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1 INTRODUCTION

1.1 Purpose of this chapter

The purpose of this chapter is to detail, for the benefit of both customers and staff of the Trade Marks Registry, the way in which we will examine applications for certification and collective marks.

1.2 Definitions of, and comparisons between, certification, collective and ordinary trade marks

A certification mark is defined in Section 50(1) of the Act as:

“A certification mark is a mark indicating that the goods and services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.”

The main feature of a certification mark is that it is used not by the proprietor of the mark but instead by his authorised users for the purpose of guaranteeing to the relevant public that goods or services possess a particular characteristic. The proprietor’s mark certifies the presence of the characteristic and will authorise the use of the mark to anyone who can demonstrate that the goods and services for which it will be used have that characteristic.

A collective mark is defined in Section 49(1) of the Act as:

“A collective mark is a mark distinguishing the goods or services of members of the association which is the proprietor of the mark from those of other undertakings.”

The main feature of a collective mark is that it is used as an indication to the relevant public that goods or services originate from a member of a particular association. It is therefore a sign of membership.

Certification and collective marks therefore differ from “ordinary” trade marks because an ordinary trade mark is one that distinguishes the goods and services of one particular trader (a single trade source) from those of other traders.

1.3 Overview of the examination process

The examination of certification and collective marks consists of two distinct phases. Firstly comes the initial examination of the application itself; this includes an assessment of the mark’s inherent acceptability under both absolute (distinctiveness and deceptiveness) and relative (confusion with other marks/rights) grounds together with some additional aspects of examination peculiar to collective and certification marks. Secondly comes an examination of the regulations (that are required nine months after filing the application) that govern the use of the certification or collective mark

2 INITIAL EXAMINATION

2.1 Section 3(1) – criteria for distinctiveness

2.1.1 Essential distinguishing function to be considered

As with ordinary trade marks, certification and collective marks will be examined against the absolute grounds for refusal contained in Section 3(1) of the Act. The fundamental aim of these provisions is to ensure that a mark is capable of carrying out its essential distinguishing function. When considering the distinctiveness of a mark it is therefore important to appreciate that the distinguishing function of certification and collective marks differs from that of ordinary trade marks.

Paragraph 2 of Schedule 1 gives the distinguishing function of a collective mark as:

“..distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings”

Paragraph 2 of Schedule 2 gives the distinguishing function of a certification mark as:

“...distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.”

In many cases an objection applicable to an ordinary trade mark will be equally applicable to a certification or collective mark, however, there will also be circumstances where it is not. For example, the mark shown below may not be acceptable as an ordinary trade mark in respect of meat or meat products (it is unlikely that the average consumer will regard it as pointing towards a single trade source for these goods) but would be acceptable as a certification mark as it is capable of performing that particular distinguishing function.



The applicant claims the colours red and blue as elements of the mark

2.1.2 Underlying interests remain the same

The interests underlying Section 3(1) do not change when considering the acceptability of certification or collective marks. Further information on these interests, together with the Registrar's main practices relating to them, can be found in Chapter 3 of this manual. However, the underlying interests can be summarised as:

Section 3(1)(b) – that the mark has the capacity to perform its essential distinguishing function in the eyes of the average relevant consumer.

Section 3(1)(c) – the need to keep descriptive indications free for the legitimate use by other traders.

Section 3(1)(d) – the need to avoid granting monopolies in respect of signs or indications that are already customary in the trade.

2.1.3 Assessing acceptability under Section 3(1)

When considering the acceptability of certification and collective marks it is therefore important to consider the underlying interests of Section 3(1) (all of which have independent scope) together with the marks particular distinguishing function. The following examples aim to provide an explanation of the approach that will be taken.

GUARANTEED 100% COTTON

(certification mark in respect of cotton shirts in Class 25.)

This mark will face an objection under Sections 3(1)(b) & (c) of the Act. The term is a descriptive one that all traders should be free to use to send the descriptive message that the goods offered are guaranteed as being made from 100% cotton. Although the mark indicates a guarantee of a particular characteristic (100% cotton) it does not indicate that a certification scheme (and not just the individual trader) is guaranteeing the presence of the characteristic.

COTTONMARK 100% COTTON

(certification mark in respect of cotton shirts in Class 25.)

