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## ARTICLES

### NATIONALIZING TRADEMARKS: A NEW INTERNATIONAL TRADEMARK JURISPRUDENCE?

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*A new international trademark jurisprudence is currently in formation that has negative impact on international trade. Indeed, this new trademark jurisprudence includes the recent phenomenon of states monopolizing the use of generic names through the elevation of such names to trademarks of national stature and the rise of global recognition and registration of*

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*geographic indication status for generic names. Professor Nguyen identifies and analyzes the new trademark jurisprudence, and critiques its impact on international trade relations and language proprietization. Professor Nguyen proposes a certification mark regime to end the expansion of generic name protection and to promote fair competition.*

## I. INTRODUCTION

What can you call a catfish if you are not allowed to call it a catfish? Not only are you prohibited from using the name "catfish," you may face fines and imprisonment. What can you call a sardine if you are forbidden from referring to it as a "sardine"? What can you call parmesan if you are prohibited from using the name "parmesan"? "Cheese-with-sharp-flavor-often-sold-as-grated-for-your-pizza-spaghetti-lasagna"?

Recently, the United States has passed laws that provide it exclusivity in the generic name "catfish."<sup>1</sup> The European Union ("EU") has created regulations that grant it exclusive rights in the generic name "sardine."<sup>2</sup> The EU is also demanding that all members of the World Trade Organization ("WTO") stop their usage of forty-one generic names, including "chablis," "prosciutto," "romano," "mozzarella," "parmesan," "asiago," "feta," and "fontina" among others.<sup>3</sup> The EU is lobbying for a new international law that would prohibit countries from using generic names within their own borders to identify the names of products.<sup>4</sup> Under such law, no

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1. See 21 U.S.C.A. § 321d(a) (West Supp. 2004) (providing new label law for the name "catfish"); *id.* § 343(t) (West Supp. 2004) (prohibiting the misbranding of the "catfish" name); *see also infra* Part V.A.

2. See Council Regulation 2136/89 of 21 June 1989 Laying Down Common Marketing Standards for Preserved Sardines, 1989 O.J. (L 212) [hereinafter Council Regulation 2136/89]; *see also infra* Part V.B.

3. See *The Status of the World Trade Organization Negotiations on Agriculture: Hearings Before the House Comm. on Agriculture*, 108th Cong. 360 (2003) [hereinafter *Hearings*] (statement of James B. Clawson, on behalf of the Wine Inst.) (noting that many of the terms requested by the EU for global protection have become generic among world consumers); *EU to Defend Geographical Product Names*, AGRA EUROPE, July 25, 2003, at EP6, available at 2003 WL 11293169 (reporting that the EU has advanced a list of food and drink product names for which it wants geographic indication protection status); Sara Lewis & Stephen Clapp, *EU Refuses to Back Down on Geographic Indications*, FOOD CHEMICAL NEWS, Sept. 8, 2003, at 7, available at 2003 WL 69648112 (reporting that the EU wants the world to recognize "some 41 names already protected in Europe and prevent their generic use").

4. James Cox, *What's In a Name? A Big Global Food Fight, That's What*,

country would be able to use generic names to sell or market products for export.<sup>5</sup>

Welcome to the new international intellectual property right. A new international trademark jurisprudence is in formation wherein generic names are elevated to the highest level of protection, a level that has never before been provided to trademarks, even famous trademarks, wherein generic names become nationally protected names with international trade impact, and wherein generic names gain geographical indication status that commands the global community to recognize and protect that geographic identity.

This Article argues that the recent phenomenon of monopolizing the use of generic words is not to protect consumers, but to facilitate a protectionist regime. The wholesale attempts to elevate generic words to nationally and globally protected names and to demand universal protection are eroding the fundamental tenets of trademark jurisprudence. The practice is anti-competition on a global scale.

The discussion proceeds as follows: Section II provides a brief background on the rise of the EU's claim of exclusive ownership of the generic name "sardine" and the United States' claim on the "catfish" name. Such claims are in conflict with established trademark jurisprudence. Section III discusses trademark law in depth and examines the sound reasons behind the genericness doctrine under which generic names are never protected. The proliferation of proprietization of generic names may lead to language depletion. The genericness doctrine prevents this erosion of language by prohibiting exclusive ownership of generic names. Section IV focuses on the theory that generic names belong to competitors and to the public, as they are necessary for fair competition—the cornerstone of established trademark jurisprudence on generic names.

Sections V and VI identify and critique the new international trademark jurisprudence. Specifically, Section V examines the elevation of generic names from a never-protected status under established trademark law to nationally protected names per respective laws created in the United States and the European

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USA TODAY, Sept. 9, 2003, at B1, *available at* 2003 WL 5318546 (reporting that the "EU wants the 146-nation World Trade Organization to create a global registry that would effectively outlaw the use of protected names outside of the regions where the foods and drinks originated").

5. See Neal Wallace, *Cheese Names Threatened*, OTAGO DAILY TIMES (N.Z.), Aug. 20, 2003 (stating that New Zealand's cheese export would be in jeopardy if the EU succeeds in restricting use of names, forcing New Zealand to rename and relabel its cheese products), *available at* <http://www.odt.co.nz/?issue=2003/20Aug2003>.

Union. The nationalizing process transforms generic names into *national* trademarks. This section compares and contrasts this new *national* trademark protection to that afforded validly protected trademarks, including registered and famous trademarks. This section also examines and critiques the effects of nationalizing trademarks upon other countries, bilateral trade relations, and the export market.

Moreover, Section VI reveals that the expansion of legal protection for generic names has reached another height with the concept of geographic indications. This section traces the history of elevating generic names to geographic indications and the current campaign by the EU for new protection for certain generic names. A generic name as a geographic indication, per the most influential multi-national trade agreement,<sup>6</sup> commands worldwide protection; nations who are members to the agreement have no right to use the generic name, and those nations must also enact laws or provide legal mechanisms to prevent their citizens and others from using the generic name.<sup>7</sup> Essentially, generic names as geographic indications are the new universal trademarks, and, together with generic names as *national* trademarks, form the new international trademark jurisprudence.

Section VII identifies and critiques the impact of the new international trademark jurisprudence. Protectionist practices are thinly veiled by the assertion that the expansion of legal protection for generic names is in the interest of consumers. The international trademark jurisprudence causes more trade barriers instead of eliminating them for the globalization of trade. Additionally, the new *national* trademarks are illustrative examples of circumventing the global protection system that requires negotiation and approval of member nations.

Section VIII suggests an end to the formation of this international trademark jurisprudence, eliminating the sudden elevation of generic names to national and universal trademarks. Fair competition within a region and across national borders necessitates a return to the established trademark jurisprudence that prohibits the monopolization of generic names. This section proposes, in balancing the desire to protect the origin designations of products of certain characteristics and the rights of others to use

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6. Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, LEGAL INSTRUMENTS—RESULTS OF THE URUGUAY ROUND OF MULTILATERAL TRADE NEGOTIATIONS, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement].

7. *Id.* at art. 22, 1869 U.N.T.S. 299, 308.

generic names, a trademark certification system similar to the United States' system. A trademark certification system will allow fair trade among competitors in the export market and encourage protection of names of certain regions that have not become generic.

The Article concludes that demand for a new international protection for generic names is irrational and hinders fair trade efforts. International trademark law must not be expanded to include protection for generic names as a new globally protected form of intellectual property right.

## II. IN THE NAMES OF SARDINES AND CATFISH

### A. *The European Union: Claiming Ownership in the Sardine Name*

"Sardine" is the common name of small or immature clupeid fish, suitable for preserving for food.<sup>8</sup> Though sardines live in almost all oceans around the world,<sup>9</sup> some countries have recently asserted that they own the name "sardine." Indeed, the EU, a group of currently twenty-five countries,<sup>10</sup> has claimed that only European sardines are true sardines and, thus, the word "sardine" can only be used on European sardines.<sup>11</sup> Sardines from other countries, when

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8. Merriam-Webster's Collegiate Dictionary defines "sardine" as "1: any of several small or immature clupeid fishes; esp: the young of the European pilchard (*Sardina pilchardus*) when of a size suitable for preserving for food 2: any of various small fishes (as an anchovy) resembling the true *sardines* or similarly preserved for food." MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY 1037 (10th ed. 1993). Encyclopædia Britannica also provides a definition for "sardine": "any of certain food fishes of the herring (q.v.) family, Clupeidae, especially members of the genera *Sardina*, *Sardinops*, and *Sardinella*; the name sardine can also refer to the common herring (*Clupea harengus*) and to other small herrings or herringlike fishes when canned in oil." Sardine, ENCYCLOPÆDIA BRITANNICA, <http://www.britannica.com/eb/article?eu=67451> (last visited Sept. 10, 2004).

9. See Report of WTO Panel on European Communities—Trade Description of Sardines, para. 2.1 (May 29, 2002), <http://www.sice.oas.org/dispute/wto/ds231/ds231e1.asp> [hereinafter WTO Panel Report] (stating that sardine species belong to the *Clupeidae* family that "populate almost all oceans").

10. *European Union Member States*, at <http://eurunion.org/states/home.htm> (last visited Oct. 2, 2004).

11. Raymond Schonfeld & John Dobinson, *Using International Standards: A Wake-Up Call to Regulators?*, ASTM INT'L STANDARDIZATION NEWS, Jan. 2004, available at [http://www.astm.org/cgi-bin/SoftCart.exe/SNEWS/JANUARY\\_2004/schondob\\_jan04.html?L+mystore+zhp2197](http://www.astm.org/cgi-bin/SoftCart.exe/SNEWS/JANUARY_2004/schondob_jan04.html?L+mystore+zhp2197).

sold within the EU, are forbidden to be labeled as “sardines.”<sup>12</sup>

The exclusive ownership of the name “sardine” is limited to the EU regions. Its impact reaches, however, to non-EU countries when such countries attempt to export preserved sardines to Europe.<sup>13</sup> The practice of claiming ownership in a common name for a fish, however, is not confined to the EU.

*B. The United States: The Great Catfish War*<sup>14</sup>

On the other side of the Atlantic Ocean, the United States has created its own generic name protection system.<sup>15</sup> Specifically, the United States prohibits catfish from countries outside North America to be called “catfish.”<sup>16</sup> Recently, the U.S. passed both federal and state labeling laws to restrict the use of the name “catfish.”<sup>17</sup> The name “catfish” is only permitted to be used on

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12. See *WTO Dispute Settlement: Sardines Panel Sides with Peru*, BRIDGES WKLY. TRADE NEWS DIG., June 4, 2002, at 7, 8 (stating that European sardines in canned fish products may be marketed as sardines while products containing other countries' sardines are prohibited from carrying such label), available at <http://www.ictsd.org/weekly/02-06-04/2002BRIDGESWeekly21.pdf>.

13. *Id.* (describing Peru's attempt to export its preserved sardines to the EU and finding that it could not use “the term ‘Peruvian sardines’ on tins containing sardine-like fish species caught off the Peruvian coast”).

14. “The Great Catfish War” was the title of a *New York Times* editorial. The editorial explained the United States' conduct in prohibiting the use of the name “catfish” as part of a catfish trade war between the United States and Vietnam. *The Great Catfish War*, N.Y. TIMES, July 22, 2003, at A18.

15. See Karen Lowry Miller, *Trade: Something Fishy*, NEWSWEEK (Atlantic Ed.), Aug. 4, 2003, at 4 (reporting that while the United States restricts the name “catfish” to U.S.-born catfish families, it continually reprimands European nations for their own list of generic name protections).

16. Edward Alden, *U.S. and Vietnam in Catfish Spat*, FIN. TIMES, Jan. 28, 2003, at P7, available at 2003 WL 11160481 (stating that congressional legislation forbids Vietnam from calling their product “catfish” when they export their catfish for sale in the United States); Barun Roy, *The Great American Catfish War*, BUS. STANDARD, Jan. 24, 2003, at 6, available at 2003 WL 4274270 (reporting the United States passage of a law prohibiting any catfish that is not a U.S. species to be labeled as “catfish”).

17. The United States prohibits catfish that are not within the Ictaluridae family to be called catfish. See 21 U.S.C.A. § 321d(a)(1) (West Supp. 2004) (stating that “the term ‘catfish’ may only be considered to be a common or usual name . . . for fish classified within the family Ictaluridae; and only labeling or advertising for fish classified within that family may include the term ‘catfish.’”); MISS. CODE ANN. § 69-7-605(b) (Supp. 2003) (stating that “[c]atfish’ means any species within the family Ictaluridae or the family Anarchichadidae”); *id.* § 69-7-608(2) (stating that “[i]t is unlawful to use the term ‘catfish’ in the advertising, distributing, labeling or selling of any of those species within the family of Siluridae, Clariidae and Pangasiidae or any other fish not within the definition of catfish in Section 69-7-605”).

species of catfish that are found in North America waters.<sup>18</sup> Catfish, however, live worldwide and enjoy a diverse population of several thousand species.<sup>19</sup> Under the new laws, countries are not allowed to use the name “catfish” if they export catfish to the U.S. market. Worse yet, a violation of the catfish labeling law is a felony with a fine or prison term, or both, under the law of the State of Mississippi.<sup>20</sup>

Both the European Union and the United States are leading the efforts to create a new international recognition and protection for generic names. Such protection is in conflict with established trademark jurisprudence.<sup>21</sup>

### III. GENERIC WORDS IN TRADEMARK JURISPRUDENCE

Trademark law provides the owner of a trademark the exclusive right to use the trademark in commerce.<sup>22</sup> The owner can seek to

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18. See Roy, *supra* note 16, at 6 (noting that the Ictaluridae catfish family lives in the United States and is the smallest of the catfish families worldwide).

19. Due to its diversity and widespread habitat, the catfish genus was chosen for a global study funded by the National Science Foundation to identify all of the species thereunder. All Catfish Species Inventory, at <http://clade.acnatsci.org/allcatfish> (last visited Sept. 15, 2004). This global, multi-phased study involves graduate students, postdoctoral fellows, and senior taxonomists in numerous countries and various regions identifying and classifying catfish in order to learn about biodiversity, biogeography, high diversity, and endemism. Overview, All Catfish Species Inventory, at [http://clade.acnatsci.org/allcatfish/ACSLidx\\_pages/Overview.html](http://clade.acnatsci.org/allcatfish/ACSLidx_pages/Overview.html) (Jan. 10, 2003); All Catfish Species Inventory, Catfish Families (Gallery), at <http://clade.acnatsci.org/allcatfish/ACSL/taxa/Families.html> (Nov. 2002).

20. Specifically, Mississippi law mandates that a person who violates . . . or who otherwise misrepresents as catfish any fish or fish product not defined as catfish under this article is guilty of a felony and upon conviction shall be punished by a fine of not more than One Thousand Dollars . . . or by imprisonment for not more than two (2) years, or both. For subsequent violations, a person shall be punished by a fine of not more than Five Thousand Dollars . . . or by imprisonment not to exceed five (5) years, or both.

MISS. CODE ANN. § 69-7-608(4) (Supp. 2003).

21. See *infra* Section III.

22. 15 U.S.C. §§ 1051, 1114(1) (2000); see also *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (stating that the federal trademark law provides the owner of a trademark both “the exclusive right to ‘register’ a trademark and to prevent his or her competitors from using that trademark”) (citation omitted); Adam Mossoff, *What Is Property? Putting the Pieces Back Together*, 45 ARIZ. L. REV. 371, 421-24 (2003) (discussing the exclusive right to use trademarks and various property theories relating to trademark right); Roberto Rosas, *Trademarks Under the North American Free Trade Agreement (NAFTA) with References to the New Trademark Law of Spain, Effective July 31, 2003 and the Current Mexican Law*, 16 N.Y. INT’L L. REV. 147, 179 (2003)



enjoin others from using an identical or similar trademark that is likely to cause consumer confusion.<sup>23</sup> To avail itself of this protection under trademark jurisprudence, the owner must establish that its trademark is valid, and therefore deserving of the exclusive right to protection.<sup>24</sup>

Established trademark law bestows arbitrary trademarks with a high level of protection and descriptive trademarks that have acquired secondary meaning with a relatively lower level of protection.<sup>25</sup> An arbitrary trademark is a common word or phrase

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(stating that under Spanish and Mexican trademark laws, trademark owners have the exclusive right to use registered trademarks in commerce).

23. 15 U.S.C. § 1116(a) (2000); *see also* *Playboy Enters. v. Netscape Communications Corp.*, 354 F.3d 1020, 1024 (9th Cir. 2004) (applying the likelihood of confusion test to ascertain whether the defendant's use of its trademark violated plaintiff's trademark right). With respect to famous trademarks, the likelihood of confusion test is not necessary in trademark dilution cases. 15 U.S.C. § 1125(c) (2000); *see* *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 431 (2003) (noting that for famous trademarks, the federal trademark dilution law extends protection against subsequent uses that blur or tarnish the distinctiveness of the famous trademark, even absent a likelihood of confusion); *see also* Lateef Mtima, *Trademarks, Copyrights and the Internet*, SH085 A.L.I.-A.B.A. 387, 394-97 (2003) (discussing extending the likelihood of confusion test from traditional trademark cases to those involving Internet domain names).

24. *See* *DeGidio v. West Group Corp.*, 355 F.3d 506, 508-09 (6th Cir. 2004) (holding that the plaintiff failed to establish that "LawOffice.net" is a valid, legally protectable trademark); *America Online, Inc. v. AT & T Corp.*, 243 F.3d 812, 819 (4th Cir. 2001) (stating that a plaintiff in a trademark infringement action must prove "the validity and its ownership of the mark as part of its larger burden in a trademark infringement action"); *see also* Danielle Conway-Jones, *Remedying Trademark Infringement: The Role of Bad Faith in Awarding an Accounting of Defendant's Profits*, 42 SANTA CLARA L. REV. 863, 869 (2002) ("The work that a trademark owner puts into developing a mark to identify the source of goods will result in goodwill and enhanced reputation. Generally, trademark law protects an intangible property interest, which is the value of the association between an identifiable mark or symbol and its source.").

