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# Geneva Act of the Lisbon Agreement

EU-Brazil Dialogues on the Protection of  
Geographical Indications



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AUGUST 2023

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# Abbreviations and acronyms

<b>EU</b>	European Union
<b>AIPO</b>	African Intellectual Property Organization
<b>WIPO</b>	World Intellectual Property Organization
<b>NIPS</b>	National Intellectual Property Strategy
<b>IP</b>	Intellectual Property
<b>IPR</b>	Intellectual Property Rights
<b>GI</b>	Geographical Indications
<b>NIIP</b>	National Institute of Intellectual Property
<b>AO</b>	Appellation of Origin
<b>MEUA</b>	Mercosur-EU Agreement
<b>IS</b>	Indication of Source
<b>IGIP</b>	Interministerial Group on Intellectual Property
<b>PROSUR</b>	Forum for the Progress and Integration of South America
<b>TRIPS</b>	Agreement on Trade-Related Aspects of Intellectual Property Rights
<b>WTO</b>	World Trade Organization
<b>ABRIG</b>	Brazilian Association of Geographical Indications

# 1. Introduction

The Lisbon Agreement was originally signed in 1958 and was amended in 1967 in the version known as the Stockholm Act 1967. Both were focused on the protection of Appellations of Origin. Subsequently a new version, called the Geneva Act 2015, came into force in 2020, which extended this protection to Geographical Indications, and relaxed some requirements that were in the Stockholm Act version.

A country may accede to both the Lisbon Agreement, in the Stockholm Act 1967 version, to which today 29 countries have acceded, and the version of the Geneva Act of 2015, to which today 17 countries have acceded. In total today there are 30 members since some countries have acceded to both.

**Figura 1 - Resumo de todos os membros**

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**9. Lisbon Agreement for the Protection of Appellations of Origin and their International Registration**

Lisbon Agreement (1958), revised at Stockholm (1967), and amended in 1979, and the Geneva Act (2015)  
(Lisbon Union)

Status on May 11, 2023

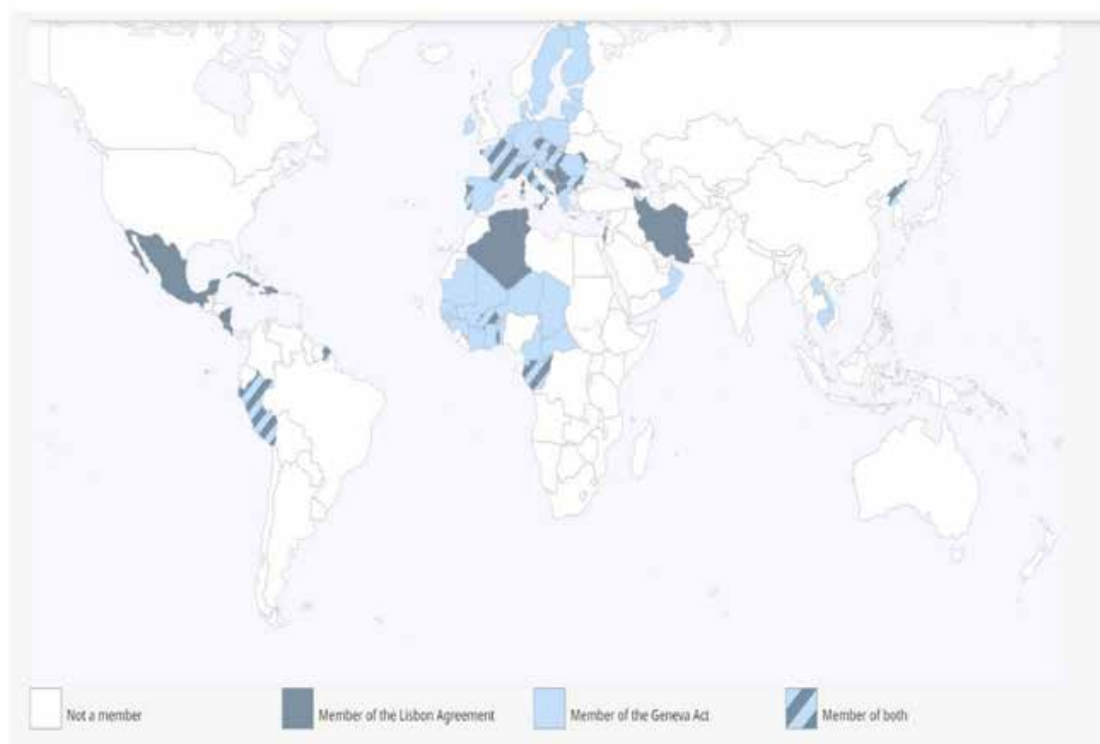
State/IGO	Date on which State became party to the Agreement	Date on which State became party to the Stockholm (or Lisbon) Act	Date on which State/IGO became party to the Geneva Act
African Intellectual Property Organization (OAPI) <sup>1,3,4</sup>	-	-	March 15, 2023
Albania	May 8, 2019	Stockholm: May 8, 2019	February 26, 2020
Algeria	July 5, 1972	Stockholm: October 31, 1973	-
Bosnia and Herzegovina	July 4, 2013	Stockholm: July 4, 2013	-
Bulgaria	August 12, 1975	Stockholm: August 12, 1975	-
Burkina Faso	September 2, 1975	Stockholm: September 2, 1975	-
Cabo Verde <sup>2,3,4</sup>	-	-	July 6, 2022
Cambodia <sup>4</sup>	-	-	February 26, 2020
Congo	November 16, 1977	Stockholm: November 16, 1977	-
Costa Rica	July 30, 1997	Stockholm: July 30, 1997	-
Côte d'Ivoire	-	-	March 15, 2023
Cuba	September 25, 1966	Stockholm: April 8, 1975	-
Czech Republic	January 1, 1993	Stockholm: January 1, 1993	September 2, 2022
Democratic People's Republic of Korea	January 4, 2005	Stockholm: January 4, 2005	February 26, 2020
Dominican Republic	January 17, 2020	Stockholm: January 17, 2020	-
European Union <sup>5</sup>	-	-	February 26, 2020
France	September 25, 1966	Stockholm: August 12, 1975 <sup>5</sup>	April 21, 2021
Gabon	June 10, 1975	Stockholm: June 10, 1975	-
Georgia	September 23, 2004	Stockholm: September 23, 2004	-
Ghana <sup>6</sup>	-	-	February 3, 2022
Haiti	September 25, 1966	Lisbon: September 25, 1966	-
Hungary	March 23, 1967	Stockholm: October 31, 1973	September 10, 2021
Iran (Islamic Republic of)	March 9, 2006	Stockholm: March 9, 2006	-
Israel	September 25, 1966	Stockholm: October 31, 1973	-
Italy	December 29, 1968	Stockholm: April 24, 1977	-
Lao People's Democratic Republic	-	-	February 20, 2021
Mexico	September 25, 1966	Stockholm: January 26, 2001	-
Montenegro	June 3, 2006	Stockholm: June 3, 2006	-
Nicaragua	June 15, 2006	Stockholm: June 15, 2006	-
North Macedonia	October 6, 2010	Stockholm: October 6, 2010	-
Oman	-	-	June 30, 2021
Peru	May 16, 2005	Stockholm: May 16, 2005	October 18, 2022
Portugal	September 25, 1966	Stockholm: April 17, 1991	-
Republic of Moldova	April 5, 2001	Stockholm: April 5, 2001	-
Russian Federation <sup>4,7,8,9</sup>	-	-	August 11, 2023
Samoa <sup>8,9</sup>	-	-	February 26, 2020
Serbia <sup>10</sup>	June 1, 1999	Stockholm: June 1, 1999	-
Slovakia	January 1, 1993	Stockholm: January 1, 1993	-
Switzerland	-	-	December 1, 2021
Togo	April 30, 1975	Stockholm: April 30, 1975	-
Tunisia	October 31, 1973	Stockholm: October 31, 1973	July 6, 2023
(Total: 41)		(30)	(18)

Fonte: Lisbon Agreement, 2023

It is important to point out that membership can take place by country or by other form of regional representation, such as the European Union (EU) and the African Intellectual Property Organization (AIPO). Other countries have signed the agreement, but not all of them have ratified it.

This document aims to bring considerations to support Brazilian decision-making regarding whether to accede to the Geneva Act of the Lisbon Agreement. And in the following points, we explain the main topics that must be observed, which were previously agreed.

**Figura 2- Países que aderiram ao Ato de Estocolmo e ao Ato de Genebra**



Fonte: OMPI

# 2. NIPS – National Intellectual Property Strategy

NIPS was established by DECREE 10,886 OF 7 DECEMBER 2021, and aims to work in seven strategic axes (lines of action):

## **Axis 1: Intellectual property for competitiveness and development**

To foster the generation and strategic use of intellectual property in the interest of the nation to promote competitiveness and business development in Brazil and the world. The actions of this axis are aimed at generating and adding IP value to goods, services and processes, which in turn will result in greater competitiveness and income generation that takes into account regional specifics and competences.

## **Axis 2: Dissemination, training and qualification in intellectual property**

Promote action to disseminate IP culture among economic agents, consumers, the academic community and society at large, with the purpose of making the system and its tools known to inventors, creators, scientists and entrepreneurs, as well as training and upskilling professionals from diverse areas on the subject.

## **Axis 3: Governance and institutional strengthening**

Ensure the alignment, connection and implementation of NIPS action with the objectives and guidelines of innovation, development, competitiveness and culture policies, and direct measures to restructure and strengthen the administrative bodies responsible for IP services.

## **Axis 4: Modernisation of legal and non-statutory frameworks**

Make the IP regulatory environment more transparent, secure and predictable in relation to the demands of a dynamic and innovative global market and, where possible, simplify procedures to facilitate system access and use.



## **Axis 5: Compliance and legal certainty**

Raise society's consciousness and awareness of the importance of Intellectual Property Rights - IPR, including the benefits of using IPR and the harm arising from their infringement, as well as the need to afford them adequate protection; strengthen the business environment and legal certainty in Brazil, including in the digital environment, with measures aimed at better equipping and organising the judicial and supervisory bodies; and coordinate action to prosecute administrative and criminal offences against intellectual property.

## **Axis 6: Intelligence and vision for the future**

Encourage the production of forward-looking analyses on the use of IP, with the purpose of identifying technological trends, challenges for its protection on new technologies and new ways of appropriating creations protected by IPR and stimulate the use of databases to support innovation and the creative economy.

## **Axis 7: Integration of Brazil into the global IP system**

Strengthen Brazil's strategic integration into the international IP forums, stimulate the presence of cultural productions and Brazilian innovations abroad and promote a domestic business environment favourable to attracting foreign investment.

Geneva/Lisbon is particularly compatible with the progress on Axis 4 and Axis 7.

In order to advance on the axes above, the Brazilian Government launched a public call for suggestions for the NIPS 2023-2025. The call provides an opportunity for the main actors related to geographical indication in Brazil to send suggestions. In the end, the analysis of the results may bring one of the indicators of the interest of Brazilian Geographical Indications (GI) into international protection.

# 3. TRIPS and Geneva/ Lisbon comparison

In order to understand the difference between the Lisbon/Geneva Act and the TRIPS Agreement, and how this relates to what was regulated in Law 9279/1996, it is necessary to understand the basis on which the definitions that inform these came from. This item was developed based on the cited international agreements and the doctoral thesis 'Distinctive signs of origin: between the old and the new world of wine', by Kelly Lissandra Bruch.

The definition of "indication of provenance" or "indication of source" comes from the Paris Convention (1883) that, in its various versions, aimed to prevent false indications of source, which was more thoroughly dealt with in the Madrid Agreement (1891), concerning false indications of source.

The PC, in its Art. 10, and the Madrid Agreement in its Article 1, relate this concept to a product coming from a particular place, locality, region or state.

This concept does not require the product to have a specific characteristic or qualities, nor is the reputation or renown of that geographical name required for the product. However, this is not a positive definition, but rather an explanation of what would be a false indication of source.

It is important to note that this has no relation to the "indication of origin" of a product, which is more related to rules of origin.

The PC, in the original, in its Art. 10, sets forth:

*Article 10 - False Indications: Seizure, on Importation, etc., of Goods Bearing False Indications as to their Source or the Identity of the Producer*

*(1) The provisions of the preceding Article shall apply in cases of direct or indirect use of a false indication of the source of the goods or the identity of the producer, manufacturer, or merchant.*

*(2) Any producer, manufacturer, or merchant, whether a natural person or a legal entity, engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used, shall in any case be deemed an interested party.*

The Madrid Agreement, in the original, in its Art. 1, sets forth:

*Article 1*

*(1) All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries.*

This same logic was runs through the Protocol on the Harmonisation of Intellectual Property Laws in the Mercosur, concerning trademarks, indication of source and appellation of origin (Decision 08/1995), which provides a positive definition in its Art. 19(2).

And it was this logic that was brought directly into Law 9279/1996, in its Art. 177.

Harmonisation Protocol	Law 9279/1996
2) The geographical name of the country, city, region or locality of its territory, which is known as the centre of extraction, production or manufacture of a given product or of the provision of a given service, shall be deemed to be an indication of source.	Art. 177. The geographical name of the country, city, region or locality of its territory, which has become known as the centre of extraction, production or manufacture of a given product or of the provision of a given service, shall be deemed to be an indication of source.

