

No. 23-1100

In the United States Court of Appeals  
for the Federal Circuit

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BUREAU NATIONAL INTERPROFESSIONNEL DU COGNAC AND  
INSTITUT NATIONAL DES APPELLATIONS D'ORIGINE,  
*Appellant,*

v.

COLOGNE & COGNAC ENTERTAINMENT,  
*Appellee.*

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Brief of Amici Curiae Scotch Whisky Association; Colombian Coffee Growers Federation; Confederation Générale Des Producteurs De Lait De Brebis Et Des Industriels De Roquefort; Consejo Regulador del Tequila, A.C.; Consorzio del Prosciutto di Parma; Distilled Spirits Council of the United States, Inc.; Federation of the Swiss Watch Industry FH; Irish Whiskey Association; Kentucky Distillers' Association; Napa Valley Vintners; and Organization for an International Geographical Indications Network in Support of Appellant and Reversal

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Appeal from the United States Patent and Trademark Office,  
Trademark Trial and Appeal Board, No. 91250532

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF INTEREST**

**Case Number** 23-1100

**Short Case Caption** Bureau National Interprofessionnel du Cognac v. Cologne & Cognac Entertainment

**Filing Party/Entity** See page 2 and attached page for list of all amici

**Instructions:**

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I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 05/19/2023

Signature: /s/ M. Patrick Yingling

Name: M. Patrick Yingling

FORM 9. Certificate of Interest

Form 9 (p. 2)  
March 2023

<b>1. Represented Entities.</b> Fed. Cir. R. 47.4(a)(1).	<b>2. Real Party in Interest.</b> Fed. Cir. R. 47.4(a)(2).	<b>3. Parent Corporations and Stockholders.</b> Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.  <input type="checkbox"/> None/Not Applicable	Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.  <input type="checkbox"/> None/Not Applicable
Scotch Whisky Association	None	None
Colombian Coffee Growers Federation	None	None
Confederation Générale Des Producteurs De Lait De Brebis Et Des Industriels De Roquefort	None	None
Consejo Regulador del Tequila, A.C.	None	None
Consorzio del Prosciutto di Parma	None	None
Distilled Spirits Council of the United States, Inc.	None	None
Federation of the Swiss Watch Industry FH	None	None
Irish Whiskey Association	None	Ibec CLG
Kentucky Distillers' Association	None	None
Napa Valley Vintners	None	None
Organization for an International Geographical Indications Network	None	None

 Additional pages attached

**4. Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable  Additional pages attached

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**5. Related Cases.** Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

Yes (file separate notice; see below)  No  N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

**6. Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable  Additional pages attached


**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF INTEREST**

Additional Page

List of all *Amici*

Scotch Whisky Association

Colombian Coffee Growers Federation

Confederation Générale Des Producteurs De Lait De Brebis Et Des Industriels De Roquefort

Consejo Regulador del Tequila, A.C.

Consorzio del Prosciutto di Parma

Distilled Spirits Council of the United States, Inc.

Federation of the Swiss Watch Industry FH

Irish Whiskey Association

Kentucky Distillers' Association

Napa Valley Vintners

Organization for an International Geographical Indications Network

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## INTEREST OF *AMICI CURIAE*<sup>1</sup>

The **Scotch Whisky Association** of Edinburgh, Scotland (“SWA”) is the trade association for the Scotch Whisky industry, and works to safeguard the Scotch Whisky trade on a worldwide basis. The SWA’s membership is comprised of over 90 members that include distillers, blenders, and brand owners of Scotch Whisky. These members produce approximately 95% of the Scotch Whisky sold worldwide, including in the United States, and include such internationally well-known brands as *The Macallan*, *Johnnie Walker*, *White Horse*, *Dewar’s*, *Ballantine’s*, *Chivas Regal*, *Famous Grouse*, *The Glenlivet*, *Glenfiddich*, and *Glendronach*.

Scotch Whisky enjoys substantial prestige and is considered a quality product throughout the world. To protect the identity of Scotch Whisky as a geographic indication of origin, and to prevent consumer confusion resulting from false and misleading labelling, the SWA diligently works to protect the Scotch Whisky category in the United States and around the world. This includes preventing the sale of products that are geographically deceptive or misdescriptive, and monitoring trademark

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<sup>1</sup> All parties have consented to the filing of this brief. No party’s counsel authored this brief in whole or in part; no party or party’s counsel contributed money that was intended to fund preparing or submitting the brief; and no person—other than the *amici curiae*, their members, or their counsel—contributed money that was intended to fund preparing or submitting the brief. *See* Fed. R. App. P. 29(a)(4)(E).

applications that contain words that are indicative of Scotland and Scotch Whisky. The Trademark Trial and Appeal Board Inquiry System reflects the SWA's diligent enforcement efforts to date.

