Chapter 2
The Geneva Act of the Lisbon Agreement: Controversial Negotiations and Controversial Results

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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,

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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; Creditt 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

[1]Lisbon 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.

[2]Geneva 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.

[3]As 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

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[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

[6]The 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 exiting 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

[7]Rules 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).*

[8]Rule 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'.

[9]Article 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.

[10]Rule 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 Secretariat[11] 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.

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[11]The 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.

2.3 Actions and Results Reveal Motivations Behind Decisions

The decision by the Lisbon Union to keep voting closed to non-members reveals the Lisbon member states' motivation. The representative of CEIPI,[12] Francois Curchod, a former Deputy Director-General of WIPO, offered a prescient statement in the fourth session of the working group, recorded as follows:

> 'The Representative of CEIPI recalled that he had indeed raised the question of the apparent contradiction between the desire of a majority of the member States of the Lisbon Union to maintain or even strengthen the current level of protection and to apply it in a uniform fashion to both appellations of origin and geographical indications on the one hand, and on the other hand *the fact that such a position might compromise the purpose of the review, which was to make the system more attractive* for countries which were not in the system at present' (*Report* 2012a, 35–36).

The decision to opt for a high level of protections at the expense of making the Lisbon Agreement more attractive becomes all the more apparent when one looks at the statements and positions from the working groups on the development of the Lisbon system. In June of 2014, the participating parties at the ninth session of the working group discussed draft Article 11 concerning the protection contracting parties would be required to extend to a registered GI or AO (*Report* 2014a, 29–35). The minimal level of protection afforded to rights holders was a crucial topic and thus ardently debated. The proposed Article 11(3) was particularly controversial, as it provided that a state could declare that protection guaranteed by 11(1) were 'not compatible with its legal system' and lower level of protection otherwise available under 11(1).

The U.S. delegation spoke early in the proceedings and argued in favor of 11(3), explaining how 11(1) was incompatible with its common law trademark system. The Australian delegation supported the U.S. by proposing that 11(3) should actually replace the level of protections afforded in 11(1) as the former was 'more inclusive and consistent with existing international standards'. The delegation of the EU initially responded by stating that it 'had some difficulties in understanding the idea that the Revised Lisbon Agreement would establish two standards for the required level of protection.' The EU then stated concisely that it 'failed to understand' the argument that 11(1) might not be compatible with the laws of potential contracting parties. These statements illustrate how large the intellectual gap and level of disagreement was between the two delegations most representative of different trademark (and GI) systems. While the U.S. argued vigorously that the draft was incompatible with its current system, the EU neglected to offer any counterargument detailing how a trademark system could coexist with higher levels

[12]CEIPI is an French acronym for the Strasbourg-based 'Centre d'Etudes Internationales de la Propriété Intellectuelle' otherwise written in English as 'Centre for International Intellectual Property Studies.' The president of the Board was, until recently, WIPO Director General Francis Gurry.

of GI protections. Rather, the EU effectively threw its hands up and pretended that it simply could not understand what the U.S. was talking about, a statement that the authors find somewhat hard to take at face value. While it may be argued that non-Lisbon members could have done more, they obviously do not bear all the blame for this failure to compromise. They had no voting right and held no legal leverage in the negotiations.

While the withholding of voting power eventually became a controversial issue, the subject was not discussed in the early sessions of the working group. Indeed, no delegation mentioned voting until the fifth session. The United States did not formally participate on the record until the sixth session. Did the United States and other common law countries simply expect a full vote as a 'right' afforded all WIPO members, or can they be blamed for failing to ask early enough? The U.S. delegation addressed this matter in the eighth working group session, claiming that they had not participated much in the early stages because it was the delegation's understanding that the working group's mandate was limited to making procedural changes, as opposed to creating a new treaty entirely (*Report* 2014a, 4–5).[13] This may be correct. Yet it can also be argued that by the *fifth* working group session it was clear that a new substantive treaty was the preferred outcome of many Lisbon members (*Report* 2012b).

This brings up the convoluted nature of the issue. While Lisbon member States wanted to keep the revision 'in-house' and exclude common law members from full participation, the U.S. for its part might not have truly been interested in participating substantively when it saw that the desired result was a new treaty increasing the attractiveness of the Lisbon system and its sui generis approach to GI protection. To be fair, one can intimate from the early working groups' reports that Lisbon members made very few efforts to craft a new agreement attractive to a common law nations. It is only when the picture of a thoroughly revised Lisbon system started to emerge that a number of non Lisbon members started to give this process their full attention. This late interest was perhaps due to a sincere desire to contribute and ultimately participate in the new system, but some saw it as an effort to limit the long-term attractiveness of the new system.

Despite its lack of regard for the concerns of several non-Lisbon members, the Geneva Act might result in a more attractive Lisbon Union for a limited though not insignificant number of nations. For example, Germany and Switzerland stated that

[13]As quoted in the Report of the fifth working group: '[t]he Delegation of the United States of America went on to say that, since the subject-matter of the Lisbon Agreement, namely appellations of origin, featured in only a handful of protection systems around the world, the Delegation had not seen any reason to intervene in the work of the Lisbon Working Group by engaging with the text as such, all the more so as its initial understanding had been that the mandate of the Lisbon Working Group was limited to making procedural changes to the Lisbon Agreement, in order to accommodate the needs of certain Lisbon member States. However, the situation was very different now, because of the inclusion of geographical indications as subject matter. This meant that the Working Group was not merely dealing with a revision of the Lisbon Agreement but, instead, with an entirely new treaty. From the Delegation's perspective, this represented a radical expansion of scope and subject matter.'

they were interested in joining the amended Lisbon system (Saez 2015a) and many French-speaking African countries are reportedly set to join the system (Gervais 2015, 368). Whether that added attractiveness builds a far-reaching stable of member states remains to be seen. Any such optimism must be tempered by the reality that whatever added appeal exists is limited at best. At worst, a mildly appealing amended Lisbon system may be ironically counterproductive to the goal of achieving a comparatively more attractive registration system in the mold of the Hague, Madrid, and PCT registration systems (*Report* 2012b, 38–39).[14]

What if non-Lisbon member states had been fully at the table? Perhaps bold proposals necessitating substantive compromises would have been more heavily debated and possibly included in the final draft, including provisions on laches, abandonment and acquiescence. However, this presupposes a diplomatic conference in which a compromise on the whole was feasible. In this hypothetical scenario, one must imagine that a coalition of trademark countries would partake in the stated goal of creating a broadly attractive system. This, in retrospect, was probably a fantasy.

2.4 Retribution at the General Assembly

The procedure leading to the adoption of the Geneva Act has inspired consequences beyond the Diplomatic Conference. Many common law jurisdictions, including the United States, committed substantial effort, time and energy at the 2015 WIPO General Assembly to find a solution to the Lisbon system's long-term financial sustainability. Leaving no doubt for confusion, the U.S. delegation acknowledged in the opening plenary that it was bringing up financial stability as a result of being excluded from participation in the 'illegitimate' adoption of the Geneva Act in addition to opposing the outcome of the Geneva Act itself (*General Report* 2016, 38).[15] Thus, the U.S.' efforts to force the Lisbon system into financial sustainability

[14]Indeed, a statement from Director General Gurry at the fifth working group advocated for broadly increasing the attractiveness of the Lisbon system rather than achieving limited progress for the sake of preserving the strength of the system. The Director General noted that the most recent Madrid Protocol revision fell short of broadly increasing the attractiveness of the system after the Madrid member states chose to adopt terms in the best interest of member states, consequently setting back any chance of real expansion by ten years. In comparison, the Lisbon System was in even more dire need of boldly increasing attractiveness of the system.

