

Examination of Geographical Indications (GIs) in the United States

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UNITED STATES
PATENT AND TRADEMARK OFFICE



GI protection through U.S. trademark law

- Section 4 of the U.S. Trademark Act provides for registration of GIs as certification and collective marks indicating regional origin, which is the legal equivalent of GI registration in sui generis regimes.
- According to U.S. case law, certification marks indicating regional origin are inherently distinctive and, therefore, are exempted from refusals based on geographic descriptiveness.
- GIs can be protected for all qualifying goods and services – they are not limited to food and agricultural products.
- The USPTO administers the registration process.
- For wines and spirits, the Trade and Tax Bureau of the U.S. Treasury Department administers the label approval process.

Contents of applications for certification marks indicating regional origin

- The GI – word, design or combination.
- The goods/services associated with the GI.
- A copy of the standards of production – including area of production and characteristics of the product/service essentially attributable to its geographical origin.
- A certification statement indicating, at a minimum, the product/service being certified and the specific region where the product/service must originate.
- A statement that the certifier is not engaged in the production of the GI.
- A specimen of use, and dates of use, by an authorized user (for applications based on use).
- A statement of bona fide intention to use the GI in commerce (for applications not based on use).

The applicant is usually a governmental body, because there must be authority to control use of the geographic term.

Genericness refusals - evidence

- U.S. regulations showing the applied-for GI is the name of a cheese or meat product – standards of identity.

https://tmep.uspto.gov/RDMS/TMEP/current#/result/ch1200_d33465_1da6c_2a3.html?q=%22standards%20of%20identity%22&ccb=on&ncb=off&icb=off&fcb=off&ver=current&syn=adj&results=compact&sort=relevance&cnt=10&index=1

- Codex Alimentarius standards of identity.
- Evidence that the applied-for GI is a grape variety or animal breed.
- Internet evidence or dictionary definitions showing productions in areas beyond the applied-for GI.
- Trademarks in the USPTO database containing the applied-for GI where the goods/services come from an area other than the GI region.

Disclaimer requirement for compound GIs

- When an applied-for GI includes a generic term, a statement must be in the record to show that the generic term is free for use by other producers.
- Example: provolone Valpadana
- “No claim is made to the exclusive right to use provolone apart from the mark as shown.”
- This provides certainty as to what part is protected, and what is not, so that countries will understand that production and importation of these generic products may continue.



Thank you!

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