The laws of both the United Kingdom and the United States recognize and protect "Scotch Whisky" as a geographic indication of origin. Scotch Whisky has been defined by statute in the United Kingdom since 1933. By definition, under current law, Scotch Whisky is whisky that has been wholly produced in Scotland in accordance with United Kingdom legislation, namely the Scotch Whisky Regulations 2009 and The Product Specification for Scotch Whisky (formerly known as the Technical File). *See* The Scotch Whisky Regulations 2009, SI 2009/2890, art. 3 et seq. (Scot.) (United Kingdom legislation defining Scotch Whisky as "a whisky produced in Scotland that has been distilled at a distillery in Scotland..."); *and* 27 C.F.R. § 5.143(c)(16) (United States Department of Treasury regulations defining Scotch Whisky as "whisky which is a distinctive product of Scotland, manufactured in Scotland in compliance with the laws of the United Kingdom regulating the manufacture of Scotch whisky for consumption in the United Kingdom").

United States regulations governing geographical designations afforded to spirits, such as Scotch Whisky, also prohibit the use of certain words that could result in consumer confusion if used to identify a whisky not produced in Scotland. Specifically, 27 C.F.R. § 5.90 expressly provides

that “[t]he words ‘Scotch,’ ‘Scots,’ ‘Highland,’ or ‘Highlands,’ and similar words connoting, indicating, or commonly associated with Scotland, may be used to designate only distilled spirits wholly manufactured in Scotland.”

The SWA also owns all rights, title, and interest in and to the United States Certification Mark for SCOTCH WHISKY, Registration No. 6,763,223, for “whisky produced in Scotland according to specific standards” (the “SWA Certification Mark”). The SWA Certification Mark “as used or intended to be used by persons authorized by the certifier, certifies or is intended to certify that the goods/services provided originate in Scotland and have met the Standards as set forth in The Scotch Whisky Regulations 2009 and The Scotch Whisky technical file.” *See* Reg. No. 6,763,223. Based on the SWA’s extensive experience representing and advocating on behalf of the Scotch Whisky trade in the United States and around the world, the SWA respectfully submits this brief to provide the Court with additional perspective on the issues presented in this appeal.

The **Colombian Coffee Growers Federation** (“FNC”) is a Colombian non-profit organization that represents over 540,000 Colombian coffee growers whose average plantation size does not exceed 1.5 hectares. FNC represents its members by certifying and promoting Colombian coffees around the world, and protecting its trademarks which embody the

goodwill of Colombian Coffee, with the objectives of promoting economic equality and social development for the coffee growers.

Since July 7, 1981, the certification mark “Colombian” has been included in the Principal Register of the United States Patent and Trademark Office. The certification standards and conditions for Colombian Coffee (Certified Product), are set forth: 1. Name: Colombian 2. Description: Certified product is the 100% arabica coffee grown in the Colombian coffee growing area which satisfies the export standards laid down from time to time by the national committee of coffee growers and when processed has the following characteristics: mild, clean cup of medium/high acidity and body and full and pronounced aroma.

FNC has been appointed by the Colombian Government to act as the entity responsible to promote, offer, and perform the quality control of Colombian Coffee, among other activities related thereto. Hence, FNC acting as administer of the Colombian Coffee Fund, a parafiscal account that is reconciled by the contributions of the Colombian coffee growers, through an administration agreement signed with the Colombian Government, has been actively promoting, offering and protecting the characteristics, quality and reputation of the Colombian Coffee associated to its origin and leveraging the intellectual property rights available, such as the Protected Designation of Origin and Protected Geographical

Indication systems adopted by the Andean countries (Bolivia, Colombia, Ecuador, Peru) and the European Union.

**Confederation Générale Des Producteurs De Lait De Brebis Et Des Industriels De Roquefort** (“Confederation”) is a French Association and the owner of the ROQUEFORT certification mark (including both the word ROQUEFORT and stylized format) (Reg. No. 0571798), and oversees the certification of cheese. The Confederation is also the owner of the ROQUEFORT collective mark (Reg No. 4680603), which indicates that cheese products are made by a member of the collective and that the Confederation controls the use of the mark by members by published regulations of the European Union on protected designations of origin.

ROQUEFORT certified cheese is a type of blue cheese made of sheep’s milk from a specific breed of sheep, and aged in specific caves, for a specific amount of time, in a specific region in southern France. In order to be certified as ROQUEFORT, and thus permitted to bear the ROQUEFORT certification mark, the cheese must meet specific criteria. Manufacturers of blue cheese that is not certified nor made by a member of the collective may refer to their product generically as “blue cheese,” but not as ROQUEFORT certified blue cheese.

The Confederation owns valuable goodwill in the ROQUEFORT Marks. In 2018–2019, nearly 1.5 million pounds of ROQUEFORT certified

cheese were exported to the U.S. alone. In 1943, the U.S. District Court for the Eastern District of Wisconsin recognized the Confederation's mark as being famous. *See Iowa State College Research Foundation v. Tolibia Cheese Corp.*, 48 F. Supp. 413, 413 (E.D. Wis. 1943) ("The most famous of blue-veined cheeses comes from Roquefort, France, and is made from sheep's milk, and is cured in caves."). In fact, the USPTO's Trademark Manual of Examining Procedure refers to both the ROQUEFORT certification mark and the ROQUEFORT collective mark as examples of their respective types of marks. *See* T.M.E.P. 1306.05(j).