25. *See* *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 905 n.1 (9th Cir. 2003) ("The law conceptually classifies trademarks along a spectrum of increasing distinctiveness: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful."); *Filipino Yellow Pages, Inc. v. Asian Journal Publ'ns, Inc.*, 198 F.3d 1143, 1147 (9th Cir. 1999) (describing the different categories of distinctiveness recognized under trademark case law); Michael Maher, Comment, *On Vino Veritas? Clarifying the Use of Geographic References on American Wine Labels*, 89 CAL. L. REV. 1881, 1889 (2001) (noting that trademarks are classified along the distinctiveness spectrum with the most distinctive marks, such as arbitrary, fanciful and suggestive, being always protected, and the least distinctive marks, such as generic, being unprotectable). For a comprehensive overview of the distinctiveness spectrum in trademark law, *see* 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND

that is used in an uncommon way,<sup>26</sup> for instance, “monster.com” for employment search services,<sup>27</sup> and “apple” for computers.<sup>28</sup> A fanciful trademark is a coined word—a non-existing dictionary word.<sup>29</sup> “Kodak,”<sup>30</sup> “Rolls Royce,”<sup>31</sup> and “Toucan Sam”<sup>32</sup> are examples of fanciful trademarks. Both arbitrary and fanciful trademarks receive the highest level of trademark protection because these words themselves do not possess any relation to the accompanying goods or services to which the words are affixed.<sup>33</sup>

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UNFAIR COMPETITION, ch. 11 (4th ed. 2004) [hereinafter MCCARTHY].

26. See, e.g., *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 943 n.6 (9th Cir. 2002) (applying the test developed in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976), and noting that “Amazon” for an online bookstore is an example of an arbitrary trademark).

27. The trademark “monster.com” was filed in 1999 and registered in 2000 for online employment recruiting services. See U.S. Patent & Trademark Office, Trademark Electronic Search System, at <http://tess2.uspto.gov> (last visited Sept. 15, 2004).

28. See *Champions Golf Club, Inc. v. The Champions Golf Club, Inc.*, 78 F.3d 1111, 1117 (6th Cir. 1996) (stating that “[a]n arbitrary mark has a significance recognized in everyday life, but the thing it normally signifies is unrelated to the product or service to which the mark is attached,” such as CAMEL cigarettes or APPLE computers”) (quoting *Little Caesar Enters. v. Pizza Caesar, Inc.*, 834 F.2d 568, 571 (6th Cir. 1987)); *Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 478 (3d Cir. 1994) (stating that the “words ‘shell,’ ‘camel’ and ‘apple’ are not uncommon, but they are arbitrary when applied to gasoline, cigarettes and computers”).

29. See, e.g., *Interstellar Starship Servs.*, 304 F.3d at 943 n.6 (noting that “Exxon” and “Kodak” are nondictionary words and examples of fanciful trademarks); *Larsen v. Terk Techs. Corp.*, 151 F.3d 140, 148 n.5 (4th Cir. 1998) (noting that “[f]anciful marks are . . . made-up words expressly coined for serving as a trademark,” and naming some examples of fanciful marks, such as “CLOROX” and “POLAROID”) (quoting *Sara Lee Corp. v. Keyser-Roth Corp.*, 81 F.3d 455, 464 (4th Cir. 1996)).

30. See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 210-11 (2000) (stating that “Kodak” film is an example of an inherently distinctive trademark because it is fanciful).

31. See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 429-30 n.10 (2002) (noting that “Rolls Royce” is among a group of fanciful trademarks that has contributed to the expansion of language (citing Frank Schecter, *Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 828-29 (1927))); *Arrow Distilleries, Inc. v. Globe Brewing Co.*, 117 F.2d 347, 349 (4th Cir. 1941) (providing “Aunt Jemima” and “Rolls Royce” as examples of fanciful trademarks fabricated by trademark owners).

32. *Kellogg Co. v. Toucan Golf, Inc.*, 337 F.3d 616, 624 (6th Cir. 2003) (holding that “Toucan Sam” is a fanciful trademark).

33. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 786 (1992) (stating that arbitrary, fanciful, and suggestive trademarks are inherently distinctive trademarks and are “presumed to represent the source of a product, and the first user of a trademark could sue to protect it without having to show

The level of trademark protection for a suggestive trademark is less than that for an arbitrary or fanciful trademark.<sup>34</sup> This is because a suggestive trademark requires the consumer to use imagination, thought, and perception to arrive at or connect the mark to a characteristic of the good or service,<sup>35</sup> such as the use of a polar bear for ice cream bars. Other examples of suggestive marks include "Apple-A-Day" for vitamin tablets,<sup>36</sup> "Bear" for boots and cold weather outerwear,<sup>37</sup> and "Playboy" for magazines.<sup>38</sup>

Descending along the spectrum of trademark protection, descriptive words such as "Vision Center"<sup>39</sup> and "Fish-Fri"<sup>40</sup> are only entitled to protection if they have acquired secondary meaning in

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that the word or symbol represented the product's source in fact"); *Larsen*, 151 F.3d at 148 (stating that "[s]o-called 'fanciful,' 'arbitrary,' and 'suggestive' marks are inherently distinctive, and therefore receive the greatest protection against infringement").

34. For example, "TREK is a suggestive trademark [for bicycles and bicycle accessories] because 'trek' means a long journey, and one can undertake a long journey on a bicycle." *Thane Int'l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 912 n.14 (9th Cir. 2002). Thus, the mark "does not belong to the highest category of distinctiveness, that reserved for arbitrary and fanciful marks, and thus does not deserve as much protection." *Id.*

35. *Gen. Shoe Corp. v. Rosen*, 111 F.2d 95, 98 (4th Cir. 1940); *see also* *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 943 n.6 (9th Cir. 2002) (noting that "ROACH MOTEL" for insect traps is an example of a suggestive trademark because it requires "imagination, thought, or perception to link the trademark with the goods"); *In re Nett Designs*, 236 F.3d 1339, 1341 (Fed. Cir. 2001) (explaining the characteristics of suggestive trademarks); *Brookfield Communications, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1058 n.19 (9th Cir. 1999) (noting that "a suggestive mark conveys an impression of a good but requires the exercise of some imagination and perception to reach a conclusion as to the product's nature," and therefore such a mark possesses both a primary descriptive meaning and a secondary trademark meaning).

36. *M & G Elecs. Sales Corp. v. Sony Kabushiki Kaisha*, 250 F. Supp. 2d 91, 101 (E.D.N.Y. 2003) (stating that the word "apple" is an arbitrary trademark when it is used for personal computers and that "Apple-A-Day" is a suggestive trademark for vitamin tablets (quoting *Paddington Corp. v. Attiki Imps. & Distributions, Inc.*, 996 F.2d 577, 583 (2d Cir. 1993))).

37. *Bear U.S.A., Inc. v. A.J. Sheepskin & Leather Outerwear, Inc.*, 909 F. Supp. 896, 904 (S.D.N.Y. 1995), *aff'd*, 216 F.3d 1071 (2d Cir. 2000) (holding that "[p]laintiffs' bear marks are suggestive, particularly as used in connection with boots and cold weather outerwear").

38. *Playboy Enters., Inc. v. Chuckleberry Publ'g, Inc.*, 687 F.2d 563, 566-67 (2d Cir. 1982) (holding that Playboy is a suggestive trademark with respect to the magazine title because it suggests the aspirations of the magazine's reader).

39. *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 116-17 (5th Cir. 1979) (holding that "Vision Center" is a descriptive trademark in reference to a business offering optical goods and services).

40. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792-96 (5th Cir. 1983) (finding "Fish-Fri" to be a merely descriptive trademark).

the mind of the consumer.<sup>41</sup> Descriptive trademarks or merely descriptive trademarks immediately convey information concerning a quality or characteristic of the associated products or services to which the trademarks are affixed.<sup>42</sup> The owner of a descriptive word must demonstrate that through extensive use of the word in commerce, the consumer has come to associate the word with a source for the products or services.<sup>43</sup> The owner of a validly protectable descriptive word, however, does not have an exclusive right to use the trademark.<sup>44</sup> A fair use defense is available to competitors, forbidding the trademark owner to appropriate a descriptive term for exclusive use and to prevent others from describing a characteristic of their goods or services.<sup>45</sup>

Nevertheless, a trademark that is arbitrary, fanciful, suggestive, or descriptive with acquired secondary meaning, even

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41. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 786 (1992) (stating that the presumption that an inherently distinctive trademark represents the source of a product does not attach to a descriptive word and therefore the owner of such a trademark could "obtain relief only if he first showed that his [trademark] did in fact represent not just the product, but a producer").

42. J. THOMAS MCCARTHY, *MCCARTHY'S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY* 119 (2d ed. 1995).

43. See *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985). Although descriptive terms generally do not enjoy trademark protection, a descriptive term can be protected provided "that it has acquired secondary meaning [in the minds of consumers], i.e., it 'has become distinctive of the [trademark] applicant's goods in commerce.'" *Id.* (quoting 15 U.S.C. § 1052(f) (2000) (permitting registration of trademarks that have become "distinctive of the applicant's goods in commerce")).

44. See, e.g., *ETW Corp. v. Jireh Publ'g, Inc.*, 332 F.3d 915, 920-21 (6th Cir. 2003) (stating that the use of Tiger Woods's name "on the back of the envelope containing the print and in the narrative description of the print are purely descriptive and there is nothing to indicate that they were used other than in good faith"); *Waco Int'l, Inc. v. KHK Scaffolding Houston Inc.*, 278 F.3d 523, 534-35 (5th Cir. 2002) (analyzing the fair use doctrine in cases where fair use is allowed to describe the good); *New Kids on the Block v. News Am. Publ'g Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (allowing nominative use of descriptive trademarks).

45. 15 U.S.C. § 1115(b)(4) (2000); see also *ETW Corp.*, 332 F.3d at 920 (noting that "[t]he Lanham Act provides a defense to an infringement claim where the use of the mark 'is a use, otherwise than as a mark, . . . which is descriptive of and used fairly and in good faith only to describe the goods . . . of such party'" (quoting 15 U.S.C. § 1115(b)(4)); *Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 319 (6th Cir. 2001) ("Under the doctrine of 'fair use,' the holder of a trademark *cannot* prevent others from using the word that forms the trademark in its *primary* or *descriptive* sense."); *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 270 (2d Cir. 1995) ("[F]air use permits others to use a protected mark to describe aspects of their own goods.").

though it is entitled to protection, is not necessarily a strong mark in the marketplace if it does not achieve broad public recognition.<sup>46</sup> A holder of such trademarks thus must spend an enormous amount of resources to build the goodwill and transform these words into known source identifiers in the mind of the consumer.<sup>47</sup> Further, the trademark holder generally expends significant resources to police the trademarks against third party use to avoid diminishment of the trademark's significance as a source identifier.<sup>48</sup>

On the other end of the trademark protection spectrum, generic trademarks deserve no protection.<sup>49</sup> Generic trademarks are also referred to as "common descriptive" terms.<sup>50</sup> As names of articles in commerce, generic trademarks are incapable of functioning as source identifiers in the mind of the consumer.<sup>51</sup> Logically, no

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46. See, e.g., *Daddy's Junky Music Stores, Inc. v. Big Daddy's Family Music Ctr.*, 109 F.3d 275, 281 (6th Cir. 1997) (noting that "[a]ssigning a category to a mark constitutes only a single step in determining the strength of the mark").

47. See, e.g., *Homeowners Group, Inc. v. Home Mktg. Specialists, Inc.*, 931 F.2d 1100, 1107 (6th Cir. 1991) ("HMS may indeed be arbitrary and hence inherently distinctive, yet have little customer recognition or 'strength' in the market, or perhaps have high recognition which is limited to a particular product or market segment.").

48. See, e.g., *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 766 (C.C.P.A. 1982). A trademark distinctiveness can be lost if the trademark owner failed to take action against infringers because

[i]f there are numerous products in the marketplace bearing the alleged mark, purchasers may learn to ignore the "mark" as a source identification. When that occurs, the conduct of the former owner, by failing to police its mark, can be said to have caused the mark to lose its significance as a mark.

*Id.*

49. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) ("A generic term is one that refers to the genus of which the particular product is a species. Generic terms are not registrable . . . ." (citations omitted)); *Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 404 (6th Cir. 2002) ("A generic mark can never function as a trademark."), *cert. denied*, 538 U.S. 907 (2003).

50. Some courts distinguish "common descriptive" terms from "merely descriptive" terms. See, e.g., *Park 'N Fly, Inc.*, 469 U.S. at 193-94. Merely descriptive terms often identify the characteristics of things and can gain trademark protection if they acquire secondary meaning. Common descriptive terms are the names of the articles and are therefore generic. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 n.11 (2d Cir. 1976). Compare 15 U.S.C. § 1052(e), (f) (2000) (stating that a "merely descriptive" term may be registered if it has "become distinctive of the applicant's goods in commerce") with *id.* § 1064(3) (stating that registration may be cancelled if the mark has become the common descriptive name of an article).

51. *TCPIP Holding Co. v. Haar Communications, Inc.*, 244 F.3d 88, 93 (2d Cir. 2001) ("Generic marks . . . are totally lacking in distinctive quality [and] are not entitled to any protection . . . ."); see *In re Gould Paper Corp.*, 834 F.2d

person or entity has the exclusive right to use generic words, nor the power to exclude others from using generic words in commerce.<sup>52</sup> For example, a company that is in the business of selling cars under the name "CAR,"<sup>53</sup> receives no trademark protection for the name, and likewise "CEREAL" deserves no trademark protection when it is used in connection with cereal products.<sup>54</sup> In addition, certain known trademarks that have become generic words due to their own enormous popularity and to the trademark owner's failure to monitor third-party use of the trademarks are not entitled to trademark protection.<sup>55</sup> In other words, when a popular trademark

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1017, 1019 (Fed. Cir. 1987) (holding "screenwipe" for screen cleaning cloth to be generic because it "would be perceived by the purchasing public as merely a common name for its goods rather than a mark identifying the good's source"); *Surgicenters of Am., Inc. v. Med. Dental Surgeries, Co.*, 601 F.2d 1011, 1018 (9th Cir. 1979) (holding "surgicenter" an unregistrable generic term for surgical center).

52. "To allow protection for generic terms would grant a 'monopoly, since a competitor could not describe his goods as what they are.'" *Nartron Corp.*, 305 F.3d at 404-05 (quoting *CES Publ'g Corp. v. St. Regis Publ'ns, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975)); see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15 cmt. b (1995) ("A seller . . . cannot remove a generic term from the public domain and cast upon competitors the burden of using an alternative name.").

53. *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 215 (2d Cir. 1999) (stating that because "car" is a generic name for articles in commerce, "no one can claim the exclusive right to use the mark 'CAR' for a car").

54. *Kellogg Co. v. Toucan Golf, Inc.*, 337 F.3d 616, 624 (6th Cir. 2003) (stating that "cereal" is a generic mark); see also *Nartron Corp.*, 305 F.3d at 404 (affirming the district court's decision that the term "smart power" is generic because it defines a type of technology used in the semiconductor industry).

55. 15 U.S.C. § 1064(3) (2002) (stating that the registration of a mark may be cancelled if the mark becomes the generic name for the goods or services for which it was registered). See, e.g., *Park 'N Fly Inc.*, 469 U.S. at 194 (stating that "a registered mark may be canceled at any time on the grounds that it has become generic"); *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 1570 (Fed. Cir. 1995) (affirming that the "Walking Fingers" mark became generic because AT & T allowed others to use it); *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 80 (2d Cir. 1936) (finding that the trademark cellophane had become generic); *Malaco Leaf, AB v. Promotion In Motion, Inc.*, 287 F. Supp. 2d 355, 365 (S.D.N.Y. 2003) (holding that the plaintiff failed to police the rampant third party usage of its trademark and trade dress of gummy fish-shaped candies in the market); *Am. Thermos Prods. Co. v. Aladdin Indus.*, 207 F. Supp. 9, 13-14 (D. Conn. 1962), *aff'd sub nom.*, *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 581 (2d Cir. 1963), *injunction modified*, 320 F. Supp. 1156, 1159 (D. Conn. 1970) (stating that the trademark "Thermos" had become generic with respect to vacuum-insulated bottles); *Bayer Co. v. United Drug Co.* 272 F. 505, 512 (S.D.N.Y. 1921) (holding that aspirin had become a generic mark); see also Vincent N. Palladino, *Assessing Trademark Significance: Genericness, Secondary Meaning and Surveys*, 92 TRADEMARK REP. 857, 860 (2002) (noting that there are two types of generic trademarks; one with initial

has become generic through use, there is no rollback to reclaim the protection it once enjoyed.<sup>56</sup>

One of the reasons for the denial of trademark protection for generic words is the depletion of the language. Courts have noted that the cost of proprietization of valid trademarks is the removal of words from language.<sup>57</sup> To balance such cost, trademark owners are prohibited from having an exclusive right in generic terms in association with generic use.<sup>58</sup> A generic word is available to all for use in commerce in naming or marketing the products.<sup>59</sup>

Under the genericness doctrine, names such as "catfish," "sardine," and "salmon" are the common names of certain types of fish in commerce.<sup>60</sup> Trademark law does not protect a generic name such as "catfish" that is used in commerce in its commonly understood way—to describe freshwater, stout-bodied, scaleless, bony fishes having long tactile barbells.<sup>61</sup> Likewise, names like

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trademark meaning and the other without).

