

United States of America
Response of the United States Group
to
Standing Committee on Geographical Indications
to Questionnaire to National Group

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Questions

I. Analysis of current legislation and case law

1) Are GIs and/or AOs protected under your Group's current law?

GIs and AOs are protected as described in Paragraph 1 of Report – Question – Q191, attached hereto.

2) If yes, please briefly describe the following:

a) How AOs and GIs are defined and the prerequisites (in particular the type, nature and intensity of link with a territory).

AOs are limited in the US to certain viticulture areas, American Viticultural Areas, and their use is controlled by the US Bureau of Alcohol, Tobacco, Firearms, and Explosives. It is governed by enacted federal regulations: 27 CFR 4.25. The term “appellation of origin” is not defined in the regulation.

The US is a WTO nation and adoptee of TRIPs. It has adopted the WTO definition of "geographical indications" as indications that 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 geographic origin.”

However, GI protection is obtained by federal registration of a trademark usually as a collective, certification, or membership mark. There is a specific provision for rejection of a trademark application which consists of or includes a GI for a wine or spirit, or codified in Section 2(a) of the Lanham Act:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) *Consists of or comprises ... deceptive ... matter;... or 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].*

15 U.S.C. §1052(a).

b) *Whether that protection is provided by sui generis laws; solely as aspects of other laws, such as by registration as collective or certification marks; or by other (and if so, what) means.*

See also Paragraph 2 of Report – Question – Q191.

There are no *sui generis* laws devoted to AOs or GIs. However, broad protection is afforded under the general US trademark and advertising/unfair competition law. See Report – Question – Q191, specifically “If so what are the criteria of registrability?”

c) *If GIs and/or AOs are protected by sui generis laws, whether your Group's laws provide for a system of registration. If so, what are the steps of this procedure including the content of the application and the possibility of opposition by third parties?*

GIs and AOs are not protected by *sui generis* laws.

3) *If your country does not protect GIs and/or AOs, was this a deliberate decision and, if so, why?*

Not applicable. GIs and AOs are protected as trademarks, certification marks, collective marks and membership marks.

4) *What are the grounds of invalidity/loss of rights for GIs and/or AOs under your Group's law (e.g. becoming generic, lack of use, not paying fees) and where can such be invoked (which court, office etc.)? Please specify the applicable test, how such is proven (e.g. consumer surveys, expert advice, dictionaries, etc.) and who bears the burden of proof.*

As has been stated, GIs and AOs with the exception of the American Viticultural Areas (AVAs) administered by The Alcohol Tobacco Tax and Trade Bureau (TTAB), are accorded protection at common-law and can be registered as trademarks, collective marks, certification marks, or membership marks as may be appropriate. See the discussion thereof in Report – Question – Q191 paragraphs 1 and 2 and 3. The grounds for invalidity/loss of rights are generally the same as for trademarks.

5) What is the scope of protection of GIs/AOs under your Group's current law?

Protection is against deceptive misuse of the specific GI/AO.

6) Against what kind of conduct are GIs/AOs protected? For example, against use misleading consumers, parasitism and free riding.

GIs/AOs are protected against uses which deceive, mislead or confuse consumers.

7) Who has legal standing to protect a GI/AO. For example, individual producers, consortiums and associations, public bodies.

Legal standing to assert protection of GI/AO resides with individual producers and traders.

8) What remedies are available in the case of violation of rights in a GI/AO?

Remedies for the successful litigant could include damages, legal fees and injunctive relief as well as corrective advertising.

9) How does your Group's law regulate the conflict between a GI/AO and a prior trademark? Does the GI/AO or the trademark prevail or do they coexist? Under what conditions?

There is no regulation specific to a conflict between a GI/AO and a trademark. The case is regulated as one involving trademark infringement and unfair competition.

10) Is there any specific provision or practice concerning the inclusion of a GI/AO in a domain name?

No.

11) Is there anybody that administers GIs/AOs in your country and/or is responsible for the verification of compliance of goods bearing a GI/AO? Please briefly describe the relevant processes, e.g. the process by which compliance with product specifications

is verified before such goods are put on the market and/or the subsequent market controls on such goods?

There is no separate body administering GIs/AOs in the United States. Individual membership or certifying organizations supervise their members' use.