[15]The U.S. delegation is recorded as stating, '[f]aced with serious questions as to why and how United States fees and contributions were being required to subsidize a system the adoption of which the State had opposed and which was so harmful to national trade, the Delegation could not support a framework under which the Lisbon System was permitted to carry a deficit covered by other Unions.' … 'It supported the use of PCT revenue to support the overall activities of the Organization because those activities had had the continuous support of the full membership. It objected only to the use of such revenue to support the Lisbon System, which, by its own Agreement, was required to be self-funding and which had recently been expanded without the broad consultations for which WIPO had long been respected.'

was at least in part a direct result of the procedure chosen for the 2015 Diplomatic Conference for the Revision of the Lisbon Agreement. More surprising, however, were the lengths to which the U.S. went to force the Lisbon Union to alter its method of financing. The U.S. first reiterated its position taken at previous meetings of the Program and Budget Committee that it would not support a budget for 2016–2017 unless a number of conditions relating to the financial independence of the Lisbon system were met (*General Report* 2016, p. 117). This hardline stance was further advocated for and bolstered within various sessions of the General Assembly as the U.S. added proposals regarding Lisbon financial sustainability to the agendas of the Lisbon Union, Madrid Union, PCT Union, and the WIPO Coordination Committee (WIPO 2016a).

In the Madrid and PCT sessions, the U.S. stated that no registration system should allow surpluses to be used by the Lisbon system to cover its deficit. Somewhat boldly, the U.S. proposed that, rather than letting it be used by Lisbon system, the Madrid Union should distribute its surplus among Madrid member states. Although supported by Australia, a coalition led by Switzerland, Hungary, and France rejected the proposal. Yet the U.S. succeeded by increasing awareness of the issue and opening up many nations to the idea of cutting the Lisbon Union off from access to surpluses generated by other registration and application systems (*Report* 2016a, b).

U.S.-applied pressure paid off. At the end of the 2015 General Assembly a compromise was reached on the Lisbon Union's portion of the 2016-2017 biennial WIPO budget. Just before midnight on the final day of the Assembly the Lisbon Union agreed 'to adopt measures by the 2016 Assemblies to eliminate the Lisbon Union's projected biennial deficit' (WIPO International Bureau 2015a, 8). Moreover, the General Assembly approved a *loan* from the other contribution-financed unions to the Lisbon Union to cover its impending deficit. While Lisbon members may be satisfied with the deal in the short-term, the U.S. will likely continue to put pressure on the Lisbon Union in the future. If the Lisbon Union is to make good on the promise to eliminate its deficit, then it must look at the prospect of raising fees yet again, likely much more substantially At the 2015 General Assembly, the Lisbon Union doubled registration fees to 1000 Swiss francs for an international application. Unfortunately, this improved fee schedule is not close to the 3350 Swiss franc fee recommended for registration under Director General Francis Gurry's proposal (WIPO International Bureau 2015, 5).[16] Furthermore, the fee increase pales in comparison to the Secretariat's summary of options in order to reach financial sustainability, which states that if single fees alone are to fund the operations of the Lisbon Union, the international registration fee required would

[16]The Director General's complete fee recommendation stated, '[i]n view of the preceding considerations, it is proposed that the Fee Schedule under Rule 23 of the Lisbon Agreement be updated, so as to reflect the following amounts: (i) an international registration fee of 3350 Swiss francs; (ii) a fee of 1500 Swiss francs for the modification of an international registration; (iii) a fee of 150 Swiss francs for providing an extract from the International Register; (iv) a fee of 100 Swiss francs for providing an attestation or any other information given in writing concerning the contents of the International Register'.

need to be anywhere from 54,750 to 80,357 Swiss francs (WIPO Secretariat 2015b). At that fee rate the system would be at risk of receiving no applications, thus endangering its very survival. Taken together, the Lisbon Union's commitment to erasing the deficit and taking loans are appropriately concerning. It may be necessary for Lisbon members to collect contributions from Lisbon member states in order to bridge the gap, but that would go against the current WIPO practice of the unitary contribution system. It also would be highly unpopular in certain circles. Regardless, the Lisbon Union will be under increasing pressure to balance its books, possibly taking measures that will make the system as a whole less attractive to WIPO member states and producers within those states. If the Lisbon system becomes less attractive over the next few years due to increased fees or obligatory member state contributions, then the Lisbon Union's aforementioned move to limit voting rights at the Diplomatic Conference would likely represent a mistake and a long-term setback for the Lisbon Union.

2.5 A Look at the Geneva Act

2.5.1 Registration Issues

A fuller comment on the substantive aspects of Geneva Act appears in Matthijs Geuze's chapter of the present volume. Nevertheless, a few features of the new Act deserve mention here in light of the kerfuffle over the process that led to the adoption of the new Act. The Geneva Act made several improvements to the administrative operation of the Lisbon register and generally modernized the system of registration of both geographical indications and appellations of origin, thus solving the terminological issue due to the reluctance that a number of countries had to using the notion of 'appellation of origin'. Appellations of origin are often considered to be tied to sui generis European systems, such as the well-known French and Italian systems of *appellation d'origine contrôlée* (AOC) et *denominazione di origine controllata*, respectively (Gervais 2010a, 108–09). Without offering an exhaustive list of such improvements, the Geneva Act (a) made the role of national offices much clearer; (b) allows members to charge a per country fee (for applications that seek protection in their territory); and (c) allows per-country fees to use the protected indication, though not the maintenance fees common to most trademark systems.[17] The Geneva Act also introduced a clearer system to refuse

[17]The issue of maintenance fees was the topic of heated debate during the conference. Maintenance fees had been mentioned in square brackets in early versions of the draft Geneva Act but did not make it into the final version. *Compare* Geneva Act 2015, arts 7–8 (explaining the fee structure, which does not include a maintenance fee), with WIPO Document LI/DC/3 of 14 November 2014 on the Basic Proposal for the New Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, art 7–8. WIPO doc. LI/DC/3 available at: http://www.wipo.int/edocs/mdocs/mdocs/en/li_dc/li_dc_3.pdf (as consulted March 21st 2016).

new GIs (and then withdraw refusals in whole or in part) at the time of application and a system allowing interested parties to 'request the Competent Authority to notify a refusal in respect of the international registration' (*Geneva Act* 2015, art 15–16, rule 19). By contrast, the 1958 Act did not mention grounds for refusal of a GI; did not explicitly allow partial refusals (though they had happened); and contained no detailed provision on withdrawals.[18] This reflects the nature of an administrative 'clean-up' rather than a true substantive change, however. Under Article 5 of the 1958 Agreement, a court or other competent authority in the country where protection is claimed could invalidate an appellation. The Geneva Act maintains this system more or less but includes both much clearer rules and specific processes.[19]

The issue of fees was a major discussion during the Diplomatic Conference and, as mentioned at the end of Part I, at the WIPO General Assembly that followed its adoption. Under the 1958 Lisbon system, applicants pay a *single fee once* to WIPO, none to the members' individual Offices, and their application is deemed valid (subject to refusal by individual members) essentially forever in all Lisbon member states where it was not initially refused or later invalidated (WIPO 2010, 2015).[20] This fee (which was 500 Swiss francs, but doubled as of 1 January 2016) is paid to, and retained by WIPO. The absence of country designation and 'per-country' fees stand in sharp contrast to the Patent Cooperation Treaty (PCT), the Madrid system for trademarks, and the Hague system for designs (WIPO 2010, 2015a; WIPO 2015b, 2016b). In addition, no renewal fee is ever required under the Lisbon Agreement.[21] This is administratively different from the situation with several other IP rights, and also arguably incompatible with the current practice of common law jurisdictions that protect GIs as trademarks. Trademarks can be considered abandoned and canceled for non-use, and a registration renewal or maintenance fee is typically payable.[22] Under the Geneva Act, part of the gap between Lisbon and those other systems was filled, but not all. Country designation was introduced and per-country fees are now possible for the initial registration and for use of the indication, but not maintenance fees. This is likely to continue to be an issue going forward.