On the other hand, the definition of appellation of origin, in the international context, was consolidated with the 1958 Lisbon Agreement, in its Art. 2, and remains the same in the 1967 Stockholm Act. There is a refinement in the 2015 Geneva Act:

1958 Lisbon Agreement 1967 Stockholm Act	2015 Geneva Act
<p style="text-align: center;"><b>Article 2</b></p> <p>1) In this Agreement, "appellation of origin" means 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.</p> <p>2) 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 which has given the product its reputation.</p>	<p style="text-align: center;"><b>Article 2 - Subject matter</b></p> <p>[Appellations of Origin and Geographical Indications] This Act applies in respect of:</p> <p>(i.) Any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area, where the quality or characteristics of the good are due exclusively or essentially to the geographical environment, including natural and human factors, and which has given the good its reputation;</p>

The Protocol on the Harmonisation of Intellectual Property Rules in Mercosur, concerning trademarks, indication of source and appellation of origin (Decision 08/1995) and Law 9279/1996, followed the same definition in the Lisbon Agreement of 1958/1967, with the exception of item 2 of the original definition:

Harmonisation Protocol	Law 9279/1996
<b>Art. 19</b>	<b>Art. 178</b>
3) Appellation of origin means the geographical name of a country, city, region or locality within its territory, designating products or services the qualities or characteristics of which are exclusively or essentially due to the geographical environment, including natural <b>or</b> human factors.	Appellation of origin means the geographical name of a country, city, region or locality within its territory, designating products or services the qualities or characteristics of which are exclusively or essentially due to the geographical environment, including natural <b>and</b> human factors.

The difference between these are the words “AND” and “OR”. Brazil literally followed the definition of the Lisbon Agreement, using the AND.

It should be noted that the concept of appellation of origin is fundamentally different from the concept of indication of source in that it relates the geographical origin to the product with qualities or characteristics which it possesses that originate exclusively or essentially from the geographical environment. For the AO there is a deeper link between the product and its origin. Furthermore, the Lisbon Agreement and the definition of the Geneva Act also highlight the renown that comes from this relationship. In other words, because it is differentiated, the product becomes well known. This is not explicitly set forth in the Brazilian legislation.

The TRIPS Agreement differed greatly from the logic that had been established, bringing a new element to international agreements, called Geographical Indication. This covers concepts present in both the indication of source and the appellation of origin. And many countries have chosen to use only this one, or to use this one and the appellation of origin. Brazil, among the Mercosur countries, is the only country that still uses indication of source.

TRIPS provides the following definition:

*SECTION 3: GEOGRAPHICAL INDICATIONS ARTICLE 22 Protection of Geographical Indications*

*1. Geographical indications are, for the purposes of this Agreement, 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.*

Considering that Brazil is a signatory to TRIPS, we should verify the converging and divergent points between it and the Lisbon Agreement and the Geneva Act, in order to understand what additional obligations Brazil would assume upon joining one of these.

The fundamental differences in the definition of Appellation of Origin and Geographical Indication that need to be highlighted are as follows:

## Sign

The appellation of origin provided for in the Lisbon Agreement necessarily refers to 'geographical names' of a state, region or locality. The TRIPS geographical indication is an 'indication' identifying a state, region or locality, and there is therefore no need for it to be necessarily geographical.

The Geneva Act is closer to TRIPS by allowing 'any denomination', 'consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area'.

LISBON AGREEMENT	TRIPS	GENEVA ACT
The appellation of origin necessarily refers to 'geographical names' of a state, region or locality.	The geographical indication is an 'indication' identifying a state, region or locality, and there is therefore no need for it to be necessarily geographical.	Any denomination consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area.

But this would not allow a name that lacks such a clear relationship, which is allowed in TRIPS.

## Product or service

### APPELLATION OF ORIGIN

In the English version, the Lisbon Agreement deals with the protection of a 'product', while TRIPS deals with the protection of a 'good'. However, in the other TRIPS language versions, such as French and Spanish, the translation results in a product, which means that both are supposed to be a product and that, in this context, its definition does not require minimum protection also for services – in the case of TRIPS – nor does it allow protection of services in the case of the Lisbon Agreement. The Geneva Act refers to this point in the Lisbon Agreement.

## GEOGRAPHICAL INDICATION

The definition of a geographical indication in the Geneva Act also speaks explicitly of a product, and therefore does not include the possibility of protection for a service GI.

## Reputation, quality or other characteristic

### APPELLATION OF ORIGIN

While the Lisbon Agreement stipulates that the product must have a quality or characteristic essentially attributable to the geographical environment, in the light of which the link becomes well known, TRIPS stipulates that the product must have a quality, a characteristic or a reputation related to its geographical origin. This makes the possibility of protection under TRIPS more flexible and broader, especially when it allows only reputation to suffice as a basis for a geographical indication. Thus, in principle TRIPS can encompass the Indication of Source, which requires only a relationship with its geographical origin. TRIPS also allows only one quality or characteristic, without renown, to serve as the basis for protection of a geographical indication, unlike the Lisbon Agreement.

This same need for the presence of reputation and qualities or characteristics was made even clearer in the Geneva Act.

## GEOGRAPHICAL INDICATION

The definition of Geographical Indication in the Geneva Act is quite close to TRIPS, as it also uses “or” to separate quality, reputation and characteristic. Thus, it could be understood that both the Act and TRIPS allowed a GI to have only one of these requirements present, provided that it is essentially derived from its geographical origin.

## Determining factors

### APPELLATION OF ORIGIN

While the Lisbon Agreement provides that such characteristics or qualities should be related to the geographical environment, including natural and human factors, TRIPS only provides that such elements should be essentially attributed to their geographical origin and does not require it to be broken down into the influence of natural and human factors on the product. The Geneva Act also includes all these determining factors.

## GEOGRAPHICAL INDICATION

The Geneva Act, like TRIPS, makes it more flexible by allowing only one of the determining factors to be present, provided that they stem essentially from their geographical origin.

Thus, with regard to the definition, we can see that the Geneva Act in particular incorporated into the definition of geographical indication that which is found in the TRIPS agreement, albeit it is still restrictive as regards the definition of appellation of origin.

However, other relevant points need to be compared to understand whether the Geneva Act would be more restrictive than TRIPS. And to achieve such understanding, this analysis will focus on the Geneva Act. It should be noted that the provisions related to registration have not been taken into account, as it is not the subject of the TRIPS agreement.

## Enforcement

TRIPS AGREEMENT	GENEVA ACT
<p><b>Art. 22</b></p> <p>2. In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:</p>	<p><b>Art. 11</b></p> <p>1. [Content of Protection] Subject to the provisions of this Act, in respect of a registered appellation of origin or a registered geographical indication, each Contracting Party shall provide the legal means to prevent:</p>
<p>(a) the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good;</p>	<p>(a) use of the appellation of origin or the geographical indication</p> <p>(i.) in respect of goods of the same kind as those to which the appellation of origin or the geographical indication applies, not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin or the geographical indication;</p>
	<p>(ii.) in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies or services, if such use would indicate or suggest a connection between those goods or services and the beneficiaries of the appellation of origin or the geographical indication, and would be likely to damage their interests, or, where applicable, because of the reputation of the appellation of origin or geographical indication in the Contracting Party concerned, such use would be likely to impair or dilute in an unfair manner, or take unfair advantage of, that reputation;</p>

TRIPS AGREEMENT	GENEVA ACT
	<p><b>Art. 15.</b></p> <p>Each Contracting Party shall make available effective legal remedies for the protection of registered appellations of origin and registered geographical indications and provide that legal proceedings for ensuring their protection may be brought by a public authority or by any interested party, whether a natural person or a legal entity and whether public or private, depending on its legal system and practice.</p>

Both agreements set forth that states parties shall establish legal means for interested parties to prevent third parties from misusing the GI/AO. TRIPS focuses on this in order to prevent people being misled as to the geographical origin of the product.

The Geneva Act is much more detailed. In addition to preventing the use of identical products, it also determines the need for mechanisms that prevent the connection or association of products or services with the IG/AO, aiming in all cases to avoid damage to reputation or prevent them from taking advantage of the reputation of the IG/AO.

Art. 15 is quite precise when it establishes the need for the state party to provide effective legal remedies for protection, and mentions, though it does not oblige, that this allows the public authority to ensure protection.

## Unfair competition

ACORDO TRIPS	ATO DE GENEBRA
<p><b>Art. 22</b></p> <p>2. In respect of geographical indications, Members shall provide the legal means for interested parties to prevent:</p> <p>(b) any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967).</p>	

In this item, only TRIPS makes express mention that the State Party to the Agreement must establish legal means to prevent acts of unfair competition by making express mention of the PC. The Geneva Act does not mention it.



## Misleading

TRIPS AGREEMENT	GENEVA ACT
<p><b>Art. 22</b></p> <p>4. The protection under paragraphs 1, 2 and 3 shall be applicable against a geographical indication which, although literally true as to the territory, region or locality in which the goods originate, falsely represents to the public that the goods originate in another territory.</p>	<p><b>Art. 11</b></p> <p>1. [Content of Protection] Subject to the provisions of this Act, in respect of a registered appellation of origin or a registered geographical indication, each Contracting Party shall provide the legal means to prevent:</p> <p>(b) any other practice liable to mislead consumers as to the true origin, provenance or nature of the goods.</p>

Both agreements mention the need for a legal rule to avoid misleading, either with regard to the origin of the product, the nature of the product, or giving the consumer or the public the false idea that the product originates from another territory.

## Trademark

TRIPS AGREEMENT	GENEVA ACT
<p><b>Art. 22</b></p> <p>3. A Member shall, <i>ex officio</i> if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark for such goods in that Member is of such a nature as to mislead the public as to the true place of origin.</p>	<p><b>Art. 11</b></p> <p>3. [Use in a Trademark] Without prejudice to Article 13(1), a Contracting Party shall, <i>ex officio</i> if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a later trademark if use of the trademark would result in one of the situations covered by paragraph (1).</p>
<p><b>Art. 23</b></p> <p>2. The registration of a trademark for wines which contains or consists of a geographical indication identifying wines or for spirits which contains or consists of a geographical indication identifying spirits shall be refused or invalidated, <i>ex officio</i> if a Member's legislation so permits or at the request of an interested party, with respect to such wines or spirits not having this origin.</p>	

TRIPS AGREEMENT	GENEVA ACT
<p>Art. 24</p> <p>7. A Member may provide that any request made under this Section in connection with the use or registration of a trademark must be presented within five years after the adverse use of the protected indication has become generally known in that Member or after the date of registration of the trademark in that Member provided that the trademark has been published by that date, if such date is earlier than the date on which the adverse use became generally known in that Member, provided that the geographical indication is not used or registered in bad faith.</p>	
	<p>Art. 13</p> <p>4. [Safeguards in the Case of Notification of Withdrawal of Refusal or a Grant of Protection] Where a Contracting Party that has refused the effects of an international registration under Article 15 on the ground of use under a prior trademark or other right, as referred to in this Article, notifies the withdrawal of that refusal under Article 16 or a grant of protection under Article 18, the resulting protection of the appellation of origin or geographical indication shall not prejudice that right or its use, unless the protection was granted following the cancellation, non-renewal, revocation or invalidation of the right.</p>

Article 22, item 3 of TRIPS lays down the refusal or invalidity of a trademark containing a geographical indication, but this provision is not absolute. This is because Art. 24, item 7, authorises the Member State to limit to five years the period during which the incorrect use of a GI as a trademark may be challenged, counting from the moment when the use of the protected indication became generally known, or from the moment of the Grandfather Clause.

This reservation does not apply only in cases of bad faith, a situation in which questioning can occur at any time.

On the other hand, TRIPS is more rigid when it comes to a trademark that is related to wines and spirits. And in this case it could be invalidated *ex officio*.

The Geneva Act, on the other hand, seems to be tougher for all products when determining – if domestic law allows – the refusal or annulment, *ex officio* or at the request of an interested party, of a trademark relating to any GI.

It remains to be seen what the scope of this determination is when considering domestic law. It also provides for the possibility of withdrawing a refusal to register a GI if what prevented registration – an earlier trademark – no longer prevents it.

## Trademark registration exception

TRIPS AGREEMENT	GENEVA ACT
<p>Art. 24</p> <p>5. Where a trademark has been applied for or registered in good faith, or where rights to a trademark have been acquired through use in good faith either: (a) before the date of application of these provisions in that Member as defined in Part VI; or</p> <p>(b) before the geographical indication is protected in its country of origin;</p> <p>measures adopted to implement this Section shall not prejudice eligibility for or the validity of the registration of a trademark, or the right to use a trademark, on the basis that such a trademark is identical with, or similar to, a geographical indication.</p>	<p>Art. 13</p> <p>1. [Prior Trademark Rights] The provisions of this Act shall not prejudice a prior trademark applied for or registered in good faith, or acquired through use in good faith, in a Contracting Party. Where the law of a Contracting Party provides a limited exception to the rights conferred by a trademark to the effect that such a prior trademark in certain circumstances may not entitle its owner to prevent a registered appellation of origin or geographical indication from being granted protection or used in that Contracting Party, protection of the registered appellation of origin or geographical indication shall not limit the rights conferred by that trademark in any other way.</p>

Article 24(5) of TRIPS provides that a trademark applied for or registered, whether identical or similar to a geographical indication, shall not be invalidated or refused if it has been used in good faith, or where the rights in respect of that trademark have been acquired in good faith, if this occurred before the date the protection established by TRIPS in its Part VI was applied. This provision caused many doubts concerning the way the trademark is applied. This is the so-called “grandfather clause” or “sins of the past”, which allows the continued use of a right if it was acquired in good faith.