56. Once a known trademark has become generic, the trademark owner generally cannot reclaim it as a trademark "merely by use and advertising." MCCARTHY, *supra* note 25, § 12.11. There are, however, very rare cases where with a massive amount of advertising, it does appear possible for a company to reclaim a generic term from the public domain and give it trademark significance. *Id.* § 12.30.

57. The Ninth Circuit balanced the cost of recognizing property rights in trademarks with a fair use defense that "forbids a trademark registrant to appropriate a descriptive term for his exclusive use and so prevent others from accurately describing a characteristic of their goods." *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992).

58. See, e.g., *Small Bus. Assistance Corp. v. Clear Channel Broad., Inc.*, 210 F.3d 278, 279 (5th Cir. 2000) (stating that "[a] trademark cannot be infringed by the generic term for the product it designates"); *GMT Prods., L.P. v. Cablevision of N.Y. City, Inc.*, 816 F. Supp. 207, 209-11 (S.D.N.Y. 1993) (finding the plaintiff had no exclusive right to use the words "The Arabic Channel" even though it had obtained registration for the words and a graphic design as a composite trademark).

59. See *Am. Online, Inc. v. AT & T Corp.*, 243 F.3d 812, 822 (4th Cir. 2001) (holding that "You Have Mail" is generic and that AOL may not exclude others from using the same words in connection with their e-mail service); *In re Wada*, 194 F.3d 1297, 1301 (Fed. Cir. 1999) (stating that "generic terms are unregistrable because registration would preclude others from using terms that truthfully describe their products" and explaining that the function of disclaiming generic terms in "composite marks . . . containing generic terms to be registered as a whole [is to prevent] any exclusive rights in the generic terms themselves").

60. See *Am. Online, Inc.*, 243 F.3d at 820 (noting that "[a]t the basic level, we can conclude that when a fruit merchant sells fruit as 'apples' or 'blackberries,' he should never be able to exclude competitors from similarly using the words 'apple' or 'blackberries' to sell their fruit").

61. See generally *Am. Cyanamid Corp. v. Connaught Labs., Inc.*, 800 F.2d

"parmesan," "feta," and "fontina" are generic words for certain types of cheese and are not entitled to trademark protection.<sup>62</sup> Otherwise, language depletion would occur as competitors continue to claim exclusive rights to use common names of articles in commerce.<sup>63</sup>

#### IV. ANTI-COMPETITION THEORY—GENERIC WORDS

Trademarks enable effective competition in a marketplace that has become increasingly complex and impersonal by providing a means through which a consumer can easily identify the products she desires, preventing the consumer from being misled as to the source of products in commerce, and rewarding the trademark holder with continued patronage.<sup>64</sup> To maintain fair competition in

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306, 308 (2d Cir. 1986) ("A trademark holder cannot appropriate generic . . . terms for its exclusive use, and a trademark infringement finding thus cannot be based on the use of a generic . . . term . . .").

62. In fact, the term "fontina" has been found generic in the United States. *In re Cooperativa Produttori Latte E Fontina Valle D'Acosta*, 230 U.S.P.Q. 133, 134 (Trademark Tr. & App. Bd. 1986).

63. Courts have expressed their concerns about language depletion if generic words were to be given trademark protection. See, e.g., *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 906 (9th Cir. 2003) ("If the trademark holder were allowed exclusive rights in [use of descriptive words], the language would be depleted in much the same way as if generic words were protectable.").

64. See *Smith v. Chanel, Inc.*, 402 F.2d 562, 563-66 (9th Cir. 1968) (examining the policy goals of trademark law, which are (1) to protect consumers from being misled as to the enterprise from which the goods or services emanate or are associated; (2) to prevent an impairment of the value of the enterprise which owns the trademark; and (3) to achieve these ends in a manner consistent with the objectives of free competition).

When Congress amended the Lanham Act to include the primary significance test for determining generic trademarks, Congress observed several essential functions of trademarks in commerce:

Among other things, trademarks (a) foster competition by enabling particular business entities to identify their goods or services and to distinguish them from those sold by others; (b) facilitate distribution by indicating that particular products or services emanate from a reliable though often anonymous source; (c) aid consumers in the selection process by denoting a level of quality relating to particular goods or services; (d) symbolize the reputation and good will of the owner, thereby motivating consumers to purchase or avoid certain trademarked products or services; and (e) protect the public from confusion or deception by enabling purchasers to identify and obtain desired goods or services.

S. REP. NO. 98-627, at 2 (1984), *reprinted in* 1984 U.S.C.C.A.N. 5718, 5718-19 (quoting *Hearings on S. 1990 Before the Subcomm. on Patents, Copyrights & Trademarks of the Comm. on the Judiciary*, 98th Cong. 25 (1984) (prepared statement of the U.S. Trademark Assoc. by Michael A. Grow, Chairman, U.S. Trademark Assoc. Fed. Legislation Comm.)).



the marketplace, the genericness doctrine in trademark law prevents "anti-competitive misuse of trademarks."<sup>65</sup> Essentially, if a generic term could be trademarked, competitors would encounter enormous "difficulty informing consumers that they *were* competitors, because they would be unable, without elaborate and possibly confusing paraphrase, to give the name of the product they were selling."<sup>66</sup> When a term is necessary for a competitor to describe or identify a product,<sup>67</sup> "a producer may not effectively preempt competition by claiming that [generic] term as its own."<sup>68</sup> Even if a generic name has accumulated goodwill, sharing such goodwill of the generic name "is the exercise of a right possessed by all—and in the free exercise of which the consuming public is deeply interested."<sup>69</sup>

To ascertain whether a term is generic requires an examination of the term's meaning to the relevant public. This is the primary significance test.<sup>70</sup> Evidence of genericness can include any

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65. *Anti-Monopoly, Inc. v. Gen. Mills Fun Group*, 611 F.2d 296, 301 (9th Cir. 1979); see also Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1328-29 (1980) ("[W]hen no name other than the trademarked word is available to the public or competitors to indicate the type or class of product on which the trademark is used, exclusive control of the trademarked word has not been permitted.").

66. *Door Sys., Inc. v. Pro-Line Door Sys., Inc.*, 83 F.3d 169, 171 (7th Cir. 1996); see also *Bada Co. v. Montgomery Ward & Co.*, 426 F.2d 8, 11 (9th Cir. 1990) (stating that a competitor will be prohibited from "impoverish[ing] the language of commerce" by preventing others from fairly describing their own goods or services); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 15 cmt. b (1995) ("A seller . . . cannot remove a generic term from the public domain and cast upon competitors the burden of using an alternative name.").

67. See *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 215 (2d Cir. 1999) (stating that generic words are "totally without distinctiveness and are ineligible for protection as marks because to give them protection would be to deprive competitors of the right to refer to their products by name").

68. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 305 (3d Cir. 1986). The *Canfield* court further explained that trademark law

grants a monopoly over a phrase only if and to the extent it is necessary to enable consumers to distinguish one producer's goods from others and even then only if the grant of such a monopoly will not substantially disadvantage competitors by preventing them from describing the nature of their goods.

*Id.*

69. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 115 (1938). The Kellogg court promoted fair competition by emphatically declaring that there is no legal protection for the goodwill generated by the use of generic names in commerce. *Id.*

70. In 1984, Congress amended the Lanham Act to require that "[t]he primary significance of the registered mark to the relevant public . . . shall be the test for determining whether the registered mark has become the generic

competent source that demonstrates the relevant public's understanding of a term.<sup>71</sup> Such sources include dictionary definitions,<sup>72</sup> yellow pages,<sup>73</sup> newspapers, and other publications,<sup>74</sup> in addition to generic use by competitors, the mark's owners, and third parties.<sup>75</sup>

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name of goods or services on or in connection with which it has been used." 15 U.S.C. §1064(3) (2000). Relevant public is not necessarily always deemed to refer to everyone, but rather could be composed of a "relatively small group of highly trained and knowledgeable professional customers for a particular specialized product or service." MCCARTHY, *supra* note 25, § 12.5; *see also* Wayne F. Osoba, *The Legislative Response to Anti-Monopoly: A Missed Opportunity to Clarify the Genericity Doctrine*, 1985 U. ILL. L. REV. 197, 211-13 (1985) (providing a critique of the congressional primary significance test for generic trademarks).

71. *See, e.g., In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed Cir. 1985); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 12 (2d Cir. 1976). In addition, to be generic, a word need not have a direct relationship to the name of the product, but some distinctive characteristic of the genus of the product. *See J. Kohnstam, Ltd. v. Louis Marx & Co.*, 280 F.2d 437, 439-40 (C.C.P.A. 1960) (holding "matchbox toy vehicles" as generic because such genus of toy cars were sold in matchbox size boxes); *In re Space-General Corp.*, 136 U.S.P.Q. (BNA) 77, 79 (Trademark Tr. & App. Bd. 1962) (holding "space electronics" generic for electronic equipment used for space navigation).

72. *Creative Gifts, Inc. v. UFO*, 235 F.3d 540, 545 (10th Cir. 2000) ("Evidence of the public's understanding may come from direct testimony of purchasers, consumer surveys, dictionary listings, newspapers and other publications"); *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1570 (Fed. Cir. 1987) (stating that the dictionary is one of the competent sources for determining whether a term is generic). Many terms, however, have been found to be generic despite their absence from dictionary sources. *See, e.g., Technical Publ'g Co. v. Lebharr-Friedman, Inc.*, 729 F.2d 1136, 1140-41 (7th Cir. 1984) (finding "software news" as a generic phrase); *Nat'l Conference of Bar Exam'rs v. Multistate Legal Studies*, 692 F.2d 478, 488 (7th Cir. 1982) (finding "multistate bar examination" to be a generic phrase).

73. *Door Sys., Inc. v. Pro-Line Door Sys., Inc.*, 83 F.3d 169, 171 (7th Cir. 1996) (noting that looking to the dictionary and the yellow pages are two of many methods for determining whether a term is generic).

74. *See In re Am. Builders & Contractors Supply Co.*, No. 74/499,226, 1996 TTAB LEXIS 334, at \*5 (holding the trademark "Construction Trade Tools" generic based on the record excerpts from articles taken from the NEXIS database).

75. Consumer survey evidence is not necessary to establish that a trademark is generic, if dictionaries, newspapers, and other publications evidence are available. *See, e.g., Liquid Controls Corp. v. Liquid Control Corp.*, 802 F.2d 934, 937-39 (7th Cir. 1986) (affirming the district court's grant of summary judgment on genericity, not on survey evidence but, instead, based primarily on dictionary and other usage evidence); *Suh v. Yang*, 987 F. Supp. 783, 791 n.4 (N.D. Cal. 1997) (noting that consumer survey evidence is "not required"); *Expoconsul Int'l, Inc. v. A/E Sys., Inc.*, 755 F. Supp. 1237, 1247 (S.D.N.Y. 1991) (stating that "[t]heoretically, there is always better evidence

When there is no alternative word available to communicate the same functional information, the word that denotes, identifies or describes the product is generic.<sup>76</sup> Such word is free for the public to use.<sup>77</sup> Otherwise, the trademark status of such word could effectively create a monopoly in the generic name and prevent competitors from engaging in fair competition in the marketplace.<sup>78</sup> In sum, that "generic trademarks be copied freely . . . [is] important for preserving effective competition."<sup>79</sup>

Indeed, courts have long held that effective competition necessitates the free use of generic terms, such as "chablis,"<sup>80</sup> "catfish," "sardine," "parmesan," "feta," or "fontina."<sup>81</sup> Established jurisprudence on anti-competition and trademark law mandates continued recognition that generic words may vest no monopolistic right in their users.<sup>82</sup> The public, including competitors, has the

[than consumer surveys] that can be produced").

76. See *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 306 (3d Cir. 1986). As the Third Circuit stated:

Whether the term that identifies the product is generic then depends on the competitors' need to use it. At the least, if no commonly used alternative effectively communicates the same functional information, the term that denotes the product is generic. If we held otherwise, a grant of trademark status could effectively prevent a competitor from marketing a product with the same characteristic despite its right to do so under the patent laws.

*Id.* (citations omitted); see also *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431, 1442 (3d Cir. 1994) (stating that a generic word means "a word with so few alternatives (perhaps none) for describing the good").

77. See, e.g., *Holzapfel's Compositions Co. v. Rahtjen's Am. Composition Co.*, 183 U.S. 1, 9 (1901) (stating that "the only name by which it was possible to describe" an article was free for public use); *Bayer Co. v. United Drug Co.*, 272 F. 505, 513 (S.D.N.Y. 1921) (focusing on the availability of "another current word" for aspirin).

78. See *Duraco Prods., Inc.*, 40 F.3d at 1442 (stating that allowing someone to monopolize a generic word would debilitate competitors).

79. *Id.*

80. *Institut Nat'l Des Appellations D'Origine v. Vintners Int'l Co.*, 958 F.2d 1574, 1581 (Fed. Cir. 1992) (affirming the Board's decision that the term "Chablis" is the generic name for a type of wine, and that "[b]eing generic and, therefore, in the public domain, 'Chablis' does not function as a trademark to indicate origin").

81. See *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 380 (2d Cir. 1997) (stating that trademarking a generic term "would create a 'linguistic monopoly' which would stifle competitors' efforts to market similar goods to consumers"). The policy for denying protection to generic names is that "[g]eneric names are regarded by the law as free for all of us to use. They are in the public domain." MCCARTHY, *supra* note 25, § 12.2.

82. See *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 304 (3d Cir. 1986).

Underlying the genericness doctrine is the principle that some

right to use such words without fear of repercussion via litigation.<sup>83</sup>

## V. ELEVATING GENERIC WORDS TO NATIONAL TRADEMARKS?

Both the United States and the European Union have extended protection to generic names in their respective legal systems.<sup>84</sup> Each respective law provides protection to words that would never have been granted recognition as trademarks nor be entitled to any protection under existing trademark jurisprudence. The examples here are “catfish” for the United States and “sardines” for the European Union.

### A. *Nationalizing the Catfish Trademark*

The United States has elevated generic names from never-protected status to nationally protected status.<sup>85</sup> Specifically, the new federal and state labeling laws prohibit other nations from using the name “catfish,” redefining the generic name of catfish by providing a specialized definition for the type of fish that can be referred to as “catfish.”<sup>86</sup> Only the species of catfish that live in the

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terms so directly signify the nature of the product that interests of competition demand that other producers be able to use them even if terms have or might have become identified with a source and so acquire “de facto” secondary meaning.

*Id.*

83. See *Otokoyama Co. v. Wine of Japan Imp., Inc.*, 175 F.3d 266, 270 (2d Cir. 1999) (stating that the genericness doctrine “protects the interest of the consuming public in understanding the nature of goods offered for sale, as well as a fair marketplace among competitors by insuring that every provider may refer to his goods as what they are”).

84. See *supra* Part II.

85. Title 21, Section 321d of the U.S. Code provides:

(a) Catfish labeling. (1) In general. Notwithstanding any other provision of law, for purposes of the Federal Food, Drug, and Cosmetic Act (21 U.S.C. § 301 et seq.)—

(A) the term “catfish” may only be considered to be a common or usual name (or part thereof) for fish classified within the family Ictaluridae; and

(B) only labeling or advertising for fish classified within that family may include the term “catfish.”

21 U.S.C.A. § 321d (West Supp. 2004).

Several states have enacted similar statutes to protect the generic name “catfish.” See ARK. CODE ANN. § 20-61-202 (Michie Supp. 2003); LA. REV. STAT. ANN. § 3:4617 (West 2003) (held preempted by the federal statute for misbranded catfish in *Piazza’s Seafood World, LLC v. Odom*, No. Civ.A. 04-690, 2004 WL 1375306, at \*4 (E.D. La. June 17, 2004)); MISS. CODE ANN. § 69-7-605 (Supp. 2003); TENN. CODE ANN. § 53-1-102 (Supp. 2003).

86. 21 U.S.C.A. § 321d(a)(1) (limiting the definition of “catfish” to the Ictaluridae family); ARK. CODE ANN. § 20-61-202(2) (“Catfish” means any species

United States are “catfish.”<sup>87</sup> Similar-looking fishes that are commonly understood by the public to be called catfish, but do not reside in the United States, cannot be referred to as “catfish.”<sup>88</sup>

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of the scientific family Ictaluridae.”); LA. REV. STAT. ANN. § 3:4617(C) (“[C]atfish’ shall mean only those species within the family Ictaluridae or the family Anarchichadidae and grown in the United States of America.”); MISS. CODE ANN. § 69-7-605(b) (defining “catfish” to reference only the Ictaluridae family); TENN. CODE ANN. § 53-1-102(4) (stating that “[c]atfish’ means any species within the family Ictaluridae or the family Anarchichadidae”). A federal district court recently held that the Louisiana statute on catfish labeling is preempted by the federal statute on misbranded catfish. *Piazza’s Seafood World, LLC.*, 2004 WL 1375306, at \*4. The court also found that the Louisiana statute is discriminatory on its face because it applies only to foreign products while the statute’s true purpose is protectionism. *Id.*

87. The aforementioned states have also enacted statutes to punish mislabeling with the name “catfish.” For example, Tennessee prohibits the use of the name “catfish” and punishes any misrepresentation or mislabeling of the name “catfish” as follows:

“Catfish product” means any product capable of use as human food that is made wholly or in part from any catfish or portion thereof, except products that contain catfish only in small proportions or historically have not been, in the judgment of the commissioner, considered by consumers as products of the United States commercial catfish industry and that are exempted from definition as a catfish product by the commissioner under such conditions as the commissioner may prescribe to assure that the catfish or portions thereof contained therein are not adulterated and that the products are not represented as catfish products.

TENN. CODE ANN. § 53-1-102(5).

