The Lisbon Agreement:
Why the United States Should Stop
Fighting the Geneva Act

ABSTRACT

In May 2015, members of the World Intellectual Property Organization (WIPO) held a Diplomatic Conference that resulted in the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications. The Act modified the Lisbon Agreement (originally created in 1958), extending its previous protection of appellations of origin to geographical indications as well. The United States, which remains a non-party to the Lisbon Agreement, has been adamantly against the expansion of the Agreement to geographical indications. This Note explores the issues surrounding the Geneva Act, the state of the law and international agreements leading up to the Act, and the potential benefits to the United States of joining the new Lisbon Agreement.

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I. LET’S TALK CHEESE (OR PRODUCTS LIKE IT)

Imagine for a moment that you are a novice cheesemaker. You have just completed all of your studies, graduated from a prestigious cheesemaking program, and have recently purchased a small plot of land in an area known as “Niceland” and a special breed of livestock to cultivate and create your product. Additionally, you have been experimenting with new so as to make your cheese a standout among the other products on the market. In a perfect scenario, the combination of your plot of land, which contains certain unique minerals and nutrients for your livestock, and your new techniques have made your cheese both exceptional and quite nouveau. Your product becomes known as “nicela,” honoring the area in which it was created. Nicela explodes onto the market, and you go through the typical trademark requirements to ensure adequate protection for your highly acclaimed cheese, which has now become associated with the area in which you are creating it. Unfortunately, your newfound fame has attracted the attention of several other cheesemakers who want to capitalize on your success by claiming to be from Niceland and selling nicela cheese. What sort of protections are available to you and your cheese? Contrary to what you might think, if your product’s country of origin is the United States, your rights may vary greatly compared to someone similarly situated in another part of the world.

This Note explores the potential legal ramifications of the United States ratifying the Lisbon Agreement and its new Geneva Act, which was adopted by several members of the World Intellectual
Property Organization (WIPO) at a Diplomatic Conference in May 2015. While many—mostly European—countries ratified the Lisbon Agreement in the twentieth century, the United States remains a non-party. The Lisbon Agreement protects appellations of origins for products, including wines and spirits, which also benefit from higher protection under the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights Agreement (TRIPS). While most Old World countries label their goods with geographical indications, the United States uses a trademark and certification mark system to protect its products from infringement, consumer confusion, and other IP-related violations. The new Geneva Act adds geographical indications (GIs) to the Lisbon Agreement, giving GIs a higher level of protection internationally than they have previously received.

Section II covers the differences between the Old and New World systems in regards to the protection of products. It introduces geographical indications and appellations of origin and the importance of these marks to the Old World system. Contrasting the two systems, this Section covers the use of trademarks and certification marks, as used in the United States, and discusses the different perspectives of both systems that have led to various international agreements and amendments. The latter part of Section II details the current state of the law by covering several important international treaties that protect intellectual property: the Paris Convention, the TRIPS Agreement, the Madrid Convention, and the Lisbon Agreement.

Section III analyzes the pre-Geneva Act Lisbon Agreement in detail. It further discusses the proposed amendments that led to the Geneva Act, including those proposed initially, and discusses how they alter the original agreement to the benefit or detriment of potential signatories. It then examines why the agreement is being revised and looks at current US apprehensions surrounding the revisions.

Section IV proposes the idea that the United States would benefit from ratifying the Lisbon Agreement with the Geneva Act in


3. Infra Section II.
place. It covers general propositions surrounding geographical indications outside of the Lisbon Agreement, examines the potential compromises both sides would need to make, and looks at future possibilities in the intellectual property landscape.

II. THE OLD WORLD AND THE NEW: DEVELOPMENT OF GEOGRAPHICAL INDICATIONS AND TRADEMARKS

Before trade de-localized production consumption, people ate, drank, and used local goods primarily because that was what was available to them geographically. With the development of more expansive trade, certain local areas and producers became famous for making highly desirable products. Some famous examples of these include Roquefort cheese and Stradivarius violins, products that derive their name from their area of origin. The concern that other producers would attempt to utilize a geographic term to increase sales and, intentionally or unintentionally, fool consumers into believing they are buying the original product, prompted many European countries to enact laws, such as the French appellations d’origine, that limited the use of some geographic terms to specific areas and producers. In order to protect these special products from freeriders, geographical indications quickly developed.

A. Geographical Indications: The Old World Way of Doing Things

In basic terms, geographical indications are signs used on goods with a specific geographical origin, used predominantly in Europe to protect products. More importantly, items with geographical indications have certain qualities or characteristics, or have achieved a reputation, that can be traced back to the geographical origin. Essentially, GIs are a type of label that provide consumers with a reliable method of ensuring that they are purchasing a good from a specified place—a way, for instance, to

5. Id.
6. Id. at 301; see Phillipe Zylberg, Geographical Indications v. Trademarks: The Lisbon Agreement: A Violation of TRIPS?, 11 U. BALT. INT’L. PROP. L.J. 1, 1 (2003) (describing the primary reason for strong GI protections in the European Union as economic due to the high number of wines and cheeses produced there).
7. See Hughes, supra note 4, at 301.
9. Id.; see Zylberg, supra note 6, at 6.
assure purchasers that the tequila they just bought had its origins in Mexico.\textsuperscript{10}

