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U.S. Protection of European Geographical Indications and Designations of Origin

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Table of Content

1

What are Geographical Indications?

2

Comparison between U.S. and EC Laws

3

Protection of Foreign GIs in the United States

4

Conclusion

Introduction

- There are currently more than 10,000 protected Geographical Indications or GIs in the world with an estimated trade value of more than US\$ 50 billion.*
- Many are well-known names such as **Bordeaux wine, Parmigiano-Reggiano cheese, Roquefort, Idaho potatoes**. Many more are less known and often unprotected.
- About 90% of GIs come from the 30 OECD* countries while in most of the more than 160 other countries, very few have been developed.
- GIs are increasingly perceived as an opportunity in many countries that have unique geographica and cultural attributes that can be translated into product differentiation.

* Source: International Trade Centre (ITC), a joint agency of the World Trade Organization and the United Nations

What are Geographical Indications (GIs)? (1)

- GI is an umbrella term whose overall purpose is to distinguish the identification of a product's origin and its link with particular characteristics related to that origin.
- In some countries, they are not formally or legally registered but operate commercially.
- When GIs are legally registered they take different forms such as AO, DO, PDO, PGI, and trademarks.

What are Geographical Indications (GIs)? (2)

- Denominations that “identify a good as originating in the territory of a WTO Member where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.” *Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)*
- A geographic term is merely a place name and not intellectual property until it is used to identify a good or service with certain characteristics (including origin) rather than merely the place where the goods or services originate, and consumers use that sign as material information when making purchasing decisions.
- GIs are intellectual property.

Table of Content

1

What are Geographical Indications?

2

Comparison between U.S. and EC Laws

3

Protection of Foreign GIs in the United States

4

Conclusion

International Protection of GIs

- The lack of a single international approach, or a common registry of GIs, makes it difficult to secure protection in different markets. This is exacerbated by often fragmented, overlapping, and unclear national protection systems.
- The 167 countries that actively protect GIs as a form of intellectual property fall into two main groups: 111 nations with specific or *sui generis* systems of GI laws and 56 that prefer to use their trademark systems.
- The two major markets for GI products, i.e. the EU and the United States, appreciate the validity of GIs yet their marketing and protection systems have evolved to be very different.

United States and European Community: Two Different Approaches

- One element of a successful strategy for GI protection by the relevant membership association is to understand the GI systems in the two largest developed country markets: the EU and the United States.
- The EU and the United States have divergent interests in their treatment of GIs. The EU is attempting to consolidate the international reputation of GIs and their increased public protection. The United States has been focusing on increasing open markets and has viewed the EU's GI efforts as somewhat protectionist.
- The EU uses a highly developed, stand-alone system of legislation and regulations specifically for GIs, while the United States incorporates GIs as a section of its existing intellectually property legislation.

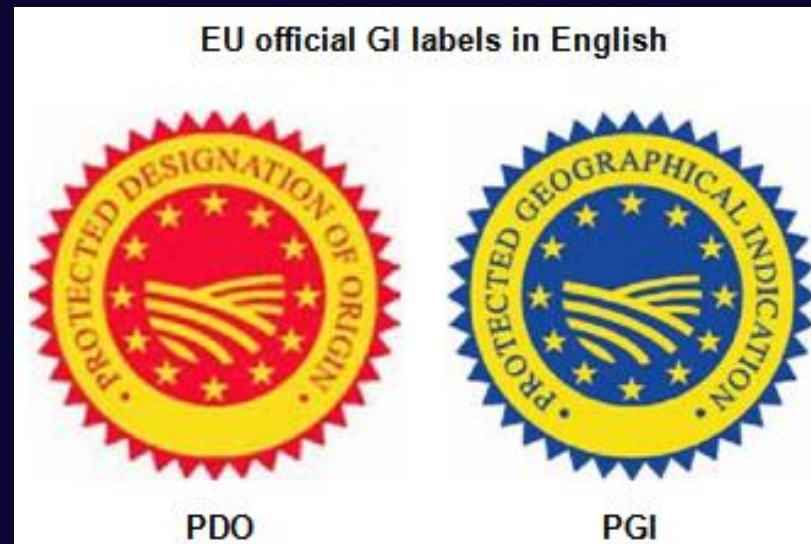
European Union Protection of GIs (1)

- Under the laws of the European Community, GIs are promulgated by the European Commission, whose system has replaced to a large degree the residual national systems in the EU. The Member States only retain competence in any GI matter to the extent that EC law does not apply.
- In 1992, the EC created systems to bring together the many different rules for appellations and protected origins, and they were updated in March of 2006.
- The current EC system is based on two main categories of protection for GIs:
 - Protected Designations of Origin (PDO) and Protected Geographical
 - Indications (PGI)

European Union Protection of GIs (2)