- 12) Please describe any other developments in your country in relation to GIs or AOs which you consider relevant, including any proposals for reform. For example, to the extent that your country has been involved in any negotiations or discussions regarding the protection of GIs and AOs in any fora, such as multilateral, regional or bilateral agreements, please specify whether your country is negotiating or has signed any agreement with other countries that includes provisions on AOs/GIs and whether it was necessary to amend domestic legislation as a result of such agreements.

We are not aware of any current activity to expand or change protection for GIs and AOs.

II. Proposals for improvements and for harmonisation

- 13) Should there be harmonised definitions of AOs and GIs? If so, please propose appropriate definitions and prerequisites.

No. There is no need for harmonized definitions of AO's and GIs.

- 14) Should there be a registration procedure for AOs and GIs? If so, what should its key features be? For example, content of the application; examination by competent bodies; possibility of opposition by third parties.

No. Adequate protection of user and consumer is available in the present system.

- 15) What should the grounds of invalidity/loss of rights for GIs and/or AOs be? For example, becoming generic, lack of use, not paying fees. Please specify what the applicable test should be, how such should be proven and who should bear the burden of proof.

The sole grounds of invalidity should be loss of distinctiveness and misuse through false application resulting in consumer deception.

- 16) How should conflicts between GIs/AOs and prior trademark rights be regulated?

See discussion in Report – Question – Q191.

17) What scope of protection should GIs/AOs have and should it matter if these are domestic or foreign? Against which conduct by third parties should they be protected?

The scope of protection should be limited to that necessary to protect its function as an accurate indicator to consumers of services or qualities.

18) Who should have legal standing to protect a GI/AO and which remedies are appropriate?

The owners or participants in the area and industry identified by the GI/AO.

19) Should there be a specific provision or practice concerning the inclusion of a GI/AO in a domain name?

No, not in addition to prohibiting misleading and deceptive domain names.

Responses to this Questionnaire

Groups are requested to submit responses to this questionnaire **by May 29, 2017**. Responses should be sent by email to StandingCommittees@aippi.org and should clearly indicate that they are responses to this questionnaire.

United States of America

Report - Question - Q191

**THE RELATIONSHIP BETWEEN TRADEMARKS AND GEOGRAPHICAL
INDICATIONS
REPORT OF THE UNITED STATES GROUP**

Contributors: Andrew Simpson, Christine James and Michael Grow

I. Analysis of current legislation and case law

1. Does your country's laws have enactments or systems dealing specifically with GIs, e.g. a registration system for GIs?

The U.S. Federal Trademark Act (often referred to as the Lanham Act) permits registration of indications of regional origin, which may be registered as collective or certification marks. Geographically descriptive trademarks may also be registered on the Principal Register, upon proof of acquired distinctiveness, or on the Supplemental Register. Thus, the United States affords protection to GI's under existing trademark law provisions which allow for protection of trademarks, certification marks, and collective marks.

The Federal government recognizes certain viticultural areas, including domestic appellations of origin for wine known as American Viticultural Areas (AVA's). State law may also recognize specific areas of the relevant state and require, for example, that wine using the name of the area comprise a minimum percentage of grapes from the area.

Bilateral agreements between the United States and foreign countries or regions may recognize GIs.¹

If so, what are the criteria of registrability?


As with all trademark, certification, and collective mark rights in the United States, rights to GIs are secured and maintained through use of the mark in U.S. commerce and, as a result, can be protected as a result of common law (non-registered) use. Federal registration memorializes and supplements common law protection. Typically, GIs are registered as certification marks or collective marks, although registrations of GIs as trademarks or service marks have been secured for marks that are not geographically mis-descriptive upon a showing of acquired distinctiveness.

Geographic signs or names which otherwise would be refused protection as primarily geographically descriptive marks can be protected as certification marks.² Certification marks provide protection to marks used to certify that goods or services associated with the mark originate in a specific geographic region known for a particular quality or having a particular reputation; that the goods or services meet a certain standard; that work or labor was performed on products or services by an individual/entity as a member of an organization (such as a union); and/or that the performer providing work or labor on such products or services meets certain standards (such as accreditation).³ Certification marks may not be used by the owner other than in literature and advertising to promote the certification program; the marks are used by owner-authorized users to affirm that the goods/services have met certain predetermined standards set and maintained by the owner. If the mark's principal use and resulting significance is as a generic term, registration will be denied (eg. FONTINA for cheese); however, if the mark's use and significance is owner-controlled and limited to goods/services meeting a certain standard, for example, registration may be



obtained (eg.  protected for citrus and owned by the State of Florida Department of Citrus;



or  protected for potatoes and owned by the State of Idaho Potato Commission) or protectable common law rights (eg. COGNAC protected at common law for French brandy). A federal trademark application for a certification mark registration must set forth the manner of the mark's use, the conditions for the mark's use (including a copy of the established standards), the applicant's control over the use or the mark by its authorized users, and verification that the applicant itself will not use the mark.

