

California Bar

IP Section – International Committee

Geographical Indications

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GATT TRIPS – Article 22

Geographical Indications - indications which identify a good as originating in the territory of a WTO 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

GATT TRIPS – Article 22

WTO Members shall provide the legal means for interested parties to prevent:

- The use of any means in the presentation of product that would mislead the public as to geographic origin.

GATT TRIPS – Article 22

WTO Members shall provide the legal means for interested parties to prevent:

- The registration of a mark containing a geographical indication if use of the GI in the mark would mislead the public as to geographic origin.

GATT TRIPS – Article 24.6

Genericness exception

- Nothing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member.

GATT TRIPS – Article 23

Additional protection for wines and spirits:

WTO members shall provide the legal means to prevent the **use** or **registration** of marks for wines or spirits which contain geographical indications when the wine or spirit does not originate from the geographic area identified by the geographical indication

GATT TRIPS – Article 23

Additional protection for wines and spirits:

- Consumers *do not* need to be misled - “absolute protection”
- Use of words “style,” “type,” etc., or use of actual geographic origin on product not sufficient

GATT TRIPS – Article 23

Additional protection for wines and spirits:

- Grandfathering of marks or generic terms used in member nation prior to enactment of TRIPS (U.S. - 1/1/1996)

Geographical Indications

Usually registered for protection in one of three ways:

- 1) Certification Mark (TM system)
- 2) Collective Mark (TM System)
- 3) Independent system for recognition of GI

Geographical Indications

Some countries do not offer any registration protection (e.g., Japan, Chile, New Zealand)

GIs are only protected through false/misleading advertising statutes

Lanham Act

Post-GATT TRIPS Article 22

- Requirements of Article 22 already in place in Lanham Act by virtue of Section 2(a) for registrations and 43(a) for use.
- Article 22 did not require any amendment to Lanham Act.

Lanham Act

Post-GATT TRIPS Article 23

Section 2(a) amended to prevent registration of a mark that comprises:

“a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after [January 1, 1996].”

Lanham Act

Post-Article 23 – Generic Exceptions

- Generic terms are not registerable in and of themselves, but are registerable as part of a composite mark pursuant to a disclaimer of the generic term.
- To the extent that trademarks for wines or spirits encompass geographical indications which are considered to be generic terms in the U.S., TRIPS Article 23 does not apply.

Lanham Act

Post-Article 23 – Generic Exceptions

Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

Reg. No. 2,220,897

United States Patent and Trademark Office

Registered Jan. 26, 1999

**TRADEMARK
PRINCIPAL REGISTER**

OFFICIAL CHAMPAGNE OF NEW YEAR'S EVE

**F. KORBEL & BROS. (CALIFORNIA CORPORATION)
13250 RIVER ROAD
GUERNEVILLE, CA 95446**

**FOR: ALCOHOLIC BEVERAGES, NAMELY,
SPARKLING WINE, IN CLASS 33 (U.S. CLS. 47
AND 49).**

**FIRST USE 9-30-1996; IN COMMERCE
9-30-1996.**

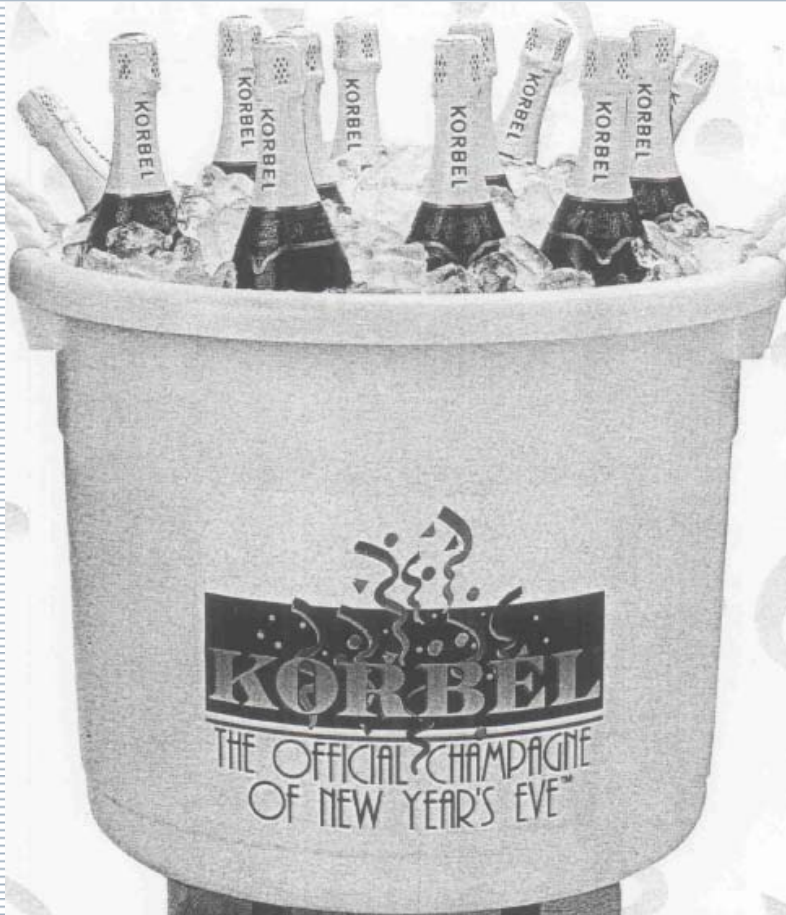
**NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "CHAMPAGNE", APART
FROM THE MARK AS SHOWN.**