Furthermore, the said clause allows a right of use and a validity of the registration of the trademark, but not an exclusive right to it. This Article does not require a geographical indication to be protected if an equal or similar trademark has been registered in good faith. However, if this is the case, the coexistence of the registered trademark with this new protection for the foreign geographical indication is automatically presumed.

In any case, such coexistence must not mislead the public or be characterised as unfair competition.

Lastly, this provision should apply to both the general and the special protection arrangements, i.e. also to wines and spirits, since there is no reservation to the contrary.

The Geneva Act preserves this provision and also opens the possibility for the State Party to establish internally that a previously registered trademark may prevent the registration of a geographical indication. Moreover, it provides that subsequent registration of a GI may not prevent or restrict the rights of the owner of the trademark.

## Use of a qualifying expression

TRIPS AGREEMENT	GENEVA ACT
<p>Art. 23</p> <p>1. Each Member shall provide the legal means for interested parties to prevent use of a geographical indication identifying wines for wines not originating in the place indicated by the geographical indication in question or identifying spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.</p>	<p>Art. 11</p> <p>2. [Content of Protection in Respect of Certain Uses] Paragraph (1)(a) shall also apply to use of the appellation of origin or geographical indication amounting to its imitation, even if the true origin of the goods is indicated, or if the appellation of origin or the geographical indication is used in translated form or is accompanied by terms such as 'style', 'kind', 'type', 'make', 'imitation', 'method', 'as produced in', 'like', 'similar' or the like (1).</p> <p>Agreed Statement concerning Article 11(2): For the purposes of this Act, it is understood that where certain elements of the denomination or indication constituting the appellation of origin or geographical indication have a generic character in the Contracting Party of Origin, their protection under this paragraph shall not be required in the other Contracting Parties. For greater certainty, a refusal or invalidation of a trademark, or a finding of infringement, in the Contracting Parties under the terms of Article 11 cannot be based on the component that has a generic character.</p>

In the case of qualifying expressions, while TRIPS sets forth the impossibility of using terms such as "type" only for wine GIs, if they are not from the geographical area, the Geneva Act extends this to all products. This is one of the clauses that can be regarded as "TRIPS plus" in relation to what the Geneva Act proposes. In addition to the impossibility of qualifying expressions, even if the true origin is stressed, the Act also prevents the use of translations.

## Homonym

TRIPS AGREEMENT	GENEVA ACT
<p>Art. 23</p> <p>3. In the case of homonymous geographical indications for wines, protection shall be accorded to each indication, subject to the provisions of paragraph 4 of Art. 22. Each Member shall determine the practical conditions under which the homonymous indications in question will be differentiated from each other, taking into account the need to ensure equitable treatment of the producers concerned and that consumers are not misled.</p>	

There is no specific provision in the Geneva Act on the possibility of coexistence between homonymous GI, which in TRIPS is only laid down concerning wines.

## Non-retrospective protection and relationship to other agreements

TRIPS AGREEMENT	GENEVA ACT
<p>Art. 24</p> <p>3. In implementing this Section, a Member shall not diminish the protection of geographical indications that existed in that Member immediately prior to the date of entry into force of the WTO Agreement.</p>	<p>Art. 11</p> <p>Art. 10 - 3. [Relation to Other Instruments] Nothing in this Act shall derogate from any obligations that Contracting Parties have to each other under any other international instruments, nor shall it prejudice any rights that a Contracting Party has under any other international instruments.</p>
	<p>Art. 10</p> <p>2. [Protection Under Other Instruments] The provisions of this Act shall not in any way affect any other protection a Contracting Party may accord in respect of registered appellations of origin or registered geographical indications under its national or regional legislation, or under other international instruments.</p>

Article 24, item 3 of TRIPS is clear in stating that no Member State may reduce the protection for geographical indications it has granted before the entry into force of the WTO Agreement.

The Geneva Act likewise sets forth that no provision of the agreement would derogate from any obligations between the parties or other protection that a party has already conferred through its domestic law or other international instruments. And in this case one could think of not derogating from the provisions, for example, in the Mercosur – European Union Agreement concerning GI, if and when it enters into force.

## Homonym

TRIPS AGREEMENT	GENEVA ACT
<p>Art. 24</p> <p>4. 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.</p>	
	<p>Art. 17</p> <p>1. [Option to Grant Transitional Period] Without prejudice to Article 13, where a Contracting Party has not refused the effects of an international registration on the ground of prior use by a third party or has withdrawn such refusal or has notified a grant of protection, it may, if its legislation so permits, grant a defined period as specified in the Regulations, for terminating such use.</p>

This provision laid down in TRIPS is an exception, and must be applied for the whole section, including general protection (Art. 22) and special protection (Art. 23), although its focus is on wines and spirits. Art. 24, item 4, sets forth that no Member State is obliged to avoid the continued and similar use of a geographical indication of another Member State, in particular for wines and spirits, if one of its nationals or domiciliaries have used it continuously, by the same person for the same goods, for at least 10 years before 15 April 1994 or in good faith before that date.

There is no similar provision in the Geneva Act, which only provides that the State Party may give a transitional period to cease the use of the GI or AO that has been requested, if it has not considered the term of use generic as laid down in Art. 12 of the Act.

## Common use or generic term

ACORDO TRIPS	ATO DE GENEBRA
<p>Art. 24</p> <p>6. Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which 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.</p>	<p>Art. 12</p> <p>Subject to the provisions of this Act, registered appellations of origin and registered geographical indications cannot be considered to have become generic (2) in a Contracting Party.</p> <p>Agreed Statement concerning Article 12: For the purposes of this Act, it is understood that Article 12 is without prejudice to the application of the provisions of this Act concerning prior use, as, prior to international registration, the denomination or indication constituting the appellation of origin or geographical indication may already, in whole or in part, be generic in a Contracting Party other than the Contracting Party of Origin, for example, because the denomination or indication, or part of it, is identical with a term customary in common language as the common name of a good or service in such Contracting Party, or is identical with the customary name of a grape variety in such Contracting Party.</p>
<p>Art. 24</p> <p>6. Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to products of the vine for which the relevant indication is identical with the customary name of a grape variety existing in the territory of that Member as of the date of entry into force of the WTO Agreement.</p>	<p>Art. 13</p> <p>3. [Rights Based on a Plant Variety or Animal Breed Denomination] The provisions of this Act shall not prejudice the right of any person to use a plant variety or animal breed denomination in the course of trade, except where such plant variety or animal breed denomination is used in such a manner as to mislead the public.</p>

The generic denomination, common or vulgar name has a denomination that is no longer distinctive but has become descriptive of a particular good.

In this regard, Art. 24, item 6 of TRIPS provides that there is no obligation to protect, under Articles 22 to 24, an indication which, although representing a GI in another Member State, is an indication identical to the usual term in common language, used as a customary name for the same goods and services in the territory of the Member State.

The Geneva Act establishes as a general rule that a registered GI cannot become a generic term or one of common usage. However, if, in the country where the GI is registered, the term is already in general use, it is stated that registration may be refused, especially on the basis of the explanatory note.

More specifically, the second part of item 6 of Art. 24 of TRIPS provides that, in relation to products of the vine, if there is an indication which is constituted by a geographical indication in one Member State, and if it is used as the customary name for a grape variety in another Member State, at the date of entry into force of the WTO Agreement, that other State is not obliged to protect it as a geographical indication and may continue to use it as a grape variety.

Art. 13.3 of the Geneva Act is not as clear as TRIPS. It says that the denomination of a plant variety or animal breed may continue to be used, unless this misleads the consumer. It would therefore appear that they could be registered.

## Common use or generic term

TRIPS AGREEMENT	GENEVA ACT
<p>Art. 24</p> <p>8. The provisions of this Section shall in no way prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.</p>	<p>Art. 13</p> <p>2. [Personal Name Used in Business] The provisions of this Act shall not prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.</p>

Article 24, item 8 of TRIPS recognises the right of a person to use his or her predecessor's name in business, unless such use is for the purpose of misleading the public. That purpose should be assessed on the basis of the intention of the person who intends to use that name, since the aim is to protect the public.

This provision is also found in the Geneva Act, which sets forth that this will not be allowed if it misleads the public.



## Protection and cancellation period

TRIPS AGREEMENT	GENEVA ACT
<p>Art. 8</p> <p>1. [Dependency] International registrations shall be valid indefinitely, on the understanding that the protection of a registered appellation of origin or geographical indication shall no longer be required if the denomination constituting the appellation of origin, or the indication constituting the geographical indication, is no longer protected in the Contracting Party of Origin.</p>	<p>Art. 8</p> <p>2 [Cancellation]</p> <p>(a) The Competent Authority of the Contracting Party of Origin, or, in the case of Article 5(3), the beneficiaries or the natural person or legal entity referred to in Article 5(2) (ii) or the Competent Authority of the Contracting Party of Origin, may at any time request the International Bureau to cancel the international registration concerned.</p> <p>(b) In case the denomination constituting a registered appellation of origin, or the indication constituting a registered geographical indication, is no longer protected in the Contracting Party of Origin, the Competent Authority of the Contracting Party of Origin shall request cancellation of the international registration.</p>

The Geneva Act establishes as a rule the indefinite term of protection of GIs, as well as the possible cancellation of registration and the need for the State Party to communicate the cancellation. TRIPS does not deal with these points, and does not even provide for compulsory registration.

## Non-protection

TRIPS AGREEMENT	GENEVA ACT
<p>Art. 24</p> <p>9. There shall be no obligation under this Agreement to protect geographical indications which are not or cease to be protected in their country of origin, or which have fallen into disuse in that country.</p>	<p>Art. 8</p> <p>1. [Dependency] International registrations shall be valid indefinitely, on the understanding that the protection of a registered appellation of origin or geographical indication shall no longer be required if the denomination constituting the appellation of origin, or the indication constituting the geographical indication, is no longer protected in the Contracting Party of Origin.</p>

The last exception, provided for in Art. 24, item 9 of TRIPS, refers to the lack of obligation to protect geographical indications that are not protected in the country of origin, that have ceased to be protected or even that have fallen into the public domain in their countries of origin. Something equivalent is to be found in the Geneva Act in Art. 8, 1.

In summary, considering the comparative analysis made between the agreements, it appears that in general the Geneva Act is more protective than TRIPS for GI/AO, and can therefore be more restrictive in what it allows as authorised uses by third parties.

# 4. Comparison between Mercosur - EU Agreement and Geneva/Lisbon

When making a comparison between what was negotiated in the Mercosur - European Union Agreement and what is set forth in the Geneva Act, some points can be raised.

On the one hand, both contain similar provisions, which means that Brazil will have to adapt to these points regardless of whether it accedes to the Geneva Act, but there are also points of difference, which may provide reasons for whether or not to accede.

## GI Recognition

In both Agreements a preliminary procedure is established for analysing and protecting existing GI. There is also a procedure for the addition of new GI (Art. XX-34 MEUA). However, in the Geneva Act this procedure is clearer.

## Enforcement

The EU-Mercosur Agreement states that:

"The Parties shall provide the legal means for interested parties to seek enforcement of the protection provided for in Articles X.35 via appropriate administrative action by public authorities and via judicial steps, within their own legal system and practise. (Art. XX-37 MEUA). This point is similar to the provisions of Art. 15 of the Geneva Agreement.

Both agreements set forth that states parties shall establish legal means for interested parties to prevent third parties from misusing the GI/AO.

And the Mercosur-EU Agreement further adds that there must be appropriate means for controlling the import, export and marketing of products that have names corresponding to those of the GI protected in the Agreement (Art. XX-38 MEUA).

## Misleading and Unfair Competition

The Mercosur-EU Agreement prohibits:

- The use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin, in a manner which misleads the public.
- Any act which constitutes an act of unfair competition within the meaning of PC Art. 10bis (Art. XX-35, 1 MEUA).
- any direct or indirect commercial use of a protected name or that exploits the reputation of a GI (Art. XX-35, 2, a MEUA), besides any misuse, imitation, or practices used to deceive the consumer (Art. XX-35, 2, c MEUA).

Article 11.1 of the Geneva Act only focuses on preventing any other practice that may mislead the consumer as to the true origin, provenance or nature of the goods, and does not specifically mention the issue of unfair competition.

## Qualifying expression (type, method, imitation)

The Mercosur - EU Agreement establishes the impossibility of using a qualifying expression, even if the true origin is highlighted, or even if the use is of a translation of the name (Art. XX-35, 2, b MEUA). The same mechanism is provided for in Art. 11-2 of the Geneva Act, including if the expression is translated.

## Trademarks x GI

With regard to the conflict between trademarks and GI, the MERCOSUR-EU Agreement sets forth that the member must refuse, reject or annul trademarks containing GI for product, including similar ones, if the application for registration is after the recognition of GI in the country. (Art. XX-35, 3, a MEUA).

For already recognised GIs this should be considered from the entry into force of the Agreement. And for trademarks, the date that counts is from publication for opposition – and not the date of filing (Art. XX-35, 3, b MEUA).

In the case of new GI to be recognised, according to Art. 34, the date of transmission of the application to the Member is what counts, so that new trademarks can no longer be registered. (Art. XX-35, 3, c MEUA)

In the Geneva Act, Art. 11 -3, there is also the provision of the obligation to refuse a later trademark, if a GI was previously registered. But there is no caveat that this is only for

similar products, which suggests that refusal for new trademarks would be for all classes in the Nice Agreement.

