands as legal tools and their different effects on rural development. Overton addresses the long-standing debate in New Zealand about GIs for wine and concludes that a GI registration scheme offers tangible advantages over existing legal mechanisms in rural development terms. Marie-Vivien takes us further by asking whether GIs have a role beyond food in supporting the development of local handicrafts.

Finally, this book concludes with two succinct case studies—one from the Old World and the New. The first considers the actual impact of the GI registration of Sorana beans in Tuscany, Italy, and identifies the benefits for local farmers. The second case study considers the rural development on King Island, Australia. In the first instance, Thorn identifies the existing challenges for rural development on the island. She then discusses the potential of GIs for maximizing returns to local farmers from already well-known foods produced there.

We hereby thank contributors for their broader consideration of the rural development question that we raised in the Australian context. We would also like to acknowledge Leyla-Denisa Obreja for her work in organizing the correspondence with both the contributors and the publisher, and developing and editing the manuscript. She worked tirelessly, enthusiastically and efficiently to draw together the work presented here.

Part I
International Trade: Perspectives on
Politics and Place

Chapter 1

Protecting Geographical-Origin-Brands Abroad: The Geneva Act of the Lisbon Agreement

Matthijs Geuze

Abstract The present chapter outlines the advantages of the Geneva Act of the Lisbon Agreement for the protection of geographical-origin-brands abroad. Thanks to the flexibilities the Act contains, its international registration and protection system should be attractive for any country that has an interest in allowing right holders in geographical-origin-brands for products from its territory to defend their rights in the jurisdictions of multiple actual and potential export markets.

1.1 Introduction

Elsewhere in this publication, the question is addressed whether geographical-origin-branding of products would be suitable for Australian producers and, if so, how such geographical-origin-brands might be protected in Australia against misappropriation. The present Chapter addresses another aspect that needs to be taken into account in this connection, namely how geographical-origin-branding is dealt with in the jurisdictions of actual and potential export markets for Australian products. This is important due to the fact that the acquisition of intellectual property rights in respect of geographical-origin-brands in other countries may be subject to quite different requirements or procedures compared to those Australia may establish.

However, it is also important because certain geographical names that were originally used as the indicator of a specific product from a particular geographical area may no longer be available as geographical-origin-brands, as they have become the generic indicator of a particular type of product not necessarily originating from a particular geographical area.

Examples of place names that have become generic in this sense include names that are even generic in the country where the place is situated, such as Brie or

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Edam, but also names that, although still acting as an indicator of a specific product from a particular geographical area in the country of origin, are considered generic in (some) other countries, such as Cognac or Feta. Moreover, issues may also arise if the name of a geographical area used and protected as the indicator of a specific product from the area is the same as the name of another geographical area used and protected as the indicator of a specific product from that other area; or if the name conflicts with a sign for which a trademark has been acquired.

In principle, a geographical name used as an indicator of a specific product from a particular geographical area cannot be protected as a trademark, as the name will be considered descriptive of the product and should not be monopolized for the benefit of one of its producers only. Protection, therefore, takes place through a right that belongs to a collectivity of producers, i.e., a brand based on the geographical origin of the product. Such brands exist in different forms and under different terms. Depending on the law of the country in question, the right acquired is called a geographical indication, an appellation of origin, a collective mark or a certification mark. Over the years, many bilateral agreements have been concluded, under which countries have agreed to protect (a number of) each other's geographical-origin-brands. However, there are also a number of multilateral treaties dealing with the protection of such brands. One of those treaties is the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, which is administered by the World Intellectual Property Organization (WIPO). In view of the need to adapt the system established by this treaty ("the Lisbon System") to the different approaches that exist around the world for the protection of geographical-origin-brands, a comprehensive review of its provisions recently resulted in the conclusion, on May 20, 2015, of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications ("the Geneva Act"). Entry into force of the Geneva Act can be expected in a few years. Consequently, it may be useful, if Australia were to opt for geographical-origin-branding, to also take into consideration its possible accession to the Geneva Act.

1.2 Procedures Facilitating the Acquisition of Rights Abroad

Under the Geneva Act, the Lisbon System will be a one stop solution for registering geographical-origin-brands in multiple countries, whether they are protected in their country of origin as geographical indications, as appellations of origin, as collective marks, as certification marks or under a specific term the country may choose to designate and protect them. Once protection is obtained in the country of origin under national law, or under the law of an intergovernmental organization of which the country is a member (e.g., the European Union or the African Intellectual Property Organization), a single application procedure can be used to extend protection to the territories of the other members of the System. It suffices to file one

application, in one language (English, French or Spanish), and pay one set of fees in Swiss francs, to obtain an international registration that will be effective in multiple territories within a set time-limit of 12 months.

