

# Protection of Indications of Geographical Origin in the Republic of Serbia

- ▶ Paris Convention 1873
- ▶ Madrid Agreement (Indications of Source) 1891
- ▶ Lisbon Agreement 1958
- ▶ TRIPS 1995
- ▶ Trademark Law 2004
- ▶ Law on Indications of Geographical Origin 2006
- ▶ CEFTA 2007 and SAA 2008
- ▶ Bilateral agreements (France, Switzerland)

## Paris Convention 1873

- ▶ Art. 1 (2) subject matter (indications of source and appellations of origin)
- ▶ Art. 10 (false indications of origin)
- ▶ Art. 10 bis (suppression of unfair competition)
- ▶ Art. 10 ter (obligation to provide adequate legal means for the suppression of unfair competition)

## Madrid Agreement (Indications of Source)

- ▶ Art. 1 (all products bearing false indications of source shall be ceased at the import, prohibition of the transit)
- ▶ Art. 2 = Border measures, Customs to act
- ▶ Art. 4 (Courts to establish generic IoS, exceptions are regional IoS for the wine products)

## Lisbon Agreement

- ▶ Art. 2 (Appellation of origin is geographical name of a country, region or a locality, used to designate a product originating therein, the quality and special characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors)
- ▶ Art. 5 (International registration procedure, WIPO to act)
- ▶ Art. 6 (Registered AO cannot become generic as long as protected in the country of origin)
- ▶ Art. 7 (AO registration eternal, one fee)

## TRIPS

- ▶ Art. 22 (Geographical indication is indication which identifies certain good as good originating from the territory of specific country, region or a locality within such territory, where specific quality, reputation or other characteristics of the good can be essentially attributed to its geographical origin)
- ▶ Art 23 (Additional protection for the wine and vine products)
- ▶ Art 24 (Future negotiations, exceptions)
- ▶ Big issue –relationship with previously registered trademark

## Trademark Law

- ▶ Art. 2 (Individual, collective and certification trademark)
- ▶ Art. 5 (4) (sign which exclusively designate geographical origin cannot be registered as individual trademark)
- ▶ Trademark registration must be renewed after 10 years, possibility of the lapse of the right due to non use or non payment, transferability of the trademark

## Law on Indications of Geographical Origin (LIGO)

- ▶ Art. 1 ( Law regulates the acquisition and legal protection of indications of geographical origin, indications of geographical origin are appellations of origin and geographical indications)
- ▶ Art. 2 (Indications of geographical origin shall be used to mark natural, agricultural and industrial products, products of traditional handicrafts and services)

## LIGO

- ▶ Art. 3 (Appellation of origin is geographical name of a country, region or a locality, used to designate a product originating therein, the quality and special characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors, and which is produced, manufactured or processed completely within a specific limited geographical area)
- ▶ Conclusion – difference with AO from the Lisbon Agreement, equal with PDO from the EU directives.

## LIGO

- ▶ Art.4 (Geographical indication is indication which identifies certain good as good originating from the territory of specific country, region or a locality within such territory, where specific quality, reputation or other characteristics of the good can be essentially attributed to its geographical origin)
- ▶ Conclusion – equal with the GI from the TRIPS

## LIGO

- ▶ Art. 5 (If the requirements referred to in Articles 3 and 4 of the Law have been met, a name that is not the administrative geographical name of certain country, region or locality, which has become well-known through a long-term use in trade as the traditional name of the product that originates from such region, or name that is a historical name of such region, shall also constitute an indication of geographical origin)
- ▶ Conclusion – possible protection of historic and traditional names

## LIGO

- ▶ Art. 6 (Where the names of two or more places of origin of the product are identical or nearly identical in written or pronounced form (homonymic names), protection of such geographical names shall be granted to all interested persons that meet requirements provided for in this Law, based on the principles of just and equal treatment of producers in the market and truthful information of consumers, except when this could give the wrong impression to the public about the exact geographical origin of the product)
- ▶ Conclusion – equity approach for the protection of the homonyms

## LIGO

- ▶ Art. 7 (what cannot be protected by the indication of geographical origin):
- ▶ names contrary to public order or morals;
- ▶ names that are names of protected plant varieties or animal species;
- ▶ names whose appearance or content may mislead consumers with respect to nature, origin, quality, manner of production or other characteristics of the product;
- ▶ a name that is the exact name of the country, region or a locality of origin of the product, which causes wrong impression among consumers that the product originates from another country, region or a locality;
- ▶ a name which, due to long-term use, became generic, i.e. usual name for designation of specific product;
- ▶ a name that is not protected or ceased to be protected or ceased to be used in the county of origin.
- ▶ Indication of geographical origin for the vine product that is identical to the name of the variety of grape that existed in the territory of Serbia before January 1, 1995, shall not be protected under the this Law.