Formally, geographical indications today are “indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”\textsuperscript{11} The historical concerns that helped develop the state of the law around geographical indications can easily be ascertained in this modern definition: the desire to protect goods associated with a certain territory or region \textit{that have achieved a quality or reputation because of their geographical origin}.\textsuperscript{12} The significance of a geographical indication is the link between the place of origin and the characteristics or reputation of the good.\textsuperscript{13} Producers have an obvious interest in protecting geographical indications by preventing imposters from utilizing a mark from their geographic area in order to capitalize on the uniqueness of the product. Though geographical indications are traditionally linked to agricultural products, they may encompass other local factors such as climate, soil, or even manufacturing.\textsuperscript{14} On the consumer side, purchasers can worry less about buying an inauthentic product. There is a large consumer interest component regarding the protection and promotion of geographical indications: a nice glass of Bordeaux or a bottle of Chianti evoke regions of France or Italy, and a consumer who desires authenticity of either wine benefits from a geographical indication.\textsuperscript{15}

Though the differences between geographical indications and trademarks will be detailed later in this Note, there is an important technical difference that should be mentioned at the outset of the discussion: geographical indications are a collective right, meaning multiple producers in the region may use a geographical indication to specify that a product is from a particular region.\textsuperscript{16} By contrast, trademarks are an individual right. Trademark owners have the right to prevent others from using their specific trademark.\textsuperscript{17} In addition,

\begin{itemize}
\item[11.] TRIPS Agreement, supra note 2, at art. 22; see Zylberg, supra note 6, at 3 (describing the incentives of GI protection as a guarantee to the consumer that the specific natural and environmental characteristics of the area are embedded in the product).
\item[12.] See Hughes, supra note 4, at 300 (emphasis added).
\item[13.] WIPO, \textit{FAQ}, supra note 8.
\item[14.] \textit{Id}.
\item[16.] See \textit{id} at 33.
\item[17.] WIPO, \textit{FAQ}, supra note 8.
\end{itemize}
geographical indications are typically predetermined by the production’s region, while trademark rights are usually attained by first in time (first use) or first to file.

1. Another Level of Protection: Appellations of Origin and Terroir

Appellations of origin, as defined in the Lisbon Agreement, are a special subset of geographical indications. While geographical indications typically obtain their name from their geographical location, appellations of origin take this connection one step further. Generally, appellations of origin derive their special qualities from the geographical environment where the good is produced. For example, Prosciutto di Parma—Parma ham—must be produced in the Parma province of Italy, using only pigs from the area strictly monitored by the Italian government. Therefore, there exists a difference between purchasing standard ham from the Parma region versus the specific Parma ham that meets the governmental requirements.

One of the main and most traditional justifications for appellation laws is terroir, or the idea that land is “a key input for a particular product.” Think back to the earlier hypothetical: if you purchased a plot of land that turns out to be both superior and unique for your good’s production, you would want to promote the uniqueness while also preventing others from exploiting it for their own gain. Though terroir has no English translation, it essentially means that a quality of a product comes with a territory (i.e., there is an important land/quality nexus which makes the product unique and entitles local producers to “exclusive use of a product name because no one outside the locale can truly make the same product”). The French system, which focuses on terroir, is the oldest of the European origin label systems. As such, France has some of the strongest geographical protections in the world.

18. Id.
19. See Torsen, supra note 15, at 33. The United States is often referred to as a “fitfir” country (i.e., “first in time, first in right”). See Zylberg, supra note 6, at 32.
20. WIPO, FAQ, supra note 8.
21. Id.
23. Hughes, supra note 4, at 301.
24. Id.
25. Barham, supra note 10, at 128; see Zylberg, supra note 6, at 3.
26. This is an unsurprising fact, especially when considering the importance of geographical locations for French wines. Champagne from the Champagne region of France is highly regarded for its originality and traditional method of production, which France benefits
B. Trademark Protections: The New World American Perspective

On the other side of the issues stand the New World producers, including the United States, Australia, Canada, and New Zealand, which typically use trademark law to protect goods from the common law tort of “passing off.” Unlike many European countries, countries like the United States did not have the traditional industrial problems that brought about the need to protect geographical indications in the first place. The focus in the United States has consistently been on consumer protection, whereas geographical indications developed in Europe were focused on protecting the locale’s reputation from where the goods were derived (i.e., more producer-based protections). The US Congress passed the first trademark registration law in the United States in 1870. Trademark law continued to develop as trade increased in the twentieth century. With the passage of the Lanham Act in 1946, trademarks began to have the protections that echo modern-day concerns. Today, the Lanham Act governs false designations of origins and provides a claim for a civil action.

To successfully apply for a trademark in the United States, the applicant must meet several requirements found in the Trademark

from. Hughes, supra note 4, at 301, 308; see also Zylberg, supra note 6, at 4 (“The regulation of production methods of certain fine foods and beverages in France are conducted through a system called the ‘Appellation d’Origine Controlee’ (AOC), which restricts the right to produce select products in specifically defined regions associated with those goods. The AOC is applied to a vast variety of products ranging from wine and dairy products to artisan products such as lace.”).

27. See Zylberg, supra note 6, at 1 (placing the United States and the European Union on opposite sides of the spectrum in the debate about the protection of geographical indications).


29. Countries of the New World, such as the United States, do not have a long history of traditional industries such as many European countries, and therefore have not had a separate law—apart from its trademark law—to protect geographical indications. Zylberg, supra note 6, at 14–15.


31. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:3 (4th ed. 2013). However, the law was struck down as unconstitutional and an overextension of congressional powers less than a decade later. Id.

