

Geographical Indications (GIs) in the U.S.: Protection Through a Trademark System

Laura Hammel

Regional Intellectual Property Attaché for Mercosur, the Guianas, and Suriname

United States Patent and Trademark Office

UNITED STATES
PATENT AND TRADEMARK OFFICE



Topics To Be Covered

- Background to the U.S. Approach
 - Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS): Important Tenants
 - Why the U.S. Chose to Protect GIs Under Our Existing Trademark System
- Types of Protection
 - Certification Marks
 - Collective Marks
 - Trademarks
- The Application and Registration Process

TRIPS: Important Tenants

- TRIPS Preamble: “Recognizing that intellectual property rights are **private rights**...”
 - GIs are included in the list of intellectual property rights in TRIPS
 - therefore they are private rights.
 - A private right must have an “**owner,**” which can be a public authority, but it can also be an entity such as a private collective or certifier.
- TRIPS Article 1(1): “Members shall be **free to determine the appropriate method** of implementing the provisions of this Agreement within their own legal system and practice.”
 - A separate sui generis GI system is not required.

Why the U.S. Chose to Protect GIs Under the Existing Trademark System

Background of the U.S. Approach: Protection of GIs Under U.S. Trademark System

- After reviewing the TRIPS requirements and comparing them to our existing law, **we found that our trademark system already protected GIs.**
- We chose not to create a whole new system because there was no need to complicate our trademark laws with redundant protection.
 - We also knew that creating **two systems for the same protection could lead to miscommunication** between trademark and GI offices – and the **possible result of diminishing or extinguishing prior trademark rights.**

No Substantial Difference Between GIs and Geographically Distinctive Trademarks

- **GI**s are “indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.” TRIPS Article 22(1).
- **Geographically Distinctive Trademark** identifies the geographic source of a product that has acquired its quality, reputation or other characteristics from that named region.

Both **GI**s and **Geographically Distinctive Trademarks** provide consumers with an important **positive association with a product**. If it has reputation as a quality product, consumers will buy it and even tell others about how good it is (free advertising). Both are **great marketing tools** for producers who will get more money for their efforts because consumers will pay premium dollars to buy their products instead of spending less on inferior ones.

Trademark Systems Are a Good Fit For Protecting GIs

- Provides **protection for source indicators** – GIs and trademarks indicate the geographic source of the product to which a consumer has associated desirable characteristics.
- Allows for a **geographic term to acquire distinctiveness because of its** reputation, when a term is no longer just a geographic designation and has secondary meaning as a source indicator.
- **Respects prior rights** through ex parte examination procedures and inter partes proceedings (can be based on common law use) – prior owners should not have to relinquish the goodwill they have established in their marks.
- **Does not require governmental involvement:**
 - No additional governmental “red tape” (it can be difficult to get protection for foreign products where governmental involvement is required)
 - The USPTO has registered over 100 foreign GIs - more than our domestic ones!

Trademark Systems Are a Good Fit For Protecting GIs—Continued

- Recognizes the **importance of preserving generic terms for producers** – loss of generics can result in **higher prices and customer confusion if the generic word needs to be renamed**. Granting intellectual property rights to private parties necessitates an examination of the impact of that potential grant of exclusivity on consumers and others in the marketplace. Terms that are descriptive or generic should remain free to be used by competitors and remain reliable identifiers for consumers as they make purchasing decisions.
 - **Genericness Test:**
 - What is the **common name of the goods**?
 - Does the **relevant public** (actual or potential purchasers of the particular goods in the marketplace – from vendors to ultimate purchasers) **understand the designation primarily to refer to that common name of the goods**?
 - **Determining Genericness in Examination:**
 - **Consumer perception** is key when determining whether a term is generic in the U.S. and this determination is done on a **case-by-case basis**, depending on the facts.
 - The trademark examiner may generate **evidence from any competent source**, including: dictionaries, research databases, newspapers, Internet evidence, categories in catalogues, sections of grocery stores, proof that the product comes from more than the country of applicant, and other publications.
 - **Compound Marks: Sometimes components of compound phrases are generic.** Therefore, it is important to understand which part of the compound phrase is the GI and which is the generic term. **Protection should not be conveyed to the generic term(s)** – and that should be made clear so that the compound designation doesn't affect legitimate generic trade.
 - The USPTO will require an applicant to **disclaim** any part of the mark that is descriptive or generic and not considered unitary, or inseparable, from the mark. An element may be considered as "unitary" if it creates a single and distinct commercial impression and if considered unitary, no disclaimer is required.
 - **A disclaimer does not physically remove the disclaimed matter from the mark**, but rather is a written statement that **applicant does not claim exclusive rights to the disclaimed wording** and/or design separate and apart from the mark as shown in the drawing.