This is not a simple descriptive term that other traders would legitimately require to describe cotton shirts, therefore no Section 3(1)(c) objection is appropriate. As well as indicating that the goods are 100% cotton, there is something else in the mark (the words "cottonmark") that ensures that it has the capacity to distinguish goods that have been certified from those that have not.

CHARTERED MORTGAGE ADVISOR

(collective mark in respect of financial services in Class 36.)

Royal charters are granted by the Crown to certain associations whose members can then use particular terms to indicate their chartered status. The charter only allows members of the association to use the particular terms, therefore there is no need to keep them free for use by other traders. The essential function of this collective mark

is to distinguish services provided by members of an association from those of other traders. This mark is capable of doing so as it sends a message to the consumer that the services are provided by a chartered mortgage advisor who necessarily belongs to the particular chartered association. The mark is therefore acceptable as a collective mark.

It should be noted that an application for the same mark as an ordinary trade mark would not succeed as the mark would be unable to distinguish services provided by one particular chartered mortgage advisor from those of others. It should also be noted that proof of the association's chartered status will need to be supplied otherwise an objection under Section 3(3)(b) of the Act will be raised as the mark would mislead the public into believing that the association and its members have chartered status.

MORTGAGE ADVISORS ASSOCIATION

(collective mark in respect of financial services in Class 36.)

The mark in totality does not describe a characteristic or the services, it instead describes an association whose members provide such services, consequently, there can be no objection under Section 3(1)(c) of the Act. Under Section 3(1)(b) the average consumer will likely perceive the mark as an indication that the services are provided by a member of the particular association, the mark is therefore capable of distinguishing services provided by members of an association from those of other traders. Marks of this type will, in general, be acceptable save where the name is already in common usage by more than one organisation.

MORTGAGE ADVISOR

(collective mark in respect of financial services in Class 36.)

The mark describes the services in question as being provided by a mortgage advisor. Furthermore, the mark is incapable of distinguishing services provided by mortgage advisors of a particular association from those of other mortgage advisors (it is also likely to be in common use by the trade). This mark will face objections under Sections 3(1)(b), (c) & (d) of the Act.

2.1.4 Section 3(1) - Geographical names & protected geographical indications (“GIs”)

Geographical names in general

A geographical name will normally fall foul of Section 3(1)(c) of the Act if it is likely to be required by other traders to designate the geographical origin of the goods or services sought for registration. However, Schedule 1 (collective marks) and Schedule 2 (certification marks) of the Act provides the Registrar with discretion to accept geographical indications as certification or collective marks. Being discretionary means that this is not an automatic right of acceptance.

The Registrar’s practice is that a geographical name will only be accepted as a certification or collective marks if it has the capacity to perform its distinguishing function. Certain names will be unable to perform the distinguishing function, e.g. BRITISH (as a certification mark for lamb) will be unable to distinguish lamb that has been certified as being produced in Britain from lamb that has not; this is because the consumer will only ever see this sign as a simple indication of geographical origin and not as an indication that the goods have been certified.

In practical terms, the Registrar will accept geographical names that would otherwise be debarred under Section 3(1)(c) if the applicant can establish that the geographical name is capable of distinguishing the goods and services of members of the applicant association (collective marks) or that the goods and services are certified by the holder’s mark as having the relevant geographical origin, and distinguishing them from other goods/services which are not. This necessarily requires the Registrar to consider whether, due to custom and practice, a particular name is capable of distinguishing certified goods. For example, Bordeaux appears to be capable of distinguishing certified wines from Bordeaux, French wine names having been used for decades to certify geographical origin. On the other hand, “Bordeaux” would probably not be registrable as a collective mark for wines, there being a number of different trade associations to whom producers of Bordeaux wine belong.

It should also be noted that if a geographical name is accepted for registration, the proprietor of such a mark is not entitled to prohibit the use of the name in accordance with honest practices, in particular, by a person entitled to use the geographical name

Protected geographical indications (GI’s)

EC regulations protect certain geographical names in the fields of agricultural products and foodstuffs, drinks, wines and spirits. The purpose of these regulations is to prevent the misappropriation or misuse of the names which are used by the trade to establish a connection between certain goods and their geographical origin normally in order to evoke a quality standard

An application to register an ordinary trade mark which consists solely of a GI will face insurmountable objections. This is because the registration of a GI to one single trader would amount to misappropriation and misuse of the GI the purpose of which is to guarantee geographical origin and not trade origin.

