

Geographical Indication Protection in the United States

United States Patent and Trademark Office

What Are “Geographical Indications”?

“Geographical indications” (“GIs”) are defined at Article 22(1) of the World Trade Organization’s (WTO) 1995 Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) as “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 geographic origin.” Examples of geographical indications from the United States include: “FLORIDA” for oranges; “IDAHO” for potatoes; and “WASHINGTON STATE” for apples.

Geographical indications can be viewed as a subset of trademarks. Geographical indications serve the same functions as trademarks, because like trademarks they are: 1) source-identifiers, 2) guarantees of quality, and 3) valuable business interests. The United States has found that by protecting geographical indications through the trademark system – usually as certification and collective marks -- the United States can provide TRIPS-plus levels of protection to GIs, of either domestic or foreign origin. The United States has provided protection to foreign and domestic GIs since at least 1946, decades prior to the implementation of the TRIPS Agreement (1995) when the term of art “geographical indication” came into wide use.

How Does the United States Protect Geographical Indications?

The United States’ GI system uses administrative trademark structures already in place, and provides opportunities for any interested party to oppose or cancel a registered GI if that party believes that it will be damaged by the registration or continued existence of a registration. The same governmental authority (the United States Patent and Trademark Office or “USPTO”) processes applications for both trademarks and GIs.

The United States does not protect geographic terms or signs that are generic for goods/services. A geographic term or sign is considered “generic” when it is so widely used that consumers view it as designating a category of all of the goods/services of the same type, rather than as a geographic origin. As an example, the word “apple” cannot be protected as a trademark for apples because the word “apple” is the generic name for the fruit. Many countries, such as the United States, do not protect generic indications because they are believed to be incapable of identifying a specific business source (or a specifically defined collective producing source). Once a geographic designation is generic in the United States, any producer is free to use the designation for its goods/services.

Another feature of the United States trademark/GI system is that it provides the trademark or GI owner with the exclusive right to prevent the use of the mark/GI by unauthorized parties when such use would likely cause consumer confusion, mistake or

deception as to the source of the goods/services. In this way, a prior right holder has priority and exclusivity over any later users of the same or similar sign on the same, similar, related, or in some cases unrelated goods/services where consumers would likely be confused by the two uses.

Benefits of Protecting Geographical Indications Through a Trademark System

Protecting GIs as trademarks, collective or certification marks employs the existing trademark regime, a regime that is already familiar to businesses, both foreign and domestic. Moreover, no additional commitment of resources by governments or taxpayers (for example, personnel or money) is required to create a new GI registration or protection system. A country's use of its existing trademark regime to protect geographical indications involves the use only of resources already committed to the trademark system for applications, registrations, oppositions, cancellations, adjudication, and enforcement. Furthermore, the system easily accommodates geographical indications that are not merely place names, but signs such as words, slogans, designs, 3-Dimensional marks, colors or even sounds and scents.

In addition to fulfilling all of the requirements of substantive GI and trademark obligations in TRIPS, this system meets the requirement for national treatment and the obligations in TRIPS regarding enforcement. (National treatment, an obligation in the TRIPS Agreement, requires WTO Members to provide the same or better treatment of foreign nationals regarding intellectual property rights as provided to domestic nationals.) Also, the system is self-policing: competitors, businesses in the geographic area, or mark owners will undoubtedly raise issues of infringement, and failure to comply with certification standards, among other things. Thus, governments do not have to commit additional enforcement resources to ensure compliance. Moreover, private owners are not forced to wait for their government to take action against infringement or address unauthorized use. The owner can determine when to take action and may do so immediately, at the first sign of infringement, thus preserving profits before they are channeled towards a competitor.

GIs as Certification Marks

The U.S. Trademark Act provides that geographic names or signs--which otherwise would be considered primarily geographically descriptive and therefore unregistrable as trademarks or collective marks without a showing of acquired distinctiveness in the United States--can be registered as certification marks.

A certification mark is any word, name, symbol, or device used by a party or parties other than the owner of the mark to certify some aspect of the third parties' goods/services. There are three types of certification marks used to indicate: 1) regional or other origin; 2) material, mode of manufacture, quality, accuracy or other characteristics of the goods/services; or 3) that the work or labor on the goods/services was performed by a member of a union or other organization.

