

# International Standards for the Protection of Trademarks



Cindy Henderson, Attorney-Advisor  
U.S. Patent and Trademark Office  
(571) 272-9300  
[Cynthia.Henderson@uspto.gov](mailto:Cynthia.Henderson@uspto.gov)



# Topics to be Covered:

- Trademark Subject Matter (TRIPs)
- Well-known Marks (TRIPs)
- Geographical Indications (TRIPs)



# TRIPS Article 15

“Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.”

“Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs shall be eligible for registration as trademarks.”



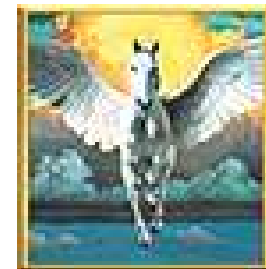
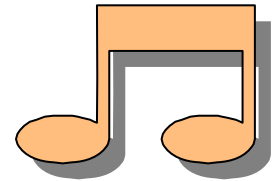
# Eligible Subject Matter

Any word, name, symbol or device (or any combination thereof) used to identify and distinguish goods or services and to indicate their source

In the U.S., trademarks can be slogans, letters, numbers, logos, three-dimensional designs, colors, *scents*, and *sounds* that indicate the source of a good or service to consumers.

# Unusual Trademarks

- Shape: Bottle shape for soda pop
- Color: Pink color for insulation
- Sound: Three chimes sound for television broadcasting services
- Scent: Plumeria flower blossom scent for sewing thread
- Motion: Flying pegasus for movie studios
- 





# TRIPs Article 16

“The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods and services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.”



# Likelihood of Confusion

The United States' Trademark Act, the Lanham Act, says that the USPTO must refuse registration of an application for a mark when it is likely --when the mark is used on or in connection with the goods of the applicant -- to cause confusion, to cause mistake, or to deceive.

15 USC Section 1052.

Two main considerations:

- Similarity of marks and
- Relatedness of the goods/services.



# Related Goods or Services

Confusion is not determined based on the same Nice Classification but on the nature of the goods or services and their relatedness.

Shoes (Class 25) and Shoelaces (Class 26) – Related Goods but Different Classes.

Computers (Class 9) and Life-saving Buoys (Class 9) – Unrelated Goods but the same Class.





# Well-Known Marks

Paris Convention Article 6bis

Members must protect well-known marks from infringement whether registered or unregistered.

This obligation is incorporated into Article 16 of the TRIPS Agreement.



# Well-Known Marks and Relatedness

Relatedness of goods and services is less important in infringements of well-known marks.

TRIPs Article 16(3): A well-known mark will be found to be infringed *even if used on unrelated goods* if consumers would be confused and the well-known mark holder would likely be damaged.

“Buick” Aspirin  
“Kodak” Shoes



# Well-Known Marks – Non-exhaustive List of Factors for Judges to Consider

- Degree of distinctiveness
- Duration and extent of use of the mark
- Duration and extent of advertising of the mark
- Extent of geographical trading area
- Channels of trade
- Degree of recognition of the mark in those channels of trade
- Nature and extent of use of same/similar marks by third parties
- Whether the mark is registered



# Geographical Indications

## TRIPs Article 22

- “[I]ndications 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.”
- Idaho potatoes, Napa Valley wine, Parma Ham



# Geographical Indications as Certification Marks

- The U.S. view is that GIs are a subset of trademarks because they are source-identifiers, guarantees of quality, and business interests.
- In the U.S., GIs are protected within the trademark system as certification or collective marks.



# Certification Marks

- Can certify:
- 1) geographic origin;
- 2) materials used, quality, method of manufacture, and accuracy; or
- 3) products made under the auspices of, or by members of a specific trade union or organization.





# Examples of Geographical Indications Protected in the U.S.

- Roquefort Cheese (France) - U.S. Reg. No. 0571798
- Idaho Potatoes (U.S.) - U.S. Reg. No. 1,735,559
- Stilton Cheese (U.K.) - U.S. Reg. No. 1959589
- Parma Ham (Italy) - U.S. Reg. No. 2014628
- Cognac (France) – common law certification mark



# Opposition and Cancellation

- Available to anyone:
  - 1) domestic or foreign,
  - 2) who would be damaged by the registration, or the continued existence of a U.S. registration.
- Trademark Trial and Appeal Board (“TTAB” or “Board”), of the U.S. Patent and Trademark Office (USPTO).





# Court Actions

## □ Federal (national) law:

- System for registration;
- Lanham Act prohibits infringement and unfair competition;
- Federal common law;

## □ State law:

- Systems for registration;
- State statutes prohibit infringement and unfair competition;
- State common law.



Trademark information:  
<http://www.uspto.gov>

Thank you!