

# The Trademark Reporter®



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Trademarks and the Brain: Neuroscience and the Processing of Non-literal Language

*Sandra M. Virtue, PhD, and Darren S. Cahr*

*U.S. Law of Geographical Trademarks, "Google Effects," Historical Developments, and U.S. International Obligations: Proposal for Changes to the Lanham Act*

*Marketa Trimble*

# INTERNATIONAL TRADEMARK ASSOCIATION

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675 Third Avenue, New York, NY 10017-5704

Telephone: +1 (212) 642-1700

email: [wknox@inta.org](mailto:wknox@inta.org)

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# The Trademark Reporter®

## TRADEMARKS AND THE BRAIN: NEUROSCIENCE AND THE PROCESSING OF NON-LITERAL LANGUAGE

*By Sandra M. Virtue, PhD,\* and Darren S. Cahr\*\* \*\*\**

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\* Sandra M. Virtue, PhD, is a Professor of Psychology and Neuroscience at DePaul University.

\*\* Darren S. Cahr is a partner at Scharf Banks Marmor LLC, Member, International Trademark Association (INTA).

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## I. INTRODUCTION

Courts, Congress, and academics have long struggled with inferences about consumer perception necessary to justify much of modern trademark law. Originating as a form of consumer protection, the existence of trademark rights in the United States has ultimately been defined by the perceptions of an aggregate of relevant individuals. Collectively, the experiences of these consumers, not only the trademark itself, give meaning as to what a trademark actually “is.”<sup>1</sup>

While the registration processes offered by the Lanham Act (and, historically, by statute in individual states) play an important role in establishing the scope of rights in source designations from an administrative and procedural perspective, the existence and strength of a trademark has long been determined by external conclusions about the cognitive processing of individual consumers. A trademark is not necessarily what the trademark claimant decides it to be; it is what the consumer purportedly experiences, as interpreted, in turn, by others.<sup>2</sup> So how do we know whether a consumer experiences something as a trademark or as just another word? Our inquiry, filtered through the perspectives of both a researcher who focuses on the neural processing of text and non-literal language, and a trademark practitioner, is simple: can recent advances in neuroscience provide us with a more meaningful understanding of trademarks and how they function, beyond the results of self-reported consumer surveys and linguistic analyses? We strongly agree with one author who stated that neuroscience “holds the potential for new insights into how human beings perceive and make decisions about commercial symbols, something at the heart of trademark law.”<sup>3</sup>

## II. DEFINING A TRADEMARK

Superficially, the task of defining a trademark seems simple: it is “any word, term, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify or distinguish his or her goods . . . from those manufactured or sold by others and to indicate

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<sup>1</sup> Despite broad judicial acceptance of this purported consumer-focused framework, recent critiques have argued that the pursuit of empirical assessment of market perceptions in trademark law has been no more than a substitute for the adoption of meaningful normative social policy values, while recognizing the need to improve and refine empirical methods in light of existing judicial frameworks. *See, e.g.*, Graeme B. Dinwoodie, *Trademark Law and Social Norms* (Sept. 5, 2006), available at <https://ssrn.com/abstract=3609377>.

<sup>2</sup> *See* Deborah R. Gerhardt, *Consumer Investment in Trademarks*, 88 N.C. L. Rev. 427, 450-458 (2010).

<sup>3</sup> Mark Bartholomew, *Neuromarks*, 103 Minn. L. Rev. 521, 528 (2018).

the source of the goods, even if that source is unknown.”<sup>4</sup> A trademark is just a means of identification—when used in commerce it serves to communicate information about the unique entity that is the source of a product or service.

But, upon closer examination, this definition is unsatisfying and circular. In a common example used to explain trademark function, we are reminded that the same word “Apple” can exist as a trademark for computers and as a generic term for a kind of fruit.<sup>5</sup> A slogan such as “Just do it” can be a strong trademark in one context for athletic apparel or a declarative sentence in another. But while there are a variety of functional cues that can be used to determine whether a word or phrase is intended to be used as a trademark, or whether consumers can be reasonably confident that what is being presented to them is *supposed* to be a trademark, the key question is still whether consumers actually *are* perceiving it as a trademark.<sup>6</sup>

For that reason, the question of whether a purported trademark actually functions as one has long been measured through consumer surveys or studies of real-world language usage as compiled in large datasets—also known as “corpus linguistics.”<sup>7</sup> While these surveys and linguistic analyses have been informed by developments in cognitive psychology, they have generally relied on linguistic cues, testing structure, and formats that measure consumers’ conscious processing (i.e., explicit perceptions) to mimic the experience of market conditions.<sup>8</sup>

The potential for neuroscience to provide novel insights into how we understand the meaning of a “trademark” is not new and has been the subject of a variety of prior, often deeply insightful inquiries over the past two decades.<sup>9</sup> There have even been sophisticated efforts made to understand the significance of

<sup>4</sup> United States Trademark Act of 1946, as amended (the “Lanham Act”), § 45, 15 U.S.C. § 1127.

<sup>5</sup> And yet, in some instances, even naming computer programs after another fruit can be deemed to be infringing activity. *See, e.g.*, *Apple Computer, Inc. v. Formula Int’l Inc.*, 725 F.2d 521 (9th Cir. 1984).

<sup>6</sup> *See* Alexandra Roberts, *Trademark Failure to Function*, 104 Iowa L. Rev. 1977 (2019).

<sup>7</sup> *See* Jake Linford & Kyra Nelson, *Trademark Fame and Corpus Linguistics* (May 19, 2021), available at <https://ssrn.com/abstract=3849635>.

<sup>8</sup> *See, e.g.*, Jerre N. Swann, *A “Reading” Test or a “Memory” Test: Which Survey Methodology Is Correct?*, 95 TMR 876 (2005).

<sup>9</sup> *See, e.g.*, Rebecca Tushnet, *Gone in 60 Milliseconds: Trademark Law and Cognitive Science*, 86 Tex. L. Rev. 507 (2008); Mark Bartholomew, *Neuromarks*, 103 Minn. L. Rev. 521 (2018); Jacob Jacoby, *The Psychological Foundations of Trademark Law: Secondary Meaning, Genericism, Fame, Confusion and Dilution*, 91 TMR 1013 (2001); Barton Beebe, Roy Germano, Christopher Jon Sprigman & Joel H. Steckel, *The Science of Proving Trademark Dilution*, 109 TMR 955 (2019).

trademark function through the lens of metaphor.<sup>10</sup> But despite these important steps, neuroscientists and trademark lawyers have only just begun to coordinate their inquiries, and one place where the potential for collaboration shows particular promise is in the analysis of trademarks and the processing of non-literal language.

### III. TRADEMARKS AND THE BRAIN

To better understand how individuals process trademarks, it is necessary to examine the corpus of experimental research in the field of neuroscience as it relates to advertising and marketing. The reason for this is critical: methodologies commonly used in neuroscience research can allow us to make conclusions about the implicit, or unconscious, processing of “trademarks” not usually possible through most behavioral methods (such as surveys, free recall, or self-reporting measures, etc.). For example, one study shows different physiological responses to words associated with two different brands—responses that are not evident when researchers use self-reporting measures.<sup>11</sup> Neuroscience research enables us to examine the specific neural substrates in the brain and their corresponding cognitive processes that are invoked when a consumer perceives and interacts with a “trademark.”<sup>12</sup> By demonstrating that different neural activity occurs when a “trademark” or branded interaction is engaged, these results can suggest that unique processing is occurring in these distinct brain structures.

The promise that research from empirical fields such as neuroscience could finally reveal the inner workings of branding

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<sup>10</sup> Dustin Marlan, *Visual Metaphor and Trademark Distinctiveness*, 93 Wash. L. Rev. 767 (2018). The “function” of a trademark in advertising as being analogous to the function of a metaphor—as a basket of associations carrying meaning in a non-literal manner—has also been explored in the context of social science. See, e.g., Xianrong Zhang, and Xingliang Gao, *An Analysis of Conceptual Metaphor in Western Commercial Advertisements*, 5 Asian Soc. Sci. 97-104 (2009).

<sup>11</sup> Flavio Camarrone & Marc M. Van Hulle, *Measuring brand association strength with EEG: A single-trial N400 ERP study* (June 10, 2019), available at <https://journals.plos.org/plosone/article?id=10.1371/journal.pone.0217125>.

<sup>12</sup> Several different neuroscience methodologies can be useful understanding the neural substrates involved in trademarks. For example, divided visual field (“DVF”) studies can isolate processing advantages during consumer interaction with branded communication that occurs in either the left or right cerebral hemispheres (i.e., showing cerebral hemisphere specializations). Electroencephalograms (“EEGs”) can provide measurements of electrical activity in the brain that occurs at specific times (i.e., with high temporal resolution) during the comprehension of a trademark or brand-specific identifiers, and functional magnetic resonance imaging (“fMRI”) studies can measure neural activity in specific areas of the brain (i.e., with high spatial resolution) as individuals view different trademarks. For a more detailed review of relevant neuroscience methodologies, see Sandra Virtue & Brian Sundermeier, *What Can Neuroimaging Research Tell Us About Inference Generation during Text Comprehension*, 10(6) Language & Linguistics Compass 257-271 (2016).

generates a persistent hope that this discipline could one day enrich our understanding of trademark law. For example, some propose that the need for trademark dilution protection might be explained through a common measurement in cognitive psychology called “spreading activation”—or the activation of related concepts in the mind of the individual while viewing a trademark.<sup>13</sup> Other authors discuss the importance of using cognitive processing models to better understand the exact nature and harm of trademark dilution<sup>14</sup> and trademark confusion.<sup>15</sup> One study empirically tests this idea and found that when participants were presented with purportedly diluting ads, decreases in accuracy and slower response times were evident when linking brands with their appropriate category and attributes.<sup>16</sup>

Expanding upon these initial efforts, researchers propose other ways to potentially incorporate not only cognitive psychology, but also neuroscience (or brain-based) research into normative discussions of what trademark law should be, in a broader sense. For example, at least one paper discusses how behavioral research on the repetition of advertisements can be closely linked to neuroscience research showing changes in the brain after repetitive simulation.<sup>17</sup>

In fact, a lack of interdisciplinary communication has meant that legal academic investigators have missed, or misunderstood, a vast amount of existing research on the processing of branded communication in the field of neuroscience. Many of the conclusions we can reach today permit us to begin the long-necessary process of considering whether empirical methods can demonstrate when language is actually functioning as a trademark, and why. To begin, we will focus on research within the field of neuroscience that will be especially useful for understanding how individuals process trademarks: the neural processing of brands.

Neuroscience research shows that different brands are often processed differently in the brain. For example, functional magnetic resonance imaging (“fMRI”) evidence, which measures brain activity by detecting changes associated with cerebral blood flow while an individual is engaged in a task, shows unique patterns of neural activity when different brands are presented to

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<sup>13</sup> See Timothy Greene, *Trademark Hybridity and Brand Protection*, 46 Loy. U. Chi. L.J. 75 (2014); Jacoby, *supra* note 9.

<sup>14</sup> See, e.g., Tushnet, *supra* note 9; Jacoby, *supra* note 9.

<sup>15</sup> Jerre Swann, *An Interdisciplinary Approach to Brand Strength*, 96 TMR 943 (2006).

<sup>16</sup> Maureen Morrin & Jacob Jacoby, *Trademark Dilution: Empirical Measures for an Elusive Concept*, 19(2) J. Pub. Pol’y & Mktg. 265-76 (2000).

<sup>17</sup> Tushnet, *supra* note 9.



participants.<sup>18</sup> Some researchers propose that findings such as these could potentially be used as unique “neuromarks” in the future, which may even include an emotional component of the consumer for the specific trademark.<sup>19</sup> For example, brain regions associated with pleasurable responses and rewards (e.g., ventromedial prefrontal cortex or “vmPFC”) show greater neural activity when participants saw brands they preferred<sup>20</sup> and when participants judged the usefulness versus the preference for a brand during an fMRI study.<sup>21</sup> Similarly, some neuroscientists propose that individuals’ emotions likely determine how we evaluate different brands. For example, one study shows greater neural activity in Broca’s area (i.e., the motor speech area of the brain) for brands that were rated as unfamiliar and weak than for brands that were rated as familiar and strong when participants viewed images of a brand (containing both the brand name and the logo of the brand).<sup>22</sup> Thus, this distinct neural activity provides evidence that consumers are processing unfamiliar and weak brands differently from familiar and strong brands, which could have huge implications for a consumer’s memory for these types of brands, their level of purchase intent, etc. The neuroscience research on emotion has been extended into investigations of brand betrayal (thought to occur when a consumer had a previous connection to a brand that was fractured due to a moral violation of the brand) and brand dissatisfaction.<sup>23</sup> Interestingly, one study shows different neural correlates (i.e., dorsolateral prefrontal cortex, insula, caudate body, angular gyrus, and the caudate tail) when participants rate a brand high in brand betrayal compared with when participants rate a brand high in brand dissatisfaction (i.e., orbitofrontal cortex and the anterior cingulate cortex).<sup>24</sup> Different neural processing for brand betrayal and brand dissatisfaction is important in demonstrating that these

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<sup>18</sup> Yu-Ping Chen, Leif D. Nelson & Min Hsu, *From “Where” to “What”: Distributed Representations of Brand Associations in the Human Brain*, 52(4) *J. Mktg. Rsch.* 453, 455 (2015).

<sup>19</sup> Bartholomew, *supra* note 3, at 525.

<sup>20</sup> Samuel M. McClure, Jian Li, Damon Tomlin, Kim S. Cypert, Latane M. Montague & P. Read Montague, *Neural correlates of behavioral preference for culturally familiar drinks*, 44(2) *Neuron* 379-87 (2004); Martin Reimann, Deborah J. MacInnis, Valerie S. Folkes, Arianna Uhalde & Gratiana Pol, *Insights into the experience of brand betrayal: From what people say and what the brain reveals*, 3(2) *J. Ass’n for Consumer Rsch.* 240-54 (2018).

<sup>21</sup> Sam Al-Kwafi, Zafar U. Ahmed & Dina Yammout, *Brand switching of high-technology capital products: how product features dictate the switching decision*, 23(4/5) *J. Prod. & Brand Mgt.* 322-32 (2014).

<sup>22</sup> Franz-Rudolf Esch, Thorsten Möll, Bernd Schmitt, Christian E. Elger, Carolin Neuhaus & Bernd Weber, *Brands on the Brain: Do Consumers Use Declarative Information or Experienced Emotions to Evaluate Brands?*, 22(1) *J. Consumer Psychol.* 75-76 (2012).

<sup>23</sup> Reimann et al., *supra* note 20, at 240-54.

<sup>24</sup> *Id.*

are unique, independent concepts, both of which need to be considered when investigating similar issues in future neuromarketing studies. Thus, the current literature investigating the neural processing of emotions in advertisements suggests that the use of neuroimaging methodologies is essential for a more complete framework to better understand how individuals process and categorize trademarks.

Neuroimaging studies have also shown different neural activity when participants focus on more functional appeals of an advertisement (i.e., the utilitarian purpose of the product) compared with when participants focus more on the experiential appeal of an advertisement (i.e., the emotional, sensory, or experiential value of the product).<sup>25</sup> Interestingly, brands that are rated more psychologically similar to one another (from participants' familiarity and preference ratings) show similar neural activity in areas throughout the brain (e.g., inferior frontal gyrus, premotor cortex, visual cortex, and the anterior and posterior cingulate gyrus).<sup>26</sup> These neuroscience findings suggest that trademarks may consist of unique characteristics that enable consumers to differentiate between them.

#### IV. TRADEMARKS AS NON-LITERAL LANGUAGE

Because trademarks are representations of much more than merely the information explicitly stated in the trademark and often contain semantically ambiguous information (i.e., information that can be interpreted in multiple ways), research on non-literal language (e.g., metaphors, idioms, etc.) and the brain can also be informative to help us better understand how individuals comprehend trademarks. Specifically, consumers likely process several meanings of a trademark and then select the appropriate meaning during processing. For example, when consumers are given a trademark such as MIRAGE, they must activate both the literal meaning (e.g., which could reasonably be “an optical effect that . . . that is caused by the bending or reflection of rays of light by a layer of heated air of varying density” or “something illusory and unattainable”)<sup>27</sup> and an implied meaning (e.g., perhaps “something too good to be true”), and then select the appropriate meaning suggested by the usage of the term as a brand (e.g., perhaps “something unworldly that appears unattainable to the masses, but is offered to the chosen few who are willing to pay the price”). This

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<sup>25</sup> Linda E. Couwenberg, Maarten A.S. Boksem, Roeland C. Dietvorst, Loek Worm, Willem J.M.L. Verbeke & Ale Smidts, *Neural responses to functional and experiential ad appeals: Explaining ad effectiveness*, 34(2) *Int'l J. Rsch. Mktg.* 355-66 (2017).

<sup>26</sup> Chen et al., *supra* note 18, at 453-66.

<sup>27</sup> “Mirage.” *Merriam-Webster.com Dictionary*, Merriam-Webster, <https://www.merriam-webster.com/dictionary/mirage>. Accessed Aug. 10, 2022.

involves complex cognitive processing, likely similar to how individuals process non-literal language during text comprehension. Therefore, we can use research on non-literal language (and specifically neuroscience research) to tell us more about how consumers implicitly process and understand trademarks.

Neuroscience findings are consistent with and expand upon previous behavioral studies in that they demonstrate that non-literal language is processed differently from literal language in the brain. For example, there is meaningful research showing that the right hemisphere of the brain plays a key role during the processing of metaphors,<sup>28</sup> idioms,<sup>29</sup> and sarcastic text.<sup>30</sup> In addition, researchers show greater neural activity within the frontal gyrus when participants generate metaphors<sup>31</sup> and idioms.<sup>32</sup> Thus, neuroscience findings provide converging evidence for the idea that non-literal language is processed differently in the brain from literal language, which we believe would extend to the processing of trademarks as well.

To more closely link non-literal language and neuroscience to our understanding of trademarks, we can look to the limited neuroscience research that investigates the neural processing of non-literal languages in advertising. Research conducted with patients who have frontal lobe damage shows that they are able to provide the explicit meanings of advertisements (i.e., the literal meaning of the advertisement). These patients, however, perform worse when determining the inferred messages of these

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- <sup>28</sup> Stephen W. Briner, Michael C. Schutzenhofer & Sandra M. Virtue, *Hemispheric processing in conventional metaphor comprehension: The role of general knowledge*, 114 *Neuropsychologia* 101-09 (2018); Nira Mashal, Miriam Faust, & T. Hendler, *The role of the right hemisphere in processing nonsalient metaphorical meanings: Application of principal components analysis to fMRI data*, 43(14) *Neuropsychologia* 2084-2100 (2005).
- <sup>29</sup> Stephen W. Briner & Sandra M. Virtue, *Hemispheric processing of idioms: The influence of familiarity and ambiguity*, 28 *J. Neurolinguistics* 1-18 (2014).
- <sup>30</sup> Stephen W. Briner, Laura Motyka Joss & Sandra M. Virtue, *Hemispheric processing of sarcastic text*, 24(4) *J. Neurolinguistics* 466-75 (2011); S.G. Shamy-Tsoory, R. Tomer & J. Aharon-Peretz, *The neuroanatomical basis of understanding sarcasm and its relationship to social cognition*, 19(3) *Neuropsychology* 288 (2005).
- <sup>31</sup> Mathias Benedek, Roger Beaty, Emanuel Jauk, Karl Koschutnig, Andreas Fink, Paul J. Silvia, Beate Dunst & Aljoscha Neubauer, *Creating metaphors: The neural basis of figurative language production*, 90 *NeuroImage* 99-106 (2014); Michele T. Diaz, Kyle T. Barrett & Larson J. Hogstrom, *The influence of sentence novelty and figurativeness on brain activity*, 49(3) *Neuropsychologia* 320-30 (2011); Zohar Eviatar & Marcel Adam Just, *Brain correlates of discourse processing: An fMRI investigation of irony and conventional metaphor comprehension*, 44(12) *Neuropsychologia* 2348-59 (2006); Susan S. Lee & Mirella Dapretto, *Metaphorical vs. literal word meanings: fMRI evidence against a selective role of the right hemisphere*, 29(2) *NeuroImage* 536-44 (2006).
- <sup>32</sup> Francesca M. M. Citron, Cristina Cacciari, Jakob M. Funcke, Chun-Ting Hsu & Arthur M. Jacobs, *Idiomatic expressions evoke stronger emotional responses in the brain than literal sentences*, 131 *Neuropsychologia* 233-48 (2019); Leonor J. Romero Lauro, Marco Tettamanti, Stefano F. Cappa & Costanza Papagno, *Idiom comprehension: a prefrontal task?*, 18(1) *Cerebral Cortex* 162-70 (2008).

advertisements (i.e., the implied or abstract meaning of the advertisement).<sup>33</sup> This finding is consistent with other research showing that frontal lobe lesions (or damage) in the brain cause difficulties during the comprehension of complex language that involves a hidden meaning, but not during the understanding of simple sentences. For example, individuals with frontal lobe damage cannot understand the sarcastic (or implied) meaning of “What a great football game,” stated during a poor football game.<sup>34</sup> These studies suggest that specific brain areas (e.g., the frontal lobe) may play an essential role when individuals need to extract implicit meanings from advertisements or trademarks. In addition, evidence from a divided visual field study, which measures the time it takes participants to respond to information (such as a word or image) presented to either the left visual field–right hemisphere or the right visual field–left hemisphere, shows that the right hemisphere of the brain has an advantage for processing literal advertisements (e.g., *These jeans are environmentally friendly.*) compared with metaphoric advertisements (e.g., *These jeans are green.*) when individuals are presented with familiar brand names (e.g., LEVPS).<sup>35</sup> This difference in hemispheric processing suggests that familiar trademarks may provide individuals with more context (or background information), leading individuals to process advertisements in a different manner from when a familiar trademark is not present. Thus, research with brain-damaged and non–brain-damaged individuals helps establish that processing of non-literal and literal language in the brain does help inform us about how trademarks are processed.

Although previous neuroscience research on brand processing and non-literal language can help us understand how consumers comprehend trademarks, new neuroscience research is needed to develop a more comprehensive understanding of how individuals develop and use trademarks. For example, the taxonomy of trademark distinctiveness, or source indication, could be investigated more closely using neuroimaging methodologies. Specifically, individuals could view lexical and non-lexical signs in a trademark (as investigated by Lee, et al.)<sup>36</sup> to determine if

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<sup>33</sup> Samantha Pearce, Skye McDonald & Max Coltheart, *Interpreting ambiguous advertisements: The effect of frontal lobe damage*, 38(2) *Brain and Cognition* 150-64 (1998).

<sup>34</sup> Skye McDonald, *Differential pragmatic language loss after closed head injury: Ability to comprehend conversational implicature*, 13(3) *Applied Psycholinguistics* 295-312 (1992).

<sup>35</sup> Kristy Vance & Sandra M. Virtue, *Metaphoric advertisement comprehension: The role of the cerebral hemispheres*, 10(1) *J. Consumer Behaviour* 41-50 (2011); Kristy Vance & Sandra M. Virtue, *Brand familiarity in advertisement slogans: The role of the left and right cerebral hemispheres*, 3(3) *Int'l J. Mktg. Studies* 42-55 (2011).

<sup>36</sup> Thomas R. Lee, Eric D. DeRosia & Glenn L. Christensen, *An Empirical and Consumer Psychology Analysis of Trademark Distinctiveness*, 41 *Ariz. St. L.J.* 1033 (2009).

different brain areas are uniquely involved with each aspect of a trademark. In addition, neuroscience research could more closely investigate the differential distinctiveness, or strength, of trademarks. In particular, researchers could investigate how specific trademark characteristics such as visual perceptibility, graphical representation, distinctiveness, and non-genericness (as previously examined by Naumovski<sup>37</sup>) are processed in the brain.

Finally, to understand the complex process of how individuals understand trademarks from a neuroscience approach, it is necessary for future studies to take into account not only the specific trademark of interest (e.g., the linguistic and non-linguistic aspects of the trademark, etc.), but also the processing constraints and abilities of the individuals who are viewing the trademark (e.g., their working memory capacity, their background or level of expertise with the topic, etc.). Thus, future neuroscience studies could isolate the specific neural substrates and corresponding cognitive processes involved in processing different aspects of trademarks, helping us develop both stronger theoretical and empirical models of how trademarks are created and maintained over time.

## V. CONCLUSION

By more closely examining the neuroscience research on the non-literal and literal language of brands, we have demonstrated how the field of neuroscience can make a unique contribution to our understanding of trademarks and how they function, and perhaps provide practitioners with new tools for measuring trademark significance. Although we have previously learned a great deal about trademarks through behavioral research, there are limits, and early results from neuroscience-specific studies suggest that trademarks, in ways similar to other forms of non-literal language, can have several meanings and that these meanings can be processed differently in the brain. The practical implications of these findings are dramatic and call for additional investigation. Future research can and should explore the significance of neurological brand recognition in light of the assumptions made by consumers in what recent scholarship has identified as literal (and often physical) “trademark spaces,” places on packaging or in advertising where consumers are trained to expect words with trademark significance.<sup>38</sup> Are marks embedded in a logo or design

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<sup>37</sup> Goce Naumovski, *Relations between quality of trademarks and cognitive and conative variables of consumers*, Law. Université de Strasbourg, 2018. English. ffNNT: 2018STRAA003ff. fftel-02056339, available at <https://tel.archives-ouvertes.fr/tel-02056339>.

<sup>38</sup> Mark A. Lemley & Mark P. McKenna, *Trademark Spaces and Trademark Law's Secret Step Zero* (Jan. 28, 2022), available at <https://ssrn.com/abstract=4020571>.

format, or with color, processed differently from marks appearing in simple text? Does processing change in a substantive manner when a mark is seen multiple times? And is a mark's distinctiveness "proven" to consumers neurologically with greater exposure? Are descriptive marks that have acquired distinctiveness through years of promotion and exposure processed differently from suggestive marks that are intended to be metaphorical? It goes without saying that the neurological processing of unconventional trademarks could reveal significant insight into the ways we view distinctiveness when considering everything from product configuration and packaging to sound and scent marks.

For decades, courts, brand owners, and competitors alike have had to resort to the legal equivalent of a divining rod in order to guess whether a trademark was distinctive inside an assortment of minds. The deference (or lack of deference) given to trademark protectability depending on abstract classifications of its distinctiveness is disconnected from the measurable impact of a trademark on the brain of a relevant consumer. If brands are like poems—and thus pregnant with meanings our minds disentangle to designate their source—then neuroscience will play an important role in providing a more solid empirical basis for the future of trademark law.

