

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast) (Text with EEA relevance)

CHAPTER 2

SUBSTANTIVE LAW ON TRADE MARKS

SECTION 6

Guarantee or certification marks and collective marks

Article 27

Definitions

For the purposes of this Directive, the following definitions apply:

- (a) ‘guarantee or certification mark’ means a trade mark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, from goods and services which are not so certified;
- (b) ‘collective mark’ means a trade mark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of an association which is the proprietor of the mark from the goods or services of other undertakings.

Article 28

Guarantee or certification marks

- 1 Member States may provide for the registration of guarantee or certification marks.
- 2 Any natural or legal person, including institutions, authorities and bodies governed by public law, may apply for guarantee or certification marks provided that such person does not carry on a business involving the supply of goods or services of the kind certified.
Member States may provide that a guarantee or certification mark is not to be registered unless the applicant is competent to certify the goods or services for which the mark is to be registered.
- 3 Member States may provide that guarantee or certification marks are not to be registered, or are to be revoked or declared invalid, on grounds other than those specified in Articles 4, 19 and 20, where the function of those marks so requires.
- 4 By way of derogation from Article 4(1)(c), Member States may provide that signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute guarantee or certification marks. Such a guarantee or certification mark

shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided that third party uses them in accordance with honest practices in industrial or commercial matters. In particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.

5 The requirements laid down in Article 16 shall be satisfied where genuine use of a guarantee or certification mark in accordance with Article 16 is made by any person who has the authority to use it.

Article 29

Collective marks

1 Member States shall provide for the registration of collective marks.

2 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, to make contracts or accomplish other legal acts, and to sue and be sued, as well as legal persons governed by public law, may apply for collective marks.

3 By way of derogation from Article 4(1)(c), Member States may provide that signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective marks. Such a collective mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, such signs or indications, provided that third party uses them in accordance with honest practices in industrial or commercial matters. In particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.

Article 30

Regulations governing use of a collective mark

1 An applicant for a collective mark shall submit the regulations governing its use to the office.

2 The regulations governing use shall specify at least the persons authorised to use the mark, the conditions of membership of the association and the conditions of use of the mark, including sanctions. The regulations governing use of a mark referred to in Article 29(3) shall authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.

Article 31

Refusal of an application

1 In addition to the grounds for refusal of a trade mark application provided for in Article 4, where appropriate with the exception of Article 4(1)(c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, and Article 5, and without prejudice to the right of an office not to undertake examination *ex officio* of relative grounds, an application for a collective mark shall be refused where the provisions of point (b) of Article 27, Article 29 or Article 30 are not satisfied, or where the regulations

governing use of that collective mark are contrary to public policy or to accepted principles of morality.

2 An application for a collective mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

3 An application shall not be refused if the applicant, as a result of amendment of the regulations governing use of the collective mark, meets the requirements referred to in paragraphs 1 and 2.

Article 32

Use of collective marks

The requirements of Article 16 shall be satisfied where genuine use of a collective mark in accordance with that Article is made by any person who has authority to use it.

Article 33

Amendments to the regulations governing use of a collective mark

1 The proprietor of a collective mark shall submit to the office any amended regulations governing use.

2 Amendments to the regulations governing use shall be mentioned in the register unless the amended regulations do not satisfy the requirements of Article 30 or involve one of the grounds for refusal referred to in Article 31.

3 For the purposes of this Directive, amendments to the regulations governing use shall take effect only from the date of entry of the mention of those amendments in the register.

Article 34

Persons entitled to bring an action for infringement

1 Article 25(3) and (4) shall apply to every person who has the authority to use a collective mark.

2 The proprietor of a collective mark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where those persons have sustained damage as a result of unauthorised use of the mark.

Article 35

Additional grounds for revocation

In addition to the grounds for revocation provided for in Articles 19 and 20, the rights of the proprietor of a collective mark shall be revoked on the following grounds:

- (a) the proprietor does not take reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use laid down in the regulations governing use, including any amendments thereto mentioned in the register;

- (b) the manner in which the mark has been used by authorised persons has caused it to become liable to mislead the public in the manner referred to in Article 31(2);
- (c) an amendment to the regulations governing use of the mark has been mentioned in the register in breach of Article 33(2), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of that Article.

Article 36

Additional grounds for invalidity

In addition to the grounds for invalidity provided for in Article 4, where appropriate with the exception of Article 4(1)(c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, and Article 5, a collective mark which is registered in breach of Article 31 shall be declared invalid unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of Article 31.