

# Geographical origins

## Application of the new law

In principle, signs that designate geographical origin should remain open to use by traders to indicate a connection with a particular geographical area : see section 11(1)(c) introducing a hurdle to the registration of marks exclusively designating geographical origin.

Consistent with this principle, signs that designate geographical origin should not be misleading : see section 11(4)(b) prohibiting registration of a mark likely to deceive the public.

Geographical signs that have become generic should not be registered : see section 11(1)(d) refusing registration of marks customary in language or trade and alternatively, section 11(1)(c) refusing registration of marks exclusively designating the characteristics of goods or services.

Geographical signs can be registered as certification marks or collective marks : see section (3)(1) of Schedule 4 and section 3(1) of Schedule 3, respectively.

## Trade marks consisting exclusively of signs designating geographical origin

A mark consisting of nothing more than a designation of geographical origin must be refused registration (section 11(1)(c)). For example, the name “Hong Kong” alone, or “Oregon” in a plain oval, or a thistle (for products from Scotland) are marks consisting exclusively of a sign designating geographical origin.

Nevertheless, if a mark consisting exclusively of a sign designating geographical origin has in fact acquired a distinctive character as a result of use before the date of application for registration, it can be registered (section 11(2)). See for example *Blount Inc v Registrar of Trade Marks* (1998) 40 IPR 498, a decision of the Federal Court of Australia under the Australian Trade Marks Act 1995, where on evidence of long and extensive use (for over 33 years before the application date showing that the products were sold by more than 1,500 retailers) the word OREGON presented in upper case in an oval was held registrable in respect of goods in classes 7 and 8.

But some geographical names are so widely used that it is unlikely that they will acquire a distinctive character as a result of use. Names of countries and major cities, for example, USA, New York, UK, London, France, Paris, China, or Beijing are unlikely in fact to acquire distinctive character in relation to a particular trader's goods or services.

Evidence that a mark has in fact acquired a distinctive character, as a result of its use for the goods or services prior to the date of application, should be given in a statutory declaration (see Section 11(2) – *acquired distinctiveness through use* in chapter on Absolute grounds for refusal).

Not all geographical names will necessarily serve as designations of geographical origin : for example places with low population or with no reputation for the goods or services in question. Those marks may have distinctive character and will be registrable without evidence (see below). See for example *Magnolia Metal Company* [1897] 2 Ch 371 where it was not only said, “the phrase ‘geographical name’ must be interpreted so as to be in accordance in some degree with the general and popular meaning of the words, and a word does not become a geographical name simply because some place upon the earth’s surface has been called by it”; but also that “if the name is really a local name (however little known the locality may be), and the name is given because of the connection of the article with the locality, whether that be real or imputed only by those who give the name, it may well be a geographical name”. (The case is cited as an illustration of the necessary connection between place and goods and services. No objection can now attach to a “geographical name” as such.)

## **Trade marks not exclusively designating geographical origin**

A composite mark that consists of more than a sign designating geographical origin will generally be registrable unless it is devoid of any distinctive character (section 11(1)(b)), exclusively characterises goods or services (section 11(1)(c)) or is in customary usage (section 11(1)(d)).

### *Examples*

- ITALIAN FLAVOUR for sauces (section 11(1)(b), 11(1)(c)).
- SWISS CHALET for chocolate does not exclusively designate geographical origin but will be deceptive unless the specification is limited to “chocolate the product of Switzerland” : see *Marks deceptive of geographical origin*, below.
- SWISS ROLL for cakes (section 11(1)(d)).

## **Geographical origin**

### ***Fanciful reference not designating geographical origin***

If there is no connection, or only a tenuous connection between the place and the goods or services, so that the mark cannot realistically designate geographical origin (because consumers would not believe that the product or service originates from the place named in the mark) the mark is registrable without evidence of distinctiveness.

### *Examples*

- NORTH POLE for bananas.

- HOTJAVA for computers, computer software etc.
- BIG APPLE BAGEL and apple device for restaurant, café, snack-bar services.
- CHELSEA GIRL for clothing.
- MAGNOLIA for ‘antifriction metal bearings’ and for ‘unwrought and partly wrought metals used in manufacture’. See *Magnolia Metal Company* [1897] 2 Ch 371.

### ***Places with relatively low population***

Names of places with a population of up to 250,000 are likely to be registrable without evidence of distinctiveness.

However, the name of a place is not registrable if the place has a reputation for the particular goods or services.

#### *Examples*

- NAPA for alcoholic beverages : exclusively descriptive of geographical origin as the Napa Valley (population 50,879) is a wine producing area.
- BLUE MOUNTAIN for coffee : exclusively descriptive of geographical origin as high quality coffee is grown on the slopes of the Blue Mountain range in Jamaica, West Indies.

## ***Oceans, seas, lakes, rivers, mountains, deserts***

Names of oceans, seas, lakes, rivers, mountains and deserts are likely to be registrable if they are not actual or likely sources for the goods or locations for services.

### *Examples*

- ATLANTIC for footwear.
- MT EVEREST for paper, stationery.
- YELLOW RIVER for printed matter for recordings.

However, names of oceans, seas, lakes and rivers, will not be registrable for marine produce or, for example boat-charters. Names of mountains will not be registrable for agricultural produce; and names of deserts may not be registrable if irrigation or development has made them likely locations for the production of goods or provision of services. Similarly, names of major rivers that flow through commercial or industrial areas are unlikely to be registrable if the river gives its name to the surrounding area.