Protection of the internationally registered geographical-origin-brand will be governed by the laws that apply in the territories of the members of the System, which will have to be in conformity with the standards stipulated in the Geneva Act. Thus, the international application is the equivalent of a bundle of national applications, but saves time and money, as there is no need to pay for translations into multiple languages or spend the time required under the national or regional procedures of the various countries or intergovernmental organizations for deciding whether protection can be granted or not—a period of time that is usually considerably longer than the 12 month time-limit that applies under the international registration procedures and which will in any case be different *per* national or regional system.

1.3 Who Can File the Application, How, and What Does It Need to Indicate?

International applications are to be presented to the International Bureau of WIPO by the national or regional authority that the country of origin of the geographical-origin-brand has identified for the exchange of communications with WIPO under the procedures of the Lisbon System. Usually, this will be the agency responsible for the grant of protection in the country or intergovernmental organization concerned. Consequently, a procedure needs to be available in each member of the System for right holder(s) to submit a request to that agency for filing an international application with WIPO. The Geneva Act is flexible as to who are the right holders that can submit such a request and specifies that an application can be filed in the name of: (i) the beneficiaries, i.e. those having the right to use the geographical-origin-brand; or (ii) a natural person or legal entity having legal standing under the law of the country of origin to assert the rights of the beneficiaries or other rights in the geographical-origin-brand, i.e. whoever is entitled to exercise control over the use of the geographical-origin-brand or to enforce rights in it.

The Geneva Act also provides for the possibility that such beneficiaries or such a natural person or legal entity can file the application with WIPO directly. However, such possibility only applies if the country of origin has made a declaration that its legislation allows for direct filings by right holders in respect of geographical-origin-brands. In regards to the content of an application, the Regulations under the Geneva Act distinguish between mandatory indications, declaration-based indications and optional indications.¹ As for mandatory indications, it is obvious that the

¹Rule 5 of the Regulations under the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (as adopted on May 20, 2015).

geographical-origin-brand itself needs to be mentioned in the application. However, also the good(s) to which the brand applies have to be indicated, as well as the applicant(s), the country of origin (or regional organization) and the beneficiaries or the natural person or legal entity referred to above. In addition, an indication needs to be given of the boundaries of the geographical area where the good(s) are made² and the identifying details of the national or regional registration (or other decision) by virtue of which protection was granted to the geographical-origin-brand in the country of origin (or regional organization). If the national or regional registration (or other decision) explicitly mentions that one or more elements of the brand are not covered by the protection granted, these elements have to be indicated in the application as well.³

The application may also need to contain other indications. That is because, under the Geneva Act, a country or regional organization that a member of the System may notify the Director General of WIPO that, for protection of the geographical-origin-brand in its territory, the application must be signed by a natural person or legal entity having legal standing under the law of the country of origin to assert the rights of the beneficiaries or other rights in the geographical-origin-brand. A member of the System may also notify the Director General that the application must be accompanied by a declaration of intention to use; or that the application must indicate particulars concerning the quality, reputation or characteristics of the good and the connection thereof with the good's geographical origin. If such a declaration-based requirement is not met, the International Bureau of WIPO will not reject the application, but the geographical-origin-brand that is the subject of the resulting international registration will not be protected in a country or regional organization that has notified the requirement in question. Protection can, however, be extended to such a country or regional organization as from a later point in time, once the requirement is met.⁴ The same will apply in respect of a country or regional organization that has notified the Director General that, for protection of the geographical-origin-brand in

²Such a geographical area of origin may consist of the entire territory of the country of origin or a region, locality or place in it, or even a trans-border geographical area (Article 2(2) of the Geneva Act). Descriptions of geographical areas of origin vary widely. For example, in respect of Lisbon registration No. 892 for the Serbian appellation of origin Homoljski med (honey), the geographical area of origin is described as "geographical area in Eastern Serbia". In respect of Lisbon registration No. 80 for the French appellation of origin Bordeaux (wine), the geographical area of origin is described as "delimited territory within the department of Gironde". However, in respect of, for example, Lisbon registrations Nos. 893 and 931, the description of the geographical area of origin is very detailed covering about a page of text.

³By way of example, reference could be made to the registration of the cheese "Edam Holland" as a protected geographical indication (PGI) in the European Union. The decision by virtue of which protection was granted to this PGI in Commission Regulation (EU) No. 1121/2010 of 2 December 2010 explicitly mentions that the PGI protects "Edam Holland", but that "Edam" remains free for use as a generic term for a particular kind of cheese.

⁴Rule 16(2) of the Regulations under the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (as adopted on May 20, 2015).

its territory, a fee has to be paid to cover the cost of substantive examination of the international registration by its competent authority. Such a country or regional organization may also require an administrative fee relating to the use by the beneficiaries of the geographical-origin-brand in its territory.⁵

As per the costs for the acquisition and maintenance of an international registration, it should be noted that no fee amounts have been established in the Geneva Act or its Regulations. It is for the Assembly of the members of the Lisbon System to make a decision on this prior to the entry into force of the Geneva Act. However, for comparison, under the current Lisbon Agreement, following a decision by the Assembly in October 2015, the fee to be paid for an international registration is 1000 Swiss francs and for any subsequent modification of the international registration 500 Swiss francs. International registration is not subject to renewal. Furthermore, as mentioned in the previous paragraph, the Geneva Act will introduce the possibility for its members to require an individual fee to cover the cost of substantive examination of the international registration by its competent authority as well as an administrative fee relating to the use by the beneficiaries of the geographical-origin-brand in its territory.