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**U.S. LAW OF GEOGRAPHICAL TRADEMARKS,  
“GOOGLE EFFECTS,” HISTORICAL  
DEVELOPMENTS, AND U.S. INTERNATIONAL  
OBLIGATIONS: PROPOSAL FOR CHANGES TO THE  
LANHAM ACT**

*By Marketa Trimble\**

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\* Samuel S. Lionel Professor of Intellectual Property Law, William S. Boyd School of Law, University of Nevada, Las Vegas. The author thanks for their comments and suggestions Professor Robert Brauneis and Professor Lisa Ramsey, and for their research support Professor Jeanne Price and Associate Professor Youngwoo Ban of the Wiener-Rogers Law Library at the William S. Boyd School of Law. The author is indebted to the editors of *The Trademark Reporter* and to Gary A. Trimble for their invaluable editing suggestions.

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## INTRODUCTION

The U.S. law of geographical trademarks<sup>1</sup> has perplexed commentators for decades,<sup>2</sup> leading to a great deal of criticism and various proposals to change the rules concerning geographical trademarks.<sup>3</sup> This continuing interest in geographical trademarks is understandable; the use of geographical names is a helpful trademarking tool for a number of reasons, and consumers benefit significantly from the information that geographical trademarks provide.<sup>4</sup> However, granting exclusive rights to geographical trademarks may be problematic because a monopolization of geographical names<sup>5</sup> can harm competition among legitimate users of identical geographical names.<sup>6</sup> It therefore seems appropriate that the Lanham Act treats geographical marks as a separate category of marks; a mark is categorized as geographical if the mark refers to a geographical location that is a “generally known

<sup>1</sup> This article uses the term “geographical trademarks,” rather than “geographic trademarks.” “Geographic” and “geographical” are interchangeable, and both are used in the trademark context—for example, “geographic certification marks” in the Trademark Manual of Examination Procedure (8th ed. July 2021) (“TMEP”) § 1306.05, “geographical designations” in TMEP § 1210.08, “geographic marks” in the title of J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 14:26 (5th ed. 2022), “geographic marks” in the title of McCarthy Chapter 14, both “geographic marks” and “geographical marks” in the same sentence in *In re The Newbridge Cutlery Co.*, 776 F.3d 854, 858 (Fed. Cir. 2015).

<sup>2</sup> “[T]he treatment of geographic names under the trademark laws has experienced unusual bouts of revision, uncertainty, and pendulum swings.” Alan L. Durham, *Trademarks and the Landscape of Imagination*, 79 Temp. L. Rev. 1181, 1182 (2006).

<sup>3</sup> *E.g.*, Mary LaFrance, *Innovations Palpitations: The Confusing Status of Geographically Misdescriptive Trademarks*, 12 J. Intell. Prop. L. 125 (2004); Robert Brauneis & Roger E. Schechter, *Geographic Trademarks and the Protection of Competitor Communication*, 96 TMR 1 (2006); Durham, *supra* note 2; Signe H. Naeve, *Chief Judge Rader’s Material Contribution to Geographic Indicator Analysis*, 7 Wash. J. L. Tech. & Arts 467, 469 (2012).

<sup>4</sup> See *infra* Part 1, Section 1 on the different functions of geographical marks.

<sup>5</sup> The monopolization problem may also concern marks other than word marks. See *infra* Part I, Section 1, for a discussion of the different types of geographical marks.

<sup>6</sup> Brauneis & Schechter, *supra* note 3, at 2. In some countries, marks that *may* designate the geographical origin of particular goods or services cannot be registered. See, *e.g.*, Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, OJ 2017 L 154/1, Article 7(1)(c). According to the Court of Justice of the European Union, “that provision pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is sought may be freely used by all, including as collective marks or as part of complex or graphic marks.” *Bundesverband Souvenir—Geschenke—Ehrenpreise eV v. EUIPO*, CJEU, C-488/16P, Sept. 6, 2018, ECLI:EU:C:2018:673, para. 36. However, even under the EU Regulation, the mark may be registered if “the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it.” Regulation (EU) 2017/1001, Article 7(3).

geographic location.”<sup>7</sup> If a mark passes this test, it is then subject to the geographical marks–specific provisions of the Lanham Act.

This article argues that within the context of current trademark law, there is no reason to maintain the separate Lanham Act provisions for geographical marks. None of the historical origins, the pre-mid-1930s trajectory of trademark law and practice in the United States, the United States’ compliance with its obligations under international intellectual property (“IP”) treaties, or the current objectives of U.S. trademark law require or support the existence of the separate treatment of geographical trademarks in U.S. law. Therefore, this article proposes the elimination of the geographical marks–specific provisions of the Lanham Act<sup>8</sup>—sections 2(e)(2) and 2(e)(3).

A significant reason for the elimination of these provisions is the increasing difficulty of categorizing a mark as geographical because of the so-called “Google effects”<sup>9</sup> on human memory, which have rendered the “generally known geographic location” test meaningless. Contrary to the arguments positing that the Internet has made all information searchable and therefore generally known,<sup>10</sup> this article contends that the Internet and the Google effects have contributed to a diminishing volume of generally known geographical names.<sup>11</sup> As scientists have described, the Google effects result from the approach that humans take to the management of memory in the brain: when we can retrieve information from a stable location outside of our brains, we use that location as external memory, which relieves us of the need to store the information in our own memory.<sup>12</sup> The Internet, enabled by powerful search engines such as Google, has added almost unlimited capacity to the external memory phenomenon; in the past three decades, expanded access to the Internet and the increasing volume of information available on the Internet have diminished the need for our brains to store much of the information that we stored in the past. Of course, more than one cause is likely behind the contraction

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<sup>7</sup> *In re California Innovations, Inc.*, 329 F.3d 1334, 1341 (Fed. Cir. 2003); *In re Newbridge Cutlery*, 776 F.3d at 862.

<sup>8</sup> U.S. Trademark (Lanham) Act of 1946, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051-1129) (the “Lanham Act”).

<sup>9</sup> Betsy Sparrow, Jenny Liu & Daniel M. Wegner, *Google Effects on Memory: Cognitive Consequences of Having Information at Our Fingertips*, 333 *Science* 776 (2011). For a discussion of “Google effects,” see *infra* Part II, Section 1.

<sup>10</sup> Recording of Oral Argument at 25:05–25:10, *In re Newbridge Cutlery* (Fed. Cir. July 10, 2014) (No. 2013–1535) (Nathan K. Kelley) (suggesting that “the Internet stuff is the very best evidence of what the average American would know.”).

<sup>11</sup> See *infra* notes 95–98 for a discussion of what the relevant knowledge is and why the existence of a geographical name on the Internet does not suffice.

<sup>12</sup> See *infra* notes 109–116 and accompanying text.

in general knowledge of geographical names,<sup>13</sup> but our growing reliance on the Internet and the increasing Google effects on our memory are likely among the major causes.<sup>14</sup>

Without the “generally known geographic location” test and without the two Lanham Act provisions, all trademarks, whether geographical or not, would be subject to the same rules that trademark law applies to non-geographical trademarks. The application of the general trademark rules to geographical trademarks would still raise questions about the meaning of a mark, including its geographical meaning, but the meaning would be tested in the context of particular goods or services and of the possible significance of the mark to an average purchaser of the particular goods or services.<sup>15</sup> The proposed approach would better reflect trademark law policies; the key inquiry should not be whether consumers in general perceive a term in a mark to be geographical or not, but whether they perceive the mark as referring to a particular source of goods or services and as distinguishing the source of the goods or services from other sources of goods or services.<sup>16</sup> In fact, the “generally known geographic location” test has already been sometimes conflated with the other tests for descriptiveness and goods/place association, suggesting the test’s limited utility.<sup>17</sup>

The proposed approach will better protect against inappropriate monopolization of geographical names that are not generally known and yet have a geographically descriptive meaning to the average purchasers of particular goods or services for which the marks with the names are used. The registration of such marks would require a showing of secondary meaning in the same way that any other descriptive mark would require if consumers perceive the mark to

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<sup>13</sup> For other causes of the contraction in general knowledge of geographical names, see *infra* Part II, Section 1.

In their 2006 article on geographical marks, Brauneis and Schechter commented on the “differences in human knowledge about geographic and non-geographic facts” and “[c]onsumers’ lack of knowledge about economic activity in particular areas around the world.” Brauneis & Schechter, *supra* note 3, at 34 and 36. In the article, they focused on the effects that the differences in human knowledge have and the lack of knowledge has on the goods/place association test (see *infra* note 60 and accompanying text, and notes 274–285 and accompanying text), and not on the determination of whether a name is perceived as a geographical name.

<sup>14</sup> Sparrow, Liu & Wegner, *supra* note 9. See also *infra* Part II, Section 1.

<sup>15</sup> TMEP § 1209.01(b).

<sup>16</sup> McCarthy, *supra* note 1, § 3.8. The approach that this article advocates is in contrast to a proposal by Professor Jeanne Frommer, who argues “against enshrining secondary meaning as a basis of protectability in trademark law” and suggests “recentering distinctiveness doctrine on the primary meaning of terms as the gauge of protectability.” Jeanne C. Frommer, *Against Secondary Meaning*, 98 Notre Dame L. Rev. (forthcoming 2022).

<sup>17</sup> On the conflating of the tests, see *infra* notes 101–105 and accompanying text.

be merely descriptive.<sup>18</sup> Secondary meaning would also be required in cases when consumers perceive a mark that refers to an obscure geographical location to be non-geographical and merely descriptive of the particular goods or services.<sup>19</sup> A strict application of the rules on generic terms should protect geographical indications<sup>20</sup> against monopolization by individual adopters. The proposed approach seems to be consistent with current reality in which consumers are affected by the Google effects and exposed to a wide range of products in a globalized marketplace in which marks consist of names that refer to geographical locations that might be unknown to U.S. consumers.

The elimination of the two geographical marks-specific provisions in the Lanham Act<sup>21</sup> would not only acknowledge the reality of the Google effects and improve the protection of names of geographical locations against inappropriate exclusive appropriation, but it would also return geographical trademark law to its originally established trajectory without impeding the United States' compliance with its international obligations. The Lanham Act provisions on geographical marks were the products of an adverse reaction to changes in the trajectory of geographical trademark law—changes that occurred in the period between the mid-1930s and the mid-1940s<sup>22</sup>—and the current law of geographical trademarks unnecessarily perpetuates the approach taken in reaction to the changes. The law regarding geographical trademarks will function better if trademark law, with one narrow internationally mandated exception for wines and spirits,<sup>23</sup> treats geographical marks in the same manner as it treats other trademarks.

Before presenting the proposal and its rationale, Part I of this article introduces the law of geographical trademarks. The first section offers an overview of geographical marks in general; it uses examples of different types of geographical marks to explain the facets of this category of marks. The second section reviews the

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<sup>18</sup> A merely descriptive mark is a mark that “when applied to the applicant’s goods or services . . . would immediately convey to the potential consumer a direct description of some aspect of the applicant’s goods or services.” McCarthy, *supra* note 1, § 11.51. On the subjective versus objective approach to assessing descriptiveness of geographical marks see Brauneis & Schechter, *supra* note 3, at 29-33.

<sup>19</sup> This should be the result even now because such mark should not be treated as primarily geographical. See *infra* notes 56 and 59 and accompanying text. See also *infra* Part I, Section 1, for a discussion of the different functions of geographical marks.

<sup>20</sup> For a discussion of geographical indications in the U.S. historical context, see *infra* Part III, Section 1.1; in the international law context, see *infra* Part III, Section 2.

<sup>21</sup> 15 U.S.C. § 1052(e)(2) and (3).

<sup>22</sup> See *infra* Part III, Section 1.3.

<sup>23</sup> Lanham Act § 2(a), 15 U.S.C. § 1052(a).

current state of the U.S. law of geographical trademarks,<sup>24</sup> and the third section analyzes the operation of the “generally known geographic location” test for geographical marks.

The first section of Part II explains the Google effects phenomenon and its implications for the knowledge of geographical names, and consequently for the operation of the “generally known geographic location” test. In light of the Google effects and other developments, Part II introduces the article’s proposal to eliminate the two geographical marks-specific provisions from the Lanham Act and to rely on general trademark law provisions and principles in assessing the registrability and protectability of the marks that are now categorized as geographical marks.

Part III analyzes whether and how the proposed changes fit within the history of U.S. trademark law and current international IP law. The first section tracks the history of the U.S. law of geographical marks while focusing on the delineation between geographical and non-geographical marks; the section shows that the developments between the mid-1930s and mid-1940s had a profound effect on the Lanham Act and generated the disproportionate attention that geographical marks received in the Act. The second section discusses the U.S. international obligations that affect geographical marks and how this article’s proposal would comply with those obligations. The article arrives at the conclusion that the elimination of sections 2(e)(2) and 2(e)(3) of the Lanham Act would be consistent with the original U.S. approach to geographical marks and would not lower the degree of United States’ compliance with its international obligations—it might, in fact, improve it in one respect.<sup>25</sup>

The goal of this article is modest—it aims to show that in the context of current U.S. trademark law, there is no reason to treat geographical marks as a separate category of marks. The article does not address the many other problems that arise in connection with geographical marks—whether those problems stem from the application of other current trademark rules<sup>26</sup> or from normative considerations, including considerations linked to questions of protection of geographical indications originating in other countries.<sup>27</sup> If U.S. policies concerning marks that include geographical names and other geographical references were changed, including, for example, in light of some new U.S. view on the international protection of geographical indications, then a

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<sup>24</sup> Other authors have reviewed the historical developments, but this article presents a different perspective on the developments. For other reviews see, for example, LaFrance, *supra* note 3, at 126-141; Brauneis & Schechter, *supra* note 3, at 4-20.

<sup>25</sup> See *infra* notes 394–405 and accompanying text.

<sup>26</sup> For problems arising in connection with geographical marks see *infra* Part I, Section 2.

<sup>27</sup> For the relevancy of the protection of geographical indications under international treaties with respect to geographical trademarks see *infra* Part III, Section 2.

separate category of geographical marks might be meaningful, in which case this article's observations would be relevant to any considerations of the proper definition of geographical marks.

## I. GEOGRAPHICAL MARKS, THE CURRENT U.S. LAW OF GEOGRAPHICAL MARKS, AND "GENERALLY KNOWN GEOGRAPHIC LOCATIONS"

### 1. *Introduction to Geographical Marks*

Geographical marks are marks that refer to or evoke a geographical location, such as AUSTIN CITY LIMITS,<sup>28</sup> which refers to Austin, Texas.<sup>29</sup> A word mark is geographical if it includes a term that refers to a geographical characteristic, such as the name of a country, region, city, river, or mountain.<sup>30</sup> Of course, a geographical term may also have a non-geographical meaning; for example, Austin is the name of the capital of the State of Texas, but it is also a common first name and can even be a last name.<sup>31</sup> In a geographical mark, the term appears in its geographical meaning; consumers perceive the term as referring to the geographical place rather than to any other meanings of the term.<sup>32</sup>

The geographical marks family comprises not only names of geographical locations, but also marks that otherwise refer to geographical locations. A term describing the population of a particular place or a recognized nickname for a place may convey a geographical meaning,<sup>33</sup> and a geographical meaning may stem

<sup>28</sup> *E.g.*, U.S. Registration No. 1,579,521.

<sup>29</sup> On the differences between geographical marks and geographical indications see *infra* notes 326–328 and accompanying text.

<sup>30</sup> *E.g.*, NEW ENGLAND ACADEMY, U.S. Registration No. 5,664,700. *But cf.* *Forschner Grp., Inc. v. Arrow Trading Co. Inc.*, 30 F.3d 348, 355-356 (2d Cir. 1994) (finding that "Swiss Army" "cannot be deemed a designation of geographic origin" because "[t]he phrase Swiss Army knife . . . denotes a knife of the type associated with the Swiss Army, rather than a military knife manufactured in Switzerland." *Id.*).

For the application of the doctrine of foreign equivalents in cases of geographical names, see *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1351-1352 (Fed. Cir. 2009).

<sup>31</sup> For an example of an originally personal name that became a geographical name see *Saxlehner v. Wagner*, 216 U.S. 375 (1910) (holding that Hunyadi, Hungary, originally the name of a fifteenth century Hungarian hero, had become a geographical name).

<sup>32</sup> *Cf.* *Hyde Park Clothes, Inc. v. Hyde Park Fashions, Inc.*, 204 F.2d 223, 224 (2d Cir. 1953), *cert. denied*, 346 U.S. 827 (1953) (opining that "[a]s applied to both plaintiff and defendant the trade-mark 'Hyde Park' does not have a geographical connotation but has a secondary connotation that connotes style or quality."). See also *infra* notes 91–94 and accompanying text.

<sup>33</sup> See, *e.g.*, *In re Charles S. Loeb Pipes, Inc.*, 190 U.S.P.Q. 238 (T.T.A.B. 1975) (OLD DOMINION for the State of Virginia); *Conagra, Inc. v. Saavedra*, 4 U.S.P.Q.2d 1245, 1249 (T.T.A.B.1987) ("the term 'tapatio' is, in fact, a term which denotes those people or things from Guadalajara. While 'tapatio' itself is not a geographical place, it does connote a geographical location." In this case, the TTAB did not consider the term to be well known in the United States.); *In re Cox Enters., Inc.*, 82 U.S.P.Q.2d 1040 (T.T.A.B. 2007)

from alphanumeric strings; for example, a telephone calling code or a postal code can refer to their particular geographical areas, and a street number may refer to a specific building.<sup>34</sup> A geographical mark may consist of a map (the contour of a country, for example)<sup>35</sup> or an image that depicts a feature such as a unique tree, a distinct mountain, or an iconic piece of architecture associated with a particular geographical location.<sup>36</sup> Geographical marks need not be only word or design marks; shape marks and even sound or scent marks might evoke a particular geographical location.

Geographical marks serve different functions. A geographical mark may have a topographical function; it places goods, services, and/or the mark owners on the map by communicating their location and making them easily locatable. Consumers know where to look for the flagship store of SAKS FIFTH AVENUE<sup>37</sup> or where the home of the VEGAS GOLDEN KNIGHTS<sup>38</sup> hockey team is located. But a geographical mark can achieve more than just placing the goods, services, or mark's owner on a map; it can serve the function of geographical indication of origin,<sup>39</sup> signaling the connection of goods

(THEATL for Atlanta); *In re* Pennwood Prods., Inc., 2008 WL 5256385 (T.T.A.B. Dec. 11, 2008) (PENN for Pennsylvania); *Guantanamera Cigar Co. v. Corporacion Habanos, S.A.*, 729 F. Supp. 2d 246 (D.D.C. 2010) (GUANTANAMERA meaning “girl from Guantanamo”); *UMG Recordings, Inc. v. Mattel, Inc.*, 100 U.S.P.Q.2d 1868 (T.T.A.B. 2011) (MOTOWN for Detroit, Michigan); *In re* Premiere Distillery LLC, 103 U.S.P.Q.2d 1483, 1484 (T.T.A.B. 2012) (“other meanings [of the word RUSSIAN, namely], a language or ethnic group, ultimately relate back to the geographic location, Russia.” *Id.*); *In re* Rich Marks, LLC, 2015 WL 1227730, \*2 (T.T.A.B., Feb. 25, 2015) (“the term ‘Redneck Riviera,’ for American consumers, is a real, significant geographical place on the northwest coastline of the Gulf of Mexico stretching from southeastern Mississippi to the Florida panhandle beaches east of Panama City.”); *In re* Deep South Studios LLC, 2017 WL 665730 (T.T.A.B. 2017) (“DEEP SOUTH” includes Louisiana). *Cf. Ex parte* Acker, Merrall & Condit Co., 165 O.G. 473 (1911) (the word “Celtic” “ha[d] never been applied to a geographical division of the earth, political or otherwise”).

<sup>34</sup> *E.g.*, *In re* John Lankshear, 2013 WL 3191596, \*6 (T.T.A.B. June 6, 2013) (recognizing that “SW3 is a postal code for the district of Chelsea, London” and concluding that “SW3, therefore, connotes a geographical location”); *In re* Air New Zealand Ltd., Serial No. 79192386 (T.T.A.B. Nov. 9, 2018), slip op. at \*6 (“NZ” for New Zealand); *In re* Committee on Advanced Tuition Payment, 2020 WL 6543360 (T.T.A.B. 2020) (“WA” for the U.S. State of Washington).

<sup>35</sup> *E.g.*, NEW ENGLAND ACADEMY, U.S. Registration No. 5,664,700 (“The mark consists of a silhouette image of the map of the New England region appearing within a circle . . .” Description of the mark.).

<sup>36</sup> *E.g.*, *In re* Save Venice New York Inc., 54 U.S.P.Q.2d 1106, 1108 (T.T.A.B. 2000), \*3 (finding that the “image of the Lion of St. Mark simply reinforces the geographical significance of the overall mark as primarily connoting Venice, Italy.”). *See also In re* Save Venice New York Inc., 259 F.3d 1346 (Fed. Cir. 2001).

<sup>37</sup> U.S. Registration No. 620,917, originally registered to Saks & Co. Corp. at 611 Fifth Avenue in New York, NY, with its flagship store at the same address.

<sup>38</sup> U.S. Registration No. 5,596,245, registered for “[e]ntertainment services, namely, professional ice hockey exhibitions” for the hockey team located in Las Vegas, NV.

<sup>39</sup> On the differences between geographical marks and geographical indications or indications of origin see *infra* notes 326–328 and accompanying text.

or services to known attributes of a location—the local conditions, terroir, people, and traditions.<sup>40</sup> Consumers expect something more of VIDALIA<sup>41</sup> onions than just their origin in Vidalia, Georgia; they associate the origin with a certain type and quality of the onions.<sup>42</sup> At times, a connection might be to the intangible attributes that people associate with a geographical location—a certain lifestyle, a perceived quality, or an allure.

A geographical mark may refer to the actual place of origin of goods or services, or it may use a reference to geography to invoke a location with which consumers should associate goods or services, including possibly their type, content, and/or quality.<sup>43</sup> For example, baguettes sold at Paris Baguette might not be baked in and imported from Paris, France, but they might be the types of baguettes that consumers associate with Paris.<sup>44</sup> Such marks stand in the place of a generic term, describing a genus of goods or services.<sup>45</sup>

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<sup>40</sup> On geographical indications in U.S. and international trademark law see *infra* Part III, Section 2. Not all geographical indications as defined by international law must be geographical marks as defined in U.S. trademark law. See *id.*

<sup>41</sup> U.S. 1,709,019 (registered to the Georgia Department of Agriculture).

<sup>42</sup> 55 FR 717, Jan. 9, 1990. See also What Makes a Vidalia Onion?, <https://www.vidaliaonion.org/about-vidalia-onions/what-makes-a-vidalia-onion/> (last visited Sep. 23, 2021).

<sup>43</sup> “Many geographical terms have developed a rich set of connotations that make it easy to see why merchants would use them for reasons other than indicating geographic origin.” Brauneis & Schechter, *supra* note 3, at 36.

<sup>44</sup> Cf. the registration of PARIS BAGUETTE in class 30. Originally, the trademark was denied registration—see *In re Paris Croissant Co., Ltd.*, 2007 WL 2972217 (T.T.A.B. 2007) (denying registration to PARIS BAGUETTE in class 30 as a primarily geographically deceptively misdescriptive mark). The applicant re-filed the application for class 30, and in response to the first office action argued the following: “Applicant secures the services of a Parisian technician who resides in Kyoungki-do, Korea, and instructs applicant technically how to make confectionary and bread. As such, it is believed [*sic*] that applicants [*sic*] goods have qualities and relation that can be properly associated with Paris, and it would not result in deception or geographically deceptively misdescriptivness [*sic*], since applicant does have a Paris-trained technician behind the menu and goods.” Response to Office Action, Application Serial No. 77/343,012, filed September 15, 2008. The Examiner responded that “having a ‘technician’ who was trained in Paris is not sufficient to overcome a 2(e)(3) refusal.” Office Action, Application Serial No. 77/343,012, issued October 8, 2008. After the applicant had removed from the application many types of goods listed in class 30, the registration issued on August 11, 2009, as U.S. Registration No. 3,665,546.

<sup>45</sup> See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (“A generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species.”). See also, in the context of a geographical term, *International Dairy Foods Association v. Interprofession du Gruyère*, 2020 WL 4559436 (T.T.A.B. 2020) (holding that “purchasers and consumers of cheese understand the term ‘gruyere’ as a designation that primarily refers to a category within the genus of cheese that can come from anywhere”). See also *Interprofession Du Gruyère v. U.S. Dairy Export Council*, 575 F. Supp. 3d 627 (E.D. Va. 2021), \*2 (appeal pending). Cf. *Institut National Des Appellations v. Brown-Forman Corp.*, 47 U.S.P.Q.2d 1875, 1884 (T.T.A.B. 1998), \*11 (“COGNAC is not a generic term, but rather a valid common law



## 2. Geographical Marks in Current U.S. Trademark Law

The Lanham Act distinguishes four categories of geographical marks,<sup>46</sup> three of which are expressly mentioned in the Act: (1) primarily geographically descriptive,<sup>47</sup> (2) primarily geographically deceptively misdescriptive,<sup>48</sup> and (3) a special category of geographically misdescriptive indications used for wines or spirits.<sup>49</sup> Primarily geographically misdescriptive marks that are not deceptive and not used for wine or spirits do not appear in the Lanham Act, but this category of marks exists as the de facto remainder of primarily geographical marks.<sup>50</sup>

The following examples illustrate the different categories: LAS VEGAS CHOCOLATES, used for chocolates that are made in Las Vegas, is a primarily geographically descriptive mark as long as the mark “designates geographical location and would tend to be regarded by buyers as descriptive of the geographic location of origin of the goods or services.”<sup>51</sup> If the mark LAS VEGAS CHOCOLATES were used for chocolates made in Los Angeles, the mark would be primarily geographically misdescriptive. Under current U.S. trademark law, in both cases, the marks may be registered; a mark that is primarily geographically misdescriptive (but not deceptive) is registrable on the principal register, and a mark that is primarily geographically descriptive is registrable on the supplemental register and must acquire secondary meaning to be registrable on the principal register.<sup>52</sup> An unregistrable mark is “Swiss Chocolates,” when used for chocolates made in Las Vegas; it is likely to be considered a primarily geographically deceptively misdescriptive mark because Switzerland is known for chocolates, and consumers will buy “Swiss Chocolates” with the expectation

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regional certification mark” because “purchasers primarily understand the designation COGNAC to refer to brandy originating in the Cognac region of France, and not to brandy produced elsewhere,” and “opposers in fact control and limit use of the designation COGNAC to brandy which meets certain standards of regional origin.”)