With regard to the precedence of trademarks, the MERCOSUR - EU Agreement sets forth that the parties must protect GI even if there are prior trademarks. These trademarks can be used, renewed and new variations can be protected. But neither the GI nor the trademarks can be used in such a way that they can mislead the consumer (Art. XX-35, 3, d MEUA).

In the Geneva Act, an earlier trademark may be grounds for refusal of a GI (Art. 13-1 GA). In the MERCOSUR-EU Agreement, however, the parties are not obliged to protect a GI if there is already a famous, reputable trademark, and this leads to confusion. (Art. XX-35, 3, e MEUA).

## Animal Breed and Plant Variety

The EU-MERCOSUR Agreement stipulates that nothing shall prevent a party from using customary names for an animal breed or plant variety if it existed in the country before the entry into force of the Agreement. (art. XX-35, 4 MEUA). Likewise the Geneva Act (Art. 13. - 3 GA), allows such coexistence.

## Homonyms

With regard to homonymous names, the MERCOSUR-EU agreement states that if there is a GI for products of the same category, according to the Nice classification, they can coexist, provided that it does not mislead the consumer (Art. XX-35, 8, a MEUA). There is no provision for homonyms in the Geneva Act.

## Particular cases

The EU-MERCOSUR Agreement also sets forth differentiated treatments for particular cases, which refer to the use of good faith with specific provisions (Gorgonzola, Grana, Gruyère, Fontina, Parmesan, Steinhäger, Jeneva, Queso Manchego, Grappa) as laid down in Art. XX-35, 9 MEUA. There is no such provision in the Geneva Act.

## Name

The EU-MERCOSUR Agreement stipulates that the name of the person or that person's predecessors may continue to be used, including for commercial purposes, if it conflicts with a GI, unless it misleads the public (Art. XX-35, 12 MEUA). Art. 13-2 of the Geneva Act contains a similar provision.

## Common name

The EU-MERCOSUR Agreement sets forth that nothing shall prevent a party from using terms that are a common name associated with the good in the country. (Art. XX-35, 5 MEUA). It also sets forth that the Party shall not be required to register a name that is in common use associated with the product in the Country. (Art. XX-35, 6 MEUA). If a translation is identical to a GI or is known as the common name of the product, the Agreement may not prejudice any person's right to use that term associated with the product (Art. XX-35, 7 MEUA). There is no specific provision for this in the Geneva Act.

## Generic GI

For GI that can become generic, the Mercosur - EU Agreement sets forth that GI that have been recognised under the agreement cannot become generic (Art. XX-35, 10 MEUA). Art. 12 of the Geneva Act contains a similar provision.

## No longer protected GI and protection period

The EU-MERCOSUR Agreement sets forth that there is no obligation to protect GI which are not or cease to be protected in their place of origin (Art. XX-35, 11 MEUA). Art. 8-1 of the Geneva Act contains a similar provision.

The EU-MERCOSUR Agreement does not talk about a protection period or a need for renewal. The Geneva Act sets forth in Art. 8-1 that entries in the international register are valid indefinitely.

## Types of products that may be covered

Certainly the most striking point is the impossibility of protection in the Mercosur-EU agreement for non-agricultural foodstuffs products (Art. XX-33 item 5 and Art. XX-36 MEUA). Under the Geneva Act, there is no such restriction and protection is in accordance with the national law of each signatory country; therefore, there is the possibility of protecting non-agricultural foodstuffs products in the countries which have such protection.

## Services GI

Neither provide protection for service GI, according to Art. XX-33, 5, MEUA and Art. 2 GA.

In summary, we may conclude that there are many similarities between the agreements, except for the fact that the Geneva Act does not prohibit the protection of GI for non-agricultural foodstuffs products (except for services GI).

What we see is that, after the entry into force – if and when that happens – of the Mercosur - European Union Agreement, little more will be needed for Brazil to accede to the Geneva Act, because the level of protection will have been raised by the former. On the other hand, as long as the Mercosur - European Union Agreement does not enter into force, the changes needed to accede to the Geneva Act will be considerable. Furthermore, Brazil's margin for negotiation vis-à-vis the European Union (in relation to the MEUA) will be small if accession to the Geneva Act precedes the MEUA.

# 5. Brazilian experience of the Madrid Protocol for trademarks

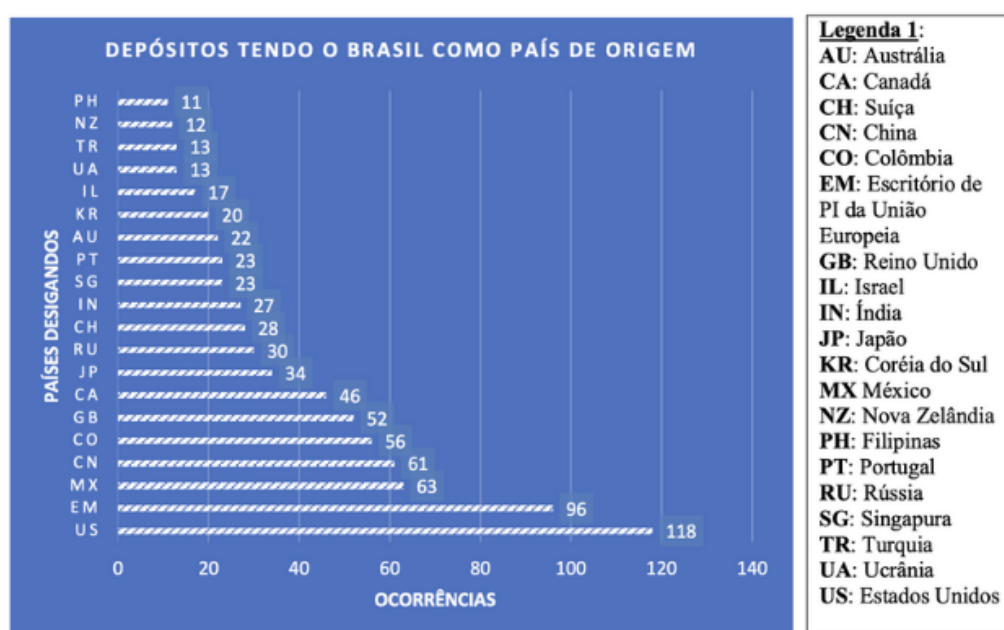
A Master's dissertation entitled 'ANALYSIS OF BRAZILIANS' USE OF THE MADRID PROTOCOL', written by Rosângela Pacheco Barros, who defended it in March 2023, focused on understanding how Brazilians were using the said instrument to register trademarks in other countries. It confirmed, through research carried out on the WIPO's Madrid Monitor platform, that between the implementation of the Madrid Protocol in Brazil, 02/10/2019 and 01/09/2021, Brazil was designated in 18,763 international registrations, but only 204 Brazilian depositors used the Protocol.

These figures demonstrate that the use by Brazilians of the Madrid Protocol was significantly lower than the use made by nationals of other member countries.

The United States had the most foreign filers and was the main country designated by Brazilians.

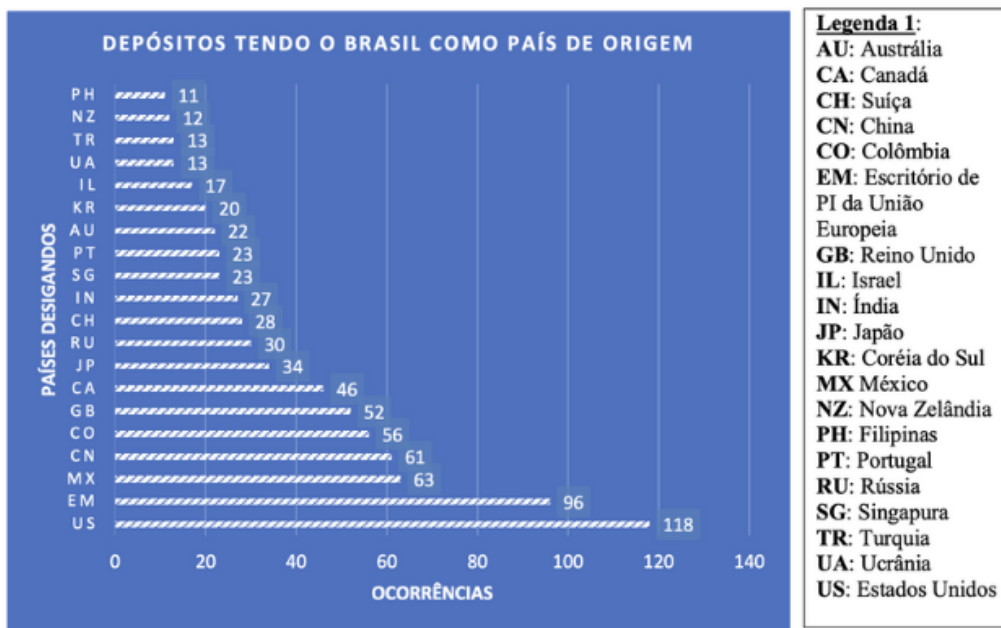
The graphs below detail the countries in which Brazil has made the most registrations and the countries from which the registrations made in Brazil originated.

**Gráfico 2 - Número de depósitos realizados pelo Protocolo de Madri tendo o Brasil como países de origem**



Fonte: Barros, 2023

**Gráfico 3** - Número de depósitos realizados pelo Protocolo de Madri tendo o Brasil como país designado



Fonte: Barros, 2023

This study found that Brazilians who seek protection of their trademarks in other countries rarely use the Madrid Protocol system.

In order to understand this low use, the study showed some probable reasons pointed out by Brazilian entrepreneurs, and among them highlighted that: a proportion of these have no interest in protecting their trademarks in the international market, and also lack of knowledge about the existence, characteristics and functioning of this international trademark system.

Thus, it appears that, on the part of the users of the system, the lack of interest in the international market or the unawareness of the functioning of the Madrid Protocol may be possible reasons for its use (BARROS, 2023).

The study also sought information from intellectual property offices, to understand whether these, by aiding in the use of the Madrid Protocol, had also identified other situations that led to low adherence. The offices found that generally this system is not financially advantageous in relation to fees and that there are high costs arising from the need to present a Notice of Opposition or Central Attack that remove any advantage from using the Madrid Protocol (BARROS, 2023).

Thus, these points end up discouraging offices from presenting this alternative to customers.

The research also identified situations related to Opposition, Central Attack, Appeal and their notices are among the rules that most need to be improved; in other words,



there could be facilitation in the use of the Madrid Protocol (BARROS, 2023). For more information on “Central Attack”, consult Art. 6, of the Madrid Protocol.

On the other hand, the study also drew other conclusions that confirmed the understanding of the literature:

<b>Przygoda (2019)</b>	in the sense that the Madrid Protocol is the cheapest option for trademark protection in other countries, and that Central Attack is seen as one of the main disadvantages of the Madrid Protocol and that this should be subject to regulatory improvements by WIPO
<b>Ballagh (2020)</b>	in the sense that the Madrid Protocol becomes cheaper when used to protect trademarks in more than three countries
<b>Bellé and Cadore (2019)</b>	in the sense that companies become more interested in protecting their trademarks after becoming more “consolidated” in the market

These data are interesting to make a comparison with the possible accession to the Geneva Act of the Lisbon Agreement and possible points that can be identified:

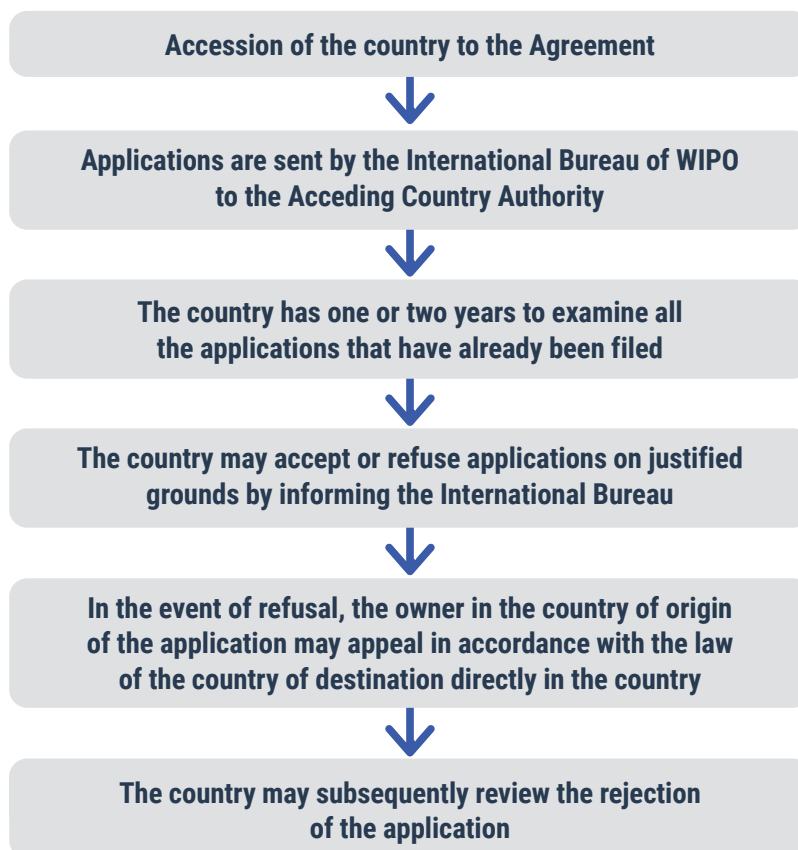
<b>1</b>	Compared to what happened with the Madrid Protocol, there may be a possible low adherence of Brazilian GI and a significant increase of foreign applications to be analysed by the National Institute of Intellectual Property (NIIP), and this would impact the analyses of the applications in Brazil;
<b>2</b>	One difference: while under the Madrid Protocol a fee is payable for each designated country, under the Lisbon Agreement a single fee is payable for registration in all countries, and an additional fee may be charged by some countries;
<b>3</b>	An approximation between the two agreements: in both cases, if there is a notice or rejection, it will be necessary to respond to them individually in view of the laws and system of each of the Member States. And this can substantially increase the costs of registration;
<b>4</b>	Interest in the international market: if there are no buyers in the destination markets and there is no internationalisation of the company or GI, registration abroad will have little value. In fact, few Brazilian GI have sought recognition abroad, and the only success in the European Union up to the present date is Vale dos Vinhedos. In view of this, we may question whether the existence of the Agreement would encourage more registrations or whether there would indeed be interest in GI, which will be discussed in a specific item;
<b>5</b>	Like the Madrid Protocol, the Lisbon Agreement may also be subject to ignorance about the external registration mechanism.

