

USPTO Draft of Examination Guide: Geographic Certification Marks

Comments/suggestions/requests of clarification by oriGIn

The Organization for an International Geographical Indications Network (oriGIn) is the global alliance of geographical indications (GIs), representing some 350 groups and over two-million producers. oriGIn advocates for the effective legal protection and enforcement of GIs at the national, regional and international level.

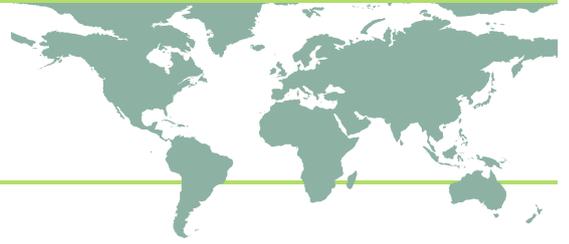
We would like to thank the USPTO for the opportunity to share comments/suggestions on the Draft Examination Guide for Geographic Certification Marks. We believe that such a Guide is a positive step, representing an opportunity to address (and improve) the policies and procedures concerning Geographic Certification Marks, as well as to ensure a more consistent implementation of those.

As for specific issues, oriGIn would like to mention the following:

With respect to Part II.A (“Identifying Geographic Certification Mark Applications”), page 2, to streamline the procedure, we believe it would be worth providing for a check box on application forms giving the opportunity to applicants to indicate that a Geographic Certification Mark is being applied for. This would be a simple indication for the examining attorney, who would keep the final word as to whether the applied-for mark is to be considered a Geographic Certification Mark;

Part II.C (“Terms Certifying Regional Origin vs generic Terms”): page 5: The list of suggested criteria to assess whether a term in a mark functions to certify geographic origin or is instead generic could be improved, by referring for instance to public surveys among relevant purchasing public/consumers as well as by mentioning the importance for examining attorneys to carefully analyze anecdotal information available on the Internet (not always accurate). Likewise, we have reservations to consider “the fact that the term is used to identify goods or services in third-parties registrations” as supporting evidence that the term at issue is viewed in the relevant marketplace as generic. On the other hand, we would like to have some clarifications with respect to the reference to “product information from the applicant or the producers of the relevant goods or services” in the context of such criteria.

Part II.G (“Likelihood of Confusion Search Analysis”): a mere quantitative approach (“If there are numerous registrations or prior applications containing the same geographical designation (whether disclaimed or not) as the applied-for certification mark...”) should not be the only criteria against which “genuine” applied-for Geographic Certification Marks are evaluated. A qualitative evaluation of the prior registrations and applications (for instance, whether they have been made by parties that can be certified by the entity applying for the Geographic Certification Marks or by third parties with no genuine link whatsoever with the geographic area at issue) should be introduced. Furthermore, it should be reinforced the concept that applications for marks for similar goods that include a prior registered Geographic Certification Mark should be administratively denied



registration. This is crucial to limit the obligation on owners to challenge even the most obviously offending marks.

Finally, we would like to take this opportunity to recall that in 2010, in collaboration with various American experts, oriGIn published a manual on GIs in the US (available at http://www.origin-gi.com/images/stories/PDFs/English/oriGIn_Publications_2010/American_Origin_Products_Protecting_a_Legacy_Final_23.02.pdf), which focuses on the adjustments the current legal framework would require for the American GI business to fully deploy its potential. We believe that the comments contained in this manual, some of them requiring legislative adjustments, remain relevant.