# EXTENDED CONTENTS

*About the author*  
xiv

*Preface to the Second Edition*  
 xv

*Table of cases*  
 xvii

*Table of legislation*  
 xxiii

1. **OVERVIEW**  
   A. WHAT ARE CERTIFICATION AND COLLECTIVE MARKS?  
   B. ABOUT THE BOOK  
   C. OVERVIEW OF CONTENTS  
   D. EMERGING ISSUES AND DEBATES  
   E. SUMMARY

2. **HISTORICAL DEVELOPMENT OF CERTIFICATION AND COLLECTIVE MARKS**  
   A. INTRODUCTION  
   B. WHAT IS CERTIFICATION?  
   C. CERTIFICATION AND REGULATION  
   D. REGULATORY ORIGINS OF MARKING: THE GUILDS  
   E. COLLECTIVE MARKS: THE GUILD MARK  
   F. COMPULSORY TRADING STANDARDS  
   G. ENFORCEMENT OF TRADING STANDARDS  
   H. SIGNIFICANCE OF GUILD MARKS COMPARED TO MODERN MARKS  
   I. POST-MEDIAEVAL REGULATION  
   J. LEGAL PROTECTION OF MARKS: REGULATORY LAW DISPLACED BY TRADEMARK LAW  
   K. THE PASSING OFF RIGHT  
   L. INTRODUCTION OF THE REGISTRATION RIGHT  
   1. UK Trademark Acts  
   2. EU trademark (EUTM)  
      (a) The EU collective mark  
      (b) The EU certification mark  
   3. US Trademark Acts  
   M. RE-EMERGENCE OF THE CERTIFICATION RIGHT  
   N. SUMMARY

3. **ELEMENTS OF STATUTORY PROTECTION**  
   A. INTRODUCTION  
   B. PART 1: OVERVIEW OF CERTIFICATION AND COLLECTIVE MARKS  
   1. Certification marks  
   2. EU trademark reform  
   3. Introduction of the EU certification mark  
   4. Collective marks  
   5. A collective mark can denote certification  
   6. Treaty influences on certification and collective mark legislation  
      (a) The Paris Convention  
      (b) The TRIPS Agreement
EXTENDED CONTENTS

8. EU GIs for non-agricultural products 3.43
9. The EU collective mark 3.45
C. PART 2: CERTIFICATION MARKS 3.51
1. Geographical name certification marks 3.51
2. US certification marks 3.55
3. Certification marks as regulatory instruments 3.58
   (a) The EU conformity assessment system 3.58
   (b) The US conformity assessment system 3.63
4. US trades unions' marks 3.69
5. Competence to certify 3.70
6. Statutory definition of certification mark 3.72
7. Certification mark registration under TMA 1994 is regulated by Sch. 2 3.73
8. The proprietor’s regulations determine the significance of a certification mark 3.75
9. Distinctiveness standard for certification marks 3.77
10. Disclaimers and other restrictions on the certification right 3.79
11. The proprietor is excluded from use of a certification mark 3.81
12. Openness of access: certification must not be refused to any qualified goods or services 3.83
13. Perceptions of the public interest attaching to certification marks 3.86
14. Regulation of certification fees 3.87
15. Infringement of a certification mark 3.89
   (a) United Kingdom 3.89
   (b) United States 3.94
16. Authorized user or 'licensee' estoppel: US case law 3.100
17. Authorized user of UK registered certification mark likened to licensee in certain matters 3.106
18. Assignment of a UK registered certification mark requires approval of the registrar 3.107
D. PART 3: COLLECTIVE MARKS 3.108
1. UK statutory definition of collective mark 3.108
2. Proprietorship of collective marks 3.110
3. Parallel use as collective mark and ordinary trademark 3.111
4. UK collective mark registrants 3.113
   (a) Association by trade or profession 3.113
   (b) Churches and charities 3.115
5. Regulations governing use of collective mark 3.116
6. Grounds for revocation 3.118
7. Infringement of a collective mark 3.121
8. Authorized user of collective mark likened to licensee in certain matters 3.122
9. Infringement proceedings taken at authorized user’s request 3.123
10. Collective mark registration in the US 3.125
11. Collective mark registration in the EU 3.127
12. Persons entitled to bring an action for infringement 3.132
13. Confusion of certification and collective marks 3.133
E. CONCLUSION 3.137

4. PRODUCT CERTIFIERS’ LIABILITY
A. INTRODUCTION 4.01
B. THE MANUFACTURER IS A CERTIFIER 4.04
C. PRODUCT LIABILITY DISTINGUISHED FROM PRODUCT SAFETY LAW 4.08
D. CAUSATION 4.09
E. THEORIES OF LIABILITY FOR DEFECTIVE PRODUCTS 4.11
F. STRICT LIABILITY NOT NORMALLY IMPOSED ON THIRD-PARTY CERTIFIERS 4.12
G. FAIRNESS AND UTILITY IN STRICT LIABILITY 4.13
H. MANUFACTURERS ARE NOT REQUIRED TO BE INSURANCE CARRIERS 4.22
I. MANUFACTURERS’ OR IMPORTERS’ DUTY TO INSPECT, TEST AND CERTIFY 4.23
J. STATUTORY LIABILITY IN THE UK 4.25
EXTENDED CONTENTS

