

DEFINITIONS AND ADDITIONAL INFORMATION ON DESIGN MARKS AND GEOGRAPHICAL INDICATIONS

Prepared by ICANN Staff, 27 April 2017

Term	Definition(s)/Common Usages	Additional Comments	Working Group Discussion
Appellation of Origin¹	“The geographical denomination of a country, region, or locality, which serves to designate a product originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors” (Article 2, Lisbon Agreement)	These are a specific form of GI (see further below)	
Certification Mark	<p>EU: “An EU certification mark shall be an EU trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified.”²</p> <p>USA: “means any word, name, symbol, or device, or any combination thereof -</p> <ul style="list-style-type: none"> • (1) used by a person other than its owner, or • (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register 	<p>From WIPO:</p> <p>“Certification marks are usually given for compliance with defined standards, but are not confined to any membership. They may be used by anyone who can certify that the products involved meet certain established standards. Famous certification marks include WOOLMARK which certifies that the goods on which it is used are made of 100% wool.</p> <p>Certification marks may be used together with the individual trademark of the producer of a given good. The label used as a</p>	

¹ See below for the distinction between an Appellation of Origin and a GI.

² Created recently as part of the overall EU trademark reform package. A stated reason for introducing the new EU certification mark was “as a complement to the existing provisions on Community collective marks and to remedy the current imbalance between national systems and the EU trade mark system”: see Regulation (EU) 2015/2424, December 2015

(https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/legal_reform/regulation_20152424_en.pdf).

	<p>on the principal register established by this [Act], to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization."</p>	<p>certification mark will be evidence that the company's products meet the specific standards required for the use of the certification mark."</p>	
<p>Collective Mark</p>	<p>EU: "This [Trade Mark] Directive shall apply to every trade mark in respect of goods or services which is the subject of registration or of an application in a Member State for registration as an individual trade mark, a collective mark or a guarantee or certification mark, or which is the subject of a registration or an application for registration in the Benelux Office for Intellectual Property or of an international registration having effect in a Member State."³</p> <p>USA: "The term "collective mark" means a trademark or service mark--</p> <ul style="list-style-type: none"> • (1) used by the members of a cooperative, an association, or other collective group or organization, or • (2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register 	<p>From WIPO: "In many countries, the main difference between collective marks and certification marks is that the former may only be used by a specific group of enterprises, e.g., members of an association, while certification marks may be used by anybody who complies with the standards defined by the owner of the certification mark. An important requirement for certification marks is that the entity which applies for registration is considered "competent to certify" the products concerned."</p>	

³ The European Commission website provides the following information on collective marks: "'[C]ollective' does not mean that the mark belongs to several persons (co-applicants/co-owners) or that it designates/covers more than one country (the EU trade mark system covers all EU countries automatically) ... A collective mark can be any mark (e.g. word, figurative, 3D, etc.), provided that it belongs to a legal person of public law or to an association and it is used to distinguish the goods and services of the members of that association from those of other undertakings. Only associations of manufacturers, producers, suppliers of services or traders, as well as legal persons governed by public law, may apply for EU collective marks."

	established by this [Act], and includes marks indicating membership in a union, an association, or other organization.”		
Composite Mark	<p>EU: does not appear to have a specific definition; seemingly used interchangeably with the term “figurative mark containing letters”⁴</p> <p>USA: used in the USPTO Trademark Manual of Examining Procedure (TMEP, 1207.01(c)(ii)) to refer to a <u>mark consisting of a design element combined with words and/or letters:</u></p> <p>“Although it is not proper to dissect a mark, if one feature of a mark is more significant than another feature, greater weight may be given to the dominant feature for purposes of determining likelihood of confusion. <i>See, e.g., In re Vittera Inc.</i>, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); <i>Giant Food, Inc. v. Nation’s Foodservice, Inc.</i>, 710 F.2d 1565, 1570-71, 218 USPQ 390, 395 (Fed. Cir. 1983) ...</p> <p>If a mark comprises both wording and a design, greater weight is often given to the wording, because it is the wording that purchasers would use to refer to or request the goods or services. <i>See, e.g., Vittera</i>, 671 F.3d at 1366, 101 USPQ2d at 1911; <i>In re Max Capital Grp.</i></p>		

