

Report Q191

in the name of the United Kingdom Group
by Jonathan D.C. TURNER, Michael EDENBOROUGH, Mark GREEN,
Nick CUNNINGHAM, Charters MACDONALD-BROWN and Catriona DOVE

Relationship between trademarks and geographical indications

Questions

I) Analysis of current legislation and case law

- 1) *Do your country's laws have enactments or systems dealing specifically with GIs, e.g. a registration system for GIs? If so, what are the criteria of registrability? To which national authority must an application for protection be made? Does the applicant have the right to appeal against the refusal of the national authority to register a GI? If so, to which entity?*

Enactments dealing specifically with GIs

As a member state of the European Community, the UK is subject to Council Regulation 2081/92/EC on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (*"the Regulation"*). The Regulation does not cover wine products (except vinegar) or spirit drinks.

Council Regulation 1493/99/EC on the common organisation of the market in wine (*"the Wine Regulation"*) applies to wine products. Council Regulation 1576/89/EC (*"the Spirit Regulation"*) applies to spirit drinks. Council Regulation 2082/92/EC on certificates of specific character affords registered protection to traditional foodstuffs which are not geographically defined (so will not be considered in these answers).

A register of protected indications and designations is maintained by the Directorate-General for Agriculture of the European Commission (*"the Commission"*).

Applications for registration of GIs from organisations domiciled in the UK are submitted through the Department for Environment, Food and Rural Affairs (*"DEFRA"*) and its equivalent departments in Wales, Scotland and Northern Ireland (see below).

GIs may be registered as trade marks at the UK Patent Office Trade Marks Registry (*"the UK Registry"*), provided that they conform to principles set out in the UK Trade Marks Act 1994 (*"TMA 1994"*) (which is harmonised under EC Council Directive 89/104/EEC (*"the Trade Marks Directive"*)) and established in European case law. In general, GIs are refused registration as individual trade marks where they refer to natural produce, unless the geographical area concerned is very small, both geographically and in terms of population, and there is no likelihood of any other trader wishing to use the name for the relevant produce.

GIs may, however, be registered under the TMA 1994 more appropriately as certification or collective marks (see Questions 3 and 7 below).

Registrability criteria

For UK trade marks, certification and collective marks see Question 7.

For GI's under the Regulation, the products must be produced or processed or prepared in a specific geographical area and there must be a specific quality, reputation or other characteristic *attributable* to that area. This affords a protected geographical indication ("PGI").

A more demanding test is required in order to obtain a protected designation of origin ("PDO"), namely, that the product must be produced *and* processed *and* prepared in the geographical area and the quality or characteristics of the product must be *essentially due* to that area.

National application authority

Applications for registration of a GI with the Commission from organisations domiciled:

- in England, are submitted through DEFRA;
- in Wales, through the Welsh Assembly Government;
- in Scotland through the Scottish Executive Environment and Rural Affairs Department; and
- in Northern Ireland, through the Department for Agriculture and Rural Development for Northern Ireland.

Applications for registration under the TMA 1994 are made to the UK Registry.

Rights of appeal

Applications under the Regulation may be refused by the national authority through which they must be submitted. There is no right of appeal although, in the UK, judicial review of the national authority's decision is possible on the grounds of error of law, procedural defect or that no reasonable tribunal could have reached the decision. There is also a procedure for dealing with objections to the application from third parties, on which the applicant will be heard (see Question 3 below).

The position is similar at the Commission level: there is a three-month procedure to try to achieve consensus between an applicant Member State and any objecting Member State; thereafter, the Commission's decision is final (subject to review by the European Court of Justice ("ECJ")).

Applications for trade marks refused by the UK Registry may be appealed as of right.

Relevant appeal bodies

Except as described above, refusals of applications under the Regulation are not appealable. Applications for judicial review in England must be made to the Administrative Court, from which there is a possibility of appeal to the Court of Appeal and, ultimately, the House of Lords.

Appeals from the UK Registry are made to the Appointed Person (a person highly specialised in trade mark law) or the High Court (from which there is a possibility of a further appeal to the Court of Appeal and House of Lords).

- 2) *What is the status of a GI in your country? Does the registration of a GI confer a property right? Who would be the rightholder of a GI? Can GIs be the subject of dealings such as assignment, mortgage and licensing?*

Status of GI

A certification or collective mark under the TMA 1994 confers the same rights on the proprietor as a normal trade mark, for example, the right to object to use of an identical or confusingly similar mark on identical or similar goods.

