

DEWEY & LeBOEUF

American Origin Products (AOP):
Protecting a Legacy

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Available Protection in the U.S.

Choices for Protecting a Geographically Distinctive Product:

- **Trademark** - generally indicates a single commercial source
- **Collective mark** - owned by a collective and usable only by members - of limited use but similar to certification marks
- **Certification mark** - goods or services meet the standards of a third party certifier

These marks can be obtained either through

- common law by use
- by registration, or by both.

Trademark

PROS

- **Commercial royalties**
- **No set standards**
- **Owner may use**

CONS

- **Single source**
- **May not be primarily geographically descriptive**

Collective Mark

PROS

- **May be primarily geographically descriptive**
- **Standards must be applied**

CONS

- **Only members of collective may use**

Certification Mark

- **Certification marks, a specific type of trademark, are the form taken by most GIs in the US**
- **They serve a unique purpose within US trademark system**
- **Certification marks exist in over 60 countries**
- **US has approximately 175 live geographic-oriented certification marks**
- **European Union has approximately 1,000 registered GIs (excluding wines and spirits)**

Certification Mark

PROS

- **May be primarily geographically descriptive**
- **Standards must be applied**
- **No discrimination**

CONS

- **Owner may not use**
- **Owner may not apply for an EU GI**

Certification Program

Causes for Cancellation:

- Lack of control over the mark
- Production or marketing by owner of goods and services under the mark
- Allowing the mark to be used for purposes other than certification
- Discriminately refusing to certify conforming goods

Trademark vs. Certification Mark

- **Ethiopia**
 - **Harrar**
 - **Sidamo**
 - **Yirgacheffe**
- **Darjeeling**

1. Registration Restrictions

- The PTO to police its approval of new registrations which conflict with existing certification marks
- Applications for trademarks *include* a registered certification mark to be administratively denied registration

Proposals for Making U.S. Certification Marks More Attractive and User Friendly

PROS

- Limit obligation to challenge even most obviously offending marks

CONS

- Creates separate standard for certification marks
- The PTO can already refuse on basis of pre-existing registration

1A. Modified Registration Restrictions

- Specific guidelines for Trademark Examiners
- Presumption

Proposals for Making U.S. Certification Marks More Attractive and User Friendly

PROS

- Less controversial

CONS

- Indications this approach already embodied in actual administrative practice

2. Extended Protection for Certification Marks

- Extend certification mark protection to include phrasing such as "like" or "style" or "kind" (already mandated by TRIPS for wines and spirits)

Proposals for Making U.S. Certification Marks More Attractive and User Friendly

PROS

- Increased protection for certification marks to generate increased rewards for producers in view of costs

CONS

- Controversial; would require Congressional action

3. Enforcement Costs

- Attorney's fees to the prevailing party in oppositions

Proposals for Making U.S. Certification Marks More Attractive and User Friendly

PROS

- Avoid frivolous applications/oppositions

CONS

- Highly unusual
- Available in district court trademark litigations under “exceptional” circumstances

4. Ownership

- Permit the owner of a certification mark to use the mark

Proposals for Making U.S. Certification Marks More Attractive and User Friendly

PROS

- Finance for some expenses (maintaining and enforcing the mark)
- Eliminate the conflict with the EU system for GIs
- Note: discrimination in certifying is already grounds for cancellation

CONS

- Would require significant changes in current law.
- Who will oversee the certification process objectively?

5. Use

- Clarify uses certification mark can be put to without ruling cancellation – i.e., what is “use for purposes other than certification”?

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Questions?