⁴ See, e.g., the judgment of the Court of Justice of the European Union in *Colloseum Holding AG v Levi Strauss & Co* (2013): <http://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62012CJ0012>. Where this is used to mean “device mark plus words”, this also seems to be the practice in some countries, e.g. the UK: see the UK IPO decision relating to *trade mark registration no. 2536999 in the name of Marriott Worldwide Corporation and Application no. 500977 by Dr Sascha Salomonowitz to revoke the trade mark for non-use* (<https://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results/o38316.pdf>).

	<p><i>Ltd.</i>, 93 USPQ2d 1243, 1247 (TTAB 2010) ; <i>In re Appetito Provisions Co. Inc.</i>, 3 USPQ2d 1553, 1554 (TTAB 1987). The Court of Appeals for the Federal Circuit has cautioned, however, that "[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue." <i>In re Electrolyte Labs. Inc.</i>, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990)."</p>		
Design Mark	<p>USA: Not specifically defined but used in TMEP 1207.01(c) when describing similarity between design marks. The USPTO has a Design Search Code Manual that lists Design Codes as the basis for categorizing marks with design elements. Its example (in its Trademark Basics brochure) seem to indicate that a design mark can mean a mark combining design and text elements.</p>		
Device Mark	<p>The distinction used in some countries (e.g. Australia, UK) seems to be that a "device mark" is one comprised only of design or graphic elements, in contrast with a "composite mark" which is comprised of letters/word/text plus a design or graphic element.</p>		
Figurative Mark	<p>"A figurative mark is represented using pictures, graphics or images. A figurative mark containing letters combines the use of pictures, graphics or images with words or letters" (EUIPO)⁵</p>	<p>From the EU Trademark & Design Network's Common Communication on the Practice of Distinctiveness – Figurative Marks</p>	

⁵ See below for examples of figurative marks with letters from the EUIPO.

		<p>Containing Descriptive/Non-Distinctive Words⁶:</p> <ul style="list-style-type: none"> • Where a figurative mark contains descriptive, non-distinctive text: mere stylization, adding a color, or using punctuation marks, simple geometric or commonplace shapes will not render it registrable • Where graphical elements are incorporated as part of the typeface, the mark is registrable if the graphical elements are sufficient to distract the attention of the consumer from the descriptive meaning of the word element or likely to create a lasting impression of the mark • Where the mark is registrable solely on account of its figurative element, its scope of protection is limited to the overall composition. 	
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⁶ Issued under the Convergence Program by the EUIPO and the various national EU IP offices: <https://www.tmdn.org/network/documents/10181/278891cf-6e4a-41ad-b8d8-1e0795c47cb1>.

Geographical Indication (GI) ⁷	“Indications which identify a good as originating in the territory of a [WTO] Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin” (Article 22(1), WTO-TRIPS⁸)	Under WTO-TRIPS, Member States are obliged to prevent ⁹ : <ul style="list-style-type: none"> • the use of any means in the designation or presentation of a good that indicates or suggests that the good in question originates in a geographical area other than the true place of origin in a manner which misleads the public as to the geographical origin of the good; and • any use which constitutes an act of unfair competition within the meaning of Article 10bis of the Paris Convention (1967). 	
Mark	<p>USA: “The term “mark” includes any trademark, service mark, collective mark, or certification mark”</p> <p>Malaysia: The term mark “includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof”</p>		

⁷ See below for the distinction between a GI and a trademark.

⁸ i.e. The Agreement on Trade-Related Aspects of Intellectual Property Rights (Annex 1C, Marrakesh Agreement Establishing the World Trade Organization, 1994)

⁹ Article 23 of WTO-TRIPS contains additional protections for GIs relating to wines and spirits, and Article 24 contains certain exceptions to protections for GIs (e.g. where the term has become customary as common usage, or where a trademark registration had been acquired in good faith before the country in question joined the WTO).