A PDO or PGI registered under the Regulation confers the rights defined by the Regulation, which may be exercised by any producer whose product complies with the relevant specification. These are essentially the right to prevent:

- commercial use of the name for products which are not covered by the registration;
- any misuse, imitation or evocation of the name, even where qualifiers such as “style”, “type” or “method” are used;
- any other false or misleading indication as to provenance, origin, nature or essential qualities of products; or
- any other practice which may mislead the public as to origin.

GIs as property rights

UK collective and certification marks may be registered by individuals, but the proposed regulations governing use of the mark must be filed and are open to inspection and objection. Authorised users may enforce the mark (but must join the proprietor to the action). The marks may be assigned (subject to the Registrar’s approval in the case of certification marks). It follows, therefore, that there is a property right in such marks.

Once registered, PDOs and PGIs afford protection which may be exercised by any producer whose goods come within the registered definition. Since the membership of the class of persons who have the benefit of the right may change at any time, and there is no “proprietor” as such, it appears that PDOs and PGIs do not confer a property right. The Regulation makes no provision for dealing with PDOs or PGIs as property.

Rightholder for GI

For certification and collective marks, the registered proprietor(s) is the holder of the mark, however, the mark may also be enforced by any authorised user.

PDOs and PGIs are registered by producers’ associations or, in limited cases, a single producer, through the administrative authority of the Member State concerned. However, there is no “rights holder” in the sense that there is anything that may be “held”, although there is a definable class of persons who may have the benefit of the right.

Dealings in GIs

See above.

- 3) *Is the application for or registration of a GI made public in your country? Is it possible to oppose such application or registration or cancel such registration of a GI? If so, by whom and on what (absolute or relative) grounds (e.g. generic or descriptive term or prior trademark)?*

GIs as collective or certification marks (see also Question 7 below)

An application for and the registration of a GI as a certification or collective mark is published by the UK Registry in the Trade Marks Journal in the same way as an application for or registration of an ordinary trade mark (paragraph 1 of Schedules 1 and 2 to the TMA 1994).

An application for registration of a GI as a certification or collective mark can be opposed on the same absolute and relative grounds as an ordinary mark, including that the GI in question is of customary use in the current language or relevant trade or there exists a prior identical or confusingly similar mark for the same or similar goods/services (paragraph 1 of Schedules 1 and 2 to the TMA 1994).

The registration of a GI as a certification or collective mark can also be revoked or invalidated on the same absolute and relative grounds as an ordinary trade mark, including that the mark has become a common name in the trade for the relevant goods/services or there exists a prior identical or confusingly similar mark for the same or similar goods/services (paragraph 1 of Schedules 1 and 2 to the TMA 1994). In addition:

- a collective mark may be *revoked* on the grounds that
 - i) the manner in which it has been used by the proprietor has rendered it misleading to the public as to the nature of the mark,
 - ii) the proprietor has failed to comply with the regulations governing use of the mark or
 - iii) there has been an improper amendment to such regulations (paragraph 13 of Schedule 1 to the TMA 1994);
- a collective mark may be *invalidated* on the grounds that
 - i) it is misleading as to the nature of the mark or
 - ii) the regulations governing use of the mark should not have been approved by the UK Registry (paragraph 14 of Schedule 1 to the TMA 1994);
- a certification mark may be *revoked* on the same additional grounds as a collective mark and also on the further grounds that
 - i) the proprietor has begun to carry on a business involving supply of goods/services of the kind certified or
 - ii) the proprietor is no longer competent to certify the goods/services for which the certification mark is registered (paragraph 15 of Schedule 2 to the TMA 1994); and
- a certification mark may be *invalidated* on the grounds that
 - i) the proprietor carries on a business involving supply of goods/services of the kind certified,
 - ii) the mark is misleading as to the nature of the mark or
 - iii) the regulations governing use of the mark do not comply with the requirements of the TMA 1994 and/or the applicant is not competent to certify the relevant goods/services (paragraph 16 of Schedule 2 to the TMA 1994).

As with ordinary trade marks, any person may oppose an application for, or apply to revoke or invalidate the registration of, a collective or certification mark (paragraph 1 of Schedules 1 and 2 and sections 38(2), 46(4) and 47(4) of the TMA 1994).

GIs registered under the Regulation

Once an application to register a GI pursuant to the Regulation has been approved by DEFRA and forwarded to the Commission, it is published in the Official Journal of the European Communities (Article 6(2) of the Regulation). In the absence of any objections, or upon resolution of such objections, the registration of the GI is published in the Official Journal (Article 6(4)).