# 6. NIIP Administrative Challenges

## Challenge to examine the number of applications after accession to the Agreement

Upon accession to the Agreement, all applications will be filed and the country will have 1 year (it may have 1 year longer, thus totalling 2 years, if explicitly requested in the negotiation) to accept or reject international requests already filed under the Geneva Act (Article 29.4 of the Geneva Act and Article 9.1 of the Common Regulation). Those that are not expressly refused during this period will be considered accepted.

### Flow of applications after accession to the Agreement



After this initial phase, new applications may be filed and received by the member countries as per the flow below.

## Flow of new GI/Appellation of Origin (AO) applications



## Increased internal IG demand and growing backlog in the trademark department

The NIIP has been experiencing a growing demand in both the analysis of trademarks and Geographical Indications. Added to this, the 10-year period without holding a public entrance exam has caused a significant reduction in the number of researchers and GI analysts.

In order to get around the staff shortage, the Ministry of Development, Industry, Trade and Services announced on its official Twitter account (@MDICOoficial) on 16-06-2023, that the Federal Government authorised a public entrance exam with 120 vacancies for the NIIP, as shown in the image below:



According to a report published on the NIIP website, on 12 June 2023, the interim president of the Institute met with the Minister of Development, Industry, Trade and Services to discuss the following issues: *statistics on the examination of trademarks and patents, expansion of the Institute's 2023 budget, advances in the application for a public tender and bills that strengthen the NIIPs budget.* (<https://www.gov.br/inpi/pt-br/central-de-conteudo/noticias/presidente-interino-do-inpi-se-reuniu-com-o-ministro-geraldalckmin>). It is appropriate to note that any accession to the Lisbon/Geneva Act Agreement will only achieve quantitative and qualitative gains related to the aforementioned agreement if the staffing needs arising from accession to the international agreement are also addressed.

## Meetings with the NIIP

In contact with the NIIP through online meetings held in May and August 2023, the **Researcher and Technologist in Industrial Property**, André Tibau, was concerned about the idea that adherence to the Lisbon Agreement/Geneva Act could take place in the short term. The civil servant pointed to the following points as the main reasons for the need for caution in the possible referrals following accession to the agreement.

Firstly, the researcher said that the issue of NIIP staff is an important concern; moreover, it is not possible to quantify the necessary effort in terms of human resources without understanding what the post-accession guidelines will be. Tibau pointed out that there are two possible paths.

On the one hand, given the need for applications for registration of GI via the Lisbon System to be examined within 12 months by the NIIP, compared with the average examination time for a GI application that is 20 months, it may be necessary to create an “exclusive queue” for GI, separate from the one that encompasses applications for registration filed via the ordinary registration procedure with the NIIP; which would not necessarily be ideal. The other option would be for international requests that are received to enjoy some kind of priority so that it is possible to dispatch them within the agreed 12-month deadline, in the existing queue, which also cannot be said to be a preferred scenario.

Tibau points out that the 12-month period is incompatible with the current routine of the NIIP, unless there is unequal treatment with the national processes, i.e. if the examination made by the INPI of the requests sent via the Lisbon System is not as judicious as the examination of the requests carried out according to the current norm of registration of GI in Brazil, as in fact appears to be the process described by the Regulation of the Agreement, without the guarantees of Law 9279/1996 and Ordinance\_INPI\_PR 4 of 12 January 2022, such as: 'Does the applicant have standing to request a registration of GI in Brazil?' 'Has control of production been done?' 'Is there a Technical Specification or similar document that provides all the parameters required for a national register in Brazil?' 'Lisbon and Geneva do not require this!'

The NIIP researcher pointed to other issues such as possible incompatibilities of the agreement with the current legislation: 'Will we accept a GI that is not a geographical name, for example?'

In the international system of Madrid, in fact, the merits of the trademarks are analysed before Brazilian legislation. In the case of Lisbon, with the current legislation, it does not seem possible to do this without rejecting all or most of the requests. Not to mention that the planned price for the registration of Brazilian GI through the agreement (CHF 1000.00) is very high, considering that BRL 590.00 for the national IP request protocol is already a price that some associations find hard to pay.

In short, the technologist believes that, at first sight, **“before joining Lisbon, it seems necessary to reflect on a possible alteration and adaptation of the national legislation on this topic, in order to adapt it to the requirements of the treaty”**.

# 7. Estimated quantity of applications that will be received in Brazil

The Lisbon System for the International Registration of Appellations of Origin and Geographical Indications offers a simplified means for the protection of a geographical indication or an appellation of origin. Through a single registration procedure and a set of charges, protection can be obtained in several countries (and in international organisations such as the European Union) covered by the Lisbon system. ([https://www.wipo.int/ip-outreach/pt/ipday/2021/toptips/lisbon\\_system.html](https://www.wipo.int/ip-outreach/pt/ipday/2021/toptips/lisbon_system.html))

Also according to the WIPO International Portal, in order to become a signatory of the Lisbon Agreement and/or the Geneva Act, an instrument of ratification of or access to the agreement and/or act must be filed with WIPO through its Director General. Membership becomes effective 3 months after the Director General of WIPO has notified the other Member States. See example access document at [https://www.wipo.int/export/sites/www/lisbon/en/docs/lisbon\\_2022\\_4.pdf](https://www.wipo.int/export/sites/www/lisbon/en/docs/lisbon_2022_4.pdf) for the Czech Republic.

The application shall be filed with the WIPO International Bureau using the official form and shall be signed by the competent authority which is submitting the application. Beneficiaries or their representatives must address their requests to the competent authority (NIIP, in this case). After preliminary verification, the competent authority can then submit to WIPO, which becomes the focal point for all types of GI communication (e.g. refusals, registrations, etc.). Under the Geneva Act, contracting countries can also use a specific declaration to authorise beneficiaries to file applications directly with WIPO without the intermediation of the competent authority (PIIP in this case). This option is called "direct filing".

The application form for international registration as well as other important forms can be viewed at <https://www.wipo.int/lisbon/en/forms/>.

Through the Lisbon Agreement/Geneva Act, 1260 applications were filed up to 16/05/23. Of these, 207 were cancelled, 639 were refused by a country and 242 were granted.

**1,260**  
Applications filed



**207**

CANCELLED



**242**

GRANTED



**639**

A REFUSAL

Some countries refuse international registrations due to the existence of trademarks that could conflict with GI registrations, such as the AO 1003 application of IG EMILIA / DELL'EMILIA, sent by Italy, which was refused by Costa Rica, due to the existence of the previous registration of the Emilia trademark. Mexico rejected the registration requested by Peru (AO 893), due to the pre-existence of the 'CAFÉ VILLA RICA' trademark. As will be explained in a specific section, Law 9279/1996 is silent on the subject and the general rule has been that Brazil does not prevent the registration of a GI due to the existence of a trademark prior to the application.

Other countries have refused because the application contravenes some internal rules, such as Iran's rules on designations of origin for alcoholic beverages, which are banned in the country.

The absence of a support tool for international registration, such as the Lisbon Agreement, has not been an obstacle for some Brazilian GI to seek recognition outside the country. Through individual filings, the Vale dos Vinhedos and Camarão da Costa Negra GI are examples of attempts at recognition in other jurisdictions. So far, only Vale dos Vinhedos has obtained registration abroad for their wines, specifically in the European Union. Camarão da Costa Negra made an attempt, but still without success. Related documents can be viewed on the following page.

**Figura 3 - Lista de indicações geográficas de vinhos de países terceiros**

Designação geográfica	Disposição do país terceiro	Publicação do país terceiro
Vale dos Vinhedos	Decreto-Lei n.º 1355 de 30.12.1994 Lei de Propriedade Industrial n.º 9279 de 14.5.1996 Resolução do Instituto Nacional da Propriedade Industrial n.º 75/2000 Registo da indicação geográfica n.º IG 200002	22.11.2002



EUROPEAN COMMISSION  
DIRECTORATE-GENERAL FOR AGRICULTURE AND RURAL DEVELOPMENT  
Directorate F – Outreach, Research & Geographical Indications  
The Director

Brussels  
AGRI.F.3/ESP agri.f.3(2023)3988842

**Subject: "Camarão da Costa Negra" (BR-PDO-0005-0991)  
Application for registration of the name pursuant to  
Regulation (EU) No 1151/2012 of the European Parliament and of the  
Council on quality schemes for agricultural products and foodstuffs**

Dear Madam,

Having completed our scrutiny pursuant to Article 50(1) of Regulation (EU) No 1151/2012, of the application referred to above, we conclude that the application does not fulfil the requirements under the Regulation.

Please find annexed to this letter the grounds on which we base this finding.

A letter requesting further clarifications was sent on to you on 23 July 2014 and 9 March 2020, addressed to Ms. Ana Soeiro, Secretária Geral da QUALIFICA, who was acting as a contact person of the applicant group (Associação dos carcinicultores da Costa Negra – ACCN) vis-à-vis the European Commission.

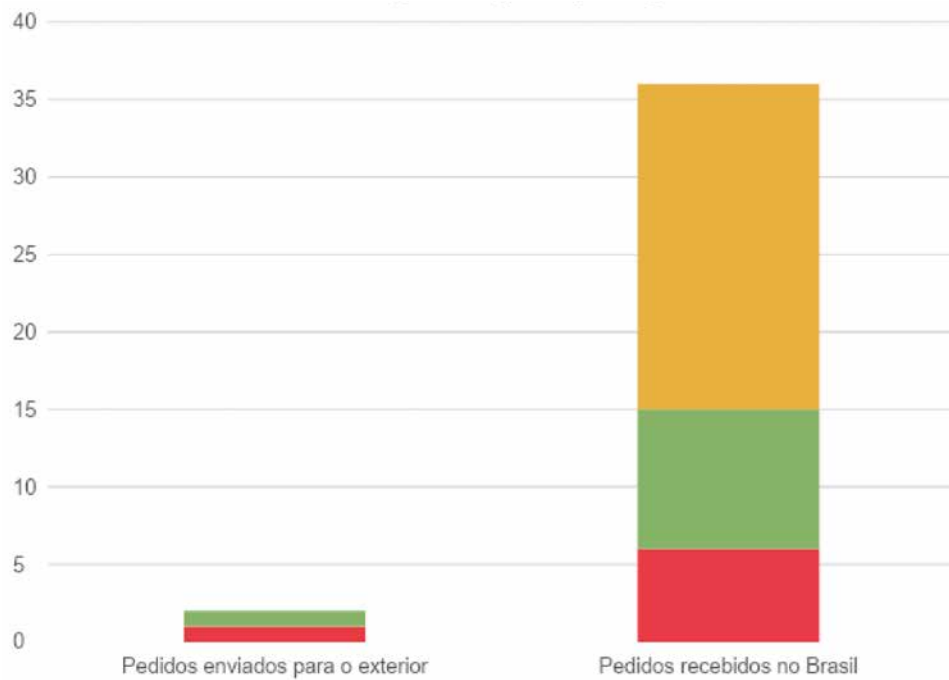
We have not received a reply to our questions, nor a revised version of the single document. In these circumstances DG AGRI will launch the procedure for the adoption of a formal Commission decision rejecting your application pursuant to Article 52(1) of Regulation (EU) No. 1151/2012 if we receive no further reaction from your services within two months of receipt of this letter.

We would also like to inform your services of the possibility to withdraw the application. The application may be re-submitted at the later stage.

While two Brazilian GI have already sought protection abroad, it is confirmed that on 16/05/2023 Brazil had received 36 applications for international protection, of which 9 were granted and 21 are still under examination or pending decision, while 6 were rejected.



**Chart 1 – Records for GI protection**



In the format currently available, it can be deduced that there is a greater interest from foreigners in protecting their GI in Brazil than a Brazilian demand for protecting GI abroad.

It can therefore be concluded that the current lack of an international agreement does not prevent countries accessing the GI registration system in Brazil. Although there has been one successful case, the opposite path, that is, Brazil registering its GIs abroad still occurs on a very small scale.

# 8. Cost for Brazilian GI to apply for international recognition

Currently the international registration of a GI, through the Lisbon Protocol, requires a single payment of CHF 1000 (one thousand Swiss francs), as a general rule, regardless of the number of designated countries. Some exceptions are laid down. Here we shall address the possibility of the Brazilian interested party benefiting from a special price for the application for protection by this route, as well as the possibility of establishing an additional fee for certain designated countries.

