



EU certification marks



EU collective marks



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21/09/2021

PROGRAMME

50'
Presentation

- 1) General introduction
- 2) EU Certification marks
- 3) EU Collective marks

10'
Questions and answers

1 General introduction

WHAT DO THESE SIGNS TELL YOU?



LEGAL FRAMEWORK

COLLECTIVE MARKS

**Section 1:
Articles 74 – 82 EUTMR**

Article 16

CERTIFICATION MARKS

**Section 2:
Articles 83 – 93 EUTMR**

Article 17

EUTMR: Chapter VIII

EUTMR: Chapters I – VII and IX - XIV

to the extent Section 1 and Section 2 (Ch. VIII) do not provide otherwise

EUTMIR: Title VI

RELATIONSHIP AMONG THE THREE KINDS OF EU TRADE MARK

	INDIVIDUAL	COLLECTIVE	CERTIFICATION
FUNCTION	Distinguish G/S of one undertaking from those of other undertaking	Distinguish G/S of the association members from those of other undertakings	Distinguish certified G/S by the mark proprietor from those non-certified
OWNERSHIP	Natural + legal persons	Associations + legal persons of public law (<i>with an internal structure of an associative nature</i>)	Natural + legal persons → No business involving supply of G/S of the kind certified !!
RIGHT TO USE	Proprietor and Licensees	Authorized users: members of the association	Authorized persons: certified users Not the proprietor

2 EU certification marks

DEFINITION AND FUNCTION

Art. 83 (1) EUTMR

- is an **EU trade mark**...
- **described as such** when the mark is applied for
- is capable of **distinguishing goods or services** which are **certified** by the mark proprietor in respect of:

material

mode of manufacture of goods

performance of services

quality

accuracy

other characteristics

with the
exception of the
**geographical
origin**

from **goods or services** which are **not so certified**

REGULATIONS GOVERNING USE REQUIREMENTS

Art. 84 EUTMR + Art. 17 EUTMIR

- 1 The **name** of the applicant
- 2 A **declaration** of the applicant stating that it does not carry on a business involving the supply of goods or services of the kind certified
- 3 The **representation** of the EU certification mark
- 5 The **goods or services covered** by the EU certification mark
- 6 The **characteristics** of the goods and services for which certification is requested
- 7 The **conditions governing use** of the EU certification mark, **including sanctions**
- 8 The **persons authorised to use** the EU certification mark
- 9 **How** the certifying body is **to test those characteristics + to supervise the use** of the mark

Template for RoU @ EUIPO website: <https://euipo.europa.eu/ohimportal/en/certification-and-collective-marks>

Case reference: R 1364/2019-2

Art. 84 EUTMR + Art. 17 EUTMIR [Art. 85(1) EUTMR]

EUTM no. 17 682 469

'(...) according to the Board, it follows from the wording of Article 17 EUTMIR that **all the information required must be included in the regulations of use (...)**' - § 27

With a view to **remedy the deficiencies raised by the Office, the RoU must be updated.** An alternative document focusing only in the omission and not containing the other conditions of Art. 17 EUTMIR does not suffice - § 23, § 28, § 33, § 41



The Board finds that the RoU **do not describe characteristics of the certified services.** (...) does not comply with Article 17(e) EUTMR or Article 83(2) EUTMR'. § 36

(..) with regard to the **list of persons authorised to use the trade mark** (Article 17(g) EUTMIR), it would be sufficient for the applicant to amend the regulations of use to **add the Internet link** referred to in its reply to the examiner (...) - § 42

(...) applicant did not amend the regulations of use pursuant to Article 85(3) EUTMR - § 43