1.4 Definition(s)

Under the Geneva Act, geographical-origin-brands can be registered when they meet either of the following definitions:⁶

- (i) “any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area, where the quality or characteristics of the good are due exclusively or essentially to the geographical environment, including natural and human factors, and which has given the good its reputation”; or
- (ii) “any indication protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another indication known as referring to such area, which identifies a good as originating in that geographical area, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin”.

In the Geneva Act, these geographical-origin-brands are referred to as “appellations of origin” and “geographical indications”, respectively. However, the Geneva Act does not require member countries and intergovernmental organizations to use

⁵Article 7(4) of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (as adopted on May 20, 2015).

⁶Article 2(1) of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (as adopted on May 20, 2015).

the same terminology. As mentioned before, the Geneva Act provides for the registration and protection of geographical-origin-brands whether such protection is provided under national or regional law in the form of an appellation of origin, a geographical indication, a certification mark, a collective mark or whatever other title as may exist under national or regional law for geographical-origin-brands.⁷

Moreover, there will be no obligation for member countries and intergovernmental organizations to make a distinction in their legislation on the basis of these two definitions.⁸ They are free to provide protection on the basis of one definition only—a definition that corresponds to the broader definition mentioned under (ii)—in which case they have to deal with denominations, as referred to under (i), as if they are indications, as referred to under (ii).

1.5 Protection

The content of the protection to be granted in respect to geographical-origin-brands in member countries and intergovernmental organizations has to be in accordance with the level of protection required by the provisions of the Geneva Act in that respect. As with every rule, there are also exceptions. However, before addressing the possible exceptions, the following sections will first explain what protection member countries and intergovernmental organizations have to provide under their national or regional law.

The Geneva Act makes a distinction between any use of the geographical-origin-brand in respect of goods of the same kind as those to which the brand applies and any use in respect of goods that are not of the same kind or services.⁹ In respect to goods of the same kind, protection has to be available for right holders against any use of the brand in respect to goods that do not originate in the geographical area of origin specified in the international registration. In addition, right holders must have the opportunity to take legal action against any use of goods that do originate in that geographical area but do not comply with other requirements that may apply for use of the brand—for example, if production of the goods has not taken place in conformity with the requirements specified in respect of the geographical-origin-brand.¹⁰ Regarding goods that are not of the same kind, or services, protection has to be available against use that would indicate or suggest a connection between those goods or services and the beneficiaries of the internationally registered geographical-origin-brand and would be likely to damage their interests. In addition, protection may be available in a given member country or

⁷Ibid, Article 10(1).

⁸Ibid, Article 9.

⁹Ibid, Article 11(1)(a).

¹⁰For example, the product specification (*cahier de charge*) of an appellation of origin or the regulations governing use of a certification mark.

intergovernmental organization against any use that would be likely to impair or dilute in an unfair manner, or take unfair advantage of, the reputation that the brand has in that member.

The Geneva Act further specifies that “use of the geographical-origin-brand” is not limited to its use in exactly the same form, but also covers use of the brand that amounts to imitation of the brand, in particular use of the brand with slight differences, use in translation, use in combination with a delocalizing term, or in combination with terms such as “style”, “kind”, “type”, “make”, “imitation”, “method”, “as produced in”, “like”, “similar” or the like.¹¹ Thus, any use of the geographical-origin-brand as a generic term for a particular kind of good can, in principle, be stopped by the right holders. However, as we will see below, exceptions may apply in this regard.

Unfair competition can also exist in the form of other practices in the presentation of goods than those addressed in the previous paragraphs. In that sense, the Geneva Act specifies that right holders must have the opportunity to take legal action against such practices, if these are liable to mislead consumers as to the true origin, provenance or nature of the goods.¹²

Issues may also arise when trademark rights are claimed in respect of a sign consisting of or containing the geographical-origin-brand. As we will see below, exceptions may apply in this regard in case the trademark predates the geographical-origin-brand. However, if the geographical-origin-brand is the earlier right, the Geneva Act specifies that registration of the later trademark must be refused or invalidated in a member country or intergovernmental organization where the geographical-origin-brand was first, if use of the trademark would result in one of the situations addressed in the previous paragraphs.¹³ The purpose of this provision is to prevent the registration of trademarks that consist of or contain an internationally registered geographical-origin-brand for goods that do not originate in the geographical area of origin or, if they do originate there, are not in conformity with the requirements for use of the geographical-origin-brand. The use of trademarks containing a geographical-origin-brand is allowed, provided they are used in respect of goods originating in the geographical area of origin of the brand and complying with any other applicable requirements for using the brand.¹⁴

Member countries or intergovernmental organizations may also provide more extensive protection than stipulated in the Geneva Act and the Geneva Act does not affect any other protection that members may accord under a bilateral, pluri-lateral

¹¹Article 11(2) of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (as adopted on May 20, 2015).