Collective marks provide protection to marks adopted by a group, such as an association, union, or fraternal organization, among others. These marks are for use only by the association's members to identify their goods/services and distinguish them from other goods/services not affiliated with the group. (eg.



 for teapots owned by The Tea Council of the U.S.A.).⁴ Another type of collective mark, known as a collective membership mark, indicates that the



individual/entity using the mark is a member of the group (eg.  for

sunflower confectionery owned by the National Sunflower Association). The collective mark owner retains the rights to the mark for the benefit of all members of the group, each of whom in turn individually uses the mark. In addition to providing all details required for a federal trademark application, an application for a collective mark registration must specify the class of persons entitled to use the mark, the class's relationship to the applicant, and the means applicant has or will have in place to control the class's use of the mark.

AVA's may be registered upon showing that the area is locally and/or nationally known; that the boundaries of the viticultural area are as specified in the application; and providing evidence relating to the geographical features (climate, soil, elevation, physical features, etc.) which distinguish the viticultural features of the proposed area from surrounding areas.⁵

The U.S. federal government has categorized GIs by their strength, in a manner similar to that of trademarks. Thus, terms are assessed on the basis of whether they are to U.S. consumers generic, semi-generic or non-generic. Semi-generic terms are those that are used to indicate a style of wine to consumers which is not actually produced in the region of the semi-generic term.

To which national authority must an application for protection be made?

Federal applications to register GIs as trademarks, certification marks, or collective marks are submitted to the U.S. Patent and Trademark Office for review and issuance. As noted above, however, rights to GIs may also be protected under U.S. trademark law at common law, i.e., without registration, by virtue of their use in or with the U.S.

AVA's are registered by the Alcohol Tobacco Tax and Trade Bureau (TTB). The TTB also recognizes for wines foreign terms having non-generic geographic significance and that are also distinctive designations of a specific wine.

Does the applicant have the right to appeal against the refusal of the national authority to register a GI? If so, to which entity?

As with any application to register a trademark, certification mark, or collective mark with the U.S. Patent and Trademark Office, the applicant is provided opportunities to file arguments with the Office in an attempt to overcome any preliminary or final refusals. In addition to such opportunities, the applicant may file a formal Notice of Appeal against a final refusal with the adjudicatory body of the U.S. Patent and Trademark Office, known as the Trademark Trial and Appeal Board (TTAB). If an applicant is dissatisfied with the decision of the TTAB, it may file an appeal in the United States Court of Appeals for the Federal Circuit or in a United States District Court.

A decision of the TTB may be reviewed in federal court.

2. What is the status of a GI in your country?

A GI that qualifies for trademark, collective mark or certification mark protection, solely at common law or by registration, is protected as are other marks under U.S. trademark law. It provides that the GI owner has the exclusive right to prevent unauthorized uses by third parties that may cause confusion as to source.

Does the registration of a GI confer a property right?

A common law trademark, or a registered trademark, certification mark, or collective mark, confers certain rights of exclusivity upon its owner which could be called a “property” right, but such a right at essence is a bundle of intellectual property rights and exists only insofar as the mark at issue continues to function as a source indicator. Because a trademark is a symbol of good will, the “property” right in it is contingent on the maintenance of the good will. This “property” right allows the owner to exclude unauthorized third parties from using the mark and thereby confusing the public as to the origin of the goods or services at issue.

AVA's are not property rights, but an appellation of origin that, for example, dictates that wine using the AVA must be produced with a certain minimum percentage of grapes grown in the AVA.

Who would be the right holder of a GI?

An individual or entity using the mark as a source-identifier and not merely as a descriptive geographic term may be a right holder of a GI. Because a collective or certification mark owner has the duty to control the manner in which the mark is used by its authorized users or members, more often than not a governmental agency, a municipality, or a private association is the right holder of a GI.