## LIGO

- ▶ Art. 8 (responsible agency for the administrative procedure for the protection of IGO is Intellectual Property Office)
- ▶ Against final decisions possible administrative dispute before Supreme Court of Serbia)

## LIGO

- ▶ Art. 14 –The application for the registration of an appellation of origin or a geographical indication may be filed by :
- ▶ domestic natural or legal persons who produce within a specified geographical area the products that bear the name of that geographical area;
- ▶ associations of persons referred to in item 1 of this paragraph, chambers of commerce, associations of consumers and the authorities interested in protection of an appellation of origin or a geographical indication, within their activities;
- ▶ foreign natural or legal persons or foreign associations, if an appellation of origin or a geographical indication were registered in the country of origin, when it stems from the international agreements.

The application for registration of an appellation of origin or a geographical indication may be related to only one indication or a name of geographical area and to only one type of product.

## LIGO

- ▶ Art. 15 (essential elements of the application)
- ▶ request for the registration of an appellation of origin or a geographical indication;
- ▶ description of the geographical area;
- ▶ data on specific characteristics of the product.

## LIGO

- ▶ Art. 27 (Initiation of the Proceedings for the Recognition of the Status of the Authorized User)  
Procedure for recognition of an authorized user is initiated by filing the application for recognizing the status of an authorized user of an appellation of origin or a geographical indication.
- ▶ This application may be submitted by natural or legal persons who, within certain geographical area, produce products marked by the name of such geographical area, as well as associations of such natural or legal persons.

## LIGO

- ▶ Art. 28 (Essential elements of the application for recognition of a status of an authorized user of an appellation of origin or a geographical indication):
- ▶ Request for recognition of a status of an authorized user of an appellation of origin or a geographical indication;
- ▶ Proof of specific activity performed within the specific geographical area.
- ▶ A proof that that the quality control of the product has been performed by the authorized organization named in the application for the registration of the appellation of origin, in case of the application for the recognition of the status of an authorized user of an appellation of origin.

## LIGO

- ▶ Art. 41 (Time of validity of the status of the authorized user)
- ▶ Status of the authorized user of an appellation of origin or a geographical indication is valid for three years as of the date of entry into the Register of Authorized Users of Appellations of Origin or the Register of Authorized Users of Geographical Indications.
- ▶ Renewal possible perpetually

## LIGO

- ▶ Art. 42 (Use of the registered appellation of origin or a geographical indication)
- ▶ Registered appellation of origin or geographical indication may be used only by the registered authorized users.
- ▶ Authorized users have the right to use the appellation of origin or the geographical indication to mark the product that the appellation of origin or the geographical indication has been related to.
- ▶ Authorized users of the appellation of origin have the exclusive right to mark their products with the indication “controlled appellation of origin”.

## LIGO

- ▶ **Art.43 (Prohibited Actions = Infringement)**
- ▶ Any person who is not an authorized user of an appellation of origin or a geographical indication cannot use registered appellation of origin or geographical indication, their translation, transcription or transliteration, regardless of the font or the color used, or expressed in any other manner, to mark products, where the appellation of origin or the geographical indication is supplemented with the words such as : “kind”, “type,” “fashion,” “imitation”, “by the process” and the like, even where the geographical origin of the product is correct.

## LIGO

- ▶ **Art 44 (Relation to the previously registered trademark)**

Provisions of the LIGO do not influence the conditions for the registration, validity of the registration or the right to use the trademark which is identical or similar to the registered geographical indication, if the application for the registration or the registration of the concerned trademark has been done in a good faith or the trademark rights have been acquired by the use in good faith prior to the filing of the application for the registration of the geographical indication

- ▶ **Priority for the appellation of origin, reason Lisbon Agreement**

## LIGO

- ▶ Art. 46 (Prohibition of transfer)
- ▶ Registered appellation of origin or geographical indication cannot not be subject to the contract on transfer of rights, license agreement, pledge, franchise or the like.
- ▶ If registered appellation of origin or geographical indication is subject of the application for the registration of a trademark or is registered trademark, such a trademark cannot be transferred, assigned, pledged or the like.