### *Examples*

- RHINESTEEL for chemical products for use as additives in the manufacture of metals and of metal alloys : exclusively descriptive of products for use in the steel industry and coming from the Rhine region.

- RIVER FRASER for salmon : exclusively descriptive.
- ALPS for organisation of sports events and provision of sports equipment : exclusively descriptive.

### ***Names of urban districts, roads and streets***

Names of urban districts, roads and streets are likely to be registrable if they are not actual or likely sources for the goods, or sites for sales of goods, or locations for services.

#### *Examples*

- SOHO for clothing : distinctive.
- OXFORD STREET for consumer goods : not distinctive.
- SAVILE ROW for spectacle frames and eyeglasses : not distinctive, see *Savile Row* [1998] RPC 155 at 163, 164.

### **Marks deceptive of geographical origin**

A trade mark which is deceptive must be refused registration (section 11(4)(b)).

A trade mark will be deceptive if it misrepresents that the goods originate from a geographical area to which a given quality, reputation or other characteristic of the

goods is attributable.

### *Examples*

- “Champagne” is a type of wine characterised by its origin from France’s Champagne district (see *Bollinger SA v Costa Brava Wine Co Ltd* [1961] RPC 116). The word “champagne” is distinctive exclusively for a sparkling wine produced in Champagne (*Taittinger SA v Allbev Ltd* [1993] FSR 641). In other words “champagne” can refer only to wine from the Champagne district of France, so that a registration for goods other than champagne from the Champagne district will be deceptive. The mark SPANISH CHAMPAGNE, even if used for sparkling wine from Spain, is deceptive (see *Bollinger SA v Costa Brava Wine Co Ltd* [1961] RPC 116). Similarly the mark ELDERFLOWER CHAMPAGNE, for a carbonated soft drink made from elderflowers, is deceptive (see *Taittinger SA v Allbev Ltd* [1993] FSR 641).
  
- “Scotch whisky” is a whisky distilled in Scotland so that a registration for goods other than Scotch whisky will be deceptive. The mark WHITE ABBEY SCOTCH WHISKY for Scotch whisky admixed with cane spirit will be deceptive (see *John Walker & Sons Ltd v Henry Ost & Co Ltd* [1970] RPC 489).
  
- “Havan” or “Habana” designates a cigar made in Cuba so that a registration for goods other than “tobacco the product of Cuba” will be deceptive (see *Newman v Pinto* (1887) 4 RPC 508 where a mark which included the words “La Pureza Habana Ramon Romnedo” for cigars not made in Havana was considered fraudulent).

A trade mark will also be deceptive if it includes clear wording suggesting a geographical origin which is not true, such as "made/made in/imported from" together with a geographical name but the goods are made in/imported from elsewhere.

In some circumstances, a restriction of the applicant's specification or a limitation will answer an objection that the mark is deceptive.

### *Examples*

- WEE McGLEN for whisky will be deceptive (*Wee McGlen* [1980] RPC 115) but the mark will not be deceptive if the specification is limited to "Scotch whisky" or an admixture of "Scotch whisky" and other ingredients (*Wee McGlen, supra*, at 121). The Hearing Officer decided that the mark did not suggest that all the ingredients of the applicant's goods were of Scottish origin but that used in connection with whisky, the mark was misleading.
- SWISS MISS for preparations for making chocolate or cocoa beverages will be deceptive if the goods are not of Swiss origin (*Swiss Miss* [1997] RPC 219). The judge rejected the argument that Switzerland, despite its reputation for chocolate and chocolate confectionery, has no reputation in a commercial sense for cocoa powder. On the facts that both chocolate and cocoa powder are produced from the cocoa bean and that manufacturers of cocoa powder are also manufacturers of chocolate, the judge found that a substantial number of people, who would assume that powder for making a chocolate drink labeled SWISS MISS came from Switzerland, would also assume that a powder for making a cocoa drink labeled SWISS MISS similarly has a *Swiss origin* (*Swiss Miss, supra*, at 229). The judge rejected the argument that SWISS used in conjunction with MISS would merely be taken as evoking a particular ambiance or as indicating the style or flavour of the product or its healthy qualities and not as indicating that, applied to chocolate or cocoa beverages, the product has a *Swiss origin* (*Swiss Miss, supra*, at 231).
- Similarly, SWISS CHALET for chocolate will be deceptive unless the specification is limited to "chocolate the product of Switzerland" (*Chocosuisse v Cadbury* [1998] RPC 117)).
- FLORIDA BELLE for oranges may be allowed if the specification is restricted

to “oranges, the produce of Florida, USA” so that the mark is not registered for goods for which it would be deceptive.

- DAVID CHUNG COMPUTERS MADE IN CAMBODIA applied to computers will be deceptive if the computers are made elsewhere. The objection may be overcome by a restriction of the specification to “computers made in Cambodia”.
- TAXNIK IMPORTED FROM JAPAN applied to cameras will be deceptive if the cameras are imported from elsewhere. The objection may be overcome by a limitation as follows:

“The rights conferred by the registration of this mark are limited to goods imported from Japan.”

## **Suggestion of restricting specification or limitation in examination report**

If a limitation or a restriction of goods or services specified in an application for registration will answer an objection that a mark is deceptive, we will suggest a restriction or limitation in the examination report. (See *Restricting specification* in chapter on Classification and *Marks deceptive of geographical origin* above.)

## **Certification marks**

A mark designating the geographical origin of goods or services can be registered as a certification mark (see chapter on Certification and collective marks).

## Collective marks

A mark designating the geographical origin of goods or services can be registered as a collective mark (see chapter on Certification and collective marks).

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