Can GIs be the subject of dealings such as assignment, mortgage and licensing?

As with non-GI marks, GIs, whether protected solely under common law or by registration, may be the subject of assignments, mortgages, or licenses, security agreements, liens, and other dealings. Cooperative marks may only be assigned to a “cooperative, an association or other collective group or organization”; if assigned to an individual entity, the mark ceases to function as a collective mark, because the individual entity is precluded, by definition, from asserting collective mark rights.

3. Is the application for or registration of a GI made public in your country?

A federal application to register a GI as a trademark, certification mark, or collective mark is a public document filed with the U.S. Patent and Trademark Office. Copies of file histories can be obtained at the Office, on the Office's website (uspto.gov), or by searching any number of commercial databases.

Is it possible to oppose such application or registration or cancel such registration of a GI? If so, by whom and on what (absolute or relative) grounds (e.g. generic or descriptive term or prior trademark)?

Any party that believes it has been or would be damaged by the issuance of a registration or the maintenance of a registration of a trademark, certification mark, or collective mark may file with the TTAB a Notice of Opposition against a pending, published application or a Petition to Cancel a pre-existing registration on any grounds within the first five years following issuance (and on certain limited grounds if the underlying registration has become incontestable). A party dissatisfied with the resulting TTAB decision may appeal it in federal court to the Court of Appeals for the Federal Circuit.

A Notice of Opposition may be based on absolute and/or relative grounds, and may include arguments that the mark is: confusingly similar to valid prior mark (registered or unregistered), generic, functional, abandoned, merely descriptive, deceptively mis-descriptive, primarily geographically mis-descriptive, primarily geographically deceptively mis-descriptive, primarily merely a surname, not in bona fide use prior to filing use-based application, not based on bona fide intent to use; purely ornamental, not owned by applicant; obtained or maintained by fraud; will dilute plaintiff's famous mark, among other arguments.

Petitions to Cancel may be based on similar arguments provided that the registration has not reached its fifth year anniversary, upon which anniversary the number of available arguments becomes limited. A petition to cancel, however, may be filed at any time on grounds that the mark has been abandoned; the registration was obtained by fraud; the mark is generic; the mark comprises matter that, as a whole, is functional; the mark comprises the flag of the United States; or the mark comprises the name of a living individual without the individual's consent.

Also, in the context of a certification mark, a petition to cancel a certification mark can be filed at any time on the ground that the registrant:

- (a) does not control, or is not able legitimately to exercise control over, the use of such mark;
- (b) engages in the production or marketing of any goods or services to which the certification marks is applied (exempting the legitimate

use of the mark for promoting recognition of the certification program or of goods/services meeting the certification standards)

- (c) permits the use of the certification mark for purposes other than to certify, or
- (d) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.

4. Must use requirements be satisfied in order to maintain GI protection?
If so, is there any definition of what constitutes use?

As with all trademarks in the United States, continued protection of a mark is inextricably linked with its continued use. Submission of a package, label or other acceptable specimen demonstrating use of a mark in connection with the goods or services listed in the application is usually a prerequisite for the issuance of a certificate of registration. Proof of use is not required to obtain a registration if the application is based on a foreign application or registration in the Applicant's country of origin or the application is filed pursuant to the Madrid Protocol. Demonstration of use is also required for the maintenance of a registration and must be filed by no later than the sixth year anniversary of the registration (to be filed in between the fifth and sixth years) and at every ten-year renewal term.

A certification mark specimen must show how a person other than the owner uses the mark to certify regional or other origin, quality, or other characteristics of that person's goods or services; or that members of a union or other organization performed the work or labor on the goods or services. Appropriate specimens of use include materials that bear the mark and are actually attached or applied to the goods or used in the sale or advertising of the services by owner-approved users.

A specimen of use for a collective trademark or service mark should show use of the mark by a member on the member's goods or in the sale or advertising of the member's services. The specimen should show use of the mark to indicate that the party providing the goods or services is a member of a certain group and meets its standards for admission.

Because the owner of a collective membership mark exercises control over the use of the mark but does not itself use the mark to indicate membership, a suitable specimen of use must show use by members to indicate membership in the collective organization. These types of specimens could include membership cards, retail outlet door decals, pennants, decals, patches.

Are the legal rules established for appraising the maintenance of a trademark registration applicable to the appraising of the maintenance of GI protection?

