

FROM THE TRENCHES

Geographical Indications

Some thoughts on the practice of the US Patent and Trademark Office and TRIPs

BERNARD O'CONNOR*

This section is intended for occasional contributions from on-the-ground practitioners. Our hope is that the definition of this category of paper will inspire practitioners to submit notes and articles – typically in the range of 2,000 to 10,000 words – to the World Trade Review. As with all notes and articles submitted to the World Trade Review, manuscripts in this category will be reviewed by independent referees. However, the focus is intended to be practice oriented and at least one of the two referees will be a fellow practitioner.

Background

Article 22(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) sets out the most commonly accepted definition of Geographical Indications (GIs). The paragraph provides:

Geographical indications are, for the purposes of this Agreement, 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.

The question to be addressed in this short note is whether the United States system for the protection of GIs, as applied by USPTO, is in compliance with this provision.

* Bernard O'Connor is a partner in the Italian law firm NCTM and teaches trade law at MILE (Bern) and IELPO (Barcelona) and food law at the State University of Milan.

The protection of GIs in the US

The United States Patent and Trademark Office (USPTO) maintains a web page on its web site dedicated to GIs.¹ This web page makes reference² to a document entitled 'Geographical Indication Protection in the United States'.

This paper shows that the US views GIs as a subset of trademarks. The paper states that '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 paper further provides that the same government authority, the USPTO, is responsible for processing applications for both trademarks and GIs.

USPTO therefore considers that the US trademark system is an adequate means of compliance with WTO TRIPs obligations. The paper observes: the use of the trademark system has meant that the US has not been required to establish costly GI-specific administrative procedures; that business is familiar with the trademark system; that the US approach meets WTO national treatment and enforcement requirements.

USPTO states that GIs can be protected in a variety of ways within trademark law. The paper first looks at GI protection by means of Certification marks made up of geographical names or signs: geographical names would not normally be registrable as marks, but can be registered as certification marks. Certification marks can be distinguished from normal marks in that, normally, they cannot be used by the owner of the mark, and that the user of the mark is under the control of the mark holder and obliged to comply with the conditions of use. USPTO observes that in most cases the owner of the mark will be a government body or a body operating with governmental authorisation.

The second means of GI protected in the US is as a Collective mark. '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.'

The third means indicated by the USPTO paper is that GIs can be protected as normal trademarks. The paper points out that normally a geographical term or sign is not registrable if they are geographically descriptive or geographically mis-descriptive of the true origin. However, if such a term or a sign may, over time, attain a secondary meaning or an acquired distinctiveness then the sign has a *source-identifying* capacity and is protectable as a trademark.

1 <http://www.uspto.gov/ip/global/geographical/>

2 See quick link: United States GI system.

Finally, the paper indicates that GIs can also be protected through common law without being registered by the USPTO. The example of Cognac is given.

The approach of the European Union

The European Union takes a different approach to protection of GIs. Particular emphasis is placed on the link between the given characteristics of a food product and its geographic origin. In comparison to the EU system, questions can be raised as to whether the US system is compliant with the TRIPs requirement to show a link or even to properly define the geographic origin.

One core element of the EU system is to be found in Article 7 of Regulation 1151/2012. Among other elements, this Article sets out the requirement that there must be a link between the origin and the product for which protection is sought. Article 7(1)(f) provides that applications for registration as GIs must provide details establishing:

- (i) the link between the quality or characteristics of the product and the geographical environment referred to in Article 5(1); or
- (ii) where appropriate, the link between a given quality, the reputation or other characteristic of the product and the geographical origin referred to in Article 5(2).

To this must also be added (within the terms of Article 7(1)(b)):

a description of the product, including the raw materials, if appropriate, as well as the principal physical, chemical, microbiological or organoleptic characteristics of the product.

The language used in the EU rules reflects the definition of a GI in Article 22 of the TRIPs, namely, that *a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin*. The EU considers that it is necessary to show a link so as to fulfill the *essentially attributable* test set out in the TRIPs.

As an aside, it can be considered that the EU approach is less comprehensive than that of the US in some respects. The EU as a whole does not have a regulatory system for the protection of industrial GIs and restricts the protection for foods to 'names'. While the names can be both geographical names or other names having a strong link to a geographical origin, the EU does not appear to allow the protection of the wider concept of 'indications'.³

³ See generally Regulation (EU) No 1151/2012. This object of this note is not to examine the compatibility of the EU regime with TRIPs.

The USPTO examination guide

USPTO publishes guides as to how examiners should implement the law. These Examination Guides are updated regularly and, as part of an effort to gain constructive input from trademark practitioners and other stakeholders, are open to comment.

