



STATEMENT
Tuesday, August 08, 2006

Geographic Indications for the Origin of Coffee

The Specialty Coffee Association of America's Perspective on Registration of Geographical Indications of Origin and Recent Efforts by Ethiopia to Trademark the Names of Coffee Growing Regions

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Specialty coffee does not come from just anywhere. Our ability to identify, with ever-increasing specificity, the source of coffee we import, roast, and brew is a hallmark of the specialty coffee industry. This, as much as any quality variable, is one of the many things that distinguish specialty coffee from coffee that is something less. Specialty coffee is not anonymous. Even when blended, the origins are often identified, and consumers have come to associate meaning and expectations with the names of coffee lands, coffee regions, coffee farms, and even coffee plants. All coffee has a story but the specialty coffee industry has stories worth telling. And while each story culminates in the experience of the cup, they all begin where the coffee was born. The names of these birthplaces of coffee have value, and should be properly protected.

One hundred years ago the U.S. government recognized the value in a name when it became illegal, as part of the Food and Drug Purity Act of 1906, to "misbrand" a product as being from somewhere it wasn't. At the time the law was written, mislabeling of coffees as originating from Java, in particular, was epidemic. More Java was sold to consumers than was ever grown and exported from that region of the world. This contributed to the word "Java" becoming one of the many synonyms for coffee. When a brand is so ubiquitous that it becomes generic, it is no longer a brand.

To protect the "brands" that are the origins of coffee, some coffee producing regions have over time sought international protection for proper use of recognized regional and geographic coffee areas, also known as Geographic Indications. According to the U.S. Patent and Trademark Office, "Geographical Indications serve the same functions as trademarks, because like trademarks they are source identifiers, guarantees of quality, and are valuable business interests."

Geographical Indications identify a good as originating in the territory, region, or locality where a given quality, reputation or other characteristic of the good is essentially attributable to its geographic origin, such as "Florida oranges."

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The U.S. Trademark Act differentiates certification marks from trademarks. Certification marks are source-identifying in that they indicate the nature and quality of the goods and affirm that these goods have met certain defined standards.

Examples of origin certification marks in the coffee industry are:

*"100% Colombian"
"100% Kona"
"Jamaican Blue Mountain"
"Genuine Antigua"*

Application for a certification mark must be made by a government or other official organization within the producing country which will own and control use of the mark by others. This control consists of taking steps to ensure the mark is applied only to coffee that meets the specified requirements that the certifier/owner has established.

Geographical terms *can* be protected as certification marks. A geographical term may be used, either alone or as a portion of a composite mark, to certify that good originate in a particular geographical region. There is a prohibition in U.S. trademark law against registration of names that are primarily geographically descriptive, but The U.S. Trademark Act makes an exception to this prohibition for indications of regional origin. Therefore, a geographical name may be registered as a certification mark even though it may not qualify as a trademark.

A trademark or certification mark registration does not necessarily prevent someone from using the term to fairly describe where their product originated if it is the same as those identified in the registration. Such use may be considered a "fair use" of descriptive terms.

Ethiopia

In Ethiopia there are a number of terms customarily used by the coffee trade based on the various districts where the coffee is grown, such as Harrar (or Harar), Sidamo, Limu, Yirgacheffe (or Yrga Cheffe), Kaffa, Gimbi (or Lekemпти), and Djimmah. For the past 100 years both coffee exporters and roasters have used these words on their bags and packages to connote the districts in Ethiopia where the coffees originated, as many of these coffees show distinct differences in their flavor profiles. Harrar, Sidamo, Yirgacheffe and Limu have become more widely known to consumers in the last 20 years, largely due to the growth of the specialty coffee industry.