Article Paragraph 7(3) of the Geneva Act sets forth that:

*'Reduced fees shall be established by the Assembly in respect of certain international registrations of appellations of origin, and in respect of certain international registrations of geographical indications, in particular those in respect of which the Contracting Party of Origin is a developing country or a least-developed country.'*

These differentiated rates are for countries designated as least developed countries, according to document LI/A/35/3 and INFORMATION NOTICE No 4/2023 of the Lisbon Agreement. Brazil is not indicated on the list of least developed countries, which can be accessed at: <https://unfccc.int/resource/ldc/documents/ldcbyregion.pdf>

At the 13th Extraordinary Session on 24/09/2018, the Assembly of the Union of Lisbon decided on a 50% reduction on the fees to be paid by the least developed countries.

Thus, it was found that different rates with a special price can be established and one of the differentiations is the 50% discount.

Another differentiation is established for specific countries. According to "Rule 8(2)(b)" of the Common Regulation, a Member State may request to WIPO that it be paid an individual fee to cover the costs of substantive examination of each international registration.

Searching the WIPO website, we found that some countries and the international organisation (AIPO), below referenced, make use of this prerogative and established an additional cost for the applicants of substantive examinations of each international registration.

**Figura 5 - Taxas individuais ao abrigo da Lei de Genebra do Acordo de Lisboa**

<b>País/IGO</b>	<b>Taxas (francos suíços)</b>	<b>Tipo</b>
Organização Africana de Propriedade Intelectual (OAPI)	750	Taxa individual para cada registro internacional
cabo verde	70	Taxa individual para cada registro internacional
Camboja	98	Taxa individual para cada registro internacional
Gana	392	Taxa individual para cada registro internacional
Samoa	187	Taxa individual para cada registro internacional

Fonte: WIPO, 2023

It should be clarified that the following countries are part of the AI:

1- Benin
2- Burkina Faso
3- Camarões
4- República Centro-Africana
5- Camarões
6- Congo
7- Costa do Marfim
8- Gabão
9- Guiné
10- Guiné Bissau
11- Guiné Equatorial
12- Mali
13- Mauritânia
14- Niger
15- Senegal
16- Chade
17- Togo

It can be concluded that in principle Brazil would not be entitled to the 50% (fifty per cent) discount on the amount to make the application, but it could indicate an additional amount to carry out the substantive examinations of each international registration. Furthermore, it should be made clear that the fee for deposit with WIPO corresponds to a one-off payment of CHF 1000 (one thousand Swiss francs), but additional fees may be added to this amount, as already reported.

# 9. Service GI and Cachaça GI

## Porto Digital (the only service GI registered in Brazil so far), and any new applications of this type, will remain outside the protection of the Geneva Act

Although the WIPO Portal states that members of the Lisbon System can obtain effective protection for their appellations of origin and geographical indications, regardless of the nature of the goods to which these apply, within the other members of the System, this statement is not valid in absolute terms. There are several applications for alcoholic beverages refused by member Iran, for example, considering that the country does not allow the marketing and consumption of alcoholic beverages and as a result does not allow the protection of a distinctive sign for this purpose.

Furthermore, the Geneva Act makes it quite clear both in the definitions and in several terms that protection refers to 'goods' or products, with no mention of services. We see this through the comparison of Article 2 of the Act, in three languages, below:

English	French	Spanish
<p><b>Article 2 Subject-Matter</b></p> <p>[Appellations of Origin and Geographical Indications] This Act applies in respect of:</p> <p>(i) any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a <b>good</b> as originating in that geographical area, where the quality or characteristics of the <b>good</b> are due exclusively or essentially to the geographical environment, including natural and human factors, and which has given the <b>good</b> its reputation; as well as</p> <p>(ii) any indication protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another indication known as referring to such area, which identifies a <b>good</b> as originating in that geographical area, where a given quality, reputation or other characteristic of the <b>good</b> is essentially attributable to its geographical origin.</p>	<p><b>Article 2 Objet</b></p> <p>(1) [Appellations d'origine et indications géographiques] Le présent Acte s'applique à l'égard de:</p> <p>(i.) toute dénomination protégée dans la partie contractante d'origine, constituée du nom d'une aire géographique ou comprenant ce nom, ou toute autre dénomination connue comme faisant référence à cette aire, servant à désigner un <b>produit</b> qui est originaire de cette aire géographique, dans les cas où la qualité ou les caractères du <b>produit</b> sont dus exclusivement ou essentiellement au milieu géographique, comprenant les facteurs naturels et les facteurs humains, et qui a donné au <b>produit</b> sa notoriété; et</p> <p>(ii.) toute indication protégée dans la partie contractante d'origine, constituée du nom d'une aire géographique ou comprenant ce nom, ou toute autre indication connue comme faisant référence à cette aire, servant à identifier un <b>produit</b> comme étant originaire de cette aire géographique, dans les cas où une qualité, réputation ou autre caractéristique déterminée du <b>produit</b> peut être attribuée essentiellement à son origine géographique.</p>	<p><b>Artículo 2 Materia</b></p> <p>1) [Denominaciones de origen e indicaciones geográficas] La presente Acta se aplica a:</p> <p>(i) toda denominación protegida en la Parte contratante de origen que consista en el nombre de una zona geográfica o que contenga dicho nombre, u otra denominación conocida por hacer referencia a dicha zona, que sirva para identificar un <b>producto</b> como originario de dicha zona geográfica, cuando la calidad o las características del <b>producto</b> se deban exclusiva o esencialmente al medio geográfico, comprendidos los factores naturales y humanos, y que hayan dado al <b>producto</b> su reputación; así como a</p> <p>(ii) toda indicación protegida en la Parte contratante de origen que consista en el nombre de una zona geográfica o que contenga dicho nombre, u otra indicación conocida por hacer referencia a dicha zona, que identifique un <b>producto</b> como originario de esa zona geográfica, cuando determinada calidad, reputación u otra característica determinada del <b>producto</b> sea imputable fundamentalmente a su origen geográfico.</p>

Thus, while in the official English version there could be doubt as to whether the term 'good' encompasses products and services, from the versions ,in French and Spanish, also official ,versions, it is clear that protection only refers to products.

Therefore, we can see no possibility for the protection of services GI in this Agreement.

## **Cachaça GI (Presidential Decree) – perspectives in the agreement**

On the other hand, with regard to the Cachaça GI, the definition of the Geneva Act is broader, indeed, than the Brazilian legislation, since it does not restrict protection to the "geographical name" for either Appellation of Origin and for Geographical Indication as, for example, Law 9279/1996 does. But it also refers to "another denomination known as referring to such area" for the AO "or another indication known as referring to such area" for the GI, according to Art. 2, I, i and ii of the Geneva Act:

*(i) any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area, where the quality or characteristics of the good are due exclusively or essentially to the geographical environment, including natural and human factors, and which has given the good its reputation; as well as*

*(ii) any indication protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another indication known as referring to such area, which identifies a good as originating in that geographical area, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.*

This may mean that there would be no restriction for the protection of the Cachaça GI, including because item 2 of said Art. 2, sets forth that the area of origin may consist of the entire territory of the Contracting Party of Origin, which would be the case of Cachaça do Brasil.

*(2) [Possible Geographical Areas of Origin] A geographical area of origin as described in paragraph (1) may consist of the entire territory of the Contracting Party of Origin or a region, locality or place in the Contracting Party of Origin. This does not exclude the application of this Act in respect of a geographical area of origin, as described in paragraph (1), consisting of a trans-border geographical area, or a part thereof.*

Another indication that there would potentially be no restriction on the submission of the application for international registration of the "Cachaça" GI is the existence of item 7(a) in the document 'application for international registration' found on the WIPO website, where it is possible to see a GI granted on the basis of an administrative or legislative act, as below:

**7(a) Legal basis for the grant of protection to the appellation of origin or geographical indication in the Contracting Party of Origin:**

*(Tick the appropriate box and complete, as appropriate; see Rule 5(2)(a)(vii))*

**Registration title:**

*(Specify the authority with which the registration was made and also the date and number of the registration, if applicable)*

**Legislative or administrative act:**

*(Specify the titles and dates of the provisions)*

**Judicial or administrative decision:**

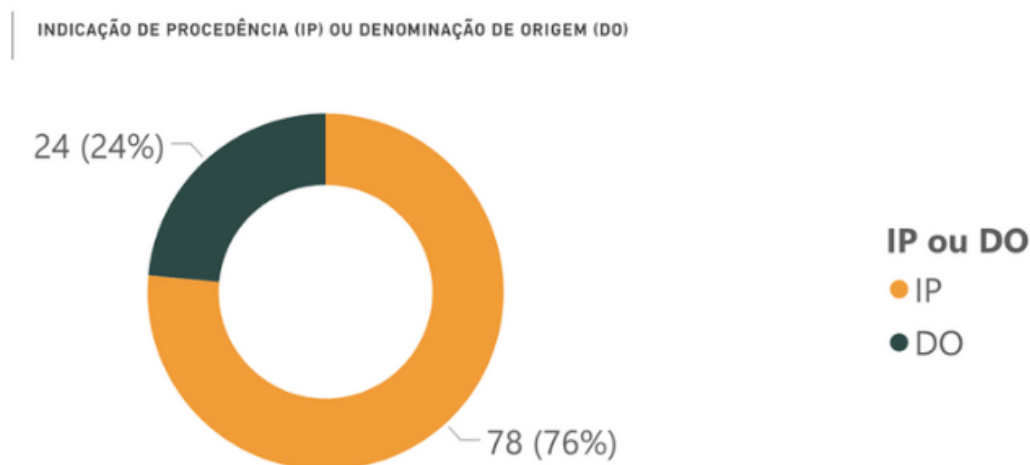
*(Specify the judicial or administrative authority that handed down the decision, and the date of such decision)*

From reading both the Geneva Agreement and the Rules of Procedure, it seems clear that the act recognising the registration may have more than one legislative or administrative origin. The decision could even be judicial. Thus, there seems to be no doubt about the admissibility of the registration in view of this deriving from a different norm (in the case of Decree 4062/2001) of Law 9279/1996. Another issue, this one of an internal nature, would be to decide who is the beneficiary or owner of the GI in Brazil, bearing in mind that each country has its own way of defining who is the owner or beneficiary. In other words, this will be up to Brazil to solve internally. It is assumed that once defined internally and informed by the country's Competent Authority to the Bureau of the Lisbon Agreement, this would not be questioned by the countries to which the agreement is addressed, since the focus of the analysis is not on the merits of the GI, which is done internally in Brazil, but on the protection of the distinctive sign in the destination country. Finally, it should be borne in mind that there are countries, such as Iran, which do not allow the protection of distinctive signs relating to alcoholic beverages, and in these countries the request will certainly be refused.

# 10. Will Brazilian Indications of Source be considered GI in the Agreement?

Currently, in terms of the total number of GI recognised in Brazil, there is a rather small number of AO, compared with the number of IS. That is, of the 102 IG recognised by the NIIP, 78 are IS and 24 are AO, according to data for up to 14 June 2023.

Figura 6 - Indicação de procedência (IP) ou denominação de origem (DO)



Fonte: Sebrae, 2023

When considering joining the Geneva Act of the Lisbon Agreement, it is imperative to think that as many GI as possible should be recognised by this agreement. However, with the current legal nomenclature and definition, laid down in Law 9279/1996, it is possible that IS are not considered as GI considering the definition of the agreement, although we find that the definition for AO is quite similar.

The official English version of Article 2 Subject matter reads as follows:

1. [Appellations of Origin and Geographical Indications] This Act applies in respect of:

(i) any denomination protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another denomination known as referring to such area, which serves to designate a good as originating in that geographical area, where the quality or characteristics of the good are due

*exclusively or essentially to the geographical environment, including natural and human factors, and which has given the good its reputation; as well as*

*(ii) any indication protected in the Contracting Party of Origin consisting of or containing the name of a geographical area, or another indication known as referring to such area, which identifies a good as originating in that geographical area, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.*

However, by way of comparison, the version of the European Union, which is a member of the Geneva Act, in Portuguese:

Law 9279/1996	Geneva Act of the Lisbon Agreement
<p>Art. 177. The geographical name of the country, city, region or locality of its territory, which has become known as the centre of extraction, production or manufacture of a given product or of the provision of a given service, shall be deemed to be an indication of source.</p>	<p>(ii.) A qualquer indicação protegida na parte contratante de origem, que consista no nome, ou contenha o nome, de uma zona geográfica, ou outra indicação conhecida como fazendo referência a essa zona, que identifique um produto como sendo originário dessa zona geográfica, sempre que determinada qualidade, reputação ou outra característica do produto resulte essencialmente da sua origem geográfica.</p>
<p>Art. 178. Appellation of origin means the geographical name of a country, city, region or locality within its territory, designating products or services the qualities or characteristics of which are exclusively or essentially due to the geographical environment, including natural and human factors.</p>	<p>(i.) A qualquer denominação protegida na parte contratante de origem, que consista no nome, ou contenha o nome, de uma zona geográfica, ou outra denominação conhecida como fazendo referência a essa zona, que sirva para designar um produto como sendo originário dessa zona geográfica, cuja qualidade ou características resultem exclusiva ou essencialmente do meio geográfico, incluindo fatores naturais e humanos, e que tenha conferido ao produto a sua reputação;</p>

IS as such would not fit within the literal definition that is used by Brazilian law. And this is why it is sought, by means of the proposal presented by the Working Group of the National Intellectual Property Strategy (NIPS) to the Interministerial Group for Intellectual Property (IGIP), to change the current definition of IS to IG.