¹²Ibid, Article 11(1)(b).

¹³Ibid, Article 11(3).

¹⁴It is recalled that the term “geographical-origin-brand” is used in this chapter to refer to any indicator of a specific product from a particular geographical area. Depending on the applicable national or regional law, these are called appellations of origin, geographical indications, collective marks or certification marks.

or multilateral agreement. Thus, nothing in the Geneva Act shall derogate from any obligations that members have in respect to each other, and nothing shall prejudice any rights they have, under, for example, the WTO TRIPS Agreement.¹⁵

1.6 Obstacles May Exist for Obtaining Protection in (Some) Countries

By their accession to the Geneva Act, member countries and intergovernmental organizations commit themselves to protect geographical-origin-brands registered under the Geneva Act on their territory in accordance with the terms of the Geneva Act.¹⁶ They can do so within their own legal system and practice, which means that they are not obliged to use the same wording and terminology as used in the Geneva Act, as long as they meet the substantive requirements of the provisions of the Geneva Act.¹⁷ Moreover, as already mentioned in the previous section, obstacles may exist for obtaining protection in (some) foreign countries. The commitment for members to protect geographical-origin-brands registered under the Geneva Act of the Lisbon Agreement is subject to any refusal, renunciation, invalidation or cancellation that may become effective with respect to the territory of a member country or intergovernmental organization.¹⁸ As the Geneva Act is not yet in force, let me illustrate this on the basis of the first ever geographical-origin-brand registered under the Lisbon Agreement itself, i.e., the appellation of origin Plzeň (or Pilsner, Pilsener, Pilsen Pils) for beer originating from that city in the Czech Republic.¹⁹ In respect of this appellation of origin, eight members of the Lisbon Agreement have sent a notification to the International Bureau of WIPO stating that they could not ensure its protection. Following Mexico's withdrawal of its refusal,²⁰ the appellation of origin is under protection in 20 Lisbon members (other than the country of origin) and not under protection in the seven countries whose refusals remain effective.

Refusals have to be submitted by the country's competent authority within one year from the receipt of the notification of a new international registration, or from the date on which a country's accession becomes effective,²¹ and they must indicate the ground on which the refusal is based. In regards to the appellation of origin

¹⁵Article 10(2) and (3) of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (as adopted on May 20, 2015).

¹⁶*Ibid.*, Article 9.

¹⁷*Ibid.*, Articles 9 and 10(1).

¹⁸*Ibid.*, Article 9.

¹⁹International registration No. 1, dated November 11, 1967.

²⁰May 25, 1980.

²¹Under the Geneva Act, a member may declare that it will apply two years for the examination of the existing stock of international registrations.

Plzeň (or Pilsner, Pilsener, Pilsen Pils), the refusals issued show four different grounds of refusal. Bosnia and Herzegovina, Montenegro, Serbia and The former Yugoslav Republic of Macedonia based their refusal on the fact that, in their territories, the denomination Plzeň (or Pilsner, Pilsener, Pilsen Pils) is a generic indication for a certain type of beer. Peru and Mexico based their refusal on the existence of prior trademark rights. France refused the term “Pils” on the ground that it does not constitute an appellation of origin. The Islamic Republic of Iran based its refusal on the fact that, under Iranian law, the production, distribution and consumption of alcoholic beverages is prohibited and appellations that are against religious values, ethics or public order are not protected.

Under the Geneva Act, refusals can, just as under the Lisbon Agreement, be based on any ground. Nevertheless, the practice under the Lisbon Agreement shows that, in respect of the majority of international registrations, the International Bureau of WIPO has not received any refusal. Even in the case of those international registrations that were refused by several countries, still the majority of countries did not submit a refusal. In this regard, reference could be made to international registration No. 837 for the Czech appellation of origin Budweiser Burgerbräu, for which 11 refusals are effective—which means that the appellation of origin is under protection in 16 Lisbon members (other than the country of origin).²²

1.7 Safeguards

The Geneva Act specifies that member countries and intergovernmental organizations have to provide safeguards in respect of prior trademark rights, personal names in business and rights based on a plant variety or animal breed denomination. Other safeguards are contained in two Agreed Statements by the Diplomatic Conference that adopted the Geneva Act. Regarding prior trademark rights, the Geneva Act recognizes that, among the existing national and regional systems, some allow, in certain circumstances, for coexistence of the geographical-origin-brand and the prior trademark, while other systems do not allow for such exceptions. In that sense, the Geneva Act specifies that, in principle, the provisions of the Geneva Act shall not prejudice prior trademark rights acquired in accordance with the law of the member country or intergovernmental organization concerned. However, where a member country or intergovernmental organization, which allows for coexistence, provides a limited exception to the rights conferred by a trademark to the effect that such a prior trademark may, in certain circumstances, not entitle its owner to prevent the grant of protection in respect of the