The same mark can be used to certify more than one characteristic of the goods/services in more than one certification category: the mark ROQUEFORT (U.S. Registration No. 571,798) is used to indicate that the cheese has been manufactured from sheep's milk and cured in the caves of the Community of Roquefort (France) in accordance with their long established methods and processes.

The U.S. Trademark Act differentiates certification marks from trademarks by two characteristics. First, a very important feature of a certification mark is that its owner does not use it. Second, a certification mark does not indicate commercial source nor distinguish the goods or services of one person from those of another person. This means that any entity, which meets the certifying standards, is entitled to use the certification mark. However, certification marks are source-identifying in the sense that they identify the nature and quality of the goods and affirm that these goods have met certain defined standards.

A certification mark may not be used by the owner of the mark because the owner does not produce the goods or perform the services in connection with which the mark is used. The mark may be used only by entities other than the owner of the mark, with authorization from the owner of the mark. The certification mark owner controls the use of the mark by others on the certified goods/services, such control consisting of the taking steps to ensure that the mark is applied only to goods/services that contain or display the requisite characteristics or meet the specified requirements that the certifier/owner has established or adopted for the certification.

The purpose of a certification mark is to inform purchasers that the goods/services of the authorized user possess certain characteristics or meet certain qualifications or standards. A certification mark does not indicate origin in a single commercial or proprietary source. The message conveyed by a certification mark, when it is applied to goods or used in connection with services, is that the goods/services have been examined, tested, inspected, or in some way checked by the certifier/owner who is not the producer of the goods/services, by methods determined by the certifier/owner. The placing of the mark on goods or its use in connection with services thus constitutes a certification by someone other than the producer that the prescribed characteristics or qualifications of the certifier for those goods/services have been met.

In the experience of the United States, in most instances the authority that exercises control over the use of a geographical term as a certification mark is a governmental body or a body operating with governmental authorization. When a geographical term is used as a certification mark, two elements are of basic concern: first, preserving the freedom of all persons in the region to use the term and, second, preventing abuses or illegal uses of the mark which would be detrimental to all those entitled to use the mark. Generally speaking, a private individual is not in the best position to fulfill these objectives satisfactorily. The government of a region is often the logical authority to control the use of the name of the region. The government, either directly or through a body to which it has given authority, would have power to preserve the right of all persons and to prevent abuse or illegal use of the mark.

All applications for federal registration of certification marks are examined (as are applications for trademarks and collective marks) at the USPTO. The accompanying specimens of use and evidence in the record are reviewed to determine whether the geographical sign is being used as a certification mark to indicate the geographical origin of the goods/services upon which it is used. If the record or other evidence available indicates that a specific sign in question has a principal significance as a generic term denoting a type of goods/services, registration will be refused. *In re Cooperativa Produttori Latte E Fontina Valle D'Acosta*, 230 USPQ 131 (TTAB 1986) (FONTINA held a generic name of a type of cheese rather than a certification mark indicating regional origin, in view of the fact that non-certified producers outside that region use the term to identify non-certified cheeses).

If use of the sign is controlled by the certifier and limited to goods/services meeting the certifier's standards of regional origin, and if purchasers understand the sign to refer only to goods/services produced in the particular region and not to goods/services produced elsewhere, then the sign functions as a regional certification mark. *Institut National Des Appellations D'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998) ("COGNAC" held to be a geographical indication for brandy from France). If, before registration, the USPTO becomes aware that the applicant does not have the authority to exercise control over use of the certification mark, registration will be refused *ex officio*.

As for the enforcement of the certifiers' standards, competitors and consumers--those with the greatest interest in maintaining accuracy and high standards--ensure that certifiers maintain the requisite quality. Of course, the U.S. government has agriculture inspectors for various types of food and beverages, but that is something completely different. With respect to protection of geographical indication certification marks, affected parties can oppose registration or seek to cancel registrations, all within the existing trademark regime in the United States. So, if a party believes that the certifier is not following its own standards or is discriminating by denying use of the mark to a qualified party, that party can file an opposition or cancellation proceeding against the certification mark or an action in federal court.