SN 75-268,510, FILED 4-3-1997.

MICHAEL MASON, EXAMINING ATTORNEY

Lanham Act

Post-Article 23 – Generic Exceptions



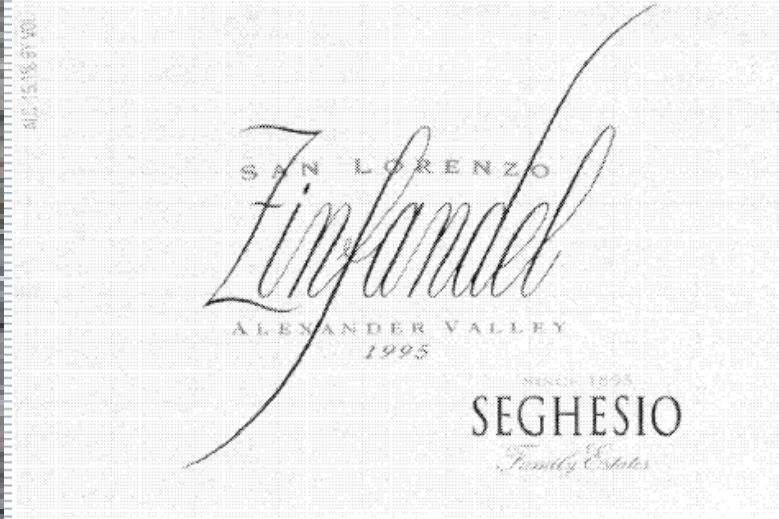
Lanham Act

Post-Article 23 – Application 2(a)

- Amendment to 2(a) failed to define “geographical indication”

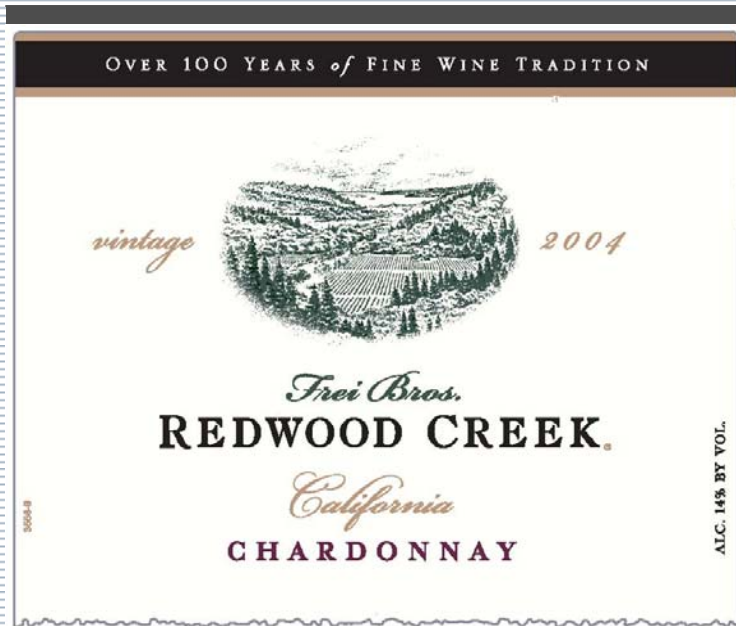
Lanham Act

Post-Article 23 – Application 2(a)



Lanham Act

Post-Article 23 – Application 2(a)



Lanham Act

Post-Article 23 – Application 2(a)

6th Edition of TMEP

- Defines “geographical indication” pursuant to Article 22
- TMEP Section 1210.08 – acknowledge TRIPS definition of GI to include quality and characteristics BUT requires that purchasers make a goods/place association AND that the erroneous belief as to geographic origin would materially affect purchaser’s decision to buy the goods.