**Consejo Regulador del Tequila, A.C. ("CRT")**, a non-profit civil association of Mexico, is responsible for ensuring that products commercialized as Tequila in Mexico, the United States, and numerous countries throughout the world, are in compliance with Mexican laws and standards. CRT is the only body accredited and approved under Mexican law to monitor and certify compliance with the Official Mexican Tequila Standard (NOM-006-SCFI -2012 –Alcoholic Beverages-Tequila-Specifications). Since 1973, the U.S. Department of Treasury, has recognized Tequila as a distinctive product of Mexico. Alcohol and Tobacco Tax and Trade Bureau regulations define "Tequila" as "a distinctive product of Mexico manufactured in Mexico in compliance with the laws of Mexico regulating the manufacture of Tequila for consumption in that country." 27 C.F.R. § 5.22. Further, CRT owns a federal registration for the

certification mark TEQUILA (Registration No. 5225126), which covers “distilled spirits, namely, spirits distilled from the *blue tequilana weber* variety of agave plant.” CRT works diligently to prevent the misuse of its famous and valuable certification mark, including, numerous proceedings before the Trademark Trial and Appeal Board to prevent unauthorized use or registration of the mark TEQUILA and similar marks.

The **Consorzio del Prosciutto di Parma** (“Consorzio”) is a non-profit association, established in 1963 to protect and promote Parma Ham around the world and offer consumers guarantees on the quality of the product. Since then it has been involved in numerous activities, including the supervision of the production, processing and sale of Parma Ham, the protection of the designation of origin and the registered trademarks “Prosciutto di Parma”, “Parma Ham” and the Ducal Crown design, currently registered in about 90 countries, including the US. The Consorzio now consists of 134 companies, all of them located in the Parma region of Italy.

The **Distilled Spirits Council of the United States, Inc.** (“DISCUS”) is a national trade association representing producers, importers, and marketers of distilled spirits products sold in the United States. DISCUS serves as the leading voice for U.S. spirits suppliers on legislative, regulatory and policy issues on a federal, state and international basis, including through the protection of Bourbon Whiskey in intellectual



property matters in the United States and around the world. DISCUS represents 19 Director Members and over 200 Craft Distillers who produce a substantial portion of all spirits sold in the United States, including internationally protected products, such as Cognac, Scotch Whisky, Bourbon Whiskey, Tennessee Whiskey, Mezcal, and Tequila.

The **Federation of the Swiss Watch Industry FH** (“FH”) is the non-profit trade association for the Swiss watch industry. The FH has around 460 members, representing more than 90% of Swiss firms active in the production and sale of watches, clocks and components. The objectives of the FH are, amongst others, to protect and develop the Swiss watch industry, to uphold its members’ interests generally and in a legal context, and to represent the sector as a whole, both in Switzerland and abroad.

To protect the identity of Swiss as a geographic indication of origin, and to prevent consumer confusion resulting from false and misleading labelling, the FH actively works worldwide and in the United States. The FH notably acts to prevent the sale of products that are geographically deceptive, monitors all the trademarks applications worldwide covering class 14 goods (watches) and takes action against those that contain a Swiss indication when there are risks that they will be used on products not originating from Switzerland. The FH owns all rights, title and interest in and to the United States Certification Mark for SWISS, Registration No. 3047277, and United States Certification Mark for SWISS MADE,

Registration No. 3038819, for “horological and chronometric instruments, namely, watches, clocks and their component parts and fittings thereof.” The FH Certification Marks “as used by persons authorized by the certifier, certifies geographical origin of the goods in Switzerland.”

Based on the FH’s extensive experience representing and advocating on behalf of the Swiss watch industry in the United States and around the world, the FH respectfully submits this brief to provide the Court with additional perspective on the issues presented in this appeal.

The **Irish Whiskey Association** (“IWA”) was established in 2014 as an all-island trade association to protect consumers, Irish Whiskey producers, and the Irish Whiskey category as a whole from unfair competition. Today, the IWA has 48 members and represents 98% of Irish whiskey production worldwide, including in the United States, and includes such internationally well-known brands as *Bushmills, Jameson, Powers, Midleton, and Paddy*.

The laws of both the United States and Ireland recognize and protect “Irish Whiskey” as a geographic indication of origin. United States regulations define “Irish Whiskey” as “a distinctive product of Ireland, manufactured either in the Republic of Ireland or in Northern Ireland, in compliance with their laws regulating the manufacture of Irish whisky for home consumption.” 27 C.F.R. 5.143(c)(17). Accordingly, Irish Whiskey

must be wholly produced in Ireland in accordance with the specific regulations set forth in the Irish Whiskey Act of 1980, the Irish Whiskey Product Specification, and Regulation (EC) No. 110/2008 of the European Parliament and of the Council.

As part of its protection work, the IWA safeguards the Irish Whiskey trade by monitoring trademark applications and labels around the globe for products that in their labelling and branding suggest to consumers that the product being sold is or contains Irish Whiskey when that is not the case. In so doing, the IWA works to protect and maintain the status of Irish Whiskey as a defined, regulated, and quality product throughout the world.