Yes. Because GIs are protected under trademark law and subject to the laws and regulations of the trademark regime, they are maintained under the same guidelines as those for other types of marks.

5. What is the scope of protection of a GI?

Is it only protected against use of the name or also against use of elements of the specification of the GI (e.g. slicing, grating) or any other practice liable to mislead the public as to the origin of the product (e.g. use of same trade dress)? Are the legal rules established for determining the scope of trademark protection applicable to determining the scope of GI protection (e.g. in relation to reputed or well-known GIs, likelihood of confusion, infringing and non-infringing acts)? May rights in a GI be enforced even where a product which allegedly infringes those rights has been made purely for export?

Because GI's are protected in the United States primarily by the trademark law, the scope of protection of a GI is founded on likelihood of confusion. The legal rules for determining the scope of trademark protection are therefore applicable to determining the scope of GI protection. Thus, registrations for trademarks, collective or certification marks provide the exclusive right to prevent others using the same or a confusingly similar mark in connection with the same or related goods, when such use would likely cause consumer confusion, mistake or deception as to the sources of the goods.

AVA's may not be used in connection with wine that is not produced from a minimum percentage of grapes from the AVA.

6. Can a GI be registered as individual trademark? If so, under what conditions?

As indicated above, a GI, may be registered as a collective, or more likely, certification mark, under the conditions described below. This is an exception to the resistance to registration of geographical terms as trademarks expressed by the Lanham Act, which provides that a trademark may be refused registration if it:

“consists of a mark which ... when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable, or when used on or in connection with the goods of the applicant is primarily geographically mis-descriptive of them ...”⁶

Thus, if the primary significance of the mark is generally known as a geographic location, the goods originate in that place and purchasers would be likely to believe the goods originate in that place, the mark may be refused registration if it:

“consists of or 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.”

7. Do your country's laws provide for collective or certification marks?

Both collective and certification marks are registrable in the United States.⁷

The Lanham Act defines a collective mark as a trademark or service 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 this Act, and includes marks indicating membership in a union, an association or other organization.⁸

The Lanham Act defines a certification mark as any word, name, symbol or device, or any combination thereof used by a person other than its owner 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 this Act to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristic 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.⁹

If so, under what conditions can a GI be registered as a collective mark or a certification mark?

As indicated above, a collective mark is a mark used by members of a cooperative, association or other collective group or organization. A certification mark is a mark owned by one person and used by others to certify regional or other origin.

Thus, a certification mark cannot be used as a trademark by its owner. The owner of certification mark does not produce the goods or control their quality, but rather controls the use of the mark by others. The role of the owner of a certification mark is to ensure that the use of the mark by others meets the requirements that the owner has established for certification.

Consequently, a certification mark does not indicate a single source, but indicates to consumers that the goods possess certain characteristics. A certification mark therefore indicates that the goods have passed some qualifications established by the owner.

One of these characteristics or qualifications is regional origin, when the mark is used to certify that the goods originate from a particular geographical region.

An example of a registration for a regional certification mark is Registration No. 0571798 for ROQUEFORT.

Applications to register collective or certification marks are subject to the same registrability criteria as other marks, except geographical descriptiveness. But, certification marks that become generic are liable to cancellation like any generic term. Other grounds of cancellation are that the owner does not control use of the mark; or uses the mark in connection with any of the goods for which the mark is registered; or allows use of the mark for purpose other than certification; or refuses to certify goods of another who would otherwise qualify for the standards or conditions that the mark certifies.

8. Does inclusion of a protected GI as part of a trademark qualify as legal bar to the registration of such trademark?

If the GI is protected in the United States by means of trademark rights – whether through a registration or through common law rights acquired by use in the United States –and if there is a likelihood of confusion between the GI and a subsequently used trademark including the GI, an application for the subsequent trademark should be rejected on the basis of the prior registration or the application may be successfully opposed by the owner of the prior registration or common law rights. Similarly, a registration for the subsequent trademark should be cancelable on the basis of the prior registration or use of the GI.

If a geographical term in a composite mark is regarded by the USPTO as a generic term that term must be disclaimed from the application to register the mark.

9. Does your country's laws, e.g. trade or merchandise legislation, require the application of correct designations of origin / source on agricultural products and food—stuffs?