[18]*Compare* rules 9-10 of Geneva Act to the Lisbon Agreement rules 9–10 with Article 5 of 1958 Lisbon Agreement.

[19]*See* Article 15–16, rules 9–11 of the Geneva Act.

[20]*See* Articles 5 and 7 of the Lisbon Agreement.

[21]The Lisbon Agreement specifically provides for the absence of renewal fees under Article 7.

[22]In the United States, since 1989, the renewal term has been 10 years. McCarthy, § 19:142, 19-422. Also, under US law, cancelation is possible after three years of nonuse. *See* 15 USC § 1127 (2012).

2.6 Genericness Issues

The 1958 Lisbon Agreement was flexible in several respects but not on genericide. Genericide is the loss of an appellation when it becomes generic, and is thus unable to function as an indication of geographic origin in a given market (Kemp et al. 2006, 266; Gervais 2010b, 96–97). The 1958 Agreement prevents invalidation for genericness in the country where protection is claimed, *unless the appellation has become generic in its country of origin*.[23] This is a rare mandatory application of *lex originis* in international intellectual property (Dinwoodie 2009, 731). A country under the Lisbon system has one year to determine whether it will refuse to protect any previously registered appellations *at the time of joining*.[24] For appellations registered *after* a country has joined, there is a 12-month period to make a similar decision. After that period has lapsed, it becomes much more complicated to refuse protection. Invalidation (e.g., by a court) is possible. An issue might surface if a common law jurisdictions were to join Lisbon, if the owner of a Lisbon GI does nothing while the GI was used with his knowledge but without his consent by a third party. This might trigger a finding of abandonment, laches, or lead to a finding of genericness of the GI is used descriptively.

It is a well-established principle of international intellectual property that the law of the country of protection (*lex loci protectionis*) typically governs. Thus, a Court or other competent authority determines the validity of a copyright, trademark, or patent in its own jurisdiction. The Paris Convention makes it clear that this does not directly affect the same trademark or a patent on the same invention in other jurisdictions—a principle known as the independence of patents and trademarks.[25] In the case of infringement, the law of the country where protection is claimed (*lex loci delicti*) typically applies.[26] It would be strange indeed if a Court could not find a patent or mark invalid unless it had been found invalid in the paten holder or trademark owner's *country of origin.* Yet that is the system under the 1958 Lisbon Agreement. Implementing this provision functionally requires a sui generis system because countries that protect GIs using trademarks assess genericness *in their territory* not in the mark's country of origin. Unfortunately, the Geneva Act, while it uses language that differs from the 1958 text, essentially maintains a version of the *lex originis* regime, especially in its Article 12: 'Subject to the provisions of this Act, registered appellations of origin and registered geographical indications cannot be considered to have become generic in a Contracting Party'.[27]The Geneva Act, like the 1958 Lisbon Agreement, allows a Lisbon member to reject a GI at the time

[23] *See* Article 6 of the Lisbon Agreement.

[24] *See* Lisbon Agreement art 14.

[25] *See* Paris Convention for the Protection of Industrial Property 1979, arts 4*bis*, 6.

[26] *Ibid*, arts. 6*quinquies*(B), 10*ter*(2); Berne Convention for the Protection of Literary and Artistic Works 1979, art. 6*bis*.

[27] Further language maintaining *lex originis* is also in art 8(1).

(within 12 months) of registration if it is generic in their territory.[28] It will also allow its members to maintain coexistence of a GI and a trademark and to protect prior trademark rights. However, if the GI gets protection under the Lisbon system and later becomes generic in a Lisbon member, for example because of inaction or even acquiescing by the holder of the GI, then it is not clear under either the 1958 Agreement or the Geneva Act how that Lisbon member could find this GI generic if the GI is not generic in its country of origin without violating Article 12.[29] Perhaps a remedy could be refused to the trademark owner in such a case. Very unfortunately, an Agreed Statement to that effect which had been initially accepted by the Chair of the group drafting the substantive part of the Geneva Act was then rejected after 'consultations' the details of which are not known (Gervais 2015, 356).

2.7 Conflicts with Prior Trademarks and Generic Terms

The 1958 Lisbon Agreement allows its Members to adopt or continue to use one of three approaches in managing conflicts between trademarks and GIs (however those are protected under national law): (1) a 'first in time, first in right' approach; (2) a 'coexistence approach' (that is, a GI and trademark with similar legal effect); or (3) a 'GI superiority approach', under which the GI wins the conflict, except perhaps where the previous trademark is considered well-known (Montén 2006, 328–30).[30]

'First in time, first in right' (FITFIR) usually is understood to mean first *in the territory of the jurisdiction concerned* (Mostert 2004, 2–34; Gangjee 2007, 1262; Rhee 2012, 48).[31] One could see a degree of irony in the case of GIs because GIs very often have been in use for decades or more before the registration of a trademark that would defeat the use of such GIs in a country other than the country of origin (Patent and Trademark Office n.d.). Yet, as a matter of trademark law, the analysis focuses on each domestic market and is largely a question of the domestic consumer's perception—although this perception may include knowledge gained through advertising of a famous mark not in use or not yet widely used in the

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[28]*See* Lisbon Agreement art 5(3), (4); Geneva Act art 15(1).

[29]*See* Lisbon Agreement art 6; Geneva Act art 12.

[30]For example, while the EU has a GI superiority approach in most cases, its regulations provide protection for prior, well-known marks. Council Regulation No 510/2006 of 20 March 2006 on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs [2006] OJ L93, art 3(4): (providing that a 'designation of origin or geographical indication shall not be registered where, in the light of a trademark's reputation and renown and the length of time it has been used, registration is liable to mislead the consumer as to the true identity of the product.'). In sum, EU law provides that prior well-known trademarks prevail over GIs and allows coexistence of prior trademarks not considered to be well-known. ibid.