Similarly, Louisiana enacted a statute of prohibition and punishment:

No one shall misrepresent the name, or type of any fruit, vegetable, grain, meat, or fish, including catfish, sold, or offered or exposed for sale, to any actual or prospective consumer. “Catfish” shall mean only those species within the family Ictaluridae or the family Anarchichadidae and grown in the United States of America.

LA. REV. STAT. ANN. § 3:4617(C); *see also* LA. REV. STAT. ANN. § 56:578.11(B)(1) (West 2004) (“No person shall possess, sell, purchase, trade, barter, or exchange or attempt to sell, purchase, barter, or exchange any species of fish as catfish or catfish product unless that catfish is within the family of Ictaluridae, Ariidae, or Loricariidae.”). Louisiana statute 3:4617(C) has been held to be preempted by the federal statute on misbranded catfish. *Piazza’s Seafood World, LLC.*, 2004 WL 1375306, at \*4. It remains to be seen whether the Louisiana legislature will amend its statute in light of this latest district court decision.

88. LA. REV. STAT. ANN. § 56:578.11(B)(2) (“Fish within the family Pangasiidae shall not be possessed, sold, purchased, bartered, traded, or exchanged as catfish or a catfish product.”). Similarly, Mississippi’s statute states that “[i]t is unlawful to use the term ‘catfish’ in the advertising, distributing, labeling or selling of any of those species within the family of Siluridae, Calriidae and Pangasiidae or any other fish not within the definition of catfish in Section 69-7-605.” MISS. CODE ANN. § 69-7-608(2) (Supp. 2003).

Despite the fact that the trademark genericness and anti-competition doctrines afford the term “catfish” no trademark protection and provide no person the exclusive right to use the term “catfish,” the United States has carved out its own protection of the generic term.<sup>89</sup>

The effect of the new laws is perpetual protection of exclusive use of the term “catfish” by the United States.<sup>90</sup> The United States essentially claims the status of exclusive ownership of the common name of a diverse fish.<sup>91</sup> An exclusive right to use a name is generally the right bestowed to a trademark owner.<sup>92</sup> Here, the

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Further, Tennessee law provides that

[i]t is a violation of this section to use the term “catfish” in the advertisement, distribution, processing, labeling, or wholesale or retail sale of any of those species within the family of Siluridae, Clariidae and Pangasiidae or any other species of fish not included within the definition of catfish set out in § 53-1-102.

TENN. CODE ANN. § 53-1-115(a)(2) (Supp. 2003).

89. 21 U.S.C.A. § 343 (West 1999 & Supp. 2004) (“A food shall be deemed to be misbranded . . . (t) If it purports to be or is represented as catfish, unless it is fish classified within the family Ictaluridae.”).

Mississippi has enforced its new label law by assessing an \$1,800 penalty against a retail grocery store for selling catfish from Vietnam under the label “Imported Catfish.” Press Release, Miss. Dep’t of Agric. and Commerce, Vietnamese Basa Illegally Sold as “Imported Catfish” (July 24, 2002), at <http://www.mdac.state.ms.us/Library/AgencyInfo/PressReleases/Basapena7-24-2002.pdf> (last visited Sept. 15, 2004).

Tennessee provides that a violation of the usage of the name “catfish” in the advertisement, distribution, processing, labeling, or wholesale or retail sale of imported catfish and imported catfish products is subject to a civil penalty of up to \$1,000 for each violation and that “[e]ach day of continued violation constitutes a separate violation.” TENN. CODE ANN. § 53-1-115(e).

90. This protection is contrary to existing trademark law which does not recognize any specific trademarks for statutory entitlement. See 15 U.S.C. § 1052(b) (2002) (disallowing registration of marks that consist of or comprise “the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof”).

91. Indeed, the United States has demanded that other nations must use different names to describe their export catfish into the United States. For example, Vietnam was forced to change the label “catfish” for its catfish to a new name, “basa.” Amy Kazmin, *Vietnam’s Catfish Farmers Left Reeling by U.S. Duty Threat*, FIN. TIMES, June 14, 2003, at 9 (reporting on the U.S. law on catfish “forcing Vietnamese companies to market their fish by lesser-known local names of tra and basa”); Press Release, Rep. Mike Ross (D-Ark.) and Rep. Marion Berry (D-Ark.), Vietnam Agrees to Use New Names for Catfish Exports, at [http://www.house.gov/ross/pr\\_2001\\_2002/pr\\_073101catfish2.html](http://www.house.gov/ross/pr_2001_2002/pr_073101catfish2.html) (July 31, 2001).

92. See, e.g., *Interpace Corp. v. Lapp Inc.*, 721 F.2d 460, 462 (3d Cir. 2001) (“The law of trademark protects trademark owners in the exclusive use of their marks when use by another would be likely to cause confusion.”).

exclusive right to use a name has been elevated to a level higher than the right generally enjoyed by a trademark owner, as the exclusivity is in the generic name.<sup>93</sup> A trademark owner never has the exclusive right to use a generic name in commerce.<sup>94</sup> The United States, however, grants itself the elevated right of exclusivity in the generic name "catfish."<sup>95</sup>

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93. Under existing trademark law, when a plaintiff's trademark is found to be generic, the plaintiff's trademark infringement and unfair competition claims fail. See *Nartron Corp. v. STMicroelectronics, Inc.*, 305 F.3d 397, 413 (6th Cir. 2002) (holding that because the plaintiff's mark was generic, no prospective injunctive relief was available); *Commerce Nat'l Ins. Servs., Inc. v. Commerce Ins. Agency, Inc.*, 214 F.3d 432, 438-39 (3d Cir. 2000) (explaining that a trademark owner's exclusive right in the mark is limited to action where likelihood of confusion exists and that the owner must prove that it owns a valid and legally protectable trademark before it can advance on the likelihood of confusion test).

94. Established trademark law never extends protection to generic names. See *Genesee Brewing Co. v. Stroh Brewing Co.*, 124 F.3d 137, 143 (2d Cir. 1997) ("Generic marks are never entitled to trademark protection."); *Union Nat'l Bank of Tex., Laredo, Tex. v. Union Nat'l Bank of Tex., Austin, Tex.*, 909 F.2d 839, 844 (5th Cir. 1990) (stating the established law that "[g]eneric terms are never eligible for trademark protection"). To protect otherwise will cause unfair competition, because

no matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name.

*Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

95. This is so despite the fact that an expert consulted by the Food and Drug Administration assured the world that the name "catfish" as used by other countries, such as Vietnam, for their catfish is not a misuse of the name. Marilyn McDevitt Rubin, *If It Has Whiskers and Swims, Is It a Catfish?*, PITTS. POST-GAZETTE, August 18, 2002, at G-14 ("Dr. Carl J. Ferraris Jr., an adjunct curator of ichthyology at the California Academy of Science, who specializes in the world's catfish species, assured [the FDA that] Vietnam was not misusing the label."). Also, despite the fact that there are several thousands species of catfish, the United States seizes the name "catfish" for the labeling of its fish. See Elizabeth Lee, *Asian Import Has to Go Fishing for a New Name*, CHI. TRIB., Jan. 1, 2003, at A7, which reports:

When is a catfish not a catfish? When it's raised outside of North America.

The U.S. Food and Drug Administration, which maintains a seafood list that determines what names species can be marketed under, has issued guidelines on what to call a fish that, in accordance with a farm bill passed this year, can never be called a catfish.

See also David Lamb, *U.S., Vietnam in Dispute over Catfish Exports*, L.A. TIMES, Dec. 8, 2002, at A5 (reporting that out of 2,500 species of catfish, only those raised in the United States could be sold as "catfish").

Additionally, unlike the trademark right, which is a private right that requires the trademark owner to initiate trademark infringement or unfair competition actions against potential wrongdoers,<sup>96</sup> the exclusive right to use the term "catfish" by the United States is a right created by the U.S. government, proclaiming the generic name of a diverse fish as belonging to a nation, the United States.<sup>97</sup> This nationally-created exclusive right to use a generic name enjoys a status that has never before been afforded to a trademark, even to nationally-famous or well-known trademarks such as "Chrysler" and "Buick."<sup>98</sup>

In other words, the term "catfish" now has effectively become a *national* trademark. The United States as a nation and through its legal framework designs to exclusively own the name "catfish."<sup>99</sup>

96. 15 U.S.C. § 1125(a) (2000); *see, e.g.*, *K Mart Corp. v. Cartier, Inc.*, 485 U.S. 176, 185-86 (1988) ("Trademark law, like contract law, confers private rights, which are themselves rights of exclusion. It grants the trademark owner a bundle of such rights . . ."); *Genesee Brewing Co.*, 124 F.3d at 142 (stating that the Lanham Act creates "a federal private cause of action for injunctive relief and damages against" a manufacturer who uses a trademark causing a likelihood of confusion as to source).

97. *Cf.* Elizabeth Becker, *Delta Farmers Want Copyright on Catfish*, N.Y. TIMES, Jan. 16, 2002, at A15 (reporting Dr. Carl Ferraris's conclusion that "there's no justification, historically or scientifically," for limiting "the term catfish to North American catfish").

98. Owners of famous trademarks can also initiate private causes of action under the Federal Trademark Dilution Act to enjoin others from tarnishing or blurring the distinctiveness of their famous trademarks. 15 U.S.C. § 1125(c); *see Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432-33 (2003) (holding that the Federal Trademark Dilution Act, an amendment to the Lanham Act that provides a dilution cause of action, requires proof of actual dilution). When a famous trademark becomes generic due to uncontrolled third-party usage, the owner of the once-famous trademark has no private right in the trademark. Examples of once trademarked terms that have become generic include "thermos," "escalator," "aspirin," and "yo-yo." MCCARTHY, *supra* note 25, § 12.1 (stating that "genericide" can occur when a protected trademark, such as "Thermos," "Escalator," or "Aspirin," over time becomes the shorthand name for an entire genus of products sold under it); *see also Union Nat'l Bank of Tex., Laredo, Tex.*, 909 F.2d at 846 ("The English language, more than most, is in a constant state of flux. A word which is today fanciful may tomorrow become descriptive or generic.").

99. Such exclusive right in the generic name has no foundation, as catfish families live in numerous countries, and the name "catfish" is used worldwide. For example, the existence of a group of catfish enthusiasts in the United Kingdom demonstrates that the name "catfish" is used outside the United States. Catfish Study Group (U.K.) Homepage, at <http://www.catfishstudygroup.org> (last visited Sept. 15, 2004); *see also* Cabela's, *Catfish Species Information*, at [http://www.cabelas.com/cabelas/en/content/community/inthefield/fieldguides/Fieldguides\\_home/kk\\_species.jhtml](http://www.cabelas.com/cabelas/en/content/community/inthefield/fieldguides/Fieldguides_home/kk_species.jhtml) (last



The United States is the only nation that can use the name because the fish must come from a particular nation, here, the United States, and the term is exclusive to naming such fish, despite the fact that catfish reside globally and there are several thousand species of catfish.<sup>100</sup>

The sudden elevation of a generic term to a *national* trademark status has another set of effects. As a *national* trademark, the generic term dictates that other countries observe and respect the exclusivity of the term usage.<sup>101</sup> No other nation or its citizens can now use the term catfish in commerce, particularly if they want such fish to be in the U.S. stream of commerce.<sup>102</sup>

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visited Sept. 15, 2004) ("Catfish are characterized by scaleless skin and barbels (otherwise known as whiskers) around their mouth. They inhabit tropical regions around the world and even oceans."); National Center for Biotechnology Information, at <http://www.ncbi.nih.gov/entrez/query.fcgi?doptcmdl=ExternalLink&cmd=Search&db=Taxonomy&term=LoProvcatfish%5BSB%5D> (providing taxonomy of catfish worldwide). Further, Highbeam Research provides the following information about a species of catfish that lives outside the United States, further indicating that the name "catfish" is known worldwide:

CATFISH - TIGER CATFISH SPECIES Locations: South America - South and Central America Catfish, Order Siluriformes, are found throughout the world. Although most of them are freshwater kinds, a few are found in a marine environment. They are characterized by having whiskers and barbels around their mouths. Many search for their food by smell and make little use of their small eyes.

Highbeam Research, Earth Life Forms—Animals: *Pseudodoris Niger*, at <http://www.highbeam.com> (May 1, 1998).

100. See Lamb, *supra* note 95, at 5 (reporting that out of 2,500 species of catfish, only those raised in the United States could be sold as catfish); Lee, *supra* note 95, at A8; Mekong River Commission for Sustainable Development, *Catfish*, at <http://www.mrcmekong.org/pdf/Catfish.pdf> (last visited Nov. 16, 2004) (stating that of the 31 families and 2,200 species of catfish, 125 species are found in the Mekong river area, and the majority of species live in South America).

101. See Mikhail Raj Abdullah, *PM Highlights America's Trade Doublespeak on Vietnam's Catfish Exports*, BERNAMA DAILY MALAY. NEWS, Aug. 13, 2003, 2003 WL 61710940, at \*1 (reporting Malaysia's Prime Minister Datuk Seri Dr. Mahathir Mohamad's critique of the U.S. law monopolizing the name "catfish" for its domestic species, though there are more than 2,000 catfish types worldwide, forcing other countries to export catfish to America under different names).

102. According to a recent article,

Congress recently mandated that Vietnamese catfish cannot be labeled and sold as such, but must be called "tra" or "basa" . . . . Antidumping duties of 36 percent to 63 percent were just imposed on imports of catfish from Vietnam, an action taken close on the heels of Vietnam and the United States signing an [sic] historic trade agreement.

Kenneth Pierce et al., *Fishy Taxes on Trade*, METRO. CORP. COUNSEL, Aug.

Generally, the owner of a registered trademark can prevent the unauthorized importation of goods bearing its trademark if the owner has registered the trademark with customs officials.<sup>103</sup> The burden is on the owner of the trademark to work with customs and to bring actions against individuals responsible for the unauthorized importation.<sup>104</sup> Here, as a result of the national treatment of a generic term as a *national* trademark, there are no identifiable owners of the generic term. Both federal and state government agencies have the authority to prosecute the misnaming of a fish as "catfish."<sup>105</sup> Moreover, there is a penalty associated with misnaming

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2003, at 17.

103. 15 U.S.C. § 1124 (2000); *see, e.g.*, *K Mart Corp. v. Cartier, Inc.*, 485 U.S. 176, 185-86 (stating that trademark law confers private rights to a trademark owner, "one of which is the right to enlist the Customs Service's aid to bar foreign-made goods bearing that trademark").

104. Indeed, the trademark owner has "sole authority to decide that all products bearing its trademark will enter or that none will, and to decide what entity may import them, under what conditions, and for what purpose." *K Mart Corp.*, 485 U.S. at 186.

105. The new provision regulating the use of the catfish name was included in the misbranded food section of the Federal Food, Drug, and Cosmetic Act. 21 U.S.C.A. § 343(t) (West Supp. 2004). A federal enforcement agency has the jurisdiction to initiate an action against owners of fish and fish products that misbrand catfish. *See United States v. Strauss*, 999 F.2d 692, 697 (2d Cir. 1993) (holding that the criminal provision of the Food, Drug, and Cosmetic Act prohibiting mislabeling was not unconstitutionally vague); *Am. Frozen Food Inst. v. Califano*, 555 F.2d 1059, 1060 (D.C. Cir. 1977) (stating that the FDA has authority, under general rule-making powers, to promulgate regulation controlling the labeling of certain food items). Similar state agencies have the authority to initiate civil and criminal actions for misbranding "catfish" on fish and fish products. *See MISS. CODE ANN. § 69-7-608(3)* (Supp. 2003) ("The State Health Officer shall regulate and inspect restaurants under this article . . . [and] shall notify . . . any restaurant violating this article and shall give the restaurant three (3) days to correct the violation."); *id.* § 69-7-613 ("The commissioner may apply for and the court may grant a temporary or permanent injunction restraining any person from violating or continuing to violate any of the provisions of this article or any rule or regulation promulgated under this article, notwithstanding the existence of other remedies at law."); *TENN. CODE ANN. § 53-1-115* (Supp. 2003) (providing the Commissioner of Agriculture the power to enforce the new catfish label requirement as amended to the Tennessee Food, Drugs, and Cosmetics Act). Specifically, the Tennessee statute regulating the name "catfish" states:

(b) The provisions of this section shall apply only to the advertisement, distribution, processing, labeling, or wholesale or retail sale of:

(1) Unprepared or packaged imported catfish and imported catfish products; and

(2) Unprepared or packaged fish and fish products described in subsection (a).

a fish as "catfish."<sup>106</sup> Such prosecution and penalty are designed to ensure the end of the generic use of a term as once understood by the global public and establish a new beginning for national treatment of generic terms as *national* trademarks.<sup>107</sup>

Such new laws undermine the well-established genericness doctrine and anti-competition jurisprudence. The new laws take the generic word "catfish" out of the language, an action that the courts have long cautioned against.<sup>108</sup> Courts have ruled against the

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(c) The commissioner shall enforce the requirements of this section and is authorized to promulgate rules and regulations pursuant to the Uniform Administrative Procedures Act, compiled in title 4, chapter 5, to implement the provisions of this section.

(d) In the event of a violation of this section, the commissioner is authorized to:

(1) Order the processor, distributor, wholesaler or retailer to cease the distribution or sale of imported catfish or imported catfish products that are not labeled or are labeled in violation of this section;

(2) Order the processor, distributor, wholesaler or retailer to cease the advertisement, distribution, labeling or sale of all other fish or fish products that are being advertised, distributed, labeled or sold in violation of this section;

(3) Seek injunctive relief to stop practices that are in violation of this section; and

(4) Order the processor, distributor, wholesaler or retailer to comply with the provisions of this section or any rule or regulation promulgated pursuant thereto.