<sup>46</sup> For the historical development of U.S. law of geographical trademarks and the classification of geographical marks, see *infra* Part III, Section 1.

<sup>47</sup> Lanham Act § 2(e)(2), 15 U.S.C. § 1052(e)(2).

<sup>48</sup> *Id.* § 1052(e)(3).

<sup>49</sup> *Id.* § 1052(a).

<sup>50</sup> For more on the primarily geographically misdescriptive marks category, see *infra* Part III, Section 1.

<sup>51</sup> McCarthy, *supra* note 1, § 14.2. For a discussion of the use of the goods/place association test for descriptive marks, see *infra* note 59.

<sup>52</sup> Lanham Act § 2(e)(2), 15 U.S.C. § 1052(e)(2). Marks that are primarily geographically misdescriptive but not deceptive have been treated as arbitrary or fanciful, making them inherently distinctive and registrable on the principal register. TMEP § 1210.02(c)(iii); see also Brauneis & Schechter, *supra* note 3, at 18.

that the chocolates are the famous chocolates from Switzerland.<sup>53</sup> Finally, marks for wine or spirits that are geographically misdescriptive (even if they are not deceptive) are also unregistrable, as is required by U.S. international obligations.<sup>54</sup>

A number of issues arise in connection with geographical marks.<sup>55</sup> To be identified as a primarily geographical mark, the mark's "primary significance to the relevant consumers in the United States [must] be that of a geographic location."<sup>56</sup> "Rachel" might be used as the name of the town in Nevada or as the female name; "West Point" may stand for the town in New York or for the U.S. Military Academy.<sup>57</sup> If a mark is perceived as "primarily geographical," whether it is descriptive or misdescriptive further determines its treatment. And, whether a primarily geographical mark is descriptive or misdescriptive might be difficult to ascertain; some goods might be manufactured in a particular geographical location, but others might only be designed in that location or contain some components from the location.<sup>58</sup> Further, consumers might not always perceive a mark as actually referring to the geographical origin of the goods.<sup>59</sup>

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<sup>53</sup> Lanham Act § 2(a), 15 U.S.C. § 1052(e)(3). See *infra* note 61 and the accompanying text for a discussion of the test for primarily geographically deceptively misdescriptive marks. For the development of the test for such marks, see *infra* Part III, Section 1.4.

<sup>54</sup> Lanham Act § 2(a), 15 U.S.C. § 1052(a); Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) (hereinafter "TRIPS Agreement" or "TRIPS"), Article 23; see also *infra* Part III, Section 2.2.

<sup>55</sup> Many of the issues are discussed or alluded to further in the following Parts of this article.

<sup>56</sup> TMEP § 1210.02(b); see, e.g., *In re Urbano*, 51 U.S.P.Q.2d 1776, 1780 (T.T.A.B. 1999) ("the primary significance of the phrase SYDNEY.2000 is as a reference to the Olympic Games" and not to the geographical location); *In re Jim Crockett Promotions Inc.*, 5 U.S.P.Q.2d 1455, 1456 (T.T.A.B. 1987) (the "Great American" . . . suggests, in much the same way as 'All American[,] something of desirable quality or excellence" and "the public would [not] consider that [the mark, THE GREAT AMERICAN BASH] is intended to, or that it does, primarily describe the geographical origin of applicant's services").

When a mark consists of a geographical term and other terms, and forms a composite mark, it must be determined whether the primary significance of the mark is geographical. TMEP § 1210.02(c).

On the treatment of terms with multiple meanings, see also *infra* notes 91–94 and accompanying text.

<sup>57</sup> *In re Cotter & Co.*, 228 U.S.P.Q. 202 (T.T.A.B. 1985).

<sup>58</sup> TMEP § 1210.03; see the example of PARIS BAGUETTE, *supra* note 44.

<sup>59</sup> In some cases, the TTAB has used the goods/place association to determine whether a mark is primarily geographically descriptive. See, e.g., *In re Cheezwhse.com, Inc.*, 85 U.S.P.Q.2d 1917, \*2 (T.T.A.B. 2008); see also Brauneis & Schechter, *supra* note 3, at 33. Under current law, the goods/place association is required only to show that a mark is deceptively misdescriptive; in cases of geographically descriptive marks, the goods-place association is presumed. McCarthy, *supra* note 1, at § 14:29. See also *infra* Part III, Section 1.4.

If a mark is identified as primarily geographically misdescriptive, its potentially deceptive nature depends on the goods/place (or service/place) association<sup>60</sup> and the role the association plays in a relevant consumer's decision to buy the goods or use the services.<sup>61</sup> The test might be straightforward in the case of "Swiss Chocolates," but in other cases it might be more difficult to establish that a particular location is "well known or noted" for the goods or services<sup>62</sup> and that the association is material to a consumer's decision to purchase the goods or services.<sup>63</sup>

But before any of the potentially difficult questions introduced above are addressed, the first question to be answered is whether a mark is a geographical mark at all.<sup>64</sup> The "generally known geographic location" test is used to answer this question; it is the first step in the geographical marks test. If the place in the mark is "generally known," the mark is subject to the geographical mark provisions of the Lanham Act (and to the tests above) and may or may not be registrable based on the application of the provisions. If the place is not "generally known," the mark is not subject to the geographical marks provisions and is registrable as an arbitrary or fanciful mark.<sup>65</sup>

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<sup>60</sup> On problems with the goods/place association, see Brauneis & Schechter, *supra* note 3, at 33–40. On the development of the test for primarily geographically deceptively misdescriptive marks, see *infra* Part III, Section 1.4 and also *infra* note 71.

<sup>61</sup> The USPTO bears the burden of establishing a prima facie case that the mark is primarily geographically deceptively misdescriptive. See *In re Pacer Technology*, 338 F.3d 1348, 67 U.S.P.Q.2d 1629 (Fed. Cir. 2003).

<sup>62</sup> TMEP § 1210.04(a).

<sup>63</sup> *Id.* at § 1210.05(c). For an example of a close call, see *In re Consolidated Specialty Restaurants, Inc.*, 71 U.S.P.Q.2d 1921 (T.T.A.B. 2004) (denying registration to COLORADO STEAKHOUSE as a primarily geographically deceptively misdescriptive mark). For the use of an inference of materiality, see *infra* notes 285 and 287–289 and accompanying text.

<sup>64</sup> The assessment of the geographical nature of a mark can affect the other steps of the test. The TTAB held that if "there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote," the goods/place association "may ordinarily be presumed from the fact that the applicant's own goods come from the geographical place named in the mark." *In re Handler Fenton Westerns, Inc.*, 214 U.S.P.Q. 848, 850 (T.T.A.B. 1982); see also *In re Brouwerij Nacional Balashi NV*, 80 U.S.P.Q.2d 1820, 1821 (T.T.A.B. 2006); *In re Spirits of New Merced, LLC*, 85 U.S.P.Q.2d 1614, 1621 (T.T.A.B. 2007) ("[s]ince the goods originate at or near the place named in the mark, we can presume an association of applicant's beer with the park."); *In re East Coast Towing & Storage, LLC*, 2011 WL 1495443 (T.T.A.B. Mar. 28, 2011) (finding that an association between the applicant's mark and its towing services could be presumed).

<sup>65</sup> TMEP § 1210.04(c).

### 3. “Generally Known Geographic Location” in Current U.S. Law

Under current U.S. law, a mark is geographical if it refers to a “generally known geographic location,”<sup>66</sup> meaning that the primary significance of a term used in the mark (or another feature of the mark)<sup>67</sup> is as identifying a place “known generally to the relevant American public.”<sup>68</sup> The primary significance may be either “clear on its face”<sup>69</sup> or there must be “substantial evidence to support a conclusion that the mark identifies a place ‘known generally to the relevant American public.’”<sup>70</sup>

If a geographical term refers to a place that is “minor, obscure, remote, or unconnected with the goods” or services, the mark is not “primarily geographical.”<sup>71</sup> Different information may be considered relevant when assessing whether a place is “minor, obscure, or remote.” Courts’ and the Trademark Trial and Appeal Board’s (“TTAB’s”) analyses of whether a place is generally known have

<sup>66</sup> TMEP § 1210.01(a).

<sup>67</sup> For the different types of geographical marks see *supra* Part I, Section 1.

<sup>68</sup> *In re Newbridge Cutlery*, 776 F.3d at 862. The definition of the “relevant public” is debatable; see *infra* notes 101–106 and accompanying text for a discussion of the conflating of the generally known geographical location test with the descriptiveness and the goods/place association analyses.

<sup>69</sup> *E.g.*, *In re American Biomimetics Corp.*, WL 699201, \*2 (T.T.A.B. 1997) (“[i]t hardly needs to be said that ‘America’ is universally known as a geographic name for the United States of America”).

<sup>70</sup> TMEP § 1210.02(b).

<sup>71</sup> *World Carpets, Inc. v. Dick Littrell’s New World Carpets*, 438 F.2d 482 (5th Cir. 1971); see also *In re Trans Continental Records, Inc.*, 62 U.S.P.Q.2d 1541 (T.T.A.B. Mar. 11, 2002) (“O-TOWN is a relatively obscure geographic reference for the city of Orlando, Florida.”).

While the TTAB has affirmed a presumption of the goods/place association when “the applicant’s own goods come from the geographical place named in the mark” and “there is no genuine issue that the geographical significance of a term is its primary significance and where the geographical place is neither obscure nor remote” (*In re Handler Fenton Westerns, Inc.*, 214 U.S.P.Q. 848, 850 (T.T.A.B. 1982)), it does not necessarily hold that just because there is a good/place association that the place in question is generally known. As the U.S. Court of Appeals for the Federal Circuit (“CAFC”) held, for a valid goods/place association “it is necessary, of course, that the purchasers perceive the mark as a place name and this is where the question of obscurity or remoteness comes to the fore.” *In re Societe Generale Des Eaux Minerales De Vittel S.A.*, 824 F.2d 957, 959 (Fed. Cir. 1987). In the VITTEL case, the CAFC found that the board “never made any clear finding” that the term “Vittel” was generally known to the public “but only found a goods/place connection between Vittel and a mineral water spa, attempting to reason from there that appellant’s goods would be associated with a spa or with mineral water and thus with Vittel.” *Id.* at 960. For another example in which the goods/place association test is conflated with the generally known geographical location test see, *e.g.*, Recording of Oral Argument at 18:27–20:05 and 28:53–29:10, *In re Newbridge Cutlery* (Fed. Cir. July 10, 2014) (No. 2013–1535).

ranged from one sentence<sup>72</sup> to a lengthy geographical exposé.<sup>73</sup> The analyses cover geographical features and the existence of points of interest, such as educational and cultural institutions, homes of celebrities,<sup>74</sup> and the histories of places have also been referred to in the analyses.<sup>75</sup>

The size of the place tends to be an important factor; in *In re Newbridge Cutlery Co.*, the CAFC noted that the fact that “the population of the location is sizable . . . is evidence that a location is generally known.”<sup>76</sup> Perhaps unsurprisingly, the Armenian village of Bjni, with “just over 3,000 people,” was found not to be “a generally known geographic place,” notwithstanding its long history, its medieval fortress, its church, and its mineral water springs.<sup>77</sup> It was “insignificant” that Newbridge, Ireland, “a town of less than twenty thousand people,” was “the second largest town in County Kildare and the seventeenth largest in the Republic of Ireland.”<sup>78</sup> But, even more populated places do not necessarily fare better. On the one hand, Altona, once a city neighboring Hamburg, Germany (and now a part of Hamburg), was not a generally known place even though its population was “approximately a quarter million people.”<sup>79</sup> On the other hand, a population of over 900,000 helped to persuade the TTAB that Mersin, a city in Turkey, was a generally known geographic location.<sup>80</sup>

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<sup>72</sup> *E.g.*, *In re Branded LLC*, 2020 WL 1166471, at \*2 (T.T.A.B. Feb. 14, 2020) (finding, in the case concerning EMPORIO ITALIA, that “[t]he evidence shows that Italy is not an obscure, remote or minor geographic location, but rather a European country with a population of more than 58 million and exports of more than \$506 billion”); *In re Tigerland-Foxland of NY, Inc.*, 2014 WL 3752409, \*3 (T.T.A.B. July 23, 2014) (finding that “[b]oth Venice and Milan are well known cities located in Italy; Venice is the ‘provincial capital of Veneto’ and Milan is ‘an industrial city in central Lombardy.’” *Id.* Internal quotations omitted.).

<sup>73</sup> *E.g.*, *In re Roy J. Mankovitz*, 90 U.S.P.Q.2d 1246, 1247-48 (T.T.A.B. 2009) (quoting extensively the examining attorney’s findings about Montecito, California).

<sup>74</sup> *Id.* at \*2.

<sup>75</sup> *E.g.*, *In re South Park Cigar, Inc.*, 82 U.S.P.Q.2d 1507, 1511 (T.T.A.B. 2007), \*5 (including *inter alia* the story of the founder of Ybor City, Florida).

<sup>76</sup> *In re Newbridge Cutlery Co.*, 776 F.3d at 861. In this case the court held that the term “Newbridge” was not primarily geographically descriptive of Newbridge, Ireland.

<sup>77</sup> *In re Vili Group Inc.*, 2016 WL 4140913, \*2 (T.T.A.B. July 14, 2016) (regarding an application for Bjni for mineral and carbonated waters).

<sup>78</sup> *In re The Newbridge Cutlery Co.*, 776 F.3d at 862.

<sup>79</sup> *In re Altona Diagnostics GmbH*, 2020 WL 2468078, \*3 (T.T.A.B. Apr. 20, 2020). The problem in *Altona Diagnostics* was that the Board did not find the city of Altona to be known generally and also not to the relevant public because “much of the Examining Attorney’s evidence is from sources which have no apparent link to purchasers of the scientific and industrial goods and services of Applicant’s identification of goods and services.” *Id.* at \*8.

<sup>80</sup> *In re Yahya Kemal Gungor*, 2016 WL 6648968, \*2 (T.T.A.B. 2016) (finding that “with a sizeable population, and no alternative meaning, . . . the primary significance of Mersin is a generally known geographic location”).

The sole fact that a term appears as a geographical term in a gazetteer, atlas, or encyclopedia is certainly relevant, but is not sufficient by itself<sup>81</sup> to support the argument that a place is generally known. For example, in *In re Spirits of New Merced, LLC*, the TTAB accepted as evidence the inclusion of Yosemite in the *Columbia Gazetteer of North America* and the *Hutchinson Unabridged Encyclopedia*.<sup>82</sup> But one listing in a single thirty-two-year-old edition of *The Columbia Lippincott Gazetteer of the World* did not convince the TTAB in *In re Bavaria St. Pauli Brauerei AG* that the German town of Jever was generally known.<sup>83</sup> In *In re Newbridge Cutlery Co.*, the TTAB relied *inter alia* on a listing of the Irish town of Newbridge in *The Columbia Gazetteer of the World*, but the CAFC discounted the weight of this evidence given the lack of “any evidence to show the extent to which the relevant American consumer would be familiar with the locations listed in this gazetteer.”<sup>84</sup>

Not surprisingly, the Internet has become an important source of evidence for showing that a place is generally known. Typically, however, the appearance of a geographical term on the Internet, on its own, is not sufficient to prove that a location is generally known. In *In re The Newbridge Cutlery Co.*, the solicitor of the United States Patent and Trademark Office (“USPTO”) urged the CAFC to understand the presence of the name on the Internet as the “very best evidence of what the average American would know,”<sup>85</sup> but the CAFC disagreed, commenting that “the Internet . . . contains enormous amounts of information: some of it is generally known, and some of it is not.”<sup>86</sup> The CAFC concluded that “the fact that a location is described on the internet does not necessarily evidence that a place is known generally to the relevant public.”<sup>87</sup>

The existence of identical geographical names used for places other than a place allegedly referenced in a mark has been used as evidence to undermine a “generally known” status if the purchasers of an applicant’s goods or services were likely more familiar with one or more of the other places with the same geographical name.<sup>88</sup>

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<sup>81</sup> For a discussion of the historical approach that relied solely on the inclusion of a name in such sources, see *infra* Part III, Section 1.3.

<sup>82</sup> *In re Spirits of New Merced, LLC*, 85 U.S.P.Q.2d 1614, 1615 (T.T.A.B. 2007); see also *Zero Transportation, LLC v. Scottsdale Taxi Sedan Serv. Co.*, 2018 WL 3004279, \*8-\*9 (T.T.A.B. 2018) (accepting as evidence for “Scottsdale” an entry in *The Columbia Gazetteer of the World Online*).

<sup>83</sup> *In re Bavaria St. Pauli Brauerei AG*, 222 U.S.P.Q. 926 (T.T.A.B. 1984).

<sup>84</sup> *In re The Newbridge Cutlery Co.*, 776 F.3d at 862.

<sup>85</sup> Recording of Oral Argument at 25:04–25:10, *In re Newbridge Cutlery* (Fed. Cir. July 10, 2014) (No. 2013–1535) (Nathan K. Kelley).

<sup>86</sup> *In re The Newbridge Cutlery Co.*, 776 F.3d at 863.

<sup>87</sup> *Id.*

<sup>88</sup> *In re Altona Diagnostics GmbH*, 2020 WL 2468078, \*5–6 (T.T.A.B. Apr. 20, 2020).

The TTAB noted, for example, the existence of “numerous geographic locations named ‘Allen’ in the United States” and concluded, based on the record before it, that it was “unconvinced that ‘Allen’ primarily identifie[d] a geographic location in New York City that [was] known generally to the American purchasing public.”<sup>89</sup> However, the existence of multiple geographical locations named Durango (not only a Mexican city and one of the states in Mexico, but also towns in Colorado and Spain) was less relevant to the issue of whether Durango was a generally known geographical location; the CAFC noted that it is not dispositive “[t]hat there is more than one place bearing the name or that one place is better known than another.”<sup>90</sup>

Similarly, the existence of alternative non-geographical meanings of an otherwise geographical term<sup>91</sup> does not change an outcome if “the most prominent meaning or significance is geographic for the identified goods”<sup>92</sup> or services. Thus, the fact that Balashi is a neighborhood in Aruba and also a cabbage variety from Bangladesh was irrelevant when BALASHI was, in fact, used in its geographical meaning as a primarily geographical term for beer.<sup>93</sup> Nonetheless, the TTAB in the case found the neighborhood to be “so minor, remote and obscure that its geographic significance would not be known or otherwise readily apparent to purchasers of the applicant’s beer.”<sup>94</sup>

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<sup>89</sup> *In re Allen Street Owner LLC*, 2018 WL 6012753, \*8 (T.T.A.B. Oct. 26, 2018).

<sup>90</sup> *In re Loew’s Theatres, Inc.* 769 F.2d 764, 768 (Fed. Cir. 1985).

<sup>91</sup> See also *supra* notes 56–57 and accompanying text.

<sup>92</sup> *In re Brouwerij Nacional Balashi NV*, 80 U.S.P.Q.2d 1820 (T.T.A.B. 2006), \*3 (quoting the examining attorney); see also *In re Fame Jeans, Inc.*, 2004 WL 545768, \*4 (T.T.A.B. Mar. 16, 2004) (the TTAB was not persuaded that “US” in the US WEAR mark stood for the word “us” as opposed to “United States”). Similarly, on “US,” see *In re Milwaukee Institute, Inc.*, 2010 WL 667943, \*2-3 (T.T.A.B. Jan. 28, 2010). See also *In re Vanity Fair, Inc.*, 2007 WL 4616262, \*2-\*4 (T.T.A.B. Dec. 17, 2007) (rejecting applicant’s argument that it used FRENCH in the sense of “sexy”); *In re Napa Valley Foods Inc.*, 2011 WL 810204, \*2 (T.T.A.B. Feb. 22, 2011) (the TTAB was not persuaded that instead of referring to Napa Valley, California, “NAPA” could stand for the “National Academy of Public Administration,” the “National Asphalt Pavement Association,” or the “National Association for the Practice of Anthropology”).

For composite marks, see *supra* note 56.

<sup>93</sup> *In re Brouwerij Nacional Balashi NV*, 80 U.S.P.Q.2d 1820, \*3 (T.T.A.B. 2006).

<sup>94</sup> *Id.* at \*11. The TTAB added:

To be sure, the average American beer consumer, after perhaps quaffing a few ‘brews’ while spending some time lying around on, or at least contemplating a vacation to, the white sand beaches of Aruba that serve as the island’s principal tourist destinations, might have occasion to research and/or check out whatever other attractions, including gold mine ruins, a large desalination plant and applicant’s brewery, would be of interest as a side trip to the locale of Balashi. The geographical significance, however, of the term “Balashi” would not be apparent without, at a minimum, consulting sources of tourism information.

*Id.* Furthermore, in this case, the TTAB did not agree that the primary meaning was geographical, and instead referred to the mark as arbitrary: “Here, ‘Balashi’ would be

Little attention seems to be paid to the degree of expected knowledge required for a place to be “generally known” to consumers. In oral argument in *In re Newbridge Cutlery Co.*, USPTO Solicitor Nathan K. Kelley pointed out that the CAFC has never required “generally known” to depend on a consumer’s memory.<sup>95</sup> No results of consumer surveys or focus groups must be presented to show that consumers recall a geographical location without consulting other sources, such as a gazetteer, atlas, encyclopedia, or the Internet.<sup>96</sup> However, it seems logical that in the trademark context, “generally known” implies that the relevant public would recall the geographical meaning of a mark when they see or otherwise perceive the mark, without having to search in other sources for the meaning of the mark.<sup>97</sup> As the exchange in the *Newbridge* oral argument suggested, making “generally known” depend on the results of Internet searches would turn most if not all geographical places into generally known geographical locations, whereas the relevant question should be what the consuming public knows at the time they encounter the mark, before conducting any further inquiry.<sup>98</sup>

As the previous paragraphs suggest, the determination of whether a place is a “generally known geographic location” is not an exact science, and the outcomes of determinations sometimes seem

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perceived as an arbitrary term which would serve to identify and distinguish applicant’s goods because its geographical significance is essentially unknown to the relevant public, given that the record contains insufficient evidence to show that American beer consumers would in fact readily recognize ‘Balashi’ as a geographical name.” *Id.* at 8.

*See also In re Int’l Taste Inc.*, 53 U.S.P.Q.2d 1604, 1605 (T.T.A.B. 2000) (where the TTAB found, “in view of the other prominent, significant meaning of the term ‘Hollywood’ as referring to the entertainment industry in general, . . . that the Examining Attorney has not established that the primary significance of the term ‘Hollywood’ is that of a geographic location in California.”).

<sup>95</sup> Recording of Oral Argument at 26:41–26:49, *In re Newbridge Cutlery* (Fed. Cir. July 10, 2014) (No. 2013–1535) (Nathan K. Kelley) (“There has never been a requirement by this court that we have to show the consumers had something in their head.”).

<sup>96</sup> *See also* Recording of Oral Argument at 03:42–04:42, *In re Newbridge Cutlery* (Fed. Cir. July 10, 2014) (No. 2013–1535) (Philip Raible for appellant).

<sup>97</sup> *In re The Steel House, Inc.*, 206 U.S.P.Q. 956, 958 (T.T.A.B. 1980) (“[i]f the notation in question does not convey an immediate or readily recognizable geographical significance to the average consumer, the mark is manifestly arbitrary . . .”) (emphasis added.). *See also* Recording of Oral Argument at 24:22–24:34, *In re Newbridge Cutlery* (Fed. Cir. July 10, 2014) (No. 2013–1535) (Philip Raible for appellant) (“The issue is not what you can find out if you do some search that you might be inclined to do or not inclined to do, it’s what the relevant public know now, prior to making all those inquiries. If you make the inquiries, of course you are going to find the smoking gun that’s going to prevent the PTO from . . . register[ing] it.”). *See also*, in the context of descriptive marks, McCarthy, *supra* note 1, § 11.16 (“A ‘descriptive’ term is one that directly and immediately conveys some knowledge of the characteristics of a product or service.” Emphasis added.).

<sup>98</sup> Recording of Oral Argument at 40:32–40:56, *In re Newbridge Cutlery* (Fed. Cir. July 10, 2014) (No. 2013–1535). For a discussion of the impact of Google effects on what “generally known” should mean see *infra* note 136 and accompanying text.



inconsistent. The USPTO requires “substantial evidence to support a conclusion that the mark identifies a place ‘known generally to the relevant American public’” in cases when “it is not clear on its face that the primary significance of the mark is that of a geographic location,”<sup>99</sup> and parties may resort to obtaining survey evidence in an attempt to show that a mark does or does not refer to a generally known place.<sup>100</sup>

The analysis of the generally known geographical location test has sometimes been conflated with the descriptiveness and the goods/place association analyses. The tendency in such cases is to conflate the tests because of a focus on the particular purchasing public and the use of the term in connection with particular goods and services.<sup>101</sup> If the relevant public is defined too narrowly for the generally known geographical location test, places can be—incorrectly—assessed as generally known.<sup>102</sup> For example, once the relevant public is defined as consisting of “people considering purchasing real property in Fountain Hills, Arizona,”<sup>103</sup> not surprisingly, “Fountain Hills” is found to be a generally known geographical location and not an obscure or remote place.<sup>104</sup> And even when a lack of sufficient evidence suggested that “Vittel” was an obscure location, the CAFC concluded further—seemingly unnecessarily—that “the evidence [was] insufficient to show the likelihood of [the American cosmetic-purchasing public] thinking that Vittel refer[red] to a place where the goods come from.”<sup>105</sup> The conflating of the tests seems more likely to have occurred in cases where the decision-maker was perhaps not confident about the “generally known geographic location” status or where the decision-maker might have been concerned about the prospect of a resulting

<sup>99</sup> TMEP § 1210.02(b).

<sup>100</sup> *E.g.*, *In re Spirits Int'l N.V.*, 86 U.S.P.Q.2d 1078 (2008), \*3, vacated and remanded 563 F.3d 1347 (Fed. Cir. 2009).

<sup>101</sup> The Lanham Act requires that the nature of a mark should be assessed “when used on or in connection with the goods of the applicant,” but this language refers to the assessment of the characteristic of the mark as primarily geographically descriptive or primarily geographically deceptively misdescriptive of the goods; the language does not refer to the assessment of only the geographical characteristic of the mark. 15 U.S.C. § 1052(e)(2) and (3).

<sup>102</sup> *In re Newbridge Cutlery*, the CAFC used the phrase “a place known generally to the relevant American public.” *In re Newbridge Cutlery*, 776 F.3d at 862 (emphasis added).