[31]A number of trade agreements have enshrined this principle. Eg, United States-Australia Free Trade Agreement, Austl-US, art 17.2(4), of May 18, 2004.

territory concerned.[32] The Geneva Act allows, but does not mandate, a member State to apply the 'first in time, first in right' principle in resolving GI–trademark disputes.[33]

What is the situation under the TRIPS Agreement? First, a WTO Member must refuse or invalidate the registration of a trademark that contains or consists of a geographical indication if: (a) the goods do not originate in the territory indicated; and (b) use of the indication in the trademark for such goods in the territory of the 'Member' concerned is *of such a nature as to mislead* the public as to the true place of origin.[34] For GIs used in connection with wines and spirits, however, deception (misleading the public as to the true place of origin) does not need to be present.[35] Second, TRIPS Article 24.5 then allows a WTO Member to protect those who were using or applied for registration of a trademark (or were 'grandfathered') in the WTO Member concerned either before the TRIPS Agreement became applicable in the Member concerned, or before the indication in question was protected in its country of origin.[36] It is also worth noting that TRIPS Article 24.6 provides that WTO Members may decide not to protect a geographical indication used in connection with foreign goods or services. This choice to withhold protection is available when the relevant indication 'is identical with the term customary in common language as the common name for such goods or services in the territory of that Member'.[37]

In *EC–Trademarks and Geographical Indications I*, a WTO dispute-settlement panel explained that the coexistence of a protected indication and a trademark can be considered, under certain circumstances a limited exception justifiable under TRIPS Article 17.[38] In other words, the coexistence of a protected indication and a

[32]This situation is reflected in TRIPS Article 16, which provides that, in determining whether a trademark is well-known for the purposes of applying Article 6*bis* of the Paris Convention (which only applies to identical or similar goods but which TRIPS extends to both dissimilar goods and to services), WTO 'Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark'. *See* TRIPS Agreement art 16; Paris Convention (n 25) art 6*bis*.

[33]*See* Geneva Act art 13(1).

[34]*See* TRIPS Agreement art 22.3.

[35]Ibid, art 23.2.

[36]Ibid art 24.5; see also WIPO Document SC/5/3 of 8 June 2000 on the Possible Solutions for Conflicts Between Trademarks and Geographical Indications and for Conflicts Between Homonymous Geographical Indications, 11–12.

[37]See TRIPS Agreement art 24.6.

[38]WTO Report of the Panel WT/DS174/R of 15 March 2005 on European Communities—Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs: Complaint by the United States, 7.688 (Complaint by the US); WTO Report of the Panel WT/DS290/R of 15 March 2005 on European Communities—Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs: Complaint by Australia, 7.644–7.686 (Complaint by Australia).

non-famous trademark is a permitted exception to *trademark rights*.[39] In sum, TRIPS allows—but does not mandate—continued application of 'first in time, first in right' by each WTO Member.[40]

The Geneva Act is clearer on this point than the 1958 Lisbon Agreement in that it provides specific conflict rules, which mostly allow for prior trademark rights to be protected and, like the 1958 text, allows GIs to be rejected for genericness in a member *at the time that member joins the system*. The genericide prohibition in the Geneva Act would make it difficult, however, to reconcile with 'first in time, first in right' in the case of a GI that was used but later becomes generic as a geographic term in a country, or a similar term was used by a third party as a trademark. A country or intergovernmental organization (such as the European Union) joining the Geneva Act may thus limit its option to use to its full extent the TRIPS exception regime as interpreted in the WTO dispute-settlement process.[41]

2.8 The Future of the Geneva Act

2.8.1 Geographical Indications and a Free Market Economy

Attaching an intangible, yet measurable (that is, a higher price due to the IP rent) value to the identification of the geographic origin of a product seems to postulate the existence of a correlative, measurable difference in *actual quality*; that is, an objectively quantifiable difference between products of different origin but similar composition—say, a wine produced from Pinot Noir grapes in Napa Valley, New Zealand or in Bourgogne (Burgundy) (Bird 2005, 1–16). One could posit that this measurable difference—assuming that one *can* measure it—lies in natural factors such as soil and climate. Which brings us close to the *terroir*. Indeed, a system of protection for denominations of geographic origin emphasizes the cluster of factors traditionally amalgamated under the term *terroir:* tradition, know-how and a link between product and land (Calboli 2015, 434). *Terroir* can be used as a marketing

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[39]And thus allowed under Article 17 of TRIPS, stating '[m]embers may provide limited exceptions to the rights conferred by a trademark…'. The report of the dispute-settlement panel mentioned in the previous note concluded, 'with respect to the coexistence of GIs with prior trademarks, the Regulation is inconsistent with Article 16.1 of the TRIPS Agreement but, on the basis of the evidence presented to the Panel, this is justified by Article 17 of the TRIPS Agreement.' Complaint by Australia 7.686; Complaint by the US 7.688. In countries that use certification marks and/or the torts of 'unfair competition' and 'passing off' in this context, such a conflict would be between two trademarks, not between a trademark and 'something else', such as a GI.

[40]Essentially, under TRIPS Article 24.5, a prior trademark continues to be registrable and its owner may continue to use the mark. This must be interpreted together with Article 16.1.

[41]State practice subsequent to the adoption of a treaty is one of the relevant factors in that treaty's interpretation. Vienna Convention on the Law of Treaties (1969) 1155 UNTS 331, reprinted in 8 ILM 679, *see* art 31(3)(b) (entered into force 27 January 1980).

tool to extract additional rents. A consumer who does not share the history and culture of the French, Italian, or Spanish *terroir* may not easily identify with the conventions and practices that were used to define the quality of a product (say, a red wine) at its point of origin. That same consumer *can* nonetheless attribute a higher value or quality to a product for a different set of reasons. Even if the higher price resulting from the linkage between a product and its origin is arguably or even demonstrably irrational—say, because no measurable objective quality differentiates the product and its non-GI equivalent—that is not a fatal argument against GI protection: trademarks also sometimes perform an 'irrational' yet well-accepted function in guiding consumer behavior.[42] Put differently, and more concretely, using a consumer's belief that *brie* cheese will be not just different but *better* because it was produced in Meaux[43] (France), as opposed to in an unknown location in some industrial plant or even in a known cheese producing location (such as the US state of Wisconsin), is not incompatible with the principles of a 'free' market economy.[44]

2.9 Can GIs Be Protected Only as Marks?

Geographical indications, like trademarks, depend on reputation and associated goodwill.[45] To paraphrase Professor Gangjee (2007, 1262), they share the same epistemological backcloth. Reputation is an element mentioned in both the Lisbon Agreement and the TRIPS Agreement.[46] 'Normal' trademarks, collective marks and certification marks can be used as symbols of or ways to suggest geographic origin.

A common feature of common law based trademark law is the so-called 'first-in-time, first-in-right' approach according to which the first user in a given territory will have senior rights. Using the US system as an example, a geographic designation of origin must not clash with a pre-existing trademark if it is to be protected under a trademark system.[47] Similarly, a geographic term that is generic

[42]McCarthy (1999), McCarthy on Trademarks and Unfair Competition. 2nd edn. New York: West Group, §2:38.

[43]'Meaux' is the name of a town near Paris, France. 'Brie de Meaux' is a protected indication, but 'Brie' is not. BRIE DE MEAUX, No 686 www.wipo.int/ipdl/en/lisbon/key.jsp?KEY=686 (as consulted 13 January 2016). Wisconsin also produces 'brie' cheese. Wisconsin Milk Marketing Board, 'Brie' (2016) www.eatwisconsincheese.com/wisconsin-cheese/article?cid=9 (as consulted 12 January 2016).

[44]Unless the perception is based on deceptive marketing practices, but that is typically handled under a different area of law.

[45]*Supra*, note 43, McCarthy § 2:38, 2–76.

[46]*See* Lisbon Agreement art 2(2); TRIPS Agreement art 22.1.

[47]*Supra*, note 43, McCarthy § 16:1.

in the United States cannot acquire trademark status.[48] A term that is merely descriptive can be protected as a mark once it acquires secondary meaning.[49] In the case of a geographic *certification mark*, there is a *collective goodwill* linked to a region or locality. This notion of collective goodwill emerged in UK in the so-called 'Drinks' cases.[50] Collective goodwill is goodwill shared by a group of producer. Any producer part of the group may file a claim in civil courts to protect the goodwill—without having to show control over or agreement of the collective.