- PDOs and PGIs are protected equally under Regulation 510/2006. The essential differences between the two are that:
 - In order to qualify for a PDO, the raw materials must come from the defined geographical area; there is no such rule for a PGI.
 - In the case of a PDO, the link between the territory and specific characteristics must be more objective, as explained by the Regulation “the quality or the characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors”.
 - For a PGI, a link is necessary but is not essential or exclusive, as stated in the Regulation: “specific quality, reputation or other characteristics” must be merely “attributable to that geographical origin”.
 - For a PGI, only one of the three stages - production, processing or preparation - of the product must take place in the defined geographical area, whereas for a PDO the production, processing and preparation of the product (all the stages from the production of raw materials until the preparation of the final product) must take place in the defined geographical area.

Sample Labels in the European Community



United States Laws do not Recognize GIs as a Separate Legal Category

- The United States view GIs primarily as property rights, a tool to assist the competitiveness of firms and producer groups. Unlike Europe, there is considerably less emphasis on rural development or traditional systems.
- United States Law does not recognize Geographical Indications (“GIs”) as a separate legal category but considers them as a subset of trademarks.
- The view expressed by the the U.S.P.T.O. is that Geographical Indications serve the same functions as trademarks, because they act as source-identifiers and guarantee of quality.
- United States law employs a variety of means, especially certification and collective marks, to provide what they view as TRIPS-plus level of protection, that is, a level of protection that exceeds the minimum standards required under the TRIPS Agreement (1995).
 - Whether the official view of U.S. institutions adequately reflects the increasing needs for protection of Geographical Indications, is a topic that is hotly debated by scholars and practitioners.

Table of Content

1

What are Geographical Indications?

2

Comparison between U.S. and EC Laws

3

Protection of Foreign GIs in the United States

4

Conclusion

The Scope of Protection for GIs under U.S. Law

- There is no statutory definition for Geographical Indications. At times, the U.S.P.T.O. will use the definition of “Geographical indications” contained in TRIPs Article 22.1 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.”
- The P.T.O. Administration, for example, expects that this definition will be applied in the context of trademark registration and that a “geographical indication” will be interpreted to comprise only those geographical areas that have a reputation for being associated with the goods of a particular type. T.M.E.P. § 1210.08(a)

Certification Marks and Collective Marks

- The United States generally protects GIs by utilizing two sub-categories of trademark law: “certification marks” and sometimes “collective marks”.

Geographic Certification Marks

- 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 first type is used to protect geographic denominations and is the only relevant to the current analysis. Under T.M.E.P. § 1306.05(a), a geographic certification mark is a word, name, symbol, device, or some combination of these elements, used alone or as a portion of a composite mark, to certify that the goods or services originate in the geographical region identified by the term or, in some circumstances, from a broader region that includes the region identified by the term. 15 U.S.C. § 1127; *Cmty of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 497, 133 USPQ 633, 635 (2d Cir. 1962).

Elements of Geographic Certification Marks

- Three primary elements are necessary to obtain protection as a certification mark:
 - 1) good-place association, i.e. the geographic area must be known for the type of products whose protection is sought for the geographic mark (e.g. cheese, wine, cured meat, vegetable or fruit, etc.) ;
 - 2) a certification statement provided together with the standards of quality,
 - 3) a statement that the applicant has “authority to control” the certification mark.

A GI is Protected only if the Public Understand that the goods come from a specific region

- The U.S.P.T.O. states that the primary issue in determining whether a geographical designation is registrable as a regional certification mark is whether the public understands that goods bearing the mark come only from the region named in the mark, not whether the public is expressly aware of the certification function of the mark *per se*.
- If use of the designation in fact is controlled by the certifier and limited to products meeting the certifier's standards of regional origin, AND if purchasers understand the designation to refer only to products produced in the particular region and not to products produced elsewhere, then the designation functions as a regional certification mark. *Institut Nat'l Des Appellations D'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (T.T.A.B. 1998).

Under U.S. law, GIs Can Become Generic Words

- Under this regimen, U.S. law will not provide protection to geographic names that are perceived as being generic.
- The claim of genericness (i.e. that the geographic name has become the common commercial name for the product as perceived among U.S. Consumers), is often reviewed under Section 14(5)(A) of the Trademark Act, which requires the owner of the certification mark to control, or being able to legitimately exercise control over, the use of the mark. 15 U.S.C. 1064(5)(A).

GIs as Collective Marks

- Occasionally, registration for a geographic term will be sought in the form of a collective mark. In the United States there are two types of collective mark: (1) collective trademarks and (2) collective membership marks. The Trademark Trial and Appeal Board (TTAB) explains the difference as follows:
 - a collective trademark 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 use the mark to identify their goods or services.
 - 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.
- The collective mark can provide additional protection under U.S. Law to geographic denomination, by designating that certain producers or distributors are member of an union or a member organization that is tasked with the duty to certify, monitor or protect a certain geographic denomination.