²²The content of the International Register of the Lisbon System can be consulted on-line on the WIPO website at <http://www.wipo.int/ipdl/en/lisbon/>.

geographical-origin-brand or its use in the territory of that member, protection of the geographical-origin-brand shall not limit the rights conferred by that trademark in any other way. This is meant to ensure that it is up to each member to provide rights on the basis of the principle of *first-in-time first-in-right* or on the basis of coexistence of the geographical-origin-brand as a limited exception to the trademark right.²³

Under the Geneva Act, geographical-origin-brands that are the subject of an international registration are protected against becoming generic.²⁴ However, it is understood that a geographical-origin-brand may not be protectable, in whole or in part, in other members than the country of origin, as the brand may contain, or consist of, a term that, at the time of international registration of the brand, is generic in such member State, for example because the brand, or part of it, is identical with a term customary in common language as the common name of a good or service, or is identical with the customary name of a grape variety.²⁵ In addition, it is understood that, where certain elements of the brand have a generic character in the member country of origin, their protection shall not be required in the other countries. Reference could be made to the Edam Holland example mentioned above. Refusal or invalidation of a trademark or a finding of infringement in a member country or intergovernmental organization cannot be based on a component that has a generic character.²⁶ Whether a term, element or component can be considered to have a generic character in accordance with the provisions of the Geneva Act is to be determined in legal proceedings in the member country or intergovernmental organization concerned,²⁷ within that member's own legal system and practice.²⁸

1.8 Conclusion

The present chapter outlines the advantages of the Geneva Act of the Lisbon Agreement for the protection of geographical-origin-brands abroad. Thanks to the flexibilities the Act contains, its international registration and protection system should be attractive for any country that has an interest in allowing right holders in geographical-origin-brands for products from its territory to defend their rights in the jurisdictions of multiple actual and potential export markets.

²³Article 13(1) and (4) of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (as adopted on May 20, 2015).

²⁴*Ibid.*, Article 12.

²⁵Agreed Statement, adopted by the Diplomatic Conference, to Article 12 of the Geneva Act.

²⁶Agreed Statement, adopted by the Diplomatic Conference, to Article 11(2) of the Geneva Act.

²⁷Article 14 of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications (as adopted on May 20, 2015).

²⁸*Ibid.*, Article 9.

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Author Biography

Geuze was in charge of the administration of the International Register under the WIPO-administered Lisbon Agreement for the Protection of Appellations of Origin and their International Registration from 2007 until his retirement in February 2016. In this capacity, he has been the Secretary of the Working Group on the Development of the Lisbon System that prepared the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, which was negotiated between 2008 and 2015 and adopted by a Diplomatic Conference at WIPO headquarters in May 2015.

Chapter 2

The Geneva Act of the Lisbon Agreement: Controversial Negotiations and Controversial Results

Daniel J. Gervais and Matthew Slider

Abstract This chapter examines the historical process that led to the adoption of the Geneva Act of the Lisbon Agreement for the Protection of Appellations of Origin, and some of the debates that may arise as ratification and implementation of the new Act progress. The chapter also considers whether common law jurisdictions are likely to eventually join the updated Lisbon system and the potential motivations for doing so, as at the time of this writing, none were part of this system yet. The chapter observes that the bridge between Lisbon and the common law system has not yet been built because of the different approaches of the Old World and New World representatives to appellations of origin as governed by the Geneva Act. Old World representatives are normatively rigid and concerned with preserving traditional elements such as *terroir* while New World representatives are concerned with elements of genericness and economic value. Thus, the adoption of the Geneva Act of the Lisbon Agreement represents a clear chance to reconcile the Lisbon system doctrinally and render it more appealing to a larger array of countries.

2.1 Introduction

Geographical indications (GIs) matter on several levels. They have roots in the *terroir*, a French word designed to encapsulate a blend of land, tradition, and human know-how (Hughes 2006). *Terroir* matters to many producers and many countries,

A US-focused version of part of this chapter is published in the *Houston Law Review* as Daniel Gervais, ‘Irreconcilable Differences? The Geneva Act of the Lisbon Agreement and the Common Law’ (2015) 53 *Houston Law Review* 339. Another part is based in part on the following book chapter: Daniel Gervais, “A Cognac after Spanish Champagne? Geographical Indications as Certification Marks”, in *Intellectual Property at the Edge* (Jane C. Ginsburg and Rochelle Dreyfuss, eds) (Cambridge Univ. Press, 2014) 130–155.