With some exceptions, all goods entering the United States must indicate to the ultimate consumer their country of origin.¹⁰ Where the goods are subject to substantial transformation by a U.S. processor or manufacturer, that processor or manufacturer may be the ultimate consumer. These provisions are administered and enforced by the U.S. Customs Service.

Excepted goods include some animal and agricultural products, such as eggs, livestock, vegetables, fruits, nuts, berries, and live or dead animals, fish and birds, which do not themselves require country of origin labeling. However, consumer ready containers for such goods do require country of origin marking.

Recent legislation requires retailers to inform consumers about the country of origin for certain meats, and all fresh and frozen fruits and vegetables.¹¹ Implementation of much of this law has been suspended until 2008.

10. How are conflicts between trademarks and GIs resolved under your country's laws?

In the U.S. some GIs may be protected as trademarks and some trademarks are GIs. Conflicts between trademarks and GI's sometimes are usually resolved in one of two ways:

- (a) in an opposition or cancellation proceeding before the Trademark Trial and Appeal Board, if one of the parties has applied for or obtained a trademark registration, or
- (b) in a civil court proceeding regardless of whether a mark or GI has been registered.

Do they co-exist or does either the trademark or GI prevail?

In certain instances a trademark and a GI may coexist. For example, the owner of a U.S. registration for a geographical name or GI cannot prevent another entity from using that name or GI fairly and in good faith solely to truthfully describe the geographical origin of a product.¹²

In other instances a trademark and GI may not coexist. For example, the owner of a Principal Registration for a trademark containing a geographical name can prevent another from using a confusingly similar geographical name or GI as a trademark or in a deceptive manner. Similarly, the owner of a collective or certification mark for an indicator of regional origin can prevent another from using a similar GI unless the other complies with standards established by the owner of the registration. On the other hand, a person or organization that has acquired common law rights through use of a GI in the U.S. to indicate the geographical origin of its products may be able to prevent another from registering the GI as a trademark. Alternatively, a person or organization that is using a GI descriptively may be able to prevent another person or organization from claiming to have acquired distinctiveness or secondary meaning in a GI.

Under U.S. law, a GI may not be registered as a trademark on the Principal Register, if when used with the goods of the applicant it is "primarily geographically descriptive" of the goods, unless the mark has acquired distinctiveness.¹³

A mark is primarily geographically descriptive if:

- (a) the primary significance of the mark is a generally known geographic location

- (b) there is a goods place association between the geographic location and the goods sought to be registered
- (c) the applicant's goods come from the at location.

Substantially exclusive and continuous use of mark in connection with an applicant's goods in commerce, for the 5 years preceding the date on which the claim of distinctiveness is made, may be accepted as prima facie evidence of acquired distinctiveness.¹⁴

Indicators of regional origin may be registered in the U.S. as collective or certification marks by persons, nations, states, and municipalities exercising legitimate control over the use of such marks.¹⁵

In the U.S., a mark that is primarily geographically deceptively mis-descriptive of the goods of an Applicant may not be registered.¹⁶ This is an absolute bar and may not be overcome through proof of acquired distinctiveness.

A mark is primarily geographically deceptively mis-descriptive if:

- (a) the primary significance of the mark is a generally known geographic location,
- (b) the consuming public is likely to believe the place identified by the mark indicates the origin of goods bearing the mark, when in fact the goods do not come from that place, and
- (c) the misrepresentation was a material factor in the consumer's decision.¹⁷

Is there a rule for determining whether the trademark or GI should prevail, and what are the criteria to take into account (e.g. the "first in time, first in right"—rule, the reputation of the geographic region or the reputation of the trademark, the length of time that the name has been used to indicate the geographic region and the extent of such usage, the length of time that the trademark has been used and the extent of such usage).

For marks that are geographically descriptive of the origin of particular goods, the first person that establishes acquired distinctiveness may be able to prevail against a person attempting to use a similar mark where the latter cannot show acquired distinctiveness.

Although a Principal Registration of a geographically descriptive mark is prima facie evidence of its validity, ownership of a registration is not a prerequisite to the filing of a lawsuit or an opposition or cancellation proceeding. If the alleged owner of the mark can establish that it acquired prior common law rights through use, the owner will be able to prevent the use of confusingly similar trademarks, collective marks or certification marks by others. In determining whether a

geographically descriptive mark has acquired distinctiveness, many factors are considered including the length of use, the volume of sales, the extent to which a mark has been advertised or publicized and the extent to which the mark has become known among prospective purchasers.