32. Id.

33. Id. at § 5:4.

Act. These include the following: (1) proof that the mark is used in commerce; (2) because the United States is a “fitfir” country (i.e., first in time, first in right), the date of the first use of the mark and the date of the mark’s first use in commerce; and (3) an example of how the mark is used in commerce. To register a mark that originated in a foreign country, the applicant must exhibit the following: (1) a bona fide intention to use the mark in commerce, (2) a true copy of the registration in the country of origin, and (3) proof of renewal in the country of origin if expiration is pending. Registered marks remain in force for a period of either ten or twenty years, dependent on the date of filing, and may be further renewed after that period unless the mark has been previously cancelled or surrendered. Filings pursuant to the Madrid Agreement for the International Registration of Marks have similar guidelines and requirements.

1. Geographical Indications in the New World

Just as appellations of origins are categorized as a subset of geographical indications, the United States views geographical indications as a subset of trademarks. In the United States, the trademark system protects GIs, typically as certification or collective marks. GIs may also be protected through common law trademark in the United States. There is an important difference between geographic terms used arbitrarily and those used descriptively: the latter requires proof of secondary meaning. For example, if, as in the

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36. 37 C.F.R. §§ 2.33 (a)–(b).
38. 37 C.F.R. § 2.181 (“Registrations issued or renewed prior to November 16, 1989 . . . remain in force for twenty years from their date of issue or renewal[,] . . . registrations issued or renewed on or after November 16, 1989 . . . remain in force for ten years from their date of issue.”).
41. Id.
42. Cognac is an example of a common law regional certification mark in the United States because US purchasers understand Cognac to refer to brandy derived from a region in France as opposed to brandy produced elsewhere. OFFICE OF POLICY & INT’L AFFAIRS, GEOGRAPHICAL INDICATIONS (GI) PROTECTION—GIs as Certification Marks, USPTO, http://www.uspto.gov/learning-and-resources/ip-policy/geographical-indications/office-policy-and-international-affairs#heading-7 [http://perma.cc/5NB4-7QNV].
43. USPTO, GI PROTECTION, supra note 40, at 6.
case of geographical indicators, the mark is the name of the place where the goods are derived, this is use in a “descriptive sense.” In the United States, the “doctrine of secondary meaning” applies to trademarks that transform a “geographically descriptive term into a trademark” because particular buyers have come to associate the term as indicating a source and quality of goods.

Essentially, the protection of geographical indications in the United States is subsumed underneath trademark law. According to the US Patent and Trademark Office (USPTO), geographical indications and trademarks serve the same functions because both are valuable business interests, source-identifiers, and guarantees of quality.

In the United States, as well as other New World countries, geographical indications are often given “certification marks” or “collective marks.” Under US law, a collective mark is defined, in relevant part, as “a trademark or service mark . . . used by the members of a cooperative, an association, or other collective group or organization” and a certification mark is “a mark used upon or in connection with the products or services of one or more persons . . . to certify regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of such goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.” Certification marks serve to protect a geographical indicator if it is used to “certify regional origin.”

Some well-known certification marks in the United States, which are registered with the USPTO, include Idaho potatoes, Washington apples, and Florida oranges.

In order to maintain the registration of a certification mark, the holder must meet several requirements, including use of the mark. Additionally, the markholder cannot be a producer of the mark and cannot allow the mark to be used for anything other than the relevant products. For both collective marks and certification

44. Id. at 1.
45. Id. at 5.
46. Hughes, supra note 4, at 308; see USPTO, GI PROTECTION, supra note 37, at 5.
47. USPTO, GI PROTECTION, supra note 40 at 1.
48. Id.
50. Hughes, supra note 4, at 308.
51. Id.; see USPTO, GI PROTECTION, supra note 40, at 1.
52. Hughes, supra note 4, at 309.
marks, government oversight is minimal, especially when compared to the often-significant amount of governmental control in the Old World system.\(^{54}\) In Europe, there are often strict governmental standards that must be followed in order to qualify for use of the geographical indication or appellation of origin.\(^{55}\)

Even without USPTO registration, some certification marks may be obtained under common law doctrines.\(^{56}\) To reach this status via common law, the owner must show that “the use of a geographic designation is controlled and limited in such a manner that it reliably indicates to purchasers that the goods bearing the designation come exclusively from a particular region.”\(^{57}\) Therefore, a producer using an appellation in another country can obtain common law rights if no one in the United States is using the mark for the same product.\(^{58}\)

In general, the protection of geographical indications parallels copyright protection; indeed, some argue that geographical indications are the precursor to our modern copyright laws.\(^{59}\) It is easy to see why there is much support for this case—for GIs, geographic names became associated with products; trademarks represent the producer that became identified with a specific product.\(^{60}\) In both instances, the main goal is essentially the same: protect the product from freeriders and help ensure that customers are receiving the item they desired instead of an imitation.\(^{61}\) Trademarks are used by enterprises to distinguish their goods from other enterprises.\(^{62}\) Like geographical indications, trademarks are often closely linked, or inseparable from, the reputation of a good.\(^{63}\) Sometimes, as in the case of Stradivarius violins, the accretion of a trademark’s meaning and that of a geographical indication occurred simultaneously.\(^{64}\) Some would argue that the TRIPS Agreement (discussed in detail below) placed

\(^{54}\) Hughes, supra note 4, at 310. France’s appellations d’origine system has especially strict governmental standards that must be followed in order to obtain the relevant protections. Id.

\(^{55}\) See id.; see also WIPO, Famous Appellations of Origin, supra note 22, at 21.

\(^{56}\) Hughes, supra note 4, at 310.