Founded in 1880, the **Kentucky Distillers' Association** ("KDA") is the representative for Kentucky's signature Bourbon and distilled spirits industry and is the worldwide voice for Bourbon, a uniquely American distilled spirit. The KDA's diverse and growing membership produces the overwhelming majority of the world's Bourbon, from historic, global brands to emerging micro distilleries. Members rely on the KDA for numerous services including international trade development, economic development support, legal defense, governmental and regulatory advocacy, and innovative tourism experiences through the KDA's world-famous Kentucky Bourbon Trail® and Kentucky Bourbon Trail Craft Tour® experiences. As a 501(c)(6) nonprofit organization, the KDA

maintains an open membership policy, champions a strong commitment to the responsible consumption of spirits, and protects and advocates on behalf of the Bourbon industry in the United States and around the world.

The KDA supports its international distilled spirits partners in utilizing intellectual property laws to protect the geographic distinctiveness of the distilled spirits products they produce, as such protections are a necessity for everyone in the broader industry as we navigate consumer markets across international borders. As one of the longest standing trade associations in the United States, the KDA fully supports our trade association partner's efforts to protect the product integrity of each of our respective signature spirits and to take necessary action to prevent third parties from creating deceptive associations with the hard-earned unique characteristics, quality, and reputation of products derived from a specific geographic location.

**Napa Valley Vintners** ("NVV") is a California, non-profit trade association founded in 1944 composed of over five hundred winery members from California's Napa Valley. Napa Valley has been recognized as America's most prestigious and most famous wine-growing region by consumers, the media and wine critics. The principal mission of NVV is the promotion and protection of the Napa Valley appellation. In this regard, NVV ensures that the Napa Valley appellation is truthfully and properly used in association with wine pursuant to U.S. laws recognizing the

appellation. NVV is the owner of U.S. Certification Mark Registration No. 4,853,438 for NAPA VALLEY for “wine.” NVV diligently enforces the NAPA VALLEY certification mark both in the U.S. and abroad, including at the U.S. Patent and Trademark Office and before the Trademark Trial and Appeal Board.

The **Organization for an International Geographical Indications Network** (“oriGIn”) is a non-for-profit non-governmental organization based in Geneva ([www.origin-gi.com](http://www.origin-gi.com)). It represents a global alliance of Geographical Indications groups and institutions from a large variety of sectors, representing some 600 associations and institutions from 40 countries. oriGIn campaigns for robust protection of Geographical Indications in national laws and international treaties. Likewise, it supports its members in securing registration of their geographical names, as well as ensuring their enforcement, in national and foreign jurisdictions (both in countries providing independent systems of protection for geographical indications, and in those relying on trademarks, including certification marks). oriGIn has an interest in ensuring that law concerning the protection of geographical names remains consistent and protects geographical names against the growing attempts to exploit and dilute their reputation.

## SUMMARY OF ARGUMENT

Unlike a trademark, which indicates an individual source of sponsorship, certification marks are used to certify an origin, material, mode of manufacture, quality, accuracy, or other characteristic of the goods or services certified. A *geographic* certification mark—as COGNAC or SCOTCH WHISKY—is a word, name, symbol, or device used to certify that the goods or services originate in the geographical region identified by the term. As with all other types of certification marks, the owner of a geographic certification mark does not use the mark on goods or services. Instead, the owner of a geographic certification mark controls use of the mark by other parties.

Under the Lanham Act, owners of geographic certification marks may assert their rights where other marks present a likelihood of confusion or dilution. A geographic certification mark's strength and fame is measured both by its market strength and its distinctiveness. The Lanham Act recognizes geographic certification marks as inherently distinctive, and the strength or fame of a geographic certification mark does not depend on consumers' awareness of the mark's certification status.

In this case, Opposers own the COGNAC certification mark and assert that Applicant's mark presents a likelihood of confusion and dilution. In addressing the likelihood-of-confusion claim, the Board

majority concluded that the COGNAC mark is not famous. That conclusion was critical to the majority's holding that Opposers did not demonstrate likelihood of confusion. It was also critical to the majority's holding that Opposers did not demonstrate dilution.<sup>2</sup> As discussed herein, the majority's analysis on the fame of the COGNAC mark—which infected its decision on both the likelihood-of-confusion and dilution claims—was flawed in multiple respects. Although *amici* agree with each of the points raised in Opposers' opening brief, *amici* focus on the majority's fame analysis because of the relevance and importance of the fame factor for other certification marks.

*First*, as the dissent recognized, the Board majority accepted Applicant's erroneous contention—*i.e.*, where a product is labeled with a famous trademark (such as the name of a brandy manufacturer) *and* a certification mark (such as COGNAC), the fact that the trademark is famous precludes finding fame in the certification mark. Fame, however, is not a zero-sum game for trademarks and certification marks on the same label. Brandy producers are not required to use the COGNAC certification mark. They are free to use their trademark only or a generic term such as

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<sup>2</sup> The Board majority stated, "As discussed in the context of our likelihood of confusion analysis, Opposers did not demonstrate by a preponderance of the evidence that its COGNAC certification mark is famous for likelihood of confusion, let alone for dilution purposes, which is a more difficult standard to meet." Appellants' Appendix ("Appx") at 35.