United States courts have recognized that goodwill could be shared but they have generally taken a less liberal approach on the right of action by individual users. They have given the holder of a certification mark more control over its use and enforcement. For example, in *State of Idaho Potato Comm'n v. G & T Terminal Packaging, Inc.*, the Ninth Circuit found that selling genuine Idaho potatoes using the name IDAHO constituted counterfeiting of the certification mark IDAHO for potatoes because the mark owner had not had the opportunity to exercise quality control.[51] The owner of the mark 'acts as the representative of the mark users'.[52] Hence, as a matter of trademark law, the owner of a certification mark—not the State—controls the certification standards. Examples of US geographic certification marks include: FAMOUS IDAHO POTATOES, FAMOUS POTATOES GROWN IN IDAHO, GROWN IN IDAHO IDAHO POTATOES, and PREMIUM PACKED IDAHO POTATOES for (unsurprisingly) Idaho potatoes; PARMIGIANO-REGGIANO, ROQUEFORT, STILTON, and REAL CALIFORNIA for cheese; PARMA for ham; DARJEELING for tea; WASHINGTON for apples; and THE FLORIDA SUNSHINE TREE for citrus.[53] Certification marks have also been used in a more typical 'Lisbon' context: booze. The three US 'Cognac' cases serve

[48]Ibid § 14:18.

[49]Ibid § 11:25.

[50]*Bollinger v Costa Brava Wine Co. Ltd*, [1961] RPC 116 (Ch); *Vine Prods Ltd v Mackenzie & Co Ltd*, [1969] RPC 1 (Ch), 4 (citing *Bollinger v. Costa Brava Wine Co Ltd*, [1960] RPC 16. These cases have a progeny in the UK. *John Walker & Sons Ltd v Henry Ost & Co Ltd*, [1970] RPC 151 (Ch); *HP Bulmer Ltd v Bollinger SA*, [1978] RPC 79 (CA); *Erven Warnink Besloten Vennootschap v J Townend & Sons (Hull) Ltd*, [1979] AC 731 (HL). The same happened in other common law jurisdictions such as Canada and New Zealand. *Institut National des Appellations d'Origine des Vins et Eaux-de-Vie* v *Andre Wines Ltd*, (1990) 30 CPR (3d) 279; *Dairy Bureau of Canada* v *Annable Foods Ltd*, (1993) 46 CPR (3d) 289 at 309; *See* also *Comite Interprofessionel du Vin de Champagne v Wineworths Group, Ltd* [1991] 2 NZLR 432.

[51]State of Idaho Potato Comm'n v G & T Terminal Packaging, Inc, 425 F3d 708, 721–22 (9th Cir 2005).

[52]*Supra*, note 43, McCarthy § 19:92.50.

[53]FAMOUS IDAHO POTATOES FAMOUS POTATOES GROWN IN IDAHO, Registration No 2,403,069; PARMIGIANO-REGGIANO, Registration No 1,896,683; ROQUEFORT, Registration No 571,798; STILTON, Registration No 1,959,589; REAL CALIFORNIA CHEESE, Registration No 1,285,675; PARMA HAM, Registration No 2,014,628; DARJEELING, Registration No 1,632,726; WASHINGTON, Registration No 1,528,514; THE FLORIDA SUNSHINE TREE, Registration No 932,033. The vast majority of certification marks in the United States are not for geographic origin. This majority includes marks registered by unions and various standardization bodies, such as Underwriters' Laboratories (Belson 2002, 26–28).

as milestones on the road to GI protection via trademark law. The first case dates back to 1944.[54] The case involved applications for the trademarks COLOGNAC and CALOGNAC for brandy. Oppositions to those applications were filed by a 'genuine' (French) Cognac maker.[55] The oppositions were not made on the basis of pre-existing registrations for other marks (such as COGNAC). Instead they were made under the terms of the statute in force at the time, which allowed certain parties (this would emerge in the case, as we shall see) to oppose the use of descriptors as marks if those descriptors would confuse or mislead the consumer. Reversing both the Examiner of Trade-Mark Interferences—who had not recognized the opposer's right to battle the applications—and the Commissioner of Trademarks, the Court of Customs and Patent Appeals confirmed the opposer's standing and agreed with the opposer.[56] The Court stated the following in a passage that has the unmistakable aroma of an 'Old World' GI perspective:

> Cognac is a name applied to a type of brandy distilled from wines made from grapes grown in a limited territorial region of France, often referred to as the Cognac district, the boundaries of which are defined by French law … there is a certain quality in the soil of the region which gives to the grapes there grown a particular character or flavor, which enters into the brandy made from them, and that that quality of soil is not found elsewhere in France, nor, it is claimed, in any other part of the world. It is recognized as a superior brandy.[57]

The second case, four decades later, dealt with applications for two similar derivatives of Cognac, namely COLOGNAC and CALOGNAC.[58] The case evidently bears strong resemblance to the previous one, but here the opposer was not an individual producer of Cognac, but rather an entity responsible under French law for defending the word Cognac.[59] Between the two cases, Congress had adopted the 1946 Trademark (Lanham) Act, which contained a specific provision for certification marks.[60] Indeed, one of the Board's first steps in this second case was to note that the statute defined certification marks and included marks used to denote a geographic origin.[61] The 1946 statute also contained the now familiar prohibition of the registration of a mark that, 'when applied to the goods of the applicant,

[54]The date is significant because, although the case is silent on that point, sympathy for France may have been a factor at that particular juncture in US history.

[55]Otard, Inc, v Italian Swiss Colony, 141 F2d 706 (CCPA 1944).

[56]Ibid, 709–11.

[57]Ibid, 708.

[58]Bureau Nat'l Interprofessionnel du Cognac v Int'l Better Drinks Corp, 6 USPQ2d 1610, 1615 (TTAB 1988).The application was filed in 1984, Ibid, 1610.

[59]Ibid, 1610–11.

[60]15 USC §§ 1052(d)–(e), 1054 (2012) (Trademark Act).

[61]Bureau Nat'l, *supra* note 59, 1614. The terminology was new, but not the notion of a collectively owned mark. Section 62 of the Trade-Marks Act of 1905 referred to standardization marks. Trade Marks Act 1905 (9 Edw 7 c 15), § 62. The statute was amended in 1936 and again in 1938 to provide for registration of collective marks owned by foreign associations.

is primarily geographically descriptive or deceptively misdescriptive of them'.[62] The Board's approach was consonant with trademark law principles, putting the focus squarely on consumer deception:

> [I]f a mark is the name of a place known generally to the public, purchasers who encounter goods bearing the mark would think that the goods originate in that place [i.e., purchasers would make a 'goods-place association' …], [if] the goods do not come from the named place, and the deception is material to the purchasing decision, the mark is deceptive under Sect. 2(a); if the deception is not material to the purchasing decision, the mark is primarily geographically deceptively misdescriptive under Sect. 2(e)(2) of the Act.[63]

In the third and final case, decided a decade later, the opposer, the French *Institut National des Appellations d'Origine*, was also a 'GI defending entity' responsible for defending several protected wine and spirit appellations of origin in France.[64] The Board applied Sect. 2(d) of the Lanham Act, which deals with likelihood of confusion with a preexisting mark, and decided that the test was the same as for other marks:

> There is nothing in the language of Sect. 2(d) which mandates or warrants application of one level of likelihood of confusion analysis … in cases where the plaintiff's mark is a trademark or service mark, but a different and more limited likelihood of confusion analysis in cases where the plaintiff's mark is a certification mark.[65]

In other words, a showing of deception was unnecessary. Certification marks should be treated for purposes of an infringement analysis in the same way as ordinary trademarks. While the opinion parallels the previous case, it is worth noting that the Board also recognized protection of the COGNAC mark under *labeling regulations*.[66]

Overall, the picture that emerges from the Cognac cases shows a willingness to recognize collective goodwill in the form of (common law) certification marks.[67] The application of trademark law by US courts and other authorities suggests that common law can protect symbols of geographic origin used in trade beyond the sui generis mechanism used for alcohol labels. Unfortunately for the future of the Lisbon system, using trademark law to protect GIs implies the ability to remove a

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[62] Trademark Act, *supra* note 64, § 1052(e)(2).