Objections can be raised to an application pursuant to the Regulation at two stages:

- Prior to the application being forwarded to the Commission – Upon receipt of a new application, DEFRA notifies relevant groups or associations of producers seeking comments or objections. The comments and objections are addressed and resolved through correspondence and discussions between DEFRA, the applicant and the relevant interested groups. DEFRA then forwards the application to the Commission.

- Within six months following publication of the application in the Official Journal – The Commission sends a copy of each new application to the relevant national authorities in the Member States. Any Member State can then file objections (Article 7(1)). At this stage, any legitimately concerned natural or legal person can also raise an objection via the relevant national authority in its Member State (Articles 7(2) and (3)).

The possible grounds of objection to an application to register a GI under the Regulation are that:

- the GI in question does not satisfy the conditions of a PDO or a PGI under Article 2 (Article 7(4), first indent);
- registration of the name would jeopardize the existence of an entirely or partly identical name or mark or the existence of products which have been legally on the market for at least five years prior to the application (Article 7(4), second indent); or
- the name is generic in nature (Article 7(4), third indent).

The Commission may cancel the registration of a GI pursuant to the Regulation where:

- the Member State which submitted the original application confirms that a request for cancellation, made by the applicant concerned, is justified and forwards it to the Commission (Article 11a(1)); or
- for well-founded reasons, compliance with the specification for the relevant product can no longer be ensured (Article 11a(2)).

- 4) *Must use requirements be satisfied in order to maintain GI protection? If so, is there any definition of what constitutes use? Are the legal rules established for appraising the maintenance of a trademark registration applicable to the appraising of the maintenance of GI protection?*

GIs registered as collective or certification marks

A GI registered as a collective or certification mark can be challenged for non-use in the same way that an ordinary mark might be, that is, where the mark has not been put to genuine use in respect of the goods/services for which it is registered for an uninterrupted period of five years and there are no proper reasons for such non-use (sections 46(1)(a) and (b) of the TMA 1994). The authorities regarding what constitutes genuine use of an ordinary trade mark apply equally in respect of collective and certification marks.

GIs registered under Regulation

There is no use requirement under the Regulation.

- 5) *What is the scope of protection of a GI? Is it only protected against use of the name or also against use of elements of the specification of the GI (e.g. slicing, grating) or any other practice liable to mislead the public as to the origin of the product (e.g. use of same trade dress)? Are the legal rules established for determining the scope of trademark protection applicable to determining the scope of GI protection (e.g. in relation to reputed or well-known GIs, likelihood of confusion, infringing and non-infringing acts)? May rights in a GI be enforced even where a product which allegedly infringes those rights has been made purely for export?*

Scope of protection

A GI registered as a PDO or PGI pursuant to the Regulation is protected to the extent of the specification approved with the application. Any use of a PDO or PGI which does not comply with the specification infringes the PDO or PGI.

The criteria which must be included in the specification include:

- the name of the relevant product, including the designation of origin or the geographical indication;
- a description of the product including the raw materials, if appropriate, and its principal physical, chemical, microbiological and/or organoleptic characteristics;
- the definition of the relevant geographical area;
- evidence that the product originates in the relevant geographical area;
- a description of the method of obtaining the product and, if appropriate, the authentic and unvarying local methods, as well as information concerning the packaging;
- details of the inspection procedures to apply in respect of the product; and
- the specific labelling details relating to the PDO or PGI;

(Article 4 of the Regulation).

It has been accepted by the ECJ (*Ravil Sarl* Case 469/00 and *Consorzio del Prosciutto di Parma* Case 108/01) that the specification for a PGI/PDO can include provisions relating to packaging, labelling and other matters such as slicing or grating of the relevant product. These are justifiable restrictions to the extent that they are important operations which may harm the quality of the relevant product and, hence, the reputation of the PDO/PGI if not carried out in the specified manner. However, where, for example, slicing, grating or packaging operations are ordinarily carried out at the stage of retail or restaurant sale, a condition in the specification that these must be carried out in the region of production will not be enforced.

For GI's protected pursuant to the Regulation, other users who cannot satisfy the specification cannot, directly or indirectly, use the words designated under the PDO or PGI insofar as their products are comparable or if use of the name would exploit the reputation in the PDO or PGI. Protection also extends to prevent any misuse, imitation or evocation of the PDO/PGI, even if the true origin of the product in question is identified, or even if the association is in the manner of "type", "style", "method", "as produced in", "imitation" or "similar" or is translated. Any other false or misleading indications is prohibited, as well as any other practice liable to mislead the public. There is a saving provision for use of a generic word for the relevant product.