“brandy.” If anything, the pervasiveness of the COGNAC certification mark on various famous brands indicates that the certification mark is driving the demand for those products equally, if not more, than the brand name standing alone.

*Second*, the Board majority concluded that COGNAC is not a famous certification mark because, on a label, the COGNAC mark often exists in a less prominent position when compared to the trademark. This fact, however, is merely reflective of the inherent nature of geographic certification marks in contrast to trademarks and other certification marks. Because geographic certification marks certify regional origin, and thus often consist primarily of a geographic term, they may appear in an inconspicuous fashion on a product and they may not look the same as other types of certification marks, which typically include wording, such as “certified,” or design elements, such as seals or similar matter. For example, in addition to COGNAC, other strong geographic certification marks often appear in non-prominent fashion on labels, including FLORIDA SUNSHINE TREE & Design for Florida Orange Juice and the DARJEELING mark for tea. Such use does not impact whether a certification mark is or is not famous.

*Third*, the Board majority assessed the strength and fame of COGNAC as a certification mark based on the extent of consumer awareness regarding COGNAC’s “certification status.” But owners of



certification marks have never been required to show that consumers are aware of the mark's status as a certification mark, and for good reason. The strength and fame of the mark comes from the fact that consumers understand that goods bearing the mark come from the region named in the mark. Neither the statute nor the case law requires that purchasers also be expressly aware of the term's certification function.

For these reasons, as further discussed below, this Court should reverse.

## ARGUMENT

### **I. Geographic certification marks are used by persons other than the mark's owner to certify a product's regional origin.**

The Lanham Act provides for the registration of "certification marks, including indications of regional origin." 15 U.S.C. § 1054. The term "certification mark" means any word, name, symbol, or device, or any combination thereof—

(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 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.

15 U.S.C. § 1127.

The owner of the certification mark does not actually apply the mark to a product or service. Instead, persons other than the owner apply the mark to their goods or services, with authorization from the owner. The owner takes steps to ensure that users apply the mark only to goods or services that contain the characteristics or meet the requirements that the owner has established or adopted for the certification. *See* Trademark Manual of Examining Procedure ("TMEP") § 1306.1(a).<sup>3</sup>

A *geographic* certification mark is a word, name, symbol, device, or some combination of these elements used to certify that the goods or services originate in the geographical region identified by the term or, in some circumstances, from a broader region that includes the region identified by the term. *See* 15 U.S.C. § 1127. A geographic certification mark may feature a recognized geographic term that identifies the relevant geographic region, as in the marks ROQUEFORT for cheese, DARJEELING

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<sup>3</sup> <https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1300d1e585.html>.

for tea, COLOMBIAN for coffee, and SCOTCH WHISKY for whisky made in Scotland according to certain standards—or, as relevant here, COGNAC for wine spirit distilled in the Cognac region of France and entitled to be designated as “Cognac” by the laws and regulations of the French government. *See* TMEP § 1306.05(a); 27 C.F.R. § 5.30(b) (defining Cognac); 27 C.F.R. § 5.143(c)(16) (defining Scotch Whisky); *Cmty. of Roquefort v. William Faehndrich, Inc.*, 198 F. Supp. 291, 292 (S.D.N.Y. 1961); *Institut Nat’l Des Appellations d’Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1896 (TTAB 1998); Justin Hughes, *Champagne, Feta, and Bourbon: The Spirited Debate About Geographical Indications*, 58 Hastings L.J. 299, 305-06 (2006). Because geographic certification marks certify regional origin, and thus often consist primarily of a geographic term, they may appear in an inconspicuous fashion and they may not look the same as other types of certification marks, which typically include wording, such as “certified,” or design elements, such as seals or similar matter. *See* TMEP § 1306.05(b)(iii).

When a geographical term is used as a certification mark (whether the mark is registered or not), two elements are of basic concern: first, preserving the freedom of all persons in the region to use the term and; second, preventing abuses or illegal uses of the mark that would be detrimental to all those entitled to use the mark. *See* TMEP § 1306.05(b)(ii). Unauthorized use can occur even when a geographic certification mark is not registered. “A federal registration is merely the recognition of a

common law right in a mark that existed prior to registration.”

*Stabilisierungrundsatz für Wein v. immermann-Graeff KG*, 199 USPQ 488, 490 (TTAB 1978). Accordingly, relevant persons and entities may rely on common law rights in *unregistered* geographic certification marks. *See, e.g., Florida v. Real Juices, Inc.*, 330 F. Supp. 428, 431 (M.D. Fla. 1971) (holding that the Lanham Act “is sufficiently broad to encompass protection of unregistered common law certification marks”); *Institut Nat’l Des Appellations d’Origine*, 47 USPQ2d at 1885 (“[W]e find that COGNAC is not a generic term, but rather a valid common law regional certification mark.”); Hughes, *supra*, *Champagne, Feta, and Bourbon: The Spirited Debate About Geographic Indications*, 58 Hastings L.J. at 310 (“Like other trademarks, certification marks can develop as a matter of common law without USPTO registration.”).