*Id.*

106. See MISS. CODE ANN. § 69-7-608 (punishing the misuse of the name "catfish" as a felony with fines and/or prison term); TENN. CODE ANN. § 53-1-115(e) ("Any person who violates the provisions of this section shall be subject to a civil penalty of not more than one thousand dollars (\$1,000) for each violation. Each day of continued violation constitutes a separate violation.").

107. Such a law for the protection of a generic name has never before been enacted, as the Lanham Act provides only a private cause of action to owners of valid trademarks. See generally 15 U.S.C. §§ 1051-1141n (2000). Though there are criminal provisions against defendants in trademark counterfeit cases, such cases require that valid trademarks be used in the distribution and sale of counterfeit goods. See *United States v. Giles*, 213 F.3d 1247, 1251 (10th Cir. 2000) (stating that criminal liability can only occur if the trademark is registered on the principal register in the U.S. Patent and Trademark Office and if the trademark is in use in commerce). Here, by deeming catfish a *national* trademark, the new law goes beyond monopoly of a generic word, as the federal and state governments use state power to enforce and control the use of a name. See 21 U.S.C.A. § 343(t) (West Supp. 2004); MISS. CODE ANN. § 69-7-608; TENN. CODE ANN. § 53-1-115.

108. See *New Kids on the Block v. News Am. Publ'g Inc.*, 971 F.2d 302, 306 (9th Cir. 1992) (stating that generic trademarks receive no protection and that the holder of such a mark receives no exclusivity in the generic mark, to allay

exclusive use of commonly descriptive words as trademarks because of potential language depletion due to the removal of words from common usage.<sup>109</sup> As generic words are elevated to *national* trademark status along with the new statutory deterrent consequences of fines,<sup>110</sup> imprisonment,<sup>111</sup> and injunction<sup>112</sup> for misusing such generic words, language depletion is no longer a fear, but a real threat. The legal precept that generic words are free to be used by all—a cornerstone of anti-competition and trademark jurisprudence—is now undermined when generic words like “catfish” acquire a new national status<sup>113</sup> and international meaning.

The passage of federal and state laws that have the effect of elevating a generic word to *national* trademark status is not unique to the United States, but is found in other countries as well. Notably, the European Union has a similar legal scheme.

### B. *Nationalizing the Sardine Trademark*

Similar to the way the United States’ legal scheme nationalizes the generic name “catfish,” the European Union has elevated the generic name “sardine” to a heightened status through its own regulation.<sup>114</sup> Under the EU regulation, the word “sardine” can only be used in commerce in the EU on one species, *sardine pilchardus*, found only in European waters.<sup>115</sup> Other sardines are thus not allowed to be called “sardines” if they are found in waters outside the EU.<sup>116</sup> For example, *sardinops sagax*, a type of sardine which generally lives off the coast of Peru, cannot be preserved and sold in

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“fears that producers will deplete the stock of useful words by asserting exclusive rights in them”).

109. Moreover, courts went further in the prevention of language depletion by denying the owner of protectable descriptive trademarks the right to exclusive use of the descriptive trademarks. See *Playboy Enters. v. Welles*, 279 F.3d 796, 802 (9th Cir. 2002) (“[W]hen a trademark also describes a person, a place or an attribute of a product’ and there is no descriptive substitute for the trademark, allowing the trademark holder exclusive rights would allow the language to ‘be depleted in much the same way as if generic words were protectable.” (quoting *New Kids on the Block*, 971 F.2d at 306)).

110. See MISS. CODE ANN. § 69-7-608; TENN. CODE ANN. § 53-1-115.

111. See MISS. CODE ANN. § 69-7-608(4).

112. See *id.* § 69-7-613(2) (2003).

113. See 21 U.S.C.A. §§ 321d, 343(t) (West Supp. 2004).

114. See Council Regulation 2136/89, *supra* note 2.

115. See Schonfeld & Dobinson, *supra* note 11 (discussing the background of the dispute between Peru and the European Communities).

116. See *WTO Dispute Settlement: Sardines Panel Sides with Peru*, *supra* note 12, at 8 (“In other words, only products of [sardines off the coasts of the Eastern North Atlantic, Mediterranean Sea, and the Black Sea] may have the word ‘sardines’ as part of the name on the container.”).

the EU as "sardines."<sup>117</sup> The regulation is contrary to the standards of Codex Alimentarius, an international standards body, which states that *sardinops sagax* could be described as a sardine!<sup>118</sup>

With the elevation of the generic name "sardine" to a new legal status of protection beyond the protection of trademarks, the EU stakes its exclusive right in a generic name that is widely used in the global community.<sup>119</sup> Similar to the United States' catfish exclusivity, the European Union aims to take a generic word from the language and prevent other nations from using this common name. This is contrary to the EU Trademark Directive that does not provide legal protection for generic names.<sup>120</sup> Specifically, the EU Trademark Directive states that words that are qualified for trademark protection must be "capable of distinguishing the goods or services."<sup>121</sup> The Trademark Directive prohibits registrations of and declares invalid trademarks that consist of words that are "devoid of any distinctive character"<sup>122</sup> or "have become customary in the current language or in the bona fide and established practices of

117. See *id.* at 7 (describing Peru's disputing of the EU's prohibition of "the use of the term 'Peruvian sardines' on tins containing sardine-like fish species caught off the Peruvian coast"); see also Schonfeld & Dobinson, *supra* note 11.

118. Codex Standard for Canned Sardines and Sardine-Type Products, CODEX STAN 94 (Codex Alimentarius Comm'n 1995); see also WTO Panel Report, *supra* note 9, para. 7.124, <http://www.sice.oas.org/dispute/wto/ds231/ds231e10.asp> ("Under Codex Stan 94, if a hermetically sealed container contains fish of species *Sardina pilchardus*, the product would be labeled 'sardines' without any qualification. A product containing preserved *Sardinops sagax*, however, would be labeled 'X sardines' with the 'X' representing the name of a country . . .").

119. Paragraph 7.131 of the WTO Report states:

[T]he *Multilingual Illustrated Dictionary of Aquatic Animals and Plants*, published in close cooperation with the European Commission and the member States of the European Communities, . . . lists the common name of *Sardinops sagax* in nine European languages as "sardines" or the equivalent thereof in the national language combined with the country or geographic area of origin. . . . [T]he *Multilingual Dictionary of Fish and Fish Products* prepared by the Organisation for Economic Cooperation and Development ("OECD") [] indicates that a common name of *Sardinops sagax* is "sardines" . . .

*id.* at para. 7.131. See also Schonfeld & Dobinson, *supra* note 11 (stating that the Codex Alimentarius indicates that Peruvian sardines are "sardines").

120. Council Directive 89/104, art. 2-3, 1989 O.J. (L 40) 32 [hereinafter Trademark Directive].

121. *Id.* at art. 2 (stating that trademarks "may consist of any sign capable of being represented graphically, particularly words, . . . provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings").

122. *Id.* at art. 3(1)(b) (stating that "[t]he following shall not be registered or if registered shall be liable to be declared invalid . . . trade marks which are devoid of any distinctive character").

the trade.”<sup>123</sup> Clearly, under the Trademark Directive, generic names are not entitled to trademark protection. Nevertheless, the EU monopolizes the generic name “sardine” with its regulation, reserving the name for its own use in connection with sardines found in the EU’s regional waters. The monopolization regulation is rooted in the concept of geographic indications.

## VI. GENERIC NAMES AS UNIVERSAL TRADEMARKS—GEOGRAPHIC INDICATIONS

The expansion of legal protection for generic names spearheaded by both the United States and the European Union has recently advanced to a new level where certain generic names will acquire a new identity—geographic indication—and enjoy global protection.

### A. *Geographic Indications*

Geographic indications mean words indicating the geographic source of a good whose quality or reputation is attributable to that geography.<sup>124</sup> Geographic indication is a new form of intellectual property<sup>125</sup> that requires worldwide protection by nation members of the WTO.<sup>126</sup> That is, when a word is recognized as a geographic indication, all nation members, except the region or country where the goods originate, have no right to use the word to describe the goods produced in their countries.<sup>127</sup>

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123. *Id.* at art. 3(1)(d).

124. See TRIPS Agreement, *supra* note 6, at art. 22 (providing that geographic indications are “indications which identify a good as originating in the territory of a 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”); Leigh Ann Lindquist, *champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographic Provisions of the TRIPS Agreement*, 27 GA. J. INT’L & COMP. L. 309, 311-12 (1998) (discussing geographic indication definition).

125. See Doris Estelle Long, “Democratizing” Globalization: Practicing the Policies of Cultural Inclusion, 10 CARDOZO J. INT’L & COMP. L. 217, 222 n.14 (2002) (noting that geographic indications are one of the new types of intellectual property rights recognized for protection under TRIPS).

126. See Shubba Ghosh, *Traditional Knowledge, Patents, and the New Mercantilism (Part II)*, 85 J. PAT. & TRADEMARK OFF. SOC’Y 885, 897 (2003) (stating that the TRIPS Agreement establishes standards of protection and enforcement of copyright, patent, trademark, geographic indicators, industrial designs, integrated circuit design layouts, and trade secrets with which member countries must comply).

127. See Lindquist, *supra* note 124, at 310 (stating that under the geographic indication provisions member countries must develop laws to

Historically, European countries have had a strong desire to protect geographic indications.<sup>128</sup> The concept of geographic indications, however, did not attract much international support. Indeed, the Paris Convention for the Protection of Industrial Property in 1883 ("Paris Convention") includes "indications of source or appellations of origin" in protectable subject matter<sup>129</sup> and prevents only the importation of goods containing false indications of geographic origin.<sup>130</sup> Though the Paris Convention has over one hundred signatories,<sup>131</sup> it is generally viewed as an ineffective international agreement because it contained no enforcement provisions.<sup>132</sup> In addition, the Paris Convention essentially

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prevent the use of geographic indications, referencing by example France's use of the designation Champagne). The TRIPS Agreement also allows a member country to not recognize geographic indications of other members if they are already common names in that country. See TRIPS Agreement, *supra* note 6, at art. 24(6).

128. See Lee Bendekey & Caroline H. Mead, *International Protection of Appellations of Origin and Other Geographic Indications*, 82 TRADEMARK REP. 765, 765 (1992) (stating that "countries with older economies and a longer tradition of localized industries that have become known for particular products, such as countries in Europe and the former Soviet Union, tend to have a stronger interest in protecting geographic indications."); Harun Kazmi, *Does It Make a Difference Where That Chablis Comes from? Geographic Indications in TRIPs and NAFTA*, 12 J. CONTEMP. LEGAL ISSUES 470, 471-72 (2001) ("Older economies have a strong interest in continuation of the forms of protection they have historically followed. Some nations have spent centuries in recognizing, cumulating, regulating, and protecting the qualities of locally and regionally developed wines, spirits, and other products."); ABM, *Agri-Food-Ministers Adopt Amendment to Regulation on Designations of Origin*, EUROPEAN REP., April 12, 2003, 2003 WL 10440136 (reporting that the EU Agriculture Ministers have amended 1992 Regulation 2081/92/EEC on the protection of designations of origin and geographic indications for farm produce and food in accord with the TRIPS Agreement).

129. Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, art. 1(2), 828 U.N.T.S. 305 [hereinafter Paris Convention] ("The protection of industrial property has as its object patents, utility models, industrial designs, trademarks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition.").

130. *Id.* at art. 10bis(3) (prohibiting "indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods"); see also Stacy D. Goldberg, Comment, *Who Will Raise the White Flag? The Battle Between the United States and the European Union over the Protection of Geographical Indications*, 22 U. PA. J. INT'L ECON. L. 107, 112-13 (2001) (discussing how the changes to the Paris Convention in 1958 seriously limited the protection of geographic indications).

131. See Goldberg, *supra* note 130, at 112 (noting that as of 2001 the Paris Convention had 117 members).

132. See Paul J. Heald, *Trademarks and Geographical Indications*:

contained no substantial provision for the protection of geographic indications,<sup>133</sup> and it left to the member nations to devise "border measures for false indications without defining the conditions for protection."<sup>134</sup>

After the Paris Convention came the Madrid Agreement for the Repression of False and Deceptive Indications of Source on Goods of 1891 ("Madrid Agreement"),<sup>135</sup> whose adherents agreed to implement border measures and provide protection against misleading geographic indications.<sup>136</sup> The Madrid Agreement contained a controversial provision that prohibited member countries from treating geographical indications of wines as generic terms.<sup>137</sup> The Madrid Agreement had only thirty-one members.<sup>138</sup>

The 1958 Lisbon Agreement for the Protection of Appellations of Origin ("Lisbon Agreement") followed the Madrid Agreement.<sup>139</sup> The Lisbon Agreement attempted to establish an absolutist protection of geographic indications by establishing an international system of registration<sup>140</sup> and protection for appellations of origin.<sup>141</sup> Under the

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*Exploring the Contours of the TRIPS Agreement*, 29 VAND. J. TRANSNAT'L L. 635, 649-50 (1996) (stating that "[u]nder the Paris Convention, a country was under no obligation to enact legislation permitting seizure or prohibiting importation of infringing goods").

133. See Albrecht Conrad, *The Protection of Geographical Indications in the TRIPS Agreement*, 86 TRADEMARK REP. 11, 24-25 (1996) (discussing how the Paris Convention provided no specific protection for geographical indications); Goldberg, *supra* note 130, at 112 (discussing the Paris Convention and the protection for geographic indications).

134. Conrad, *supra* note 133, at 23.

135. Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of April 14, 1891, 828 U.N.T.S. 162 [hereinafter Madrid Agreement].

136. The primary prohibition of the Madrid Agreement is included in Article 1(1), which provides: "All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries." *Id.* at art. 1(1).

137. See *id.* at art. 4.

138. Goldberg, *supra* note 130, at 113 (noting that as of 1999 the Madrid Agreement had attracted only thirty-one members).

139. Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration, Oct. 31, 1958, 923 U.N.T.S. 205, available at [http://www.wipo.int/lisbon/en/legal\\_texts/pdf/lisbon\\_agreement.pdf](http://www.wipo.int/lisbon/en/legal_texts/pdf/lisbon_agreement.pdf) [hereinafter Lisbon Agreement]; see also Goldberg, *supra* note 130, at 114 (discussing the Lisbon Agreement as an "attempt to achieve effective and enforceable protection for geographical indications").

140. A survey of the Lisbon registration system as of 1997 reveals that [o]f the 738 appellations of origin which had been registered by 1997, 472 of these had been registered by France, 108 by Czechoslovakia (70 of which were subsequently attributed to the Czech Republic and 37 to



Lisbon Agreement, an "appellation of origin" is "the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors."<sup>142</sup> Specifically, the Lisbon Agreement extends protection "against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as 'kind,' 'type,' 'make,' 'imitation,' or the like."<sup>143</sup> And it prohibits any geographical indication to be considered generic, so long as the geographical indication is protected in the country of origin.<sup>144</sup> The Lisbon Agreement could garner only seventeen signatory countries.<sup>145</sup>

Both the Madrid and Lisbon Agreements required member states to recognize and protect geographical indications even when the indications had become generic in their territories.<sup>146</sup> Both agreements also failed to attract members<sup>147</sup> and had very little international impact due to the legal protection they provided to generic identifiers.<sup>148</sup> Moreover, the Lisbon Agreement has been criticized as representative of an Old World philosophy and absolutist commercial viewpoint.<sup>149</sup>

Despite the failures of the Paris Convention, Madrid Agreement, and Lisbon Agreement to develop international protection for geographic indications, efforts have been renewed vigorously in modern times.<sup>150</sup> The Uruguay Round of Negotiations

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Slovakia (one was canceled), 48 by Bulgaria, 28 by Hungary, 26 by Italy, 19 by Algeria, 18 by Cuba, and fewer than 10 each by Tunisia, Portugal, Mexico and Israel. 90 refusals were made.

Norma Dawson, *Locating Geographical Indications—Perspectives from English Law*, 90 TRADEMARK REP. 590, 592 n.9 (2000).

141. Lisbon Agreement, *supra* note 139, at arts. 1(2), 5.

142. *Id.* at art. 2(1).

143. *Id.* at art. 3.

144. *Id.* at art. 6.

145. Conrad, *supra* note 133, at 23 n.66.

146. Dawson, *supra* note 140, at 604-05.

147. See Bendekgey & Mead, *supra* note 128, at 781 ("The Lisbon Agreement's treatment of genericness is the primary source of the United States' refusal to adhere to it.").

148. See Dawson, *supra* note 140, at 604-05 (stating that the failure of the two agreements to attract adherents was due to the genericness protection for geographic indications).

149. *Id.* at 591 (citing FREDERICK W. MOSTERT, FAMOUS AND WELL-KNOWN MARKS (1997)).

150. *Id.* at 592 (stating that "the importance of geographical indications in export markets fuels the desire of those states which are home to a significant

of the Agreement on Trade Related Aspects of Intellectual Property Rights of 1994 ("TRIPS Agreement")<sup>151</sup> contains the concept of geographic indications.<sup>152</sup> Specifically, the TRIPS Agreement, which is generally viewed as the most important international intellectual property agreement,<sup>153</sup> sets a major turn in establishing new international norms by providing international protection for geographic indications.<sup>154</sup> The TRIPS Agreement contains the current definition of and protection for geographic indications.<sup>155</sup> Administration and regulation of the TRIPS Agreement are within the province of the WTO.<sup>156</sup>

The TRIPS Agreement sets the framework for the recognition and protection of geographic indications.<sup>157</sup> If a term is recognized as

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number of geographical indications to secure greater international cooperation in affording higher standards of protection").

151. TRIPS Agreement, *supra* note 6. Currently, there are 149 members of the WTO bound by the TRIPS Agreements. World Trade Organization Home Page, at <http://www.wto.org> (last visited Sept. 15, 2004).