Lanham Act

Post-Article 23 – Application 2(a)

Speaker's view:

- **WRONG** – Article 23 requires “additional” protection, consumers need not be misled

Protecting Geographical Indications

Geographical Certification Marks

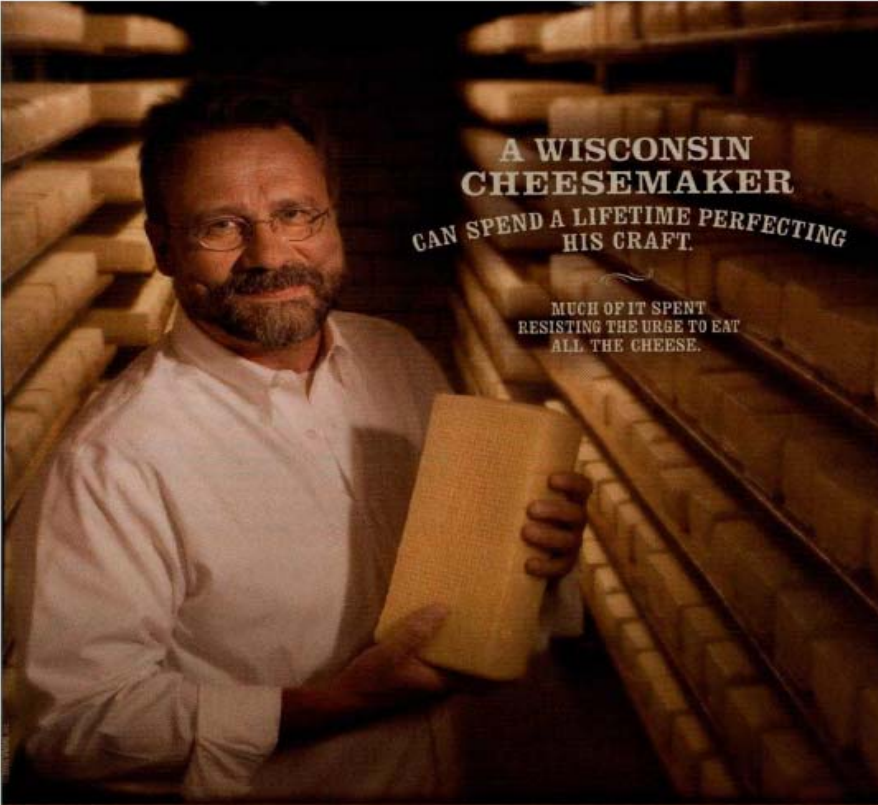
- Owner of mark certifies goods as to geographical origin and possibly other requirements

Protecting Geographical Indications

Geographical Certification Marks


- Owner cannot itself use the mark, usually owned by regional trade associations
- All parties who qualify must be allowed to apply for certification

Protecting Geographical Indications



**A WISCONSIN
CHEESEMAKER**
CAN SPEND A LIFETIME PERFECTING
HIS CRAFT.


MUCH OF IT SPENT
RESISTING THE URGE TO EAT
ALL THE CHEESE.



Look For The
WISCONSIN PRIDE SEAL
On Cheeses From Wisconsin

www.WisDairy.com

**CERTIFICATION MARK
PRINCIPAL REGISTER**



PRIDE.
OUR SECRET INGREDIENT.

