

**GUIDELINES FOR EXAMINATION OF  
EUROPEAN UNION TRADE MARKS**

**EUROPEAN UNION  
INTELLECTUAL PROPERTY OFFICE  
(EUIPO)**

**PART B**

**EXAMINATION**

**SECTION 4**

**ABSOLUTE GROUNDS FOR REFUSAL**

**CHAPTER 15**

**EUROPEAN UNION COLLECTIVE MARKS**

## Table of Contents

<b>1</b>	<b>Character of Collective Marks</b> .....	<b>3</b>
1.1	Definition .....	3
1.2	Specific function .....	3
1.3	Relationship with individual and certification marks .....	3
1.4	Applicable provisions and examination .....	4
<b>2</b>	<b>Ownership</b> .....	<b>5</b>
<b>3</b>	<b>Specific Absolute Grounds of Refusal</b> .....	<b>5</b>
3.1	Misleading as to the character or meaning of the mark .....	5
3.2	Regulations of use .....	6
3.2.1	Filing .....	6
3.2.2	Content .....	6
3.2.3	Compliance with public policy and morality .....	7
<b>4</b>	<b>Specificities as Regards the General Absolute Grounds for Refusal</b> .....	<b>7</b>
4.1	Descriptive signs and the ‘geographical derogation’ .....	8
4.2	Objections raised under Article 7(1)(j), (k) or (l) EUTMR .....	9

# 1 Character of Collective Marks

## 1.1 [Definition](#)

A European Union collective mark (EU collective mark) is a specific ~~type~~[kind](#) of EUTM which, pursuant to Article ~~66~~[74](#)(1) EUTMR, 'is described as such when the mark is applied for and 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'.

[It is one of the three kinds of marks set out in the Regulation, next to individual marks and certification marks.](#)

## 1.2 [Specific function](#)

An EU collective mark ~~is aimed at distinguishing~~[distinguishes](#) the goods and services of the members of the association that owns the mark from those of other companies that do not belong to that association. Therefore, the ~~European Union~~[EU](#) collective mark qualifies the commercial origin of certain goods and services by informing the consumer that the producer of the goods or the service provider belongs to a certain association and that it has the right to use the mark.

An EU collective mark is typically used by companies, together with their own individual marks, to indicate that they are members of a certain association. For example, Spain's Association of Shoe Manufacturers may want to apply for the collective mark 'Asociación Española de Fabricantes de Calzado', which, while belonging to the association, is also going to be used by all its members. A member of the association may want to use the collective mark in addition to its own individual mark, which could be, for example, 'Calzados Luis'.

~~Collective marks do not necessarily guarantee the quality of the goods, although this is sometimes the case. For example, regulations governing use frequently contain provisions to certify the quality of the goods and services of the members of the association and this is acceptable (see decision of 10/05/2012, R 1007/2011-2, REPRESENTATION OF A FLAG WITH STARS (FIGURATIVE MARK), § 13).~~

## 1.3 [Relationship with individual and certification marks](#)

It is up to the applicant to decide whether the trade mark fulfils the requirements of a collective mark ~~or of~~, [as opposed to](#) an individual mark, ~~or certification mark within the meaning of Article 83 EUMTR~~. This means that, in principle, the same sign ~~could~~[applied for as an EU collective mark might also](#) be applied for ~~either~~ as an individual EUTM or, ~~if the~~ [EU certification mark, provided that the respective](#) conditions ~~described in this chapter of the EUTMR~~ are met, ~~as a EU collective mark~~. Differences ~~between individual and collective~~ [for each application](#). The three kinds of marks do not ~~depend on~~[differ necessarily with respect to](#) the signs per se; but ~~rather, they depend on~~ [as regards their respective specific](#) other characteristics ~~such as~~[including, in particular, the requirements of](#) ownership ~~or~~[and](#) the conditions of use of the mark.

[However, an applicant should be aware of the fact that, in the event of having to subsequently demonstrate genuine use of the marks, it will probably be rather difficult to show use of the same sign for different kinds of marks. For further information](#)

[regarding genuine use of a mark in accordance with its function, please see the Guidelines, Part C, Opposition, Section 6, Proof of Use, point 2.3.1.](#)

For example, an association can file an application for the word mark ‘Tamaki’ either as an individual mark, [a certification mark](#) or ~~as~~ a collective mark, depending on the mark’s intended use (by the association itself or its members thereof); ~~or as a sign of guarantee of a characteristic or not~~. If it is applied for as ~~an~~ EU collective mark, certain additional formalities must be met, such as the submission of regulations of use; [\(see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph 9.2\).](#)

After filing [the application](#), changes to the kind of mark (~~from between~~ collective ~~to~~ [certification and individual](#) ~~or vice versa~~ marks) are accepted only ~~under certain circumstances when it is obvious from the application that the wrong kind of mark has been selected~~ (see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph ~~8.2.5~~[9.4](#)).