For protected geographical wine products in the EU (pursuant to the Wine Regulation), there is also provision to prevent any incorrect, confusing or misleading advertising, description or presentation. This applies to information used in translations or with similar qualifications as are noted above.

Manufacture for export

Although the Regulation does not refer explicitly to infringing products for export, the rights in the PDO or PGI are not expressed as being restricted to protection for infringing activity wholly within the EU. Consequently, rights in a GI registered as a PDO or PGI should be enforceable against any party infringing the PDO or PGI for export or otherwise.

For GI protection of wine products, derogation from the appropriate regulatory provisions may be authorised by the Member States, where the legislation of the importing third country so requires.

6) *Can a GI be registered as individual trademark? If so, under what conditions?*

In the UK, a GI can be registered as an individual trade mark at the UK Registry only under certain conditions. (For collective and certification marks, see Question 7.)

To register a GI as an individual trade mark it must be capable of being represented graphically and of distinguishing goods or services of the proprietor from those of other undertakings.

The TMA 1994 contains absolute grounds for refusal for marks which consist exclusively of signs or indications which serve, in trade, to designate the geographical origin or goods or services. However, this ground for refusal shall not apply if, by the date of application, the mark has in fact acquired a distinctive character as a result of the use made of it. Further, the applicant for a trade mark (or the proprietor) may disclaim any right to the exclusive use of any specified element of the trade mark, or agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

The rights granted to a trade mark holder are not infringed by third parties using indications concerning the geographical origin of goods or services, provided the use is in accordance with honest practices in industrial or commercial matters.

A GI can also be registered as a Community trade mark ("CTM") in the same manner as for a national trade mark. The CTM has largely the same registration requirements as national trade marks although the qualification for use of a sign or indication designating geographical origin is such that the trade mark must have become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it. (There are also Community collective marks.) A GI registered as a CTM (or a Community collective mark) has largely the same protection as under national trade mark laws.

Rights in a GI registered as a trade mark can be enforced against any party manufacturing infringing products in the UK (for exportation or otherwise) as with any other registered trade mark.

- 7) *Do your country's laws provide for collective or certification marks? If so, under what conditions can a GI be registered as a collective mark or a certification mark?*

In the UK, a GI can be registered as an individual trade mark at the UK Registry only under certain conditions. (For collective and certification marks, see Question 7.)

To register a GI as an individual trade mark it must be capable of being represented graphically and of distinguishing goods or services of the proprietor from those of other undertakings.

The TMA 1994 contains absolute grounds for refusal for marks which consist exclusively of signs or indications which serve, in trade, to designate the geographical origin or goods or services. However, this ground for refusal shall not apply if, by the date of application, the mark has in fact acquired a distinctive character as a result of the use made of it. Further, the applicant for a trade mark (or the proprietor) may disclaim any right to the exclusive use of any specified element of the trade mark, or agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation.

The rights granted to a trade mark holder are not infringed by third parties using indications concerning the geographical origin of goods or services, provided the use is in accordance with honest practices in industrial or commercial matters.

A GI can also be registered as a Community trade mark ("CTM") in the same manner as for a national trade mark. The CTM has largely the same registration requirements as national trade marks although the qualification for use of a sign or indication designating geographical origin is such that the trade mark must have become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it. (There are also Community collective marks.) A GI registered as a CTM (or a Community collective mark) has largely the same protection as under national trade mark laws.

Rights in a GI registered as a trade mark can be enforced against any party manufacturing infringing products in the UK (for exportation or otherwise) as with any other registered trade mark.

- 8) *Does inclusion of a protected GI as part of a trademark qualify as legal bar to the registration of such trademark?*

Articles 13 and 14 of the Regulation do not allow for registration of a trade mark which includes a protected GI as part of that trade mark.

As to registration of trade marks which incorporate GIs under TMA 1994, see Questions 6 and 7 above.

- 9) *Do your country's laws, e.g. trade or merchandise legislation, require the application of correct designations of origin/source on agricultural products and food-stuffs?*

Omitting to use any designation of origin/source on a product does not infringe UK domestic law, although in the case of wines it may infringe the Wine Regulation, (Annexes VII.A.2(b) and (c)).

Use of incorrect designations of origin/source on products may be contrary to

- i) the Trade Descriptions Act 1968 ("TDA 1968"),
- ii) the law of passing off and
- iii) EC protection of GIs.

TDA 1968

Under section 1(1) of the TDA 1968, a person is guilty of a criminal offence if, in the course of trade or business, s/he applies a "*false trade description*" to any goods or supplies or offers to supply any goods to which such a description has been applied.