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and not just in Europe. But in parts of the ‘Old World’, it is not an exaggeration to say that some countries link *terroir* to national identity (Guy 2009; Credit 2009, 427). So-called ‘New World’ producers see things differently. While they also recognize the economic value of geographic origin for certain products (e.g., in the United States, Napa Valley wines, Vidalia onions, Wisconsin cheese and Idaho potatoes), they are concerned about possible restrictions on the use of terms considered generic (meaning terms that describe a type of product not its geographic origin) (McCarthy 1999, §19:92.50). Developing country producers have concerns of their own, notably about the protection of foreign terms that have become or may become generic in their country or region. Several developing nations also see GIs as a way of protecting and globally marketing rural and traditional products at a higher price, which they assert should lead to ‘development from within’, that is, ‘an alternative development strategy that prioritizes local autonomy and broad, community-wide development goals’ (Bowen 2010, 232; Gervais 2012a, 121–47). GIs tend to focus production on a nation’s comparative advantage in making a product whose origin infuses it with a higher market value (Bramley et al. 2009, 121). GIs may have environmental significance and thus form an increasingly relevant part of agricultural and food policy (van Caenegem 2004, 172–73). It is not surprising, therefore, that the debate surrounding the protection of GIs has captured the attention of a number of consumer groups, many of which insist on proper labeling of products, notably to indicate their origin.

At an international level, a *sui generis* regime of protection (that is, outside of trademark law) for ‘appellations of origins’ has been in place since the adoption of the 1958 Lisbon Agreement.¹ In May 2015, a number of World Intellectual Property Organization (WIPO) member States met in Geneva and adopted a new version or ‘Act’ of the Lisbon Agreement.² In this chapter, we consider the process that led to the adoption of this Geneva Act and some of the controversies that may arise as the ratification and implementation of the new Act is underway, and whether common law jurisdictions are likely to join the updated Lisbon system.

As of this writing (January 2017), no common law jurisdiction is party to the Lisbon Agreement (WIPO 2013).³ There are a number of reasons that explain this lack of enthusiasm. Several common law jurisdictions use trademarks, collective

¹Lisbon Agreement for the Protection of Appellations of Origin and their International Registration 1958 (Lisbon Agreement). The notions of appellations of origin and geographical indications are closely related. One of the authors discussed the differences in detail in Daniel Gervais, ‘Reinventing Lisbon: The Case for a Protocol to the Lisbon Agreement (Geographical Indications)’ (2010) 11 *Chicago Journal of International Law* 67, 83–87.

²Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, 2015 (Geneva Act). A previous update of the original 1958 Lisbon Agreement was adopted on July 14, 1967.

³As of February 2016, the parties to the Lisbon Agreement are: Algeria, Bosnia and Herzegovina, Bulgaria, Burkina Faso, Congo, Costa Rica, Cuba, Czech Republic, Democratic People’s Republic of Korea, France, Gabon, Georgia, Haiti, Hungary, Iran, Israel, Italy, Mexico, Montenegro, Nicaragua, Peru, Portugal, Republic of Moldova, Serbia, Slovakia, the former Yugoslav Republic of Macedonia, Togo, and Tunisia.

marks, and certification marks to protect geographic symbols and names, instead of a *sui generis* regime. This has a number of both normative and administrative implications, including use requirements, possible loss or diminution of right due to acquiescence and abandonment or genericness, and the payment of maintenance fees, to mention just the main ones. The question of the compatibility of *terroir* recognition in law with modern international trade rules has also been raised in the United States and elsewhere. The chapter proceeds as follows. In Part I, we review the adoption process, which was somewhat unusual. In Part II, we review the outcome, namely the main features of the Geneva Act. In Part III, we review future options, including whether the Geneva Act is likely to gain global traction as a vehicle to protect GIs. In Part IV, we discuss briefly what implications this may have for other multilateral initiatives.

2.2 Procedural Controversies

2.2.1 *Stated Objectives at Odds with the Willingness to Compromise*

According to WIPO Director General Francis Gurry, a primary objective of the adoption of the Geneva Act was to ‘produce a Lisbon system that is attractive to the full membership of the Organization’ by providing a ‘basis for the expression of the Lisbon system beyond the *historically rather low level of participation* amongst the members states of the WIPO’.⁴ Such a statement recognizes that, despite over 50 years of existence, the Lisbon Union was perceived as unattractive to the full membership of WIPO. As of early 2017, it only had 28 members. By comparison, the Madrid Union (international registration of trademarks) had 98 members, the Hague Agreement (Industrial Designs) had 66 contracting parties, and the Patent Cooperation Treaty (PCT) had 151 contracting parties.⁵ Placed in this context, the Lisbon system appears to be an IP ‘niche’. Although the stated objective of the Geneva Act was to widen the scope of the Lisbon Agreement, that objective was not reflected in the procedure chosen to negotiate and adopt the New Act. Instead of

⁴*Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement*, World Intell. Prop. Org., available at <http://www.wipo.int/webcasting/en/index.jsp> (as consulted 1 Feb 2015) (to find the Director General’s comments, select on ‘Videos on Demand,’ choose LI/DC: Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement for the Protection of Appellations of,’ select LI/DC—Mon 11—Opening Ceremony and Plenary, remarks begin at 4: 21 min in.).

