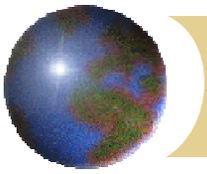


Geographical Indications (GIs)

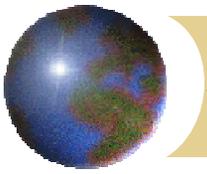
Global Intellectual Property Academy

Nancy Omelko—Attorney-Advisor (Trademarks)
Office of Intellectual Property Policy and Enforcement
United States Patent and Trademark Office



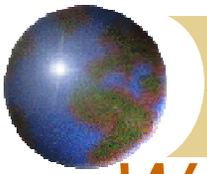
What are geographical indications?

- Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) (1994) defines geographical indication as
 - a product from a region
 - where a given quality, reputation or other characteristic of the product
 - is essentially attributable to its geographical origin."



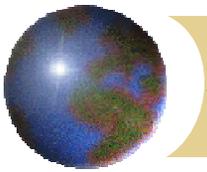
Trademarks and Geographical Indications

- ❖ The United States view is that a geographical indication is a type of trademark.
- ❖ A sign functions as a trademark/geographical indication if that sign:
 - ❑ If it is distinctive; and
 - ❑ If it indicates that the product originates from a particular *source*.



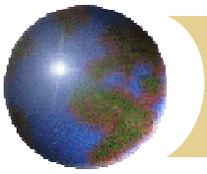
Words that are generic or that merely describe the product are not distinctive

- For example, “apple” to identify apples is a generic term and is not distinctive. (But note that APPLE certainly is distinctive if it is used to identify another product, like a computer).
- For example, “fast” to identify restaurant services is merely descriptive of the services and not distinctive. (But “fast” for apples is distinctive.)
- It depends on which product or service the mark/geographical indication is used on.



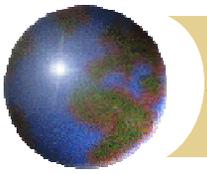
Acquired Distinctiveness

- ❑ But although a sign that is not distinctive does not function as a trademark, that is not the case if that sign *acquires distinctiveness* in the minds of consumers.
- ❑ A distinctive term can be a trademark/geographical indication if consumers come to associate the term with a particular source.
- ❑ Generic terms may never acquire distinctiveness.



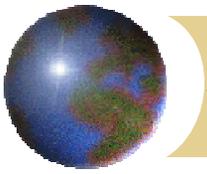
Business Interests/Guarantees

- More generally, in addition to functioning as source identifiers, geographical indications and other trademarks also share the following characteristics:
 - Both are valuable business interests; and
 - Both are guarantees of quality.



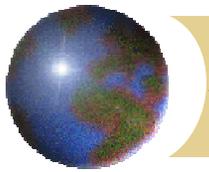
Protection of GIs in US

- The US protects geographical indications through the same system that it uses to protect other trademarks.
- Typically, geographical indications are registered as *certification marks* in the United States.



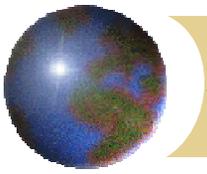
Certification Marks for Origin

- A certification mark is owned by a party other than the user(s) of the mark
- is used to certify that the goods originate in a particular location
- and, because of the characteristics of that location, have reputation.



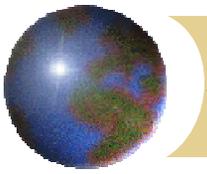
Examples of GIs registered in the US





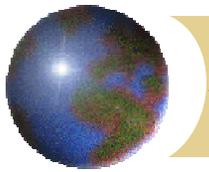
Benefits Owner and Consumer

- For the owner—is a (possibly very valuable) intangible economic asset.
- For the purchaser—conveys (possibly very useful) information about the characteristics of the product, and distinguishes them from other products.



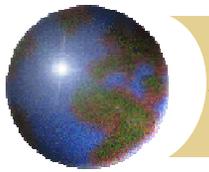
Benefits of registering geographical indications within existing trademark system

- An effective trademark system can function to prevent the use and registration of GIs and other trademarks that are similar to existing trademarks.
- An effective trademark system that encompasses GIs can function to ensure that governments will provide required notice.
- A well-functioning trademark system treats *all* requests to register GIs and other trademarks in the same manner, whether the request is from a citizen or a non-citizen.



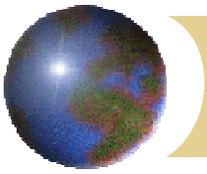
Benefits (continued)

- Well-functioning trademark systems provide trademark owners with the means to protect their rights, at their own initiatives. That benefits both right holders
 - who retain control over the protection of their trademarks
 - and national governments, who are spared the burden and expense of intervening on behalf of the trademark owner.



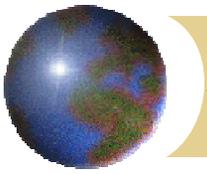
Other Systems

- ❑ Exchange lists of terms that each country recognizes as a GI.
- ❑ Unless the country receiving the list objects to a particular term, that term would be protected as a GI in the receiving country.
- ❑ Even if a particular term *acquired distinctiveness* as a GI among consumers in one country, that term may not have acquired distinctiveness, and may not even be known, in another country.