Types of Protection

Certification Marks: Examples

PARMIGIANO
REGGIANO



(with a disclaimer of "SILK")

CAPPERO DI
PANTELLERIA

(with a disclaimer of "CAPPERO")

DARJEELING



(with a disclaimer of "THAI" and
"RICE" and "DEPARTMENT OF
FOREIGN TRADE" and
"ORIGINATED IN THAILAND")

What is a Certification Mark?

- Used by a person **other than its owner**, or which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by the U.S. Trademark Act
 - Owners cannot themselves use the mark because of the presumed bias in favor of their own products meeting the standards.
- **Certifies regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics** of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

Regional Certification Marks

- Protects geographical signs that certify goods originate in the region identified, where use of the sign:
 - is **controlled by the certifier**,
 - is limited to **products meeting the certifier's standards** of regional origin, and
 - **purchasers understand the sign to refer only to products from that region.**

Certification Marks: Standards


- **Owners of certification marks determine the standards** that each producer must meet in order to use the certification mark on its packaging.
- **Certification mark applications must include the certifier's standards** used to determine whether a product is qualified to display the certification mark.
- These **standards should be created bottom up, by the certifier and the growers** – not top down, by the governments. If the owners and producers need help from the government they can always ask for it – it should never be imposed.
- **Standards include** the demarcations of the territory where the product is grown, the desirable characteristics, the climate and topography that produce those characteristics, testing qualifications, etc.
- **Owners cannot discriminate against those producers who meet the certification standards** – these producers must be allowed to use the mark.

Certification Marks are Self-Enforcing

- **No government inspection is necessary** – except for health or safety reasons.
- The **certification standards provide for inspection** of the products – **by someone designated by the certifier**. This can be an independent inspector.
- The **logic for non-involvement of government** is that it is in the **owner's best interest to ensure that its product retains the quality characteristics for which consumers are paying top dollar** – otherwise the diminished quality of the product could have a negative impact on sales and this would eventually lead to the devaluation of the mark and the diminishing of profits for producers.

Collective Marks: Example



THE AREA WHERE ORIGINAL  PECORINO ROMANO CHEESE COMES FROM



PECORINO ROMANO IS AN OFFICIAL REGISTERED DENOMINATION (D.P.R. N. 1269 OF 30/10/1955) ENLISTED IN THE ENCLOSED A OF THE STRESA INTERNATIONAL CONVENTION ON THE DENOMINATION OF ORIGIN AND TYPES OF CHEESES. PRODUCTION AND SALES ARE, BY DELEGATION, CARRIED OUT BY THE ITALIAN STATE (D.M. 14/1/1981) UNDER THE CONTROL FROM THE **CONSORZIO PER LA TUTELA DEL FORMAGGIO PECORINO ROMANO**, FOUNDED BY THE PRODUCERS THEMSELVES.

- CHEESE MADE FROM SHEEP'S MILK
- Owner: CONSORZIO PER LA TUTELA DEL FORMAGGIO PERCORINO ROMANO UNINC. ASSOCIATION ITALY
- Disclaimer of "PECORINO ROMANO."
- Map shows where product originates.

What is a Collective Mark?

- **Used by the members of a cooperative, an association, or other collective group** or organization, or which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by the Trademark Act, and includes marks indicating membership in a union, an association, or other organization.
 - The collective organization itself does not sell the goods under the mark, but may advertise to publicize the mark and promote the goods sold by its members under the mark. For example, an agricultural cooperative of produce sellers does not sell its own goods, but promotes the goods of its members who do sell the goods.
- Under the Trademark Act, a collective mark is **owned by a collective entity even though the mark is used by the members of the collective**.
 - No one member can own the mark—the collective organization holds the title to the collectively used mark for the benefit of all members of the group.

Trademarks: Examples

- PROVOLONE VALPADANA for “cheese” (with “PROVOLONE” disclaimed).
- The Government of Ethiopia secured trademark registrations for the following geographic trademarks, all for use in connection with coffee:
 - SIDAMO
 - HARAR
 - YIRGACHEFFE

The Application and Registration Process at the USPTO

Advantages of USPTO Registration

- Serves as **constructive notice** nationwide of trademark owner's claim to the mark.
 - The **USPTO's electronic database** is a valuable source for providing notice to third parties that the registrant claims exclusive rights to the mark. Applicants routinely search the database prior to filing.
 - The prudent applicant will forego filing if a confusingly-similar mark is uncovered.
 - This benefits both the rights holder and the applicant because it eliminates the need to litigate.
 - **TRIPS Article 63 requires transparency.** The USPTO's system provides that and additional benefits to its users.
- Is **evidence of ownership** of the mark.
- **Facilitates suing in U.S. Federal Courts.**
- Can be used as a **basis for obtaining registration in foreign countries.**
- May be **recorded with U.S. Customs Service to prevent importation of infringing foreign goods.**