## **II. Owners of geographic certification marks may assert their rights where other applied-for marks present a likelihood of confusion.**

As relevant here—given the Board majority’s focus on Opposers’ likelihood-of-confusion claim—(A) the likelihood-of-confusion test for geographic certification marks is the same as that for trademarks; (B) the fame of an inherently distinctive geographic certification mark plays a key role in the likelihood-of-confusion analysis; and (C) rights to a geographic certification mark do not depend on consumers’ awareness of the mark’s certification status.

**A. The likelihood-of-confusion test for geographic certification marks is the same as that for trademarks.**

For any likelihood-of-confusion analysis under Section 2(d) of the Lanham Act, the *du Pont* factors initially established for trademarks must be considered. These factors include, among other things, “[t]he similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression”; “[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use”; and “[t]he fame of the prior mark (sales, advertising, length of use).” *In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62 (C.C.P.A. 1973).

Accordingly, the test for determining likelihood of confusion with respect to geographic certification marks is the same as that applied to trademarks. “There is nothing in the language of Section 2(d) which mandates or warrants application of one level of likelihood of confusion analysis (i.e., the *du Pont* analysis) in cases where the plaintiff’s mark is a trademark or service mark, but a different and more limited likelihood of confusion analysis in cases where the plaintiff’s mark is a certification mark.” *Institut Nat’l Des Appellations d’Origine*, 47 USPQ2d at 1889-90; see also *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2049 (TTAB 2012); *Motion Picture Ass’n of Am. v. Respect Sportswear, Inc.*, 83 USPQ2d 1555, 1559 (TTAB 2007); *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1897 (TTAB 2006);

TMEP § 1306.05(g). “[A]s in any other Section 2(d) case, the ‘likelihood of confusion’ which may bar registration of applicant’s mark, if proven, includes likelihood of confusion as to source, sponsorship, affiliation, or connection.” *Inst. Nat’l Des Appellations d’Origine*, 47 USPQ2d at 1891.

Ultimately, while the inherent characteristics of a certification mark must be accounted for, the classification as a certification mark “has very little effect on [a] determination as to whether or not there is a likelihood of confusion.” *In re Accelerate s.a.l.*, 101 USPQ2d at 2049; TMEP § 1306.05(g).

**B. The fame of an inherently distinctive geographic certification mark plays a key role in the likelihood-of-confusion analysis.**

Fame of an opposer’s mark can play a “dominant role in the process of balancing the *DuPont* factors.” *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000). “[F]amous marks thus enjoy a wide latitude of legal protection.” *Id.* “This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists.” *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002). Indeed, “[a] strong mark ... casts a long shadow” that others “must avoid.” *Kenner Parker Toys, Inc. v. Rose Art Indus.*, 963 F.2d 350, 353 (Fed. Cir. 1992).

“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).” *In re*

*Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010); *New Enchantment, LLC v. MedSpa S.R.L.*, 2023 TTAB LEXIS 132, \*62-63 (TTAB 2023) (same). “Thus, whether a particular mark is inherently distinctive may affect the scope of protection accorded in an infringement proceeding.” *In re Chippendales USA, Inc.*, 622 F.3d at 1354 (citing *Tana v. Dantanna’s*, 611 F.3d 767, 2010 WL 2773447, at \*5 (11th Cir. 2010); *Boston Duck Tours, L.P. v. Super Duck Tours, L.L.C.*, 531 F.3d 1, 16-17 (1st Cir. 2008); *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 454 F.3d 108, 115 (2d Cir. 2006)).

These principles apply to certification marks as much as to trademarks or service marks. As noted, “[t]here is no authority for treating certification marks differently from service marks or trademarks under Section 2(d), or for affording them a lesser scope of protection.” *Inst. Nat’l Des Appellations d’Origine*, 47 USPQ2d at 1889-90 (the “argument that the likelihood of confusion analysis applicable to certification marks is different from the analysis applicable to trademarks or service marks finds no support in the statute”); *see also In re Accelerate s.a.l.*, 101 USPQ2d at 2049; *Motion Picture Ass’n of Am.*, 83 USPQ2d at 1559; *Tea Bd. of India*, 80 USPQ2d at 1897; TMEP § 1306.05(g).

The Lanham Act recognizes geographic certification marks as *inherently distinctive*. Ordinarily, a term that describes the geographic source of a product is not protectable without a showing of acquired

distinctiveness. However, Section 2(e)(2) of the Act, which prohibits registration of a mark that is primarily geographically descriptive of an applicant's goods, provides a specific exception for marks used to certify indications of regional origin. *See* 15 U.S.C. § 1052(e)(2) ("indications of regional origin may be registrable under section 4 [15 U.S.C. § 1054]"). The Act thus "recognizes an exception to the requirement of acquired distinctiveness for geographically descriptive certification marks, and there is no indication of a different rule at common law." Restatement 3d of Unfair Competition, § 11, cmt b.