[63] Bureau Nat'l, *supra* note 64, 1615.

[64] Institut Nat'l des Appellations d'Origine v Brown-Forman Corp, 47 USPQ2d 1875, 1877 (TTAB 1998). Apparently, the applicant's concoction actually contained some French brandy. Ibid, 1880.

[65] Ibid, 1890.

[66] Ibid, 1878, 1885–96. The regulation is 27 CFR § 5.22(d)(2) (2014), (recognizing French governmental authority to designate and regulate Cognac grape brandy distilled in the Cognac region of France).

[67] This actually started with Pillsbury-Washburn Flour Mills Co v Eagle, 86 F 608 (7th Cir 1898). For a fuller discussion of this topic (from which this part of the Article is derived), see Gervais, Daniel. 2014. Cognac after Spanish Champagne ? Geographical Indications as Certification Marks, *see* n.1 above.

mark not used by its owner. More generally, trademark law implies (1) a requirement of use to register, (2) the payment of renewal or maintenance fees, and (3) a level of protection tied to the existence of a likelihood of confusion except for famous or well-known marks.[68] None of these are allowed, at least explicitly, under the Geneva Act even though they were raised on several occasions by delegations at the Diplomatic Conference. Fortunately, the Geneva Act does allow member countries to impose examination and use fees, however. Yet a number of potential areas of incompatibility between GIs—or a certain conception of GIs at least—and trademarks remains. It seems that it is that particular conception that informed many of the members that negotiated the Geneva Act and, as a result, it may not be easy to get countries that look at GIs differently to join.

2.10 Will the Geneva Act Succeed?

As of the date of the Diplomatic Conference that adopted the Geneva Act of the Lisbon Agreement in May 2015, the Special Union (of Lisbon members) had 28 member states (WIPO 2013).[69] Many of those members will likely join the Geneva Act, which is also open to intergovernmental organizations such as the European Union and *Organisation Africaine de la Propriété Intellectuelle* (OAPI).[70] Even if several OAPI members join Lisbon, how much they will use it (that is, how many GIs they will actually register) is unclear. Indeed some OAPI members are already members of the 'old' Agreement and have not used it much.[71] North African countries such as Morocco and Tunisia, together with Algeria, which is already party to the 'old' (1958/1967) Act, may also join the Geneva Act membership. A few Latin American countries might do so as well, adding to the existing five members of the old Agreement (Costa Rica, Cuba, Mexico, Nicaragua and Peru).[72] More importantly, European membership will likely broaden to include most or all EU members (including Germany, who is not currently a Lisbon member) and probably Moldova and Russia, among others. This means a potential of approximately 55 member States. If the EU were to join backed by all its member states,

[68]On the protection of well-known marks, TRIPS Agreement Article 16.2 requires WTO Members to take account 'of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark.'

[69]The term 'Special Union' (that is, the group of parties to the Lisbon Agreement) is used in Article 1 of the Lisbon Agreement, and in Article 21 of the Geneva Act.

[70]Geneva Act, art 22(2). The OAPI has 17 members, most of which are French-speaking sub-Saharan African countries (OAPI 2010, *see*: www.oapi.int/index.php/en/aipo/etats-membres. (as consulted January 12, 2016).

[71]The following countries are members of both agreements: Burkina Faso, Congo, Gabon, and Togo.

[72]Haiti is also a member (WIPO 2013), *Supra* note 72.

it would potentially have a majority vote in the Special Union (which it could exercise as a single vote on behalf of all 28 EU members-subject to Brexit of course).[73] Yet that would leave a sore spot: the complete absence of common law jurisdictions.

The denouement of the Geneva Act story may be more complicated, however. True, despite the strength of the opposition manifested at the closing plenary by a number of common law jurisdictions, the art of trade negotiations is such that anything is possible. Smaller common law jurisdictions might find it harder to resist EU trade pressure to join Lisbon. The Trans-Pacific Partnership (TPP)[74] is interesting.in this context. Clearly, it will affect the trademark laws of the various countries[75] and is currently the subject of widespread commentary and controversy (Dreyfuss et al. 2015, 569–71). Relevant here is the TPP's requirement that contracting parties ratify or accede to either the Madrid Protocol on international trademark registration or the Singapore Treaty on the Law of Trademarks.[76] If member states follow the treaty's obligations, the TPP would represent a breakthrough in the Latin American and Southeast Asian countries that had previously been difficult areas for the trademark registration systems to crack (Lince 2015). As more countries reflect the strong trademark system of the U.S., the ratcheting up of trademark protection in more countries gradually makes a universally attractive multilateral GI registration system all the more difficult to conceive.

More importantly, some see the TPP as containing normative countermeasures to Lisbon, such as definitions of prior rights or genericness standards. The TPP text is not easy to reconcile with Article 12 of the Geneva Act (providing for genericide only in the country of origin of the GI): it provides that a GI may become generic *in each country* that protects it, leading to its potential invalidation in such country.[77] Though not expressly permitted by Lisbon, it seems that court invalidation is, however, possible under Lisbon so that this may not be as formidable an obstacle at may seem at first glance. More generally, a renewed emphasis on the role of certification marks to protect GIs has surfaced in various fora. Is the TPP an anti-Lisbon tool? That is far from obvious. Some of the nations that negotiated the Trans-Pacific Partnership (TPP) recently introduced sui generis GI legislation that may make it easier for them to agree to join Lisbon, for example, as part of a trade

[73]Lisbon Agreement, art 22(b)(4)(ii) allows any Contracting Party that is an intergovernmental organization to vote in place of its members.

[74]The TPP is an extensive trade agreement between the U.S., Canada, Japan, Australia, Malaysia, Mexico, Peru, Vietnam, Chile, Brunei, Singapore, and New Zealand concerning a wide range of IP and trade issues. *See* Trans-Pacific Partnership, Oct. 5, 2015.

[75]TPP art. 18.

[76]TPP, art. 18.7(2).

[77]TPP, art 1832.3(3) states, '[n]o Party shall preclude the possibility that the protection or recognition of a geographical indication may be cancelled, or otherwise cease, on the basis that the protected or recognized term has ceased meeting the conditions upon which the protection or recognition was originally granted in that Party.'

deal with the EU.[78] The list of bilateral EU trade agreements with a GI focus might soon include India. In 2014, Canada and the EU signed a trade agreement (reportedly in trouble as of this writing due to resistance to its investor-state dispute provisions) that contains a detailed set of provisions on GIs.[79] CETA provides that, subject to exceptions, interested parties can prevent the use of certain GIs for products that fall within a class linked to that GI.[80] This protection is provided even when the true geographic origin of is indicated, the GI is used in translation, and even when the GI is accompanied 'by expressions such as "kind", "type", "style", "imitation" or the like.' In effect, the EU negotiated an extension of TRIPS Article 23 protection for wines and spirits.[81] Furthermore, registration of a trademark that contains or consists of a GI listed in CETA 'shall be refused or invalidated.' Although not without flaws, CETA delivers an adequate and improved level of protection for GIs exported from the EU.