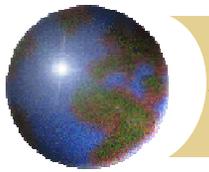
Pitfalls of List-Trading

- ❑ Governments that enter into list-trading agreements would be required to expend resources to protect the terms that acquired GI status via the lists.
- ❑ On the other hand, they would not earn any of the *revenue* produced by examination systems.
- ❑ List-exchange systems require costly government-to-government negotiations.



Unequal numbers on lists

- The exchange that results from a list-exchange between countries may be an uneven exchange:
 - one country may have thousands of GIs on the list it submits
 - and the second country may have only a handful on its list.



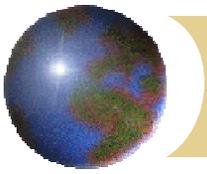
Why US Favors the Trademark System over List Trading

● Examination in a Trademark System

- ❑ Prior existing trademarks and GI protected.
- ❑ Terms that have not acquired distinctiveness as GIs will not be protected.
- ❑ Generic designations may not be accorded GI protection.
- ❑ International obligations to provide notice of claims in GIs can be met.

● Lists

- ❑ Prior existing trademarks may not protected.
- ❑ Terms that have not acquired distinctiveness may be protected as GIs.
- ❑ Generic terms may be accorded GI protection.
- ❑ International obligations to provide notice of claims in GIs might not be met.



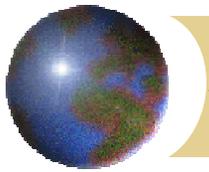
(continued)

✿ Examination in a
Trademark System

- ✿ Governments can earn revenue from fees for examining applications.

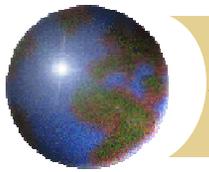
✿ Lists

- ✿ Governments are deprived of the revenue they could earn from examination systems.



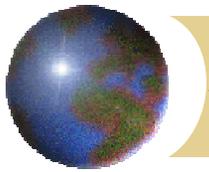
Requirements for Certification Mark Application in USPTO

- Statement that Use Is by Person Other than Owner
- Indication of the Region
- Showing of Authority to Control a Geographical Term
- Specimens showing use by others (if application based on use)



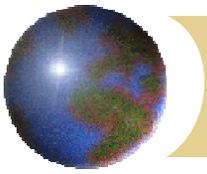
Necessary Statements by Applicant

- Applicant is exercising legitimate control over the use of the certification mark in commerce or in connection with the above identified goods or services.
- Applicant is not engaged in the production or marketing of the goods or services to which the mark is applied



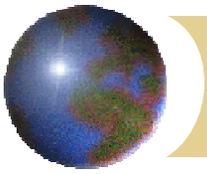
Message Conveyed by Certification Mark

- ✿ The goods or services have been examined, tested, inspected, or in some way checked by a person who is not their producer, by methods determined by the certifier/owner.
- ✿ The placing of the mark on goods or its use in connection with services thus constitutes a certification by someone other than the producer that the prescribed characteristics or qualifications of the certifier for those goods or services have been met.



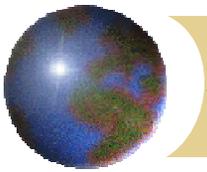
How does this work in practice?

- ❖ All products (and services) that derive their specific attributes or expertise from the region can be protected as a certification mark.
- ❖ Because Africa produces 25% of the world's tea—we now look at the *Darjeeling* case.



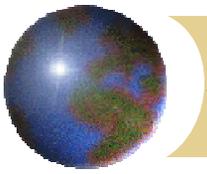
Darjeeling for tea

- Registered in the USPTO by the Tea Board of India
- Successfully opposed registration of “Darjeeling Nouveau” for tea before the Trademark Trial and Appeal Board.



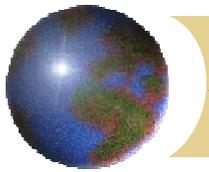
The Certification Statement

“The certification mark, as used by authorized person, certifies that the tea contains at least one hundred percent (100%) tea originating in the Darjeeling region of India, and that the blend meets other specifications established by the certifier.”



Ownership

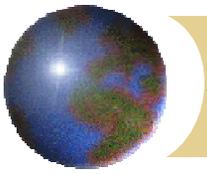
- “The certification mark is the absolute property of the Proprietor and shall not be used by any person except as an authorized user.
- “The power of issuing and cancelling a License is vested in the Proprietor.”
- “The Proprietor” in this case is the Tea Board of India—located in India.



Geographic Areas

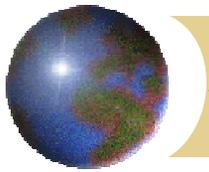
The following areas within the District of Darjeeling in the State of West Bengal, India:

- (i) hilly areas of Sadar sub-division
- (ii) hilly areas of Kalimpong sub-division
- (iii) Kurseong sub-division, excluding, the areas in the District of Darjeeling Authority's Jurisdiction List These areas are non-hilly areas of the Kurseong sub-division, which are not capable of producing tea of the requisite standard.