The other MERCOSUR countries – which have already used this term on the basis of the Protocol of Harmonisation of Intellectual Property Laws in the Mercosur, concerning trademarks, indications of origin and appellation of origin (Decision 08/1995) – today adopt the nomenclature geographical indication, and approximate the definition of the TRIPS Agreement, which resembles the definition of the Geneva Act.

However, it should be noted that the legal definition does not reflect reality.

And it can be stated, based on the study by Tonietto and Bruch (2021), in the study entitled 'The Indication of Source in Law 9,279/1996 and demands for the improvement of the Legal



Framework' that, analysing the notebooks of technical specifications/regulations for the use of the Brazilian recognised IS, the requirements which these establish as a minimum go far beyond reputation or to demonstrate that the product has become known. They also have requirements that can be likened to those contained in the definition of GI of the Geneva Act.

In this regard, so that all GI of products recognised in Brazil can also be recognised under the Geneva Act, it would be fundamental for Brazilian legislation to reflect what Brazilian IS already present.

In other words, an amendment to Law 9179/1996 would be necessary, so that the concept of IP be changed to match the concept of GI, which is the one used internationally.

That is to say, with the adoption of the basic definition in the TRIPS agreement, to which Brazil is also a signatory, which defines GI as:

## **ARTICLE 22: Protection of Geographical Indications**

1. Geographical indications are, for the purposes of this Agreement, 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.

### **In summary, we can confirm:**

- a) Existence of "few" Appellations of Origin registered in Brazil.
- b) Need to change the IP Law to modify the definition of the Indication of Source, to now be called "Geographical Indication".
- c) This amendment should take into account the definition of TRIPS - Quality, reputation or other characteristic, which is also in the Geneva Act.

# 11. Is filing in Portuguese with WIPO permitted?

Currently the official languages of WIPO are: English, French, Spanish, Russian, Chinese and Arabic.

Applications can only be submitted in English, French or Spanish according to:

*COMMON REGULATIONS UNDER THE LISBON AGREEMENT FOR THE PROTECTION OF APPELLATIONS OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION AND THE GENEVA ACT OF THE LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS*

*Rule 3 - Working Languages*

*(1) [Application] The application shall be in English, French or Spanish.*

*[Communications Subsequent to the Application] Any communication concerning an application or an international registration shall be in English, French or Spanish, at the choice of the Competent Authority concerned or, in the case of Article 5(3) of the Geneva Act, at the choice of the beneficiaries or the natural person or legal entity referred to in Article 5(2)(ii) of that Act. Any translation needed for the purposes of these procedures shall be made by the International Bureau.*

Percentage of the Brazilian population fluent in one of the above languages:

According to a British Council survey, only 1% of the Brazilian population speaks English fluently. Those who speak English, but not at an advanced level, account for 5% of the population. Therefore, it is necessary to consider the cost associated with the application for international registration considering the translation of documents such as the Technical Specifications, among others.

In other words, applications will have to be filed in one of the three languages, and this is a potential obstacle to Brazilians using the Geneva Act.

# 12. Can Mercosur or PROSUR join Lisbon/Geneva?

Even if there are similar precedents (EU and AIPO), Mercosur does not recognise GIs in its collective structure, unlike the EU and AIPO.

It is not possible to compare the EU with Mercosur, because in the EU there is the possibility of recognition of the GI directly as a European GI. And the request is set out directly in the Agreement. Countries may choose to register with the Agreement (as is the case with France, which was one of the original signatory countries to the agreement and had GI recognised long before the EU signed the agreement), but there are still two possibilities. For example, France, Portugal and Italy are individual members of the agreement, even though they are in the EU. France alone has 426 applications. The EU has 117 applications.

An interested party originating from a European country may have made the application directly in the Agreement, by not being registered in the EU, but being registered in their own country. Countries that are not signatories to the Agreement but are members of the EU can apply through the EU for GI registration in the Agreement.

In Mercosur we have the Harmonisation Protocol, the Wine Agreement and the Mutual Recognition Agreement of 2019, but we do not have a body that recognises a GI as being from Mercosur.

At present, PROSUR - Cooperation System on aspects of Operational Information and Industrial Property cannot be compared to "AIPO", since this is a regional IP registration office for all acceding African countries. PROSUR, on the other hand, has the mission of facilitating and improving processes related to Industrial Property, with the objective of promoting the transfer of knowledge and entrepreneurship to aid development in Latin America. In PROSUR there is no regional recognition of GI. Image from the institutional page of PROSUR below (<https://prosur.org/pt/>)



On the other hand, when analysing Art. 28, 1, iii of the Geneva Act, the following are established as conditions for an intergovernmental organisation, be it MERCOSUR or PROSUR:

*Any intergovernmental organization may sign and become party to this Act, provided that at least one member State of that intergovernmental organization is party to the Paris Convention and provided that the intergovernmental organization declares that it has been duly authorized, in accordance with its internal procedures, to become party to this Act and that, under the constituting treaty of the intergovernmental organization, legislation applies under which **regional** titles of protection can be obtained in respect of geographical indications.*

In other words, there is a need for the intergovernmental organisation to grant regional protection for a geographical indication before it can be eligible to become a Member of the Geneva Act.

Thus, on the basis of the information gathered, we can conclude that it is currently impracticable for Mercosur or PROSUR to accede to the Agreement as the AIPO or the European Union did, due to its current stage and the scope of its operation.

# 13. GI versus “generic”, “common” or “vulgar” names

Article 12 of the Geneva Act sets forth that:

Art. 12 - Subject to the provisions of this Act, registered appellations of origin and registered geographical indications cannot be considered to have become generic (2) in a Contracting Party.

And, in a footnote it states that:

*Agreed Statement concerning Article 12: For the purposes of this Act, it is understood that Article 12 is without prejudice to the application of the provisions of this Act concerning prior use, as, prior to international registration, the denomination or indication constituting the appellation of origin or geographical indication may already, in whole or in part, be generic in a Contracting Party other than the Contracting Party of Origin, for example, because the denomination or indication, or part of it, is identical with a term customary in common language as the common name of a good or service in such Contracting Party, or is identical with the customary name of a grape variety in such Contracting Party.*

Thus, on the one hand, it appears that an already registered GI/AO cannot become generic. However, if it is already a generic term in the country – and this must be proven or justified in some way – this may prevent the GI/AO from being registered. In other words, the State Party may refuse registration on the basis that the distinctive sign has become generic.

Another exception is set forth in Art. 13, item 3:

*Art. 13. - 3. [Rights Based on a Plant Variety or Animal Breed Denomination] The provisions of this Act shall not prejudice the right of any person to use a plant variety or animal breed denomination in the course of trade, except where such plant variety or animal breed denomination is used in such a manner as to mislead the public.*

This summary informs us that a denomination based on an animal breed or plant variety may not prevent that breed or variety from continuing to be used, provided it does not mislead the public.

In addition, we should mention Art. 11, item 2:

Art. 11 (2) [Content of Protection in Respect of Certain Uses] Paragraph (1)(a) shall also apply to use of the appellation of origin or geographical indication amounting to its

imitation, even if the true origin of the goods is indicated, or if the appellation of origin or the geographical indication is used in translated form or is accompanied by terms such as 'style', 'kind', 'type', 'make', 'imitation', 'method', 'as produced in', 'like', 'similar' or the like.

The TRIPS agreement already laid down the impossibility of qualifying expressions for wines. This impossibility would now extend to all products. The goal of not being able to use 'type' or 'method' would be precisely to prevent the name from becoming generic. Thus, by adhering to the Geneva Act, Brazil could no longer use qualifying expressions like 'gorgonzola type' and 'parmesan type', since there is a great probability of countries registering their GI in Brazil by means of the Geneva Act.

Some Brazilian laws that conflict with the Geneva Act are also noteworthy:

- Law 7678/1988: Defines 'Champagne', 'Cognac', 'Grappa' as products ("Wine Law")
- Presidential Decree: 6871/2009, lists some examples of Geographical Indications that are described as 'type' in Brazil.
- Law 9279/1996

Art. 193 - Use, on a product, container, wrapper, strap, label, invoice, circular, poster or other means of publicity or advertising, qualifying expressions, such as 'type', 'species', 'genre', 'system', 'similar', 'substitute', 'identical', or equivalent, without prejudice to the true origin of the product.

Penalty - imprisonment, from 1 (one) to 3 (three) months, or a fine.

Art. 180 - When the geographical name designating a product or service has become of common use, it shall not be considered a geographical indication.

We can conclude that, in order to accede to the agreement, such legal changes are necessary. These are only examples and other sector-specific rules may need to be amended if they conflict with the provisions of the Geneva Act. On the other hand, some GI can effectively be considered in common use and could not be registered in Brazil based on the agreement.

# 14. GI and Enforcement

In this item, we questioned how compliance with Article 11, cited below, could be put into practice and the penalties for possible non-compliance.

We also questioned what level of enforcement is needed and how much this would impact the change in Brazilian legislation, and also the extent to which it would be necessary to mobilise administrative and judicial effort with, for example, border measures (search and seizure of goods, official measurements), since Law 9279/1996 has no provision for public prosecution, for example, that underpins search and seizure of goods that violate GI carried out by public bodies without a complaint from the rights holder. We therefore resolved to check whether the agreement requires action in this direction.

Art. 11 sets forth that:

*Art. 11 sets forth that:*

*Article 11 - Protection in Respect of Registered Appellations of Origin and Geographical Indications (1)*

*[Content of Protection] Subject to the provisions of this Act, in respect of a registered appellation of origin or a registered geographical indication, each Contracting Party shall provide the legal means to prevent:*

*(a) the use of the appellation of origin or the geographical indication*

*(i.) in respect of goods of the same kind as those to which the appellation of origin or the geographical indication applies, not originating in the geographical area of origin or not complying with any other applicable requirements for using the appellation of origin or the geographical indication;*

*(ii) in respect of goods that are not of the same kind as those to which the appellation of origin or geographical indication applies or services, if such use would indicate or suggest a connection between those goods or services and the beneficiaries of the appellation of origin or the geographical indication, and would be likely to damage their interests, or, where applicable, because of the reputation of the appellation of origin or geographical indication in the Contracting Party concerned, such use would be likely to impair or dilute in an unfair manner, or take unfair advantage of, that reputation;*

Reading the article and considering other points set out in the treaty, there are no explicit sanctions for non-compliance with this article. Rather, it is set forth that the parties should establish internal measures that are sufficient to offer mechanisms for the parties to act. However, these mechanisms must effectively allow the party, through administrative or judicial means, to prevent the use of both similar names and others that are not similar,

and also apply to services, which would make it impossible to use the principle of speciality (applicable to trademarks) for IG and AO.

Brazil currently has, in Law 9279/1996, two judicial mechanisms:

- private criminal proceedings provided for in Articles 192, 193 and 194. However, these are not fully adequate and would have to be revised, because they allow, for example, the use of qualifying expressions.
- Civil action targeting civil liability, which may include search and seizure, destruction of goods, lost profits and emerging damage, provided for in Art. 209 and 210, and understood combined with Art. 186, 187 and 927 et seq. of the Civil Code. These must be brought and pursued by rights holders.

It should also be stressed that Art. 124 of Law 9279/1996 sets forth, in its sections IX and X, that trademarks cannot be registered if they contain:

IX - Geographical indication, its imitation likely to cause confusion or a sign which may mislead as to geographical indication;

X - A sign which misleads as to the origin, provenance, nature, quality or utility of the product or service for which the trademark is intended;

However, currently trademarks have been granted for other products or services containing GI recognised in Brazil. This practice would not be in accordance with the provisions of Art. 11 of the Geneva Act.

Thus, we can confirm that there is no official activity in Brazil for the repression of misuse of geographical indications. The Consumer Protection Code can be applied by analogy, but this action, which could be carried out *ex officio*, would be focused on consumer protection and not on intellectual property rights. Thus, if consumers are not misled, there would be no breach.



# 15. Possibility of refusal of applications for GI registration

Refusals are provided for in the Geneva Act in its Art. 15.

## Article 15 - Refusal

### (1) *[Refusal of Effects of International Registration]*

(a) *Within the time limit specified in the Regulations, the Competent Authority of a Contracting Party may notify the International Bureau of the refusal of the effects of an international registration in its territory. The notification of refusal may be made by the Competent Authority ex officio, if its legislation so permits, or at the request of an interested party.*

(b) *The notification of refusal shall set out the grounds on which the refusal is based.*

(1) *[Protection Under Other Instruments] The notification of a refusal shall not be detrimental to any other protection that may be available, in accordance with Article 10(2), to the denomination or indication concerned in the Contracting Party to which the refusal relates.*

(2) *[Obligation to Provide Opportunity for Interested Parties] Each Contracting Party shall provide a reasonable opportunity, for anyone whose interests would be affected by an international registration, to request the Competent Authority to notify a refusal in respect of the international registration.*

(3) *[Registration, Publication and Communication of Refusals] The International Bureau shall record the refusal and the grounds for the refusal in the International Register. It shall publish the refusal and the grounds for the refusal and shall communicate the notification of refusal to the Competent Authority of the Contracting Party of Origin or, where the application has been filed directly in accordance with Article 5(3), the beneficiaries or the natural person or legal entity referred to in Article 5(2)(ii) as well as the Competent Authority of the Contracting Party of Origin.*

(4) *[National Treatment] Each Contracting Party shall make available to interested parties affected by a refusal the same judicial and administrative remedies that are available to its own nationals in respect of the refusal of protection for an appellation of origin or a geographical indication.*

As a basis for such an act, we may consider, for example, what is set forth in Art. 10, in which it is clear that GI registered in the country will be protected, as item 2 highlights that

the country's accession will not affect the GI/AO registrations already carried out under national legislation.