⁵*Status on January 15, 2017*, <http://www.wipo.int/export/sites/www/treaties/en/documents/pdf/hague.pdf> (as consulted Jan. 17, 2017) (document listing Hague members); Contracting Parties > Madrid Protocol, WIPO, http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=8 (as consulted Jan. 17, 2017) (webpage listing Madrid members); Contracting Parties > Patent Cooperation Treaty, http://www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=6 (as consulted Jan. 17, 2017) (webpage listing PCT members).

granting all WIPO members full participation rights, the Lisbon Union kept voting rights for all ten sessions of the working group and then the Diplomatic Conference restricted to its current 28 member states. This relegated the majority of WIPO members who were not also Lisbon member states to observer status, able only to participate by making statements (only after the list of member States requesting the floor had been exhausted) and submitting proposals but unable to vote. This move infuriated a number of non-member countries, especially the United States. Critics of the Geneva Act's procedure alleged that it was a divisive procedure that called into question the very legitimacy of the process, especially in view of the fact that rules of procedure adopted by the Lisbon Assembly bucked some precedents at WIPO that would have supported opening up a treaty revision fully to all members (*General Report 2016*, p. 38). Lisbon members held firm that the rules and procedures for both the working group meetings and the Diplomatic Conference were not only valid and fair, but indeed were legally required. In a joint letter distributed to all non-members, Lisbon members stated that they were 'bound by international law' to restrict full participation. Invoking the Vienna Convention on the Law of Treaties (VCLT), they argued that to allow only contracting parties to a treaty to 'decide on the conditions of its amendment' was not only possible but mandated by the VCLT (Saez 2015a). The letter also argued that Article 13 of the 1958 Lisbon Agreement stipulated that the text 'may be revised by conferences held between the delegates of the countries of the Special Union'.

These assertions are questionable. First, the Director of WIPO's Office of Legal Counsel, Edward Kwakwa, stated that neither the VCLT nor Article 13 of the 1958 Lisbon Agreement explicitly *required* Lisbon members to restrict voting rights to member states (Saez 2015c). In short, Lisbon members had the choice. The WIPO Secretariat, including Director General Francis Gurry and Deputy Director General Binying Wang,⁶ apparently concur on this point. At the sixth working group meeting, they noted that:

'[T]he Working Group would recommend the Lisbon Union Assembly to call a diplomatic conference for the adoption of a Revised Act of the Lisbon Agreement, the Rules of Procedure adopted at the Conference would in turn determine who would have a right to vote' (*Report 2013*, 7).

Furthermore, as already noted a number of precedents favored full participation. For example, a U.S. official cited 'a longstanding tradition' at WIPO to include all members in the process of revising WIPO-based treaties, citing three recent cases, namely the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled adopted in 2013; the Beijing Treaty on Audiovisual Performances adopted in 2012; and the 1999 Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs (Saez 2015b). In all three examples all WIPO members had full

⁶The WIPO Secretariat also included Matthijs Geuze, Head, Lisbon Registry, Brands and Designs Sector; Florence Rojal, Legal Officer, Lisbon Registry, Brands and Designs Sector.

participation rights.⁷ It can be said that the first two were new instruments and not a new act of an existing treaty, though they certainly had to fit within the framework of extant instruments including the Berne Convention for the Protection of Literary and Artistic Works and other copyright-related instruments to which not all WIPO Members are members. The Hague revision is directly on point, however, it was a revision of an existing agreement. The argument that Lisbon itself *required* a closed vote (open only to existing members) is thus dubious. The relevant language of the Lisbon Agreement did not *foreclose* opening the process to all WIPO Members. Article 13(2) of the Lisbon Agreement is clear: the ‘Agreement *may* be revised by conferences held between the delegates of the countries of the Special Union.’ Indeed, the 1999 Geneva Act to the Hague Agreement contains similar language in Article 25(1) and was the product of a revision process open to all members. On its face, language such as ‘*may* be revised’ allows for flexibility to keep participation limited in cases of minor revisions. The phrase also leaves the door open to include all members in the case of complete revision or the adoption of a new treaty. The fact that the 1958 Lisbon Agreement shares similar language with other WIPO-administered instruments strengthens the argument that the 1958 Lisbon Agreement is not unique in this regard.