\(^{58}\) Id.

\(^{59}\) Id. at n.7 (“In antiquity, geographic indications were the prevailing type of designation for products.”).

\(^{60}\) Id. at 300.

\(^{61}\) See id.

\(^{62}\) WIPO, FAQ, supra note 8.

\(^{63}\) Id.

\(^{64}\) See Hughes, supra note 4, at 300 (explaining that Stradivarius was a house creating violins in the area of Cremona, which was known for its premier violin making).
geographical indications on the same level as copyright, patents, and trademarks.65

C. Merging the Two Worlds: International Agreements

There have been several international agreements that have had a significant impact on the intellectual property world in the past two centuries. The first, the Paris Convention of 1884, sought to grant global protections for industrial property rights. The trademark-focused Madrid Agreement quickly followed at the turn of the century. The original Lisbon Agreement came into being in the 1950s, seeking to protect appellations of origin by closing the gaps left by the Madrid Agreement. Finally, the TRIPS Agreement attempted to compromise Old and New World views by addressing how geographical indications are treated globally by members of the World Trade Organization.

1. In the Beginning: The Paris Convention

Increased international trade in the nineteenth century highlighted the need for an international system of protection of industrial property laws.66 Practical problems in obtaining industrial property rights around the world accelerated the development of the law.67 The Paris Convention for the Protection of Industrial Property came into existence in 1884, with fourteen countries party to the agreement.68 The Paris Convention provided for “national treatment” of industrial property, meaning that each Contracting State to the convention is required to grant the same protection to nationals of other Contracting States that it grants to its own.69 Nationals domiciled or those with real and effective industrial or commercial interests in a Contracting State are also entitled to national treatment under the Convention.70

65. See id. at 301.
67. Id.
68. Id.
70. WIPO, Summary of the Paris Convention, supra note 69.
In addition to national treatment, the Paris Convention’s two other main parts cover the right of priority in the case of patents, marks, and industrial designs and common rules that all Contracting States must follow.\textsuperscript{71} Important among the common rules is the concept of independence of patents and marks, which allows for Contracting States to independently assess patents and marks, but also prevents states from refusing protection based either on a lack of patent or mark in the country of origin or other Contracting States.\textsuperscript{72} However, where a mark has been duly registered in the country of origin, it must be protected in its original form in the other Contracting States.\textsuperscript{73}

The Paris Convention was a milestone for the protection of industrial property. Categorically, the Convention was extremely broad, covering patents, trademarks, industrial designs, utility models, service marks, trade names, geographical indications, and the repression of unfair competition.\textsuperscript{74} By its own definition, it encompasses industry and commerce, agriculture and extractive industries, and all manufactured or natural products, including wine.\textsuperscript{75} The United States became a party to the Paris Convention in 1887.\textsuperscript{76} The Convention is open to all states and has gone through multiple revisions, with the last amendment occurring in 1979.\textsuperscript{77} To date, there are 176 countries party to the Convention.\textsuperscript{78}

2. Aftereffects of the Paris Convention: Increasing International Agreements and Protection

Following the Paris Convention, additional agreements developed to further the purposes of international trade and property protection. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) was established in 1994 at Marrakesh, a century after the Paris Convention.\textsuperscript{79} Administered by the World Trade Organization (WTO), the TRIPS Agreement requires WTO members to provide broad protection for copyright to many categories of intellectual property, including, in relevant part, geographical

\begin{itemize}
\item \textsuperscript{71} Id.
\item \textsuperscript{72} Id.
\item \textsuperscript{73} Id.
\item \textsuperscript{74} Id.
\item \textsuperscript{75} See Paris Convention, supra note 69, at art. 1(3).
\item \textsuperscript{77} Paris Convention, supra note 69.
\item \textsuperscript{78} WIPO-Administered Treaties, supra note 76.
\item \textsuperscript{79} See TRIPS Agreement, supra note 2.
\end{itemize}
indications and appellations of origin. Additionally, the TRIPS Agreement provides for a higher protection of wines and spirits, allowing members to prevent the use of geographical indicators on these types of products that falsely identify the origin of a specific area, even if the true origin is indicated elsewhere. Therefore, even if there is no risk of consumer confusion due to words such as “like,” “kind,” or “imitation,” the products are still prohibited under the TRIPS Agreement. The United States became a party to the TRIPS Agreement in 1995 with 161 countries party to date.

The TRIPS Agreement brings together both the Old and New Worlds in a compromise between the two viewpoints and an agreement to continue discussions about geographical indications protections at a later date. The TRIPS Agreement was the first multilateral agreement to use the term “geographical indications.” The most recent negotiations, taking place in Doha, highlight two hot-button issues: creating a multilateral register for wine and spirits and extending the higher protection of Article 23 to other categories of geographical indications beyond wines and spirits.

Also of significance is the Madrid Agreement Concerning the International Registration of Marks and the Protocol Relating to the Madrid Agreement, which collectively govern the system of international registration of marks (trademarks and service marks). The International Bureau of the World Intellectual Property Organization (WIPO) administers the system. According to WIPO, the Madrid System is “a one stop solution for registering and managing marks worldwide.” The system is open to any state party to the Paris Convention. The system facilitates both the protection

80. See id. at arts. 22–23.
81. Id. at art. 23. Conceptually, it is easy to think of this protection as along similar lines with American dilution laws. See 15 U.S.C. § 1127.
82. Zylberg, supra note 6, at 27.
84. Hughes, supra note 4, at 301.
87. WIPO, Int’l Treaties & Conventions, supra note 63, at 279.
88. Id.
of marks and the management of that protection. The effect of an international registration is highly beneficial: the protection of the mark in each of the Contracting Parties functions as if the mark had been independently filed with each country. It is “equivalent to a bundle of national registrations.” Contracting parties have the option of refusing protection, but are required to do so within a limited time period after the registration has been filed (twelve to eighteen months depending on whether the contracting party requested the longer time period under the Protocol). An international registration is not set forever, but is only effective for ten years, and may be renewed for periods of ten years by paying prescribed fees.

