



## **ARE Trademark Alert: The USPTO Issues New Examination Guide on “Geo-Significant” Trademarks for Cheeses and Processed Meats**

Author(s): Holly Pekowsky , Max Vern ,

On May 15, 2020, the United States Patent and Trademark Office (USPTO) has issued a new Examination Guide, “Marks Including Geographic Wording that Does Not Indicate Geographic Origin of Cheeses and Processed Meats,” which sets out procedures for examination of trademark applications for cheeses and processed meats including a geographic term (also-called “geo-significant” wording), which is not a geographic origin indicator.

These guidelines are not meant to interfere with protection of geographical indications (GI), used to identify products originating from certain loci, such as Prosciutto di Parma dry-cured ham or Parmigiano Reggiano cheese, a related yet separate and painful for the U.S. practice subject, but to prevent protection of geo-significant wording which is generic for these goods.

As a general rule, when a mark consists of a geographic term, and the latter designates the geographic location, the mark will be considered geographically descriptive and refused registration unless the owner can show that the mark has acquired secondary meaning. The policy behind requiring secondary meaning for geographically descriptive marks makes sense, since otherwise the owner could prohibit competitors from truthfully indicating that their products originate in certain region.

If only a portion of a mark is geographically descriptive, and the remaining portion of the mark is protectable, the owner will likely be able to register the mark, but will have to disclaim the geographically descriptive portion. A disclaimer would serve as an admission that the term is geographically descriptive, and the trademark owner isn’t trying to prevent others from using the term, only the composite mark.

Section 1210.02(b)(iii) of the Trademark Manual of Examining Procedure acknowledges that a geographic term may be recognized by consumers as designating a type or food rather than a geographic location where the food is sourced or made. For example, a consumer purchasing Swiss cheese will not think the cheese is from Switzerland, but rather, that it is a certain type of cheese. The same is true for Boston-baked beans and Italian spaghetti.

The new Examination Guide provides further guidance on this issue, specific to cheese and processed meats. In particular, there are certain criteria (known as “standards of identity”), which companies must meet in order to label or market their products as a particular type of cheese or processed meat – for example, CHEDDAR, EDAM, for cheese and FRANKFURTER, WIENER and BOLOGNA for processed meat, even if many of these terms



identify a cheese or processed meat that once came only from the location referred to in the name (e.g., CHEDDAR originated in Cheddar, England, WIENER originated in Vienna, Austria, and BOLOGNA originated in Bologna, Italy).

Although these foods may have originally been named for the geographic loci where they were produced, standards of identity relate solely to production methods and ingredients and there is no requirement that the products come from a specific place.

In practical terms, consumers today associate them with a type of cheese or processed meat rather than a geographic location.

The U.S. Food and Drug Administration (FDA) handles the standards of identity for cheeses and the U.S. Department of Agriculture (USDA), establishes standards of identity for processed meat. In addition to these two federal agencies, an international body, Codex Alimentarius operates within the U.N. Food and Agriculture Organization and the World Health Organization to establish international food standards for, among other things, cheese, including BRIE, CAMEMBERT, EDAM, GOUDA and HAVARTI.

Under the new guidelines, in addition to searching for evidence using traditional sources, when a mark includes a geographic term relating to cheese or processed meat, the Examining Attorney should also conduct research using the FDA, USDA and Codex databases as appropriate to determine if the wording is used to designate a type of cheese or processed meat under the relevant standard of identity.

When the marks include or consist of such terms, the Examining Attorney may refuse registration on the basis that the term is descriptive, and should also advise the applicant that the relevant wording appears to be the generic term for the goods, i.e. it identifies the genus of product rather than a brand (think, "ASPIRIN"), and is unregistrable. If the geographic term is only part of the mark, and the other part is inherently distinctive, the geographic term may need to be disclaimed.

When there is evidence that consumers may buy the product thinking it is a particular type of cheese or processed meat, and it is not (for example, Swiss cheese that does not meet the industry standards to be called "Swiss cheese"), the mark will be considered deceptive and cannot be registered.

Thus, the new guidelines will aid the USPTO in determining whether a mark identifies a type of cheese or processed meat and should be refused registration on that basis.

For more information please feel free to contact us.

\*[Holly Pekowsky](#) and [Max Vern](#) are partners at Amster, Rothstein & Ebenstein LLP. Their practice involves all aspects of intellectual property law, including trademark law. They can be reached at [hpekowsky@arelaw.com](mailto:hpekowsky@arelaw.com) and [mvern@arelaw.com](mailto:mvern@arelaw.com).