Accordingly, a geographic certification mark should be assessed as inherently distinctive. *See Tea Bd. of India*, 80 USPQ2d at 1899 ("We consider DARJEELING *inherently distinctive* as a certification mark indicating geographic origin as it inherently identifies the geographic source of the tea.") (emphasis added).

**C. Rights to a geographic certification mark do not depend on consumers' awareness of the mark's certification status.**

In the 1998 decision in *Institut Nat'l Des Appellations d'Origine*, the Board addressed an applicant's attempt to register the mark CANADIAN MIST AND COGNAC. *See* 47 USPQ2d 1875. INAO and BNIC opposed the application because of the likelihood of confusion with the COGNAC certification mark, among other reasons. *Id.* at 1879. According to the



Board, the “crux of the parties’ disagreement” pertained to whether the opposers’ rights to the COGNAC mark depended on the public’s awareness of COGNAC’s *certification function*. *Id.* at 1884-85. The Board rejected the applicant’s argument that the opposers were required to show that the public was aware of the certification status of the COGNAC mark:

... [T]he issue is not whether the public is expressly aware of the certification function of the mark or the certification process underlying use of the mark, but rather is whether the public understands that goods bearing the mark come only from the region named in the mark. If use of the designation in fact is controlled by the certifier and limited to products meeting the certifier’s standards of regional origin, and if purchasers understand the designation to refer only to products which are produced in the particular region, and not to products produced elsewhere, then the designation functions as a regional certification mark. Neither the statute nor the caselaw requires that purchasers also be expressly aware of the term’s certification function, per se.

*Id.* at 1885 (emphasis added). Subsequent decisions and commentary recognize this as a settled principle. See *Swiss Watch Int’l, Inc. v. Fed’n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1743 (TTAB 2012) (“The issue is not whether the public is expressly aware of the certification function of the marks or the certification process underlying use of the marks, but rather is whether the public understands that goods bearing the marks come only from the region named in the marks.”) (citing *Institut Nat’l Des Appellations*

*d'Origine*, 47 USPQ2d at 1885); TMEP § 1306.05(c) (“Consumers need not be expressly aware of the certification purpose of a designation.”).

**III. The Board majority’s decision contradicts settled and sensible principles relevant to geographic certification marks.**

As noted, *amici* agree with each of the points raised in Opposers’ opening brief. At the heart of the Board majority’s (incorrect) decision on Opposers’ claims for likelihood of confusion and dilution is the majority’s flawed analysis on the strength and fame of the COGNAC certification mark.

The Board majority began its likelihood-of-confusion analysis by discussing the fame factor and noted (correctly) that “[a] very strong mark receives a wider latitude of legal protection in the likelihood of confusion analysis” and “[f]ame, if present, plays a dominant role in a likelihood of confusion analysis because of the broad scope of protection afforded famous or strong marks.” Appx13-14.

The Board majority recognized Applicant’s primary argument against fame: A mark must be a “source identifier” to be famous, and ““Opposer[s]’ common law certification mark is, by its very nature, not a source identifier”” because it ““does not distinguish the goods or services of one company from those of another producer ....”” Appx14-15 (quoting 20 TTABVUE 24). Applicant’s argument was (and still is) wrong. To be

sure, Applicant is correct that certification marks by their very nature do not necessarily distinguish the goods or services of one producer from those of another producer; however, to declare that a certification mark is not famous or strong on this basis would mean that no certification mark could be considered famous or strong for purposes of a likelihood-of-confusion analysis. That would be contrary to law because “[t]here is no authority for treating certification marks differently from service marks or trademarks under Section 2(d), or for affording them a lesser scope of protection.” *Inst. Nat’l Des Appellations d’Origine*, 47 USPQ2d at 1889-90. Moreover, as the dissent acknowledged, “[a]lthough it is not used as a brand name, its use as a certification mark does serve to distinguish the goods of the certified users of COGNAC from those of other brandy makers, such as those whose brandies originate in Spain or Germany.” Appx39.

The Board majority recognized that Applicant was wrong to suggest that certification marks cannot be famous, but the Board majority nonetheless gave legs to Applicant’s argument and stated: “Applicant’s argument can also be construed, in essence, as asserting that products bearing both certification marks and trademarks are more likely to be recognized and called for by consumers using their trademarks, and the certification mark is less significant.” Appx16. Based on this, the majority stated, “[W]e must look closer at the evidence and how the marks are

presented to the consumer on the goods and in the advertising.” Appx18.

In concluding that the COGNAC mark is not entitled to the broad scope of protection that is due a famous mark, the majority reasoned:

- “[T]he record presented in this case reflects that Opposers’ certification mark, such as Hennessy, often use the term ‘Cognac’ or ‘cognac’ (with a lowercase ‘c’) in advertisements or on the bottles in a manner either inconspicuous or in a manner that is not likely to heighten *consumer awareness to the certification status* of the term COGNAC.” Appx18 (emphasis added).
- “Despite Cognac’s success as a spirit, it is difficult to extrapolate from the evidence when it comes to measuring the level of *consumer awareness for the goods’ certification status*.” Appx22-23 (emphasis added).