3. Filling the Gap: Introducing Lisbon

The Lisbon Agreement for the Protection of Appellations of Origin and their Internal Registration, which will be discussed in greater detail in Section III, arrived on the scene in 1958, in the century between the Paris Convention and the TRIPS Agreement. The Lisbon Agreement came into being to fill a gap in IP protection: the Paris Convention left protection for geographical indications quite weak and appellation of origin protection practically non-existent. In short, the Lisbon Agreement protects “the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality of characteristics of which are due exclusively or essentially to the geographic environment, including natural and human factors.” It was the international agreement that defined “appellation of origin.”

91. Id.
92. Id.
93. Id.
94. Id.
95. Id.
98. Torsen, supra note 15, at 34.
99. Summary of the Lisbon Agreement, supra note 96 (emphasis added).
100. Torsen, supra note 15, at 35.
the Madrid System, the agreement is open to States that are party to the Paris Convention.¹⁰¹

The Lisbon Agreement allows for a higher level of protection above what is already provided for general products in the TRIPS Agreement; however, the agreement specifically states that the protections under the Lisbon Agreement do not rule out any protections that might already exist in a member country by virtue of other international treaties.¹⁰² The Lisbon Agreement is also unique in that it allows each country to decide how each domestic law will protect appellations.¹⁰³

III. UNDERSTANDING THE LISBON AGREEMENT FOR THE PROTECTION OF APPpellations of Origin and Their International Registration

The Lisbon Agreement arose out of the complications of securing international protection of geographical indications.¹⁰⁴ The Agreement was part of a desire to create an international system that would easily provide the desired protection for appellations of origin: namely, the same protection that appellations of origin have in their countries of origin.¹⁰⁵ Contracting Parties to the Lisbon Agreement agree to protect the appellations of origins of other Contracting States within their own territories.¹⁰⁶ Therefore, when an appellation of origin has been approved in a Contracting State of origin and filed with the WIPO, it is automatically protected in the other Contracting States.¹⁰⁷

To achieve protection from the international registration, the appellation of origin is first required to be formalized in the country of origin.¹⁰⁸ The Lisbon Agreement, unlike the Paris Convention and Madrid Agreement, obligates each States Party to provide protection even if the true origin of the product is indicated or uses terms such as “kind,” “type,” or similar phrases.¹⁰⁹ As such, the Lisbon System provides a higher level of protection by not requiring potential

¹⁰¹ Summary of the Lisbon Agreement, supra note 96.
¹⁰² Lisbon Agreement, supra note 97, at art. 4
¹⁰³ See Hughes, supra note 4, at 312.
¹⁰⁵ Id.
¹⁰⁶ Id.
¹⁰⁷ Id.
¹⁰⁸ Id.
consumer deception. This is the same level of protection that WTO members agreed to provide for wines and spirits under the TRIPS Agreement. This heightened protection becomes important in the debate regarding generics and semi-generics.

A. The Original Lisbon Agreement

As stated, the Lisbon Agreement serves to protect and provide the strongest protections for appellations of origin. These are, as discussed above, a subset of geographical indications that obtain their qualities or characteristics from the geographic environment in which they are produced. Compared to appellations of origin, geographical indications are “broader and have a weaker link to the environment of origin.” Contracting States to the Lisbon Agreement may request a denomination of an appellation of origin from the International Bureau of WIPO. There are currently twenty-eight parties to the Lisbon Agreement. A quick glance at the states party to the Agreement shows the vast majority to be European and Mediterranean countries, with a few from Central and South America, Africa, and North Korea. Approximately one-third joined the Lisbon Agreement after the TRIPS Agreement was established in 1994.

110. Id. at 78; see Zylberg, supra note 6, at 6 (“The Code de la Consommation here adopts a two-fold prohibition, namely, the prohibition to use an appellation of origin for similar products, which may cause consumer confusion, such as, for example, Champagne for nonalcoholic beverages; and the prohibition to use the appellation of origin for any other product, which may not necessarily cause consumer confusion, such as Champagne for perfume. Thus, the Code has ensured that the appellation of origin should not be diluted from its distinctiveness even when no consumer confusion will occur.”)
111. TRIPS Agreement, supra note 2, at art. 23.
112. Zylberg, supra note 6, at 21; see WIPO, THE LISBON SYSTEM, supra note 104.
113. Lisbon Agreement, supra note 97, at art. 2(1).
115. Lisbon Agreement, supra note 97, at art. 5(1).
118. Gervais, supra note 109, at 79.
Each state party that adheres administratively to the Stockholm revisions of the Agreement is a member of the Assembly. Under the current Agreement, a Contracting State may declare, up to one year after the registration is filed, that it cannot ensure the protection of an appellation within its country. Some of the most well-known products protected under the Lisbon Agreement include tequila (Mexico), Parmigiano-Reggiano (certain territories of Italy), and Huile D’olive de la Vallée des Baux de Provence (France). The Lisbon Agreement’s searchable database, the “Lisbon Express,” lists all appellations of origin registered under the Agreement, the product to which they apply, the area of production, refusals of member countries, and the holders of the right to use the appellation. Currently there are over nine hundred appellations listed on the Lisbon Express, with the overwhelming mass of them stemming from France.