<sup>103</sup> *In re McO Properties Inc.*, 38 U.S.P.Q.2d 1154, 1156 (T.T.A.B. 1995), at \*3.

<sup>104</sup> *Id.*, at \*3. The problem with the test in this case was that it was subject to the same fallacy as the test for disparaging marks: with a sufficiently narrow definition of the relevant public, no term will refer to an obscure or remote place.

<sup>105</sup> *Societe Generale Des Eaux Minerales De Vittel S.A.*, 824 F.2d 957, 960 (Fed. Cir. 1987). For another example in which the goods/place association test is conflated with the generally known geographical location test *see, e.g.*, Transcript Recording of Oral Argument at 18:27–20:05 and 28:53–29:10, *In re Newbridge Cutlery*, 2013–1535 (Fed. Cir. July 10, 2014) (No. 2013–1535) (Nathan K. Kelley, Solicitor, USPTO).

monopolization of a geographical term if the location were to be found to be not generally known and the mark therefore immediately registrable as a fanciful mark.<sup>106</sup>

## II. THE LAW OF GEOGRAPHICAL TRADEMARKS IN LIGHT OF “GOOGLE EFFECTS”

### 1. *Geographical Names and “Google Effects”*

The application of the “generally known geographic location” test seems to be increasingly difficult. In *Newbridge*, oral argument focused on the Internet as an expander of geographical knowledge and on the dangers of making sweeping conclusions about knowledge of places based on the places’ searchability on the Internet.<sup>107</sup> It is true that the Internet significantly assists the public in expanding their knowledge, including geographical knowledge. But if the point of the geographical significance question is what the consuming public knows at the time they encounter the mark in question, before any further inquiry, the Internet does not enlarge the volume of the type of geographical knowledge that is relevant to geographical marks; instead, the Internet might actually contribute to a reduction in the volume of the relevant type of geographical knowledge.

The Internet ensures that we are surrounded by more information and more easily accessible information than ever before, but our ability to recall certain types of information from our own memory might be declining because of the easy accessibility. We might like to think that our geographical knowledge is as broad as or even broader than that of our predecessors in 1946, when the Lanham Act was adopted, but our readily available knowledge, for geographical names and other information, is likely less robust. With the Internet readily available to supplant our knowledge, we no longer need to store as much information in our memory; in fact, we no longer need to remember where any particular information might be found. For better or worse, the Internet has it all.

Scholars have long been concerned about the effects of easy access to information on human memory; for the same reason, Socrates was concerned about the effects of the written language because he predicted that for those who use it, “[t]heir trust in writing, produced by external characters which are no part of themselves, will discourage the use of their own memory.”<sup>108</sup>

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<sup>106</sup> See Brauneis & Schechter, *supra* note 3, at 24-27 (discussing concerns about monopolization of geographical names in cases when the locations are known for the production of particular goods or for the particular services).

<sup>107</sup> Recording of Oral Argument at 24:22–26:02, *In re Newbridge Cutlery* (Fed. Cir. July 10, 2014) (No. 2013–1535).

<sup>108</sup> Plato, *Phaedrus* 275 (H. N. Fowler, trans. 1925) (Socrates continued: “You have invented an elixir not of memory, but of reminding; and you offer your pupils the appearance of

Socrates' conclusion may seem absurd today, particularly to those who memorize from text. But the Internet presents different challenges.

In 2011, *Science* magazine published an article by Betsy Sparrow and two other psychologists who described the "Google effects on memory."<sup>109</sup> In the article, the authors reported the results of four studies that suggested that "when people expect to have future access to information, they have lower rates of recall of the information itself and enhanced recall instead for where to access it."<sup>110</sup> The authors concluded that "[t]he Internet has become a primary form of external or transactive memory, where information is stored collectively outside ourselves."<sup>111</sup>

Some commentators have called the Google effects findings "convincing,"<sup>112</sup> while others have expressed a certain degree of skepticism, suggesting that the findings were "far from conclusive"<sup>113</sup> and in need of "more empirical evidence."<sup>114</sup> A recent study confirmed the existence of the Google effects when experiment participants perceived that they could rely on pertinent information being reliably saved for future use; in their 2021 article, Schooler and Storm reported that their experiment participants exhibited "a significant Google Effect"<sup>115</sup> once the participants knew that the information-saving process was reliable. The authors theorized that when "[people] do not believe they will need to remember [particular] information themselves," they "are choosing, either explicitly or implicitly, to study information in a way that will make the information less recallable in the future than it would have been otherwise."<sup>116</sup>

If the Google effects existed in the experiments reported in the 2011 article, these effects should only have expanded since then,

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wisdom, not true wisdom, for they will read many things without instruction and will therefore seem to know many things, when they are for the most part ignorant and hard to get along with, since they are not wise, but only appear wise."); see also Richard Heersmink, *The Internet, Cognitive Enhancement, and the Values of Cognition*, 26 *Minds & Machines* 389, 393 (2016) (discussing Socrates' concerns with the effect of writing on memory, as discussed in the *Phaedrus*); Joel N. Schooler & Benjamin C. Storm, *Saved Information Is Remembered Less Well Than Deleted Information, If the Saving Process Is Perceived as Reliable*, *Memory* 1, 6 (2021).

<sup>109</sup> Sparrow, Liu, & Wegner, *supra* note 9.

<sup>110</sup> *Id.* at 776.

<sup>111</sup> *Id.*

<sup>112</sup> Roddy Roediger, quoted in John Bohannon, *Searching for the Google Effect on People's Memory*, 333 *Science* 277, 277 (2011).

<sup>113</sup> Adam S. Kahn & Todd M. Martinez, *Text and You Might Miss It? Snap and You Might Remember? Exploring "Google Effects on Memory" and Cognitive Self-Esteem in the Context of Snapchat and Text Messaging*, 104 *Computs. in Human Behavior* 1, 1 (2019).

<sup>114</sup> Heersmink, *supra* note 108, at 393.

<sup>115</sup> Schooler & Storm, *supra* note 108, at 6.

<sup>116</sup> *Id.* at 6.

now that the Internet contains even more, and more easily accessible, information. In a later article, Sparrow recalls that she and her colleagues ran their first experiment in 2006, which was, as she points out, “one year before the first iPhone was released.”<sup>117</sup> She notes that at that time, there were important hurdles to the accessibility of information on the Internet; to access information, one was “required [. . .] to sit at a computer, with keyboard, mouse and ethernet cable, navigate to a browser on the desktop, and type a query.”<sup>118</sup> These hurdles have disappeared with smartphones, wireless connections, and voice-operated devices.<sup>119</sup>

The prevalence of smartphones has made the “constant access to information”<sup>120</sup> observed by Sparrow et al. in 2011 more than just constant; today, Internet access is omnipresent and instantaneous because it is within quick reach of most people—at least in the United States, which is the relevant public for the purposes of this article. The difference between Internet use in the United States in 2011, when Sparrow’s article was published, and today is substantial but not surprising; in 2011, 79% of U.S. adults used the Internet, and in 2021 that percentage was 93% of U.S. adults.<sup>121</sup> But the difference between 2011 and 2021 in accessing the Internet on a smartphone is astonishing: in 2011, only about 35% of U.S. adults owned a smartphone, but by 2021, that figure was 85% of U.S. adults.<sup>122</sup> If the Google effects become more pronounced because of the ease and reliability of retrieving information, the prevalence of smartphones combined with the high degree of connectivity we have today has undoubtedly contributed to an even more extensive outsourcing of people’s memory.

Geographical names—such as the names of regions, countries, cities, rivers, and towns—are the kinds of information that lend themselves greatly to outsourcing because they tend to be available and easily searchable on, and retrievable from, the Internet. They are part of semantic memory—a type of long-term memory that

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<sup>117</sup> Betsy Sparrow, *The Importance of Contextual Relevance*, 2 *Nature Human Behaviour* 607, 607 (2018).

<sup>118</sup> *Id.*

<sup>119</sup> For a similar argument, see Recording of Oral Argument at 25:10–25:35, *In re Newbridge Cutlery* (Fed. Cir. July 10, 2014) (No. 2013–1535) (Nathan K. Kelley pointing out the difference between searching the Internet in 1987 and 2014 in the context of an argument that the appearance of a geographical term on the Internet contributes to the term being “generally known”).

<sup>120</sup> Sparrow, Liu, & Wegner, *supra* note 9, at 776.

<sup>121</sup> Internet/Broadband Fact Sheet, Pew Research Center, <https://www.pewresearch.org/internet/fact-sheet/internet-broadband/#internet-use-over-time> (last visited Apr. 24, 2022).

<sup>122</sup> Mobile Fact Sheet, Pew Research Center, <https://www.pewresearch.org/internet/fact-sheet/mobile/> (last visited Apr. 24, 2022). Although not all smartphone users have access to the Internet all the time, it is perhaps reasonable to assume that in 2021 most smartphone users do.

“includes knowledge of facts, events, ideas, and concepts,”<sup>123</sup> which is the type of memory for which the Google effects have been shown.<sup>124</sup> By now, we have grown accustomed to relying increasingly on the reliability of the Internet, and because we believe that we will have access to all Internet information in the future, we are less likely to remember the information.<sup>125</sup>

Another related factor contributes to the contraction in the knowledge of geographical names:<sup>126</sup> we have been losing any reason to learn geographical names for purposes of spatial orientation. Before GPS devices began to chart our travel routes, we learned geographical names to orient ourselves on a map and in the landscape, and to receive and impart instructions about locations and directions. Because GPS devices—including our smartphones—now guide us across continents just as effectively as they do across city parks, we no longer have any reason to store geographical names in our memory for purposes of spatial orientation.

If in 2011, the “processes of human memory [were] adapting to the advent of new computing and communication technology,”<sup>127</sup> the adaptation of the processes must have progressed even more rapidly in the past ten years. We cannot fault ourselves for not remembering information that we have easily outsourced; in fact, the educational systems across many countries have enthusiastically embraced the notion of outsourcing by departing from the memorization of facts, such as geographical names, in favor of emphasizing other skills.<sup>128</sup>

<sup>123</sup> A. Martin, *Semantic Memory*, Encyclopedia of Neuroscience, 561–566 (Larry R. Squire ed. 2009) (providing overview of semantic memory).

<sup>124</sup> S. Pishdadian & R.S. Rosenbaum, *Memory and Amnesia*, in Encyclopedia of Behavioral Neuroscience 418 (2d ed., 2021) (“Semantic memory consists of knowledge of the world and of the self that does not require one to revisit the time and place in which the knowledge was first acquired. For example, knowing that the capital of Canada is Ottawa . . . does not require you to have visited Ottawa . . .”).

<sup>125</sup> Kahn & Martinez, *supra* note 113, at 1.

<sup>126</sup> The abysmal state of geography education in the United States, a misunderstanding of and lack of respect for geography as a scientific field, and widespread disinterest in geography all contribute to the declining knowledge of geography. Harm De Blij, *Why Geography Matters: Three Challenges Facing America—Climate Change, The Rise of China, and Global Terrorism* 13 (2005) (observing that “an American student might go from kindergarten through graduate school without ever taking a single course in geography—let alone a fairly complete program.”). See also *id.*, 14 (noting that “geography as a school subject and as a university discipline in the United States is, to put it mildly, underrepresented”) and 19 (stating that “[t]he best assessment is that when the [National Geographic] Society’s campaign began, about 7 percent of American students were getting some geography; today, after nearly 20 years and an estimated investment of \$100 million, the figure is still below 30 percent.”). In a 2019 survey that was commissioned by the Council on Foreign Relations and the National Geographic Society, respondents “on average answered 53% of the [geography] knowledge questions correctly.” U.S. Adults’ Knowledge About the World, Gallup, 2019, at 8.

<sup>127</sup> Sparrow, Liu, & Wegner, *supra* note 9, at 778.

<sup>128</sup> Irit Levy-Feldman and Zipora Libman, *Student Assessment and Good Teaching: The Gap Between Ideology and Practice*, in *Beyond Bystanders: Educational Leadership for a*

The law should reflect these developments and adjust where appropriate, and the U.S. law of geographical marks is one of the areas where adjustments are necessary.

## ***2. The Law of Geographical Marks in the Absence of General Geographical Knowledge***

Numerous problems arise in practice with the generally known geographical location test,<sup>129</sup> and both the practical application problems and the considerations of the Google effects<sup>130</sup> on the general knowledge of geographical names have prompted this article's proposal that the test be eliminated.

The recognition of the impact of the Google effects on the knowledge of geographical names does not necessarily imply the elimination of the geographical marks-specific provisions of Lanham Act sections 2(e)(2) and 2(e)(3). Even with diminished geographical knowledge, these provisions could be maintained if the current test were replaced with another, more straightforward test: if a name appeared in any source—a gazetteer, an atlas, an encyclopedia, or the Internet—as a geographical name, the mark would be a geographical mark and subject to the geographical marks-specific provisions. But this outcome would be, as Part III, Section 1.3, below, discusses, precisely the outcome that the Lanham Act strived to avoid by making geographical marks-specific provisions apply only to marks that are *primarily* geographical.<sup>131</sup>

Another option—and the approach that this article advocates—is the elimination of the generally known geographical location test and the two geographical marks-specific provisions in sections 2(e)(2) and 2(e)(3).<sup>132</sup> Without these provisions, geographically descriptive marks would be treated in the same manner as other descriptive marks,<sup>133</sup> geographically misdescriptive marks would be

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Humane Culture in a Globalizing Reality (Nimrod Aloni and Lori Weintrob eds. 2017), at 205-217 (noting “great popularity around the world in recent years” of “constructivist theory” of knowledge and learning, which has led to the “move [of] the focus of teaching toward the development of thinking and creativity and the cultivation of skills such as implementation, analysis, synthesis, and evaluation, which highlight the responsibility of the learner, as opposed to skills such as the memorization and reproduction of subject matter.” *Id.* at 207). See also de Blij, *supra* note 126, at 4 (“When I was a high-school student, learning to name countries and cities, rangers and rivers was an end in itself. Making the connections that give geography its special place among the sciences was not on the agenda.”).

<sup>129</sup> TMEP § 1210.01. See *supra* Part I, Section 3.

<sup>130</sup> See *supra* Part II, Section 1.

<sup>131</sup> See *infra* Part III, Section 1.3.

<sup>132</sup> *Id.* §§ 1052(e)(2) and (3). The reference to “indications of regional origin” would be maintained in 15 U.S.C. § 1054. For international law requirements, see also *infra* Part III, Section 2.

<sup>133</sup> For earlier examples of cases in which marks including geographical terms were found to be descriptive rather than geographically descriptive see *In re Busch Entm't Corp.*, 60

treated in the same manner as other misdescriptive marks, and geographically deceptively misdescriptive marks would be treated in the same manner as other deceptively misdescriptive marks or deceptive marks.<sup>134</sup>

The elimination of the generally known geographical location test and the subjecting of geographical marks to the general trademark rules would reflect the range of functions that geographical marks may serve.<sup>135</sup> For geographical marks that do not serve a topographical function but do serve other functions, it should be irrelevant whether consumers appreciate the geographical meaning of a mark; they may still perceive the mark to be descriptive. With the Google effects and a globalized marketplace, consumers may encounter more and more marks whose geographical meaning will evade them.<sup>136</sup>

Eliminating the geographical marks–specific provisions would make apparent the fact that general trademark rules apply to all marks, including marks that are now classified as geographical marks. For example, it should be clear that rules concerning generic marks apply to geographical marks,<sup>137</sup> and generic geographical marks should be treated in the same manner as any other generic marks, with unfair competition providing limited protection to an adopter of a generic mark.<sup>138</sup> Descriptive fair use is available for geographical marks,<sup>139</sup> and the doctrine of foreign

U.S.P.Q.2d 1130 (T.T.A.B. 2000) (EGYPT merely descriptive of subject matter or motif of amusement park services); *In re MBNA Am. Bank, N.A.*, 340 F.3d 1328, 67 U.S.P.Q.2d 1778 (Fed. Cir. 2003), *reh'g denied*, 2004 U.S. App. LEXIS 2187 (Fed. Cir. Jan. 12, 2004) (MONTANA SERIES and PHILADELPHIA SERIES are merely descriptive of “credit card services featuring credit cards depicting scenes or subject matter of, or relating to” the places named in the marks); *In re Cox Enters. Inc.*, 82 U.S.P.Q.2d 1040, 1043, 1045 (T.T.A.B. 2007) (“[a]pplicant’s mark THEATL is simply a compressed version of the descriptive term THE ATL,” which is “a recognized nickname for Atlanta,” and is “merely descriptive of the subject matter of applicant’s publications.”).

<sup>134</sup> Currently, geographically deceptively misdescriptive marks are treated in the same manner as other deceptive marks. For the development of the law concerning geographically deceptively misdescriptive marks, see *infra* Part III, Section 1.4.

<sup>135</sup> See *supra* Part I, Section 1.

<sup>136</sup> Maintaining the generally known geographical location test would also be problematic because a recognition of the impact of the Google effects would necessitate a change in the approach to the test; no longer should the outcome of the test rely on sources that are deemed to be generally known or on a body of knowledge that we assume consumers share. The focus of the inquiry should be on consumers’ perception of the mark at the time the consumers perceive the mark and before they consult further sources. See also *supra* notes 95–98 and accompanying text for a discussion of arguments in *In re Newbridge Cutlery Co.*

<sup>137</sup> For examples of generic mark arguments used in the context of geographical marks see *supra* note 45.

<sup>138</sup> On unfair competition protection in cases of generic geographical names see *infra* Part III, Section 1.

<sup>139</sup> See Brauneis & Schechter, *supra* note 3, at 44–46 (discussing descriptive fair use and the limits of the doctrine in the context of geographical trademarks).

equivalents should also apply to all trademarks, including geographical marks.<sup>140</sup>

This article's proposal to eliminate the geographical marks-specific provisions in the Lanham Act might be surprising given the voluminous history of the provisions and their firm place in the Lanham Act. The introduction of these provisions into the Lanham Act was considered a significant improvement over the pre-Lanham Act rules, and therefore it might seem imprudent to remove them. It might also seem imprudent to remove these provisions because many international law obligations concern geographical indications of origin, which may appear to imply that geographical marks-specific provisions are necessary to comply with these international law obligations.

But neither historical developments nor international law obligations necessitate the two geographical marks-specific provisions in the Lanham Act. The following Part III of this article traces the origins of the Lanham Act's geographical marks-specific provisions and shows that the provisions were the reaction to a judicial change of course that was inconsistent with the historical trajectory of trademark law, that the change resulted in geographical marks attracting disproportionate attention in the Lanham Act, and that the inclusion of the provisions caused more confusion than clarification. Part III also reviews the relevant international law obligations and shows that U.S. compliance with the obligations would not decrease if the two Lanham Act provisions were eliminated.

### III. THE PROPOSED CHANGES IN LIGHT OF HISTORICAL DEVELOPMENTS AND U.S. INTERNATIONAL OBLIGATIONS

#### *1. Historical Developments of the U.S. Law of Geographical Trademarks*

The standard narrative of Lanham Act history is that the Lanham Act needed to remedy the Patent Office's pre-Lanham Act practice of rejecting registrations of any trademarks that had any geographical meaning; before the Lanham Act, if a gazetteer, atlas, or encyclopedia listed a term as a geographical name, the term could not be registered as a trademark.<sup>141</sup> However, as discussed below, a closer look at the history of geographical marks reveals that this practice was prevalent only in the period immediately preceding the 1946 enactment of the Lanham Act (the mid-1930s to the mid-1940s) and stemmed from specific court decisions that departed

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<sup>140</sup> On the doctrine of foreign equivalents and geographical marks see *In re Spirits International, N.V.*, 563 F.3d 1347 (Fed. Cir. 2009).

<sup>141</sup> See *infra* notes 233–240 and accompanying text.



from earlier case law.<sup>142</sup> The deviation by the courts from the earlier trajectory had major consequences for the Lanham Act because it directly affected the drafting of the Act and the design of its geographical marks—specific provisions, which are, with minor amendments, still in effect today.

The following sections map the history of the U.S. law of geographical marks and explain why the developments from the mid-1930s to the mid-1940s should be regarded as a departure from the original trajectory of the law of geographical marks. If those developments were, in fact, a deviation, the proposal outlined in the previous section to eliminate the geographical marks—specific provisions of the Lanham Act is consistent with the original trajectory of trademark law as it had developed prior to the mid-1930s.

### 1.1. Geographical Marks in U.S. Trademark Law Before the 1905 Trademark Act

The first U.S. trademark statute that mentioned geographical marks was the Trade Mark Act of 1905 (“the 1905 Act”);<sup>143</sup> before the 1905 Act, U.S. trademark statutes did not expressly refer to geographical marks. The first U.S. trademark statute, the Trade Mark Act of 1870, which the U.S. Supreme Court held unconstitutional in 1879,<sup>144</sup> included no provision specifically addressing geographical marks; it referred only to “a lawful trademark.”<sup>145</sup> The statute expressly required distinctiveness from a mark that included “the name of a person, firm, or corporation only,” but the Act did not mention geographical names.<sup>146</sup> The 1881 Trademark Act also did not refer to geographical marks.<sup>147</sup>

Before 1905, the U.S. Supreme Court addressed geographical marks in 1871 in *Canal Co. v. Clark*,<sup>148</sup> where a company that was mining coal in Lackawanna, Pennsylvania, sought to enjoin a coal dealer from using “Lackawanna coal” for the coal that the dealer sold. The Supreme Court refused to approve a trademark monopoly over the name and considered “sound doctrine” the rule that “no one can apply the name of a district of country to a well-known article

<sup>142</sup> See *infra* Part III, Section 1.3.

<sup>143</sup> Act of Feb. 20, 1905, 33 Stat. 724, § 85(b).

<sup>144</sup> *In re Trade-Mark Cases*, 100 U.S. 82 (1879).

<sup>145</sup> Trademark Act of 1870, 16 Stat. 210, § 79. On trademarks being registered as design patents see William L. Symons, *Early Attempts to Protect Trade-marks*, 107 Sci. Am. 333 (1912). For examples of design patents on trademarks that included geographical names see D1,183 (1860) (including “Reims”); D2,181 (1865) (including “Portland”); D2,238 (1865) (including “Copenhagen”).

<sup>146</sup> Trademark Act of 1870, 16 Stat. 210, § 79.

<sup>147</sup> Act of March 3, 1881, § 3.

<sup>148</sup> *Canal Co. v. Clark*, 80 U.S. 311 (1871).

of commerce, and obtain thereby such an exclusive right to the application as to prevent others inhabiting the district or dealing in similar articles coming from the district, from truthfully using the same designation.”<sup>149</sup>

It is notable that the mark at issue in *Canal Co. v. Clark*, a decision that influenced the treatment of geographical marks for the next seven decades, was what we might consider today a geographical indication.<sup>150</sup> The Court referred to “Lackawanna coal” as a “generic name,”<sup>151</sup> and when it listed examples of other geographical names, it also used other generic geographical marks—or geographical indications—such as “Pennsylvania wheat” and “Virginia tobacco.”<sup>152</sup> The Court considered it “obvious” that “the same reasons which forbid the exclusive appropriation of generic names . . . apply with equal force to the appropriation of geographical names.”<sup>153</sup> The Court stated, “could any one prevent all others from using them, or from selling articles produced in the districts they describe under those appellations, it would greatly embarrass trade, and secure exclusive rights to individuals in that which is the common right of many.”<sup>154</sup> Later decisions relied on *Canal Co. v. Clark* to deny exclusive trademark rights in geographical marks.<sup>155</sup>

Following *Canal Co. v. Clark*, geographically descriptive marks were held unregistrable,<sup>156</sup> and this was the case even if a mark might have had acquired secondary meaning.<sup>157</sup> Nevertheless, adopters of geographically descriptive marks were not without protection; courts protected the adopters under the doctrine of

<sup>149</sup> *Id.* at 327.

<sup>150</sup> The term “geographical indication” is used here in its broadest sense. On the various definitions of geographical indications in international and foreign laws, see *infra* Part III, Section 2.

<sup>151</sup> *Canal Co.*, 80 U.S. at 328.

<sup>152</sup> *Id.* at 324.

<sup>153</sup> *Id.*

<sup>154</sup> *Id.*

<sup>155</sup> *Columbia Mill Co. v. Alcorn*, 150 U.S. 460 (1893).

<sup>156</sup> *Elgin Nat'l Watch Co. v. Illinois Watch Case Co.*, 179 U.S. 665, 673 (1901) (“[W]ords that do not in and of themselves indicate anything in the nature of origin, manufacture, or ownership, but are merely descriptive of the place where an article is manufactured or produced, cannot be monopolized as a trademark”). Similarly, registration of “P-I-T-T-S-B-U-R-G-H P-U-M-P” was denied for pumps manufactured in Pittsburgh, Pennsylvania, in *Ex parte* Pittsburgh Pump Co., 84 O.G. 309 (1898), and registration of “St. Johnsbury” was denied for crackers made in St. Johnsbury, Vermont, in *Ex parte* Cross, 96 O.G. 643 (1901).

<sup>157</sup> *Elgin Nat'l Watch Co.*, 179 U.S. at 677. An exception developed in cases when the location was owned by the applicant for the geographically descriptive trademark. See also *infra* note 255.

unfair competition,<sup>158</sup> at least against their competitors who used identical geographical marks and deceived consumers.<sup>159</sup> In 1903, the U.S. Supreme Court, in a case that concerned the rights to the name “Vichy,” which was used for Vichy spring water, explained that “geographical names often acquire a secondary signification indicative not only of the place of manufacture or production, but of the name of the manufacturer or producer and the excellence of the thing manufactured or produced.”<sup>160</sup> According to the Supreme Court, the owner of such a mark could enforce the owner’s rights against “every one not doing business within the same geographical limits; and even as against them, if the name be used fraudulently for the purpose of misleading buyers . . . , or of palming off.”<sup>161</sup>

The refusal of registration of geographical marks applied only when geographical names were used in their geographical meaning;<sup>162</sup> even if a mark coincided with a geographical term, it was registrable if it was not used in its geographical meaning. For example, GERMAN SWEET CHOCOLATE was registrable because the word “German” in this case stood for the last name of Mr. Samuel German, who registered the trademark and later assigned the mark to the complainant, who used the mark for many years.<sup>163</sup> DELTA was registered for hardware, notwithstanding the existence of the counties of Delta in Michigan and Texas, because the applicant did not do business “at any place bearing the name of Delta” and because the significance of delta as a letter of the Greek alphabet was in the case “far superior to any geographical meaning.”<sup>164</sup> On the other hand, “Mobile” was denied registration

<sup>158</sup> For the historical development of unfair competition law in the United States see Christine Haight Farley, *The Lost Unfair Competition Law*, 110 TMR 739, 746-755 (2020).