Decision confirmed

Cl.: 35, 37, 41, 42



Application rejected

GROUNDS FOR REFUSAL

Art. 85 EUTMR

SPECIFIC	Regulations governing use	Not submitted	Art. 84(1) [Art. 85(1)]
		Content incorrect or incomplete	Art. 84(2) [Art. 85(1)]
		Contrary to public policy or morality	Art. 85(1)
	Others	Not conforming to mark's essential function	Art. 83(1) [Art. 85(1)]
		Certification in respect of geographical origin	Art. 83(1) [Art. 85(1)]
		Lack of applicant's neutrality	Art. 83(2) [Art. 85(1)]
		Misleading character or significance of the mark	Art. 85(2)
GENERAL	Absolute grounds (descriptiveness, lack of distinctiveness, ...)		Art. 7 [Art. 85(1)]
NON-REFUSAL	Amendment of the RoU → meets requirements Art. 85(1)+(2)		Art. 85(3)

1) ESSENTIAL FUNCTION

Art. 83(1) EUTMR [Art. 85(1) EUTMR]

- A certification mark indicates that the **goods or services bearing the mark**:
 - (i) **comply with a given standard** set out by the owner of the mark;
 - (ii) as a **result of a control set up** by the certification mark owner;
 - (iii) **irrespective of the identity of the undertaking** that actually produces or provides the g/s at issue and actually uses the certification mark.

- Relates to the **guarantee of specific characteristics** of certain **goods and services**

Example:

EUTM applies for **services** to be certified vs. RoU only speaks of characteristics/standards of **goods**

2) CERTIFICATION OF GEOGRAPHICAL ORIGIN

Art. 83(1) EUTMR [Art. 85(1) EUTMR]

Scenarios falling **within** the scope of objection:

- **Sign** → perceived G/S will be certified in respect of their geographical origin
- **RoU** → indicate that characteristic being certified is the geographical origin of the G/S or imposes an obligation of geographical nature
- **G/S list** → specifies G/S have a geographical origin or comply with a PDO/PGI

Scenario falling **outside** the scope of objection:

- **reference to a geographical term**, that indicates a particular geographical place, **BUT** it is **not perceived** that the **G/S will be certified in respect of that geographical origin**

EXAMPLE 1: GEOGRAPHICAL ORIGIN CERTIFICATION



EUTM No 17 277 245



Goods and Services

Class 9: oils and fats



Potential issues

The sign reproduces a registered **PGI 'Steirisches Kürbiskernöl'** [PGI-AT-1460] for **edible oil**. By definition GIs are linked to a specific geographical origin and will be perceived as such. Therefore, the sign gives direct information about the geographical origin of the goods (Styrian pumpkin oil).

Besides, the RoU explicitly mention that the goods are certified in relation to their geographical origin.



Result

Application refused.

EXAMPLE 2: GEOGRAPHICAL ORIGIN CERTIFICATION



EUTM No 17 870 740



Goods and Services

Class 44: *inter alia*, doctors' services & medical treatment provided by medical clinics and hospitals, in particular in the field of cardiology and cardio surgery.



Potential issues

The geographical reference in the sign ('German') read in combination with the other word elements and, in particular, the overall expression '*certified by the German cardiac society*' will not be perceived as an indication of the geographical origin of the goods and services but as an **indication of the certifier itself**. No element in the RoU that would suggest otherwise.



Result

Application accepted.

EXAMPLE 3: GEOGRAPHICAL ORIGIN CERTIFICATION

APPROVED BY
**ANIMAL PROTECTION
DENMARK**



EUTM No 17 596 917



Goods and Services

Classes: 29, 30 and 31



Potential issues

The overall expression **'approved by' 'animal protection Denmark'** will not be perceived as an indication of the geographical origin of the goods. However, the **RoU clearly state that the mark intends to certify a geographical origin**, namely that the goods in question originate from animals that have been bred according to certain specifications, among which is the necessary link to Denmark or the Danish area.



Result

Application refused. The geographical origin reference in the RoU was not amended.

