

Geographical Indications in Branding Strategies – Legal Issues and Examples in the U.S.

J. Scott Gerien

Dickenson, Peatman & Fogarty

1455 First Street, Ste. 301

Napa, California 94559

(707) 261-7058

sgerien@dpf-law.com



Geographical Indications in U.S.

- U.S. recognizes TRIPs provisions on GIs
- However, U.S. has no registration system that expressly protects GIs
- GIs may be protected as geographical certification marks, although USPTO does not acknowledge if a certification mark is a GI

Geographical Indications in U.S.

- What does this mean?
- The U.S. standard to register a geographical certification mark is lower than the standard for establishing a GI under TRIPs
- It is not necessary that a geographical certification mark have any established quality, characteristic or reputation to be registered in US

Geographical Indications in U.S.

- So, a GI may be registered in the U.S. as a geographical certification mark, but just because a term is registered as a geographical certification mark does not mean it is a GI pursuant to the TRIPS definition of GIs

Geographical Indications in U.S.

- Examples of U.S. registrations for geographical certification marks that are also arguably GIs under TRIPs:
 - IDAHO for potatoes
 - ASTI for wine
 - COLUMBIAN for coffee
 - WISCONSIN for cheese
 - WEST INDIES for fabrics

Geographical Indications in U.S.

- Owners of U.S. certification marks *cannot* use the marks on the goods for which the mark is registered
- Usually owned by governments or trade associations, not producers themselves
 - Idaho Potato Commission owns the registration for the IDAHO certification mark for potatoes

Geographical Indications in U.S.

- So if the certification mark owner cannot *use* the certification mark, how does it promote the certification mark and the certified goods?
- Special exception under U.S. law ► owner of the certification mark may promote the mark and the goods, but cannot sell the goods under the certification mark

Geographical Indications in U.S.

- Certification mark owner may own service marks or trademarks which include the geographic term, so long as the trademark or service mark is distinguishable from the geographical certification mark

Geographical Indications in U.S.

Prior U.S. Cl.: A

United States Patent and Trademark Office

Reg. No. 2,914,308

Registered Dec. 28, 2004

CERTIFICATION MARK PRINCIPAL REGISTER

IDAHO

STATE OF IDAHO POTATO COMMISSION (IDAHO STATE AGENCY)
599 WEST BANNOCK STREET
P.O. BOX 1068
BOISE, ID 837011068

FOR: POTATOES AND POTATO PRODUCTS, NAMELY FRESH, FROZEN, REFRIGERATED AND DEHYDRATED POTATOES, IN CLASS A (U.S. CL. A).

THE CERTIFICATION MARK, AS USED BY AUTHORIZED PERSONS, CERTIFIES THAT GOODS IDENTIFIED BY THE MARK ARE GROWN IN IDAHO AND THAT THE GOODS CONFORM TO QUALITY, GRADE AND OTHER REQUIREMENTS, PURSUANT TO STANDARDS DESIGNATED BY THE APPLICANT.

SER. NO. 76-542,379, FILED 9-3-2003.

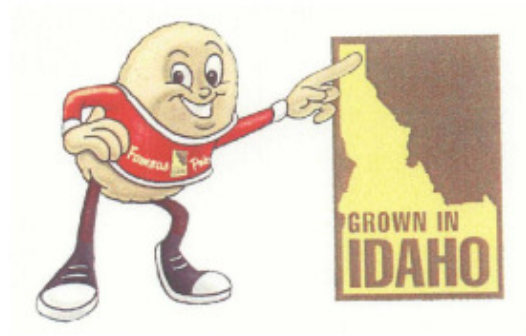
Geographical Indications in U.S.

United States Patent and Trademark Office

Reg. No. 2,939,377

Registered Apr. 12, 2005

**TRADEMARK
PRINCIPAL REGISTER**



IDAHO POTATO COMMISSION (IDAHO STATE AGENCY)
599 WEST BANNOCK STREET
P.O. BOX 1068
BOISE, ID 837011068

FOR: MAGNETS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-0-2003; IN COMMERCE 10-0-2003.

FOR: CALENDARS AND STICKERS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 2-0-1999; IN COMMERCE 2-0-1999.

OWNER OF U.S. REG. NOS. 1,735,559, 2,406,487 AND OTHERS.

THE COLOR(S) RED, BEIGE, BROWN AND GOLD IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE COLOR RED APPEARS ON THE SHIRT OF THE CHARACTER, BEIGE APPEARS IN THE POTATO BODY, BROWN APPEARS ON THE LEGS OF

Geographical Indications in U.S.