2. Consumer Protection Act 1987, Part I 4.28
3. General Product Safety Regulations 2005 4.33

K. TORTIOUS LIABILITY 4.37
1. Burden of proof 4.37
2. Economic loss 4.38

L. INSPECTORS’ AND CERTIFIERS’ DUTY OF CARE 4.40

M. SHIPPING INSPECTION – CLASSIFICATION SOCIETIES 4.45

N. NEGLIGENT CERTIFICATION – PHYSICAL HARM 4.52
1. Negligent undertakings and statements 4.52
2. The Poly Implant Prostèse (PIP) silicone gel breast implant cases 4.53

O. RELIANCE ON STATEMENTS OF PROFESSIONALS 4.60
1. Reliance placed on certifier’s skill and judgement 4.60
2. Building contractors/vendors distinguished from professional advisers 4.61

P. WRONGFUL DENIAL OF APPROVAL 4.63

Q. DEFAMATION 4.64

R. US PERCEPTIONS OF TORTIOUS NEGLIGENCE 4.66
1. The alleged undertaking 4.69
2. Product approvers and endorsers 4.70

S. TRADE ASSOCIATIONS 4.72

T. ORDINARY TRADEMARK LICENSES 4.79

U. US APPARENT MANUFACTURER DOCTRINE 4.82

V. SUMMARY AND CONCLUSION 4.90

5. THE LEGAL AND COMMERCIAL SIGNIFICANCE OF CERTIFICATION AND COLLECTIVE MARKS

A. INTRODUCTION 5.01

B. CERTIFICATION MARKS 5.05
1. The guarantee function 5.05
2. Is a certification mark a legally-binding guarantee? 5.09
3. The Consumer Rights Act 2015: product labelling and sale by description 5.10
4. Consumer protection against false certification 5.16
5. Can a certifier be held liable under the Consumer Protection Against Unfair Trading Regulations 2008? 5.18
6. Certification mark implicated in breach of implied terms 5.19
7. Certification provided for by contract of sale 5.20
8. Contractual certification can impact both description and quality 5.22
9. Contractual meaning of description 5.26
10. A certification mark may comprise little or no description 5.27
11. Contractual meaning of quality 5.29
12. Quality functions of certification and ordinary trademarks compared 5.31
13. Significance of a certification mark in US warranty law 5.34

C. BASIS FOR TRUST IN CERTIFICATION MARKS 5.43
1. Role of legalized trust 5.43
2. Proprietor’s right of action against infringers 5.44
3. Conditions of registration of a certification mark 5.46
4. Criminal offences under the Trade Marks Act 1994 5.48
5. False representations of registration 5.49
6. False indication of conformity to certification standards 5.50

D. CODES OF PRACTICE 5.52
1. UK trade associations’ codes of practice 5.52
2. Consumer codes of practice 5.54
3. Sanctions against misleading actions involving codes of practice 5.55
4. Consumer protection by approved consumer codes: official symbol 5.57

E. CERTIFICATION AND FRANCHISING SCHEMES DISTINGUISHED: US SYSTEM 5.58

F. EU GEOGRAPHICAL INDICATIONS: A SUI GENERIS CERTIFICATION SYSTEM 5.62
1. Certified GIs for agricultural products and foodstuffs 5.62
2. The certification scheme 5.64
3. Market surveillance and control provisions 5.66
EXTENDED CONTENTS

4. The guarantee function of GIs 5.67
5. Qualifications for GI registration 5.68
6. Informative logos for EU GIs 5.70
7. International protection of EU GI logos as registered trademarks 5.73
8. Comparison of GIs with certification and collective marks 5.75
9. GI infringement 5.78
10. The US v. EU GI dispute: WTO ruling 5.79
11. Summary of this section 5.82

G. COLLECTIVE MARKS 5.86
1. Object and essential function 5.86
2. Use of collective mark 5.87
3. Basis for protection 5.88
4. Eligibility to file applications 5.89
5. EU and Member State collective marks may function as geographical indications 5.94
6. UK registration system 5.98
7. Are collective marks necessary to modern commerce? 5.101
8. US registration system 5.105
9. Collective marks in co-branding schemes 5.112

