

Rap Music and Cognac: The Federal Circuit Considers if the Mix is Strong Enough to Protect Cognac as a Geographic Indicator

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In March 2019, Cologne & Cognac Entertainment of New Jersey filed a trademark application at the USPTO for recordings featuring music and artistic performances, music composition services, production of musical videos in the nature of live performances by musical artists, and providing related entertainment and information services, under the following mark:



The Examining Attorney assigned to the application at the USPTO did not raise any issues with respect to the use of “COGNAC” as part of the mark, presumably due to the fact that the goods and services in the application do not cover wines and/or spirits. Nonetheless, the use of COGNAC in the application certainly caught the attention of the Bureau National Interprofessionnel du Cognac because COGNAC is a geographical indication for “appellations of controlled origin” (AOC) for alcoholic products that come from the Cognac region of France.

BNIC opposed the application for the COLOGNE & COGNAC ENTERTAINMENT & Design mark to protect the interests of producers of COGNAC brandy in the Cognac region of France, enforcing its common law certification mark COGNAC for brandy.

In a split decision (2-1) issued on August 25, 2022, the Trademark Trial and Appeal Board determined that:

- 1) BNIC has exclusive rights in COGNAC as a regional certification mark used by growers, producers, and merchants and has controlled its use by authorized users to represent to consumers that a distilled spirit bearing the COGNAC mark comes from a defined region of France (the Board has acknowledged this previously in *Institut Nat’l des Appellations d’Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1891 (TTAB 1998));
- 2) BNIC has priority rights in COGNAC having been first exported into the U.S. in 1794 and sold continuously in the U.S. ever since;
- 3) The COGNAC certification mark may be famous, but that use of COGNAC on products does not make a particularly “strong impression on consumers for purposes of showing strength or even raising awareness as to Opposers’ certification mark.” As such, when COGNAC appears with a brand, the brand makes the strongest consumer impression; and,
- 4) In viewing the similarity of the marks COGNAC and COLOGNE & COGNAC

ENTERTAINMENT & Design, the Board found that COLOGNE & COGNAC was the dominant element of the mark, creating an image of “a person wearing cologne and drinking brandy, projecting a certain lifestyle, such as one of leisure and high-living,” that is distinct in its own manner.

BNIC submitted compelling evidence that “COGNAC certified product has an intimate and legendary history with music, particularly rap and hip hop music, in the United States,” showcased by brand owners of Cognac products partnering with various musical artists in the US, such as Snoop Dogg and 50 Cent. The Board found it unlikely that a consumer coming upon the COLOGNE & COGNAC ENTERTAINMENT & Design mark for musical/entertainment good and services would be confused that there may be an affiliation with BNIC or the beverage producers it works to protect. As a results, a likelihood of confusion under Section 2(d) of the Trademark Act was dismissed (*Note: a dilution claim was also dismissed because it was not properly pleaded*).

A lengthy and compelling dissent by Administrative Trademark Judge Wolfson followed with respect to the dismissal of the Section 2(d) claim, wherein he laid out clear relatedness of the goods and services, overlapping channels of trade, and overlapping consumers, and a strong affiliation between Cognac and music industry icons, particularly in the black community, namely, Quavo, Pharrell Williams, Jay-Z, Ludacris, 50 Cent, Dr Dre, Snoop Dogg, and Erykah Badu.

BNIC appealed the decision of the Board to the U.S. Court of Appeals for the Federal Circuit on October 27, 2022, and the CAFC heard oral arguments on June 4, 2024. Based on the Oral Argument, the TTAB decision appears unlikely to hold up.

The contested finding from the Board’s majority was that the COGNAC certification mark was not famous enough on its own to prevent a company in a distinct industry from making use of COGNAC as part of a trademark. Should it be expected that a consumer would understand the certification process and impact? Other geographically specific trade groups, such as the Scotch Whisky Association and the Napa Valley Vintners, co-signed an amicus brief, stressing “owners of certification marks have never been required to show that consumers are aware of the mark’s status.”

The three judges sitting on the panel for the CAFC have signaled that the Board’s decision will not hold up:

Judge Clevenger: “The Board, seems to me, has said ‘Well, when the two travel together, there’ll be a presumption that the name brand dominates, unless there’s a showing to the contrary.’ That seems to me to be wrong.”

Judge Hughes: “The Board has to sort out whether the fame [of COGNAC] is due to the name brand marks or to the ‘cognac’ mark, or maybe it’s famous for both, without applying a presumption or putting a thumb on the scale. But they didn’t do that.”

Judge Clevenger: “There is a clear overlap in the consumers, between the consumers and the users in the hip-hop community, with makers of cognac. Every person who

listens to hip-hop and hears about cognac and the quality of cognac and the performers...having themselves gone to France and produced cognac and put their own brand on it, along with the “cognac” certification, so the inner mixture between the rap music industry and the cognac industry is undeniable.”

We will keep you apprised of the CAFC's decision.