The Application Process

- Electronic **application filed** with the USPTO.
- Application **examined** by a USPTO examiner.
- If refused registration, an **opportunity to appeal** that decision within the USPTO is provided.
- If approved, interested parties can **oppose** registration.
 - Available to anyone (domestic or foreign), who believes they would be damaged by the registration.
 - Cases may be heard by the USPTO's Trademark Trial and Appeal Board (TTAB) or U.S. Federal Courts.
- If no opposition, or the applicant prevails, then the **registration will issue**.
- Although relatively rare, a third party may **petition to cancel the registration**.
 - Available to anyone (domestic or foreign), who believes they would be damaged by the continued existence of the registration.
 - Cases may be heard by the USPTO's Trademark Trial and Appeal Board (TTAB) or U.S. Federal Courts.

USPTO's Trademark Electronic Application System (TEAS) Filing Options

Questions	TEAS Plus	TEAS Reduced Fee (TEAS RF)	TEAS Regular
What is the filing fee per class of goods/services?	\$225	\$275	\$325
Must the application include an e-mail address and authorization for the USPTO to send application-related e-mail correspondence?	Yes	Yes	No
Must certain subsequent application-related submissions, such as responses to Office actions, be filed via TEAS?	Yes	Yes	No
Must the identification of goods/services be selected from the USPTO Trademark ID Manual?	Yes	No	No
Must the filing fee per class for all classes listed in the application be paid upfront?	Yes	No	No
Must certain statements regarding the mark be provided in the application as filed, if applicable (e.g., translation statement, claim of ownership, color claim and description, if applicable)?	Yes - see TMEP §819.01	No	No
Is there an additional processing fee if applicant does not satisfy the relevant filing option requirements?	Yes - \$50 per class of goods/services	Yes - \$50 per class of goods/services	No

Filing Basis

- There are 5 bases for foreign applicants in the U.S.:
 - Bona fide intent to use the mark in commerce
 - Use in commerce
 - Priority based on an application filed in home country within the prior 6-month period*
 - Foreign registration*
 - Madrid Protocol*

***Common Filing Basis for Foreign Applicants**, which require the applicant to state a bona fide intention to use the mark in U.S. commerce, e.g. a business plan for introducing this product in the U.S.

Applicant Has Time to Use the Mark in U.S. Commerce

- If the **U.S. application is based on a foreign filing**, the foreign owner does not have to use the mark in U.S. commerce until 3 years after registration (or may be subject to a non-use cancellation), but more likely 6 years after registration, when a declaration of use must be filed.
 - This is not true for American applicants because they must use the mark in U.S. commerce before it can be registered.
 - TRIPS Article 3 requires WTO Members to afford nationals of other Members no less favorable treatment – the U.S. actually treats foreign rights holders more favorably.

Examination Timeline

FISCAL YEAR 2015

(October 1, 2014 through September 30, 2015)

- Examination: 2.9 months from filing to 1st Office Action
- Registration: 10.1 months after filing

Maintaining Rights in the U.S.

- Once the registration issues, a showing of use in commerce with the U.S. between the 5th and 6th year of registration is necessary.
 - Cost: \$100 per class.
- This is also required for renewing a registration every 10 years.
 - Cost: \$300 per class.
- Electronic forms can be completed very easily; much of the data is prepopulated.
- The owner must exercise control over use of the mark, otherwise it may become generic.

Protecting Your IP in the U.S.

- As discussed, you should **register** marks and **maintain** the registrations.
- You may also **license use of marks, in writing**, with manufacturers, distributors, and any other authorized third-party users.
- **Exercise quality control** over the licensees' products.
- **Monitor** the online USPTO Official Gazette (and similar publications in other countries), monitor the marketplace, and **STOP** unauthorized third-party uses.

Conclusion

- An existing trademark system can protect GIs, either as certification marks, collective marks, or trademarks.
- Trademark systems are user-friendly – countries, consumers and producers are familiar with them.
- They protect prior rights.
- They recognize that generic terms must be available for all producers to use.
- The U.S. trademark system is TRIPS compliant, efficient, transparent, and economical.

Important Links

- Trademarks Home Page:
<http://www.uspto.gov/trademark>
– or links to searching, status, documents, electronic forms, etc.
- Trademark Manual of Examining Procedure:
<http://tess2.uspto.gov/tmdb/tmep/>

Questions?

Laura.Hammel@trade.gov

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