The Lisbon Agreement defines an appellation of origin as the geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors. It further states “the country of origin is the country whose name, or the country in which is situated the region or locality whose name, constitutes the appellation of origin that has given the product its reputation.”

1. So What Exactly Does the Lisbon Agreement Do?

As detailed in Section II of this Note, geographical indications are a collective right. Appellations of origin, as a subset of geographical indications, are often used by producers to endorse the specific characteristics of their product’s environment, along with keeping a high-quality standard and reputation intact. The Lisbon Agreement purports to benefit producers, consumers, and economic development of regions and countries by helping stabilize and

119. Summary of the Lisbon Agreement, supra note 96.
120. Id.
121. WIPO, THE LISBON SYSTEM, supra note 104.
122. Id.
124. Lisbon Agreement, supra note 97.
126. Id.
maintain high prices for products, providing guarantees of quality and production to consumers, and benefitting local communities by promoting development of products within the area. Generally, geographical indications push the focus on the country’s comparative advantage of producing a good with a high market value due to its origin. Even in the United States, the desire for local goods and specific products can be seen in the “farm-to-table” movement that has become increasingly popular in the last few years.

The Lisbon Agreement provides an efficient way for international protection of appellations of origin among those countries party to the Agreement. In brief, after the holders of the right to use the appellation of origin have protected their right in their country of origin, the country of origin’s government may request to file an application for international registration. International registration requires a one-time fee of five hundred Swiss francs, which ensures that the appellation of origin will be protected without a requirement of renewal as long as the appellation remains protected in the country of origin. Though generally any registered appellation should be protected in all countries party to the agreement, States have the right to refuse the protection on the grounds that the appellation of origin corresponds to a generic indication of a particular product or a protected trademark within their territory. Refusals may later be withdrawn or statements of protection given if, after a period of time, the initial issues surrounding the refusal of protection are no longer a concern. Parties may appeal a refusal using the judicial and administrative remedies available to nationals of that country.

B. Adding Geographical Indications to Lisbon: The Geneva Act

Since 2009, the Working Group on the Development of the Lisbon System has engaged in a review of the Lisbon Agreement with the idea of extending the scope of the Agreement to cover geographical indications.
indications instead of just appellations of origin.\textsuperscript{135} Established in 2008, the Working Group was charged with examining potential improvements to the Lisbon System that would attract more members and enhance benefits for those already party, while maintaining the goals of the original Agreement.\textsuperscript{136} A major reason for the full review of the Agreement was to increase membership, including expansion to international organizations.\textsuperscript{137} The tenth session of the working group devised a draft for presentation at the Diplomatic Conference.\textsuperscript{138} From May 11 to May 15, 2015, the Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement for Appellations of Origin and their International Registration took place, resulting in the Geneva Act.\textsuperscript{139}

In order to accomplish the Working Group’s goals, a variety of issues had to be addressed.\textsuperscript{140} The main issue, for the purposes of this Note, was the expansion of the Lisbon System to include geographical indications.\textsuperscript{141} Two of the other main topics were changes in the international registration system and a potential maintenance fee; many of the other proposed changes were administrative.\textsuperscript{142}

\textsuperscript{136} Id. The main issues were debated for years prior to the actual conference. See generally Diplomatic Conference for the Adoption of a New Act of the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, WIPO, http://www.wipo.int/meetings/en/details.jsp?meeting_id=35202 [http://perma.cc/462N-8HDL].
\textsuperscript{138} WIPO, DRAFT REVISED LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS, WORKING GROUP ON THE DEVELOPMENT OF THE LISBON SYSTEM (APPELLATIONS OF ORIGIN), TENTH SESSION 2 (2014) http://www.wipo.int/edocs/mdocs/en/li_wg_dev_10/li_wg_dev_10_2.pdf [http://perma.cc/XB6J-PWS7] [hereinafter WIPO, DRAFT REVISED LISBON AGREEMENT] (This draft served as the primary source for the revisions to the Lisbon Agreement, due to the timing of this Note. It is the final draft that was prepared for the Diplomatic Conference in May 2015.).
\textsuperscript{139} A major controversy surrounding the new Agreement is in regards to voting: only the twenty-eight contracting states to the current Lisbon Agreement will be allowed to vote. See Pamela Hamamoto, US Ambassador & Permanent Representative, United Nations, Opening Statement to the Preparatory Committee of the Diplomatic Conference for the Adoption of a Revised Lisbon Agreement on Appellations of Origin and Geographical Indications at WIPO (Oct. 30, 2014), https://geneva.usmission.gov/2014/11/03/u-s-opening-statement-for-the-adoptions-of-a-revised-lisbon-agreement/ [http://perma.cc/5ED7-KF6X]. Though this is an important issue leading up to the Diplomatic Conference and a source of controversy among members and non-members of the Lisbon Agreement, this issue is beyond the scope of this Note.
\textsuperscript{140} Id.
\textsuperscript{141} Id.
\textsuperscript{142} Id.
The tenth session of the Working Group met in October 2014 to finalize the draft to be presented at the Diplomatic Conference in May 2015. In addition to twenty-one Contracting State participants, several States were represented as observers, including the United States. Additionally, several international intergovernmental organizations and non-governmental organizations participated in observer capacity. At the Diplomatic Conference, negotiators approved the Geneva Act allowing the international registration of geographical indications, providing protection for names that identify the origin of products such as coffee, tea, fruits, wine, pottery, and cloth.