Protecting Geographical Indications

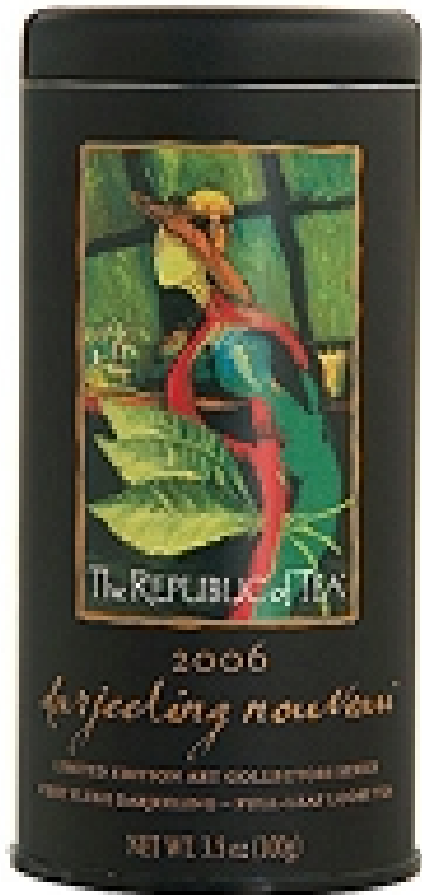
- WISCONSIN CHEESE and Design certification mark certifies that the cheese is 100% cow's milk natural cheese produced in the state of Wisconsin or processed cheese made exclusively with cow's milk natural cheese produced in the state of Wisconsin.
- Owned by Wisconsin Milk Marketing Board

Protecting Geographical Indications

Geographical Certification Marks

- The geographical term is *not* required to be disclaimed
- The geographical certification mark gives the owner exclusive control of the geographical term on the goods
- No fair use defense for use of term as part of trademark

Protecting Geographical Indications



DARJEELING
NOUVEAU

Protecting Geographical Indications

Geographical Certification Marks

Tea Board of India v. Republic of Tea, 80 USPQ2d
1881 (TTAB 2006)

- Analysis is likelihood of confusion
- Mark DARJEELING is distinctive

Protecting Geographical Indications

Geographical Certification Marks

Tea Board of India v. Republic of Tea, 80 USPQ2d
1881 (TTAB 2006)

- Applicant could not simply disclaim
“Darjeeling” or limit its goods to 100%
Darjeeling tea

Protecting Geographical Indications

Geographical Certification Marks

Tea Board of India v. Republic of Tea, 80 USPQ2d
1881 (TTAB 2006)

- Could not make be an auto repair shop and register JERRY'S VOLKSWAGEN GARAGE even if you fixed Volkswagens

Protecting Geographical Indications

Geographical Certification Marks

Tea Board of India v. Republic of Tea, 80 USPQ2d 1881 (TTAB 2006)

- Similarly, cannot make a product with goods from a particular protected geographic area and use the geographical certification mark for such area as part of a brand, i.e., DARJEELING NOUVEAU tea

Protecting Geographical Indications

Geographical Certification Marks

Geographical Certification Marks can also be recognized under common law, need not be registered

Institut Nat'l des Appellations d'Origine v. Brown Forman Corp., 47 USPQ2d 1875 (TTAB 1998)

Protecting Geographical Indications

Geographical Collective Marks

- Owned by an association for use by association members on products produced by members approved by the association
- Association promotes, but does not use the mark on goods

Protecting Geographical Indications

Geographical Collective Marks

Int. Cl.: 31

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 1,851,635

Registered Aug. 30, 1994

**COLLECTIVE TRADEMARK
PRINCIPAL REGISTER**



Protecting Geographical Indications

Geographical Collective Marks



Protecting Geographical Indications

Geographical Collective Marks

- Unlike certification marks, must disclaim geographic term

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "COLORADO POTATOES",
APART FROM THE MARK AS SHOWN.

- More of a marketing device

Geographical Indications

TRIPS Article 23.4 requires negotiations for creation of a multilateral register for geographical indications for wines and spirits

Deadline for completion was 2003. Not yet near complete

Geographical Indications

Three Multilateral Proposals:

- 1) New World - voluntary system, non-binding. Notified GIs would be registered in a database. Participating governments would consult the database when taking decisions on protection in their countries. Non-participating members would be “encouraged” to consult the database.

Geographical Indications

Three Multilateral Proposals:

- 2) EU – GI registration would establish a “presumption” in all member countries that the GI is non-generic and meets TRIPS definition of GI — challengers would bear burden of proving genericness or not a GI

Geographical Indications

Three Multilateral Proposals:

- 3) Hong Kong – GI registration would be recognized voluntarily by participating member states and could be challenged in member courts on bases of genericness or priority

Geographical Indications

INTA – Madrid-like System

GIs registered in home country and extension of protection to other countries requested through international organization, country examines request for extension, and third parties allowed to oppose registration.

Thank You

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