The EU achieved protection for names that could be considered generic in Canada and therefore not capable of protection under trademark law. Naturally, however, the EU made concessions to reach a compromise. CETA provides that Canada is not obligated to prevent the use of certain GIs: Asiago, Feta, Fontina, Gorgonzola and Munster when they are accompanied by the terms '"kind", "type", "style", "imitation" or the like' in combination with a visible indication of the true origin.[82] Moreover, CETA Article 7.6.5 is a coexistence clause, stating that where trademarks have been applied for or registered in good faith prior to the date of the signing of the Agreement, those trademarks are valid and owners shall have the right to use them even if they are identical to a GI in Annex I. While this type of agreement, including those enumerated cheeses, amount to TRIPS protection extended beyond wine and spirits, the protection of previously registered trademarks-, could represent a rough blueprint for compromising those difficult GIs regarded as specific in the EU but generic in other countries. Though the agreement has many flaws, the end product delivers a system of protection that leaves both parties better off than they were before. Whether Canada and other common law jurisdictions that may sign similar deals will consider that it is compatible with Lisbon has not been publicly discussed.

The matter is more complex still. With or without the common law world in Lisbon, companies based in non-Lisbon members—including all those common law countries—using terms they consider generic or descriptive on their products will find Lisbon members in the path of their trade transactions with other nations.

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[78] Geographical Indications of Goods (Registration and Protection) Act, 1999, Act of Parliament No 48 (India); Geographical Indications Act, 2000, Act 602 (Malaysia); Geographical Indicators Regulation, 2007, Government Regulation No 51 (Indonesia).

[79] See Comprehensive Trade and Economic Agreement, Can.-EU, Consolidated CETA Text, ch. 22, Intellectual Property, Sept. 26, 2014, available at http://trade.ec.europa.eu/doclib/docs/2014/september/tradoc_152806.pdf. (as consulted March 21st 2016).

[80] Ibid, 7.4.

[81] Ibid.

[82] Ibid art. 7.6.

Members of the Association of Southeast Asian Nations (ASEAN), where the cost of protecting foreign GIs (and implementation of the Geneva Act) could be low, may be substantial beneficiaries in trade dealings with the EU and be tempted to join Lisbon, though it may come at a cost in their relations with the United States and others.[83]

The Geneva Act may thus be considered not just as opposing common law and civil law but also plurilateral and multilateral approaches to the international protection of intellectual property. Countries have shifted their preferred forum for intellectual property negotiations from open-door multilateral negotiations to, initially, closed-door bilateral negotiations and, eventually, closed-door plurilateral negotiations—often referred to as 'country clubs' (Gervais 2012b)—seen in the TPP and Transatlantic Trade and Investment Partnership (TTIP) in addition to the Transpacific Partnership Agreement (TPP). The risk from this shift in forums is the emergence of a tapestry of different and possibly incompatible norms (Sell 2011). So far, bilateral trade negotiations have been rather successful, showing progress is possible by finding specific compromises on international protections of domestic GIs without overly infringing on trademark owners' expected rights (Yu 2004). Since 1994, the EU has concluded a series of agreements on the mutual protection of specifically handpicked GIs for wines and spirits, including those with the Australia, Mexico, South Africa, Canada, and even the USA (O'Connor et al. 2012, 39). More recently, a variety of EU bilateral agreements have protected a broader range of goods.[84] Yet they too add to this risk of incompatible norms.

Agreements like CETA show that some degree of compromise is possible. Meanwhile, the languishing multilateral picture especially at the WTO make broad progress in trade law unlikely. This is either good for the Geneva Act (as an alternative to the WTO) or bad because it shows reluctance to engage at the multilateral level on matters already covered in regional or plurilateral agreements. Our best guess is that the former argument is not going to be very convincing because the countries that were slow to engage at the WTO are precisely those that now feel left out of the Geneva Act. Compounded with an understanding of the differences between sui generis GI and trademark systems, this sets the stage for grasping why the rules of procedure for the Diplomatic Conference for the Geneva Act excluded non-Lisbon members from full participation. At the end of the day, it may all come down to money. As alluded to earlier, it appears that the progress on Lisbon fees and financing at the 2015 General Assembly is unlikely to be adequate: the recent doubling of fees will not be enough to balance Lisbon's budget, leading to further deficits

[83]According to an April 2015 press release announcing the restart of EU-ASEAN trade talks, '[t]he EU is ASEAN's second-largest trading partner with total trade amounting to $248 billion in 2014 and was Southeast Asia's largest source of foreign direct investment in 2014 with $29.1 billion, or 21.3% of foreign inflows to the region.' EurActiv.com. 2015. EU and ASEAN to Jumpstart Trade Agreement Talks. www.euractiv.com/sections/trade-society/eu-and-asean-kick-start-free-trade-agreement-talks-314100 (as consulted12 Jan 2016).

[84]The EU Korea Free Trade Agreement, EU Colombia Peru Agreement, and the EU Central America Agreement and the EU Singapore Agreement to name a few.

(WIPO Secretariat 2015b). Moreover, the Lisbon Union's loan agreement, due in large part to pressure from the U.S., will likely be a source of disputes if or when the Union lacks the funds to repay it. All of this possibly could necessitate the addition of renewal or other fees that the Contracting Parties at the Diplomatic Conference for the Geneva Act refused to adopt. Though this would require a deeper analysis, the text of the Geneva Act does not seem to allow this change by a simple change to Regulations. Thus the loan compromise may well represent a clever move by the U.S. to isolate the Lisbon system by making registration less attractive.

2.11 The Future of Consensus Building at WIPO

2.11.1 Implications for WIPO's Role in Norm-Setting

It remains to be seen whether the procedure leading to the adoption of the Geneva Act will serve as a precedent against multilateralism and full participation in the future revision of other WIPO treaties. The procedure provides an example that may be used to justify the exclusion of non-contracting states in future diplomatic conferences.[85] This calls into question the very role of WIPO as a forum for reaching consensus on IP-related laws in the ear of bilateral and plurilateral free trade agreements that affect IP standards (Sell 2011). If WIPO desires to keep playing a central role in the evolution of IP norm-setting through treaty development, then the organization needs to make changes.

2.12 Legal Solutions

Although we cannot go back in time and change the substance or procedure of the Geneva Act, WIPO can effect changes for future diplomatic conferences. Indeed, WIPO's system of governance, especially their rules and procedures, directly affects the ways in which substantive work is conducted and produced (Birkbeck 2014a). The unorthodox and divisive procedure behind the Geneva Act adoption could be seen as the final straw to convince the member states and the WIPO hierarchy that

[85]US Ambassador Pamela Hamamoto, in a statement discussing the closed diplomatic conference, stated, '[T]his is about more than the legitimacy of the Lisbon Agreement itself. This issue has alarming implications for the future of WIPO as an organisation.' U.S. National Statement, *All WIPO Members Should Be Able to Participate Equally in Lisbon Agreement Diplomatic Conference*, available at https://geneva.usmission.gov/2015/05/11/all-wipo-members-should-be-able-to-participate-equally-in-lisbon-agreement-diplomatic-conference/ (as consulted March 21st 2016).

now is the time to review and revise the Rules of Procedure,[86] which were last amended in 1979 (Birkbeck 2014b).