<sup>159</sup> *E.g.*, Pillsbury-Washburn Flour Mills Co., Ltd. v. Eagle, 86 F. 608 (7th Cir. 1898) (including cases cited therein); Shaver v. Heller & Merz Co., 108 F. 821 (8th Cir 1901); Elgin Nat’l Watch Co. v. Illinois Watch Case Co., 179 U.S. 665, 674 (1901) (“[P]rotection is accorded against unfair dealing, whether there be a technical trademark or not”). *See also* James Love Hopkins, *The Law of Trademarks, Tradenames, and Unfair Competition*, 129–131 and 159 (2d ed. 1905). This line of cases was reflected in the original version of section 43(a) of the Lanham Act before it was amended in 1988; section 43(a) of the Lanham Act expressly provided a cause of action to “a person doing business in the *locality* falsely indicated as that of origin or in the *region* in which said locality is situated.” Lanham Act, § 43(a) (1946) (emphasis added).

<sup>160</sup> *La Republique Française v. Saratoga Vichy Spring Co.*, 191 U.S. 427, 435 (1903).

<sup>161</sup> *Id.*; *see also* John T. Dyer Quarry Co. v. Schuylkill Stone Co., 185 F. 557 (D.N.J. 1911) (analyzing in detail the protection for BIRDSBORO TRAP ROCK).

<sup>162</sup> *See, e.g.*, *Ex parte* The Columbia Incandescent Lamp Co., 96 O.G. 1036 (1901). This was also the case where the geographical terms formed the essential feature of the mark. For simplification, this article does not discuss additional details concerning composite marks. For the current rule on composite marks, see *supra* note 56.

<sup>163</sup> *Walter Baker & Co. v. Baker*, 77 F. 181, 188 (W.D. Va. 1897).

<sup>164</sup> *Ex parte* Manogue-Pidgeon Iron Co., 97 O.G. 2084 (1901). *See also Ex parte* Magnus Metal Co., 100 O.G. 451 (1902) (GALENA for antifriction metal was not understood by the purchasing public as a geographical name and was registered); *Ex parte* Aspegren

for playing cards because the examiner, and on appeal the assistant commissioner as well, considered the word to be geographical, referring to Mobile, Alabama.<sup>165</sup> The applicant in the case was unsuccessful with his argument that the expanding automobile industry “made the word [‘mobile’], as applied to vehicles, far more familiar to English-speaking people than it ever was as applied to the city of Mobile.”<sup>166</sup>

In some cases, the Patent Office found that an applicant for a trademark registration had selected a geographical name but did so arbitrarily, and therefore the mark was registrable.<sup>167</sup> However, not every applicant who alleged an arbitrary or fanciful use of a geographical term succeeded; as Commissioner Simonds concluded in an 1892 decision, a mark with “a positive geographical meaning” could be registered only if it was “taught by some decision of a court or by some unusual state of facts that [the mark] has attained arbitrary or fanciful meaning of greater substance and value than its mere geographical sense.”<sup>168</sup>

For example, VIENNA, FLORENTINE, and SELMA were registrable because the applicants used the marks as arbitrary or fanciful marks. In the case of VIENNA, where the mark was used for flour, the commissioner referred to the fact that “no flour made in any town called ‘Vienna’ in this country has been placed upon the market under the name ‘Vienna,’” and “no flour is upon this market coming from Vienna, Austria.”<sup>169</sup> Additionally, the commissioner noted that it was customary “in the flour trade to use fanciful names to designate flour, rather than the names of places of production.”<sup>170</sup> The word FLORENTINE was registered for glass when the commissioner determined that “Florence is not noted as a place for the manufacture of glass, and therefore no deception as to the quality or origin of the manufacture can occur.”<sup>171</sup> And while in 1901, “Mobile” was held unregistrable for playing cards because in

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and Co., 100 O.G. 684, 685 (1902) (AURORA was registered for oils, lard, syrup, and honey because the geographical meaning did not predominate).

<sup>165</sup> *Ex parte* the United States Playing Card Co., 96 O.G. 1855 (1901).

<sup>166</sup> *Id.*; but see also *Ex parte* Tabor, 96 O.G. 1036 (1901) (denying registration to a mark including the word “Tabor” because it was “merely the name of the applicant” with “no new or arbitrary significance,” and not mentioning at all the fact that the word is also a geographical name for the Mount Tabor located in Israel or a town in Bohemia, today’s Czech Republic); *Ex parte* Peats, 96 O.G. 1649 (1901) (“Yale” was denied registration for “belt-supporters” because the name was found to have geographical significance and also be a “more or less common surname”).

<sup>167</sup> See *infra* notes 169, 171, and 172.

<sup>168</sup> *Ex parte* American Saw Co., 58 O.G. 521, C.D. (1892).

<sup>169</sup> *Ex parte* Jenkins, 53 O.G. 759 C.D. (1890).

<sup>170</sup> *Id.*

<sup>171</sup> *Ex parte* Mississippi Glass Co., 64 O.G. 713, C.D. (1893); see also *Ex parte* Jewell Belting Co., 110 O.G. 309 (1904) (GIBALTAR for belts registered because purchasers would not suppose the goods to be manufactured in Gibraltar).

that case the word was considered geographical as it referred to Mobile, Alabama,<sup>172</sup> in 1902, SELMA, the name of another Alabama town, was registered for washing machines because the mark “would be accepted by purchasers of such machines as arbitrary and fanciful and would not in any case be given a geographical significance.”<sup>173</sup>

The law and practice in the Patent Office concerning geographical marks in the pre-1905 Trademark Act period was summarized by Commissioner Duell in his 1898 decision in *Ex parte Little & Co.*<sup>174</sup> In response to a call to clarify the demarcation between registrable and unregistrable geographical names,<sup>175</sup> Commissioner Duell noted that “the general ruling that geographical names cannot be allowed registration [was] well settled” and “very rarely [could] a word which is truly geographical be registered even though it [had] a fanciful or arbitrary meaning.”<sup>176</sup> A mark was registrable if the primary significance of the name as used in the trademark was non-geographical; the mere appearance of a term in the Postal Guide as the name of a post office did not make the mark with the term automatically unregistrable because the mark could still be conveying a non-geographical meaning.<sup>177</sup>

## 1.2. Geographical Marks in U.S. Trademark Law Under the 1905 Trademark Act and Before the Mid-1930s

Section 5 of the Trade Marks Act of 1905 expressly disallowed registration of a mark that was “merely a geographic name or term.”<sup>178</sup> In the 1908 decision *In re Crescent Typewriter Supply Co.*, the Court of Appeals of District of Columbia interpreted section 5 to prohibit not only “the use of any word that has an *exclusive* geographical significance,” but also any word that “would suggest any particular geographical location.”<sup>179</sup>

Under the 1905 Act, geographically descriptive marks continued to be unregistrable, and the only exception was available under a

<sup>172</sup> *Ex parte* the United States Playing Card Co., 96 O.G. 1855 (1901).

<sup>173</sup> *Ex parte* Huenefeld, 98 O.G. 1968, 1969 (1902); *see also* Lewis N. Green, 8 O.G. 729 (1875) (GERMAN SIRUP a lawful trademark because it was chosen arbitrarily for a “medicated compound, evidently designated ‘German’ for lack of a better term”).

<sup>174</sup> *Ex parte* Little & Co., 85 O.G. 1221 (1898).

<sup>175</sup> *Id.* at 1222.

<sup>176</sup> *Id.*

<sup>177</sup> *Id.* at 1221. Nevertheless, in this case, the Commissioner affirmed the denial of registration of AURORA for boots and shoes not made in Aurora.

<sup>178</sup> Act of Feb. 20, 1905, ch. 592, § 1, 33 Stat. 724 at § 5(b). For a discussion of the provision in the larger context of the 1905 Act *see* Brauneis & Schechter, *supra* note 3, at 6-7.

<sup>179</sup> *In re* Crescent Typewriter Supply Co., 30 App. D.C. 324, 326 (D.C. Cir. 1908) (emphasis added).

special ten-year rule in the 1905 Act according to which descriptive, including geographically descriptive, marks that were in exclusive and continuous use for ten years preceding February 20, 1905, could be registered.<sup>180</sup> The ten-year rule applied only for the ten years immediately preceding 1905; any other ten-year period of exclusive and continuous use did not allow registration of a geographically descriptive mark.<sup>181</sup> Courts continued to provide unfair competition protection to adopters of unregistrable geographically descriptive marks.<sup>182</sup>

Many marks were held unregistrable under the 1905 Act because they were found to be “merely a geographic name or term,” and denial of registration was the outcome whether or not the marks were geographically descriptive or misdescriptive: “Oriental Cream” was not registrable for a cosmetic lotion,<sup>183</sup> nor was “Oriental” for typewriter ribbons.<sup>184</sup> Also unregistrable were the marks “Golden State” for certain food products,<sup>185</sup> “French Tissue” for paper,<sup>186</sup> “American Strength” for coffee,<sup>187</sup> “Parisian Ivory” and “Avon” for toothbrushes,<sup>188</sup> and “Kenosha-Klosed-Krotch” for underwear.<sup>189</sup> “Savoy” was not registrable for beer because the term was geographical and “also because as a family name it [was] not printed in a particular distinctive manner,” which was a requirement under the 1905 Trademark Act.<sup>190</sup>

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<sup>180</sup> Act of Feb. 20, 1905, section 5; *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U.S. 461, 58 L. Ed. 1046, 34 S. Ct. 648 (1914); *In re Cahn, Belt & Co.*, 27 App. D.C. 173 (D.C. Cir. 1906); *Ex parte The Yale & Towne Mfg. Co.*, 127 O.G. 3641; *see also* McCarthy, *supra* note 1, § 5:3 (“Anyone who had not used a descriptive surname or geographical mark at least as early as 1895 was prevented from registration.”). For example, Coca Cola’s October 1905 registration was made under the ten-year provision of the 1905 Trademark Act. *Nashville Syrup Co. v. Coca Cola Co.*, 215 F. 527, 530 (6th Cir. 1914). *See infra* notes 204–210 and accompanying text for the 1920 statute on limited registration of geographical marks.

<sup>181</sup> *Hercules Powder Co. v. Newton*, 266 F. 169, 175 (2d Cir. 1920).

<sup>182</sup> *Draper v. Skerrett*, 116 F. 206, 209, 211 (E.D. Pa. 1902).

<sup>183</sup> *Ex parte Hopkins*, 125 O.G. 670 (1906), *aff’d*, 29 App. D.C. 118 (D.C. Cir. 1907).

<sup>184</sup> *Ex parte Crescent Typewriter Supply Co.*, 128 O.G. 1295 (1907), *aff’d*, 30 App. D.C. 324 (1908); *see also Ex parte Union Carbide Co.*, 135 O.G. 450 (1908) (UNION CARBIDE was not registered because UNION was a geographical name and CARBIDE was a descriptive word); *Ex parte Meyer Brothers Coffee and Spice Company*, 135 O.G. 893 (1908) (AMERICA’S STRENGTH was not registrable for coffee because it was geographical and descriptive).

<sup>185</sup> *Ex parte Goldberg, Bowen & Co.*, 182 O.G. 974 (1912).

<sup>186</sup> *Draper*, 116 F. at 208.

<sup>187</sup> *In re Meyer Brothers Coffee and Spice Co.*, 32 App. D.C. 277 (D.C. Cir. 1908).

<sup>188</sup> *Ex parte Loonen*, 146 O.G. 957 (1909); *In re California Perfume Co.*, 56 F.2d 885 (C.C.P.A. 1932).

<sup>189</sup> *Ex parte Cooper Underwear Co.*, 266 O.G. 741 (1919).

<sup>190</sup> *Ex parte United States Brewing Co.*, 125 O.G. 352 (1906).

Nevertheless, even in the harsh world of the 1905 Act, many marks with geographical terms were held registrable.<sup>191</sup> As they were in the pre-1905 period, some marks were found registrable if they had an additional non-geographical meaning that prevailed over the geographical meaning.<sup>192</sup> Thus, as DELTA had been registered before the 1905 Act,<sup>193</sup> so was ALPHA registered under the 1905 Act; ALPHA was held registrable for a “protein compound for use in adhesives, plastics, paints, etc.” because, as Assistant Commissioner Frazer stated in his decision, even though Alpha was “a small town in New Jersey,” “that [was] not a generally accepted nor a generally known meaning” of the word.<sup>194</sup> A court held OLD SOUTH registrable because the court agreed that the words “indicate[d] a régime or period in history, and that therefore the term [was] capable of appropriation as a trade-mark.”<sup>195</sup>

As they were in the pre-1905 Act period, in the post-1905 Act period, some geographical marks were found registrable if they were used as arbitrary or fanciful marks. For example, ARAB was eventually registered for sardines; Assistant Commissioner Frazier noted that the word as used with the particular goods, which were not from Arabia, was “neither descriptive nor deceptive, but fanciful.”<sup>196</sup> CELTIC for tea was also registrable;<sup>197</sup> Assistant Commissioner Clay observed in a later decision that “[n]obody would suppose that the tea came from a place peculiarly inhabited by the Celts.”<sup>198</sup> Other cases of registrable marks of this nature

<sup>191</sup> “[T]he rule of the 1905 Act was not as severe as it might first appear.” Brauneis & Schechter, *supra* note 3, at 7.

<sup>192</sup> *Id.* (explaining that “[e]ven if the geographic term in a composite mark continued to convey a geographical meaning, the composite mark could be registered, so long as the geographical term did not dominate the mark and it was disclaimed.”). For the current rule on composite marks, see *supra* note 56.

<sup>193</sup> *Ex parte* Manogue-Pidgeon Iron Co., 97 O.G. 2084 (1901).

<sup>194</sup> *Ex parte* The Glidden Co., 40 U.S.P.Q. 629 (Comm’r Pat. & Trademarks, 1939).

<sup>195</sup> Southeastern Brewing Co v. Blackwell, 80 F.2d 607, 609 (4th Cir. 1935).

<sup>196</sup> *Ex parte* Seacoast Canning Co., 199 O.G. 617 (1914).

<sup>197</sup> *Ex parte* Acker, Merrall & Condit Co., 165 O.G. 473 (1911). Notwithstanding its later interpretation (see *infra* note 198), in this decision, Commissioner Moore ruled that the term “Celtic” was not a geographical term.

<sup>198</sup> *Ex parte* Crew Levick Co., 255 O.G. 161 (1918). In a 1918 decision concerning CASHMERE, which was used for oil used to lubricate wool fibers, Assistant Commissioner Clay explained that the mark’s geographical nature depended “upon the question whether the public might suppose that the term indicated the place from which goods came”—the goods/place association, as used in today’s trademark parlance. He added that this additional step in determining whether a term was geographical—and the resulting limitation of the prohibition of registration of geographical marks—was warranted because “the only reason Congress had for prohibiting the registration of geographical names was that it would interfere with the rights of others who had an equal right with the applicant to say that their goods came from that place.” *Id.* Assistant Commissioner Clay thus had conducted an analysis that later was applied to identify primarily geographically deceptively misdescriptive marks before the NAFTA amendment and *In re California Innovations*. See *infra* notes 273–275 and accompanying

included CASHMERE for oil used to lubricate wool fibers<sup>199</sup> and POUFRE DE RIZ DE JAVA for face powder.<sup>200</sup> The U.S. Supreme Court did not regard THE AMERICAN GIRL for shoes as “a geographical or descriptive term”;<sup>201</sup> the Court concluded that it was “a fanciful designation, arbitrarily selected by [the adopters] to designate shoes of their manufacture,”<sup>202</sup> and exclusive trademark rights existed in the mark.<sup>203</sup>

Although geographically descriptive marks were denied registration under the 1905 Act, they received some registration-based protection pursuant to a 1920 statute. The Trade Mark Act of 1920<sup>204</sup> created a new register, the predecessor of the supplemental register,<sup>205</sup> for registration of two kinds of marks. The first kind was marks registered under an international convention;<sup>206</sup> the second kind was some of the marks that were unregistrable under the 1905 Act, including descriptive and geographical marks. To be registered on this special register, a descriptive or geographical mark must have been in “bona fide use [by its owner] for not less than one year in interstate or foreign commerce, or commerce with the Indian tribes.”<sup>207</sup>

The two goals of the 1920 statute were to comply with the international convention and to enable U.S. trademark owners to benefit from the convention provisions outside the United States, where their descriptive and geographical marks could not be registered if the marks were not registered in their home country.<sup>208</sup> Because of the narrowly defined goals of the statute, the protection of marks registered under the 1920 Act was extremely limited; the statute afforded no substantive rights to registrants<sup>209</sup> and provided

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text. On the current occasional conflating of the goods/place association test with the generally known geographical location test, see *supra* note 71.

<sup>199</sup> *Ex parte Crew Levick Co.*, 255 O.G. 161 (1918).

<sup>200</sup> *Wertheimer et al. v. Batcheller Importing Co.*, 185 F. 850 (S.D.N.Y. 1911).

<sup>201</sup> *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251, 256 (1916).

<sup>202</sup> *Id.* at 257.

<sup>203</sup> *Id.* at 258.

<sup>204</sup> Trade Mark Act of March 19, 1920, ch. 104, 41 Stat. 533, an Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes, March 19, 1920.

<sup>205</sup> Trade Mark Act of March 19, 1920, § 1; see also Lanham Act § 23, 15 U.S.C. § 1091 (“[T]he Director shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920.”)

<sup>206</sup> Trade Mark Act of March 19, 1920, § 1(a); Convention for the protection of trademarks and commercial names, 1910. On international obligations affecting U.S. trademark law of geographical marks, see *infra* Part III, Section 2.

<sup>207</sup> Trade Mark Act of March 19, 1920, § 1(b).

<sup>208</sup> McCarthy, *supra* note 1, § 5.3.

<sup>209</sup> *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315, 322 (1938).



for liability only for reproducing, counterfeiting, copying, or colorably imitating a mark in commerce.<sup>210</sup>

### 1.3. Geographical Marks in U.S. Trademark Law Between the Mid-1930s and the Lanham Act: Judge Irvine L. Lenroot's and Edward S. Rogers's Influence on the Law of Geographical Marks

In 1931, the U.S. Court of Customs and Patent Appeals (“CCPA”) confirmed the consistency of the geographical marks practice under the 1905 Act with earlier, pre-1905 case law. In *In re Plymouth Motor Corp.*,<sup>211</sup> where it held PLYMOUTH registrable, the CCPA explained that “by using the adverb ‘merely,’ Congress intended to, and did, follow the common law principle that there are circumstances under which a geographic name, or term, may come to have a meaning other than one merely geographic, and that, where such is true, the word, so recognized or recognizable at common law, should not be excluded from registration.”<sup>212</sup>

Judge Irvine L. Lenroot<sup>213</sup> dissented from the majority opinion in *In re Plymouth Motor Corp.*, and in 1933, only two years after *Plymouth*,<sup>214</sup> filed a concurring opinion in *Barber-Colman Co. v. Overhead Door Corp.*,<sup>215</sup> where the CCPA panel majority gravitated toward Judge Lenroot’s view, though that opinion concerned a descriptive mark and not a geographical mark.<sup>216</sup> While the majority in *Barber-Colman* did not address geographical marks, Judge Lenroot referred to geographical marks in his concurring opinion and considered the majority decision as “clearly” overruling the court’s earlier decision in *Plymouth*.<sup>217</sup> The 1933 *Barber-Colman* decision had significant implications for geographical marks.

In *Barber-Colman*, the CCPA distilled from earlier case law that, to the extent that a descriptive mark had acquired secondary meaning, courts could protect such a mark against unfair

<sup>210</sup> *Id.* at 324, n.5. The registration (and the adoption of) a descriptive mark conferred “no right to exclude another from the use of the descriptive features of that mark, if used in such a way as to distinguish the two marks.” *Red Motor Car Co. v. Traffic Motor Truck Corp.*, 55 App. D.C. 227, 227 (C. App. D.C. 1925).

<sup>211</sup> *In re Plymouth Motor Corporation*, 46 F.2d 211 (C.C.P.A. 1931).

<sup>212</sup> *Id.* at 213.

<sup>213</sup> Irvine L. Lenroot, who was nominated by President Herbert Hoover, was confirmed as an associate judge of the CCPA on May 17, 1929. He served on the CCPA until 1944. Prior to becoming a judge, Lenroot had worked as a lawyer and served in the Wisconsin State Assembly (1901–1907) and U.S. Congress (1909–1927).

<sup>214</sup> *In re Plymouth Motor Corporation*, 46 F.2d 211 (C.C.P.A. 1931).

<sup>215</sup> *Barber-Colman Co. v. Overhead Door Corp.*, 65 F.2d 147 (C.C.P.A. 1933).

<sup>216</sup> The mark at issue in the case was OVER HEAD DOOR for garage doors, Registration No. 250,386.

<sup>217</sup> *Barber-Colman Co.*, 65 F.2d at 151 (J. Lenroot concur.).

competition, but the secondary meaning could not turn a merely descriptive mark into a registrable mark.<sup>218</sup> The court referred to a 1920 Court of Appeals for the Second Circuit decision in which the court held that *no* other ten-year period of exclusive use of a descriptive mark other than the single special ten-year period in the 1905 Act<sup>219</sup> would allow a mark to be registered.<sup>220</sup> The CCPA considered this Second Circuit decision to be confirmation of the strict prohibition against the registration of descriptive marks, even if a mark had acquired distinctiveness through use. Even when a mark was found *not* to be “merely descriptive,” it was unregistrable because the finding had to have been based on the mark’s secondary meaning, and the acquisition of secondary meaning could not convert an unregistrable descriptive mark into a registrable one.

In 1936, Judge Lenroot was able to apply the same rationale to geographical marks in *In re Canada Dry Ginger Ale*.<sup>221</sup> The trademark at issue was a map of Canada that was being used for “maltless beverages sold as soft drinks,”<sup>222</sup> and the CCPA held the mark unregistrable.<sup>223</sup> Judge Lenroot, writing for the majority, seized the opportunity to expressly overrule *Plymouth* and extended the reasoning of *Barber-Colman* to geographical marks.<sup>224</sup> The result was that even when a mark was found *not* to be “merely” geographical, the mark was still not registrable, because no secondary meaning could convert a geographical mark into a registrable mark.<sup>225</sup>

It seems apparent from the examples in the previous sections of this article that not all geographical marks that were found to be registrable were held as such because they had acquired secondary meaning. Indeed, some such marks were deemed to be arbitrary in connection with the goods and services that they identified. Nevertheless, court decisions from the second half of the 1930s unequivocally (or nearly unequivocally) held that “if a mark [had] a

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<sup>218</sup> The court referred to dicta in a 1920 decision by the Circuit Court of Appeals for the Second Circuit that stated that while “[t]here [was] much to be said in favor of a registration law which would give legal and governmental sanction to any mark which it could be shown the public had accepted,” such a law would have to have been adopted by Congress. *Hercules Powder Co. v. Newton*, 266 F. 169, 175 (2d Cir. 1920).

<sup>219</sup> On the ten-year period under the 1905 Act, see *supra* note 180 and accompanying text.

<sup>220</sup> *Hercules Powder Co.*, 266 F. at 175.

<sup>221</sup> *In re Canada Dry Ginger Ale*, 86 F.2d 830 (C.C.P.A. 1936).

<sup>222</sup> *Id.* at 831.

<sup>223</sup> *Id.* at 833.

<sup>224</sup> *Id.*

<sup>225</sup> The U.S. Supreme Court used what is arguably a secondary meaning analysis to hold that *Chartreuse* “cannot be regarded in a proper sense as a geographical name.” *Pere Alfredo Luis Baglin v. Cusenier Co.*, 31 S. Ct. 669 (1911). For another example that equates the two analyses (of whether a mark was “merely geographic” and whether the mark was used as a fanciful or arbitrary mark) see the *CELTIC* example in footnotes 197 and 198, above.

descriptive or geographical significance, as well as an identifying one resulting from secondary meaning, it remain[ed] merely or only descriptive or geographical and [was] not entitled to registration.”<sup>226</sup>

Some examples illustrate the effect of this rule since the mid-1930s on marks that were used as arbitrary marks: “Marquette” was held unregistrable notwithstanding the applicant’s argument that the word had “a double meaning, one meaning of which is geographical and the other of which is the name of a famous person no longer living.”<sup>227</sup> “Edgewood” fared no better when the applicant for a composite mark that included the word argued that the mark, “while admittedly geographical, [was] not ‘merely’ so, because it [was] also ‘suggestive of a shady, restful spot where such furniture is used, and was adopted with that thought in mind.’”<sup>228</sup> “Chantelle” was unregistrable for cheese produced in Illinois; although the applicant argued that the term was “a French word meaning a feudal collector of taxes who has the right to live and operate in a feudal manor,”<sup>229</sup> the examiner found the term in *Lippincott’s Gazetteer of the World* as the name of a town in France.<sup>230</sup> Both the examiner and the commissioner found the term “merely geographical,” and the court affirmed their rejection of registration.<sup>231</sup> Even “Antarctica,” a place from which the applicant’s products—soft drinks—could have hardly originated, was held unregistrable.<sup>232</sup>

If a term appeared in a gazetteer, atlas, encyclopedia, or another source as a geographical term, the term was merely geographical and excluded from trademark registration.<sup>233</sup> In *In re Kraft-Phenix Cheese Corp.*, the applicant argued that the term “Chantelle” should not have been considered “merely geographical” because it had “no

<sup>226</sup> *Ex parte* Canada Dry Ginger Ale, Inc., 26 U.S.P.Q. 244, \*5 (Comm’r Pats. & Trademarks 1935) (emphasis added), *aff’d*, 86 F.2d 804 (C.C.P.A. 1936); *but, cf.* R.W. Eldridge Co. v. Southern Handkerchief Mfg. Co., 23 F. Supp. 179, 185 (W.D. South Carolina, 1938) (holding that “[t]he term ‘All American’ with its well-established secondary meaning is thus not within the prohibition of the act.”).

<sup>227</sup> *Ex parte* Grommes & Ullrich, Inc., 27 U.S.P.Q. 152 (Comm’r Pats. & Trademarks 1935).

<sup>228</sup> *Ex parte* Hettrick Mfg. Co., 32 U.S.P.Q. 164 (Comm’r Pats. & Trademarks 1937).

<sup>229</sup> *In re* Kraft-Phenix Cheese Corp., 120 F.2d 391, 392 (C.C.P.A. 1941).

<sup>230</sup> *Id.* at 391.