	<p><u>NOTE:</u> The Malaysian definition is taken from the old UK law, which contained a similar definition. Singapore and Hong Kong law also used to contain this definition, but they have since updated their trademark legislation which now uses the word “sign”, as does the UK law.</p>		
Service Mark	<p>USA: “The term “service mark” means any word, name, symbol, or device, or any combination thereof—</p> <ul style="list-style-type: none"> (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.” 	<p>Generally, a service mark is the same as a trademark, except that it identifies and distinguishes the source of a service rather than goods.</p>	
Standard Character Mark	<p>USA: Marks comprising words, letters, numbers, or any combination thereof without claim to any particular font style, size, or color cannot include a design element.</p> <p>USPTO Trademark Basics: “The standard character format means you are able to type your mark into the designated field on the electronic filing form by using characters found within the standard character set ... This is used to register word(s), letter(s), number(s) or any combination thereof, without claim to</p>		

	<p>any particular font style, size, or color, and absent any design element. Registration of a mark in the standard character format will provide broad rights, namely use in any manner of presentation ... the rights associated with a mark in standard characters reside in the wording (or other literal element, e.g., letters, numerals, punctuation) and not in any particular display. Therefore, registration of a standard character mark would entitle you to use and protect the mark in any font style, size, or color. It is for this reason that a standard character mark can be an attractive option for many companies.”</p>		
<p>Stylized Mark</p>	<p>USA: No clear distinction, for definitional purposes¹⁰ at least, between a mark comprising stylized text only and a mark comprising stylized text with a design element – e.g. in the USPTO’s Trademark Basics brochure when contrasting the application method for these with that for a standard character mark:</p> <p>“The stylized/design format, on the other hand, is appropriate if you wish to register word(s) by themselves or combined to form a phrase of any length and/or letter(s) having a particular stylized appearance, a mark consisting of a design element, or a combination of stylized wording and a design. Once filed, any design element will be assigned a “design code” [per the Design Code Search Manual].”</p>		

¹⁰ But see below for visual depictions of what the USPTO considers a “stylized” mark as compared to a “design” mark.

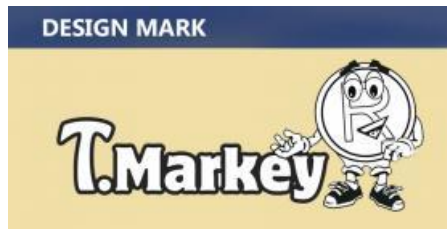
<p>Trademark</p>	<p>EU: “A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings” (Article 2, Directive 2008/95/EC – NOTE THE CHANGE in the new Amending Regulation that comes into force in October 2017: <i>“A sign should be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective” (i.e. there will no longer be a requirement of graphical representation – as stated in <u>Article 4</u> which provides that the sign must be capable of being registered “in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.”</i></p> <p>UK: A trademark means “any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”</p> <p>USA: “The term “trademark” includes any word, name, symbol, or device, or any combination thereof— (1) used by a person, or</p>		
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	(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”		
Word Mark	<p>EU: “A word mark is represented using words, letters, numbers or any other characters that can be typed.”</p> <p>USA: Seems to be commonly used to describe the “standard character” mark, especially in contrast with a “design”, “stylized” or “composite” (i.e. word plus design element) mark</p>		

Examples of Figurative Marks with Letters from the EUIPO:



Examples of Stylized and Design Marks from the USPTO:



Differences between GIs and Trademarks

From WIPO's Publication on Geographical Indications: An Introduction

(http://www.wipo.int/edocs/pubdocs/en/geographical/952/wipo_pub_952.pdf):

“Geographical indications and trademarks are distinctive signs used to distinguish goods or services in the marketplace. Both convey information about the origin of a good or service, and enable consumers to associate a particular quality with a good or service. Trademarks inform consumers about the source of a good or service. They identify a good or service as originating from a particular company. Trademarks help consumers associate a good or service with a specific quality or reputation, based on information about the company responsible for producing or offering it. Geographical indications identify a good as originating from a particular place. Based on its place of origin, consumers may associate a good with a particular quality, characteristic or reputation.