Section 2(1)(h) of the TDA 1968 specifies that an indication, direct or indirect, given by any means with respect to any goods or parts of goods as to, *inter alia*, the place of manufacture, production, processing or reconditioning constitutes a "*trade description*".

Section 3 of the TDA 1968 specifies that a trade description is "false" if it is false to a material degree or if it would be likely to be taken for an indication as specified in section 2 which would be false to a material degree.

Liability under the TDA is strict (no fault), except that section 24 provides that it is a defence to prove that the commission of the offence was due to a cause beyond the defendant's control and that he took all reasonable precautions and exercised all due diligence to avoid its commission by himself or by a person under his control.

Sections 2(4) and 2(5) of the TDA 1968 provide that descriptions applied pursuant to or in compliance with various legislation governing agricultural products are deemed *not* to be trade descriptions for the purpose of the TDA 1968. The legislation in question includes the Agricultural Produce (Grading and Marking) Act 1928 (as amended), the Plant Varieties and Seeds Act 1964, the Agriculture and Horticulture Act 1964 (and Community grading rules within the meaning of its Part III), Part IV of the Agriculture Act 1970, the Consumer Protection Act 1987, the Food Safety Act 1990 and the Plant Varieties Act 1997. However, it is unlikely that any descriptions applied pursuant to these Acts would be incorrect designations of origin or source.

Passing off

Use of an incorrect designation of origin or source gives rise to civil liability for passing off if it is likely to cause confusion as a result of its identity or similarity to a designation identifying a particular origin of goods which has a reputation and goodwill for those goods in the UK (see, for example, *Taittinger v Allbev* [1993] FSR 641, EWCA (“Elderflower Champagne”).

The Regulation

Use of an incorrect designation of origin in relation to an agricultural product or foodstuff is liable to contravene Article 13 of the Regulation if it:

- is identical to a protected indication; or constitutes a misuse, imitation or evocation of a protected indication; or
- constitutes a false or misleading indication as to provenance or origin affecting a protected indication.

Use of an incorrect designation of origin in relation to a wine contravenes Article 48 of the Wine Regulation. It has been observed that this provision may apply even if the designation is not misleading (see *Mezzacorona Trade Mark* (2004) RPC 26 at §33, EWCA). Use of an incorrect designation of origin also contravenes Article 49 of the Wine Regulation if, as will normally be the case, it does not comply with the detailed requirements in Annexes VII and VIII of that Regulation.

Use of an incorrect designation of origin in relation to a spirit may contravene article 5 of the Spirit Regulation. It has been held to be arguable that this provision confers private rights on affected producers as well as consumers (*Gloag v Welsh Distillers* [1998] FSR 718 – “Welsh Whisky” concocted from Scotch Whisky and herbs).

- 10) *How are conflicts between trademarks and GIs resolved under your country’s laws? Do they co-exist or does either the trademark or GI prevail? Is there a rule for determining whether the trademark or GI should prevail, and what are the criteria to take into account (e.g. the “first in time, first in right”-rule, the reputation of the geographic region or the reputation of the trademark, the length of time that the name has been used to indicate the geographic region and the extent of such usage, the length of time that the trademark has been used and the extent of such usage)?*

The position is essentially governed by EC law: UK trademarks are governed by the TMA 1994 which implements and must, so far as practicable, be interpreted in accordance with the Trade Marks Directive. CTMs are governed by EC Regulation 40/94 (“the CTM Regulation”). Geographical indications are protected in the UK by the Regulation (agricultural products and foodstuffs), the Wine Regulation (wines) and the Spirit Regulation (spirits); although, as discussed above, they may also be protected by collective or certifications marks or the domestic law of passing off or trade descriptions legislation.

The position resulting from these laws is quite complex and cannot be characterised by a simple rule such as “first in time, first in right”. In general terms, registered GIs prevail over trade marks unless the GI was misleading when it was registered (for example because of a prior trade mark with a reputation), in which case the registration of the GI is invalid.

Conversely, registered trade marks prevail over the protection of unregistered GIs by the law of passing off unless the trade mark was misleading at the priority date of the application (for example because of the reputation of the GI), in which case the registration of the trade mark is invalid.

Four issues can be considered:

- Is a trade mark unregistrable/invalid if it conflicts with a prior GI?
- Is a GI unregistrable/invalid if it conflicts with a prior trade mark?
- Is the use of a trade mark unlawful if it conflicts with a GI?
- Is the use of a GI unlawful if it conflicts with a trade mark?