- Pursuant to U.S. law, wine appellations are recognized and regulated by the Alcohol and Tobacco Tax and Trade Bureau (TTB)
- TTB will establish a wine region as an American Viticultural Area (AVA) if it can be demonstrated that the region demonstrates common soil, climactic and geological characteristics

Geographical Indications in U.S.

- The U.S. Government does not expressly recognize AVAs as GIs
- However, certain AVAs clearly meet the TRIPs definition of GIs by demonstrating qualities, characteristics or reputation attributable to the region

Napa Valley AVA

- **27 CFR Section 9.23** - recognizes Napa Valley as an AVA
- Recognized February 21, 1981
- Second Recognized AVA

Napa Valley AVA

- Napa Valley is a GI
- One of the reasons is because Napa Valley can claim a worldwide reputation as a result of the quality of its wines and promotion of the GI

Napa Valley AVA

- Napa Valley is located 50 miles north of San Francisco, California.



Napa Valley AVA

- NVV founded in 1944
- Today 450 winery members
- Two primary missions
 - Protecting the Napa Valley AVA
 - Promoting the Napa Valley AVA



napa valley vintners

Ensuring Napa Valley Brand Conjunctive Labeling Requirement

- Experience of Bordeaux – Strength of Bordeaux reduced by use of smaller sub-appellations instead of larger Bordeaux appellation
- Solution – Conjunctive labeling law

Ensuring Napa Valley Brand Conjunctive Labeling Requirement

The Napa Valley Appellation and its
Sub-Appellations

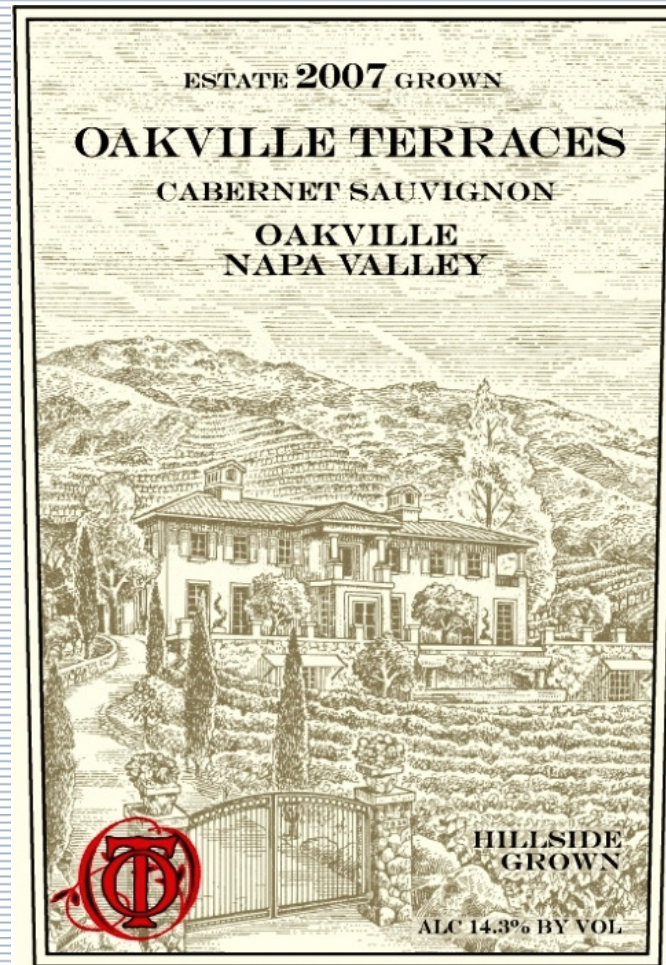


Napa Valley and
Sub-Appellations

Ensuring Napa Valley Brand Conjunctive Labeling Requirement

- California Business & Professions Code 25240
– Any wine carrying a sub-appellation contained entirely within Napa Valley must use the “Napa Valley” AVA in direct conjunction with the sub-appellation on the label.

Ensuring Napa Valley Brand Conjunctive Labeling Requirement



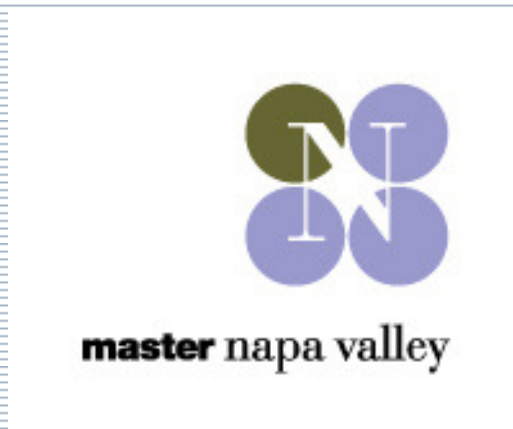
Promotion of Napa Valley Brand



PREMIERE NAPA VALLEY®

Three-day festival and wine auction in Napa Valley for the trade, raises money to support NVV marketing programs