<sup>231</sup> *Id.* at 392.

<sup>232</sup> *Companhia Antarctica Paulista v. Coe*, 146 F.2d 669, 669 (D.C. Cir. 1945).

<sup>233</sup> Geographical terms continued to appear in registered trademarks as components of composite marks. For example, among the marks registered in 1938 were marks that included terms such as “American,” “Arkansas,” “Bostonian,” “California,” “Canadian,” “Chesterton,” “Chicago,” “Chinese,” “Dutch,” “Fifth Avenue,” “German,” “Hawaii,” “Hollywood,” “Italian,” “Java,” “Kentucky,” “Maryland,” “Navajo,” “Ocean City,” “Paris,” “San Diego,” “Savannah,” “Saxon,” “St. Louis,” “Tennessee,” “Worcester,” and “Wormser.” *Index of Trade-Marks Issued from the United States Patent Office, 1938*, at 449–466 (1938).

geographical significance to people of the United States.”<sup>234</sup> However, the CCPA pointed out that “[t]he [1905] statute, in prohibiting the registration of geographical terms made no exemption in favor of those which lacked importance or of those which were not well known by the people in this country.”<sup>235</sup> The CCPA decided the “Chantelle” case in 1941, about halfway through the years of discussions in Congress of bills that would eventually lead to the adoption of the Lanham Act.<sup>236</sup>

Edward S. Rogers, the “dean of the trademark and unfair competition field of law,”<sup>237</sup> prompted the introduction into the trademark bill of the language that limited the application of provisions on geographical marks to marks that were “primarily geographic.”<sup>238</sup> In 1938, Rogers complained about the pre-Lanham Act practice of the Patent Office that it simply “[took] a word without reference to its connotation, and if it appear[ed] in the atlas anywhere as the name of a place, or if it appear[ed] in the Postal Guide they [said] that [it was] a geographical name or term, and hence [was] not registrable.”<sup>239</sup> Although as the previous sections of

<sup>234</sup> *In re Kraft-Phenix Cheese Corp.*, 120 F.2d at 392.

<sup>235</sup> *Id.*, 392.

<sup>236</sup> A bill for the new trademark statute was presented to the ABA as early as 1920 and to Congress as early as 1924, but the bill that was to become the Lanham Act was introduced in Congress only in 1938. Joe Cleveland, Fritz Garland Lanham: Father of American Trademark Protection 28–30 (2021). For background on Rogers’s bills and the bills presented in Congress, see Jessica Litman, *Edward S. Rogers, the Lanham Act, and the Common Law*, in Robert G. Bone & Lionel Bentley, *Research Handbook on The History of Trademark Law* (forthcoming 2023), available at <https://ssrn.com/abstract=3932701> (last visited Apr. 27, 2022).

<sup>237</sup> William T. Woodson, *A Profile of Edward S. Rogers*, 62 TMR 177, 177 (1972). On Rogers’s contributions to trademark law and unfair competition law, including international law, see Farley, *supra* note 158, 755-768.

<sup>238</sup> Hearings on H.R. 4744 before the Subcomm. on Trade-Marks of the House Comm. on Patents, 76th Cong., 1st Sess., at 19 (1939).

As early as in an 1895 decision, Assistant Commissioner Fisher had proposed a classification of geographical names to simplify the determination of when names were geographical: The first type of geographical names were those that were “well known and in common use,” which were never to be registered. The second type were “words which in their primary significance [were] not geographical, even though they may appear in the Postal Guide or similar publications”; because “it cannot be said that they are ‘words in common use as designating locality or section of a country,’” such words should be registered. The third type were words that had a primarily geographical meaning, such as “Lake City,” “Charleston,” “Hampshire,” and “Vermont”; as was the case with the words of the first type, such words would not be registered. *Ex parte Hendley*, 72 O.G. 1654, C.D. (1895).

On Edward S. Rogers and the Lanham Act see S.P. Ladas, *The Contribution of Edward S. Rogers in the Int’l Field of Industrial Property*, 62 TMR 197 (1972); Litman, *supra* note 236.

<sup>239</sup> House Comm. on Patents, 75th Cong., 3d Sess., at 71–72 (1938). Commenting further on the practice of the Patent Office under the 1905 Act, Rogers noted that “[e]verybody knows that in any statute sometimes a bunch of rubbish gets accumulated around your structure.” *Id.*, 72; see also Joe E. Daniels, *Trade-Marks from the Patent Office Point of*

this article suggest, this statement did not reflect the full picture of the pre-Lanham Act practice, it captured the situation after the mid-1930s, and some notably “absurd results”<sup>240</sup> provided useful illustrations in support of the proposed change to the law.

Rogers’s influence on the wording of the Lanham Act is well documented,<sup>241</sup> and his interest in geographical marks should not be surprising given his professional experience that shaped his views on the pre-Lanham Act law of geographical marks. Rogers represented Canada Dry Ginger Ale, Inc., in *In re Canada Dry Ginger Ale*,<sup>242</sup> where Judge Lenroot in 1936 de facto rendered all geographical marks unregistrable.<sup>243</sup> The impact of the case might explain why Rogers’s earlier (1921) preliminary draft of a new trademark act, which he prepared for the American Bar Association,<sup>244</sup> did not mention geographical marks; section 2 of the draft bill prohibited registration generally of a mark likely “to deceive purchasers as to the source or origin of the goods in

*View*, 39 T.M.R. 383, 384 (1949) (Assistant U.S. Commissioner of Patents recalling the Office’s practice under the 1905 Act in his paper delivered before an annual meeting of the United States Trade-Mark Association in New York on May 24, 1949).

<sup>240</sup> Mr. Rogers referred to “Humble,” “Ramsay,” and “Little Shop”—all recent cases at that time in which the Patent Office based its rejection on the fact that there were geographical places with these names. House Comm. on Patents, 75th Cong., 3d Sess., at 72 (1938); see also, e.g., McCarthy, *supra* note 1, § 14:27 (5th ed.); *Companhia Antarctica Paulista v. Coe*, 146 F.2d 669, 669 (D.C. Cir. 1945) (rejecting the argument that “the public knows that Antarctica is an uninhabited country and therefore cannot be the origin of the product—since the use of the geographical term is fanciful it is more than ‘merely geographical’”); *Application of Westgate Sea Prods. Co.*, 154 F.2d 1010, 1011 (C.C.P.A. 1946) (finding that “Westgate is a geographical word even though it is the name of inconsequential towns”).

<sup>241</sup> E.g., Walter J. Derenberg, *The Contribution of Edward S. Rogers to the Trademark Act of 1946 in Historical Perspective*, 62 TMR 189 (1972).

<sup>242</sup> *In re Canada Dry Ginger Ale*, *supra*, 86 F.2d 804 (C.C.P.A. 1936).

<sup>243</sup> See also the discussion of the decision and its predecessors at *supra* notes 213–225 and accompanying text. Mr. Rogers recounted the Canada Dry trademark matters during a House Committee hearing in 1938. House Comm. on Patents, 75th Cong., 3d Sess., at 139–140 (1938). Mr. Rogers also described what the company did after it lost the case concerning the trademark for its ginger ale:

“I am trying not to be emotional, but that suit had a byproduct that struck me as intensely amusing. The Canada Dry Co, put out afterward a sparkling water which they called ‘Canada Dry Sparkling Water.’ The Patent Office did not make any objection to that mark. They stated that dry water was impossible, therefore the mark was purely arbitrary and fanciful, and therefore was entitled to registration. And ‘Canada Dry’ as a trade-mark on the water was held as a valid trade-mark, but the same mark applied to the gingerale, which is really valuable, they could not get.” *Id.* at 140.

<sup>244</sup> The committee that explored revisions of the 1905 Trademark Act was appointed at a meeting of the Patent Section of the American Bar Association in 1920. Cleveland, *supra* note 236, at 28. The 1921 draft bill was approved at the ABA annual meeting in 1922. *Id.*

connection with which such mark is used,”<sup>245</sup> but it did not expressly mention geographical marks. The later-introduced “Vestal Bill” included a prohibition against registration of “a mark which when applied to the goods of the applicant has a merely descriptive or geographical meaning”;<sup>246</sup> under the bill, such marks were registrable if they acquired secondary meaning.<sup>247</sup> Congress never passed the Vestal Bill,<sup>248</sup> but the Lanham Act was adopted in July 1946 with geographical marks-specific provisions, which are discussed in the next section.

In August 1946, shortly after the adoption of the Lanham Act, the Court of Appeals for the Second Circuit interpreted the Act’s treatment of geographical marks as Congress’ codification of common law principles, which prohibited the registration of “generically descriptive” names such as “Pennsylvania wheat” and “Virginia tobacco,” and which allowed exclusive rights when geographical names were used as arbitrary marks.<sup>249</sup> Neither *Barber-Colman Co. v. Overhead Door Corp.*,<sup>250</sup> nor *In re Canada Dry Ginger Ale*<sup>251</sup> appeared among the cases that the Second Circuit Court cited in its August 1946 majority opinion,<sup>252</sup> which omission suggests that in the geographical marks area, the majority of the court panel might have viewed the two cases and their progeny as a deviation from previously established principles.<sup>253</sup>

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<sup>245</sup> Preliminary Draft of Trade-Mark Act, section 2(f), reprinted in *Text of Proposed New Trade-mark Law*, Printer’s Ink, June 23, 1921, Vol. 115, 77–82, at 77.

<sup>246</sup> H.R. 6248, 69th Cong. (1925), section 2. Edward S. Rogers mentioned the Vestal Bill when he explained the system of an A and a B register—the principal and supplemental registers—in Edward S. Rogers, *Some Suggestions Concerning the International Trade Mark Situation*, 36 Yale L.J. 235, 242 (1926).

<sup>247</sup> H.R. 6248, 69th Cong. (1925), §§ (e) and (f). On Edward S. Rogers’s suggestion that Article 23 of the General Inter-American Convention for Trade Mark and Commercial Protection refers specifically to the prohibition of every illegal “indication of geographical origin or source” see Christine Haight Farley, *The Protection of Geographical Indications in the Inter-American Convention*, 6(1) WIPO J. 52, 57–58 (2014).

<sup>248</sup> See also Cleveland, *supra* note 236, at 28.

<sup>249</sup> *LaTouraine Coffee Co. v. Lorraine Coffee Co.*, 157 F.2d 115, 116 (2d Cir. 1946).

<sup>250</sup> 65 F.2d 147, 151 (C.C.P.A. 1933).

<sup>251</sup> *In re Canada Dry Ginger Ale*, 86 F.2d 830 (C.C.P.A. 1936).

<sup>252</sup> The dissenting judge referred to *In re Canada Dry Ginger Ale* in his dissenting opinion. *LaTouraine Coffee Co.*, 157 F.2d at 121 (Frank, J., dissenting.).

<sup>253</sup> *LaTouraine Coffee Co.*, 157 F.2d at 116 (holding LATOURAINE to be a protectable trademark). Post-Lanham Act, courts have continued to refer to pre-Lanham Act decisions in the context of geographical marks. *E.g.*, *Forschner Grp., Inc. v. Arrow Trading Co. Inc.*, 30 F.3d 348, 355, n.5 (2d Cir. 1994).

### 1.4. The Lanham Act and Geographical Marks Before and After the 1993 NAFTA Amendment

The Lanham Act, passed in 1946, originally referred to—and still refers to—marks that are “primarily” geographical;<sup>254</sup> marks that are not primarily geographical may be treated as arbitrary or fanciful.<sup>255</sup> In its original wording from 1946, the Lanham Act referred only to two types of geographical marks—primarily geographically descriptive marks and primarily geographically deceptively misdescriptive marks; both of these types of marks were registrable on the supplemental register,<sup>256</sup> and after they had acquired secondary meaning and become distinctive they could be registered on the principal register.<sup>257</sup>

A 1941 draft of the Lanham Act bill denied registration on the principal register to marks that were “primarily geographically descriptive” of an applicant’s goods, and the bill made an exception for “indications of regional origin,” which were registrable as collective marks.<sup>258</sup> During a congressional hearing, geographically misdescriptive marks were added to the provision with “primarily geographically descriptive” marks, but later debate clarified that geographically misdescriptive marks were registrable as long as

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<sup>254</sup> Lanham Act, § 2(e), 15 U.S.C. § 1052(e). For a discussion of the provision in the larger context of the 1905 Act see Brauneis & Schechter, *supra* note 3, at 6–7.

<sup>255</sup> *In re Charles S. Loeb Pipes, Inc.*, 190 U.S.P.Q. 238, 244 (T.T.A.B. 1975) (“If the notation in question does not convey an immediate or readily recognizable geographical significance to the average consumer, the mark is manifestly arbitrary . . .”); *In re Dixie Ins. Co.*, 223 U.S.P.Q. 514, 516 (T.T.A.B. 1984) (“Dixie” held not primarily geographically descriptive of property and casualty underwriting services where the examining attorney provided no evidence to show that the geographical significance of “Dixie” was its primary significance); *Forschner Grp., Inc.*, *supra*, 30 F.3d at 354 (“a geographic term may enjoy trademark protection without a showing of secondary meaning when it is used in an arbitrary or suggestive manner, taking into account the nature of the goods or services at issue.”). See also the continuing exception for a trademark that includes a geographical term referring to a location owned by the applicant, such as in *In re Pebble Beach Co.*, 19 U.S.P.Q.2d 1687, \*2 (T.T.A.B. 1991) (“Today, because ‘17 MILE DRIVE’ continues to refer to a place owned by applicant, to the extent that ‘17 MILE DRIVE’ is descriptive of goods or services originating at that location it is identifying goods or services originating with applicant.”) and *In re Kapalua Land Co., Ltd.*, 2013 WL 2951784,\*5 (T.T.A.B. 2013) (“KAPALUA did not signify a geographic place before applicant adopted the term to designate the origin of its services and it continues to serve the function of designating source,” and also there was no “manufacturer or other commercial enterprise in a place named ‘Kapalua’ outside of applicant’s ownership or control.” *Id.*).

<sup>256</sup> For the predecessor of the supplemental register under the 1920 Act see *supra* note 205 and accompanying text.

<sup>257</sup> Lanham Act §§ 2(e)(2) and (f) (1988); see also *In re Charles S. Loeb Pipes, Inc.*, 190 U.S.P.Q. 238.

<sup>258</sup> H.R. 102, 77th Cong., 1st Sess., at 2–3, § 2(e) and § 4. The 1938 version of the bill denied registration without secondary meaning to “a mark which when applied to the goods of the applicant has merely a descriptive or geographical meaning.” H.R. 9041 (1938), § 3(e).

they were not deceptive.<sup>259</sup> Although it was suggested that the general provision prohibiting registration of any deceptive marks would have sufficed to cover geographically misdescriptive marks that were also deceptive, Mr. Lanham proposed that “deceptively misdescriptive” be used instead of just “misdescriptive,” and Mr. Rogers responded, “[t]here cannot be any objection to that.”<sup>260</sup> In the end, both geographically deceptively misdescriptive marks and “indications of regional origin” appeared in the Lanham Act as it was adopted in 1946.<sup>261</sup>

The two references to deceptive marks in the 1946 Lanham Act—deceptive marks in section 2(a) and primarily geographically deceptively misdescriptive marks in section 2(e)(2)—resulted in more confusion than clarity. The delineation of the difference between the two categories of marks was important because deceptive marks under 2(a) were unregistrable, while primarily geographically deceptively misdescriptive marks under 2(e)(2) could be registered on the supplemental register and subsequently registered on the principal register after they had acquired secondary meaning.<sup>262</sup>

The TTAB tried to justify the existence of the two seemingly mutually inconsistent provisions in 2(a) and 2(e)(2). In its 1969 decision in *In re Amerise*, the TTAB concluded from the language of the Lanham Act that “the persons instrumental in the framing of the Lanham Act [must have] attributed different meanings to the terms ‘deceptive’ and ‘primarily geographically deceptively misdescriptive.’”<sup>263</sup> The TTAB surmised that for any geographical mark to be deceptive and unregistrable under 2(a), the mark must have been used “with the intention thereby of inducing or misleading a particular class of consumers into purchasing this product.”<sup>264</sup> Having admitted evidentiary issues concerning a proof of intent, the TTAB concluded that “intent [could be] inferred . . . where a geographical area or place [was] well-known for the particular product.”<sup>265</sup> Marks that were geographically misdescriptive, but for which no intent to induce or mislead was proven or inferred, were in the category of primarily geographically deceptively misdescriptive marks under 2(e)(2).<sup>266</sup>

<sup>259</sup> H.R. 102, 77th Cong., 1st Sess., at 84–85.

<sup>260</sup> H.R. 102, 77th Cong., 1st Sess., at 85. For a discussion of the provisions in light of U.S. international relations see H.R. 102, 77th Cong., 1st Sess., at 87 (Mr. Lanham) and also *infra* Part III, Section 2.

<sup>261</sup> Lanham Act § 2(e)(2) (1946).

<sup>262</sup> Lanham Act § 2(f), 15 U.S.C. § 1052(f).

<sup>263</sup> *In re Amerise*, 160 U.S.P.Q. 687, \*2 (T.T.A.B. 1969).

<sup>264</sup> *Id.* at \*3.

<sup>265</sup> *Id.*

<sup>266</sup> *Id.*



Because the 1946 wording of the Lanham Act treated primarily geographically descriptive marks and primarily geographically deceptively misdescriptive marks identically (both were registrable on the supplemental register until they had acquired secondary meaning), TTAB practice evolved so that the only classification that was required was whether a mark was primarily geographical.<sup>267</sup> The descriptive or misdescriptive nature of the mark did not matter; if the term, “when applied to the goods or services of the applicant, convey[ed] to consumers primarily or immediately a geographical connotation,”<sup>268</sup> registration on the principal register was denied,<sup>269</sup> and only registration on the supplemental register was possible.<sup>270</sup> This result harmed marks that were primarily geographically misdescriptive while not being deceptive, because such marks had previously been registered on the principal register as arbitrary or fanciful marks, but were no longer registrable on the principal register.

The CCPA perceived this TTAB practice to be a continuation of the undesirable pre-Lanham Act practice of refusing registration to all geographical marks. In its 1982 decision in *In re Nantucket, Inc.*, the CCPA warned that if the TTAB practice continued, the practice “would [have] resurrect[ed] most if not all of the pre-Lanham Act practice with respect to such [marks].”<sup>271</sup> The CCPA seemed to have been referring only to the practice from the mid-1930s to the mid-1940s; as was discussed earlier, before the mid-1930s, marks that were geographically misdescriptive (but not deceptive) were held to be registrable,<sup>272</sup> and therefore any post-Lanham Act TTAB practice that resulted in such marks being held unregistrable was contrary to pre-mid-1930s law. But it is important to note that the TTAB practice resulted “only” in denials of registration on the principal register; the marks were registrable on the supplemental register and, with secondary meaning, could move to the principal register.

In *In re Nantucket, Inc.*, the CCPA overruled the TTAB practice; the court emphasized the need to limit the application of Lanham Act section 2(e)(2) to primarily geographically *deceptively* misdescriptive marks and not sweep into the rule marks that were

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<sup>267</sup> The TTAB noted that “its test for registrability of geographic terms [was] ‘easy to administer.’” *In re Nantucket, Inc.*, 677 F.2d 95, 97 (C.C.P.A. 1982) (quoting the TTAB).

<sup>268</sup> *In re Nantucket, Inc.*, 209 U.S.P.Q. 868, 871 (T.T.A.B. 1981).

<sup>269</sup> *Id.*

<sup>270</sup> The TTAB’s understanding seems to have been aligned with the understanding of at least one U.S. House representative during the debate of the bill. H.R. 102, 77th Cong., 1st Sess., at 86 (Mr. Pohl). A conspicuous note in the record refers to an off-the-record discussion following Mr. Pohl’s comment. *Id.*

<sup>271</sup> *In re Nantucket, Inc.* 677 F.2d 95, 99 (C.C.P.A. 1982).

<sup>272</sup> See *supra* notes 196–203 and accompanying text.

primarily geographically misdescriptive, but not deceptive.<sup>273</sup> Therefore, the court ruled that the analysis would have to proceed past the first step (whether a mark was primarily geographical) and proceed to assess misdescriptiveness and the goods/place association, because “geographically deceptive misdescriptiveness cannot be determined without considering whether the public associates the goods with the place which the mark names.”<sup>274</sup> The court explained that “[i]f the goods do not come from the place named, and the public makes no goods-place association, the public is not deceived and the mark is accordingly not geographically *deceptively* misdescriptive.”<sup>275</sup> The court quoted with approval earlier post-Lanham Act cases in which primarily geographically misdescriptive (but not deceptive) marks were registered because they were used as arbitrary marks, such as DUTCH and DUTCH BOY for paint<sup>276</sup> and WORLD for a carpet business.<sup>277</sup> Just as they had been before the mid-1930s, after *Nantucket*, marks that were primarily geographically misdescriptive, but not primarily geographically deceptively misdescriptive, were registrable as arbitrary or fanciful marks.<sup>278</sup>

After *Nantucket*, the TTAB in 1983 altered its approach to the delineation of the difference between geographically deceptively misdescriptive marks under 2(e)(2) and deceptive marks under 2(a). In *In re House of Windsor*, the TTAB abandoned intent as the decisive factor in distinguishing between the two types of marks and instead drew the dividing line based on the materiality test. If deception was material to the purchasing decision, a mark was deceptive under 2(a) and denied registration;<sup>279</sup> if the deception was not material to the purchasing decision, the mark was primarily geographically deceptively misdescriptive under 2(e)(2) and therefore registrable on the supplemental register, and on the principal register after it had acquired secondary meaning.<sup>280</sup> The

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<sup>273</sup> *In re Nantucket*, 677 F.2d 95. The CCPA referred to its earlier decision concerning a non-geographical misdescriptive mark, in which the CCPA stated that “[t]he proscription is not against misdescriptive terms unless they are also deceptive.” *In re Automatic Radio Mfg. Co.*, 404 F.2d 1391, 1396, 160 U.S.P.Q. 233, 236 (C.C.P.A. 1969).

<sup>274</sup> *In re Nantucket, Inc.* 677 F.2d 95, 99 (C.C.P.A. 1982).

<sup>275</sup> *Id.* at 99 (emphasis added).

<sup>276</sup> *Nat'l Lead Co. v. Wolfe*, 223 F.2d 195, 199 (9th Cir. 1955), *cert. denied*, 350 U.S. 883 (1955).

<sup>277</sup> *World Carpets, Inc. v. Dick Littrell's New World Carpets*, 438 F.2d 482, 486 (5th Cir. 1971).

<sup>278</sup> *E.g., In re Sharky's Drygoods Co.*, 23 U.S.P.Q.2d 1061 (T.T.A.B. 1992) (PARIS BEACH CLUB for T-shirts and sweatshirts); *see also* Brauneis & Schechter, *supra* note 3, at 10 (noting that “[i]n any number of pre-1982 cases, the TTAB and the courts held that clearly geographic terms could be registered without a showing of secondary meaning because they were ‘arbitrary’ for the goods in question.”).

<sup>279</sup> *In re House of Windsor, Inc.*, 221 U.S.P.Q. 53, \*4 (T.T.A.B. 1983).

<sup>280</sup> *Id.* at \*4. *See also supra* note 61 and accompanying text.

TTAB suggested that “the deception [would] most likely be found not to be material” in cases when “the geographical area named in the mark [was] an area sufficiently renowned to lead purchasers to make a goods-place association but the record [did] not show that goods like applicant’s or goods related to applicant’s [were] a principal product of that geographical area.”<sup>281</sup> Needless to say, the line between the two categories was somewhat blurry.

In 1993, Congress amended the Lanham Act to comply with U.S. obligations under the North American Free Trade Agreement (“NAFTA”).<sup>282</sup> The amendment moved primarily geographically deceptively misdescriptive marks from 2(e)(2) to a separate provision of 2(e)(3) and made them unregistrable, as were deceptive marks.<sup>283</sup> This change to the statute put pressure on distinguishing more accurately between geographically misdescriptive marks and primarily geographically deceptively misdescriptive marks; after the amendment, the difference between the two categories was no longer the difference between registrability on the principal register versus registrability on the supplemental register, but the difference between registrability on the principal register versus no registrability at all.

The CAFC decided, in *In re California Innovations, Inc.*, that the NAFTA Implementation Act subjected primarily geographically deceptively misdescriptive marks to the same treatment as any other deceptive marks.<sup>284</sup> After the decision in *In re California Innovations, Inc.*, the test for primarily geographically deceptively misdescriptive marks under 2(e)(3) was changed to be identical to the test for deceptive marks under 2(a), and the test now analyzes not only whether a mark is primarily geographical and misdescriptive and whether the goods/place association exists, but also whether “the goods-place association made by the consumer is material to the consumer’s decision to purchase those goods.”<sup>285</sup>

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<sup>281</sup> *Id.*, \*4. In *In re House of Windsor*, the TTAB affirmed the refusal to register BAHIA for cigars because it found that the mark was deceptive under section 2(a). *Id.*, \*5.

<sup>282</sup> North American Free Trade Agreement, Dec. 17, 1992, art. 1712, 32 I.L.M. 605; North American Free Trade Agreement Implementation Act, Pub. L. No. 103-182, 107 Stat. 2057 (1993).

<sup>283</sup> Lanham Act, §§ 2(e)(3) and (f) (2000).

<sup>284</sup> *In re California Innovations, Inc.*, 329 F.3d 1334, 1338-39 (Fed. Cir. 2003). Geographical indications for wines and spirits have also been excluded from registration since the post-NAFTA Lanham Act, and for these marks this is the case even if the marks are not deceptive. Lanham Act § 2(a), 15 U.S.C. § 1052(a).

<sup>285</sup> *In re California Innovations, Inc.*, 329 F.3d at 1340; see also *In re Spirits Int’l, N.V.* 563 F.3d 1347, 1353 (Fed. Cir. 2009) (clarifying that “the appropriate inquiry for materiality purposes is whether a substantial portion of the relevant consumers is likely to be deceived, not whether any absolute number or particular segment of the relevant consumers (such as foreign language speakers) is likely to be deceived”). Additionally, “the PTO may raise an inference in favor of materiality with evidence that the place is famous as a source of the goods at issue.” *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1374 (Fed. Cir. 2003).