Trade mark which conflicts with a prior GI

Registration of a UK trade mark is prohibited by section 3(4) of the TMA 1994 Act (implementing Article 3(2)(a) of the Trade Marks Directive) if use of the trade mark is prohibited in the UK by any enactment or rule of law or any provision of Community law, such as the protection of GIs under the Regulation, the Wine Regulation or the Spirit Regulation. A trade mark registered contrary to section 3 is invalid under section 47 of the TMA 1994.

Article 14(1) of the Regulation further prohibits the registration of a trade mark after publication of a GI under Article 6(1) of the Regulation if use of the trade mark would infringe the GI under Article 13 of the Regulation. This provision overlaps but goes further than section 3(4) of the TMA 1994, in that it applies to the registration of a trade mark between publication and registration of a GI. It is thought that the UK Registry and Courts must apply Article 14(1) of the Regulation since it is directly applicable.

Various provisions of the TMA 1994 Act prohibit the registration of a trade mark whose use would mislead, for example, having regard to the prior reputation of a GI. The relevant sections of the TMA 1994 and, in square brackets, the article of Trade Marks Directive which they implement are 5(4)(a) [4(4)(b)], 3(3)(b) [3(1)(g)] and 3(4) [3(2)(a)]. A trade mark registered contrary to these provisions is invalid under section 47 of the TMA 1994. These provisions effectively prevent or invalidate the registration of a trade mark which is confusingly similar to a GI with a prior reputation in the UK as at the date of the trade mark application (see *Inter Lotto v Camelot* [2004] RPC 186).

Article 7(1)(j) of the CTM Regulation prohibits the registration of CTMs for wines or spirits which contain or consist of GIs for wines or spirits respectively.

Article 7(1)(k) of the CTM Regulation also prohibits the registration of CTMs whose use would infringe a GI registered under the Regulation where the application for registration of the trade mark was submitted after the filing with the Commission of the application for registration of the GI. While this overlaps with Article 14(1) of the Regulation, it does not appear to be coterminous. It is not clear whether the prohibitions are cumulative or whether one prevails over the other.

Trade marks registered contrary to Article 7 of the CTM Regulation are invalid under Article 51 of that Regulation.

GI which conflicts with a prior trade mark

Article 14(3) of the Regulation prohibits registration of a GI if it is liable to mislead the public in the light of a trade mark's reputation and renown and the length of time it has been used.

No specific provision prevents protection of a GI under the Wine Regulation or the Spirit Regulation on the ground that it is similar to a prior trade mark, but it is thought that protection of a misleading GI under these Regulations would be invalid as offending Article 48 of the Wine Regulation or Article 5 of the Spirit Regulation, as well as general principles of law.

Use of a trade mark which conflicts with a GI

In general, registration as a trade mark does not constitute a defence to infringement of a valid GI under the Regulation, the Wine Regulation or the Spirit Regulation, or to passing off. However, where a trade mark infringes a GI under Article 13 of the Regulation but was

registered in good faith before the application for the GI was filed, use of the trade mark may continue provided that there are no grounds for revocation of the trade mark under the Trade Marks Directive Articles 3(1)(c) (exclusively serving to designate geographical origin etc. and no distinctive character), 3(1)(g) or 12(2)(b) (liable to deceive).

Use of a GI which conflicts with a trade mark

Protection as a GI does not appear to avoid infringement of a trade mark protected by a valid UK or EU registration or the law of passing off.

II) Proposals for adoption of uniform rules

The Groups are invited to put forward any proposals for adoption of uniform rules regarding the relationship between trademarks and GIs. More specifically, the Groups are invited to respond to the following questions:

- 11) *Should countries provide for registration systems dealing specifically with GIs? If so, what should the key features of such system be? Should a multilateral system of registration of GIs be established? If so, what should the key features of such multilateral system be? Specifically, which international body should be tasked with establishing such system? How should the application for or registration of a GI be notified/made public (either in your country or at a multilateral level) in order to avoid that a trademark may conflict with a GI previously unknown to the trademark owner?*

As an important preliminary point, before a country decides to implement a system for the protection of GIs, or there is any multilateral system, it is necessary to decide upon what basis protection is to be conferred. For example, one rationale may be to grant protection because a given geographical term has become associated with a particular product by reason of the inherent characteristics that appertain to that particular geographical area (e.g. Whitstable oysters or Newcastle Brown Ale; in each case, the product deriving its unique characteristic from the local water). A different rationale may be to grant protection to a group of producers, located within a given geographical area, who have established a reputation for a particular product, in order to preserve some social-cultural heritage (e.g. Melton Mowbray, a place where the product in question, namely, pork pies, was historically created, but the product owes nothing to the particular inherent climatic or geological conditions prevalent there).