In 2005, the Ethiopian government initiated a program to "register trademarks for Harrar, Yirgacheffe, and Sidamo in 40 countries - and eventually four other well-known Ethiopian fine coffees with good reputations." According to Light Years IP, an organization assisting the Ethiopian Intellectual Property Office (EIPO) with this project:

The trademark program will be followed by a licensing initiative – the EIPO and other ministries will be trained to negotiate with international importers to recognize Ethiopian brand ownership of its high quality coffees. Control of the name brand use through licenses will allow Ethiopia to play a significant role in determining export prices for its fine coffees more relevant to the high world market prices.¹

¹ Light Years IP, "Ethiopia: Coffee Trademarking and Licensing Project"
<http://www.lightyearsip.net/ethiopiacooffee.shtml>, © 2006 Light Years IP.

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In pursuing this trademarking strategy in the United States, the Ethiopian government ran into several challenges, including the U.S. Trademark Office denying registration of “Harrar” as a word mark. The Trademark Office stated:

It appears that the term “Harrar” indicates the generic name for a blend of coffee that is grown in the Harrar or Harar region of Ethiopia. Accordingly, registration is refused under Section 2(e) (1) of the Trademark Act. Registration is refused because the proposed mark is merely descriptive of applicant’s goods. Applicant’s claim of acquired distinctiveness is insufficient to overcome the refusal.

For information on TRIPS, visit www.wto.org.

The examining attorney’s statement is consistent with U.S. trademark law as well as the International Trade Agreement on Intellectual Property Right (TRIPS). The World Trade Organization recommends using “certification marks” for the protection of geographic indications of origin as a means of protecting the intellectual property rights of agricultural producers. **This is also the position adopted by SCAA.**

Ethiopia encountered another challenge when SCAA objected to the U.S. Trademark Office’s pending registration of a word mark for “Yirgacheffe.” Apparently, the Yirgacheffe examining attorney had not concluded the word “Yirgacheffe” was generic and merely descriptive, which had been the case with the “Harrar” examining attorney. In order to correct what appeared to be a research error by the Yirgacheffe examining attorney regarding the meaning and use of the word “Yirgacheffe,” SCAA filed a permitted Letter of Protest with the Trademark Office, citing evidence that demonstrated the term “Yirgacheffe” is used and understood by the relevant industry and the general public as the name of a type of coffee from a district in Ethiopia. SCAA requested the application be given further review, and the mark be refused as generic under the appropriate sections of the Trademark Act, as had been done in the case of “Harrar.”

Email the SCAA board of directors at board@scaa.org

The matter is now under review by the U.S. Patent and Trademark Office, and the issue is presumed to be under advisement. SCAA’s board of directors did consider the further corrective action of filing a Notice of Opposition regarding the “Yirgacheffe” trademark application, and in doing so requested an extension of time to review the matter before proceeding with an Opposition. The filing of a first extension of time generated a great deal of discussion within the coffee industry, with people taking both sides of the issue without fully understanding either the facts or the applicable trademark law. It also led to a meeting between a representative of the Ethiopian Government, Senior Second Secretary for

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Trade and Investment – Fitsum Hailu, and SCAA board President Rob Stephen at the Ethiopian embassy in Washington, DC. Although the meeting helped to clarify the issues, the Ethiopian government remained convinced that they are proceeding correctly in registering their district names as trademarks rather than certification marks.

During their review of the issues, SCAA’s board consulted with its International Relations Council and SCAA’s legal Counsel, Stuart Adelson. Although most agreed that Ethiopia would be better served by certification marks, the board decided not to file a formal opposition.

Coffee’s Geographic Indicators, the names of the places that coffee is grown, have the power to invoke expectations and affect consumer behavior. This power should be properly protected and enhance the participation of producers in the marketplace. The SCAA believes that this is best accomplished through certification marks. The SCAA will continue to assist producer governments and organizations in developing robust certification programs by teaching producers how the consumer marketplace defines and rewards quality, facilitating the creation of official coffee appellation systems, and guiding origin representatives through the process of properly attaining and enforcing their certification marks within the United States.

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