## LIGO

- ▶ Art. 52 (Cease of the Appellation of Origin or Geographical Indication In the Country of Origin)
- ▶ Registered appellation of origin or registered geographical indication shall cease to be valid when its protection in the country of origin ceases.
  
- ▶ Art. 53 (Cease of the Geographical Indication Based on the Court Decision)
- ▶ Interested person may file a suit before the court in order to establish that certain geographical indication became generic.
- ▶ Registered geographical indication that is registered and protected in its country of origin as an appellation of origin, cannot be declared as generic, for as long as such protection is valid in the country of origin.
- ▶ After the responsible authority receives the court decision referred to in paragraph 3 of this Article, it shall insert the decision in the appropriate register and publish the prescribed information on the cease of validity of the geographical indication in the official publication.

## LIGO

- ▶ Art. 54 (Cease of the status of an authorized user of an appellation of origin or a geographical indication)
- ▶ Status of an authorized user lapses:
- ▶ if the authorized user of an appellation of origin or a geographical indication renounces his right – on the first day subsequent to the day on which the IPO receives the motion of renunciation;
- ▶ if an appellation of origin or a geographical indication cease based on the decision of the responsible authority according Articles 52 or 53 of the LIGO – on the day set in the decision concerned;
- ▶ if the legal person who is the authorized user ceased to exist or if the natural person who is the authorized user has died – on the day the legal person ceased to exist or on the day of death, except where the right has been transferred to the successors in right of the legal person.

## LIGO

- ▶ Art. 55 (Revocation of the decision to recognize the status of an authorized user)
- ▶ IPO may revoke a decision to recognize the status of an authorized user, if it determines that the conditions prescribed for the recognition of the status of an authorized user have ceased to exist.
- ▶ In the proceedings initiated upon the application for the revocation of a decision to recognize the status of an authorized user, an authorized user must prove the existence of the conditions prescribed by the law for the recognition of the status of an authorized user.

The status of a person inserted in the appropriate register as the authorized user of an appellation of origin or a geographical indication shall cease on the first day subsequent to the day the decision to revoke a decision to recognize the status of an authorized user became final and enforceable.

## LIGO

- ▶ Art. 56 (Civil law protection)– The plaintiff may request:
- ▶ determination of the infringement of an appellation of origin or a geographical indication;
- ▶ termination of the infringement of an appellation of origin or a geographical indication;
- ▶ destruction or alteration of the objects used to infringe of an appellation of origin or a geographical indication;
- ▶ destruction or alteration of the tools and equipment used to manufacture the infringing objects, if necessary for the protection of rights;
- ▶ reimbursement of pecuniary damages and justifiable legal costs and expenses;
- ▶ publication of the court decision at the expense of the defendant;
- ▶ supplying of information about third parties participating in the infringement of an appellation of origin or a geographical indication.
- ▶ Any person that infringes registered appellation of origin or registered geographical indication shall be liable for the damages in accordance with general rules of compensation of damages.
- ▶ If the infringement was intentional, the plaintiff may request from defendant the compensation amounting up to three times of the amounts of direct damage and lost profits.

## LIGO

- ▶ Art. 57 (Infringement)
- ▶ Any unauthorized use of registered appellation of origin or a geographical indication
- ▶ Imitation of the registered appellation of origin or geographical indication also constitute an infringement of an appellation of origin or a geographical indication.
- ▶ Art. 58 (Right to file an action)
- ▶ An action may be filed by any person who can establish IGO, authorized users and public or state prosecutor.
- ▶ Art. 59 (Time Limit to File an Action)
- ▶ Three years as subjective and five years as objective time limit from the day of the first infringement.

Zavod za intelektualnu svojinu  
Kneginje Ljubice 5  
11000 Beograd  
Telephone: +381 11-2025-800  
Telefax: +381 11-311-23-77  
E-mail: [zis.@.gov.rs](mailto:zis.@.gov.rs)  
Web site: [www.zis.gov.rs](http://www.zis.gov.rs)

# Thanks for the attention!

Miodrag St. Marković