

Question B: What rules should govern claims by suppliers about the national or geographic origin of their goods or services?

Answer from UK National Rapporteur

1 – national provisions dealing with indications of origin

The UK jurisdiction's laws have provisions which deal with indications of origin which are used by manufacturers, distributors and service providers to commercialise their goods and services.

There are three laws being the general European Law protecting geographical indications (including specific laws relating to specific things such as wine), our local law of passing off and also the law of business misrepresentation, which is a form of consumer protection. The text of those provisions are principally General European Law: Regulation (EU) № 1151/2012 of the European Parliament and of the Council of 21 November 2012 on quality schemes for agricultural products and foodstuffs – text appended. Only an appointed policing authority or a group of interested concerns may take action to restrain the use of geographical indications which have been registered. It is a condition of the registration that the region in question must influence the quality or other characteristic of the product and that specific criteria are set out. Once goods fall within the criteria then no licence or permission is required; the trader may simply use the indication. Other texts exist of certain kinds of alcoholic beverages.

The texts of the relevant legislation can be found at

http://ec.europa.eu/agriculture/quality/index_en.htm

Our local English law of passing off whereby a group of traders, all of whom can show (1) a joint goodwill arising in association with a designation (whether geographical or otherwise) and which arises as a result of its reputation, (2) that a misrepresentation has been made which causes (3) damage to that goodwill, is entitled to take action – there are no written provisions concerning this law, it deriving from the general power of a court to protect trader's earned goodwill.

Our local English law of consumer protection where a statement made about a saleable product or service is unlawful if it is misleading. Misleading includes any statement which incorrectly ascribes the geographical origin of the product in question.

2 – requirements to qualify for marking with indication of origin

For goods to be marketed with an indication of origin and where the indication is not registered, then the only criteria are accuracy and truth.

For goods to be marketed with an indication of origin and where the indication is registered, then the only criteria is that the goods or their origin or method of production fall within the registered characteristics.

For services to be marketed with an indication of origin then the only criteria are accuracy and truth.

3 – are there different provisions relating to resist ability of a geographical indication for different types of goods?

There are different provisions for different types of goods such as for wines and spirits, foodstuffs, natural goods, industrial products and so on. In relation to foodstuffs, wines and spirits and certain agricultural products the rules are that the region in question must influence the quality or other characteristic of the product and that specific criteria are set out and met. Where the indication is registered then the only criteria is that the goods or their origin or method of production fall within the registered characteristics.

Our local English law of consumer protection where a statement made about a saleable product or service is unlawful if it is misleading, including as to origin, relates to all types of product.

4 – domestic and foreign indications

There is a difference between domestic and foreign indications. However, unless enforcing a foreign law, England does not apply the country-of-origin principle (according to which foreign indications of origin are judged according to the law of their country of origin). This principle is unknown in England.

5 – Is there a special geographical indications register?

There is no special register for the registration of indications of origin for goods and/or services within the English jurisdiction.

However to leave the answer there would be misleading. Our law of trade marks allows applications to be made for collective and certification marks (applications for which must be accompanied by draft rules which must be complied with in order to be entitled to use the mark, though gather is no “owner“ as such) and the usual limitation against registering geographical indications is relaxed. The marks concerned are not kept on special registers but the registrations are accompanied by a citation of the rules in question. The scope of protection is as for any registered trade mark.

6 – systems of mandatory protection

There is no requirement for any indication of origin to be registered before it can be protected. Of course protection is an arguably easier process if there is registration, but there does not have to be in England.

7 – position concerning pre-existing users of geographical indications

It is possible that manufacturers, suppliers and distributors of goods or services which have lawfully advertised their goods or services with an indication of origin for a long time be excluded from using the indication of origin after the indication’s registration (*e.g.* because they cannot comply with new use requirements that apply after the registration of the indication of origin)? England does not have any provisions which try to prevent such exclusions of previous legitimate users of indications of origin.

8 – registration of geographical indications as trademarks and service marks

The laws of England provide for the registration of indications of origin as trademarks or service marks, as certification marks or collective marks but not individual marks. The requirements are that use must not be misleading.