These revisions could form part of other efforts. In August 2014a, UN Joint Inspection Unit (JIU) reported numerous underlying governance issues[87] facing WIPO and recommended that the WIPO General Assembly should 'review the WIPO governance framework as well as current practices with a view to strengthen the capacity of the governing bodies to guide and monitor the work of the organisation. The report also noted that an increasing number of Member States had lately begun to repeatedly voice their dissatisfaction with regard to the current state of governance at WIPO.

This perceived increasing ineffectiveness of WIPO coincides with an era in which the opportunity for multilateralism is overtaken by the rise in bilateralism and plurilateralism (Okediji 2004). The Authors believe that multilateralism still represents the best chance for Pareto-optimal solutions between developed and developing countries, incorporating a variety of interests to impact a range of substantive economic and public policy issues including harmonization of systems, public health, education, the environment, and the protection of rights holders' interests. In the long term, plurilateral deals may fragment the international IP system. In other words, there is an urgent need for resurgence in multilateralism today but given what is at least a perception possibly reinforced by the Geneva Act kerfuffle, in order for that to occur WIPO's rules of governance and its rules and procedures must be updated.

Rule 56 of the General Rules of Procedure provides for amendments to WIPO's rules and procedures. As it currently stands, there is no provision mandating that a diplomatic conference for the adoption of a new treaty be open to the full participation of all WIPO member states.[88] Such a rule of procedure would prevent the Diplomatic Conference for the Geneva Act to the Lisbon Agreement from establishing a precedent that could be used by other systems and unions to further divide

[86]WIPO (1998) WIPO General Rules of Procedure, WIPO Doc. 339 (FE) Rev. 3., available at http://www.wipo.int/edocs/pubdocs/en/general/399/wipo_pub_399.pdf (as consulted March 21st 2016).

[87]The governance issues include, among others: a disproportionate weight that informal and undocumented meetings have on the outcome on various subjects of interest; the sheer number and variety of different WIPO bodies negatively effects the clarity of governance arrangements and, hence, their effectiveness; the lack of a comprehensive reference document detailing good practices and the roles and functions of different bodies.

[88]One could curtail worries about such a rule of procedure stifling a possibly legitimate diplomatic conference needing to be closed to certain member states by providing for the particular rule to be overridden in the case of a majority vote of WIPO member states granting permission for the diplomatic conference in question to proceed without full participation of all WIPO members. This compromise may admittedly be imperfect or undesired, but it represents one example of how WIPO could prevent future conflicting factions without sacrificing the arguably necessary flexibility to advance IP systems and policies.

WIPO and the IP community as a whole.[89] We know of no instrument administered by WIPO that is incompatible with such a rule. Correspondingly, member states could revise the Chapter regarding the conduct of business so as to give the Secretariat or Chairperson more power, including to curtail discussion on non-substantive issues. Ultimately, any revision that works towards increasing substantive member state discussions, transparency in negotiations, or clarity to the process of treaty revision and creation would be a positive step for the future of international IP norm-setting under WIPO's aegis. Taken as a whole, member states have a plethora of options at their disposal to improve both the governance framework and the rules of procedure.

2.13 Political Solutions

At the conclusion of the 2015 General Assembly a deal was reached on the Lisbon system's funding and its Chair, Vladimir Yossifov, took the opportunity to defend the Union's successive deficits. He pointed out that the Hague system on designs also loses money regularly[90] but had not been targeted for criticism by the U.S. 'What is the definition of corruption?' Yossifov questioned before answering, 'Corruption is a deal in which I don't participate' (Saez and New, 2015) Such barbed language cuts to the heart of the dispute within WIPO: the U.S. did not feel the need to instigate debate on the budget of the Lisbon system until after they had been shut out of the Geneva Act. It is also true that many Lisbon members had been increasingly frustrated by ineffective negotiations at the WTO on a registration system for wine and spirits, and did not trust non-Lisbon members to negotiate Lisbon revisions in genuine goodwill.[91]

If this cycle of distrust actually affects the normative outcomes of WIPO meetings and discussions, then all member states must recognize that such a state of affairs is suboptimal. Indeed, the U.N.'s Joint Inspection Unit noted that 'accumulated tension among Member States may adversely impact the effective

[89]There is some evidence that WIPO member states have already recognized this: the 2015 General Assembly took formal note that all diplomatic conferences in the 2016/17 budget funded by WIPO 'will be open to the full participation of the all WIPO Member States', *see* (WIPO International Bureau 2015a).

[90]While it may be easy to point out the U.S.' hypocrisy towards the Hague Union's deficit, distinctions can be found in that the Hague Union is composed of considerably more members (64) with additional members expected to join in the near future and Hague applications expected to increase rapidly (*Report adopted by PBC* 2015, 15).

[91]Neither author wishes to partition blame for the lack of progress in WTO negotiations, but do note that each side is most likely to consider the other side as the disproportionate source of the stalemate.

functioning of the organization'[92] In this regard the 2015 WIPO General Assembly is a prime example. Not only was it divisive but the debate over Lisbon financing dominated the assembly's discussions at the expense of other substantive issues. Namely, the discussion on Lisbon finances overshadowed the important work on reaching an agreement on an international legal instrument relating to the protection of traditional knowledge, the inclusion of technical assistance to developing countries within the proposed design law treaty, and the opening of new WIPO external offices (Saez and New, 2015).

2.14 Conclusion

The adoption of the Geneva Act of the Lisbon Agreement was a clear chance to update Lisbon fully and to reconcile the Lisbon system on two fronts: doctrinally, with the common law; and administratively, by allowing countries that protect GIs under trademark law (often as certification marks) to continue to do so as Lisbon members. That did not happen, at least not clearly. The absence of consensus—indeed, the deep divide—at the Diplomatic Conference, and the stated[93] incompatibility of the Geneva Act with trademark-based GI systems are unlikely to prove productive in the short- to medium-term for GI holders, authorized users of GIs, users of generic denominations, or consumers. The bridge between Lisbon and the common law system has not been built by the Geneva Act. Some useful foundations were laid, but much remains to be done. The bridge, if it is ever built, will not be the result of a normative meeting of the minds. It will be made of trade bricks, such as those that the TTIP is hoping to lay. In the end, both the U.S. and the Lisbon Union were engaged in a prisoner's dilemma in the Lisbon discussions: each party would have been better off working together, but both remained risk averse and chose to work in their self-interest. In so doing, they bucked precedent and a spirit of cooperation in favor of advancing domestic agendas. That is what they must now overcome if TTIP is going to be Lisbon-friendly. Otherwise, if applied on a broader scale, such behavior could prove toxic to ongoing and future negotiations affecting substantive issues at WIPO.

[92]From page 11 of the JIU report: '[t]he accumulated tension among Member States may adversely impact the effective functioning of the organization. A constructive and productive dialogue on the ways and means to conduct governance reform has thus become a priority for both the membership and management.'

[93]Reference is made here again to statements, notably by Australia, Japan, Korea, and the United States, during the closing plenary of the Diplomatic Conference that adopted the Geneva Act (May 20, 2015).

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