Case reference: R 2205/2020-4

Art. 83(1) EUTMR [Art. 85(1) EUTMR]

EUTM no. 18 209 306

The mark designates that the claimed goods are from Canada. It is so clear that any use of the mark for milk (or other dairy products) from, for example France, would be deceptive (02/03/2020, R 1499/2016-G, La Irlandesa 1943, § 39,40) **§15**



The amended RoU do not remedy the objection under Art. 83(1), although Art. 85(3) allows such possibility, since it simply **deleted** the reference to 'milk of Canadian origin'. Despite such **silence**, the origin of any milk covered by the RoU would still have to be Canadian milk as: (i) it is stated in the sign representation and (ii) Foods and Drugs Act standards apply, meaning certification re: compliance with Canadian law - **§26-28; 30**

✓ Decision confirmed

Cl. 29: Dairy products

✗ Application refused

3) OWNERSHIP AND ‘DUTY OF NEUTRALITY’

Art. 83(2) EUTMR [Art. 85(1) EUTMR]

- Ownership limitation → **Declaration** in the RoU must be included → **good faith**
- **Precluded from using the mark** → neutrality
- **Proprietor must not have any economic (business) interest on the relevant market**

Scenarios falling **within** the scope of objection:

- producer or supplier of the G/S to be certified, although formally distinct from the owner of the certification mark, is **economically linked to the latter**;
- **use** of the certification mark is **conditioned** by **use of the G/S provided by the owner of the MARK** (e.g. when a raw material is supplied by the owner of the certification mark).

BUT, it is **acceptable** for the owner to provide some **training on the certification scheme to its users** since (as long as) **it is an economical field that is different from the certified G/S**.

EXAMPLE: DUTY OF NEUTRALITY



W01496823



Goods and Services

Class 37: Repair services in the field of repair of pressure valves, relief valves, pilot operated valves, (...)



Potential issues

RoU: In order to be certified, a **repair service** must meet, three criteria: (1) must repair **products manufactured and sold by the holder**; (2) must do so **using spare parts manufactured and sold by the holder**; (3) must **use test equipment obtained from the holder**.

Duty of neutrality is **not fulfilled** where **use of the certification mark is conditioned by use of the G/S provided by the owner of the certification mark**. The holder has an economic interest in the relevant market.



Result

Application refused.

Case reference: R 1364/2019-2

Art. 83(2) EUTMR [Art. 85(1) EUTMR]

EUTM no. 17 682 469

‘(...) even assuming that the ‘characteristic’ of the services certified by the applicant is ‘quality’ (Article 83(1) EUTMR), the mere fact that the persons have been filed by the applicant itself is not sufficient to guarantee the objective quality of the services, even if that may potentially imply, indirectly, a certain quality. Furthermore, the procedures followed, the technical repositories, the applicable statutory, legal and normative requirements that apply depend on each undertaking and that are not insignificant and are therefore not certified by the applicant, contrary to Article 83(2) EUTMR’ - § 38



‘(...) as regards the other services in Classes 35, 41 and 42 (evaluation, training, audit etc.), even considering that the characteristics of those services are described in the RoU, (...), the RoU are inconsistent in any event with Article 83(2) EUTMR, since **the applicant, providing training and certification for technicians and an audit of undertakings, carries out the activity relating to the provision of services of this kind.** Thus, as regards the services in Classes 35, 41 and 42, the RoU clearly show that the mark does not comply with the requirement of Article 83(2) EUTMR’. § 40



Decision confirmed

Cl.: 35, 37, 41, 42



Application rejected

4) MISLEADING CHARACTER or SIGNIFICANCE

Art. 85(2) EUTMR

- If the **public is liable to be misled** as regards **the character or the meaning of the mark**, in particular if it is likely to be perceived as something other than a certification mark
- No need of any reference in the representation of the sign linked to its kind
- When **the sign** indicates a **quality that is different from or contradicts the subject of the quality standard as stated in the RoU** the public is liable to be misled
- The **perception** of the sign **by the relevant consumer** is decisive and will depend on:
 - (1) on the **sign itself**; and
 - (2) on the **specification of use** of the **mark** as laid down in the **RoU**; and
 - (3) on the **goods and services** covered.