C. US Issues with the Geneva Act: Generics and Trade

A major point of contention between the European perspective and the US perspective comes with genericization of products. The United States does not protect geographic terms that are generic for goods or services (i.e. terms or signs so widely used that consumers view them as designating a category of all of the goods or services of the same type, instead of as indicators of geographical origin). Because of this viewpoint, any producer is free to use the geographic indication in the United States once it has been deemed generic. Preventing the use of the mark typically relies on consumer confusion: if use by an unauthorized party is likely to cause consumer confusion, the trademark or GI owner can prevent the use of the mark or GI. This stands in contrast to the Lisbon Agreement’s higher protection for appellations of origin, which prevents use regardless of consumer confusion.

The United States fears the impact the Geneva Act would have on global trade, specifically on companies whose business depends on

143.  *Id.*
145.  *Id.* One of the proposed revisions to the agreement would allow non-State entities to become party to the agreement, such as the European Union. WIPO, *DRAFT REVISED LISBON AGREEMENT, supra* note 138.
147.  USPTO, *GI PROTECTION, supra* note 40.
148.  *Id.*
149.  *Id.*
150.  See *supra* Section II.
the use of common or generic names. For example, “apple” cannot be protected as a trademark in the United States because “apple” is a generic name for a type of fruit. This type of protection could extend to well-known products prominent in the United States, such as Parmesan or fontina cheese.

The United States fears the expansion to geographical indications, which would allow parties to the Agreement to simultaneously register their geographical indications with all other parties. Further, the United States is concerned about the consequences and effects the changes would have beyond parties to the current Lisbon Agreement. Specifically, the US delegation anticipates that the Geneva Act lacks adequate protection for users of common or generic names or for prior trademark holders, which would negatively impact sales opportunities and IP rights. The fear that countries will prevent US companies that use common food names from participating in the market is the foundation of the US position in this debate.

IV. STOP FIGHTING, START JOINING: WHY THE UNITED STATES SHOULD SUPPORT THE GENEVA ACT

Though the current US apprehension is warranted, the Geneva Act is likely to be more beneficial than harmful in the long run. Certainly there are some serious issues that will need to be resolved prior to implementation of the Geneva Act—specifically involving companies who currently use common food names that are considered geographical indications in some countries—but looking at the broader picture of the international intellectual property world and its future,

152. USPTO, GI PROTECTION, supra note 40.
154. Letter from Sen. Orrin Hatch, Chairman, S. Comm. on Fin., to Director General Francis Gurry, WIPO, supra note 151.
155. Id.
156. Id.
the baseline issue of geographical indication protection is not disappearing anytime soon. The Lisbon Agreement and Geneva Act could be a way for the United States to have its concerns addressed early in the process.

Comparing the Geneva Act to the TRIPS Agreement, to which the United States is a party, is helpful in addressing US fears.158 The TRIPS Agreement currently calls for higher protection for geographical indications used for wines and spirits.159 This level of protection is equal to that of appellations of origin in the current Lisbon Agreement, preventing the use of the GI even in the absence of consumer confusion and in the presence of terms such as “kind,” “type,” or “style.”160 While Article 22 of the TRIPS Agreement covers geographical indications generally, with a standard level of protection meant to avoid unfair competition or misleading the public, Article 23’s protection for wine and spirits is greater, requiring protection even if the public would not be misled.161

However, one of the major issues of the current round of negotiations of the TRIPS Agreement is the possibility of extending the higher Article 23 protection beyond just wine and spirits.162 The other major issue concerning the TRIPS Agreement is the creation of an international register.163 Some delegations see a relation between the two issues: the revised Lisbon Agreement may marry them.164 The


159. TRIPS Agreement, supra note 2, at art. 23.

160. Id. at arts. 23–24 (“Nothing in this Section shall require a Member to prevent continued and similar use of a particular geographical indication of another Member identifying wines or spirits in connection with goods or services by any of its nationals or domiciliaries who have used that geographical indication in a continuous manner with regard to the same or related goods or services in the territory of that Member either (a) for at least 10 years preceding 15 April 1994 or (b) in good faith preceding that date.”).

161. TRIPS Agreement, supra note 2; TRIPS: Geographical Indications, Background and the current situation, WTO, http://www.wto.org/english/tratop_e/trips_e/gi_background_e.htm [http://perma.cc/A82Q-K4X3] [hereinafter GIs, Background].

162. GIs, Background, supra note 161.

163. Id.

164. See id. for discussions on these issues at the WTO that are still ongoing, but have mostly stalled because delegations believe that the only mandate is to negotiate a multilateral register; see also Catherine Saez, At WTO Next Week: GI Register, Plain Packaging, Women in Innovation, INTELLECTUAL PROP. WATCH (Feb. 19, 2015), http://www.ip-watch.org/2015/02/19/at-wto-next-week-gi-register-plain-packaging-women-in-innovation/ [http://perma.cc/6G6E-7KEK] (stating that an informal session regarding the GI register is to be held in 2015 for which members have agreed to lay out plans by July 2015). For a detailed discussion on the Lisbon Agreement serving as the register requirement for Art. 23 of TRIPS, see Gervais, supra note 109, at 87–100.
most important exception in the TRIPS Agreement, for the purposes of this Note, located in Article 24, is that for geographical indications that use common food names and names already registered for a trademark.\footnote{165} These are the two major concerns, from the US perspective, of the Geneva Act of the Lisbon Agreement. Without a similar exception, the United States fears the impact higher protection for GIs will have on the international trade community.