Distinctions between trademarks, collective marks and certification marks for GIs

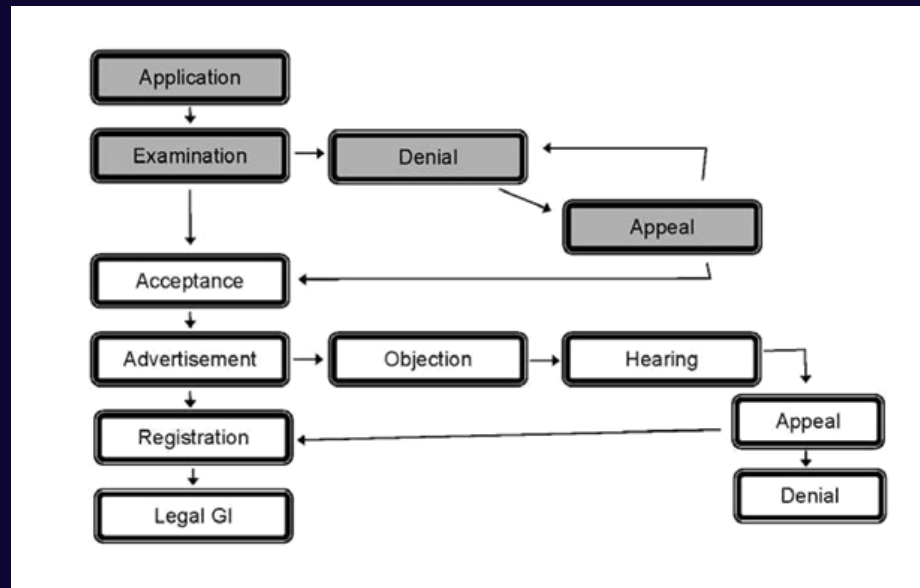
<u>Trademarks and collective marks</u>	<u>Certification marks</u>
Acquired distinctiveness required for geographic terms.	Acquired distinctiveness not necessarily required for geographic terms.
Anyone can own trademark but for GI usually a government body or producer group. Associations or cooperatives own collective marks.	Owner is usually a government body or association on behalf of producers in a geographic region.
Owner controls use. For collective marks, group membership is required.	Certifier may not discriminately refuse to certify any products that meet the standards.
Owners can license or use the mark.	Mark used by someone other than its owner.
The mark for the name can apply to any product.	Applies to a specified product (or group of products).
Rewards producers and collectives who have already commercialized a geographic term as a source identifier.	Can be applied prior to commercialization in the United States.

Common Law Geographic Denominations

- Under United States law, unregistered geographic denominations are protected also through common law.
- A famous example is the GI “COGNAC”, analyzed in *Institut National Des Appellations v. Brown-Forman Corp*, 47 U.S.P.Q. 2d. 1875, 1884 (T.T.A.B. 1998).
 - In that case, the Board stated that “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”

Shared Features of the Application Process

- The application processes for GI protection have some shared features though variants are common. Typically there is an initial internal stage wherein the responsible government agency processes a request and either accepts or denies. In many cases this is open to appeal. If approved, the second stage allows for public dissemination of the proposed GI and can also be subject to objection and a hearing or appeals process.



The U.S. Application Process

- For a certification mark, in addition to meeting the general requirements of a trademark, the USPTO requires the applicant to submit a copy of their certification standards and means of enforcement, and retains these as part of the official record.
- Similarly, an application for a collective mark, in addition to specifying and containing all elements necessary in a general trademark application, must define the relationship between the group and its members, and illustrate how the applicant (group or collective) exercises control over the use of the mark by its members
- During the application process, the USPTO's examining attorneys will review the application for compliance with various regulatory requirements. The process includes an opposition system, which allows interested third parties to object to an application before the USPTO's Trademark Trial and Appeal Board (TTAB).

Two Systems (EC-US) At a Glance

Comparisons between Geographical Indications, designations and marks					
	International Framework	Protected Designation of Origin (PDO)	Protected Geographical Indication (PGI)	Trademark for GI	Collective mark for GI
Legislation or Agreement	Individual national legislation and TRIPS 1994 art 22, 23, 24.	EC 510/2006.	EC 510/2006.	15 U.S.C. § 1127	15 U.S.C. §§ 1054, 1127
Basis	International interest as expressed in various multilateral treaties (Paris, Madrid, Lisbon) and TRIPS Agreement).	Agriculture and consumer policies (public).	Agriculture and consumer policies (public).	Property rights (private).	Property rights (private).
Purpose	Protection of the identification of product's origin indications that identify a good as originating in a specified territory and having some distinct characteristics related to that territory.	Specific public protection for geographical designations of agri-food whose essential character is due to its geographical environment, including natural and human factors.	Specific public protection for geographical designations of agri-food whose essential character has some relation to a geographical region.	Intellectual property rights tool to assist the competitiveness of individuals, private firms or groups, and as a means to inform consumers of ownership.	Intellectual property rights tool to assist the competitiveness of private collectives or groups, and as a means to inform consumers of ownership.
Structure	Varies according to national rules.	Sui generis or stand alone legislation, government policy tool.	Sui generis or stand alone legislation, government policy tool.	Intellectual property legislation.	Subset of intellectual property legislation.
Identifier	Varies according to government regulations.	PDO logo. 	PGI logo. 	® Registered trademark.	® Registered collective mark.