## **1.4 Applicable provisions and examination**

The EUTMR provisions apply to EU collective marks, unless Articles ~~6775~~ to ~~7482~~ EUTMR provide otherwise. On the one hand, EU collective marks are therefore subject to the general EUTM regime and on the other hand, to some exceptions and particularities.

It follows, firstly, that an [application for an](#) EU collective mark is, [in principle](#), subject to ~~broadly~~ the same examination procedure and conditions as [an application for an](#) individual ~~marks~~ mark. In general terms, the classification of goods and services, and the examination of formalities and of absolute grounds for refusal is done according to the same procedure as that applied to individual trade marks.

For example, examiners will check the list of goods and services or the language requirements in the same way as they do with individual trade marks. Similarly, if the EU collective mark falls under one of the grounds for refusal under Article 7 EUTMR, it will also be examined.

~~The~~ [Pursuant to the new provision of Article 16 EUTMIR, the](#) regulations provided by the applicant governing the use of its EU collective mark **must cover its use for all the goods and services** included in the list of the EU collective mark application. ~~This may be expressed, for example, by reproducing the list of goods and services in the regulations of use or by referring to the list of goods and services in the EU collective mark application.~~

For EU collective marks conflicting with PGIs/PDOs, traditional terms for wine or traditional specialities guaranteed, the regulations governing the use of an EU collective mark should accurately reflect any limitation introduced to overcome such conflicts. For example, the regulations of use of the EU collective mark ‘XYZ Designation of Origin’ for ‘wines’ should accurately reflect the fact that they refer to the use of the trade mark for wines complying with the PDO ‘XYZ’.

Secondly, the examination of an EU collective mark will also consider the exceptions and particularities of this kind of mark. These exceptions and particularities refer both to the formal and substantive provisions. As regards formalities, the requirement of the regulations governing use of the mark is, for example, a specific characteristic of an EU collective mark. (For further details of the examination of formalities of EU collective

marks, including the regulations of use of the mark, see the Guidelines, Part B, Examination, Section 2, Formalities, paragraph [89.2](#)).

The substantive exceptions and particularities that apply to an EU collective mark are described below.

## **2.14.2 Ownership**

Ownership of EU collective marks is limited to (i) associations of manufacturers, producers, suppliers of services, or traders which, 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; and (ii) legal persons governed by public law. [\(Article 74 EUTMR\)](#).

The first type of owner typically comprises private associations with a common purpose or interest. They must have their own legal personality and capacity to act. ~~Therefore, private companies such as sociedades anónimas, Gesellschaften mit beschränkter Haftung, or~~ [Therefore](#), multiple applicants with a separate legal personality or temporary unions of companies cannot be owners of an EU collective mark. As set out in the Guidelines, Part B, Examination, Section 2, Formalities, paragraph [89.2.1](#), ‘collective does not mean that the mark belongs to several persons (co-applicants/co-owners) nor that it designates/covers more than one country’.

[Associations may be organised under different legal forms, including that of private corporation \(such as Gesellschaften mit beschränkter Haftung\). However, as the latter are generally not organised as associations, the Office considers that a private corporation cannot be the owner of an EU collective mark unless it shows that its internal structure is of an associative nature.](#)

~~The~~ [As regards same applies to](#) the second type of owners, ~~the concept ‘legal-’~~ ‘Legal persons governed by public law’ ~~must be interpreted broadly.~~ [have to be either associations in a formal sense or need to have an internal structure of an associative nature \(the broader approach, in decision of 10/05/2012, R 1007/2011-2, REPRESENTATION OF A FLAG WITH STARS \(fig.\), § 17, relates to the state of the law prior to the creation of the EU certification mark by Regulation 2015/2424\).](#) This concept includes, ~~on the one hand, associations, corporations and other entities governed by public law —~~ [for example, the associations or corporations governed by public law, such as the](#) ‘consejos reguladores’ or ‘colegios profesionales’ under Spanish law. ~~On~~

## **[3 Specific Absolute Grounds of Refusal](#)**

### **[3.1 Misleading as to the character or meaning of the mark](#)**

[The examiner must refuse the application 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](#) ~~hand, it~~ [than a collective mark under Article 76\(2\) EUTMR.](#)

[This refers to the situation where the mark will not be perceived as a collective mark by the public, but rather as an individual or certification mark.](#)

For example, a collective mark that is available for use only by members of an association that owns the mark could be liable to mislead if it gives the impression that it is available for use by anyone that is able to meet certain objective standards.