Some commentators have observed that the addition of the materiality requirement made it more difficult to show the deceptiveness of a geographically misdescriptive mark.<sup>286</sup> However, the effect of the inclusion of the materiality test might be weakened by the fact that, according to the CAFC, “an inference in favor of materiality [may be raised] with evidence that the place is famous as a source of the goods at issue.”<sup>287</sup> On the other hand, this inference applies only if a sufficiently strong association is found, which is not always the case,<sup>288</sup> and in cases of service marks, the inference requires “a very strong services-place association.”<sup>289</sup> The narrowing of the category of primarily geographically deceptively misdescriptive marks makes more geographically misdescriptive marks registrable immediately on the principal register;<sup>290</sup> marks that would have been in the primarily geographically deceptively misdescriptive marks category prior to *In re California Innovations* but that do not meet the materiality test are now, after *In re California Innovations*, simply geographically misdescriptive (but not deceptive) and consequently registrable on the principal register as arbitrary or fanciful marks.<sup>291</sup>

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<sup>286</sup> Durham, *supra* note 2, at 1201 (“Congress’s post-NAFTA amendments made challenging ‘primarily geographically deceptively misdescriptive’ marks more difficult.”); Naeve, *supra* note 3, at 469 (“the court misinterpreted the NAFTA amendments and unnecessarily raised the standard for rejecting a primarily geographically deceptively misdescriptive mark.”); *see also* LaFrance, *supra* note 3, at 141 (pointing out that “[a]fter all, if Congress had intended for both the same legal test and the same legal consequences to apply, it makes little sense for Congress to have retained two separate categories for these marks rather than combine them into one.”).

For a discussion of the compliance of post-*In re California Innovations* law with international IP law *see infra* Part III, Section 2.

<sup>287</sup> *In re Les Halles de Paris J.V.*, 334 F.3d 1371, 1374 (Fed. Cir. 2003); *see also, e.g., In re Beaverton Foods, Inc.*, 84 U.S.P.Q.2d 1253, \*6 (T.T.A.B. 2007) (in the case of an application for “Napa Valley Mustard Co.” for “condiments, namely mustard,” “NAPA VALLEY is a well-known geographic location and . . . it is also sufficiently known for mustard and other gourmet items for such location to be a material factor in the purchasing decision.”).

<sup>288</sup> *See, e.g., United States Playing Card Co. v. Harbro, LLC*, 81 U.S.P.Q.2d 1537 \*7 (T.T.A.B. 2006) (“the goods-place association between playing cards and VEGAS is merely indirect” and not sufficient for “the Board [to] presume that the geographical connection between the place and the goods led to the consumer’s decision to purchase the goods.” (Internal quotation omitted)).

<sup>289</sup> *In re Les Halles de Paris J.V.*, 334 F.3d at 1375.

<sup>290</sup> *Cf. Durham, supra* note 2, at 1200 (commenting on the change made by the NAFTA amendment, that “[t]he apparent effect of this change is to narrow the range of geographic trademarks eligible for protection by denying ‘primarily geographically deceptively misdescriptive’ marks the saving grace of secondary meaning.”).

<sup>291</sup> *E.g., In re Hiromichi Wada*, 194 F.3d 1297, 1300 (1999) (“a mark with a geographic term used fancifully or arbitrarily may be registered like any other fanciful or arbitrary mark”); *see also Brauneis & Schechter, supra* note 3, at 18 (commenting that *In re California Innovations* “create[d] a category of geographically misdescriptive marks that are immediately registrable . . .”).

### 1.5. The Elimination of the Lanham Act's Geographical Marks–Specific Provisions in Light of the Historical Development of U.S. Trademark Law

The historical developments discussed in the sections above may be interpreted as follows: The law of geographical marks evolved relatively consistently until the mid-1930s, when CCPA decisions deviated from the previous trajectory of trademark law. The Lanham Act bill was drafted in order to correct the mid-1930s to mid-1940s practice with the objective of returning the law of geographical trademarks to its original, pre-mid-1930s path. However, as it was originally adopted in 1946, the Lanham Act created confusion about deceptive geographical marks; following some later clarifications, the law of geographical marks returned de facto to its original pre-1930s trajectory, making the geographical marks–specific provisions of the Lanham Act unnecessary.

In light of the historical developments, it is not surprising that the outcome of the application of the current law of geographical trademarks remarkably resembles the outcome of the application of the pre-1930s law. An inventory of the treatment of the various types of geographical marks under current law supports the following conclusions:

(a) Geographical marks that are generic are not registrable, just as any other generic marks are not. “Lackawanna coal,” if it were established today as a term used generically for coal mined in Lackawanna, Pennsylvania, would still not be registrable.<sup>292</sup>

(b) Marks that include geographical terms, but which are not perceived to have a geographical meaning, are registrable on the principal register. Therefore, DELTA would again be registrable for hardware.<sup>293</sup>

(c) Geographical marks that are used as arbitrary or fanciful marks are registrable on the principal register. Therefore, SELMA would be registrable for washing machines.<sup>294</sup> Even though such marks are found to be “primarily geographical,” they are primarily geographically misdescriptive (but not deceptive) marks and are registrable on the principal register.<sup>295</sup>

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<sup>292</sup> See *Canal Co.*, 80 U.S. 311 (1871), discussed above in Part III, Section 1.1. The Lackawanna Coal Mine closed in 1966.

<sup>293</sup> See *Ex parte Manogue-Pidgeon Iron Co.*, 97 O.G. 2084 (1901), discussed in Part III, Section 1.1, above; see *In re Newbridge Cutlery Co.*, 776 F.3d at 864.

<sup>294</sup> See *Ex parte Huenefeld*, 98 O.G. 1968, 1969 (1902), discussed in Part III, Section 1.1, above.

<sup>295</sup> Brauneis & Schechter stated that *In re California Innovations* “create[d] a category of geographically misdescriptive marks that are immediately registrable” (Brauneis & Schechter, *supra* note 3 at 18), but, arguably, the category existed even before the Lanham Act. See *supra* notes 167–173 and 196–203 and accompanying texts.

(d) Primarily geographically descriptive marks with secondary meaning are registrable on the principal register. By acquiring secondary meaning, marks are no longer perceived by consumers as solely associated with their descriptive quality but also as indicating a particular source of the relevant goods or services.

(e) Primarily geographically descriptive marks without secondary meaning, while they are registrable on the supplemental register, do not, in fact, enjoy protection against other marks that are identical or confusingly similar unless the first marks have acquired secondary meaning. Only when these marks have acquired secondary meaning may their owners prevail in a suit for trademark infringement<sup>296</sup> and enjoy the benefits of registration on the principal register.<sup>297</sup> Adopters of primarily geographically descriptive marks may make an unfair competition claim under section 43(a) to defend themselves against those who use the marks to cause confusion or mistake, or to deceive, or to misrepresent the origin of their goods.<sup>298</sup>

(f) Geographical marks that are deceptive are not registrable on either the principal or supplemental registers. The test for the deceptiveness of geographical marks is identical to the test for other, non-geographical deceptive marks.

(g) The prohibition against registration of geographical indications for wine and spirits—irrespective of consumer confusion—is a requirement of modern international trademark law;<sup>299</sup> the 1994 Uruguay Round Agreements Act<sup>300</sup> inserted this prohibition in the Lanham Act.<sup>301</sup> Although the rule did not exist before 1994, the rule may nevertheless be regarded as consistent with pre-1930s law if it is interpreted as establishing a legal fiction that all misdescriptive indications used for wines and spirits are automatically deceptive.<sup>302</sup>

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<sup>296</sup> Lanham Act, § 32, 15 U.S.C. §1114.

<sup>297</sup> Registration on the supplemental register does not provide a presumption of validity, and in litigation a trademark owner must prove validity and ownership of a protectable trademark to bring an action for trademark infringement under section 32 of the Lanham Act.

<sup>298</sup> Lanham Act, § 43, 15 U.S.C. § 1125(a). Although ownership of a protectable trademark is not required for a claim of unfair competition under section 43(a), to bring a 43(a) claim, the injured party must show that it incurred “an injury to a commercial interest in reputation or sales” and that the injury was proximately caused by the infringer’s violations of section 43(a). *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697, 707 (Fed. Cir. 2016).

<sup>299</sup> TRIPS Agreement, *supra* note 54, Article 23(2).

<sup>300</sup> PL 103-465, Dec. 8, 1994, 108 Stat 4809, § 522.

<sup>301</sup> Lanham Act, § 2(a), 15 U.S.C. § 1052(a).

<sup>302</sup> Not all geographical indications must be geographical marks; *see infra* Part III, Section 2.

As demonstrated above, the current law of geographical marks leads to results that are consistent with pre-1930s law, which functioned without geographical marks–specific statutory language. The 1905 Act did include a provision that made unregistrable a mark that consisted of “merely a geographic name or term,”<sup>303</sup> but the provision existed within the context of general common law rules that also governed the registration and protection of geographical marks—rules that Congress left intact when it adopted the 1905 Act. As far as the historical development of U.S. trademark law is concerned, there appears to be no reason for the continued existence of geographical marks–specific provisions in the Lanham Act.

## ***2. Elimination of Geographical Marks–Specific Provisions in the Context of U.S. International Obligations***

An important aspect to consider when changing trademark law is whether any proposed amendments align trademark law with international IP obligations. The United States is a party to several international IP treaties,<sup>304</sup> and if it is to comply with its international obligations, any changes to its trademark law must comport with the treaties.

This section analyzes whether the change that this article proposes—the elimination of the geographical marks–specific provisions from the Lanham Act—would affect U.S. compliance with international IP law. It is beyond the scope of this article for this section to analyze fully the extent to which U.S. federal and state trademark laws comply with international IP law; rather, this section focuses on those international obligations that may affect the geographical marks–specific provisions of the Lanham Act.

The first subsection below discusses the Lanham Act’s geographical marks–specific provisions that were directly shaped by U.S. international IP obligations; the second subsection reviews the compliance of this article’s proposal with international IP obligations; and the third subsection focuses on gaps in the

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<sup>303</sup> 33 Stat. 724 § 5(b). For a discussion of the provision in the larger context of the 1905 Act, see Brauneis & Schechter, *supra* note 3, at 6-7.

<sup>304</sup> The relevant multilateral treaties for the purposes of this article are the Paris Convention, the General Inter-American Convention for Trademark and Commercial Protection, the TRIPS Agreement, the United States–Mexico–Canada Agreement, and other trade treaties that have IP law provisions and to which the United States is a party. The United States is also a party to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks; however, the Protocol is not directly relevant to the proposal in this article. The United States is not a party to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration.

This article refers in footnotes to other U.S. treaties with international IP law obligations, namely free trade agreements.

compliance and on whether the elimination of the Lanham Act’s provisions would affect U.S. compliance with the obligations. The abbreviated review in this section supports the conclusion that the elimination of the current geographical marks–specific provisions of the Lanham Act<sup>305</sup> would not decrease the level of U.S. compliance with international IP law.

### **2.1. The Lanham Act and the Effects of International Law Regarding Geographical Indications (and Other Indications of Origin)**

International treaties do not refer to “geographical marks” and do not set any express requirements concerning geographical marks as they are defined in U.S. law, but some of the treaties do include provisions on “geographical indications” or “indications of source” (“geographical indications”)<sup>306</sup>—a category of IP that does not exist as a separate category in the United States, but that does exist in other countries. In the absence of this separate category of IP in its law, the United States asserts its compliance with the international treaty provisions on geographical indications primarily through its trademark law.<sup>307</sup>

The Lanham Act bill was not without traces of geographical indications–related international obligations. Edward Rogers, who was instrumental in the design of the geographical marks–specific provisions of the Lanham Act,<sup>308</sup> had been personally involved in the negotiations of the General Inter-American Convention for Trademark and Commercial Protection (the “Inter-American Convention”),<sup>309</sup> which today is a less known and largely forgotten

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<sup>305</sup> See *supra* Part II, Section 2, for the proposal.

<sup>306</sup> For the various terms used in and the development of their usage in international IP treaties see Sam Ricketson, *The Paris Convention for the Protection of Industrial Property: A Commentary*, para. 13.87-13.91, 13.94, and 13.112-13.113, at 714-717, 719-720, and 733-734 (2015); Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis*, paras. 3.321-3.326, at 377-384 (5th ed. 2021). For the definition used in TRIPS, see *infra* note 327 and accompanying text.

<sup>307</sup> Additional measures that contribute to the protection of geographical indications in the United States are labeling regulations and various state laws. See, e.g., 27 C.F.R. § 5.22; 27 C.F.R. § 9.23 (2017); Ga. Comp. R. & Regs. 40-7-8 (2017); Haw. Rev. Stat. § 486-120.6 (2017); Cal. Bus. & Prof. Code § 25240 (2017).

<sup>308</sup> On Rogers’s involvement in the design of the Lanham Act see *supra* notes 237–247 and accompanying text.

<sup>309</sup> General Inter-American Convention for Trade-mark and Commercial Protection, Feb. 20, 1929, 46 Stat. 2907, 124 L.N.T.S. 357 (“Inter-American Convention”). The Convention was signed in 1929 and replaced two earlier conventions, namely the Convention for the Protection of Trade Marks, which was signed in 1910, and the Convention for the Protection of Commercial Industrial, and Agricultural Trade Marks and Commercial Names, which was signed in 1923. Further on the Inter-American Convention, see *infra* Part III, Section 2.2.2.



plurilateral treaty that evidenced the negotiating countries' concerns regarding geographical indications.<sup>310</sup>

Aware of the international obligations stemming from the Inter-American Convention, both Rogers and Lanham defended the inclusion of a reference to "indications of geographical origin" in the Lanham Act bill provision on collective and certification marks as "comport[ing] with the good-neighbor policy."<sup>311</sup> Even when it was suggested that the inclusion was superfluous,<sup>312</sup> Rogers replied that "[i]t would be very helpful if [it] could be left in"<sup>313</sup> and explained that the foreign countries that had no understanding of unfair competition as it existed in the United States wanted the provision to be in the statute.<sup>314</sup> Congress adopted the reference, which remains in the Lanham Act today,<sup>315</sup> and the reference is now consistent with the United States–Mexico–Canada Agreement (the "USMCA," the replacement of NAFTA),<sup>316</sup> which requires that countries "provide that signs that may serve as geographical indications are capable of protection under its trademark system."<sup>317</sup> This article's proposal would not change this reference to geographical indications in Lanham Act section 4.<sup>318</sup>

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<sup>310</sup> Given the development and state of the law of geographical marks in the United States (as discussed in Part III, Section 1, above), and the degree of involvement of U.S. trademark experts, including Rogers, in the shaping of the Inter-American Convention, it is not surprising that the text of the Convention corresponded to a significant extent to the state of the U.S. law in the 1920s. See Farley, *supra* note 247, at 56-58.

<sup>311</sup> Trade-marks, Hearings before the Subcommittee on Trademarks of the House Patents Committee on H.R. 102, H.R. 5461, and S. 895, 77th Congress, Nov. 4, 12, 13–14, 1941 Hearing: 77th Congress: Document No. 13—Nov. 4, 12–14, 1941, at 87 and 98 (Lanham).

On Rogers's involvement in the Convention negotiations see Stephen P. Ladas, *The Contribution of Edward S. Rogers in the International Field of Industrial Property*, 62 TMR 197 (1997).

<sup>312</sup> Trade-marks, Hearings before the Subcommittee on Trademarks of the House Patents Committee on H.R. 102, H.R. 5461, and S. 895, *supra* note 311, at 87 (Scott arguing that the inclusion of "indications of regional origin used in commerce" in the provision on collective and certification marks was akin to "saying 'fruit, including apples.'" *Id.*).

<sup>313</sup> *Id.*

<sup>314</sup> *Id.*

<sup>315</sup> Lanham Act § 4, 15 U.S.C. § 1054.

<sup>316</sup> Agreement between the United States of America, the United Mexican States, and Canada, July 1, 2020 ("USMCA"); on the USMCA see further *infra* Part III, Section 2.2.4.

<sup>317</sup> *Id.*, Article 20.18; see also, with similar wording, U.S.–Jordan FTA, 2000, Article 4(6); U.S.–Singapore FTA, 2003, Article 16.2(1); U.S.–Australia FTA, 2004, Article 17.2(1); U.S.–Oman FTA, 2006, Article 15.2(2). On geographical indications protected as certification or collective marks see U.S.–Bahrain FTA, 2005, Article 14.2(2); U.S.–Colombia FTA, 2006, Article 16.2(2); U.S.–Peru FTA, 2006, Article 16.2(2).

<sup>318</sup> Lanham Act § 4, 15 U.S.C. § 1054. The registrability of collective and certification marks under this provision is "[s]ubject to the [Lanham Act] provisions relating to the registration of trademarks, so far as they are applicable," which has been interpreted by some as precluding the registration of generic marks as certification marks. *Interprofession Du Gruyère v. U.S. Dairy Export Council*, 575 F. Supp. 3d 627 (E.D. Va.

International law requires that the registration of geographically misdescriptive indications used for wines and spirits be prohibited;<sup>319</sup> the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement” or “TRIPS”) mandates that countries prohibit the registration of marks including such indications irrespective of consumer confusion,<sup>320</sup> and the 1994 Uruguay Round Agreements Act<sup>321</sup> inserted the prohibition in the Lanham Act.<sup>322</sup> This provision must remain in the Lanham Act, and the proposal in this article does not affect this provision.

The 1993 NAFTA Implementation Act<sup>323</sup> was responsible for moving marks that are primarily geographically deceptively misdescriptive from the category of marks potentially capable of acquiring secondary meaning (section 2(e)(2)) to the category of unregistrable marks (section 2(e)(3)).<sup>324</sup> This change was prompted by the requirement introduced by NAFTA and TRIPS (which TRIPS still includes) to “refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the trademark [would] mislead the public as to the true place of origin.”<sup>325</sup>

Critics have argued that the NAFTA Implementation Act went unnecessarily far with respect to primarily geographically deceptively misdescriptive marks.<sup>326</sup> NAFTA and TRIPS limited (and TRIPS still limits) the prohibition of registration to marks that contain or consist of “geographical indications,” which they defined (and TRIPS still defines) as “indications which identify a good as originating in the territory of a [country], or a region or locality in

2021), \*2 (appeal pending). See also *Institut National Des Appellations v. Brown-Forman Corp.*, 47 U.S.P.Q.2d 1875, 1884 (T.T.A.B. 1998), \*11.

<sup>319</sup> Lanham Act § 2(a), 15 U.S.C. § 1052(a); see also *supra* Part III, Section.1.1.5 regarding how the wine and spirits prohibition may be regarded as consistent with pre-1930s law if interpreted as establishing a legal fiction that all misdescriptive indications used for wines and spirits are automatically deceptive.

<sup>320</sup> TRIPS Agreement, *supra* note 54, at Article 23(2).

<sup>321</sup> PL 103-465, Dec. 8, 1994, 108 Stat. 4809, § 522.

<sup>322</sup> Lanham Act § 2(a), 15 U.S.C. § 1052(a). The USMCA does not include a provision corresponding to TRIPS Article 23(2); the USMCA only clarifies the intersection of USMCA rules on geographical indications with other rules concerning wines and spirits. USMCA, Article 20.31, fn. 17 and 19.

<sup>323</sup> PL 103-182, Dec. 8, 1993, 107 Stat 2057, § 333.

<sup>324</sup> Lanham Act § 2(e)(3), 15 U.S.C. § 1052(e)(3). For a discussion of the change to the Lanham Act and the following important decision in *In re California Innovations*, see *supra* notes 282–291 and accompanying text.

<sup>325</sup> TRIPS Agreement, *supra* note 54, at Article 22(3); see also NAFTA, *supra* note 282, Article 1712(2) (with slightly different wording). On the genesis of the TRIPS provision, see Gervais, *supra* note 306, para. 3.313–3.320, at 370-377.

<sup>326</sup> Brauneis & Schechter, *supra* note 3, at 68.

that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.”<sup>327</sup> The Lanham Act amendment made the prohibition of registration apply to the entire category of geographical marks, of which geographical indications are only a subcategory.<sup>328</sup> To what extent the United States may or should go beyond the minimum treaty standard in this case may be debatable.<sup>329</sup>

While the U.S. implementation went beyond the required minimum standard with respect to the coverage of the types of trademarks, the implementation might be insufficient in a different respect: The Lanham Act amendment and its subsequent interpretation concerning primarily geographically deceptively misdescriptive marks might not have correctly reflected the fact that the prohibition of registration should, according to NAFTA and TRIPS, apply in cases when the use of the trademark “is of such a nature as to *mislead* the public.”<sup>330</sup> The standard applied now, post–

<sup>327</sup> TRIPS Agreement, *supra* note 54, Article 22(1); *see also* NAFTA, *supra* note 282, at Article 1721(2) (with slightly different wording). The USMCA uses the same definition as TRIPS (but in the singular instead of the plural) but does not provide for the prohibition of trademark registration on this ground. USMCA, *supra* note 316, at Article 20.1(1).

<sup>328</sup> On the different functions and subcategories of geographical marks see *supra* Part 1, Section 1. Geographical indications as defined by international treaties may consist of non-geographical terms. *E.g.*, “feta,” a term with no independent geographical meaning, is considered a geographical indication under the European Union law. *See* Federal Republic of Germany and Kingdom of Denmark v. Commission of the European Communities, CJEU, C-465/02 and C-466/02, Oct. 25, 2005, ECLI:EU:C:2005:636. *See, e.g.*, definitions of geographical indications in free trade agreements: U.S.–Australia FTA, 2004, Article 17.2(1), fn. 17-5 (“A geographical indication shall be capable of constituting a mark to the extent that the geographical indication consists of any sign, or any combination of signs (such as words, including geographic and personal names, as well as letters, numerals, figurative elements and colours, including single colours), capable of identifying a good as originating in the territory of a Party, 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.”); U.S.–Bahrain FTA, 2005, Article 14.2(2), n.4 (“Any sign or combination of signs (such as words—including geographical and personal names, as well as letters, numerals, figurative elements and colors, including single colors), in any form whatsoever, shall be eligible to be a geographical indication.”).

<sup>329</sup> Under TRIPS Article 1(1), countries “may, but shall not be obliged to, implement in their law more extensive protection than is required by this Agreement, provided that such protection does not contravene the provisions of this Agreement.” *Supra* note 54. For a discussion whether some TRIPS provisions are a floor or a ceiling, see, for example, Henning Grosse Ruse-Khan, *IP and Trade in Post-TRIPS Environment*, in *TRIPS Plus 20: From Trade Rules to Market Principles* (Hanns Ullrich et al. eds., 2018), 163-183, at 170. For a general discussion of “substantive maxima” in international IP treaties, see also Annette Kur, *International Norm-Making in the Field of Intellectual Property: A Shift Towards Maximum Rules?*, 1(1) WIPO J. 27 (2009).

<sup>330</sup> TRIPS Agreement, *supra* note 54, at Article 22(3) (emphasis added); NAFTA, *supra* note 282, Article 1712(2). John R. Renaud, *Can't Get There from Here: How NAFTA and GATT Have Reduced Protection for Geographical Trademarks*, 26 *Brook. J. Int'l L.* 1097, 1111 (2001); LaFrance, *supra* note 3, at 134-35; Courtney Liotti, *The Registrability of*

*In re California Innovations*, to determine whether a mark is primarily geographically deceptively misdescriptive, is the deception standard,<sup>331</sup> which, depending on the interpretation of the term “misleading,” might be narrower than a standard for misleading the public, thus allowing more geographically misdescriptive marks to be registered than NAFTA or TRIPS intended.<sup>332</sup>

The international treaties do not define what the standard should be for determining the misleading character of the use of a mark,<sup>333</sup> and there is no internationally uniform interpretation of the term “misleading.” Some TRIPS drafts included not only “misleading,” but also “misleading and confusing,”<sup>334</sup> but the final TRIPS wording refers only to “misleading.” The provision prohibiting the registration of a mark containing or consisting of a geographical indication thus stands in contrast to the provision on trademark rights, which refers to “a likelihood of confusion” and which does not use the term “misleading.”<sup>335</sup> It is therefore reasonable to assume that the terms “misleading” and “confusing” in TRIPS refer to different standards, and indeed in 2005 a WTO panel agreed with a dispute settlement party argument that “[m]isleading’ is a stricter evidentiary standard than ‘confusing’.”<sup>336</sup> However, the panel did not interpret the actual meaning of the term “misleading,”<sup>337</sup> nor the difference in meaning, if any, between

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*Primarily Geographically Deceptively Misdescriptive Marks: The Development of §1052(E)(3)*, 22 *Touro L. Rev.* 511, 526 (2006); Naeve, *supra* note 3, at 486-87 and 498-99.

<sup>331</sup> For the discussion of *In re California Innovations* and the deception test, see *supra* notes 284-291 and accompanying text.

<sup>332</sup> LaFrance, *supra* note 3, at 141 (arguing that “the court made too great a leap when it concluded that Congress’s decision to bar registration of both classes of disfavored marks necessarily implied that the same legal test should apply to determine which marks fall into each category . . .”).

<sup>333</sup> On an initial TRIPS draft that included a “definition of what would constitute misleading of the public,” see Justin Malbon, Charles Lawson, & Mark Davison, *The WTO Agreement on Trade-Related Aspects of Intellectual Property Rights: A Commentary*, para. 22.26, at 339 (2014).

<sup>334</sup> Draft of 23 July 1990 (W/76), 4b.2, reprinted in Gervais, *supra* note 306, at para. 3.316, at 373-374; Draft of 1 October 1990, 3.2, reprinted in Gervais, *supra* note 306, at para. 3.317, at 375.

<sup>335</sup> TRIPS Agreement, *supra* note 54, Article 16(1).

<sup>336</sup> European Communities—Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, WT/DS290/R, Mar. 15, 2005, para. 7.536, p. 121, and para. 7.562, at 12 (noting also that “the standard . . . that registration would ‘mislead the consumer as to the true identity of the product’ is intended to apply in a narrower set of circumstances than the trademark owner’s right to prevent use that would result in a likelihood of confusion”).