The 2006 Diplomatic Conference for the Adoption of a Revised Trademark Law Treaty (TLT) opened participation to all WIPO members.⁸ That conference resulted in the Singapore Treaty on the Law of Trademarks and contrasts sharply with the Geneva Act to the Lisbon Agreement. Perhaps one could argue that the Singapore revision was different because the Geneva Act extended Lisbon Agreement protection beyond appellations of origin to the broader notion of geographical indications (*Geneva Act 2015*).⁹ By contrast the Singapore Treaty only widened the scope of protected marks (*Regulations Under Singapore Treaty 2011*).¹⁰ As one of the Authors demonstrated in a previous publication, however, there was little difference between AOs and GIs to begin with (Gervais 2010a, 83–86). Moreover, in discussing the draft rules and procedures for the Geneva Act, the delegation of

⁷Rules of Procedure for the Diplomatic Conference to Conclude a Treaty to Facilitate Access to Published Works by Visually Impaired Persons and Persons with Print Disabilities *available at* http://www.wipo.int/edocs/mdocs/diplconf/en/vip_dc/vip_dc_2.pdf; Preparatory Committee of the Diplomatic Conference on the Protection of Audiovisual Performances, *available at* http://www.wipo.int/edocs/mdocs/copyright/en/avp_pm/avp_pm_3.pdf; Diplomatic Conference For The Adoption Of A New Act Of The Hague Agreement Concerning The International Deposit Of Industrial Designs - Draft Rules Of Procedure, *available at* http://www.wipo.int/edocs/mdocs/diplconf/en/h_dc/h_dc_2.pdf (as all consulted on March 21st 2016).

⁸Rule 33 of the rules of procedure stated, ‘[e]ach Ordinary Member Delegation shall have the right to vote. An Ordinary Member Delegation shall have one vote, may represent itself only and may vote in its name only’.

⁹Article 11 covers protections of both appellations of origin and GIs and therefore constitutes an expansion over the 1958 Lisbon Agreement, which only covered appellations of origin.

¹⁰Rule 3 of the regulations allows for the protection of, among others, a ‘Hologram Mark’, ‘Motion Mark’, ‘Color Mark’, and ‘Position Mark’, expanding the scope of the Trademark Law Treaty.

Switzerland reasoned that appellations of origin were a sub-category of GIs and therefore the Lisbon Agreement already de facto essentially covered GIs (Saez 2015a). Besides, if this logic held, then the contracting parties for the Trademark Law Treaty could have put forth a very similar argument in regards to a revisionary Diplomatic Conference. By stating that the previous Trademark Law Treaty covered specific types of trademarks, each a sub-category of ‘trademarks as a whole,’ contracting parties could have asserted that the Trademark Law Treaty merely needed to be updated to cover ‘trademarks as a whole’ just as the Lisbon Agreement would be updated to cover GIs ‘as a whole’. Nevertheless, the contracting parties to the TLT chose to open the voting on the Singapore Treaty to all WIPO members. This reinforces the notion that the Lisbon Union made a conscious decision to deny all non-Lisbon member states the right to vote.

Bolstering the impression that the Geneva Act to the Lisbon Agreement represented a ‘new’ treaty—and thus necessitated extending the right to vote to all member states at the Diplomatic Conference—was a Secretariat’s statement during the fifth session of the working group. This statement concerned the substance of the proposed revisions as they began to take place. Following a discussion in which several delegations questioned whether a Diplomatic Conference would be required to implement the revisions and the EU delegation suggested that the term ‘Revision Conference’ could serve as an alternative, the WIPO Secretariat¹¹ issued a clarifying statement (*Report 2012b*, pp. 44–45). It was recorded as follows:

‘In response to the question raised by the Delegation of Iran (Islamic Republic of) as to whether a Protocol would be a new treaty or where it would fit in the text which only referred to a revision of the Lisbon Agreement, the Secretariat said that the answer to that question would depend on the nature of the Protocol itself. Hence, if in substance the Protocol went beyond the ambit of the original Lisbon Agreement then the Protocol would be considered to be a new treaty, whereas, if the Protocol stayed within the ambit of the original Agreement, it would be seen as a Protocol amending the Lisbon Agreement. *The Secretariat pointed out that the working documents focused more on a Protocol as a new treaty rather than an amending Protocol to an original treaty.*’

This statement from the WIPO Secretariat suggests that the substance of the revisions at the fifth working group necessitated a new treaty and full participation of all WIPO members. As the overall substance of the revisions were not drastically changed or scaled back to stay within the ambit of the original Lisbon Agreement, a diplomatic conference open to all WIPO members would have been required in order to enact a new treaty. Yet, while a diplomatic conference was indeed called, the rules and procedures withheld voting rights from non-Lisbon member states.

¹¹The WIPO Secretariat at the fifth session of the working group consisted of the following: Francis Gurry, Director General; Binying Wang, Deputy Director General; Matthijs Geuze, Head, Lisbon Registry, Brands and Designs Sector; Florence Rojal, Legal Officer, Lisbon Registry, Brands and Designs Sector; Jessica Van Weelde, Consultant, Lisbon Registry, Brands and Designs Sector.