There is a fundamental difference between the two rationales: in the case of the first rationale, it would be, in practice, impossible to reproduce exactly the precise characteristics of the inherent natural conditions at any other location in the world (i.e. one could never reproduce exactly the oyster beds off the Whitstable coast line precisely elsewhere); however, in the case of the second rationale, it is quite possible to reproduce the characterizing features elsewhere (i.e. the relevant methods of manufacture, processing etc. could, with modern technology, easily be replicated elsewhere).

Thus, it would be logical and defensible if there were a difference between the treatment of the two situations. An indication of the former type cannot accurately be applied to products produced in other areas (i.e. it cannot be translocated), while an indication of the latter kind (with suitable quality condition provisions) could properly be applied to products produced elsewhere (i.e. it is translocatable). Therefore, the former rationale justifies absolute protection, while the latter does not.

For example, there can only ever be one place in the world where genuine Whitstable oysters may be sourced: all others will only be imitations (some better, some worse). In a case such as this, the genuine article ought to be able to proclaim its genuineness absolutely (and all others, if they wish to allude to the genuine article, must state clearly and unambiguously that they are not the genuine article).

By contrast, for the second category, articles that are identical in all respects may be produced anywhere and each and every version (assuming suitable quality control) should be allowed to state its compliance with that standard. If indications in this latter category are granted protection at all (which is more a matter of public policy than inherent justification) the protection should be qualified: use of an indication in connection with truly equivalent products originating outside the relevant area should be permitted, at any rate if their origin has been clearly stated.

If this division is recognized and involved, it solves the thorny issue of any prior generic usage that might have arisen in any given part of the world in relation to terms that in other parts of the world are considered to be GIs. The local, non-original, later user of the term may continue to use the term, but only so long as

- a) the qualification of "*style of*", etc. is applied in relation to the first category in order to indicate clearly that it is not the genuine product, but only an imitation that conforms more or less closely; or
- b) there is strict compliance with the quality control conditions in relation to the second category of products in order to show that, for all practical purposes, it is identical to the original product. If the appropriate condition is met, then there is no deception upon the public. If not, then the offending use may be prohibited with equanimity.

Given the above analysis, a multilateral system could be established and operated by, for example, WIPO. Alternatively, existing trade mark systems could be used (see Question 13 below). Publication of proposed GIs should be wide-spread but also, in fairness to existing registered rights holders, any potentially-affected entities should be notified directly by WIPO.

- 12) *Do you have any suggestions as to the acquisition, maintenance, scope and enforcement of GI protection? What should the scope of protection of a GI be? Should the legal rules established for appraising the acquisition, maintenance, scope and enforcement of trademark protection apply to the appraising of the acquisition, maintenance, scope and enforcement of GI protection?*

The acquisition should depend upon the appropriate category into which the GIs fall. In either case, the protection conferred should be narrow, i.e. for non-translocatable GIs, it should be permissible to indicate a non-genuine article by stating clearly and unambiguously that the product is "*in the style of*" etc.; while in the case of translocatable GIs, there should be strict compliance with the detailed characteristics that define the product in question. Breach of these conditions ought to be actionable. Maintenance and enforcement follow.

Interestingly, in relation to the use of the relevant term upon dissimilar goods, it is the latter, translocatable, category that would be the most likely to be adversely affected. This is because, in order to qualify for protection under the second heading, a reputation must by definition have been established and hence, by necessary implication, it would be possible to take unfair advantage, etc. thereof. The former, non-translocatable category might, or might not, have a reputation that could be adversely affected, but the existence of such a reputation is not a prerequisite to protection being properly conferred in the first place. Thus, if protection is granted to the second category of GIs, it would be illogical not to confer protection on them *vis-à-vis* dissimilar goods, in which case it would seem inequitable not to confer such protection to the first category of GIs as well if they have acquired a reputation.

13) *Should a protection of GIs by individual and/or collective or certification marks be possible?*

Given the above rationales, the most appropriate protection of GIs would be by certification or collective marks, which themselves are special categories of trade marks. It may well be more efficient to use and adapt existing national and multi-lateral trade mark systems and institutions to protect GIs than to create wholly new ones.

However, normal trade marks are inappropriate, because GIs by their very nature do not apply to a single trading entity, but rather to a collective or other association, of which each and every member complies with strict pre-conditions and regulations.