152. TRIPS Agreement, *supra* note 6, at art. 22(1); *see also* Ghosh, *supra* note 126, at 897-98 (summarizing various standards for intellectual property rights protection regimes under the TRIPS Agreement).

153. *See generally* Stanley M. Besen, *International Coordination of Intellectual Property Protection*, 621 PLI/PAT 213, 236-37 (2000) (discussing the significant aspects of TRIPS with respect to uniformity in the intellectual property rights regime, raising the degree of protection for intellectual property rights in all countries, effecting the means for enforcing rights, and access to an international forum for adjudicating disputes); Janet L. Hoffman, *International Considerations in Licensing*, 496 PLI/PAT 125, 130-32 (1997) (discussing the TRIPS Agreement as one of the most important multilateral treaties affecting trademark rights).

154. *See* Dawson, *supra* note 140, at 592-93 (stating that the TRIPS Agreement provides protection for geographical indications under Articles 22-24 and "foreshadows how this emerging intellectual property right may appear in the twenty-first century"). Other commentators, however, applauded TRIPS's geographic indication provisions because they "provide incentives for underdeveloped member states to develop local industries and market agricultural products worldwide under an exclusive indication of source." Heald, *supra* note 132, at 656.

155. *See* TRIPS Agreement, *supra* note 6, at art. 22(1).

156. Amir H. Khoury, *The Development of Modern Trademark Legislation and Protection in Arab Countries of the Middle East*, 16 TRANSNAT'L LAW. 249, 301-02 (2003) (stating that "the WTO administers and enforces the TRIPS agreement through administrative panels and dispute resolution mechanisms"); Charles R. McManis, *Intellectual Property, Genetic Resources and Traditional Knowledge Protection: Thinking Globally, Acting Locally*, 11 CARDOZO J. INT'L & COMP. L. 547, 547 (2003) (stating that WTO administers TRIPS).

157. *See* TRIPS Agreement, *supra* note 6, at arts. 22-24; Dawson, *supra* note 140, at 592-93 ("Article 22 provides that national laws must afford protection against any use of geographical indications which misleads consumers as to the geographical origin of products or which constitutes unfair competition.").

a geographic indication, member nations must provide the legal means to prevent the use of the geographic indication by others whose goods are not products of that geographical origin.<sup>158</sup> Within that legal framework, the TRIPS Agreement sets the stage for a global registration system for geographic indications, but only in the categories of wines.<sup>159</sup> Members have agreed that negotiations will occur to determine the individual geographic indications of wines worthy of global registration and protection.<sup>160</sup>

The negotiations for systemic registration for certain wines as geographic indications began at the Fourth Ministerial Conference held in Doha, Qatar in 2001. The WTO declared that the negotiations for a multilateral registration system for geographical indications for wines and spirits would be completed by the Fifth Ministerial Conference to be held in 2003 in Cancun, Mexico.<sup>161</sup> The

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158. The TRIPS Agreement states:

In respect of geographical indications, Members shall provide the legal means for interested parties to prevent: (a) 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; (b) any use which constitutes an act of unfair competition . . . .

TRIPS Agreement, *supra* note 6, at art. 22.

159. TRIPS Article 23 provides that,

[i]n order to facilitate the protection of geographical indications for wines, negotiations shall be undertaken in the Council for TRIPS concerning the establishment of a multilateral system of notification and registration of geographical indications for wines eligible for protection in those Members participating in the system.

*Id.* at art. 23(4).

160. According to Article 24 of TRIPS,

Members agree to enter into negotiations aimed at increasing the protection of individual geographic indications under Article 23 [wines and spirits] . . . . In the context of such negotiations, Members shall be willing to consider the continued applicability of these provisions to individual geographical indications whose use was the subject of such negotiations.

*Id.* at art. 24(1).

161. Doha Ministerial 2001: Ministerial Declaration, Nov. 14, 2001, para. 18, 41 I.L.M. 746, 749 [hereinafter WTO Ministerial Declaration] (“[W]e agree to negotiate the establishment of a multilateral system of notification and registration of geographical indications for wines and spirits by the Fifth Session of the Ministerial Conference.”). Further, the WTO website declares that “the Doha Declaration sets a deadline for completing the negotiations: the Fifth Ministerial Conference in 2003.” World Trade Organization, The Doha Declaration Explained, at [http://www.wto.org/english/tratop\\_e/dda\\_e/doha\\_explained\\_e.htm](http://www.wto.org/english/tratop_e/dda_e/doha_explained_e.htm) (last visited Sept. 15, 2004) [hereinafter Doha Explained]; see also Sungjoon Cho, *A Bridge Too Far: The Fall of the Fifth WTO Ministerial*

WTO TRIPS Council conducted such negotiations.<sup>162</sup> Seizing the momentum of the global trade talks on geographic indications, the EU attempted to advance its agenda by having members, bound by the TRIPS Agreement, extend the protection of geographic indications to a list of generic names in food categories.<sup>163</sup>

### B. *The EU's Generic Names as Geographic Indications*

The EU insists that the world recognize a list of generic names such as "mozzarella," "parmesan," "fontina," "gorgonzola," "bologna," and "feta," among other generic names, as the intellectual property

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*Conference in Cancun and the Future of Trade Constitution*, 7 J. INT'L ECON. L. 219, 221-25 (2004) (tracing the trade negotiations and conferences that led to the Fifth WTO Ministerial Conference in Cancun).

162. Doha Explained, *supra* note 161 ("The WTO TRIPS Council has already started work on a multilateral registration system for geographical indications for wines and spirits.").

163. The EU's lobbying efforts for negotiations on geographic indications led the Fourth WTO Ministerial Conference held in November 2001 in Doha, Qatar to direct future negotiations on the possibility of extending geographic indications from wine and spirits to food. See Peter N. Fowler & Alice T. Zalik, *A U.S. Government Perspective Concerning the Agreement on Trade-Related Aspects of Intellectual Property: Past, Present and Near Future*, 17 ST. JOHN'S J. LEGAL COMMENT. 401, 406 (2003) (noting that a number of WTO Members, led by Switzerland, have been advocating for the extension of geographic indications to foodstuffs while other non-European countries have strongly opposed such an extension); Paul W. Reidl, *On Treaties*, 93 TRADEMARK REP. 99, 104 n.20 (2003) ("The Fourth WTO Ministerial Conference held in November 2001 in Doha, Qatar, directed that negotiations be undertaken to extend the protections of TRIPS for geographic indications in the wine and spirits area to other goods."). The EU's quest for global protection for geographical indications of generic names became an issue at the Fifth WTO Ministerial Conference in Cancun.

One might reasonably suspect that the EU's insistence on the expansion of geographical indications in areas other than wine and spirits, for instance certain ham and cheese, was intended to collect bargaining chips for future agriculture negotiations, considering that very few Member countries are enthusiastic about this issue. In fact, Canada's Trade Minister Pierre Pettigrew warned against this proposal, describing it as "open[ing] a Pandora's box that will take decades to close."

Cho, *supra* note 161, at 229 (alteration in original) (quoting Cotton—*The "TRIPs and Health" of Cancun?*, 2 BRIDGES DAILY UPDATE ON THE FIFTH WTO MINISTERIAL CONFERENCE, at 2 (Sept. 11, 2003), at [http://www.ictsd.org/ministerial/cancun/wto\\_daily/ben030911.pdf](http://www.ictsd.org/ministerial/cancun/wto_daily/ben030911.pdf)). This issue, among others, led to the collapse of the Fifth WTO Ministerial Conference in Cancun. See *id.* at 225-35 (describing the collapse of the Fifth WTO Ministerial Conference in Cancun); see also Carol Emert, *Politics, Body Parts, and Champagne*, S.F. CHRON., Sept. 25, 2003, at D2 (reporting the failure of WTO conference over the generic use of geographic indications).

of certain European countries.<sup>164</sup> All member nations of the WTO must cease the use of such generic names in connection with the sales and distribution of cheese, meat, and food products that are not produced by European countries.<sup>165</sup> In other words, "mozzarella" cannot be used to describe the mozzarella cheese if the cheese comes from Wisconsin.<sup>166</sup> Different names must be used for mozzarella, parmesan, feta, and gorgonzola if those cheeses are products of geographic regions that are not within the EU.<sup>167</sup>

Specifically, the EU asserts that the global community must grant the protection status of geographic indications to its list of generic names.<sup>168</sup> The EU desires to control the use of the generic names, so once a name is recognized worldwide as a geographic indication, only the nation or region that produces the products of origin has the exclusive right to use the name.<sup>169</sup> Currently,

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164. See Brenda Sandburg, *Food Fight, The E.U. Seeks a Unified System to Register Brand Names*, N.Y.L.J., Aug. 7, 2003, at 5 (reporting the EU's efforts to get a worldwide registry for geographic indicators for its products); Cox, *supra* note 4, at 1B (reporting the EU's agenda to protect generic names for its control of global trade).

165. See Steven Chase, *Canada Battles EU's Proposal to Extend Trade Name Protection*, GLOBE & MAIL, July 30, 2003, at B3 (reporting that Canada and other countries have joined forces to oppose the European Union's agenda of monopolizing generic names for food).

166. See Stephen Clapp, *EU Geographic Indication Initiatives Condemned at House Hearing*, FOOD CHEMICAL NEWS, July 28, 2003, at 7, available at 2003 WL 11733273 (reporting that "U.S. producers and traders of cheeses such as feta, mozzarella, parmesan, brie, cheddar, havarti, muenster and gouda would no longer be able to use these names at home or abroad under the EU proposals").

167. *Hearings, supra* note 3, at 358 (statement of Thomas M. Suber, President, U.S. Dairy Export Council) (stating that the European Union's proposal would "sharply disrupt domestic and export sales of U.S. cheeses with a commensurately negative effect on their U.S. processors and the dairy farmers who supply them," because "names that are considered generic in the United States will no longer be available for use by U.S. agricultural producers").

168. See Gustavo Capdevila, *Trade: "Geographical Indications" A New Snag in Agricultural Talks*, INT'L PRESS SERV., June 12, 2003, 2003 WL 6915682; Fowler & Zalik, *supra* note 163, at 406-07 (stating that European countries have been pushing for extension of geographic indication protection to include products other than wines and spirits).

169. See Fowler & Zalik, *supra* note 163, at 406 (explaining that "a geographical indication for wines and spirits cannot be used on any wines or spirits that do not actually come from the place indicated, even if consumers would not be misled by such use"); Katherine M. Skiba, *EU Proposal Has U.S. Cheesed*, MILWAUKEE J. SENTINEL, Aug. 3, 2003, at 3A, available at 2003 WL 58647122 (reporting that countries will not be able to use the names or their translations to describe such products either domestically or in any other WTO

geographic indication status has only been extended to the category of wines and spirits.<sup>170</sup> The EU insists that the protection must be expanded to food items,<sup>171</sup> specifically a list of forty-one names of which mozzarella, parmesan, feta, and fontina are included, for global recognition and registration as geographic indications.<sup>172</sup> The purposes asserted by the EU are to prevent these names, as exclusively owned by the countries of the EU, from being copied worldwide.<sup>173</sup> Essentially, no other countries could use the generic names domestically or in export markets once the names have received global recognition and registration as geographic indications.<sup>174</sup>

The problem with the EU's proposal springs from the fact that geographical names generally do not identify a single business source or a definite group of business sources;<sup>175</sup> thus, the

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country, for example, the use of the name mozzarella for a certain type of cheese will be prohibited to the United States under the EU's proposal).

170. See Chase, *supra* note 165, at B3 (reporting that the WTO has not agreed to extend geographic indication protection to products beyond wines and spirits); Lindquist, *supra* note 124, at 309-10 (noting the TRIPS Agreement grants protection for wines and spirits).

171. See Alice Slayton Clark et al., *International Trade*, 37 INT'L. LAW. 399, 403 (2002) (stating that "some European nations are pushing for geographic indication protection for other products, such as cheese, and have linked flexibility in agricultural talks to the outcome of talks on geographic indicator protection"); Cox, *supra* note 4, at 1B (providing a list of generic names for food claimed by the EU).

172. See David Joy, *Brussels Sprouts from Idaho?* FOOD PROCESSING, Sept., 2003, at 32, 34 (reporting that the EU seeks to have a high level of protection for the names of their food items, and "envision[s] a multi-national register of geographic indications" whereby once the names are registered, the European nation registrants would become the exclusive users of such names); Lewis & Clapp, *supra* note 3, at 7 (reporting the EU's generic name list would be presented at the WTO ministerial meeting in Cancun, Mexico).

173. See David Williams, *Europe Fights for Parma Ham, Mozzarella Cheese*, AGENCE FR. PRESSE, July 29, 2003, available at 2003 WL 69297493 (stating that the protection for geographic indications is a top concern for the EU at the WTO's meeting because the EU wants the world to stop "copycat abuses" of their names); see also Carolyn Said, *The Label Police, Europeans Are Getting Snippy About Foreigners Using Their Place Names for Food*, S.F. CHRON., Aug. 17, 2003, at I1, available at 2003 WL 3760617 (reporting that the EU wants "the rest of the world" to apply the rule that only products made in a particular region in Europe can carry such names as cheddar and parmesan).

174. See Skiba, *supra* note 169, at 3A (reporting that the EU wants to have the names protected in every WTO country—an "absolute worldwide protection").

175. Trademarks identify to the consumer a specific source, even though the consumer may not know the identity of the source, whereas geographic indications presume that the consumer knows the products are produced by

boundaries of the region that can claim with certainty that it has the right to use the name exclusively are difficult to determine.<sup>176</sup> Indeed, member countries within the EU are in strong disagreement as to which region or country may lay claim to the name "feta."<sup>177</sup> Moreover, since the geographic indications are generic names in many countries, even if the TRIPS member countries recognize and protect such names in compliance, who will actually conduct the efforts to reclaim generic names and establish them as protected names in the minds of the consumers?<sup>178</sup> Generally, in regard to a name that was once known or popular and then became generic, the owner of the name must spend an enormous amount of resources to recapture the name for its own exclusive use.<sup>179</sup> Here, since geographic indications cannot identify a business source or definite group of sources, who will be ultimately responsible for the expenses

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business in a region or country. Further, geographic indications connote specific qualities or characteristics of the region or country, regardless of the specific source or sources within that region. See Maher, *supra* note 25, at 1889 (explaining the differences between geographical indications and trademarks).

176. See Conrad, *supra* note 133, at 12. In his article, Alfred Conrad notes that one of the

notorious problems involved in the protection of geographical names arises from the fact that in most cases they do not identify a single business source (or a definite number of business sources) and therefore it is often difficult to establish the boundaries of the region that can legitimately claim use of the name.

*Id.*

177. See Cox, *supra* note 4, at 1B (reporting that the EU has its own food fight, as Denmark claims to make more feta cheese than Greece, Bulgaria claiming to produce the best feta cheese, and Greece claiming that its feta production dates back to the time of Homer's *Odyssey*); Guy de Jonquieres, *EU Gets In a Stew Protecting Regional Foods*, FIN. TIMES, Aug. 23, 2003, at 5 (reporting that Denmark and Germany objected to Greece's advocating that the name "feta" be labeled as a geographic indication despite feta not being a region).

178. The reclaiming of a once distinctive and popular name is rarely possible. See *Union Nat'l Bank of Tex., Laredo Tex. v. Union Nat'l Bank of Tex.*, Austin Tex., 909 F.2d 839, 846 n.15 (5th Cir. 1990) (stating that although it is possible for a party to recapture a generic term from the public domain, such a feat is rare); Lindquist, *supra* note 124, at 339-40 (discussing the rare instances of reclaiming the generic names of once very popular names such as "Singer" and "Goodyear Rubber").

179. See *Singer Mfg. Co. v. Briley*, 207 F.2d 519, 520 n.3, 521 (5th Cir. 1953) (holding that the trademark "Singer," which the Supreme Court had held generic in 1896, had been "recaptured" from the public domain by continuous and exclusive use and advertising). However, "there is no instance of this happening to an ordinary dictionary word which was always a generic name and never performed a trademark function in its semantic history." MCCARTHY, *supra* note 25, § 12.11.

incurred in the recapturing of the generic names<sup>180</sup> and for preventing consumer confusion due to the prohibition that generic names can no longer be used generically?

#### VII. THE NEW INTERNATIONAL TRADEMARK JURISPRUDENCE AND GLOBAL TRADE

The newly elevated protection for generic names created by the United States and the EU strikes at the core of globalization and trade.<sup>181</sup> Despite the protectionism that may have resonance in the European emphasis on the value of traditional and specialty food items,<sup>182</sup> the real issue behind the expansion of the protection is the trade barrier.<sup>183</sup>

The maneuver in the United States by both federal and state legislatures to prohibit the use of the generic name "catfish" on catfish from outside the United States has been seen as nothing less than trade protectionist practice.<sup>184</sup> The fear that motivated the

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180. See de Jonquieres, *supra* note 177, at 5 (reporting that the EU's proposal of geographic indications for generic names, as viewed by a diplomat, "is just an excuse for producers who are too lazy to build their own brands to get governments to do their work for them").

181. See Dawson, *supra* note 140, at 606 ("The real issue in the genericness debate is whether the multilateral system of trade discipline established by TRIPS and related WTO Agreements gives all countries an equal chance to maintain the trading freedom which genericness confers, a question which is beyond the scope of this article.").

182. The EU's tactics on emphasizing high quality foods and protecting generic names of such foods serve to "block food from countries still producing large quantities of food" and the tactics must be "defended at international level to prevent EU producers losing out on the advantages of such products through copying or misleading labelling [sic]." *Informal Farm Council—EU Agriculture Ministers Push Food Quality*, EUR. REP., May 17, 2003, available at 2003 WL 10440576.