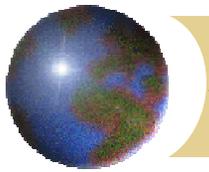
Requisite Characteristics of the Tea

- ❖ Cultivated, grown or produced in the tea gardens in the geographic areas registered in accordance with the Indian Tea Act.
- ❖ Processed and manufactured in a factory located in these areas.
- ❖ Tested by expert tea tasters and determined to have:



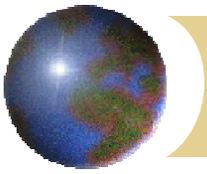
Tea Tasters Findings

- Distinctive and naturally occurring organoleptic characteristics of taste, aroma and mouth feel typical of tea cultivated, grown and produced in these areas.



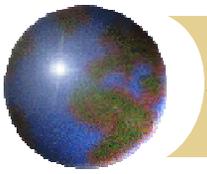
Tea Tasters Credentials

- ➊ Considered competent to evaluate these characteristics as a result of many years of practical training and experience in the assessment of tea and their highly refined sensory perception, in particular, in relation to the sensations of smell, taste and mouth feel of the different types of tea.
- ➋ This enables them to recognize the distinctive characteristics associated with a particular type of tea and thereby accurately analyze the nature and quality of the tea.



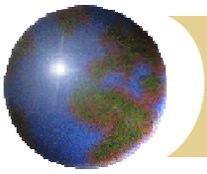
Blends

- The certification mark may be used in relation to a blend of Darjeeling teas drawn from more than one tea garden, only if each tea constituting the blend is capable of being described by reference to the Certification Mark, in accordance with these regulations.
- The Certification Mark may not be used in relation to a mixture of Darjeeling tea with teas of other origin and/or countries, even in phrases incorporating the word “blend” such as “DARJEELING Blend” or “Blended DARJEELING”.



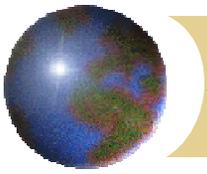
Licensing

- Applicant for license must:
 - Indicate that the tea will conform to the standards set out.
 - Guarantee that the proprietor or its agent shall be entitled to inspect, prior to and after the grant of the license, the user's premises and take samples of tea or packaging used by the user.



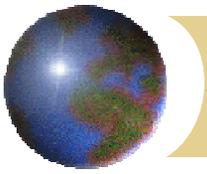
Other requirements

- ❖ The proprietor will keep a register of all the names, addresses and trade descriptions of each user including any cancellations of the licenses.
- ❖ The proprietor shall be entitled to enter upon the premises where the tea is being grown, cultivated, processed, manufactured, packed or stored for ensuring that the standards are being adhered to.



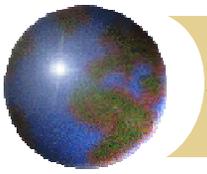
Conditions as to use of the mark

- Pay license fee
- Certification mark shall be applied to packaging for the tea so that it is clearly visible along with the license number.
- User will provide quarterly reports on volume sold.



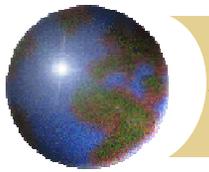
Duration and conditions of license

- ⊕ One year with automatic renewals.
- ⊕ Each party may terminate without prejudice to its other remedies with notice in writing.



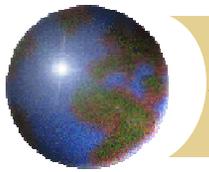
Breach of regulations

- ✿ Uses certification mark in an unauthorized, misleading or deceptive manner, or is convicted of any offense leading to the discredit of his reputation, or is adjudicated bankrupt, the license may be cancelled.
- ✿ All items bearing the certification mark shall be delivered to the proprietor for the purpose of being destroyed.



Procedure for Resolving Disputes and other provisions

- ❖ Right to appeal cancellation to the Central Government of India, with notice to the proprietor.
- ❖ Regulations may be amended with the consent of the Indian Central Government and the USPTO.
- ❖ The proprietor may delegate its authority to appropriate persons.

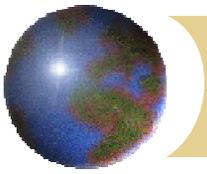


Tea Board of India

v.

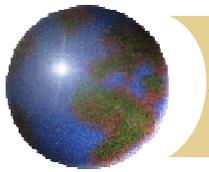
The Republic of Tea, Inc.

- The TTAB found that in view of the similarity of the marks and the strength of opposer's marks in relation to the goods, and because the goods, as well as the trade channels and purchasers for the goods are identical, confusion is likely.



Why is this all so important?

- Trademarks and geographical indications are intellectual property
- They are private rights that can lead to economic benefits that reward the producer and bring increased income to the lowest level of the production chain.
- The consumer benefits from consistency of product characteristics.



Thank you

Nancy Omelko

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USPTO

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