It could also ~~includes other legal~~ mislead if it conveys a strong certification message (for



example, (invented example), which is a clear contradiction of the function of the collective mark.

A collective mark would not, as such, be considered misleading as to its character by the sole fact that the regulations of use may also include specific requirements of use with respect to the quality of the goods and services protected by the mark. However, where the examination of the regulations of use reveals that the mark is actually to be used as a certification mark and not as an indicator that the goods and services come from the members of the association, it will be considered to mislead the public.

## 3.2 Regulations of use

### 3.2.1 Filing

The regulations of use may be filed within **two months** of the application of the collective mark (Article 75(1) EUTMR) and its content must comply with the requirements of Article 16 EUTMR.

### 3.2.2 Content

The regulations of use form an **integral part of the collective mark.**

They must **specify the** persons ~~governed by public law, for example, the European Union, States or municipalities, that do not necessarily have a corporative or an associative structure but which can nevertheless be owners of EU collective marks. In these cases, the requirement concerning~~ authorised to use the mark, the conditions ~~for~~ of membership under Article 67(2) EUTMR is not applicable of the association and can also include the conditions of use of the mark (Article 16 EUTMR).

The regulations of use should reflect the specific kind of mark of the application and the fact that the mark is indeed a collective mark, which will be used by the members of the association.

In addition, where the collective mark is applied for by making use of the 'geographical derogation' (see ~~decision of 22/11/2011, R 828/2011-1, REACH, § 18, and decision of 10/05/2012, R 1007/2011-2, REPRESENTATION OF A FLAG WITH STARS (FIGURATIVE MARK), § 17-18).~~ That is to say, when the applicant for an EU collective mark ~~is a legal~~ paragraph 4.1 below), the regulations of use must explicitly authorise any person ~~governed by public law that does not necessarily have a corporative or an associative structure, such as the European Union, a State or a municipality, whose goods or services originate in the geographical area concerned to become a member of the association that is the proprietor of the mark.~~

The substantive examination of the application will only start upon reception of the regulations of use.

### 3.2.3 Compliance with public policy and morality

If the regulations governing use of the mark ~~need not contain details concerning membership~~ are contrary to **public policy** or to **accepted principles of morality**, the EU collective mark application must be refused under Article 76(1) EUTMR. This ground for refusal applies, in addition to Article 7(1)(f) EUTMR (which relates in the first place to the sign applied for), to the regulations of use.

~~2.14.3 Particularities as regards~~ It refers to situations where, regardless of the trade mark, the regulations governing use of the mark contain a provision that is contrary to public policy or to accepted principles of morality. This would be the case, for example, where the authorisation or conditions of use discriminate between market operators without due justification (such as a lack of objective criteria or application of inadmissible criteria) or the regulations of use would establish manifestly discriminatory fees.

### 3.2.4 Remedies

In some cases, it will be possible to amend the regulations of use in order to remove a ground for refusal of a collective EUTM application (Article 76(3) EUTMR) which has been raised by the Office under Articles 76(1) and (2) EUTMR.

## 4 Specificities as Regards the General Absolute Grounds for Refusal

In addition to the specific grounds for refusal applicable to collective marks, applications for this kind of mark need to be examined with regard to the absolute grounds for refusal

~~Absolute grounds for refusal, as listed in Article 7(1) EUTMR, apply to EU collective marks. (Article 74(3) EUTMR). This means that these EU collective marks will, like any other EUTM application, be examined in the first instance under those provisions to verify, assessed on all general grounds for example, whether or not they are distinctive, deceptive or have become a customary sign. refusal laid down in Article 7(1) EUTMR.~~

If, for example, a collective mark is not inherently distinctive under Article 7(1)(b) EUTMR, it will be refused (~~see~~ decision of 18/07/2008, R 229/2006-4, CHARTERED MANAGEMENT ACCOUNTANT, § 7).

~~However, there are some exceptions and particularities that must also be taken into account when examining absolute grounds for refusal of EU collective marks. In addition to the grounds for refusal of an EUTM application contained in Article 7(1) EUTMR, examiners assess the following specific grounds:~~

- ~~• descriptive signs~~
- ~~• misleading character as to its nature~~

- ~~regulations of use contrary to public policy and morality.~~

~~These specific grounds for refusal can also be the subject of observations submitted by third parties.~~

2.14.3

#### **4.1** **Descriptive signs and the ‘geographical derogation’**

Pursuant to Article ~~66~~[74](#)(2) EUTMR, signs or indications that may serve, in trade, to designate the geographical origin of the goods or services may constitute EU collective marks.

