

How To Protect Your Distinctive Regional Product in the United States

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Applying Legal Expertise and Experience to Geographic Indication (GI) Protection in the United States: The Basic Issue

A group of producers of a geographically distinctive product intends to market that product in the US. The region of origin may be in the Americas, Asia, Africa or Europe. How best to create a brand that links the geographic source of the product to its geographic region? The strongest possible brand is key to achieving higher prices and recognition, leading to economic, ecological and cultural benefits to the producers.

Who should be interested?

- Producers
- Associations of producers
- Their governments, from local to national

How to Proceed?

Producers (including all of the above interested parties) may prefer that the US had an EU-style GI regime in place, with government-based enforcement available to keep watch over the use of brands. They may also wish that the existence of pre-existing trademarks was less of a concern.

In the US, however, your choices arise from a menu of trademarks:

- An ordinary single "commercial" source – identifying trademark
- A certification mark
- A collective mark
- Common law trademark rights

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This memorandum is intended only as a general discussion of these issues. It is not considered to be legal advice. We would be pleased to provide additional details or advice about specific situations. For additional information on this important topic, please feel free to call upon your Dewey & LeBoeuf relationship partner.

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For the most part, enforcement is a matter of self-help, and the quality standards are self-defined. No trademarks are available if the name in question is generic for, or highly descriptive of, the product in question.

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With that in mind, the focus will be on the two leading alternatives:

Commercial Trademarks. A trademark consists of a word, name or symbol and indicates a single source, usually a commercial source, of goods. The single source may license its rights to third parties. Because trademarks cannot for the most part be geographically descriptive of the place of the origin of the goods, they are frequently inappropriate for regionally distinctive products.

One way to side-step the restriction on geographic descriptiveness is to use a logo (such as a map) to indicate the locale, or to include the place name in the trademark – knowing that the place name will not receive protection as a trademark – and add a distinctive and recognizable design or logo which can be protected.

Certification Marks. A certification mark is a type of trademark, one of the specific purposes of which is to protect regionally distinctive products. Unlike commercial trademarks, certification marks may be geographically descriptive. Most often, GIs take the form of certification marks in the US.

Note, however, that certification marks come with a significant restriction: they may be used only to certify goods produced and sold by persons other than the certification mark owner. The owner, most often a governmental entity or a producers' cooperative or association, certifies the origin and/or the quality of the goods in question. Consequently, it is often advisable to form a special purpose entity as the certifier, minimizing the opportunity for claim that the owner is selling the relevant goods and avoiding problems under GI regimes such as that in the European Union, where the owner of the GI is a seller of the goods.

How to obtain and retain a certification mark or trademark?

We at Dewey & LeBoeuf frequently advise clients on how to acquire trademarks and certification marks and how to establish certification mark and trademark programs, as well as how to form and put to good use associations which own and control certification marks.

Register the mark with the Patent and Trademark Office. This step involves confirming that there are no pre-existing conflicting marks,

advising on the relationship between the certification mark and the producers' GI protection outside the US, and exploring means to enhance protection, such as the use of designs and logos.

Control the use of the certification mark

- No use of the mark for purposes other than to certify
- Develop standards
 - May be self-defined
 - May be based on requirements of local statute or regulation
- Apply those standards
- Establish internal controls to police quality and origin at the place of origin
- Establish an enforcement program to police use in the marketplace
- Consider requiring licenses for users of the certification mark

Do not discriminate in application

- **Failure to apply in a non-discriminatory fashion may result in the loss of the certification mark**

Enforcement is crucial on two levels: not only is the certification mark worth only as much as it is identified with the quality and characteristics of the products certified, but the certification mark may be cancelled upon a showing that the certified goods are not controlled. Similar consequences apply to trademarks.

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Producers and their associations, and governments and their agencies, need to understand the US system and their choices under that system in order to be able to work their way through its complexities, because the end result – a protected regional designation with an effective enforcement program – can be of high value to local economy and tradition.

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