Similar protections and exceptions can be found in the Draft Revised Lisbon Agreement, which led to the Geneva Act, regarding flexibility of implementation and legislation, safeguards, and refusal, from which the United States would benefit if it became a party to the Agreement. Article 11’s addition of geographical indications does not extend to products that have a generic character in the Contracting Party of Origin.\footnote{166} The more problematic Article 12 protects registered appellations of origin and geographical indications from becoming generic as long as the denomination is protected in the Contracting Party of Origin.\footnote{167} However, it is subject to several provisions similar to those found in the TRIPS Agreement, including safeguards for prior trademark rights and trademarks used in good faith in Contracting Parties (Article 13) and refusal (Article 15). For international products that seek protection in the United States, Article 15’s refusal provision allows Contracting Parties to refuse to protect a geographical indication by filing a refusal within one year of the request. Articles 9 and 10 highlight the flexibility of the Lisbon Agreement’s implementation, which allows Contracting Parties to protect appellations of origin and geographical indications using its own legal system and practice and freely choose the type of legislation under which to establish protection as called for in the Agreement.\footnote{168} Therefore, the United States could keep its current system of protecting geographical indications through trademark protection.

These provisions in the Geneva Act should help quell some of the fears of extending the scope of the Agreement to cover geographical indications, and, as a Contracting Party, the United States would benefit from them. However, from a practical standpoint, how much will this really affect common and generically-named products? One of the examples continually brought up is that of Parmesan cheese: Americans view it as a type of cheese, generally unrelated to a geographical area, whereas Italians strongly link it to a cheese produced in Parma, Italy. If those party to the

\footnote{165} TRIPS Agreement, supra note 2, at art. 24; GIs, Background, supra note 161.  
\footnote{166} WIPO, GENEVA ACT, supra note 1, at art. 11(2) n.1.  
\footnote{167} Id at art. 12.  
\footnote{168} Id. at arts. 9-10.
Lisbon Agreement are now required to protect “Parmesan” from usurpers of the name, what will be the effect? Due to the prior trademark rights provision of Article 13(1), the trademark rights of current American Parmesan cheese producers may remain protected. From a practical standpoint, Italians are unlikely to buy American-style Parmesan cheese anyway. Further, the increasing interest in purchasing local, high-quality, and authentic products everywhere in the world supports the idea of protecting geographical indication expansion. The “foodie” movement that is so prominent in today’s culture is unlikely to go away and is instead very likely to grow with future generations.

A. Other Practical Considerations: Organizational Influence

The Geneva Act opens up the Lisbon Agreement to international governmental organizations, such as the European Union and the African Organization for Intellectual Property. If powerful and prominent organizations join the Geneva Act, it will certainly benefit the United States to become a party as well. While another concern remains that the Geneva Act will lead to potential conflicts between the WIPO system and the WTO talks, it instead may serve to bring the two regimes together. As higher protection for wine and spirits is already afforded under Article 23 of the TRIPS Agreement, and expansion to other geographical indications has been on the table for years, extending the higher protection through the Lisbon Agreement can pave the way to smooth out issues that concern members of the WTO, especially if some of the New World concerns can be added into the Lisbon Agreement. Unlike the WTO, WIPO agreements are generally more flexible and can be tailored to meet the needs of members. This flexibility can greatly benefit the way the new revisions are implemented and help sort out any issues from

169. While this is obviously an extreme example, and there will be many more nuanced issues, it is used to demonstrate the practical implications of the revision from a consumer standpoint.
170. For more insight on the farm to table movement, see N.J. AGRIC. EXPERIMENT STATION, From Farm to Fork, RUTGERS, https://njaes.rutgers.edu/health/farmtofork.asp [http://perma.cc/H4TN-NA3X].
172. Id.
future TRIPS revisions, in addition to pushing forward discussions in the Doha round.

V. CONCLUSION: GI PROTECTION AND THE FUTURE

The Geneva Act has taken the Lisbon Agreement from a small convention with less than thirty members to an agreement that has sparked global concern and controversy. However, the push for higher protections of geographical indications across the board is not a new concept. Greater GI protection has been a topic of discussion for a decade at the WTO and will not likely recede anytime soon. The Geneva Act grants the protection desired by delegations of the WTO that want higher protection for geographical indications, while also allowing for quick international registration that would protect domestic products across all Contracting States to the Agreement.

In conclusion, the Geneva Act, though it may initially pose some practical problems, attempts to face some of the issues currently surrounding the world of international intellectual property. While its revisions certainly are expansive, the issues it addresses are the same ones being discussed in other global forums and are unlikely to simply disappear if they remain in the negotiation sphere. The Geneva Act gives geographical indications the same protection as appellations of origin in an attempt to bring new members in as parties; the applicability and expansiveness of the GI market should help achieve this goal. Further, if the United States joins the Lisbon Agreement with the Geneva Act, it will obtain the benefits of other Contracting States while utilizing the exceptions in the Agreement under its own legal system. The Geneva Act allows the United States to maintain the versatility of national protections regarding geographical indications, while US producers will benefit from the protections of other Contracting States. An international geographical indication register with a one-stop shop approach to registration is finally within the grasp of the global trade community, and the United States would be smart to seize the opportunity to shape its future and reap the early rewards.

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