Case reference: R 2205/2020-4

Art. 85(2) EUTMR

EUTM no. 18 035 160

Application is refused because there is a **serious risk** the sign will be misleading by conveying the following strong certification message: that the natural plants and flowers (class 31) purchased are produced with quality and social and environmental responsibility, when in turn the **specification of use** of the mark conveys that the **natural plants and flowers can in fact be mixed between certified product (at least 70%) and non-certified product** → **contradiction**



Reference to Article 85(3) EUTMR - §23

The Board took note of the **amendment to the regulations of use** which **removes the reference** to the **possible use** of the certified trade mark for mixtures where at least 70 % of the flowers were using the applicant's quality and sustainability scheme. - §24

Considers that the objection correctly presented has been **remedied** and the certification mark can be accepted. - §25

✗ Decision annulled

Cl. 31: natural plants and flowers



Application allowed

5) RoU CONFORMING TO PUBLIC POLICY AND MORALITY

Art. 85(1) EUTMR

- Situations where, regardless of the sign, the **RoU contain a provision** that is **contrary to public policy or to accepted principles of morality**.

Examples:

- a) the applicant would not be entitled to carry out the certification (e.g. for lack of compliance with statutory provisions);
 - b) the authorisation or conditions of use discriminate between market operators without due justification (lack of objective criteria or application of inadmissible criteria).
- This ground for refusal applies in addition to Article 7(1)(f) EUTMR, which relates in the first place to the sign applied for.

3 EU collective marks

DEFINITION AND FUNCTION

Art. 74 (1) EUTMR

- is an **EU trade mark**...
- **described as such** when the mark is applied for
- is capable of **distinguishing** the goods or services of the members of the association which is the proprietor of the mark **from those of other undertakings**

(20/09/2017, C-673/15 P & C-674/15 P & C-675/15 P & C-676/15 P DARJEELING (fig.) / DARJEELING et al., EU:C:2017:702, § 63; 12/12/2019, C-143/19 P, EIN KREIS MIT ZWEI PFEILEN (fig.), EU:C:2019:1076, § 26, 57, 58)

REGULATIONS GOVERNING USE REQUIREMENTS

Art. 75 EUTMR + Art. 16 EUTMIR

- 1 The **name** of the applicant
- 2 The **object** of the **association** or for which the legal person governed by public law is created
- 3 The **bodies authorised to represent** the association or legal person governed by public law
- 5 In the case of an association, the **conditions of membership**
- 6 The **representation** of the EU collective mark
- 7 The **persons authorised to use** the EU collective mark
- 8 Where appropriate, the **conditions governing use** of EU collective mark, including **sanctions**
- 9 The **goods or services covered** by the EU collective mark including, where appropriate, **any limitation** introduced as a consequence of Article 7(1)(j), (k) or (l) EUTMR
- 10 Where appropriate, the **authorisation of Article 75(2) EUTMR** (geo descriptive marks)

REFUSAL GROUNDS

Art. 76 EUTMR

SPECIFIC	Regulations governing use	Not submitted	Art. 75(1) [Art. 76(1)]
		Content incorrect or incomplete	Art. 75(2) [Art. 76(1)]
		Contrary to public policy or morality	Art. 76(1)
	Others	Not conforming to mark's essential function and/or lack of entitlement	Art. 74(1) [Art. 76(1)]
		Misleading character or significance of the mark	Art. 76(2)
GENERAL	Absolute grounds (descriptiveness, lack of distinctiveness, ...)		Art. 7 [Art. 76(1)]
NON-REFUSAL	Amendment of the RoU → meets requirements Art. 76(1)+(2)		Art. 76(3)

1) ESSENTIAL FUNCTION + OWNERSHIP

Art. 74(1) EUTMR [Art. 76(1) EUTMR]

- Ownership is limited to:

(i) **Associations of manufacturers, producers, suppliers of services, or traders**

Under the terms of the **law governing them**, have the **capacity in their own name** to have rights and obligations of all kinds, to make contracts or accomplish other legal acts and to sue and be sued.