Table of Content

1

What are Geographical Indications?

2

Comparison between U.S. and EC Laws

3

Protection of Foreign GIs in the United States

4

Conclusion

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- Consumer vs. producer interests
 - Long-time, generic use of expressions that have geographic origins (parmesan)
- Differing national treatment of GIs
 - -weaker: (Canada, US) “Canadian Champagne;” “American-made Pecorino cheese”
 - -stronger: (EU) GI use reserved to producers in the region, even if other origin is indicated

Conclusion: European Community Approach

- Geographical Indications are not exclusively commercial or legal instruments.
- They exist in a broader context as an integral form of rural development that can advance commercial and economic interests while fostering local values such as environmental stewardship, culture and tradition.
- GIs are the embodiment of 'glocalization' i.e. products and services participating in global markets and at the same time supportive of local culture and economies.
 - On the development side, GIs often generates better quality rural employment. They can provide the structure to protect the unique intellectual or socio-cultural property embodied in indigenous knowledge or traditional and artisanal skills that are valued forms of expression for a particular community.
 - On the business side, GIs are market-oriented. They align with emerging trade demands since they tend to have standards for quality, traceability and food safety.

Conclusion: United States Approach

- Given its legal traditions and dominant economic theory, the United States views GIs as a private system of rights that tends toward exclusive ownership of assets, brands, and other identifiers.
- These require private management. Mark owners need not wait for their government to obtain certification or address unauthorized use or take legal action against infringement. It does also put the responsibility on the owner of the mark to initiate and pay for any legal action for protection.

COMTÉ

- Owned by Comite Interprofessionnel du Gruyere de Comte U.S. Reg. Nos. 1473687
- “The certification mark is used by persons authorized by the certifier to certify that the goods come from the Comté division (an administrative division of France); that the goods are only made from milk that comes only from the Montbeliarde breed of dairy cattle, which are fed fresh grass or dry hay; and that the cheese meets the hygiene, production methods or standards and appearance methods or standards of the certifier.”

Examples of Foreign GIs Protected In the United States

Prosciutto Di Parma



- Owned by Consorzio Del Prosciutto Di Parma Association U.S. Regs. Nos. 2014629; 2014628; 2014627
- “The certification mark is used by persons authorized by the certifier to certify the regional origin of the product to which the mark is applied.”
- “Parma Ham” is also registered in English—U.S. Reg. No. 2014628.

Examples of Foreign GIs Protected In the U.S.

Vino Nobile Di Montepulciano



- Owned by the Consorzio del Vino Nobile di Montepulciano; U.S. Reg. No. 2251165.
- “The certification trademark, as used by persons duly authorized by Certifier, certifies the region or origin of the goods as emanating from a specific geographic region, namely, Montepulciano, a region in Italy.”

Examples of Foreign GIs Protected In the U.S. *Darjeeling*

- Owned by Tea Board of India U.S. Reg. No. 2,685,923
- Word Mark (Word “DARJEELING” protected)
- “As used by authorized persons, certifies that the tea contains at least 100% tea originating in the Darjeeling region of India and that the blend meets other specifications established by the certifier.”



Examples of Foreign GIs Protected In the United States *Roquefo*



ROQUEFORT

- Owned by the Community of Roquefort
U.S. Reg. No. 571,798 (Registered March 10, 1953)
- “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 natural caves of the Community of Roquefort, Department of Aveyron, France.”

Examples of Foreign GIs Protected In the United States – *Collective Marks*



- The protected mark is the design incorporating the Black Rooster with the words “Chianti Classico Consorzio Vino ChiantiClassico”;
- Owned by the Consorzio Vino Chianti Classico Association;
- U.S. Reg. No. 0889138

Examples of Foreign GIs Protected In the United States

Collective Marks



- “Frankfurter Apfelwein”; Owned by Verband Der Deutschen Fruchtwein- Und Schaumwein-Industrie E.V.; U.S. Reg. No. 1097779; “The mark certifies origin in the city of Frankfurt in the Federal Republic of Germany.”

Questions?



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