

Examination Guide 2-20

Marks Including Geographic Wording that Does Not Indicate Geographic Origin of Cheeses and Processed Meats

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This examination guide sets out the procedures for examining applications for cheeses and processed meats in which the mark includes geographic wording (hereinafter “geo-significant wording”) that does not indicate geographic origin, but otherwise may be a generic designation for such goods. See Trademark Manual of Examining Procedure (TMPE) § 1210.02(b)(iii). The contents of this document do not have the force and effect of law and are not meant to bind the public in any way. This document is intended to provide clarity regarding existing requirements under the law or agency policies. This guidance supersedes any previous United States Patent and Trademark Office guidance on this topic to the extent there are any conflicts.

I. BACKGROUND

Two federal agencies maintain lists of particular cheeses or processed meats for which the producers of such goods must satisfy certain requirements or standards in order to label or market them with the listed common name of the product. Thus, these names cannot be single-source indicators, and inclusion on such lists is strong evidence that the otherwise geo-significant wording is generic for the goods.

The U.S. Food and Drug Administration (FDA), responsible for protecting the public health by ensuring the safety of the nation’s food supply, establishes mandatory requirements, known as “standards of identity,” for marketing cheese products under specific common names. These standards of identity relate solely to the production methods and ingredients necessary to label a product with the common name given to that standard. For example, part 133 of title 21, chapter 1, subchapter B (Food for Human Consumption) includes standards of identity for the following types of cheeses: CHEDDAR, EDAM, ROMANO, and PROVOLONE.

The U.S. Department of Agriculture (USDA), also responsible for ensuring food safety, establishes standards of identity for labeling of processed meat products under specific common names. For example, USDA regulations part 319 include standards of identity for the following types of processed meat: FRANKFURTER, WIENER, BOLOGNA, and BRAUNSCHWEIGER.

In addition to these two federal agencies, an international body, Codex Alimentarius (hereinafter “Codex”), operates within the U.N. Food and Agriculture Organization and the World Health Organization to establish international food standards for, among other things, cheese. Codex standards of identity for cheese include: BRIE, CAMEMBERT, EDAM, GOUDA, and HAVARTI.

Because standards of identity relate solely to production methods and ingredients, there is no requirement that the product come from a specific place, even though many of these

terms identify a cheese or processed meat that once came only from the place referred to in the name (e.g., CHEDDAR originated in Cheddar, England; BRIE originated in Brie, France; and BOLOGNA originated in Bologna, Italy). Therefore, such geo-significant terms differ from certification and collective marks of regional origin, which are registrable under Trademark Act § 4, 15 U.S.C. § 1054. Certification and collective marks of regional origin refer to the place the products come from and the quality standards they meet. Standards of identity are food-labeling requirements intended to prevent consumers from being misled as to what product they are buying.

II. PROCEDURE FOR EXAMINING APPLICATIONS FOR CHEESES AND PROCESSED MEATS

In addition to searching for evidence using traditional sources, when a mark includes geo-significant wording relating to a particular cheese or processed meat, the examining attorney must also conduct research to determine if the wording is a standard of identity for the goods specified in the application, using sources of evidence that are appropriate for the particular goods specified in the application (e.g., the FDA, USDA, and Codex databases). The examining attorney may submit a request to the Trademark Law Library to undertake such research or may personally conduct the research. In either case, the examining attorney must add a Note to the File indicating “standards of identity search” or “Law Library standards of identity search.” Evidence that the particular term is a standard of identity must be included with the Office action. If available, the examining attorney should include additional evidence that shows how the proposed mark would be perceived in the marketplace. Note that if the name of a product appears only on the Codex list, further evidence, such as a dictionary definition or internet evidence of the product’s availability to U.S. consumers, must be included.

When warranted by the evidence, the examining attorney must refuse registration or require a disclaimer under § 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), in accordance with current practice as outlined in the TMEP. TMEP §§ 1209.02, 1209.02(a), 1213.03(a). Because inclusion on the FDA or USDA list is strong evidence that the term is generic for the particular cheese or processed meat, when the marks include or consist of such terms, the examining attorney should also advise the applicant that the relevant wording appears to be the generic term for the goods, in accordance with current practice as outlined in TMEP § 1209.02(a) (“If there is strong evidence that the proposed mark is generic, a statement that the subject matter appears to be a generic name for the goods or services should be included in conjunction with the refusal on the ground that the matter is merely descriptive.”).

When there is evidence that the accuracy of a product’s compliance with standards of identity is material to purchasing decisions—in other words, the consumer bought the product thinking it was the particular cheese or processed meat named in the mark—a mark including or consisting of such terms used on non-compliant cheeses or processed meats would be deceptive under § 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). Therefore, the examining attorney must require that the applicant amend the identification of goods to include the term. See TMEP §§ 1203.02(a), (d), (e)(i)-(ii), (f)(i).

If the name of a standard of identity comprises, in whole or in part, a mark for services that relate to cheese or processed meat, the assigned examining attorney must consult the Office of the Deputy Commissioner for Trademark Examination Policy before taking any action on the application.