

**USE OF GEOGRAPHICAL
INDICATIONS AS PART OF
DESIGNATIONS FOR
OTHER GOODS**

U.S. LAW



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.
- 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.

Lanham Act

Post-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.

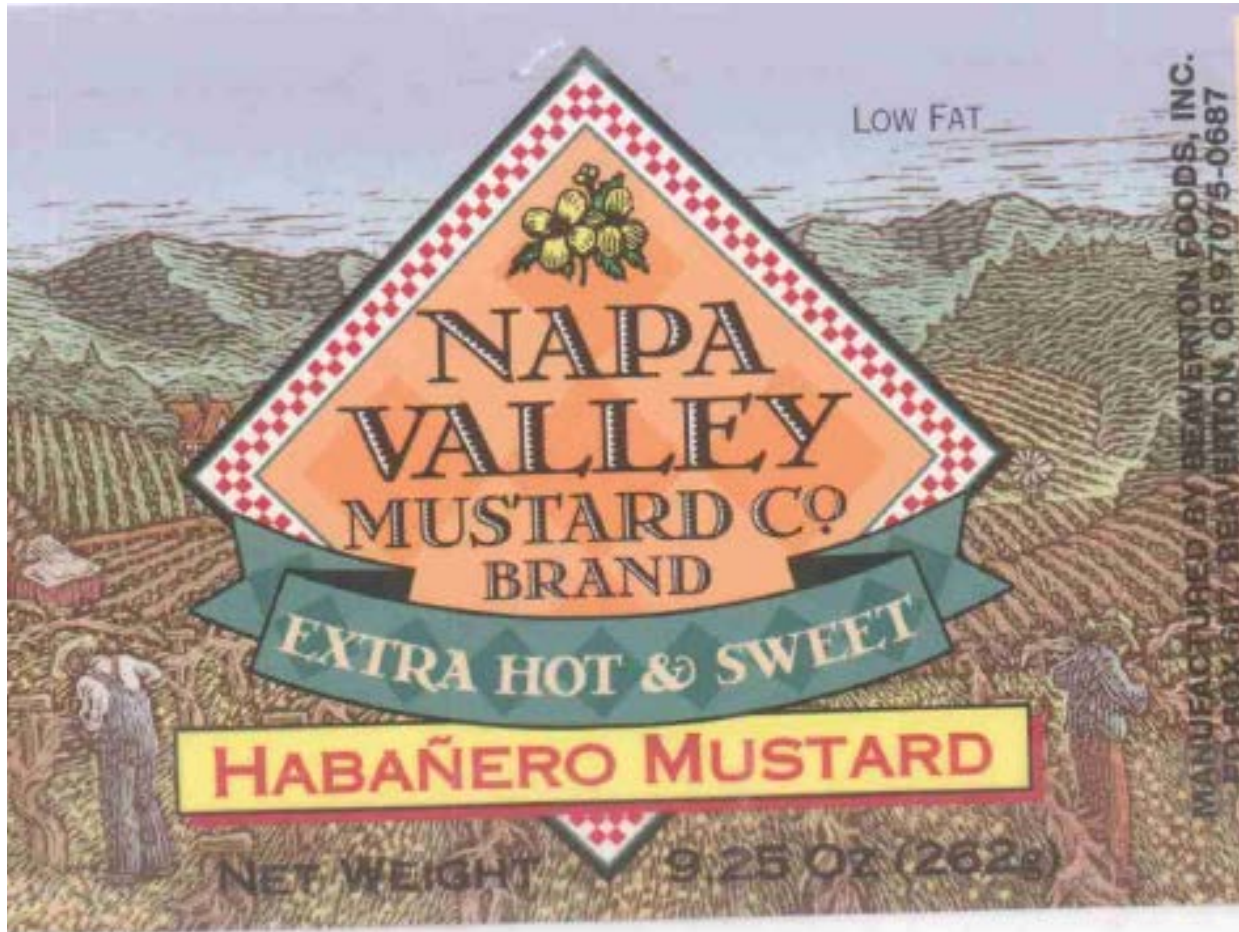
Lanham Act

Post-TRIPS Article 22

Section 43(a) of the Lanham Act (15 U.S.C. §.1125(a)):

Any person who, on or in connection with any goods or services ... uses in commerce ... any false designation of origin ... which— is likely to cause confusion, or to cause mistake, or to deceive as to ... the origin ... of his or her goods, services, or commercial activities ... or in commercial advertising or promotion, misrepresents the ... geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action

Geographic Deceptiveness



Geographic Deceptiveness

“goods are manufactured in Oregon ‘from mustard seed grown in the Northern tier states and in Canada, but not in the Napa Valley.’”

