

United Kingdom

Protection of country names

The Legal basis

The relevant UK legislation for the protection of country names in the context of the registration of trade marks is the Trade Marks Act 1994, (the Act) and in particular Section 3 which reads:

“3. Absolute grounds for refusal of registration

(1) The following shall not be registered—

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(2) A sign shall not be registered as a trade mark if it consists exclusively of—

(a) the shape which results from the nature of the goods themselves,

(b) the shape of goods which is necessary to obtain a technical result, or

(c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is—

(a) contrary to public policy or to accepted principles of morality, or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

(5) A trade mark shall not be registered in the cases specified, or referred to, in section 4 (specially protected emblems).

(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

UK law is derived from (and must comply with) Directive 2008/95/EC of The European Parliament and of The Council of 22 October 2008 (the Directive) to approximate the laws of the Member States relating to trade marks. Section 3 implements Article 3 of the Directive.

The Section 1(1) referred to in Section 3 (1)(a) defines what a trade mark means in the context of the Trade Marks Act as follows:

1.(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging."

The applicable procedures

The determination of whether a trade mark satisfies the requirements for registration is undertaken during a formal pre-registration examination, although may also be a matter for dispute in a pre-registration opposition, or a post registration application to invalidate a registration.

In the specific question of trade marks consisting of country (geographical) names, objection may be raised under Section 3(1)(c) which precludes registration of trade marks "which consist exclusively of signs or indications which may serve, in trade, to designate the ...geographical origin ... of goods or of rendering of services..." A trade mark consisting of a geographical place name with other elements may be considered to "consist exclusively" of a sign or indications which may designate geographical origin where any additional element(s) do not make it distinctive (registrable) as a totality. See *Hormel Foods Corp. v Antilles Landscape Investments NV* [2005] RPC 28.

Section 3(1)(c) of the Act and Article 3(1)(c) of the Directive pursues an aim which, in the public interest, prevents registration of a sign or indication which may serve to designate the geographic origin of the categories of goods in relation to which registration of the mark is applied for. The public interest is to prevent a geographic place name from being reserved to one undertaking alone:

"...not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response." Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) And Boots- und Segelzubehör Walter Huber (C-108/97), Franz Attenberger (C-109/97)

Section 3(1)(c) does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question. It also applies to geographical names which are liable to be used in future. Where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the assessment is whether it is reasonable to assume that such a name is, in the mind of

the relevant class of persons, capable of designating the geographical origin of that category of goods. In making this assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name and with the category of goods concerned. It is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it. *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) And Boots- und Segelzubehör Walter Huber (C-108/97), Franz Attenberger (C-109/97)*

Registration of a geographic place name as a trade mark does not of itself prevent its use by other traders. There is a provision in Section 11(b) of the Act (implementing Article 6 of the Directive) which states that a registered trade mark is not infringed by the use of another registered trade mark ... where the use is of an indication concerning the "... geographical origin ... of goods or of rendering of services ...".

Objection to trade marks consisting of country (geographical) name may also be raised under Section 3(3)(b) of the Act (Article 3(1)(g) of the Directive) which precludes registration of trade marks which are:

“of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

Objection to registration under Section 3(3)(b) is taken at the first examination stage to geographical place names and figurative trade marks indicating geographical origin, and variations of these, where the geographical place has a reputation for the goods or services, for example:

PIAZZA D' ITALIA for "clothing", because the public would be deceived if the goods or the cloth were not made in Italy, which has a strong reputation for quality cloth and clothing;

SOMERSET GOLD for "cider", because Somerset is well-known for its cider;

SWISSTEX for "Watches and horological instruments" because Switzerland is famous for high quality watches.

Use of a geographical place name in circumstances where it has a reputation creates an “expectation” in the minds of the consumer which could lead to deception if that expectation is not fulfilled.

In *Elizabeth Emanuel v Continental Shelf 128 Ltd, Case C-259/04 [2006 ETMR 56]*, the ECJ stated in paragraph 47 of its judgment that the application of this provision “presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived”. An objection under Section 3(3)(b) should therefore only be raised if there is a real (as opposed to a purely theoretical) potential for deception of the public.

An objection under Section 3(3)(b) may be overcome by a restriction to the specification. This generally results in the narrowing of the rights in the mark by means of imposing a limitation to the specification of goods/services. Where a specification of goods or services is being restricted to overcome a deceptiveness objection based upon the origin of the goods/services the specification should be restricted to goods *manufactured in* the appropriate place for manufactured goods or *produced in* for other goods, for example:

SWISSTEX: "Watches and horological instruments; all manufactured in Switzerland".

Geographical Indications and Designations are protected under Sections 3(4) (and also 3(1)(c) and 3(3)(b))

There are three EC Regulations which impact upon the examination of geographical indications under Section 3(4) of the Act. These are:

Regulation 510/2006 protects geographical indications and designations of origin in relation to agricultural products and foodstuffs;

Regulation 1493/99 protects those used in relation to wines and Regulation 1576/89 protects those used in relation to spirits.

Protected Geographical Indications are terms used in the course of trade to establish an association between a place and certain goods in order to evoke a quality standard and to benefit from the region's good reputation; for example, "Roquefort" for cheese, and "Champagne" for sparkling wine.