183. See Dawson, *supra* note 140, at 592 (stating that the importance of geographical indications in the export market is the reason for the countries that are home to a "significant number of geographical indications to secure greater international cooperation in affording higher standards of protection"); Michael Woods, *Food for Thought: The Biopiracy of Jasmine and Basmati Rice*, 13 ALB. L.J. SCI. & TECH. 123, 142-43 (2002) (stating that the United States acted hypocritically in passing "a protectionist law that would prevent Third World catfish farmers from competing in the United States").

184. See 147 CONG. REC. S11,876 (daily ed. Nov. 15, 2001) (statement of Sen. McCain) (stating that the federal labeling law on catfish effectively bans all Vietnamese catfish to the United States and, as such, is an "offensive trade barrier"); Miller, *supra* note 15, at 4 (noting that the United States and EU practices of protecting generic names create barriers to free trade and cause underdevelopment); Tobias Nischalke, *Vietnam—US Supports Vietnam's WTO Membership Bid*, W.M.R.C. DAILY ANALYSIS, Aug. 7, 2003, available at 2003 WL 60321432 (describing the U.S. catfish practice as "arbitrary protectionist



enactment of the labeling protection law for the generic name catfish was the importation of catfish from non-U.S. countries at competitive prices.<sup>185</sup> Ironically, the farming and exportation of catfish by other countries to the U.S. market were undertaken at the insistence of the United States as a result of a bilateral trade agreement.<sup>186</sup> This trade protectionist practice restricts the freedom of other countries to use generic names in the flow of goods across borders.<sup>187</sup> Worse yet, the United States has declared, subsequent to its enactment of laws to elevate generic names to a heightened level of protection, that the exportation of catfish from Vietnam to the United States amounted to dumping.<sup>188</sup> Under the anti-dumping

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measures”).

185. See 147 CONG. REC. S11,876 (daily ed. Nov. 15, 2001) (statement of Sen. McCain) (stating that, regarding the labeling catfish law, “[n]o doubt it was inserted on behalf of several large, wealthy U.S. agribusinesses that will handsomely profit by killing competition from Vietnamese catfish imports”); David Rogers, *Add-On Spending Projects Are on Course to Exceed Those of Last Administration*, WALL ST. J., Nov. 9, 2001, at A16 (reporting that “House and Senate negotiators approved a \$75.9 billion agriculture budget adding scores of research projects along with an amendment to help U.S. catfish growers fight off imports from Vietnam”).

186. As Senator McCain stated:

[The new labeling law] patently violate[s] our solemn trade agreement with Vietnam, before the Vietnamese National Assembly has even ratified that agreement . . . . After preaching for years to the Vietnamese about the need to get government out of the business of micromanaging their economy, we have sadly implicated ourselves in the very sin our trade policy claims to reject.

147 CONG. REC. S11,876 (daily ed. Nov. 15, 2001) (statement of Sen. McCain); see also *The Great Catfish War*, *supra* note 14, at A-18 (stating that Vietnam began farming catfish for exportation to the U.S. market at the suggestion of U.S. trade officials).

187. See 147 CONG. REC. S11,876 (daily ed. Nov. 15, 2001) (statement of Sen. McCain) (noting that the new catfish labeling law does not mention a specific country by name, but for the present time, it effectively bans all imported catfish from Vietnam to the United States); Woods, *supra* note 183, at 142-43 (stating that the U.S. law prevents catfish farmers from the Third World from competing freely in the U.S. market).

188. See Notice of Antidumping Duty Order: Certain Frozen Fish Fillets from the Socialist Republic of Vietnam, 68 Fed. Reg. 47909 (Aug. 12, 2003) (ordering antidumping duties for all catfish from Vietnam and postdating the order to catfish imported on or after January 31, 2003). Reports have also stated that

American fishermen have fought back, contending that the Vietnamese fish are not really catfish and persuading Congress to bar the Vietnamese from using that name. The American group is also pressing hard for import duties based on anti-dumping laws.

law, the United States then imposed high tariffs from three to sixty-four percent against catfish exported by Vietnam to the U.S. markets.<sup>189</sup> The United States has effectively destroyed the free trade movement of globalization.<sup>190</sup>

Similarly, the label regulation on the name "sardine" created by the EU is an example of trade protectionist practice. Indeed, the EU passed the regulation to "improve the profitability of sardine production" in Europe "and the market outlets therefor."<sup>191</sup> Even though there are numerous species of sardines and various authoritative referential sources indicate that sardines living outside of Europe are nevertheless sardines,<sup>192</sup> the EU attempted to control the usage of the generic name "sardine" using the pretense of consumer protection.<sup>193</sup> Countries such as Peru, Canada, Chile,

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They have begun a hardball publicity campaign aimed at buyers, calling Vietnamese catfish dirty, even toxic, and definitely un-American.

Seth Mydans, *Americans and Vietnamese Fighting over Catfish*, N.Y. TIMES, Nov. 5, 2002, at A3.

189. Catherine McKinley, *U.S. Charges of Dumping Imports May Lead to Tariffs That Would Hurt Vietnam*, ASIAN WALL ST. J., Jan. 14, 2004, at A6, available at 2004 WL-WSTA 56588520 (reporting that the United States has imposed tariffs of 64% on imported Vietnamese catfish); A. Gary Shilling, *The Protectionist Threat*, FORBES, Nov. 24, 2003, at 268 ("In a wondrous example of hypocrisy, the U.S. accuses Vietnam of unfair trade in catfish—and so justifies a retaliatory tariff on the fish of up to 64%.").

190. See Paul Blustein, *Trade Ruling Favors U.S. Catfish Farmers over Vietnamese*, WASH. POST, July 24, 2003, at E4 (reporting that the trade ruling "will heighten perceptions . . . that the United States doesn't abide by its own free-trade principles").

191. Council Regulation 2136/89, *supra* note 2 ("Whereas the adoption of such standards for preserved sardines is likely to improve the profitability of sardine production in the Community, and the market outlets therefor, and to facilitate disposal of the products . . .").

192. See e.g., WTO Panel Report, *supra* note 9, at annex 2, para. 2.1.1 ("Canned sardines or sardine-type products are prepared from fresh or frozen fish of the following species: *Sardina pilchardus*, *Sardinops melanostictus*, *S. neopilchardus*, *S. ocellatus*, *S. sagax*, *S. caeruleus*, *Sardinella aurita*, *S. brasiliensis*, *S. maderensis*, *S. longiceps*, *S. gibbosa*, [and] *Clupea harengus*"). Peru initiated an action challenging the EU on the labeling law. Indeed, Peru claimed that the name "sardines" is a "generic term used to describe fish belonging to a large group of clupeid marine fish sharing the characteristics of young pilchards, and that until the adoption of the EC Regulation . . . all species of sardines could be marketed under European Communities law as sardines." *Id.* at para. 4.84.

193. Peru contended that the regulation on the labeling of sardines is trade restrictive. *Id.* at para. 4.107 ("In the view of Peru, the EC Regulation is more trade restrictive than necessary."). The EU asserted that the regulation "is part of its legitimate policy to ensure precision in the names of foodstuffs and in

Colombia, Ecuador, and Venezuela have asserted that the regulation is an "unnecessary obstacle to trade" and that reserving a name "exclusively for one particular species" provides the EU a "competitive advantage over other like products because it imposes the use of names with negative connotations, thus bringing down their prices and triggering an adverse reaction on the part of the consumers."<sup>194</sup> These countries opposed the regulation as a trade barrier to the exportation of sardines from their countries, whereby they are prohibited to compete in Europe.<sup>195</sup> Ironically, the United States became one of these third parties, arguing that the regulation is trade restrictive because the United States could not export its sardines to Europe.<sup>196</sup> This demonstrates that the trade barriers negatively impact not only developing countries attempting to export their goods to Europe, but affects developed countries as well.

The United States' catfish labeling laws and the EU's sardine regulation are both prime examples<sup>197</sup> of circumvention of the WTO's

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doing so to preserve quality, product diversity and consumer protection." *Id.* at para. 4.77.

194. *Id.* at para. 5.26, 5.39 ("[T]he different and discriminatory marketing requirement imposed by the EC Regulation disrupts the conditions of competition between these like products in favour of domestic and imported preserved sardines . . ."). Ecuador asserted that "the EC Regulation serves protectionist purposes with trade-distorting effects beyond those already affecting the sector as a result of fisheries subsidies in the form of Community aid to offset marketing costs for products such as sardines." *Id.* at para. 5.56.

195. Among these countries, Peru brought the complaint to the WTO Panel. The other countries submitted their arguments, challenging the regulation and expressing concerns about the trade impact of the regulation on sardines exports. *See id.* at Part V, para. 5.1-5.83.

196. *Id.* at para. 5.70 ("[T]here is no doubt that a measure prohibiting the use of the term 'sardines' in connection with sardine products is trade restrictive."). The WTO Panel Report further provides that

[t]he United States indicates that there are a number of sardine species that are harvested in the United States, but that are not exported to the European Communities because of the restrictive labeling requirements in the European Communities. They are, however, sold to many parts of the rest of the world.

*Id.* at para. 5.60.

197. Additionally, under EU Regulation 2081/92/EEC, there are several thousand names being elevated to special protection as geographic indications for the internal EU. Council Regulation 2081/92 of 14 July 1992 on the Protection of Geographical Indications and Designations of Origin for Agricultural Products and Foodstuffs, 1992 O.J. (L 208) 1, 2; *see also EU/Australia—Challenge to EU Food Indications*, EUR. REP., Apr. 26, 2003, available at 2003 WL 10440312 (reporting that the regulation allows geographic indication protections for 600 food products and 4,000 wines and spirits). The impact reached Australia, which challenged the EU regulation through the WTO's formal dispute mechanism. *Id.* The impact of such regulation,

official process for recognition and protection of geographic indications.<sup>198</sup> In bypassing negotiations with the WTO TRIPS Council on the issue of whether sardines and catfish merit geographic indication status, the European Union and the United States each unilaterally elevated generic names to a higher level of protection.<sup>199</sup> Such efforts are a mockery to the legitimate negotiation process of international agreements on fair trade and the protection of geographic indications as mandated by TRIPS<sup>200</sup> and the subsequent WTO Ministerial Declaration in Doha.<sup>201</sup>

In addition, the EU's latest effort in campaigning for a list of generic names to become globally protected terms of geographic indication through passage of EU regulations for its own internal markets is a desperate tactic of trade manipulation.<sup>202</sup> Indeed, the

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ironically, also hit trading countries such as the United States, whereby companies such as Kraft could not sell American-made parmesan in Europe using the name parmesan. See Cox, *supra* note 4, at 1B (reporting how Kraft lost its export sales in Europe for parmesan cheese).

198. The WTO TRIPS Council is responsible for overseeing negotiations among countries for the recognition of names as geographic indications. WTO Ministerial Declaration, *supra* note 161, at para. 18 (describing the role of the WTO TRIPS Council). These negotiations are strongly tied with trade and are often contentious. See Burkart Goebel, *Geographical Indications and Trademarks—The Road from Doha*, 93 TRADEMARK REP. 964, 976-82 (2003) (analyzing different proposals advanced by different groups of countries with respect to geographic indications).

199. To challenge either the EU regulation or U.S. labeling law, the burden rests on a WTO member state to bring the complaint through the WTO dispute settlement system. Such a challenge is costly. See Frances Williams, *WTO Minnows Cry Foul on Mediation*, FIN. TIMES, Oct. 24, 2002 at P8, available at 2002 WL 101376449 (reporting that the developing countries could not bring cases under the WTO dispute settlement system due to high costs, complexities, and inadequate remedies). Moreover, if a country that is not a WTO member faces the trade barrier as the result of the EU regulation or U.S. labeling law, it will have very little recourse.

200. The TRIPS Agreement provides that member states will engage in negotiations for the protection of geographic indications. TRIPS Agreement, *supra* note 6, at art. 24(1).

201. See Goebel, *supra* note 198, at 965-66 (stating that post-Doha, the WTO members "are currently negotiating or discussing sensitive issues such as the establishment of a multilateral system for the notification and registration of geographical indications").

202. See *Hearings*, *supra* note 3, at 362 (stating that the EU's efforts toward geographic indication protection for generic names is "a push to provide additional leverage to construct market access barriers and protect domestic producers in [the EU] wishing to protect their domestic industry"). The EU could not advance its plan at the last round of the international trade meeting because the Fifth Ministerial Conference in Cancun broke off. See Deborah Haynes, *WTO Panel to Study Dispute by US, Australia with EU over Home*

purpose of rolling back the generic status of names has very little to do with consumer protection.<sup>203</sup> Instead, the reasoning has much more to do with the staking of economic advantages by the European countries from which the geographic indications originate.<sup>204</sup> Here is an illustration: consumers in a country, for example, the United States, know that "parmesan" is the name of a cheese that has a sharp flavor and is often sold in grated form by the U.S. cheese producer Kraft Foods.<sup>205</sup> In fact, the U.S. Trademark Office often requires a disclaimer of the word "parmesan" in trademark registrations because it is a common word.<sup>206</sup> If a European country gains geographic indication status for "parmesan," the U.S. cheese producers will not be able to use the name "parmesan" in the United States or the global market. The cheese producers will have to use a different name, such as "a cheese-with-sharp-flavor-often-sold-as-grated-for-your-pizza-

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*Grown Brands*, AGENCE FR. PRESSE, Oct. 2, 2003, 2003 WL 71500082 (stating that the EU "agreed a list of 41 well-known foodstuffs for which it planned to seek global trade-name protection at the WTO ministerial conference in Cancun last month. But the plan for WTO rules on indications is in limbo due to the collapse of the talks at the Mexican resort").

203. See Bendekgey & Mead, *supra* note 128, at 765-66 (stating that the consumer protection concern invoked by the European countries is no longer valid, because such countries actually sought to "protect the economic value inherent in geographic indications, especially as insufficient protective measures have resulted in certain terms becoming generic").

204. See Goebel, *supra* note 198, at 966 (stating that many WTO members are perceiving "unjustified barriers to trade in products designated with geographical indications"); Gustavo Capdevila, *Trade: 'Geographical Indications' a New Snag in Agricultural Talks*, INTER PRESS SERV., June 12, 2003, 2003 WL 6915682 (reporting that other WTO member nations believe that geographic indication status for generic names is "a form of protectionism" and that the EU only wants to protect its "goods from cheaper products, and divert attention from [the EU's] vast agricultural subsidies").

205. Indeed, Kraft sells sixty million pounds of grated parmesan cheese each year. Kraft stands to lose sales and faces "the risk of alienating [its] consumers and losing them" if the EU's proposed names receive global protection as geographic indications. Cox, *supra* note 4, at 1B. In fact, Kraft is currently prohibited by the European Court from selling Kraft parmesan in the EU under the name "parmesan." *Id.*

206. For example, CHICKEN PARMESAN POPPERS, trademark application ser. no. 75013938; PARMESAN, trademark application ser. no. 73547665; PARMESAN, trademark application ser. no. 78250037; PARMESAN PETITES, trademark application ser. no. 75616686, and GRANDE PARMESAN, trademark application ser. no. 78250030, were all required by the U.S. Trademark Office to make the disclaimer that "[n]o claim is made to the exclusive right to use 'parmesan' apart from the mark as shown." See U.S. Patent & Trademark Office, Trademark Electronic Search System, at <http://tess2.uspto.gov> (last visited Sept. 15, 2004).

spaghetti-lasagna" to market and sell American-made parmesan cheese.<sup>207</sup> Therefore, rolling back names that are generic to the public and elevating the names to globally-protected status is both politically and economically unfeasible.<sup>208</sup> Even though the TRIPS Agreement permits member states, such as the United States in this illustration, not to recognize the geographic names that have become generic, those member states are still required to prevent deception resulting from their use.<sup>209</sup>

Peculiarly, the attempted monopolization of generic names, in the case of cheese and meat products, is not confined to trade conflicts between developed and developing countries, but also between developed countries, as here, the European nations and the United States. This seems to contradict the belief that geographic indications are of benefit to mainly developing countries,<sup>210</sup> as opposed to developed countries like members of the EU that are demanding geographic indication protection for their names. In fact, today, only a very few of the products known by their origin indications are from developing countries.<sup>211</sup>

In sum, all of these new measures strike against the goal of globalization and fair trade development. The TRIPS Agreement was supposed to create trade balance by providing a standard for intellectual property rights, protection, and enforcement; it was

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207. Relabeling products could cost producers millions, and producers may lose consumers who have been long familiar with generic names such as parmesan and feta. See Brenda Sandburg, *Food Fight*, N.Y.L.J., Aug. 7, 2003, at 5 (reporting that for each name the cost of repackaging, relabeling, and reeducating consumers can cost tens to hundreds of millions of dollars).

208. The cost of advertising and educating consumers about the new status of the generic names, along with the cost of selecting new names and repacking and relabeling of products would be very high. See Lindquist, *supra* note 124, at 340 (noting that the advertising efforts to reclaim generic names for EU geographical indications for wines alone would possibly cost billions of dollars); Sandburg, *supra* note 207, at 6 (reporting that each new brand name would cost between \$20 and \$200 million annually). Moreover, some American vineyards may even be forced to close "as a result of [the EU's] reclamation process." Lindquist, *supra* note 124, at 340.

209. Efforts to prevent the rolling back of generic names are underway. See Goebel, *supra* note 198, at 978-84 (commenting on various proposals and positions advanced by groups of countries and the International Trademark Association).

210. See Heald, *supra* note 132, at 655 (stating that undeveloped member countries will benefit from having the exclusivity in geographic indications for the sources of agricultural products).

