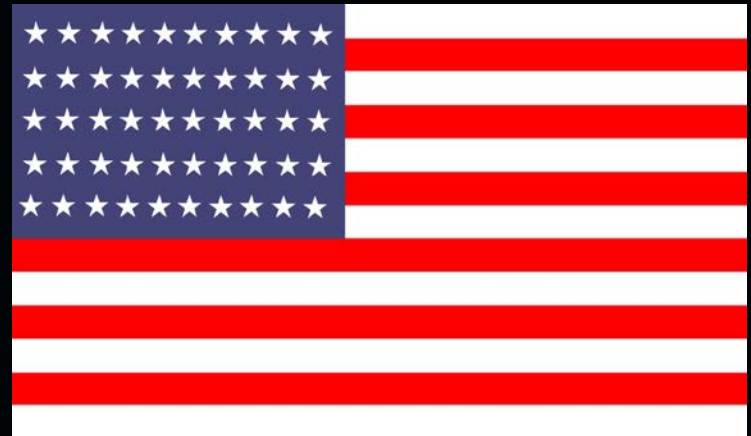


Geographical Indications in the United States

Donna A. Tobin

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Does the US Protect GIs?

- Yes. The US has protected GIs Since 1929
 - Inter-American Convention 1929
- The US is a Member of the WTO 1995 TRIPS Agreement.
 - Obligation to provide the same or better treatment of foreign nationals regarding IP as domestic.
 - Obligation to provide means for protection of Geographical Indications.
 - Geographical Indications are defined in 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 geographical origin.”



How does the US Protect GIs?

- As a subset of trademarks under the existing US trademark law – Lanham Act.
- Basic tenants of US trademark law
 - “An owner’s mark is his authentic seal; by it he vouches for the goods which bear it; it carries his name for good or ill. If another uses it, he borrows the owner’s reputation, whose quality no longer lies within his own control. This is an injury...” 2d Cir. (1928)
- Benefits to the approach:
 - Private owners are not forced to wait for government enforcement
 - GI owners are afforded the exclusive right to prevent use of their mark where such use would cause confusion.
 - Generic terms are available to all for use.

Options for Protection of GIs Under U.S. Trademark Law

- Certification Marks
 - Prosciutto di Parma
- Collective Membership Marks
- “Regular” Trademarks
- Common Law Trademarks
 - Cognac



Certification Marks

- What is a Certification Mark?
 - Geographical Name which would be considered primarily geographic and therefore unregistrable without a showing of acquired distinctiveness.
 - Characteristics
 - Name, word, symbol used by parties **other than the owner** to certify an aspect of goods or services.
 - Does not indicate commercial source nor distinguish the goods/services of one person from those of another.
 - Are source identifying as they affirm goods/services have met certain standards.
 - Can be used by any entity meeting certifying standards and obtaining certification.

Types of Certification Marks

- Three different types:
 - Indications of regional or other origin
 - Indications of mode of manufacture, material, quality, accuracy, etc.
 - Indication that work or labor on the goods/services was performed by a member of a union or other organization.

Examples of GIs Registered as US Certification Marks

- Roquefort (Reg. No. 571,798)
- Parma (Reg. No. 2,014,628)
- Brunello di Montalcino (Reg. No. 1,860,163)
- Liebfraumilch (Reg. No. 1,008,251)
- Darjeeling (Reg. No. 2,685,923)
- Jamaica Blue Mountain Coffee (Reg. No. 1,414,598)
- Vidalia (Reg. No. 1,709,019)
- Parmigiano Reggiano (Reg. No. 1,754,410)



PARMIGIANO
REGGIANO



Obtaining a Certification Mark

- Examined by US PTO
 - Submissions of specimens and evidence relating to the use of the mark
 - Registration will be refused if:
 - If principal significance of mark **in the US** is as a generic term registration will be refused.
 - (Fontina held to be generic for a type of cheese).
 - Registration will be granted if:
 - Owner has authority to exercise control over the mark and use on goods/services
 - Mark and use on goods/services is controlled by certifier (owner)
 - Purchasers understand the mark to refer only to goods/services produced in particular place not elsewhere
- Typically owner is a governmental agency or one operating with government authority.
 - Best suited to preserve freedom of all persons in region to use mark
 - Best suited to prevent abuses or unauthorized use of the mark



Collective Marks

- **Collective Mark:**
 - Adopted by collective (union, cooperative, etc.)
 - For use only by members
 - Members use mark to identify their goods/services and distinguish them from those of non-members.
 - Collective itself does not sell or render goods/services under mark
- **Collective Membership Mark:**
 - Sole function is to indicate membership
 - Not used in connection with goods/services

“Regular” Trademarks

- Geographic marks registrable upon proof of secondary meaning
- Owner supplies goods/services
- Example:



- Owned by Florida Department of Citrus (Florida state agency)
- For: “Advertising, marketing and promoting sales by way of television and radio broadcasts and webcasts through an online global computer network, and websites; production of television commercials.”

Common Law Trademarks

- US is a "first to use" jurisdiction.
- Trademarks, including certification marks, can exist even if not registered.
- Example: COGNAC
- Weighing federal registration over common law use

® = federal

common law = **TM**

Donna A. Tobin

Frankfurt Kurnit Klein & Selz

488 Madison Avenue

New York, NY 10022

212-705-4878

dtobin@fkks.com