Promotion of Napa Valley Brand



MASTER NAPA VALLEY®

Three-day educational program in Napa Valley about Napa Valley wine for wine professionals

Promotion of Napa Valley Brand



NAPA VALLEY WINE EDUCATORS ACADEMY®

Educational course offered with
The Culinary Institute of
America for professional wine
educators about winegrowing
and winemaking in the Napa
Valley

Promotion of Napa Valley Brand



EXPERIENCE NAPA VALLEY®

Special program where trade and media from a particular region are invited to Napa Valley to visit vineyards and wineries to learn more about the Napa Valley appellation

Promotion of Napa Valley Brand



TASTE NAPA VALLEY®

Tastings for trade and consumers in cities in U.S. and abroad

Promotion of Napa Valley Brand



NIGHTLIFE NAPA VALLEY®

Tastings targeted to millennial
wine drinkers

Promotion of Napa Valley Brand



NAPA GREEN®

Sustainability certification
program for Napa Valley
vineyards and wineries



Promotion of Napa Valley Brand



AUCTION NAPA VALLEY®

Largest charitable wine auction in U.S. featuring wine from single appellation



Over \$110 million dollars has been raised for Napa Valley charities

Promotion of Napa Valley Brand



NAPA NEIGHBOR®

Program for Napa Valley residents to receive wine discounts and special benefits at Napa Valley wineries

Promotion of Napa Valley Brand

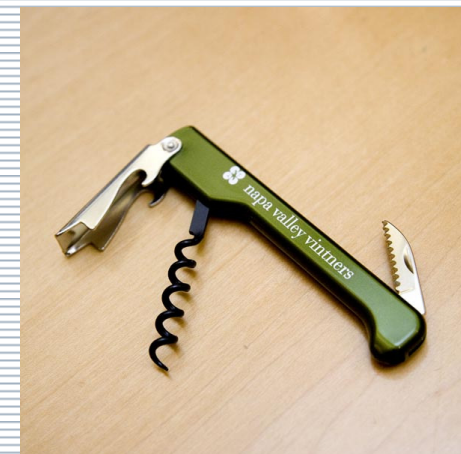
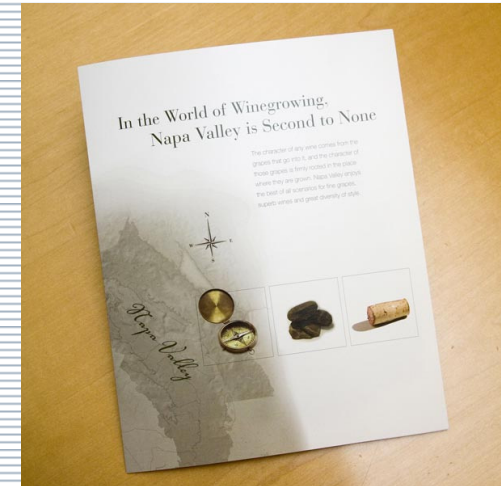
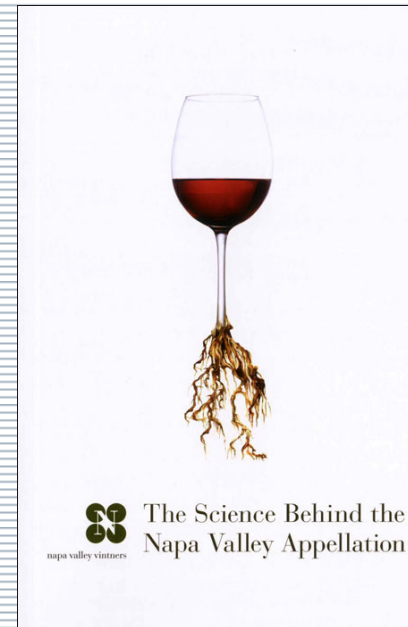
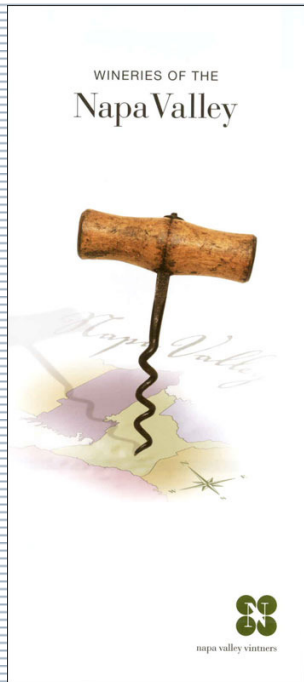