In 2013, USPTO published draft Examination Paper no 13 dealing with Geographic Certification Marks. The consultation Paper was dated July 2013 but also contains the date 26 June 2013 preceded by the word 'draft'. The Paper is no longer available for comment. Nor is it available on the USPTO web site. However the publicly available Trademark Manual of Examination Procedure (TMEP) from October 2013 provides a summary of the more detailed provisions that were set out in consultation Paper no 13. Examination Paper no 13 can be still be found with a Google search.⁴

Paper no 13 provided:

Specifically, the guide describes the application requirements for geographic certification marks, explains the analysis for determining whether a mark functions to certify regional origin, discusses the relevant considerations for Section 2(d) likelihood-of-confusion determinations involving geographic certification marks, and provides examples illustrating some of the concepts covered.

The certification statement in a geographic certification mark application must define the regional origin that the mark certifies. The identified region could be as large as a country or as small as a village, and need be defined only generally in the certification statement (e.g., 'the Darjeeling region in India' or 'the community of Roquefort, Department of Aveyron, France'). The certification standards, however, will likely be more specific as to the particular geographic boundaries involved.

If the available evidence indicates that the region identified by the geographic designation in the mark is famous as a source of the identified goods or services, or that the goods or services are principal products of the region, the certification statement must limit the defined region to the region identified by the designation in the mark. When the certification statement is not appropriately limited in these instances, it is possible that the mark will be applied to goods or services that do not originate in the region named in the mark. Thus, the mark will be geographically deceptive as to those goods or services and must be refused accordingly. The applicant may overcome the refusal by amending the certification statement to limit the defined region to the region identified by the geographic designation in the mark.

⁴ See http://webcache.googleusercontent.com/search?q=cache:21t4_1DhDmMJ:www.uspto.gov/trademarks/notices/GeoCertExamGuide_-_26_JUNE_2013_-_External_Distribution.doc+%&cd=1&hl=it&ct=clnk&gl=it&clicl=firefox-a. Accessed on 5 April 2014.

Chapter 1300 of USPTO's TMEP⁵ in relation to Service Marks, Collective Marks and Certification Marks, mirrors Paper no 13 by providing:

When a geographic term is being used as a certification mark to indicate regional origin, the application should define the regional origin that the mark certifies. The defined region in the certification statement should be limited to the place named in the mark if the named place is famous as a source of the goods or the goods are a principal product of that place.

The defined region in the certification statement may be broader than the place named in the mark as long as the place named in the mark is within the larger defined region and there is no evidence that it is famous as a source of the goods or they are a principal product of the place. If there is evidence that the narrower geographic area named in the mark is famous for the goods or they are a principal product of that place, and by virtue of the broader region identified in the certification statement the goods may not originate in the geographic location named in the mark, the examining attorney must refuse registration of the mark as geographically deceptive under §2(e)(3) of the Trademark Act. See §§1210.05–1210.05(e).⁶

At first sight USPTO appears to address the question of the link or the *essentially attributable* test. USPTO examines the link between the proposed mark and the fame of the product to which it is to be applied. But is this link in relation to essential characteristics or even in relation to reputation? It appears not. Paper no 13 provided a more detailed analysis of how USPTO examiners must apply the law when applications for the registration of regional names are received:

To illustrate the relevant analysis, if the applied-for mark consists of the wording MARYLAND APPLES, and the certification statement indicates that the mark certifies that the apples it is applied to originate in Maryland, Virginia, or Delaware, the examining attorney must determine if Maryland is famous for apples or if Maryland's principal products include apples. If so, the examining attorney must refuse registration, pending an appropriate amendment to the certification statement to limit the defined region to Maryland.

If there is insufficient evidence to conclude that the region identified in the mark is famous for the goods or services, or that the goods or services are principal products of the region, the region defined in the certification statement may be broader than the region named in the mark. However, the region named in the mark must still be encompassed by the larger region specified in the certification statement.

There are two problematic elements here. The first is the name to be registered (or the mark). The second is the geographic area in which the mark can be used. These two elements need not be the same. To continue with the MARYLAND

⁵ See <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/d1e2.xml>.

⁶ See 1306.02(a) at <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/Oct2013/TMEP-1300d1e1.xml>.

APPLES example, if Maryland is not famous for apples or apples are not a principal product of Maryland, then it would be possible to use the MARYLAND APPLES certification mark on apples originating in Virginia and Delaware.

Does this comply with USPTO's own description of a Geographic Certification mark as:

a word, name, symbol, device, or some combination of these elements, which certifies that goods or services originate in a particular geographic region.⁷

Or is this more in line with the USPTO's description of a Certification trademark as:

any word, phrase, symbol or design, or a combination thereof owned by one party who certifies the goods and services of others when they meet certain standards. The owner of the mark exercises control over the use of the mark; however, because the sole purpose of a certification mark is to indicate that certain standards have been met, use of the mark is by others.⁸

In other words, the second scenario whereby the MARYLAND APPLES mark may be used to certify certain standards in relation to apples coming from Virginia and Delaware, is more akin to a traditional certification mark than a geographic certification mark. This becomes confusing and could even be deceptive: allowing the use of a geographical name MARYLAND in relation to products not originating there, even if the condition that Maryland is not famous for apples is met, may ultimately be deceptive as to the true origin of the apples. In that case, according to established practice and the Examination Guide itself, the mark should not be registered.