After concluding that the COGNAC certification mark was not famous, *see* Appx23, the Board majority went on to hold that the *DuPont* factors on balance showed that Opposers did not demonstrate likelihood of confusion, Appx31-32. The majority’s fame analysis on the likelihood-of-confusion claim also infected its dilution analysis: “As discussed in the context of our likelihood of confusion analysis, Opposers did not demonstrate by a preponderance of the evidence that its COGNAC certification mark is famous for likelihood of confusion, let alone for dilution purposes, which is a more difficult standard to meet.” Appx35.

There are multiple problems with the Board majority’s reasoning and analysis.

*First*, the fame of a trademark cannot count against the fame of a certification mark on the same label. No legal authorities support such a ruling. Fame is not a zero-sum game for trademarks and certification marks on the same label. If anything, the fact that a product bearing a certification mark also bears a famous trademark *supports* a finding of fame for the certification mark. Brandy producers (such as Hennessy) are not required to include the certification mark “COGNAC” on their labels. They are free to use their trademark only or a generic term such as “brandy.” The pervasiveness of the COGNAC certification mark on numerous famous brands indicates that the certification mark is driving the demand for those products. *See Tea Board of India*, 80 USPQ2d at 1900 (“[T]he record shows that there are currently at least 10 different brands of tea designated as ‘Darjeeling’ tea available on grocery store shelves, suggesting a strong market presence and demand for Darjeeling tea.”).

*Second*, the fact that a geographic certification mark may be “inconspicuous” or less prominent than a trademark on a label is not indicative of its weakness—instead, it is reflective of the inherent nature of geographic certification marks in contrast to trademarks and other certification marks. In contrast to trademarks, which require prominent placement on specimens of use, the TMEP recognizes that “[b]ecause geographic certification marks certify regional origin, and thus often consist primarily of a geographic term, they may appear in an

inconspicuous fashion on specimens and they may not look the same as other types of certification marks, which typically include wording, such as 'certified,' or design elements, such as seals or similar matter." TMEP § 1306.05(b)(iii). In addition to COGNAC, other strong geographic certification marks appear in a non-prominent fashion on labels, including the FLORIDA SUNSHINE TREE & Design (circled in red below):



See TMEP § 1305.05(j).

Another example of a strong geographic certification mark that appears in an inconspicuous fashion on labels is the DARJEELING tea mark:



See TMEP § 1305.05(j). As previously recognized by the Board in 2006, the non-prominent nature of the DARJEELING geographic certification mark on a product does not evidence the mark's lack of strength or fame. See *Tea Bd. of India*, 80 USPQ2d at 1899 (“We find that the evidence considered as a whole demonstrates that DARJEELING is a strong mark as an indicator of geographic source for tea.”).

*Third*, the Board majority improperly assessed the strength and fame of the COGNAC mark based on the extent to which consumers are aware of the mark's “certification status.” Appx18; Appx23. But owners of certification marks have never been required to show that consumers are aware of the mark's status as a certification mark under the law, and for good reason. The strength and fame of the mark stems from the fact that

consumers understand that goods bearing the mark come from the region named in the mark. As noted above, “[n]either the statute nor the caselaw requires that purchasers also be expressly aware of the term’s certification function, per se.” *Institut Nat’l Des Appellations d’Origine*, 47 USPQ2d at 1885.<sup>4</sup> “The issue is not whether the public is expressly aware of the certification function of the marks or the certification process underlying use of the marks, but rather is whether the public understands that goods bearing the marks come only from the region named in the marks.” *Swiss Watch Int’l, Inc.*, 101 USPQ2d at 1743. As such, the dissent correctly observed that “[c]onsumers need not be expressly aware of the certification purpose of the designation” and “[i]t is sufficient they would perceive COGNAC as an indication of a particular regional origin.” Appx43.

As evidenced by these errors, the Board majority effectively disregarded the principle that geographic certification marks are due no lesser protection than trademarks. The majority’s analysis unfairly prejudices owners of geographic certification marks. And because the majority relied on its no-fame conclusion from its likelihood-of-confusion

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<sup>4</sup> Despite the foundational role *Institut Nat’l Des Appellations d’Origine* holds in defining the rights pertaining to COGNAC as a famous certification mark, the Board majority only mentioned it in a footnote, stating: “Opposers have been determined to have rights in the COGNAC regional certification in previous, unrelated proceedings.” Appx8 n.11.



analysis to conclude also that Opposers did not demonstrate dilution, the majority's errors identified above also support reversal on dilution. As the dissent noted, it is "highly likely that Opposers would succeed in their dilution by blurring claim, given the fame of the mark and the degree of association with it that Applicant's mark engenders." Appx37 n.55.

### CONCLUSION

This Court should reverse the Board majority's decision.

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Respectfully submitted,

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## CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(g), I certify that this brief complies with the type-volume limitation of Federal Circuit Rules 29(b) and 32(b) because it contains 6,796 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b)(2).

This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type-style requirements of Federal Rule of Appellate Procedure 32(a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Word 2010 with 14-point Palatino Linotype font.

*/s/ M. Patrick Yingling* \_\_\_\_\_