

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Examining for genericness at the USPTO

Standing Committee on Trademarks, Geographical
Indications, and Industrial Designs (SCT42)

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Burden of proof

- **In examination:**
 - Standard for examining attorney to prove that a term is generic is “clear evidence.”
 - Clear evidence of generic use means not simply possible infringing uses.
- **In the inter partes opposition and cancellation context:**
 - The USPTO’s reviewing court, the Court of Appeals for the Federal Circuit, has applied the preponderance of the evidence standard for genericness.

Generic inquiry

- A two-part inquiry is used to determine **whether a designation is generic**:
 - 1) What is the category of goods or services at issue?
 - 2) Does the relevant public understand the designation primarily to refer to that category of goods or services?

Category (genus) of the goods

- Any term that the relevant public uses or understands to refer to the category of the goods, or to a key aspect or subcategory of the category, is generic.
- The genus is often defined by an applicant's identification of goods and/or services.
- Generic examples:
 - MALAI (a word for cream) for goods including ice cream
 - CHURRASCOS (a type of grilled meat) for restaurant services featuring grilled meat
 - FOOTLONG (for 12 inch sandwiches) for sandwiches

Relevant consumer of the goods

- Purchasing or consuming public of the goods.
 - For example, TOUCHLESS for car washing services:
 - Even though vendors, operators and manufacturers (traders) all say term is generic, the relevant consumer is car owners/operators

Primary significance

- The public's perception is the primary consideration in determining whether a term is generic.
 - Not evaluating purchaser motivation
- To evaluate what consumer perception is, we look at a variety of evidence:
 - 1) Direct and indirect evidence of consumer understanding;
 - 2) marketplace use;
 - 3) regulatory treatment; and
 - 4) control by the owner over the term.

Collecting evidence

Dictionary definitions

Do the entries identify a single geographic origin for the goods?

Internet evidence

How is the term used in news stories or in recipes?
Is it used as the name of product or ingredient?

Categories in catalogs

Is the term used to identify a category of goods, not a set of goods from a single geographic source?

Sections of grocery stores

How do retailers use the term?

Prior Registrations

Is the term disclaimed in prior applications or registrations?

Evidence that the product comes from multiple places

Are the goods available to consumers from multiple places, not just from a single origin?

Foreign origin evidence

- Evidence of registration in other countries is not legally or factually relevant to potential consumer perception of a term in the United States.
- However, information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark.
- The probative value, if any, of foreign information sources must be evaluated on a case-by-case basis.

Translations

- Under the U.S., “doctrine of foreign equivalents,” non-English words from common, modern languages are translated into English to determine their significance.
- The doctrine normally applies only when it is likely that the ordinary American purchaser would stop and translate the word into its English equivalent.
- An examining attorney will generally apply the doctrine when the relevant English translation is literal and direct, the term comes from a common, modern language, and there is no evidence of another relevant meaning

Marketplace use

- **What does the consumer see in the marketplace?**
 - How does the applicant use the proposed matter on the goods or in advertising materials/product brochures?
 - Is the matter used by competitors, and if so how are competitors using the proposed matter?
 - Is there evidence of imports using the proposed term and production outside of the territory identified in the application?

Regulatory treatment

- When food regulations restrict the use of a generic term to only those products conforming with the prescribed standards, it encourages producers of products meeting those standards outside of the region of origin to adopt it in their labelling.
- Widespread generic use by competitors will influence public perception.
- Standards of identity:
 - U.S. Food and Drug Administration (FDA) food standards of identity
 - U.S. Department of Agriculture (USDA) also establishes standards for marketing processed meat products under specific common names.
 - Codex Alimentarius standards

Regulatory treatment

- How is the term treated in the country of origin?
 - For example, 1996 EU Regulation (Commission Regulation (EC) No. 1107/96 of 12 June 1996) specifically indicates which portion of compound GIs are not protected:
 - Protection of the name “Camembert” is not sought.
 - Protection of the name “Emmental” is not sought.
 - Protection of the name “Brie” is not sought.
 - Protection of the name “Pecorino” is not sought.
 - Protection of the name “Provolone” is not sought.
 - Protection of the name “Mozzarella” is not sought.
 - Protection of the name “Edammer” is not sought.
 - Protection of the name “Gouda” is not sought.
 - Protection of the name “Cheddar” is not sought.

Compound terms & the role of disclaimers

- In a compound term GI, terms that are generic should be identified in the registration through a disclaimer to avoid negatively affecting legitimate trade.
- A disclaimer is a statement that the applicant or registrant does not claim the exclusive right to use a specified element or elements of the mark in a trademark or GI application or registration.
 - For example: GOUDA HOLLAND
 - Disclaimer statement on the registration certificate: “No claim is made to the exclusive right to use “gouda” apart from the GI (or mark) as shown.”

Control by the owner

- The mere presence on the market of non-originating products does not automatically mean that the term at issue is generic.
- However, it likely means that the purported GI owner is not adequately controlling the designation in the territory for purposes of ensuring that the term remains distinctive.
- Once that lack of control results in the relevant consumer finding that the primary significance of the sign is to describe a category of product that can come from anywhere, then the mark is considered abandoned due to genericide.

Darjeeling

Tea Board of India v. The Republic of Tea, 80 U.S.P.Q.2d 1881 (T.T.A.B. 2006)

Opposer:

Tea Board of India



No disclaimer

Claim: Likelihood of confusion

Applicant:

Republic of Tea

**DARJEELING
NOUVEAU**

Disclaimer of "DARJEELING"
For Darjeeling tea blend
from India

Counterclaim: Generic



Darjeeling

- Applicant, Republic of Tea, did not meet the burden of proof on the counterclaim of genericness.
- The counterclaim was that the term “Darjeeling” was generic because the Tea Board failed to police its mark, leading to unlicensed third party uses.
- Argument & Evidence Presented by Applicant on counterclaim:
 - Dictionary evidence
 - Survey evidence
 - Market evidence of “blends”
 - Tea Board licensing program started in 1987, 50 years later than use commenced in the U.S.
- Holding: Even if misuse occurs, the misuse must be of such significance to permit an inference that the mark is generic.

