

Geographical Indications



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What are Geographical Indications (GIs)?

- Indicators of Source – specific place or region
- DO NOT inform consumer of the specific producer in the same way as trademarks
- Article 22(1) of TRIPS – “indications, which 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 geographical origin.”



Examples of GIs

- “Vidalia” Onions
- “Roquefort” Cheese
- “Darjeeling” Tea
- “Swiss” Chocolate
- “Bashu Somen” Noodles

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Why are GIs Afforded Protection?

- Valuable marketing tools in the Global Economy
 - Identify goods as originating from particular territory or region
 - Indicate quality by informing consumers that goods come from areas where a given quality, reputation, or other characteristic of the goods is essentially attributable to their geographic origin.
 - Intellectual property subject to relief from acts of infringement and unfair competition.



TRIPS Compromise - Art. 22(2)

- WTO Members are required to provide legal means for interested parties to prevent use of a GI that:
 - Indicates or suggests good originates in a geographical area other than true place of origin in manner which misleads the public as to the geographic origin of the goods, or
 - Constitutes an act of unfair competition.
- “Misleading Test”



Enhanced Protection under TRIPS

■ Art. 23 of TRIPS

- GIs that identify wines and spirits
- Protection, even if public would not be deceived, if wines or spirits do not originate in place indicated by the GI.
- Cannot use words like “kind,” “style,” or “type,” in connection with products covered by enhanced protection.



Limitations on Arts. 22 and 23

- Protection not required if GI is generic name for goods
 - “Swiss” Cheese
 - “Danish” Pastries
 - “Bermuda” Shorts
 - “Dijon” Mustard
 - “Canadian” Bacon



Protection of GIs in U.S.

■ Certification Mark

- Any 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.



Types of Certification Marks (1)

- Certify that Goods or Services originate in a specific geographic region
 - ROQUEFORT for cheese
 - COGNAC for distilled brandy from a region in France



Types of Certification Marks (2)

- Certify that goods or services meet certain standards of quality, materials, or mode of manufacture
 - UL certifies representative samplings of electrical equipment meeting certain safety standards
 - CELANESE certifies plastic toys meeting certifiers safety standards



Types of Certification Marks (3)

- Certify that work or labor on the products or services was performed by a member of a union or other organization, or that the performer meets certain standards



Owner of Certification Mark

- Does not produce goods or perform services in connection with which mark is used
- Owner does control use of the mark by others on their goods or services
- Applicant must submit copy of standards established for use of mark
- Must assert that applicant is exercising legitimate control over use of mark in commerce or has bona fide intent



Collective Mark

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



Types of Collective Marks

- **Collective trade or service marks**
 - Indicate commercial origin of goods or services (source is a member of the group)
 - Florida Orange Growers Mark of Purity
- **Collective membership marks**
 - Simply indicate membership and do not serve any origination function
 - Good House Keeping Seal



Collective Mark

- Collective organization owns the mark
- All group members use the mark
- Collective mark owner may use the mark itself
- Protection enforced under general trademark law



Common Law GIs

- Common law without registration
- Institut National Des Appellations v. Brown-Forman Corp., 47 USPQ 2nd (BNA) 1875 (TTAB 1998)
- TTAB held COGNAC to be a protected common law certification mark for brandy originating in the Cognac region of France.



Bronco Wine Company v. Jolly

- California State Wine Labeling Statute
 - Requires that no wine produced or marketed in California shall use a brand name or have a label bearing the word “Napa” unless 75% of the grapes from which the wine was made was grown in Napa County.
- Bronco makes and sells 3 brand name wines made from grapes not grown in Napa.
- Bronco also makes Charles Shaw wine, commonly called “Two-buck Chuck”



Bronco Action

- Requested writ of mandamus to prohibit enforcement of the state statute
- Asserted that the statute was preempted by federal law, among other things
- 1986 Federal statute provides protection similar to state statute, but makes exception for brand names being used prior to July 7, 1986
- California statute removes the exception.



Court proceedings

- Court of Appeal held the state statute was preempted by the federal law
- California Supreme Court reversed
- U.S. Supreme Court denied review on March 21, 2005.

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Case still pending

- Bronco alleges the statute violates free speech rights, places undue burden on interstate commerce, and unconstitutionally takes Bronco property without compensation
- Napa grapes average \$4000 per ton, while other state red wine grapes average \$600 per ton.