NAPA VALLEY ROCKS®

Suite of educational and promotional materials available to the media and trade to provide information and background on the science of the Napa Valley appellation

Promotion of Napa Valley Brand

Promotional Materials



Value of Napa Valley Brand

Napa Valley Grape Production 1975 - 2005

Year	Grape-Bearing Acres	Tons Produced	Dollar Value
1975	15,708	50,218	\$13,524,580
1985	25,504	101,406	\$79,531,089
1995	31,514	109,841	\$140,804,079
2005	41,910	181,025	\$540,743,398

Value of Napa Valley Brand

- Due to their superior quality, Napa Valley Wines command a higher price than wines from any other region in the United States of America.
- Wines labeled with the Napa Valley AVA cost \$19.80 more on average per bottle than wines labeled with a California appellation.

Value of Napa Valley Brand

Napa Valley produces just 4% of California's wine grapes, yet the region is responsible for nearly 30% of the economic impact of wine in California and nearly 34% of the economic impact of California's wine on the U.S. economy

Value of Napa Valley Brand

- Economic impact of Napa Valley wine industry in Napa County is \$10.9 billion
- Economic impact on State of California is \$15.2 billion
- Economic impact on U.S. economy is \$42.4 billion

Napa Valley Reputation = GI



ประกาศกรมทรัพย์สินทางปัญญา
เรื่อง การขึ้นทะเบียนสิ่งบ่งชี้ทางภูมิศาสตร์
นาปา วัลเลย์ "Napa Valley"
ทะเบียนเลขที่ สช 54100036

เพื่อให้การขึ้นทะเบียนสิ่งบ่งชี้ทางภูมิศาสตร์เป็นไปตาม พระราชบัญญัติคุ้มครอง
สิ่งบ่งชี้ทางภูมิศาสตร์ พ.ศ.2548 อาศัยอำนาจตามความในมาตรา 32 แห่งพระราชบัญญัติระเบียบ
บริหารราชการแผ่นดิน พ.ศ.2534 แก้ไขเพิ่มเติมโดยพระราชบัญญัติระเบียบบริหารราชการแผ่นดิน
(ฉบับที่ 5) พ.ศ.2545 กรมทรัพย์สินทางปัญญาจึงออกประกาศไว้ ดังต่อไปนี้

ให้ขึ้นทะเบียนสิ่งบ่งชี้ทางภูมิศาสตร์ นาปา วัลเลย์ "Napa Valley" ลำยเลขที่
51200049 ทะเบียนเลขที่ สช 54100036 ซึ่งมีรายการทางทะเบียนตามบัญชีแนบท้ายประกาศฉบับนี้

ทั้งนี้ ตั้งแต่วันที่ 12 มิถุนายน 2551

ประกาศ ณ วันที่ 15 พฤศจิกายน พ.ศ. 2554

(นางปวีณา ชนกันต์)
อธิบดีกรมทรัพย์สินทางปัญญา

As a result of its reputation for quality wine "Napa Valley" has been registered as a GI in six countries so far, including Thailand on November 15, 2011

Napa Valley Reputation = GI

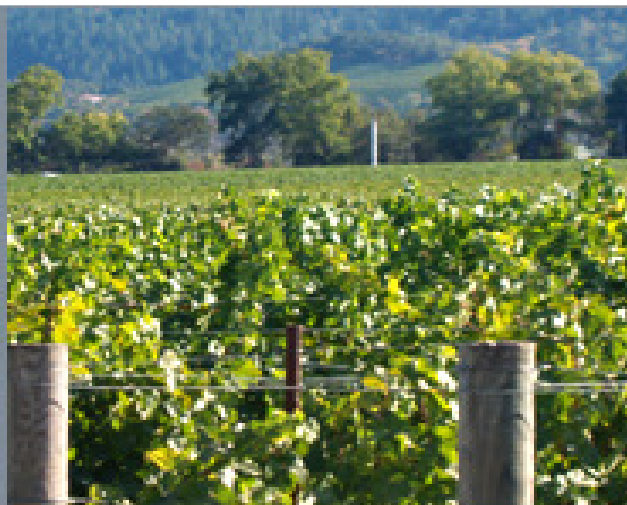


February 14, 2013, Napa Valley, California

Napa Valley Reputation = GI

Other jurisdictions where Napa Valley registered as a GI

- European Union
- China
- India
- Brazil
- Canada



J. Scott Gerien

Dickenson, Peatman & Fogarty

sgerien@dpf-law.com

(707) 261-7058

1455 First Street, Ste. 301

Napa, CA 94559 U.S.A.

DICKENSON PEATMAN & FOGARTY