In fact, in searches carried out in the structured database of the *Lisbon express* on 12-06-23, it was possible to identify 753 records of refusals. The existence of prior trademarks, alcoholic beverages (prohibited in countries such as Iran) and even refusals just because they are agri-foodstuff products, as Bulgaria justified in case AO1121, are examples of refusals viewed in the tool.

The Geneva Act also makes clear in Art. 11, 5, the need to offer the registration applicant a way to appeal the refusal. This format varies in each country and some, like the cited case of Bulgaria, require the national prosecutor to bring the appeal. There is also a clear need to provide for the possibility for third parties to oppose registration, according to Art. 11, 3.

After the refusal of registration, the country may decide to cancel the refusal in whole or in part, without providing further clarification, as Mexico did in the AO 1121 registration for the "Aceituna de Tacna".

The question of previously registered trademarks and other justifications with a "questionable" basis, such as those mentioned above, may constitute a weak point for possible Brazilian requests to be filed through the Lisbon Agreement/Geneva Act.

# 16. GI vs Trademark use

In comparison with existing legislation and with what is already provided for in the TRIPS Agreement, the use of a trademark, equal to or similar to a GI, may be more restricted in the Geneva Act.

First, Art. 11, item 3 expressly sets forth:

*Art. 11 (3) [Use in a Trademark] Without prejudice to Article 13(1), a Contracting Party shall, ex officio if its legislation so permits or at the request of an interested party, refuse or invalidate the registration of a later trademark if use of the trademark would result in one of the situations covered by paragraph (1).*

Item 1 refers both to goods of the same kind and to goods not of the same kind, or services. This means that:

- it would not be possible to register a trademark containing the same sign as a protected GI through the agreement in Brazil;
- Brazil should establish *ex officio* or by means of an application of an interested party, the possibility of refusing or revoking the registration of a trademark applied for after the recognition of the GI/AO.

This in practice means that Brazil could no longer apply the principle of speciality to GI for trademark registration.

It should be noted that Law 9279/1996 sets forth that:

*Art. 124 - The following are not registrable as trademarks:*

*IX - Geographical indication, its imitation likely to cause confusion or a sign which may mislead as to geographical indication;*

*X - A sign which misleads as to the origin, provenance, nature, quality or utility of the product or service for which the trademark is intended;*

In other words, analysing only the law, in theory it is not possible to register a geographical indication as a trademark. Currently the NIIP understands that this only applies in the class of product or service related to the geographical indication.

The Geneva Act makes it clear, by the reference it makes to item 1 of Art. 11, notably point b, that registration would no longer be possible.

Another point refers to the prior right of trademarks and personal names used commercially, both provided for in Art. 13.

*Article 13 - Safeguards in Respect of Other Rights*

*(1) [Prior Trademark Rights] The provisions of this Act shall not prejudice a prior trademark applied for or registered in good faith, or acquired through use in good faith, in a Contracting Party. Where the law of a Contracting Party provides a limited exception to the rights conferred by a trademark to the effect that such a prior trademark in certain circumstances may not entitle its owner to prevent a registered appellation of origin or geographical indication from being granted protection or used in that Contracting Party, protection of the registered appellation of origin or geographical indication shall not limit the rights conferred by that trademark in any other way.*

*(2) [Personal Name Used in Business] The provisions of this Act shall not prejudice the right of any person to use, in the course of trade, that person's name or the name of that person's predecessor in business, except where such name is used in such a manner as to mislead the public.*

The first item informs us that:

- the registration of a later GI does not prevent a previously registered trademark from continuing to operate, and that the GI will not limit the rights conferred on the trademark;
- it also makes it clear that, if provided for in domestic law, an earlier trademark may prevent the registration of a later GI.

Likewise, item 2 states that the registration of a GI should not prejudice the right of someone to use their personal name or that of a predecessor in business if that is identical or similar to an already registered GI. The caveat is when this is done in a way that misleads the public.

# 17. Homonymous GI

The registration of homonymous GI in Brazil is provided for and described in the NIIP\_ PR Ordinance 4 of 12 JANUARY 2022 and in the GI Manual published by NIIP. One example is the possibility of registering official acronyms of states associated with the geographical name of the GI or its demonym. This enables the protection of homonymous geographical names for areas located in distinct states.

Another peculiarity of the Brazilian standard is the inability to register the same name to the Geographical Indication already registered in Brazil to indicate an identical or similar product or service, except when there is substantial differentiation in the distinctive sign. However, the Lisbon Agreement/Geneva Act does not have such a provision, a fact that may give rise to inconsistency if two Brazilian GI decide to opt for the international registration, for example.

## For different products

The registration of two homonymous GI for different products is possible in Brazil. There are few cases, such as those shown below for wines and fruit, where there is significant differentiation in the distinctive signs, as provided for in the relevant legislation.

Examples:



## For identical products

These are allowed in the Mercosur - EU Agreement - Art. 4.

## Situation in Geneva/Lisbon

There is no provision.

# 18. Real interest in international registrations of GI by Brazilians

The Brazilian Association of Geographical Indications (ABRIG) aims to support and unite the representative entities of recognised GI for high-quality products and services based on origin. In an online meeting held with ABRIG, the association showed interest in exploring the topic in greater depth and sent a letter requesting participation in future discussions and consultations. The document they sent to formalise interest in the topic can be viewed on the following page:

Figura 8 - Ofício enviado pela ABRIG



In the Northeast region of Brazil, in consultation with the representatives of the Geographical Indication “Sul da Bahia” for the cocoa product (NIIP Registration: BR402014000011-5) and the potential IG “Viçosa do Ceará” (NIIP Application BR402022000023-5), both stated that they will be interested in potential international registration through the Lisbon Agreement, provided that it is possible to recognise a GI of the Indication of Source type.

## Brazilian SEBRAE and the Lisbon Agreement

The Brazilian Micro and Small Business Support Service has an important national track record in the diagnosis, qualification, structuring and promotion of Geographical Indications. Considering its solid experience with GI, we may properly infer that SEBRAE holds sufficient “field knowledge” to give an opinion on the interest and viability of Brazilian GIs to use an international agreement for registrations abroad.

When sought as part of this study, the Technology Based Business and IP Coordinator of the Innovation Unit, Hulda Oliveira Giesbrecht, showed concern about an issue already addressed in this study: the need for the adequacy of the Brazilian legal framework, in particular the conceptual question of the “Indication of Source” used in Brazil versus the terminology “Geographical Indication” used in the Lisbon system.

Upon being informed about the cost involved for international registration, of 1000 CHF, the coordinator stated: *‘As for the viability of the management entities of the Brazilian GI to bear the costs of the process of recognition via the Lisbon System, I understand that some GI, which have in their business plans export targets for specific countries, will benefit greatly from this accession.*

*If these GI understand the value that this recognition in other countries can bring to their product and to the region, the decision to bear the costs becomes an investment that they can collectively assume. We can’t expect this accession to directly benefit all Brazilian GI, because some have as their goal to act at the local, regional or national level – with a brilliant role to play in this context.*

*Therefore, in Sebrae’s view, for those GI whose products have export potential, the cost of recognition fees in other countries via the Lisbon System will not be a hindrance. Sebrae will be able to offer consultancy via Sebraetec to guide companies in their request for recognition via the Lisbon System,’* concluded Hulda Giesbrecht.

# 19. Brazil/INPI regulatory challenges: analysis of points of the Agreement and of the needs of adaptations/legal/normative changes of Brazil/NIIP for possible accession

The main points were detailed throughout the report. However, the points that merit greatest attention are:

- Definition of Geographical Indication: in order for Brazil to ensure that its current indications of origin are recognised, it is necessary to adapt the norm so that the nomenclature and the legal definition (Art. 177 - Law 9279/1996) are similar to the provisions of Art. 2, 1, ii of the Geneva Act. And also to ensure that the existing ones can migrate to the new nomenclature, as otherwise they will remain excluded;
- In the current Geneva Act there is no way to include GI for services, but just as there was progress from the Stockholm Act to the Geneva Act, it is not something to be ruled out in the long term;
- There is the possibility to request recognition of the GI Cachaça do Brasil under the Geneva Act, as already addressed, by the definition used for GI;
- It will be necessary to adjust NIIP's interpretation in relation to the application of the principle of speciality of trademarks for GI, considering that the Geneva Act understands that the protection of GI is valid both for similar products and for other products and services, according to Art. 11, 1, a. And for this it is not necessary to alter Art. 124 of Law 9279/1996, but rather to adjust its interpretation as regards the granting of trademarks in Brazil;
- The Geneva Act does not talk about graphic or figurative protection, which is set forth in Art. 179 of Law 9279/1996. And this is perhaps an obstacle to protection if Brazilian holders want to register these in other countries. It is therefore important to consider an adaptation of the documentation to send only nominative content for international registration or to amend the internal standard;



- Article 193 of Law 9279/1996 would need to be adapted, to remove the possibility of using qualifying expressions, even if the true origin is provided for;
- Article 194 of Law 9279/1996 would need to be adapted, to clarify that only those who have the right to use the name of a geographical indication can use it, since it could also be interpreted as a form of infringement of Art. 11, 1, a, of the Geneva Act;
- Another question concerning Art. 192 to 194 is whether private prosecutions would meet the requirements in the Geneva Act. Nothing has been expressed – as there is, for example, in the Mercosur - European Union agreement – but converting them into public criminal proceedings could better serve the scope of Art. 10 and 11 of the Geneva Act;
- It would need to be made clearer in the law whether or not a geographical indication can be rejected or refused and on what grounds this could be done, in order to base possible refusals – if this is of interest – since this point is not clear in today's law. This would also apply to the annulment of a GI, as stated in Art. 19 of the Act, and should set forth whether it is possible and for what reasons it would be – both domestic and foreign;
- There would also be a need for a deadline for opposition filings expressed in law, as well as the notice of opposition, as is the case for other industrial property rights;
- There could be a greater explanation of the civil and criminal instruments available in the law, especially if one considers the general principles of Art. 207 to 210, which deal with civil actions;
- **At the national level, it would need to be clear who would be responsible for filing the registration with the Bureau – the holder or the Competent Authority – and if there would be a prior analysis before sending, which could optimise such filings.**
- **It would be appropriate to establish internally whether there is an interest in collecting an individual fee for registrations – as is the case today in Brazil – for those who enter via the Geneva Act. And this would need to be negotiated, as provided for in Art. 7 of the Act;**
- It is important to note that the Geneva Act, in its Art. 8, considers that the registrations are valid indefinitely. And they would only be cancelled if they were in their home countries. Today there is no express provision about the validity of GI registrations in Brazil, and this could be better specified;
- Currently there is no discrimination in Brazilian law in relation to foreign GI that apply for registration in Brazil. However, some of them have difficulties in delivering all the requested documentation. The Geneva Act Art. 6 sets out what details need to be included in the application for registration. And perhaps an adjustment is needed to the current requirements, because no further analysis of merit – as is apparent in principle – would be made, but rather a formal verification related to the use of the distinctive sign and any conflicts related to it;

- Another issue relates to Art. 12 of the Act, which sets forth that once a GI has been registered it cannot be considered generic. And this legal prediction does not exist in Brazil at the moment.
- Other points, concerning safeguards in respect other rights, should perhaps be included in the law, such as the issue related to coexistence with denominations of plant varieties or animal breeds, personal name used in business, prior trademark rights, among others. These are questions posed in the current Ordinance 04/2022 or in the uses of the NIIP and perhaps should be better clarified in the law. It should be recalled that the Ordinance today is more restrictive than the Act, which proposes coexistence, while the Ordinance would prevent registration – which is in accordance with the Mercosur - European Union Agreement. It should be noted that the Act does not deal with homonymous GI, but does not prevent their regulation from what can be inferred.

These are the main points related to Law 9279/1996. We should recall that other legislation may also need to be amended but, in view of the specific nature of this exercise, this were not addressed.

## 20. Assessment of possible declarations (reservations) to the Geneva Act of the Lisbon Agreement at the time of accession

According to Art. 30 of the Geneva Act, no reservations are permitted when signing the agreement. As already stated in this document, certain points are open to negotiation after accession, such as the time allowed to accept or reject international requests already filed under the Geneva Act, which may be 1 or 2 years, provided that this is explicitly requested. (Article 29.4 of the Geneva Act and Article 9.1 of the Common Regulation).

In addition, the prerogative of establishing an additional cost for applicants for substantive examination of each international registration (individual fee) may also be used.

*This process is done directly with the International Bureau of WIPO and is subject to the approval of the Director General of the Organisation, as provided for in Rule 8, 1, V; 2 a and b, combined with Rule 5, 2, c, of the COMMON REGULATIONS UNDER THE LISBON AGREEMENT FOR THE PROTECTION OF APPLICATIONS OF ORIGIN AND THEIR INTERNATIONAL REGISTRATION AND THE GENEVA ACT OF THE LISBON AGREEMENT ON APPELLATIONS OF ORIGIN AND GEOGRAPHICAL INDICATIONS.*

Another point to be defined in the accession is who would be responsible for filing the registration with the International Bureau (WIPO) – the holder or the Competent Authority.

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