As a result, a **sign that describes the geographical origin of the goods or services** (and that would be refused if it were applied for as an individual EUTM) **can be accepted** if ~~(i) it is validly applied for as a EU collective mark and (ii) it complies with the authorisation foreseen in Article 67(2) EUTMR (see decision of 05/10/2006, R 280/2006-1, VINO NOBILE, § 16-17).~~

~~A sign that describes the geographical origin of the goods or services comprises those signs that exclusively include a geographical term but also, those signs that include other non-distinctive or generic terms. For example,~~

- ~~it is validly applied for as an EU collective mark [No 13729611](#), [BIO LËTZEBUERG](#), for goods; and services~~

~~it complies with the authorisation set out in [Classes 29, 30, 31, 32, 33 and 35](#).~~

- [Article 75\(2\) EUTMR \(decision of 05/10/2006, R 280/2006-1, VINO NOBILE, § 16-17\)](#). According to this provision, the regulations governing use of ~~an~~[an](#) EU collective mark that is descriptive 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.

For example, an application for the word mark ‘Alicante’, specifying *tourist services*, should be refused under Article 7(1)(c) EUTMR if it is applied for as an individual EUTM, given that it describes the geographical origin of the services. However, as an exception, if it is validly applied for as ~~an~~[an](#) EU collective mark (i.e. it is applied for by an association or a legal person governed by public law and it complies with the other requirements of EU collective marks) and the regulations governing use of the mark contain the authorisation ~~foreseen~~[set out](#) in Article ~~67~~[75](#)(2) EUTMR, it will be accepted for registration.

~~[A sign that describes the geographical origin of the goods or services comprises those signs that exclusively include a geographical term but also, those signs that include other non-distinctive or generic terms. For example, EU collective mark \[No 13 729 611\]\(#\), \[BIO LËTZEBUERG\]\(#\), for goods and services in \[Classes 29, 30, 31, 32, 33 and 35\]\(#\).](#)~~

This exception only applies to those signs that are descriptive of the geographical origin of the goods and services. If the EU collective mark is **descriptive of other characteristics of the goods or services**, this exception does not apply and the application will be refused under Article 7(1)(c) EUTMR. ~~(decisions of 08/07/2010, R 934/2010-1, ENERGY WINDOW, § 38; 12/12/2014, R-1360/2014-5, DOWNMARK, § 35; and judgments of 15/11/2012, T-278/09, GG, EU:T:2012:601, § 48, 49; 17/05/2011, T-341/09, Txakoli, EU:T:2011:220, § 33-35).~~

~~For example, if the word mark 'Do-it-yourself' is applied for as an EU collective mark for tools in Class 7, it will be considered descriptive of the intended purpose of the goods. Since the sign is descriptive of certain characteristics of the goods other than their geographical origin, it will be refused under Article 7(1)(c) EUTMR despite having been applied for as an EU collective mark (see decision of 08/07/2010, R 934/2010-1, ENERGY WINDOW, § 35).~~

#### ~~2.14.3.2 Misleading character as to its nature~~

## **4.2 Objections raised under Article 7(1)(j), (k) or (l) EUTMR**

In the event that the goods and services have to be limited as a consequence of an objection raised under Article 7(1)(j) (geographical indication), 7(1)(k) (traditional terms for wines) or 7(1)(l) EUTMR (traditional specialties guaranteed), the applicant of the EU collective mark **has to amend the regulations of use accordingly** (Article 16(h) EUTMR). For further information regarding these objections, please see the Guidelines, Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapters 10, 11 and 12.

~~The examiner must refuse the application 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 under Article 68(2) EUTMR.~~

~~A collective mark that is available for use only by members of an association that owns the mark could be liable to mislead if it gives the impression that it is available for use by anyone who is able to meet certain objective standards.~~

#### ~~2.14.3.3 Regulations of use contrary to public policy and morality~~

~~If the regulations governing use of the mark are contrary to public policy or to accepted principles of morality, the EU collective mark application must be refused under Article 68(1) EUTMR.~~

~~This ground for refusal must be differentiated from that contained in Article 7(1)(f) EUTMR, which prohibits registration of those trade marks that are by themselves contrary to public policy or to accepted principles of morality.~~

~~The refusal foreseen in Article 68(1) EUTMR refers to situations where, regardless of the trade mark, the regulations governing use of the mark contain a provision that is contrary to public policy or to accepted principles of morality; for instance, rules that discriminate on the grounds of sex, creed or race. For example, if the regulations contain a clause that prohibits women from using the mark, the EU collective mark application will be refused, even if the trade mark does not fall under Article 7(1)(f) EUTMR.~~

~~The examiner's objection can be waived if the regulations are amended in order to remove the conflicting provision. In the above example, the EU collective mark application will be accepted if the clause that prohibits women from using the mark is deleted from the regulations.~~