

# Trademarks and Geographical Indications



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1



## Trademarks

- Trademarks serve to identify and distinguish the goods or services of one party from those of another party.
- In general, trademarks may consist of a variety of elements:
  - letters
  - numbers
  - words
  - logos
  - slogans
  - shapes (configurations)
  - colors
  - motions

In some countries, they can even consist of *non-visual* signs such as sounds and scents.

2



## Examples of signs as Trademarks

- Word Marks: KODAK
- Design Marks: 
- Composite Marks (words and designs): 
- Slogans: WE BRING GOOD THINGS TO LIFE

3



## Unusual Trademarks

- Shape: Bottle shape for soda pop 
- Color: Pink color for insulation 
- Sound: Drums, trumpets and strings for entertainment / motion picture films   
20thCenturyFox.mp3
- Scent: Plumeria flower blossom scent for sewing thread 
- Motion: Flying pegasus for movie studios 

4



## Trademarks help businesses

- Through hard work and investment, businesses and entrepreneurs build reputation and goodwill in their products with their customers and the public in general.
  - Trademarks are a key way of protecting this reputation and good will.
- Businesses frequently cite their trademarks as their most valuable asset that they own: Think of Coca Cola, McDonalds



- By using and protecting trademarks, entrepreneurs can develop marketing and branding strategies that can be used in expanding their businesses.

5



## Trademarks: Tool for improving opportunity and profits

- As trademarks become more well-known and familiar to the public, there will likely be a higher demand for those products or services that are identified by these trademarks and which customers and the public have grown accustomed to.
- Once a brand is well established, a party can increase its profits and visibility by entering into lucrative business arrangements (i.e., **licensing** and **joint ventures**) with third parties.
  - As a business owner, it is important to consult with legal counsel before entering into these forms of businesses contractual relationships that can impact your legal rights.



6



## Helpful TIPS concerning TMs

### Avoiding TM mistakes concerning strategy, territoriality and registration



#### **STRATEGY:**

- Choosing the right trademark for you is vitally important as this will be the name that customers will associate with your goods.
  - Frequently, a business will choose a mark that describes their product. However, this is problematic as others may need to use the same sign to describe their products as well.
  - You should choose wisely and select a sign that will clearly identify and distinguish your products from your competitors.
    - In other words, it should be distinctive.

7

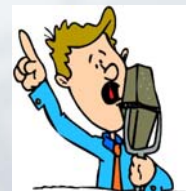


## Helpful tips, Continued

#### **REGISTRATION:**



- In general, acquiring a Trademark Registration provides:
  - notice to third parties and
  - informs of all the rights you are claiming.



8



## Helpful Tips, Continued

### TERRITORIALITY:

- It is common for small and medium size businesses to be unfamiliar with the rights they have once they have obtained a registration.
  - For example, many trademark owners may not be familiar with the fact that the registration they have in hand is only valid and enforceable within the borders of the country that registered that trademark.
- In other words, if they want protection in other countries, they must file an application and get a registration in each of those countries.
  - Businesses and entrepreneurs should consider filing and registering their marks in those countries where they plan to expand to or are conducting business in.



9



## Trademark Protection

- Trademark rights are territorial.
- Most countries follow a “first-to-file” rule:
  - Protection is granted to the first party who files an application and receives a registration.
- You must search and file in each country in which you wish to sell your goods or services.



10



## Trademark Registration Process

- Procedures can be common among IP offices.
- Generally, the process consists of the filing of an application, examination of the proposed sign (including relative and/or absolute grounds), publication of the application (to allow third parties to oppose) and maintenance. Also, allow for cancellation of the registered mark.
- Frequent issues in examination:
  - refusal of the pending application if the proposed sign is likely to cause confusion with prior rights
  - refusal based on the proposed sign being generic and not serving as a trademark
    - Varietal or cultivar names: how should they be handled?

11



## Varietal or Cultivar names

In the U.S.:

A Varietal or Cultivar name is not registrable because it is essentially the generic name for a particular plant, seed, etc., and therefore does not function as a trademark.





## Definitions

- “Varietal” or “cultivar” names are designations given to hybrids and cultivated varieties by plant breeders. Often, a varietal or cultivar name is used in a plant patent to identify the newly created variety of plant.
- Example: “Legacy” is a cultivated variety of the sugar maple tree. Thus, “Legacy” is the varietal name.



## The Test: In U.S. practice

- In order to issue the refusal, the following test must be satisfied:
  - The identification of goods includes plants, flowers, trees, fruit, vegetables, foliage or seeds; and
  - The identification, specimens or information from the applicant demonstrate that identified goods are living/fresh; and
  - Evidence establishes that the proposed mark is a varietal or cultivar name for those goods.





## Public perception?

- Whether a plant variety denomination is listed in the UPOV database is not evidence that the variety denomination is generic for that plant variety in the United States.
- As with other generic terms, the United States consumer is the object against which the determination of whether a term is generic must be weighed.

15



## Trademark Registrations

Examples of Bolivian owned trademarks registered for seeds, plants and other related goods at the U.S. Patent and Trademark Office:

Mark	TROPIGENE
Goods and Services	IC 031. Agricultural grains for planting; Agricultural seeds; Flower bulbs and corms; Fresh corn; Live plants; Natural plants and flowers; Plant seeds; Raw corn; Seeds and bulbs; Seeds for flowers; Unprocessed cereals; Unprocessed corn; Unprocessed grain; Vegetable seeds for planting.
Registration Number	3848626
Registration Date	September 14, 2010
Owner	(REGISTRANT) AGRICOMSEEDS S.R.L. CORPORATION BOLIVIA Calle Seyeye, 2455 Santa Cruz BOLIVIA

16





## Geographical Indications

What are geographical indications?

Article 22 of the TRIPs Agreement (Agreement on Trade Related Aspects of International Property Rights):

“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 geographic origin.”



## Examples of Geographical Indications Protected in the U.S.

- Roquefort Cheese (France) - U.S. Registration No. 0571798
- Idaho Potatoes (U.S.) - U.S. Registration No. 1,735,559
- Colombian Coffee (Colombia) – U.S. Reg. No1160492
- Parma Ham (Italy) - U.S. Reg. No. 2014628
- Cognac (France) – common law certification mark



## Geographical Indications as Certification Marks

- The U.S. view is that GIs are a subset of trademarks because they are both: source-identifiers, guarantees of quality, and business interests.
- In the U.S., GIs are protected within the trademark system as certification or collective marks.



## Certification Marks

- Can certify:
  - 1) geographic origin;
  - 2) materials used, quality, method of manufacture, and accuracy; or
  - 3) products made under the auspices of, or by members of a specific trade union or organization





## Opposition and Cancellation

- Available to anyone:
  - 1) domestic or foreign,
  - 2) who would be damaged by the registration, or the continued existence of a U.S. registration.
- Trademark Trial and Appeal Board (“TTAB” or “Board”), of the U.S. Patent and Trademark Office (USPTO).



## Benefits of the U.S. System

- Efficiency – utilizes the existing trademark regime
- Meets TRIPs obligations.
- System is self-policing - no additional enforcement resources necessary.





# Thank You

Gracias

Köszönettel

شكراً

Hvala

Merci

ขอบคุณ

Teşekkürler

תודה

Bedankt

Eυχαριστώ

Obrigado!

Díky

Vielen Dank

धन्यवाद

Grazie