In re Beaverton Foods, Inc., 84 U.S.P.Q.2D 1253, 1254 (TTAB 2007)

Geographic Deceptiveness

- widely advertised annual festival dedicated to mustard supports the goods/place association
- further connection of the area to wineries and gourmet food enhance that association

In re Beaverton Foods, Inc., 84 U.S.P.Q.2D 1253, 1258 (TTAB 2007)

Geographic Deceptiveness?

United States of America
United States Patent and Trademark Office

NAPA VALLEY

Reg. No. 3,849,174

Registered Sep. 21, 2010

Int. Cl.: 20

ASHLEY FURNITURE INDUSTRIES, INC. (WISCONSIN CORPORATION)
ONE ASHLEY WAY
ARCADIA, WI 54612

FOR: MATTRESSES, IN CLASS 20 (U.S. CLS. 2, 13, 22, 25, 32 AND 50).



Geographic Deceptiveness?

PARK AVENUE is not geographically deceptive or misdescriptive of cigarettes not from Park Avenue in New York City. There is no goods-place association. Rather, “Park Avenue” is used only to suggest a sophisticated aura often linked to that wide street in New York City associated with fashionable living and high society.

Philip Morris, Inc. v. Reemtsma Cigarettenfabriken GmbH, 14 U.S.P.Q.2d 1487 (TTAB. 1990)

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

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)

Geographical Certification Marks

- Test: Likelihood of Confusion
 - Similarity of marks
 - Relatedness of goods and services
 - Sophistication of consumers

Geographical Certification Marks

The test for likelihood of confusion for certification marks is the same as for trademarks, there is no additional element of geographic deceptiveness required.

Institut Nat'l Des Appellations D'Origine v. Brown-Forman Corp., 47 U.S.P.Q.2D 1875, 1890 (TTAB 1998)

Geographical Certification Marks

Fact that defendant's mark CANADIAN MIST AND COGNAC was for a product that contained genuine, certified Cognac as an ingredient not matter, deception not required, just confusing similarity

Institut Nat'l Des Appellations D'Origine v. Brown-Forman Corp., 47 U.S.P.Q.2D 1875, 1888-90 (TTAB 1998)

Geographical Certification Marks

BLACK COGNAC



Class 3 - Personal grooming products for men, namely, cosmetic hair and skin care preparations

*BNIC and INAO v. Gibbs
Distribution LLC., Cancellation No.
92064771*

Geographical Certification Marks

BLACK COGNAC BEARD BALM-AID

\$21.00

SKU: GIBS-BALMAID

DESCRIPTION

All wrapped up in manly hints of cognac, bergamot, black carnation and musk, you won't want to forget to slip Black

Beard badasses, it's time to spiff, not stiff, your whiskers!

We're helping you do it with our new Black Cognac Beard Balm-Aid; a one-two punch to your pucker. This double duty wonder product acts as a balm and pomade in one, busting a smooth move on your beard and keeping strands in place and at attention for whatever life throws your way.

Shea and cocoa butters help soothe and breathe life, and manhood, back into brittle, busted beards, leaving your barbell of a beard soft and strong. Coconut, grape seed and sweet almond oils slick, shine and condition your jaw jersey while sending beardruff to the curb. Finally, catch a beard buzz with a little beeswax, which adds a finishing touch of hold and heft without that stiff upper lip.

All wrapped up in manly hints of cognac, bergamot, black carnation and musk, you won't want to forget to slip Black

Geographical Certification Marks

AFTER DINNER COGNAC

Class 25 - Hats; hoodies; jackets; polo shirts; sweaters; t-shirts; t-shirts for women, men; graphic t-shirts

BNIC v. Washington, Opposition No.
91235203

Strong or Well Known Marks



Strong or Well Known Marks

Where strong and well-known marks are used by others, the scope of protection may extend far to other product fields. For example, the following uses of well-known, alcoholic beverage marks were held infringements: BEEF-EATER restaurant, JOHNNY WALKER motel, JOHNNIE WALKER cigars, and BLACK LABEL cigarettes.

4 McCarthy on Trademarks and Unfair Competition § 24:49 (5th ed.)

Strong or Well Known Mark?



GIs and Dilution

Trademark Dilution Revision Act – famous mark, defendant is making use of the challenged designation as a mark or trade name, likelihood of association with plaintiff's famous mark arising from its similarity to the plaintiff's famous mark.

15 U.S.C. §1125(c)

GIs and Dilution

Dilution Act apply to Geographical Indications?

Peter M. Brody, Geographical Indications and Dilution: Reinterpreting "Distinctiveness" Under the Lanham Act, 100 Trademark Rep. 905 (2010)

DP&F

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