6. REGULATIONS AND STANDARDS

A. INTRODUCTION 6.01
B. TECHNICAL REGULATIONS, STANDARDS AND INDICA OF CONFORMITY 6.03
C. REGULATIONS AND STANDARDS AS TECHNICAL BARRIERS TO TRADE 6.06
D. REGULATIONS AND STANDARDS DISTINGUISHED: THE WTO/GATT FRAMEWORK 6.08
E. PRINCIPLE OF MUTUAL RECOGNITION 6.12
1. Mutual acceptance of conformity assessments 6.12
F. COMMERCIAL TREATIES IN HISTORICAL CONTEXT 6.15
1. Early bilateral agreements 6.15
2. Establishment of the Standards Code 6.17
3. The GATT Uruguay round: agreement on technical barriers to trade 6.20
G. STANDARD-SETTING BODIES 6.22
1. WTO/GATT designated bodies 6.22
2. Central government standard setting: code of practice 6.27
3. Local government and non-governmental bodies’ codes of practice 6.28
4. Non-governmental standard-setting bodies 6.29
H. WTO RELATIONS WITH NON-GOVERNMENTAL ORGANIZATIONS (NGOS) 6.30
I. THE EU FRAMEWORK 6.31
1. Product conformity assessment standards and mandatory marking 6.31
2. European harmonized standards 6.32
3. Mandatory marking in the EU single market 6.33
4. Background to the ‘New Approach’ 6.34
5. The Information Directive 6.36
6. The notification procedure 6.37
7. Case law 6.38
8. Minimum requirements and mutual recognition within the EU single market 6.42
J. THE EU PRODUCT CONFORMITY SYSTEM 6.44
1. Conformity assessment bodies 6.44
2. Accreditation of conformity assessment bodies (CABs) – national accreditation bodies (NABs) 6.50
3. The EU CE marking scheme: a single mark for products in many classes 6.54
4. Is the CE mark a certification mark? 6.55
5. European standards bodies 6.56
K. TECHNICAL COOPERATION BETWEEN GATT/TBT-NOMINATED STANDARDIZATION BODIES AND THEIR EU COUNTERPARTS 6.61
1. Background 6.61
2. The Vienna Agreement 6.62
3. The Frankfurt Agreement 6.63

xii
L. STANDARD-SETTING BY INDIVIDUAL COMPANIES AND CONSORTIA 6.64
   1. De jure and de facto standards 6.64
   2. The spectre of antitrust allegations in de facto standard generation 6.67
   3. Standard essential patents 6.68
   4. The common patent policy 6.70
M. EU COMPETITION LAW: TRADE ASSOCIATIONS’ CONFORMITY ASSESSMENT AND STANDARD-SETTING ACTIVITIES 6.73
   1. EU policy 6.73
   2. Certification marks, seals of approval and quality marks viewed as standards 6.75
   3. Trade association standards: UK competition law 6.78
   4. E-commerce in the EU 6.80
N. CONCLUSION 6.82

7. ECOLABELS
   A. INTRODUCTION 7.01
   B. BACKGROUND 7.07
   C. DEFINITIONS AND TYPOLOGY 7.15
   D. OWNERSHIP AND GOVERNANCE 7.21
   E. AWARD POLICIES 7.31
   F. INTELLECTUAL PROPERTY RIGHTS 7.35
      1. Ordinary trademarks 7.36
      2. Certification marks 7.45
      3. Collective marks 7.46
      4. Copyright 7.47
   G. ECOLABELS AS ENVIRONMENTAL CLAIMS 7.48
      1. US regulation and control of environmental advertising 7.56
   H. ECONOMIC INTERESTS AND MARKET RELATIONS 7.66
      1. Public v. private goods 7.66
      2. Credence qualities and information asymmetry 7.67
   I. INTERNATIONAL TRADE 7.74
   J. CONCLUDING REMARKS 7.77

8. AUTHENTICATION MARKING OF DIGITAL PRODUCTS
   A. INTRODUCTION 8.01
   B. TOWARDS A DIGITAL AUTHENTICATION MARK: THE AUTHENTICITY-AUTHORIZATION NEXUS 8.04
   C. DIGITAL WATERMARKS 8.08
      1. Watermark robustness v. perceptibility 8.11
      2. Digital watermarking technology evaluation 8.12
      3. Authentication and encryption 8.13
   D. PUBLIC KEY INFRASTRUCTURE (PKI) CRYPTOGRAPHY 8.14
      1. Digital signatures as evidence of authenticity 8.15
      2. Digital signatures as authenticators in UK law 8.18
      3. The role of certification authorities 8.19
   E. THE ELECTRONIC COMMUNICATIONS ACT 2000 (ECA) 8.21
   F. THE EU EIDAS REGULATION 8.23
   G. WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO) COPYRIGHT TREATY 8.25
      1. WCT art. 11 protects against circumvention 8.27
      2. EU implementation of WCT art.11 8.28
      3. US implementation of WCT art.11 8.38
      4. WCT, art.12 protects rights management information 8.42
      5. EU implementation of WCT art.12 8.43
      6. US implementation of WCT art.12 8.45
   H. SUMMARY AND CONCLUSION 8.47

APPENDIX 264

Index 267