The elements to be considered, according to the USPTO's web site when determining if geographically descriptive mark should be refused under Trademark Act §2(e)(3) are as follows:

- (1) the primary significance of the mark is a generally known geographic location;
- (2) the goods or services do not originate in the place identified in the mark;
- (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark; and
- (4) the misrepresentation would be a material factor in a significant portion of the relevant consumers' decision to buy the goods or use the services.

It is hard to see how the example of Virginia and Delaware apples being marketed under the MARYLAND APPLES certification trademark would not fall within the first three criteria. It is clear that not all the apples being sold

⁷ See Geographical Certification Marks, Examination Guide no 13.

⁸ See http://www.uspto.gov/faq/trademarks.jsp#_Toc275426676.

come from Maryland. In addition, given the use of the term MARYLAND it is likely that the consumer could assume that the apples come from that State. In relation to the fourth criteria, USPTO does not appear to require the examiner to evaluate the possibility of material deception. All the examiner has to do is determine if Maryland is famous for apples or they are a primary product from that State. If so, the different consequences seem to apply automatically.

A subsequent section of Paper no 13 addresses Geographic designations that do not certify regional origin. The Paper provides:

Sometimes, a geographic designation in a certification mark is not used to certify the geographic origin of the goods or services. Consider, for example, a certification mark that includes the word ‘California’ and is used to certify that the fruits and vegetables to which it is applied are organically grown. The word ‘California’ may or may not describe the geographic origin of the goods, but it is not being used to certify that the goods originate in California. If a geographic designation in a certification mark is primarily geographically descriptive of the goods or services, and the certification mark’s purpose, as indicated by the certification statement, is to certify something other than geographic origin, the examining attorney must refuse under Trademark Act Section 2(e)(2) or require a disclaimer, as appropriate. If a geographic designation in a non-geographic certification mark is geographically deceptive as applied to the goods or services, the mark must be refused.

Is this not the situation in the MARYLAND APPLES case? The geographic term MARYLAND can, in certain circumstances, be used in relation to apples coming from Virginia and Delaware. In that situation, the certification statement is to be used to certify something other than geographic origin, then the registration must be refused or a disclaimer required.

Is there compliance with TRIPs?

The first question to be asked of the US system is whether it allows the registration of indications which go beyond the first element of the TRIPs Article 22 definition of a GI, namely, the protection of *indications which identify a good as originating in the territory of a Member, or a region or locality in that territory*. As has been seen in detail in relation to MARYLAND APPLES, it appears that the US system allows for the registration of geographical indications which do not identify a good as originating in a geographic place.

A second question is whether the US system requires the applicant to show a link between the products’ characteristics and the geographic origin let alone show that the characteristics are essentially due to that origin.

There is an examination of the link or reputation. But the only purpose of that examination is not to determine compliance with *essentially attributable* test but to determine what the geographic delimitation of a certification mark containing a geographic name should be.

The absence of the need for a link between the geographic origin and the product is made clear from the text of the certification statements that accompany the certification mark. Two examples suffice to show this. The first is in relation to the EU GI Roquefort. The statement reads:

The certification mark is used upon the goods to indicate that the same has been manufactured from sheep's milk only, and has been cured in the nature caves of the community of Roquefort, Department of Aveyron, France.

This is merely descriptive and mechanical. It does not say that the special characteristics of Roquefort cheese are essentially due to the geographical origin. The second is in relation to Idaho potatoes. The statement reads:

The certification mark, as used by person[s] authorized by the certifier, certifies the regional origin of potatoes grown in the State of Idaho and certifies that those potatoes conform to grade, size, weight, color, shape, cleanliness, variety, internal defect, external defect, maturity and residue level standards promulgated by the certifier.

All this declaration does, in essence, is to state that the potatoes come from Idaho and they conform to certain standards. There is nothing to do with qualities or reputation or distinctive characteristics. And there is nothing to show that these product distinctions are essentially due to the origin as required by Article 22 of the TRIPs.

Conclusions

The purpose of this note is to understand and explore the application by USPTO of its TRIPs commitments in relation to GIs. The object is not to examine whether TRIPs requires, or does not require, a particular system of law for the protection of GIs, in other words, can TRIPs compliance be achieved through a trademark system. This note merely concludes that current USPTO practice seems not to examine essential elements of the GI definition as set out in TRIPs Article 22(1) and allows registration of geographical terms which may be deceptive as to origin.