(ii) **Legal persons governed by public law**

Taking into account the essential function, they have to be either **associations in a formal sense** or need to have an **internal structure of an associative nature**.

2) MISLEADING CHARACTER or SIGNIFICANCE

Art. 76(2) EUTMR

- If the **public is liable to be misled** as regards **the character or the meaning of the mark**, in particular if it is likely to be perceived as something other than a collective mark
- Scenarios falling **within** the scope of objection:
 - a) If it is perceived as **available for use by anyone meeting certain objective standards**
 - b) If the **RoU permits use** of the collective mark **by non-members of the association**
 - c) If it **conveys a strong certification message**
 - d) If the wording of **RoU reveals** that the mark is **actually to be used as a certification mark**
 - e) if it **consists of**:
 - **PDO/PGI** (*'Arroz del Delta del Ebro / Arròs del Delta de l'Ebre'* [PDO-ES-0336], *'Nocciola Romana'* [PDO-IT-0573])
 - **logo contained in the PDO/PGI product specification**



EXAMPLE : MISLEADING CHARACTER or SIGNIFICANCE



EUTM No 18 061 747



Goods and Services
Classes 35, 36 and 45.



Potential issues

The sign representation, among other elements, contain the terms: **'BRAND WARRANTY'**

Specific provisions of the RoU gathers **explicit references to a certification system** established by the ICAB and it establishes **specific use conditions of the applied sign as a certification mark.**

Sufficiently serious risk that the public is liable to be misled by the applied sign, since it conveys a strong certification message (sign + RoU)



Result

Application refused.

3) RoU CONFORMING TO PUBLIC POLICY AND MORALITY

Art. 76(1) EUTMR

- Situations where, regardless of the sign, the **RoU contain a provision that is contrary to public policy or to accepted principles of morality.**
 - e.g. authorisation or conditions of use discriminate between market operators without due justification (such as a lack of objective criteria or the application of inadmissible criteria) or establish manifestly discriminatory fees.
- This ground for refusal applies in addition to Article 7(1)(f) EUTMR, which relates in the first place to the sign applied for.

4) ABSOLUTE GROUNDS

Art. 7(1) EUTMR [Art. 76(1) EUTMR]

- EU collective mark application will, like any other EUTM application, be assessed against Article 7(1) EUTMR, without prejudice to the application of Article 7(3) EUTMR.
- If **limitation** is required after an objection under:
 - Article 7(1)(j) EUTMR (geographical indication)
 - Article 7(1)(k) EUTMR (traditional terms for wines)
 - Article 7(1)(l) EUTMR (traditional specialities guaranteed)

the **RoU should be amended accordingly** (Article 16(h) EUTMIR)

4. a) 'GEOGRAPHICAL DEROGATION'

Art. 7(1)(b) + Art. 75(2) EUTMR [Art. 76(1)]

- A collective mark may serve in trade to **designate the geographical origin** of the G/S – pursuant to Article 74(2) EUTMR, by way of derogation from Article 7(1)(c) EUTMR
- **Geographical descriptive** collective marks are **subject to**:
 - ✓ the **requirement of distinctiveness** - Article 7(1)(b) [and Article 7(3) EUTMR]
i.e. must have additional elements capable of distinguishing the G/S of the members of the association from those of other undertakings to be considered distinctive pursuant to Article 7(1)(b) EUTMR (05/03/2020 C-766/18 P, *BBQLOUMI (fig.) / HALLOUMI*, EU:C:2020:170, § 72 - 73)
 - ✓ the compulsory **authorization** required under Art. 75(2) EUTMR
i.e. RoU must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association that is the proprietor of the mark

CONCLUSION