II. **Proposals for adoption of uniform rules**

The Groups are invited to put forward any proposals for adoption of uniform rules regarding the relationship between trademarks and GIs. More specifically, the Groups are invited to respond to the following questions:

1. Should countries provide for registration systems dealing specifically with GIs?

Yes.

If so, what should the key features of such a system be?

Non-deceptive geographically descriptive names should be registered as a trademark provided the owner can prove acquired distinctiveness. Geographical names also should be registrable as collective or certification marks.

Should a multilateral system of registration of GIs be established?

Yes, as set forth in the TRIPs built-in agenda, but only as a non-binding informational database. The U.S. Group specifically opposes any multinational GI register with supranational effect, e.g., as proposed by the EU.

If so, what should the key features of such multilateral system be?

Non-deceptive geographically descriptive names should be registered provided the owner can prove acquired distinctiveness. Geographical names also should be registrable as collective or certification marks.

The United States favors a voluntary registration system.¹⁸

Specifically, which international body should be tasked with establishing such system?

Existing international bodies, such as WIPO (through the Madrid Arrangement and Madrid Protocol) and OHIM.

How should the application for or registration of a GI be notified/made public (either in your country or at a multilateral level) in order to avoid that a trademark may conflict with a GI previously unknown to the trademark owner?

The GI as protected within trademark law should be published for opposition prior to registration.

2. Do you have any suggestions as to the acquisition, maintenance, scope and enforcement of GI protection? What should the scope of protection of a GI be?

Acquisition, maintenance and scope of enforcement of GI protection should be governed by the same rules that apply to trademarks, certification marks and collective marks.

Should the legal rules established for appraising the acquisition, maintenance, scope and enforcement of trademark protection apply to the appraising of the acquisition, maintenance, scope and enforcement of GI protection?

Yes.

3. Should a protection of GIs by individual and/or collective or certification marks be possible?

Yes, the owner of a GI should have the option of seeking protection of the GI as a trademark, collective mark and certification mark, if the conditions for each are met.

4. How should conflicts between trademarks and GIs be resolved? Please propose a specific rule for determining whether trademark or GI should prevail, which is likely to be broadly accepted. If co-existence is contemplated, should such co-existence be limited to the country of origin or relate to the relevant markets?

The same administrative and judicial bodies that resolve trademark disputes should have authority to resolve conflicts between trademarks and GIs on a "first in time, first in right" basis.

There should be no exclusive rule as to whether a trademark or GI should prevail in all instances. Rather, each case should be considered in light of the specific facts.

The U.S. Group does not favor coexistence since such coexistence undermines exclusivity and the "first in time, first in right" principle.

¹ Agreement Between the United States of America and the European Community on Trade in Wine, dated March 10, 2006, agreeing, *inter alia*, to limit the use of certain semi-generic names in the U.S. market.

² Section 1052(e)(2) of the Lanham Act prohibits registration of names deemed primarily geographically descriptive. However, "indications of regional origin" are expressly permitted protection under Section 1054 of the Lanham Act as certification or collective marks.

³ Certification mark is defined in the Lanham Act as "[A]ny word, name, symbol, or device, or any combination thereof –

(1) used by a person other than its owner; or

(2) 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 this Act,

to certify 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."

⁴ Collective mark is defined in the Lanham Act as "a trademark or service mark –

(1) used by the members of a cooperative, an association, or other collective group or organization, or

(2) 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 this Act,

and includes marks indicating membership in a union, an association, or other organization."

⁵ 27 C.F.R. 4.25(a)

⁶ 15 U.S.C.1052

⁷ 15 U.S.C.1054

⁸ 15 U.S.C.1127

⁹ 15 U.S.C.1127

¹⁰ 19 U.S.C. 1304 (Tariff Act)

¹¹ The Farm Security and Rural Investment Act of 2002

¹² 15 U.S.C. 1115(b)(4).

¹³ 15 U.S.C. 1052(e)(1)

¹⁴ 15 U.S.C. 1052(f)

¹⁵ 15 U.S.C. 1054

¹⁶ 15 U.S.C. 1052(e)(3)

¹⁷ *In re California Innovations*, 393 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003)

¹⁸ TN/IP/W/5 www.docsonline.wto.org