GIs as Collective Marks

There are two types of collective marks in the United States: (1) collective trademarks or collective service marks and (2) collective membership marks. The distinction between these types of collective marks is explained by the Trademark Trial and Appeal Board (TTAB), a USPTO administrative tribunal, as follows:

A collective trademark or collective service mark is a mark adopted by a "collective" (*i.e.*, an association, union, cooperative, fraternal organization, or other organized collective group) for use only by its members, who in turn use the mark to identify their goods or services and distinguish them from those of non-members. The "collective" itself neither sells goods nor performs services under a collective trademark or collective service mark, but the collective may advertise

or otherwise promote the goods or services sold or rendered by its members under the mark.

A collective membership mark is a mark adopted for the purpose of indicating membership in an organized collective group, such as a union, an association, or other organization. Neither the collective nor its members uses the collective membership mark to identify and distinguish goods or services; rather, the sole function of such a mark is to indicate that the person displaying the mark is a member of the organized collective group.

Aloe Creme Laboratories, Inc. v. American Society for Aesthetic Plastic Surgery, Inc., 192 USPQ 170, 173 (TTAB 1976).

Collective trademarks and collective service marks indicate commercial origin of goods or services just as “regular” trademarks and service marks do, but as collective marks they indicate origin in members of a group rather than origin in any one member or party. All members of the group use the mark; therefore, no one member can own the mark, and the collective organization holds the title to the collectively used mark for the benefit of all members of the group. An agricultural cooperative of produce sellers is an example of a collective organization, which does not sell its own goods, or render services, but promotes the goods and services of its members.

The collective organization might conduct advertising or other promotional programs in which reference is made to the mark in order to publicize the mark and promote the business of the members, but this would be merely informational use or a publicity display of the mark.

GIs as Trademarks

Finally, under the U.S. regime, it is possible to protect geographical indications as trademarks. Pursuant to well-established U.S. trademark law, geographic terms or signs are not registrable as trademarks if they are geographically descriptive or geographically misdescriptive of the origin of the goods (or services). If a sign is misdescriptive for the goods/services, consumers would be misled and/or deceived by the use of the sign on goods/services that do not come from the place identified.

However, if a geographic sign is used in such a way as to identify the source of the goods/services and over time, consumers start to recognize it as identifying a particular company or manufacturer or group of producers, the geographic sign no longer describes only where the goods/services come from, it also describes the "source" of the goods/services. At that point, the sign has "secondary meaning" or "acquired distinctiveness." The primary meaning to consumers is the geographic place; the secondary meaning to consumers is the producing or manufacturing source. If a descriptive sign has "secondary meaning" to consumers, the sign has a source-identifying capacity and is protectable as a trademark. Because of this feature of U.S. trademark law, GIs can also be protected as trademarks or collective marks. There are many signs that

meet the TRIPS definition of a GI that have been protected as trademarks in the United States for many years.

Opposition and Cancellation

If a party would be aggrieved by the registration of a trademark, service mark, certification mark or collective mark or would be damaged by the continued existence of a U.S. registration, that party may institute a proceeding at the TTAB, an administrative body at the USPTO. The TTAB has jurisdiction over opposition and cancellation proceedings as well as over appeals from an examining attorney's final refusal to register a mark in an application.

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration of a mark on the Principal Register. "Any person who believes that he would be damaged by the registration" of a mark may file an opposition thereto, but the opposition may be filed only in response to the publication of the mark during the application in the Official Gazette of the USPTO. A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration of a mark. The proceeding may only be filed after the issuance of the registration. A petition for cancellation may be filed by "any person who believes that he is or will be damaged by the registration" of the mark.

The losing party at the TTAB level may appeal the TTAB's decision to the Court of Appeals for the Federal Circuit, a court with jurisdiction, *inter alia*, over intellectual property matters. From that court, the losing party may appeal to the U.S. Supreme Court.

Common-Law Geographical Indications

Geographical indications also are protected through common law trademark law without being registered by the USPTO. For example, the TTAB has held that "COGNAC" is protected as a common-law (unregistered) certification mark in the United States. *Institut National Des Appellations v. Brown-Forman Corp*, 47 USPQ2d 1875, 1884(TTAB 1998) ("Cognac" is a valid common law regional certification mark, rather than a generic term, since purchasers in the United States primarily understand the "Cognac" designation to refer to brandy originating in the Cognac region of France, and not to brandy produced elsewhere, and since opposers control and limit use of the designation which meets certain standards of regional origin.)