A trademark often consists of a fanciful or arbitrary sign that may be used by its owner or another person authorized to do so. A trademark can be assigned or licensed to anyone, anywhere in the world, because it is linked to a specific company and not to a particular place. In contrast, the sign used to denote a GI usually corresponds to the name of the place of origin of the good, or to the name by which the good is known in that place. A GI may be used by all persons who, in the area of origin, produce the good according to specified standards. However, because of its link with the place of origin, a GI cannot be assigned or licensed to someone outside that place or not belonging to the group of authorized producers.”

Differences between GIs and Geographical Names

See the European Commission's report on GIs and TRIPS – Ten Years Later

(http://trade.ec.europa.eu/doclib/docs/2007/june/tradoc_135088.pdf):

“GIs are signs (most usually proper names) which identify a good as originating in the territory of a particular country, or a region or locality in that country, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical

origin. It is a separate type of intellectual property. From this definition it can be deduced that GIs are, first of all, signs and indications, necessarily linked to a particular territory. These are mostly geographical names (such as Parma, Manchego, Roquefort, etc.). Traditional and historical non-geographical names can nevertheless be protected if they are linked to a particular place. The most famous example of such a GI is “Feta”, which is not a place in Greece but is so closely connected to Greece as to identify a typical Greek product.

There are three major conditions for the recognition of a sign as a geographical indication:

- it must relate to a good (although in some countries services are also included, for example in Azerbaijan, Bahrain, Croatia, Jamaica, Saint Lucia, Singapore and others);
- these goods must originate from a defined area;
- the goods must have qualities, reputations or other characteristics which are clearly linked to the geographical origin of goods.

Any sign, even geographical, may not be considered as a geographical indication if it does not fulfil these three conditions.”

Differences between GIs and Appellations of Origin

From WIPO’s Publication on Geographical Indications: An Introduction

(http://www.wipo.int/edocs/pubdocs/en/geographical/952/wipo_pub_952.pdf):

“Appellations of origin are a special kind of GI. The term is used in the Paris Convention¹¹ and defined in the Lisbon Agreement. Appellations of origin and GIs both require a qualitative link between the product to which they refer and its place of origin. Both inform consumers about a product’s geographical origin and a quality or characteristic of the product linked to its place of origin.

The basic difference between the two terms is that the link with the place of origin must be stronger in the case of an appellation of origin. The quality or characteristics of a product protected as an appellation of origin must result exclusively or essentially from its geographical origin. This generally means that the raw materials should be sourced in the place of origin and that the processing of the product should also happen there. In the case of GIs, a single criterion attributable to geographical origin is sufficient, be it a quality or other characteristic of the product, or only its reputation. Moreover, the production of the raw materials and the development or processing of a GI product do not necessarily take place entirely in the defined geographical area.

¹¹ Article 1(2) of the Paris Convention recognizes “indications of source” and “appellations of origin” as subject matter for industrial property. However, it did not contain specific definitions for either of these terms. In cases of false indications of source, the Paris Convention allows for seizure of the goods upon importation and remedies provided by the country of importation. Member States are also obliged to ensure appropriate legal remedies for repressing the use of false indications of source as well as effective protection against unfair competition. Protections against false indications of source were subsequently extended to “deceptive” indications by the Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods.

The term appellation of origin is often used in laws that establish a specific right and system of protection for GIs, in so-called sui generis systems of protection (see the chapter on how to obtain protection for GIs). Geographical indication is a more general concept that does not determine a specific mode of protection.”

Legal Protections for Geographical Indications¹²:

Generally, GIs are currently protected in the following ways:

- (1) “Sui Generis” protections – i.e. where a specific right is created for GIs separately from trademark or other intellectual property right (e.g. EU, India, Switzerland)
- (2) Through collective or certification marks – i.e. as a type of trademark (e.g. Australia, Canada, China, USA)
- (3) Indirect protections under other areas of law - e.g. unfair competition, labeling, consumer protection laws

¹² The European Commission published a report surveying the state of legal protection for GIs in 160 countries worldwide (as of 2007): http://trade.ec.europa.eu/doclib/docs/2007/june/tradoc_135088.pdf.