Conflicts between trademarks and non-registered indications of origin are resolved under our country’s laws by (1) banning trade marks from being registered if they serve as geographical indications and have no secondary meaning derived by use of the trade mark by the trade mark owner and (2) a law of conflict which prohibits trade marks from being registered if opposed by prior use of non-registered indications of origin.

Conflicts between trademarks and indications of origin that are subject to *sui generis* protection are resolved under our country’s laws by allowing the (pre-existing, pre applied for or pre used, and in all cases, in good faith) trade mark to continue to be used.

There are specific rules or case law governing such conflicts.

10 – differentiated manufacturing or production locations

The expression “manufacturing step” is understood to include steps of conditioning, preparing or production of a product. If that be so then it is possible in our jurisdiction for a producer or marketer to highlight in an advertisement for that product that one specific manufacturing step took place in a particular place (such as “sliced in XY”). However that is only allowed if the advertisement does not overall exploit the reputation of the name or is otherwise false or misleading as to origin. This is dealt with under article 13(1) of EU regulation 1151/2012. Our national English law does allow the use of descriptive terms alongside geographical terms provided that in using them there is no misrepresentation and that the goodwill in relation to the geographical term is not owned by another. Where the term is misleading then that may amount to an unfair trading practice as well, whether or not there is any incident goodwill, though that is a criminal matter.

11 – labelling and country of origin labelling requirements

The laws in England have no specific provisions with regard to the requirements that have to be met to use the indication “Made in XY” for goods in a general sense.

However in relation to precious metals, footwear, food and drink and products for children there are specific rules for packaging, though none of them relate to origin save that for food and drink the country of origin must be indicated where otherwise the purchaser might be misled as to true origin and, since 13 December 2014 country of origin information will be required for fresh, chilled and frozen meat of sheep, pigs, goats and poultry. Exemptions exist for certain foods and drinks (non-pre-packaged foods, pre-packaged foods for direct sale, white bread and flour confectionary, individually wrapped fancy confectionary products not enclosed in any further packaging and which are intended for sale as single items, any pre-packaged food (other than milk) contained in an indelibly marked glass bottle intended for re-use which has no label, ring or collar, any pre-packaged food where the largest surface area is less than 10cm² and any pre-packaged food sold or supplied as an individual portion which is intended as a minor accompaniment to another food or service. Our local rules are the Food Labelling Regulations 1996 and the European rules are contained in the European Food Information to Consumers Regulation № 1169/2011.

The EU laws on geographical indications make it clear that the expression “made in XY” is likely to be regarded as an evocation of any registered geographical indication. Evocation is a concept which describes the situation which arises “when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected” – (C-4/10 & C-27/10) *Bureau national interprofessionnel du Cognac; Gust. Ranin Oy* [2011] E.T.M.R.1045, C.J.E.U. [56] and (C-87/97) *Consorzio per la Tutela del Formaggio Gorgonzola v. Kaserei Champignon Hofmeister GmbH & Co KG* [1999] E.C.R. I-1301; [1999] 1 C.M.L.R. 1203; [1999] E.T.M.R. 454, E.C.J. [25].

12 – product specific labelling requirements

There are no provisions in the laws of our jurisdiction which provide that for certain goods or services the geographic origin must be indicated (mandatory labelling requirements for example in the legislation with respect to foodstuffs, cosmetics, pharmaceuticals or customs) save as set out in relation to Q11. There is no specific wording requirement of these provisions. These provisions apply to the goods and services identified in Q11 above. Again there is no specific wording requirement of these provisions. The mandatory labelling requirements are not considered to be trade restraints in our jurisdiction.

13 – conflicts of local laws on labelling requirements

There is a risk of conflicts between the mandatory labelling requirements and the provisions regarding the voluntary use of geographical indications. However the likelihood of those conflicts would be rare or very rare since the mandatory labelling requirements require a statement of the country of origin whereas registrations including the name of a country are very difficult to attain or are very rare indeed, if they exist at all.

14 – personal opinion

In the personal opinion of the English rapporteur the interplay between trademarks and geographical indications must be looked at again so that those who have prior rights are entitled to keep them and not have their investment in those rights expropriated.