<sup>337</sup> The WTO panel in the 2005 report refused to interpret the term. European Communities—Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs, WT/DS290/R, Mar. 15, 2005, para. 7.562, at 126, fn. 505 (“The TRIPS Agreement does not define the terms ‘likelihood of confusion’ and ‘mislead the

“misleading” and “deceptive.” So it is possible that the United States is currently in compliance with TRIPS when it limits the prohibition of registration to geographical marks that are deceptive.<sup>338</sup> However, some commentators argue that “misleading” should be a standard that is less stringent than “deceptive,”<sup>339</sup> and that consequently the United States is not in compliance with its international obligations on this point. This argument and the effects of this article’s proposal on compliance in this regard are further discussed in subsection 2.3, below.<sup>340</sup>

## 2.2. Compliance of this Article’s Proposal with Geographical Indications (and Other Indications of Origin) Provisions in International Law

If the geographical marks-specific provisions of sections 2(e)(2) and 2(e)(3) of the Lanham Act<sup>341</sup> were eliminated, as this article proposes, compliance with any geographical indications-specific provisions of international law would need to rely on the general, non-geographical marks-specific provisions of the Lanham Act. These provisions are already subject to international IP obligations; for example, international treaties include provisions that permit the denial of registration to generic terms,<sup>342</sup> mandate the protection for well-known marks,<sup>343</sup> and permit limited exceptions to trademark rights, such as fair use of descriptive terms.<sup>344</sup>

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public as to the geographical origin’. These terms define the scope of protection provided for in Articles 16.1 and 22.2 of the TRIPS Agreement and apply in a very wide range of factual situations. Therefore, the Panel considers it inappropriate to embark on a detailed interpretation of these or similar terms unless necessary for the purposes of the resolution of the dispute, which is not the case here.”)

<sup>338</sup> On the test used under current U.S. law, see *supra* notes 284-291 and accompanying text.

<sup>339</sup> *E.g.*, a commentary on TRIPS states, without citing any support for the statement, that “[d]eceptive conduct is usually considered to be misleading conduct combined with an intention to mislead.” Malbon, et al., *supra* note 333, at para. 22.28, p. 340. The statement evokes the TTAB’s approach to deceptiveness under its 1969 decision *In re Amerise*, which the TTAB overruled in its 1983 decision *In re House of Windsor*. See *supra* notes 263-266 and 279-281 and accompanying text.

<sup>340</sup> See *infra* notes 394-405 and accompanying text.

<sup>341</sup> Lanham Act § 2(e)(2) and (3), 15 U.S.C. § 1052(e)(2) and (3).

<sup>342</sup> Paris Convention for the Protection of Industrial Property, as last revised at the Stockholm Revision Conference, Mar. 20, 1883, 21 U.S.T. 1583; 828 U.N.T.S. 305, Article 6quinquies(B)(2) (“Paris Convention”); Inter-American Convention, *supra* note 309, at Article 3(2).

<sup>343</sup> Paris Convention, *supra* note 342, Article 6bis; TRIPS Agreement, *supra* note 54, at Article 16(2) and (3).

<sup>344</sup> TRIPS, Article 17 (on exceptions to trademark rights generally); USMCA, *supra* note 316, at Article 20.20 (on exceptions to trademark rights generally and listing descriptive fair use as an example); U.S.–Morocco FTA, 2004, Article 15.2(5) (on exceptions to trademark rights generally and listing descriptive fair use as an example). To the extent that geographical indications consist of terms that have no independent geographical

International treaty provisions on unfair competition are also relevant to the enforcement of trademark rights, including rights to geographical marks.<sup>345</sup>

### 2.2.1. *The Paris Convention*

The elimination of the geographical marks-specific provisions from the Lanham Act would not affect U.S. compliance with the Paris Convention for the Protection of Industrial Property (the “Paris Convention”).<sup>346</sup> Under the Paris Convention, countries may deny registration to marks that “consist exclusively of signs or indications which may serve, in trade, to designate . . . [the] place of origin . . . of the goods,”<sup>347</sup> but this ground for denial is optional.<sup>348</sup>

Referring specifically to geographical origin, the Paris Convention provides for seizure of “[a]ll goods unlawfully bearing a trademark”<sup>349</sup> to be requestable by “[a]ny producer, manufacturer, or merchant . . . engaged in the production or manufacture of or trade in such goods and established either in the locality falsely indicated as the source, or in the region where such locality is situated, or in the country falsely indicated, or in the country where the false indication of source is used.”<sup>350</sup> The Lanham Act’s provisions on unfair competition and importation seizures would seem to satisfy this requirement of the Paris Convention, as well as any unfair competition proscribed under the Paris Convention.<sup>351</sup>

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meaning, general U.S. trademark provisions must already be securing U.S. compliance with international obligations concerning such geographical indications. On such types of geographical indications see *supra* note 328.

<sup>345</sup> Paris Convention, *supra* note 342, at Article 10*bis*.

<sup>346</sup> The Paris Convention does not use the term “geographical marks” but refers to “indications of source” and “appellations of origins,” which it includes in the definition of industrial property covered by the Paris Convention, but it does not require that countries introduce such categories in their laws. *Id.* at Article 1(2).

<sup>347</sup> *Id.* at 6*quinquies*(B)(ii).

<sup>348</sup> See Ricketson, *supra* note 306 at para. 12.23(b), at 544.

<sup>349</sup> Paris Convention, *supra* note 342, at Article 9(1).

<sup>350</sup> *Id.* at Article 10(2).

<sup>351</sup> Lanham Act §§ 24 and 25(a) and (b), 15 U.S.C. §§ 1124 and 1125(a) and (b); Paris Convention, *supra* note 342, at Article 10*bis*. For the historical development of the Paris Convention’s Articles 9(1) and 10 and the related Madrid Agreement for the Repression of False or Deceptive Indications of Sources on Goods (to which the United States is not a party) see Ricketson, *supra* note 306, at para. 13.05–13.32, pp. 670–686. The “prohibitions concerning State Emblems, Official Hallmarks, and Emblems of Intergovernmental Organizations” under Paris Convention Article 6*ter* are also covered in the Lanham Act. § 2(b).

### 2.2.2. *The General Inter-American Convention for Trademark and Commercial Protection*

The elimination of the geographical marks—specific provisions would not affect U.S. compliance with the General Inter-American Convention for Trademark and Commercial Protection. Any concerns about compliance with this Convention are mitigated by the fact that the U.S. Supreme Court in 1940 held the entire Convention to be a self-executing treaty,<sup>352</sup> and any inconsistencies between U.S. law and the Convention should be resolved by the direct application of the Convention. Although any such inconsistencies should therefore not raise concerns about the United States being in compliance with international law,<sup>353</sup> any inconsistencies create unnecessary friction in practice and should be avoided.<sup>354</sup>

The Convention prohibits “individual appropriation” in cases of “geographical names indicating . . . geographical origin or source,”<sup>355</sup> such names “may be freely used to indicate the origin or source of the products or merchandise or his commercial domicile, by any manufacturer, industrialist, merchant or agriculturist established in the place indicated or dealing in the products there originating.”<sup>356</sup> However, the Convention recognizes that some geographical names may through “constant, general and reputable use in commerce”<sup>357</sup> become “the name or designation itself of the

<sup>352</sup> *Bacardi Corporation of America v. Domenech*, 311 U.S. 150, 161 (1940) (“This treaty on ratification became a part of our law. No special legislation in the United States was necessary to make it effective.”); *see also* The Inter-American Convention, *supra* note 309, at Article 35 (the Convention “shall have the force of law in those States in which international treaties possess that character, as soon as they are ratified by their constitutional organs.”). Although typically only specific provisions are held to be self-executing at any given time, in this case the Supreme Court held the entire Convention to be self-executing. *See* Restatement (Fourth) of Foreign Relations Law § 310 (2018), § 310, Comment b (“Courts often speak to whether a treaty as a whole is self-executing, but the inquiry is best understood as requiring an assessment of whether the particular treaty provision at issue is self-executing.”). Edward Rogers represented the petitioner in the case, *Bacardi Corporation of America*, and was instrumental in having the treaty declared self-executing. Farley, *The Lost Unfair Competition Law*, *supra* note 158, at 741 (“Rogers also argued and won a Supreme Court case declaring the treaty to be self-executing.”).

<sup>353</sup> A Reporters’ Note to the Restatement (Fourth) of Foreign Relations Law, § 310, lists the Convention as a rare example of when “a treaty [is] regarded as addressing the methods of domestic implementation for the United States.” Restatement (Fourth) of Foreign Relations Law § 310 (2018), Reporters’ Note 7.

<sup>354</sup> *E.g.*, *British-American Tobacco Co. Ltd. and Tabacalera Istmena, S.A. v. Philip Morris Inc.*, 55 U.S.P.Q.2d 1585, 1590 (T.T.A.B. 2000) (“[I]n the absence of statutory language or legislative history to the contrary, [TTAB] must construe the provisions of the [Lanham] Act in such a manner as to be consistent with provisions of the Convention.”).

<sup>355</sup> Inter-American Convention, *supra* note 309, at Article 25.

<sup>356</sup> *Id.*

<sup>357</sup> *Id.* at Article 27.

article, product or merchandise”<sup>358</sup> and be subject to “individual appropriation.” Therefore, U.S. rules on descriptive marks, including rules on the possibility of acquiring secondary meaning, can secure compliance with the provisions of the Convention,<sup>359</sup> with one possible exception under which current U.S. law might not be consistent with the Convention, as is discussed further in subsection 2.3, below.<sup>360</sup>

The Convention’s prohibition of the use of “[e]very indication of geographical origin or sources which does not actually correspond to the place in which the article, product or merchandise was fabricated, manufactured, produced or harvested,”<sup>361</sup> irrespective of whether or not the use causes consumer confusion, could be achieved through the U.S. rules on unfair competition,<sup>362</sup> and does not depend on the geographical marks–specific provisions in the Lanham Act. The Lanham Act’s unfair competition provision is also consistent with the Convention’s prohibition of unfair competition in the form of the use of false indications of geographical origin that tend to deceive the public<sup>363</sup> or create an incorrect impression about the origin of goods.<sup>364</sup>

In its provision on the registration or deposit of trademarks, the Convention allows countries to deny or cancel the registration or deposit of trademarks that “contain representations of racial types or scenes typical or characteristic of any of the Contracting States, other than that of the origin of the mark,”<sup>365</sup> whether or not the inclusion of such representations or scenes would lead to consumer confusion. However, this provision is optional; the United States is not obligated to implement the provision and has not implemented it.<sup>366</sup>

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<sup>358</sup> *Id.*

<sup>359</sup> Regarding the lack of compliance with this provision in cases of geographical indications see *infra* notes 391–393 and accompanying text.

<sup>360</sup> See *infra* notes 391 and 393 and accompanying text.

<sup>361</sup> Inter-American Convention, *supra* note 309, at Article 23 and Article 26 (on labeling).

<sup>362</sup> Lanham Act § 43(a), 15 U.S.C. § 1125(a). Doubts about the degree of compliance might stem from the limitations on standing to bring an unfair competition claim, which may reduce the effectiveness of the prohibition.

<sup>363</sup> Inter-American Convention, *supra* note 309, at Article 21(c).

<sup>364</sup> *Id.* at Article 21(d).

<sup>365</sup> *Id.* at Article 3(5). Even such representations or scenes might be considered geographical marks. For a discussion of different types of geographical marks see *supra* Part 1, Section 1.

<sup>366</sup> See also *supra* note 352 and accompanying text on the self-executing nature of the Convention.



### 2.2.3. *The TRIPS Agreement*

U.S. compliance with the TRIPS provisions concerning geographical indications<sup>367</sup> appears achievable without the geographical marks-specific provisions in the Lanham Act.<sup>368</sup> The Act's unfair competition provision covers any misleading uses of geographical indications and other acts of unfair competition concerning geographical indications,<sup>369</sup> including uses of homonymous geographical names that falsely represent to the public that goods originate in another, identically named location.<sup>370</sup> The Lanham Act's provisions on generic terms satisfy the TRIPS optional provision that permits a country to deny protection to foreign geographical indications that are identical to a generic term in the country—"the term customary in common language as the common name for such goods or services."<sup>371</sup>

The effects of this article's proposal on the TRIPS prohibition of registration of marks containing or consisting of geographically misleading geographical indications<sup>372</sup> is further discussed in subsection 2.3, below.

### 2.2.4. *The USMCA*

The USMCA, which replaced NAFTA on July 1, 2020, includes provisions concerning geographical indications, some of which were not in NAFTA, but even the USMCA provisions may be complied with without resorting to the geographical marks-specific provisions of the Lanham Act.<sup>373</sup> The USMCA provisions on geographical indications<sup>374</sup> provide rules, applicable to *sui generis*

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<sup>367</sup> TRIPS defines "geographical indications" as "indications which identify a good as originating in the territory of a [country], 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." TRIPS Agreement, *supra* note 54, at Article 22(1). NAFTA, which was negotiated at the same time as TRIPS and pre-dated TRIPS, included very much the same provisions on geographical indications as did TRIPS. NAFTA, *supra* note 282, at Articles 1712 and 1721(2); North American Free Trade Agreement Implementation Act, Pub. L. No. 103-182, 107 Stat. 2057 (1993).

<sup>368</sup> See also *supra* note 328 on geographical indications consisting of terms with no independent geographical meaning.

<sup>369</sup> TRIPS Agreement, *supra* note 54, at Article 22(2).

<sup>370</sup> TRIPS Agreement, *supra* note 54, at Article 22(4) and 23(3). An example would be the use of PARIS for baguettes made in Paris, Texas, as opposed to Paris, France.

<sup>371</sup> TRIPS Agreement, *supra* note 54, at Article 24(6).

<sup>372</sup> See also *supra* notes 323-340 and accompanying text.

<sup>373</sup> See also *supra* note 328 on geographical indications consisting of terms with no independent geographical meaning.

<sup>374</sup> The USMCA defines geographical indications in the same manner as TRIPS does. See USMCA, *supra* note 316, at Article 20.1(1) and *supra* note 367.

protection systems and trademark protection systems alike,<sup>375</sup> on administrative procedures<sup>376</sup> and grounds for the denial, opposition, or cancellation of geographical indications.<sup>377</sup> In addition to a likelihood of confusion with a pre-existing trademark,<sup>378</sup> the grounds for a denial, opposition, or cancellation include a situation when a geographical indication is “a term customary in common language as the common name for the relevant good in the territory of the Party.”<sup>379</sup> The USMCA specifies “guidelines for determining whether a term is the term customary in the common language,”<sup>380</sup> complete with a list of illustrative relevant factors. The general Lanham Act provision concerning generic marks provides for the grounds required by the USMCA, and compliance with the USMCA guidelines, which are not reflected in the Lanham Act, seem to be addressable through case law.

A separate USMCA article requires prevention of the commercial use of the country name in relation to goods in a manner that misleads consumers as to the origin of goods;<sup>381</sup> this requirement seems to be covered by the Lanham Act’s unfair competition provision. The USMCA requirement in the collective and certification marks article, which states that countries provide that “geographical indications are capable of protection under its trademark system,”<sup>382</sup> has a parallel provision in the Lanham Act section on collective and certification marks.<sup>383</sup>

A current gap in U.S. compliance regarding the “double identity” rule, which the USMCA includes with a reference to geographical indications,<sup>384</sup> is discussed in subsection 2.3, below<sup>385</sup>; this gap

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<sup>375</sup> In the USMCA, the signatory countries expressly recognized that geographical indications may be protected through a *sui generis* mechanism or through “other legal means,” but protection through a country’s trademark system must be also possible. USMCA, *supra* note 316, at Article 20.29. The USMCA requires that countries “provide that signs that may serve as geographical indications [be] capable of protection under [their] trademark system[s].” *Id.* at Article 20.18.

<sup>376</sup> *Id.* at Article 20.30.

<sup>377</sup> *Id.* at Article 20.31.

<sup>378</sup> *Id.* at Article 20.31(1)(a) and (b).

<sup>379</sup> *Id.* at Article 20.31(1)(c). Footnotes 18, 19, and 20 further detail the rules relating to such terms. A provision addresses translations and transliterations of geographical indications. *Id.* at Article 20.31(5).

<sup>380</sup> *Id.* at Article 20.32.

<sup>381</sup> *Id.* at Article 20.28.

<sup>382</sup> *Id.* at Article 20.18.

<sup>383</sup> Lanham Act § 4, 15 U.S.C. § 1054; *see also supra* note 318.

<sup>384</sup> USMCA, *supra* note 316, at Article 20.19; *see also* U.S.–Australia FTA, 2004, Article 17.2(4); U.S.–Oman FTA, 2006, Article 15.2(4); U.S.–Panama FTA, 2007, Article 15.2(3). The TRIPS Agreement’s provision on “double identity” does not mention geographical indications. TRIPS Agreement, *supra* note 54, at Article 16(1).

<sup>385</sup> *See infra* notes 387 and 388 and accompanying text.

would not be expanded by eliminating the Lanham Act's geographical marks-specific provisions.

### 2.3. Gaps in Compliance with Geographical Indications (and Other Indications of Origin) Provisions in International Law

To the extent that gaps exist in U.S. compliance with geographical indications provisions in international law, the elimination of the geographical marks-specific provisions of the Lanham Act would not enlarge the gaps.<sup>386</sup> The gaps would need to be filled with provisions other than the provisions that this article proposes to eliminate, which is particularly the case with gaps that stem from noncompliance with provisions that do not apply only to geographical indications; the USMCA's requirement of a presumption in cases of "double identity" should be implemented for trademarks generally,<sup>387</sup> which, as the USMCA expressly states, would also cover geographical marks used as geographical indications.<sup>388</sup>

Other Lanham Act compliance gaps concern geographical indications provisions in international law, but closing the gaps does not depend on the Lanham Act's current geographical marks-specific provisions. The USMCA's "guidelines for determining whether a term is the term customary in the common language"<sup>389</sup> could be—although they would not necessarily have to be<sup>390</sup>—implemented by the inclusion of the illustrative factors in the Lanham Act to ensure a consistent interpretation of the rules on generic terms, including geographical terms, but the implementation does not require the Act's current geographical marks-specific provisions.

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<sup>386</sup> As opposed to NAFTA, the USMCA includes no provision requiring that countries prevent the use of misleading designations of origin for goods originating from a location other than the location designated. NAFTA, *supra* note 282, at Article 1712(1)(a). However, this fact is not a reason to drop the corresponding Lanham Act provision on unfair competition; TRIPS continues to require the inclusion of the provision.

<sup>387</sup> See Barton Beebe & C. Scott Hemphill, *The Scope of Strong Marks: Should Trademark Law Protect the Strong More than the Weak?*, 92 N.Y.U. L. Rev. 1339, 1357, n.74 (2017) (observing that "U.S. trademark doctrine does not have a clear double identity rule, though in practice the United States is very likely in compliance with this aspect of TRIPS").

<sup>388</sup> The USMCA provides for a double identity presumption and extends the presumption to geographical indications, meaning that "[i]n the case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed." USMCA, *supra* note 316, at Article 20.19. The TRIPS Agreement's "double identity" provision does not mention geographical indications. TRIPS Agreement, *supra* note 54, at Article 16(1).

<sup>389</sup> USMCA, *supra* note 316, at Article 20.32. See also *supra* note 380 and accompanying text.

<sup>390</sup> See *supra* note 380 and accompanying text for possible implementation through case law.

An implementation of the Inter-American Convention's prohibition of "individual appropriation" of "geographical names indicating such geographical origin or source,"<sup>391</sup> even if such names have acquired secondary meaning, could be problematic; however, such an implementation is not necessary because of the Convention's self-executing status.<sup>392</sup> The Convention prohibits "individual appropriation" if geographical names serve as geographical indications—"regional indications of origin of industrial or agricultural products the quality and reputation of which to the consuming public depend on the place of production or origin."<sup>393</sup> In this case, a stricter application of the current general rules on generic marks, combined where necessary with the doctrine of foreign equivalents, might be sufficient for law and practice to be treaty compliant. The current Lanham Act's geographical marks-specific provisions are irrelevant to the implementation of this Convention requirement.

The last question relating to this article's proposal for changes in the Lanham Act is what the effects of the proposal would be on U.S. compliance with the TRIPS prohibition of registrations of misleading geographical indications. As discussed in subsection 2.1, above,<sup>394</sup> some commentators have argued that by prohibiting the registration of geographical marks that are deceptive, the Lanham Act ignores the prohibition in TRIPS of the registration of all misleading geographical marks—not just those that are deceptive.<sup>395</sup> Given the lack of an internationally authoritative interpretation of the term "misleading,"<sup>396</sup> it is possible that the U.S. law is consistent with TRIPS even under current law, and eliminating the provision concerning primarily geographically deceptively misdescriptive marks would not affect compliance because the general rule on deceptive marks would continue to apply.<sup>397</sup>

If the term "misleading" in the TRIPS provision on the prohibition of registrations of misleading geographical indications were to be interpreted as being broader than the term "deceptive" under U.S. law, the United States would not be in compliance with the TRIPS provision because under current U.S. law, any geographically misdescriptive mark that is not deceptive is

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<sup>391</sup> Inter-American Convention, *supra* note 309, at Article 25.

<sup>392</sup> On the Inter-American Convention's self-executing status see *supra* note 352.

<sup>393</sup> Inter-American Convention, *supra* note 309, at Article 27.

<sup>394</sup> See *supra* notes 330–340 and accompanying text.

<sup>395</sup> The provision appeared also in NAFTA, but NAFTA was replaced by the USMCA.

<sup>396</sup> See *supra* note 333–339 and accompanying text.

<sup>397</sup> See *supra* note 285 on the current application of the identical test to determine whether a mark is deceptive or primarily geographically deceptively misdescriptive.

registrable on the principal register as a fanciful or arbitrary mark.<sup>398</sup>

This article's proposal would re-create the intermediate category of misdescriptive geographical marks that *In re California Innovations* eliminated: the category of geographical marks that are misdescriptive but not deceptive and not used as arbitrary or fanciful marks. Without the geographical marks-specific provisions in the Lanham Act, geographical marks would be categorized in the same manner as are any other marks—into marks that are merely descriptive,<sup>399</sup> misdescriptive but arbitrary or fanciful, deceptively misdescriptive,<sup>400</sup> or deceptive.<sup>401</sup> A recognized difference remains between marks that are deceptively misdescriptive (under section 2(e)(1)) and deceptive (under section 2(a))—the difference being the use of the materiality test,<sup>402</sup> which *In re California Innovations* extended to primarily geographically deceptively misdescriptive marks, resulting in the elimination of the difference between such marks and deceptive marks.<sup>403</sup>

This article's proposal would make deceptively misdescriptive geographical marks registrable on the supplemental register, and registrable on the principal register after they have acquired secondary meaning.<sup>404</sup> This result is consistent with TRIPS because these marks, after they have acquired secondary meaning, cannot be said to mislead the public; and if at some point the marks become generic, their registration can be invalidated, as required by TRIPS.<sup>405</sup>

## CONCLUSIONS

Legislatures seldom solve complex legal problems by making statutes less complex; they tend to add rather than remove statutory provisions to address new problems. In 1946, Congress adopted the Lanham Act with geographical marks-specific provisions to address

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<sup>398</sup> Under current law, geographical marks are either deceptive (and therefore non-registrable) or not deceptive (and therefore registrable). There are no marks in between. See *supra* note 323–340 and accompanying text.

<sup>399</sup> Lanham Act § 2(e)(1), 15 U.S.C. § 1052(e)(1).

<sup>400</sup> *Id.*

<sup>401</sup> *Id.* § 2(a).

<sup>402</sup> The difference between the two types of marks is based on whether the misdescription is merely a relevant factor in a purchasing decision (in which case a mark is deceptively misdescriptive and capable of acquiring secondary meaning) or a material factor in a purchasing decision (in which case a mark is deceptive and unregistrable). TMEP § 1203.02(c). For deceptively misdescriptive marks, only the goods/place association test must be met.

<sup>403</sup> On the extension of the materiality test to primarily geographically deceptively misdescriptive marks, see *supra* notes 284–291 and accompanying text.

<sup>404</sup> Lanham Act § 2(e)(1) and (f), 15 U.S.C. § 2(e)(1) and (f).

<sup>405</sup> TRIPS Agreement, *supra* note 54, at Article 22(3).

the issues of the day concerning this category of marks. Unfortunately, the wording of the provisions and the development of the law surrounding the provisions not only failed to clarify the law, but it also created additional confusion. This article argues that at this point, eliminating the geographical marks-specific provisions of the Lanham Act would be a useful step in clarifying the law.

The elimination of Lanham Act provisions 2(e)(2) and 2(e)(3) would certainly not solve all of the problems associated with geographical trademarks; difficult cases will continue to challenge the application of general trademark rules in cases involving geographical marks. Nonetheless, the elimination of these geographical marks-specific provisions in the Lanham Act would be an admission that it is no longer reasonable to make the application of any rules and legal consequences dependent on whether a geographical name is generally known to the relevant public. The “Google effects” phenomenon suggests that the human capacity to remember and recall geographical names has and will continue to diminish, and it will become increasingly difficult to ascertain whether the locations to which the geographical names refer are truly generally known. Once it becomes impossible to rely on general public knowledge acquired from common sources, consumer surveys will become necessary to establish that a geographical location is “generally known,” which will add costs to trademark applicants and opposers. Some names will, of course, remain unequivocally generally known and present clear cases, but law should not be designed only for clear cases.

A departure from geographical mark exceptionalism might seem contrary to the obligations that the United States must meet under international IP law; while international treaties do not refer to geographical marks, they impose robust obligations concerning geographical indications. The United States traditionally asserts compliance with such geographical indication provisions primarily via its trademark law; therefore, the inclusion of geographical marks-specific provisions in the Lanham Act might seem, if not necessary, then at least useful for purposes of compliance with international IP law. The reference to geographical indications in Lanham Act section 4 and the wine and spirits provision in section 2(a) must remain to ensure U.S. compliance with international IP treaties. However, the geographical marks-specific provisions of 2(e)(2) and 2(e)(3) can be deleted without negatively affecting the level of U.S. compliance with international law. Reliance on general trademark law provisions will suffice to maintain the current level of compliance, and for one particular international treaty obligation,

the change might even improve U.S. compliance with the obligation.<sup>406</sup>

The elimination of Lanham Act sections 2(e)(2) and 2(e)(3) will not resolve key international disagreements regarding the protection of geographical indications. The “seismic fault” between the United States and some of its major trading partners in the area of geographical indications is likely to persist, certainly for the foreseeable future, and particularly while countries widen their protections for geographical indications to include products other than agricultural products and foodstuffs.<sup>407</sup>

The elimination of the geographical marks–specific provisions of the Lanham Act would align the goals of the Act for geographical and non-geographical marks. If the Lanham Act is to attain some policy goals for geographical marks that differ from the goals applicable to trademarks in general, this article and its proposal should be a call for Congress to articulate the goals for geographical marks and amend the Act to meet such goals in view of the diminishing geographical knowledge.

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<sup>406</sup> See *supra* notes 394–405 and accompanying text.

<sup>407</sup> See, e.g., Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, May 20, 2015, Article 11. In 2014 and 2015, the European Commission and the EU Parliament recommended the adoption of a geographical indications system for handicrafts, and several countries, including Croatia, the Czech Republic, Estonia, France, India, Thailand, Tunisia, and Uganda, created *sui generis* protection for nonagricultural products.

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