

# Managing Intellectual Property™

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**Katten Muchin Rosenman  
LLP**  
New York

*Karen Artz Ash*



*and  
Bret J Danow*

US: TRADE MARKS

## What to know about geographic references

When contemplating the expansion of a brand into the United States marketplace, foreign trade mark owners often want to take advantage of the panache and elegance that American consumers typically associate with foreign locations. In order to maintain the commercial impression of a particular brand with a foreign manufacturer, brand owners often create a new composite mark that combines their brand with a geographic designation such as “Milan”, “Paris” or “London”. These geographic references may help establish consumer association for the brand and may help distinguish the brand from third party marks.

However, before expanding to the US under a composite mark that combines the brand and a geographic designation, the trade mark owner should be certain to conduct a complete US trade mark search to ascertain whether any third party has senior rights in and to the identical brand name in the US. This is particularly important because the simple addition of a specific geographic location to the brand may not be sufficient to obviate a likelihood of confusion with a prior existing similar US brand. This, of course, depends upon the particular facts and circum-

stances, including in particular whether the foreign trade mark owner possesses the more famous mark (that is, whether the addition of the geographical designation would be enough to foster the association and public perception between the foreign brand and brand owner). In the absence of circumstances such as these, in general, a subsequent user may not avoid a likelihood of confusion by simply adding geographically descriptive matter to it. Under certain circumstances, it is possible that the addition of a geographically descriptive modifier may support a claim of additional confusion by purportedly leading consumers to believe that the senior user is merely offering a territorially customized version of the same product.

US trade mark counsel should be consulted to determine whether the addition of a geographic component will obviate confusion or would be optimal to support association with an established foreign renown. Trade mark counsel can also advise whether the added reference may compromise the ability of the brand owner to obtain a federal trade mark registration (for example if the geographic designation is geographically mis-descriptive).

# Katten

KattenMuchinRosenman LLP

[www.kattenlaw.com](http://www.kattenlaw.com)