211. See Conrad, *supra* note 133, at 12-13 ("Although geographical indications are supposedly of growing importance in developing countries, today only very few of the products known by their indication of origin are from these countries." (citations omitted)).

certainly not designed to produce a new standard for heightened protection of generic names as a disguise for trade barriers.<sup>212</sup> The legitimization of generic names as *national* trademarks in the United States and the EU creates trade barriers, as many countries are prohibited from using generic names to describe food products for export to other countries or to be marketed and sold within their own national boundaries.

Presently, the elevation of protection for generic names has caused and will continue to cause more disputes among countries over names, while the real issues of trade barriers are hidden, serving as a subtext of the disputes. Most particularly, the United States, as the world leader, by engaging in the name game does not serve its own national interest.<sup>213</sup> While the United States elevated the word "catfish" to a nationally-protected word for the purpose of suppressing other countries from exporting their catfish products into the United States, the United States faces its own trade barriers from the EU's heightened protection for the word "sardine," prohibiting U.S. sardines from being labeled sardines in Europe.<sup>214</sup> It would be difficult for the United States to condemn the EU and yet persuade the rest of the global community about the benefits of free trade and globalization while catfish remains a stark example of U.S. trade barriers.

Moreover, while the TRIPS Agreement is intended to "reduce distortions and impediments to international trade by promoting adequate protection of intellectual property rights,"<sup>215</sup> the geographic indication provisions undermine that intent. These provisions allow the reclamation of generic names and their elevation to a global status that restricts international trade. Although the provisions allow member states to not recognize a generic name as geographic indication, that permission is confined to the territory of the

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212. See Dawson, *supra* note 140, at 593 (raising concerns about the TRIPS Agreement and its definition of geographical indications, and urging that the "more important agenda for the intellectual property community... is to influence the continuing debate on the scope of protection of geographical indications in a manner which is consistent with intellectual property law generally").

213. See 147 CONG. REC. 158, S11,876 (daily ed. Nov. 15, 2001) (statement of Sen. McCain) (explaining that the new U.S. labeling law fails to serve the national interest, but instead, only a small group of powerful farmers).

214. See 147 CONG. REC. 173-74, S13,247 (daily ed. Dec. 14, 2001) (statement of Sen. Smith of Oregon) (supporting the McCain amendment to repeal the U.S. catfish labeling law because such protectionist law has implications for Oregon sardines which are not allowed to be sold in the European market due to European law).

215. Hoffman, *supra* note 153, at 132.

member state.<sup>216</sup> Thus, the member state cannot use the geographic indication when it attempts to export goods bearing the generic name to other countries, members of TRIPS that recognize the generic name as a geographic indication.

#### VIII. ENDING THE EXPANSIVE PROTECTION

It is time to end the expansive protection for generic names. In legalizing the elevated protection for generic names, both the United States and the European Union create a new form of protected generic trademark, subverting the traditional trademark jurisprudence of many countries, including the United States and member countries of the EU.<sup>217</sup> It is time to return to the established trademark jurisprudence where generic names are never protected under the law.<sup>218</sup> This will encourage the fair

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216. Specifically, the TRIPS Agreement provides that

[n]othing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member.

TRIPS Agreement, *supra* note 6, at art. 24(6).

217. As the Second Circuit has explained,

It is a bedrock principle of the trademark law that no trader may acquire the exclusive right to the use of a term by which the covered goods or services are designated in the language . . . .

The same rule applies when the word designates the product in a language other than English.

*Otokoyama Co. v. Wine of Japan Imp., Inc.*, 175 F.3d at 270 (2d Cir. 1999); see also "Partner With the Best" Trade Mark Application (Case 30 W(pat) 202/95), 1998 ETMR 679, 682, 1998 WL 1076832 (BGH Jan. 27, 1997) (affirming the German Patent Office's rejection of the trademark application "Partner With the Best" on the grounds of lack of distinctiveness as well as the need to keep the phrase freely available for general use).

218. See Trademark Directive, *supra* note 120, at art. 2 (stating that a trademark may consist of "any sign . . . capable of distinguishing the goods or services of one undertaking from those of other undertakings"). Further, the Trademark Directive provides grounds for refusal of registration:

The following shall not be registered or if registered shall be liable to be declared as invalid:

. . . .

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographic origin;

. . . .



competition and consumer protection that are the cornerstones of trademark law.<sup>219</sup>

Fair competition within a nation and across borders requires that generic words continue to be just that—generic words—so the public and competitors can freely use the words to describe and to name articles in commerce.<sup>220</sup> If the consumer views geographic

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(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

*Id.*

U.S. trademark law extends protection only to source identifier trademarks:

The term "trademark" includes, any word, name, symbol, or device, or any combination thereof . . . used by a person, or . . . which a person has a bona fide intention to use in commerce and applies to register . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. § 1127 (2002).

Moreover, U.S. law provides that if a registered trademark becomes the generic name for the goods, the registration may be canceled. *See id.* § 1064(3); TRIPS Agreement, *supra* note 6, at art. 15(1) (providing that a trademark includes "[a]ny sign, or any combinations of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings," and that the term "signs" includes "personal names, letters, numerals, figurative elements, and combinations of colours as well any combination of such signs"); Heald, *supra* note 132, at 639 (stating that the TRIPS definition for trademark "clearly excludes generic 'marks'").

219. *See Otokoyama*, 175 F.3d at 270 (stating that generic marks belong to all because such "rule protects the interest of the consuming public in understanding the nature of goods offered for sale, as well as a fair marketplace among competitors by insuring that every provider may refer to his goods as what they are"); *CES Publ'g Corp. v. St. Regis Publ'ns, Inc.*, 531 F.2d 11, 13 (2d Cir. 1975) ("To allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold [is impermissible because] a competitor could not describe his goods as what they are.").

220. *See Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 861 (3d Cir. 1992) (stating that "[a] trademark holder cannot appropriate generic . . . terms for its exclusive use, and a trademark infringement finding thus cannot be based on the use of a generic . . . term") (quoting *Am. Cyanamid Corp. v. Connaught Labs., Inc.*, 800 F.2d 306, 308 (2d Cir. 1986)). A trademark ceases to be enforceable against others when it loses its significance as an indication of the origin of goods sold by and associated with the mark owner or the mark has become generic. *See In re Montrachet S.A.*, 878 F.2d 375, 376 (Fed. Cir. 1989) ("If through usage MONTRACHET has become the common or generic name of the cheese, and is no longer an indication of source, it would no longer be entitled to trademark status, for generic names are incapable of indicating source."). One Federal District Court summarized the doctrine thus:

[T]he purpose of [trademarks] is to distinguish the seller's particular version of a given type of good. ("Car," for example, is generic;

indications as merely names of products, the names belong to all.<sup>221</sup> Even if the use of the generic names may cause consumer confusion, the use is still permissible, as the generic name receives no protection.<sup>222</sup>

In addition, with respect to geographic terms, through years of use of such terms by the public, many geographic terms become so associated with a product or process that they lose their original meanings and come to represent the product or process alone.<sup>223</sup> Trademark law does not extend exclusive rights to the use of such geographic terms that have become generic words.<sup>224</sup> Examples are Swiss cheese,<sup>225</sup> Worcestershire sauce,<sup>226</sup> Boston baked beans and Brussels sprouts.<sup>227</sup>

Moreover, many generic words are in English or are foreign words that have become part of the English language, including

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"Mustang" is not.) To allow one party to claim a generic name for its exclusive use would be tantamount to granting it a monopoly over the thing it named. Thus trademarks, which guarantee exclusive use, are not granted for generic terms.

Forschner Group, Inc. v. Arrow Trading Co., 904 F. Supp. 1409, 1415 (S.D.N.Y. 1995), *aff'd*, 124 F.3d 402 (2d Cir. 1997).

221. See *In re Montrachet*, 878 F.2d at 375-76 (stating that "[w]hether a term is entitled to trademark status turns on how the mark is understood by the purchasing public," and rejecting the Commissioner's analogy of Montrachet cheese to such names as "feta" or "cheddar," names of kinds of cheeses that are common or generic names); *In re Cooperativa Produttori Latte E Fontina Valle D'Acosta*, 230 U.S.P.Q. (BNA) 131, 133 (TTAB 1986) (finding that newspaper articles and dictionary definitions show that fontina is the generic name of a type of cheese).

222. No individual or entity can appropriate a generic term. This is true even if consumers are confused by a competitor's use of a generic term. See *Soc'y of Fin. Exam'rs v. Nat'l Ass'n of Certified Fraud Exam'rs*, 41 F.3d 223, 225 (5th Cir. 1995) ("Even total confusion, however, is irrelevant if 'CFE' constitutes a 'generic' mark.").

223. See *Boden Prods., Inc. v. Doric Foods Corp.*, 552 F. Supp. 493, 497 (N.D. Ill. 1982) ("There may be some products where the geographic label has lost its meaning entirely and represents a type of product and is thus generic."); MCCARTHY, *supra* note 25, § 14:18 ("Some geographic terms may become so associated with a product or process that the term comes to mean the product or process itself, and cannot function as a trademark to distinguish one seller.").

224. See *Boden Prods., Inc.*, 552 F. Supp. at 497 (discussing cases where courts held geographic terms are generic and not entitled to trademark protection).

225. See *Schweizerische Kaeseunion Bern v. Saul Starck, Inc.*, 293 N.Y.S. 816, 816 (Sup. Ct. 1937) (holding "Swiss cheese" generic).

226. *Lea v. Deakin*, 15 F. Cas. 95 (C.C.N.D. Ill. 1879) (No. 8154) (holding "Worcestershire sauce" generic).

227. See *In re Nantucket, Inc.*, 677 F.2d 95, 102 n.2 (C.C.P.A. 1982) ("A geographic name may also come to describe or identify the type of goods, such as Boston baked beans or Brussels sprouts, regardless of where produced . . .").

many of the names of items advocated by the EU for geographic indication status.<sup>228</sup> The English language in the twenty-first century has become the language of communication and commerce for the global community;<sup>229</sup> thus no person, entity, region, or country should have exclusivity in the English versions of generic names. Both the public and competitors would be rendered speechless.<sup>230</sup>

A less burdensome solution would be the adoption of certification marks for names that are geographic indications. A certification mark means any word, name, or symbol used by a person other than its owner in connection with their goods or services to certify origin, material, mode of manufacture, quality, or other characteristics of such persons' goods.<sup>231</sup> Essentially, if a

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228. See Said, *supra* note 173, at 11 (reporting that the U.S. trade representative at the international trade negotiations has noted that "a lot of the names are in English . . . and I thought that was my language, not some of their [European languages]" ).

229. See *International Review of Trademark Jurisprudence*, 84 TRADEMARK REP. 799, 903 (1994) (noting that because English is the language of the computer business, English terms cannot be considered foreign terms, and thus rejecting the registration of the "Computer Associates" trademark for software (citing BPatG Mitt 1994, 20)); BGH GRUR 1999, 1089 (stating that the court rejected the trademark application "For You" for tobacco products because such words are commonly used in English in tobacco advertising).

230. The TRIPS Agreement contains a provision to exempt member states from recognizing a name as a geographic indication; the burden will rest on such member states to show that such names are not worthy of protection, as they are common or generic in their countries. TRIPS Agreement, *supra* note 6, at art. 24(6). Specifically, the TRIPS Agreement states that

[n]othing in this Section shall require a Member to apply its provisions in respect of a geographical indication of any other Member with respect to goods or services for which the relevant indication is identical with the term customary in common language as the common name for such goods or services in the territory of that Member.

*Id.* The reality remains, however, that although a member state is permitted to refuse recognition within its territory to a foreign geographic indication, it does not mean that the member state will be able to export goods bearing that name to the foreign source of the geographic indication or to any other member state.

231. 15 U.S.C. § 1127 (2000) states:

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 chapter, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or

product is of special quality due to its geographic origin, certification would distinguish the product from others.<sup>232</sup> Examples include Angus beef, Florida citrus, Vidalia onions, Idaho potatoes, and Napa Valley wines.<sup>233</sup> Certification marks have an exclusive certifying organization behind them and must be sought on a country-by-country basis.<sup>234</sup> In the United States, geographical indications may be registered as certification marks with the U.S. Patent and Trademark Office.<sup>235</sup> For example, Idaho and "Grown in Idaho" are certification marks for potatoes.<sup>236</sup> Each mark certifies that "goods so marked are grown in the State of Idaho."<sup>237</sup> The Idaho Potato Commission controls its marks through a licensing system that ensures the quality and geographic authenticity of potatoes by requiring everyone in the chain of distribution, from in-state growers to out-of-state repackers and resellers, to be licensed in order to use the certification marks on their packaging.<sup>238</sup>

The certification mark regime is available for individuals and entities from other countries. For example, Parmigiano-Reggiano for cheese from Italy may be registered as a certification mark to protect and ensure the quality and geographic authenticity of the Italian cheese.<sup>239</sup> Similarly, Roquefort may be registered as a certification mark<sup>240</sup> for products that "ha[ve] been manufactured

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services or that the work or labor on the goods or services was performed by members of a union or other organization.

232. See MCCARTHY, *supra* note 25, § 19:91 ("A certification mark is a special creature created for a purpose uniquely different from that of an ordinary trademark or service mark. It is a mark owned by one person and used by others in connection with their goods or services to certify quality, regional or other origin.").

233. See Skiba, *supra* note 169, at 3A (listing various certification marks in the United States).

234. See *id.* (reporting the differences between certification marks and geographical indications).

235. U.S. Patent and Trademark Office, What Protection Does the United States Offer Geographical Indications?, at <http://www.uspto.gov/web/offices/dcom/olia/globalip/geographicalindication.htm> (last modified Mar. 30, 2004).

236. Idaho Potato Comm'n v. M & M Produce Farm & Sales, 335 F.3d 130, 132 (2d Cir. 2003).

237. *Id.*

238. *Id.*

239. The certification mark for Parmigiano-Reggiano, Reg. No. 1754353, was registered by Consorzio del Formaggio Parmigiano-Reggiano Consortium Italy for the purpose of "promoting the awareness of the use of cheese, from the Parma-Reggio region of Italy, in food dishes." See U.S. Patent & Trademark Office, Trademark Electronic Search System, at <http://tess2.uspto.gov> (last visited Sept. 15, 2004).

240. The Roquefort certification mark, Reg. No. 0571798 was registered by the Community of Roquefort, the Municipality France. See U.S. Patent &

from sheep's milk only, and ha[ve] been cured in the natural caves of the Community of Roquefort, Department of Aveyron, France, in accordance with the historic methods and usages of production."<sup>241</sup>

A certification mark system will adequately protect the interests of those who claim exclusivity in geographic indications for consumer protection purposes. Indeed, certification marks are designed to facilitate consumer expectations of a standardized product, ensuring that a consumer is not confused by the marks on the product.<sup>242</sup> More importantly, unlike the trademark system, the certification mark regime protects the public interest in free and open competition among all the producers, distributors, and sellers of the certified product.<sup>243</sup> The system protects all of the market players involved in the chain of production and distribution of certified products from the influence of the certification mark owner.<sup>244</sup> Also, the certification mark regime aims to "ensure the broadest competition, and therefore the best price and quality, within the market for certified products."<sup>245</sup>

Adopting the certification trademark regime instead of the global geographic indication protection system will achieve the balance of fair competition. The regime rewards the producers of products of certain quality, characteristics, and geography with rights against unfair competition similar to those of trademark

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Trademark Office, Trademark Electronic Search System, at <http://tess2.uspto.gov> (last visited Sept. 15, 2004).

241. *Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 496 (2d Cir. 1962).

242. *See Levy v. Kosher Overseers Ass'n*, 104 F.3d 38, 39 (2d Cir. 1997) ("Certification marks are generally treated the same as trademarks for purposes of trademark law."); *Institut Nat'l des Appellations d'Origine v. Brown-Forman Corp.*, 47 U.S.P.Q. 2d 1875, 1889-90 (TTAB 1998) (holding that the same likelihood of confusion test applied in the context of trademarks also applies to certification marks).

243. The owner of a certification mark "cannot refuse to license the mark to anyone on any ground other than the standards it has set." MCCARTHY, *supra* note 25, § 19.96.

244. The U.S. Code allows cancellation of a certification mark on the grounds that the registrant

does not control, or is not able legitimately to exercise control over, the use of such mark, or . . . engages in the production or marketing of any goods or services to which the certification mark is applied, or . . . permits the use of the certification mark for purposes other than to certify).

15 U.S.C. § 1064 (2002)

245. *Idaho Potato Comm'n v. M & M Produce Farm & Sales*, 335 F.3d 130, 138 (2d Cir. 2003); *see also* 15 U.S.C. § 1064 (providing that the certification mark registration may be cancelled if the holder "discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies").

owners. And yet the regime does not facilitate the taking of generic names necessary to competitors to conduct their businesses. Competitors and the public freely use generic names to describe products. The regime provides certainty and accountability, as the identity of the certification trademark holder and members are transparent.

Without adopting a system similar to the certification trademark regime, the alternative is the current system of global recognition and registration of geographic indications which have become embroiled in contentious and protracted negotiations, while eroding the fundamental basis of trademark law to accommodate the heightened level of protection for generic names. Such a system will reward those who for years did not claim any rights to geographic indications, and where the geographic indications had long ago lost their source of significance. Such a system will reward those who do not want to spend resources to build goodwill and recognition in the public mind, but want a free ride by having the government do the work for them, by using the legal system to take generic names from the public and competitors.

#### IX. CONCLUSION

The recent WTO Fifth Ministerial Conference's failure is a wake-up call for further examination of the irrational demand for the protection of generic names. To achieve fair trade by having a standard protection for intellectual property globally requires an end to geographic indication protection for generic names. Trademark law grants no protection to generic names. Unfair competition grants no special protection to generic names. Likewise, international trademark law must not tolerate an expansion of generic names to a globally protected new form of intellectual property rights.

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