14) *How should conflicts between trademarks and GIs be resolved? Please propose a specific rule for determining whether trademark or GI should prevail, which is likely to be broadly accepted. If co-existence is contemplated, should such co-existence be limited to the country of origin or relate to the relevant markets?*

A recognition of the division proposed above solves the issue of later proposed trade mark use. A subsequent application for a trade mark for the same goods would be prohibited, because invoking either rationale, the proposed trade mark would have a meaning that is incompatible with designating a unique trade origin. A subsequent application for a trade mark for dissimilar goods would be prohibited if the latter took unfair advantage etc. of the earlier GI.

Moreover, earlier trade mark owners should be allowed to keep their trade marks so long as they comply with the necessary conditions to avoid deception of the public. Yet, in this context, one must not apply the "first-in-time" maxim without thought. If the earlier trade mark has, over time, lost its significance of indicating only one particular trader, then the mark might have become eligible to be a GI. If, however, it has not lost that significance, then (save for the unusual case in which there is only one true producer), the mark is inherently unsuitable to be a GI.

Summary

In the UK, GIs are governed by several regimes, namely, Council Regulations No. 2081/92, 1493/99 and 1576/89, the protection of collective and certification trade marks and the prohibition of unfair competition (passing off). It is also possible to envisage protection by a normal trade mark but only where one trader has a monopoly of the product in question.

GIs in the strict sense depend upon some inherent characteristics that appertain to a particular geographical area and cannot be reproduced elsewhere; they are thus non-translocatable. Therefore, there can only ever be one genuine product and all others are merely imitations thereof. GIs in the wider sense depend upon a group of producers located within a given geographical area who have established a reputation for a particular product. It is possible to reproduce exactly the product in question elsewhere in the world and so they are translocatable.

The protection afforded should recognize this distinction.

Résumé

Dans le R-U, les indications géographiques (IGs) sont soumises à plusieurs régimes, à savoir les Règlements du Conseil des CEs Nos 2081/92, 1493/99 et 1576/89, la protection des marques collectives et de certification, et l'interdiction de la concurrence déloyale ("passing off"). On peut envisager par ailleurs la protection d'une GI par une marque individuelle, mais uniquement où un commerçant jouit d'un monopole du produit en question.

Les IGs sensu stricto se fondent sur quelques caractéristiques inhérentes qui relèvent d'une région géographique particulière et ne peuvent être reproduites ailleurs; elles sont donc incapables de transposition. Par conséquent, il n'y aurait qu'un seul produit authentique, et tous autres seraient simplement des imitations.

En revanche, les IGs dans le sens plus étendu s'appuient sur une groupe de producteurs dans une région particulière qui ont établi une réputation pour un produit spécifique. C'est possible de reproduire exactement le produit en question ailleurs dans le monde; donc ceux-ci sont capables de transposition.

La protection accordée devrait reconnaître cette distinction.

Zusammenfassung

Im Vereinigten Königreich unterliegen geografische Herkunftsangaben verschiedenen gesetzlichen Regelungen, nämlich den EG-Ratsverordnungen Nr. 2081/92, 1493/99 und 1576/89, den gesetzlichen Vorschriften für den Schutz von Kollektiv- und Zertifizierungsmarken sowie wettbewerbsrechtlichen Regeln ("passing off"). Schutz kann auch aufgrund einer normalen Marke angestrebt werden. Dieses jedoch nur dann, wenn ein einzelner Handelstreibender ein Monopol für das fragliche Produkt innehat.

Geografische Herkunftsangaben im engeren Sinne umfassen solche Produkte, deren untrennbar anhaftende Eigenschaften einer bestimmten geografischen Region zuzuschreiben sind und nirgendwo anders nachgemacht werden können. Die Herstellung eines solchen Produktes an einem anderen Ort mit exakt den gleichen Eigenschaften ist nicht möglich. Daher kann es nur ein authentisches Produkt geben und alle anderen sind lediglich Nachahmungen hiervon.

Geografische Angaben im weiteren Sinne stehen einer Gruppe von Herstellern/Anbietern einer bestimmten geographischen Region zur Verfügung, die einen bestimmten Ruf für ein Produkt aufgebaut haben. Es ist möglich dieses in Frage stehende Produkt anderswo in der Welt exakt zu reproduzieren. Diese Produkte sind nicht zwingend ortsgebunden, um den Ansprüchen gerecht zu werden, die die angesprochenen Verkehrskreise mit einer bestimmten geographischen Herkunftsangabe verbinden.

Der gewährte Schutz sollte diese Unterscheidung zwischen den an geographische Herkunftsangaben zu stellenden Ansprüche berücksichtigen.