However, an application to register a GI as a certification mark will not be regarded as misappropriation or misuse. The function of certification marks can be seen as complimentary to a GI as opposed to an ordinary trade mark which is antagonistic to it. For example, a certification mark for a geographical name sends a message to the consumer that the goods are certified as being the produce of the particular location, this therefore supports the function of a GI. Collective marks may also be acceptable in the face of a GI so long as the circumstances (such as the association being of producers of the goods protected by the GI) permit.

2.1.5 Evidence of acquired distinctiveness

A trade mark that has been objected to under the provisions of Section 3(1)(b), (c) or (d) of the Act may nevertheless be accepted for registration if, in consequence of the use made of it, it has in fact acquired a distinctive character. This is equally applicable to the examination of collective and certification marks as it is to ordinary trade marks. Further guidelines on the filing of evidence of use are provided in Chapter 3 of this work manual.

Case-law exists (*Re Legal Aid Trade Mark Application* (High Court 2000 No.00817) & *Stilton Trade Mark Case* [1967] RPC 173) that supports the view that it is not a prerequisite that the relevant public know who is actually certifying the goods or services, or even know that the proprietor has actually carried out formal certification in the past. It is the nature of the use and the message that it sends to the relevant consumer that is important when deciding if the use made of the mark transforms it into one that is capable of carrying out its distinguishing function. Thus, if a mark is shown to have become capable of certifying a characteristic of goods or services, or membership of an association, by the date of application, it should be accepted. It is not essential that the mark should have been used that way prior to the relevant date.

2.2 Other absolute (Section 3) grounds

There are a number of other absolute grounds objections that have the potential to be raised against collective and certification mark applications. These include objections under Section 3(2) (registrability of shape marks), Section 3(3) (public policy, morality or deceptiveness), Section 3(4) (other enactment or rule of law), Section 3(5) (protected emblems) and Section 3(6) (applications made in bad faith). There is nothing in any of these potential objections that are peculiar to the examination of collective and certification marks, therefore, for a more detailed explanation of these objections please refer to Chapter 3 of this Manual which deals with the examination of ordinary trade marks.

2.3 Relative grounds examination

As part of the examination process of certification and collective marks a search will be undertaken to ascertain if there exist any earlier marks (certification, collective or ordinary trade marks) owned by someone other than the applicant that conflict with the subject application. When assessing potential conflict the same principles apply as they do to the examination of ordinary trade marks, namely, after considering the similarity between the respective marks and their goods and services, is there a likelihood of confusion between them. For a full explanation of the factors taken into account when making this assessment please see Chapter 3 of this Manual which deals with the examination of ordinary trade marks.

The normal avenues for overcoming objections based on relative grounds (consent, amending specifications, filing evidence of honest concurrent use) apply equally to certification and collective marks as they do to ordinary trade marks. Further details are again provided in Chapter 3.

2.4 Co-existence with ordinary trade marks

Schedule 2 Paragraph 4 of the Act states that:

“A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods of the kind certified.”

If during the examination of a certification mark it comes to light that the applicant is also the proprietor of an earlier ordinary trade mark in respect of goods or services identical to those of the certification mark, this will be taken as a *prima facie* indication that the proprietor of the certification mark also carries on a business in the supply of the goods certified. This is not a relative test, there is, for example, no need for the marks in issue to be similar. In this situation, an objection will be raised under Schedule 2 Paragraph 4 of the Act.

To overcome an objection of this sort it is sufficient for the applicant to make a statement that he does not carry on a business in the goods or services certified. It will not be necessary to withdraw or surrender the ordinary trade mark so long as this statement is made. It should be noted however that grounds for revocation and invalidation exist (upon application from a third party) should this prove to be false or to become false by the applicant beginning to trade in the goods or services.

There is no equivalent prohibition in Schedule 1 relating to collective marks. Therefore, no objection of the kind described above will be raised against a collective mark application if the applicant is also the proprietor of an ordinary trade mark even in respect of identical goods or services. It should also be noted that no objection will be raised against either certification or collective marks where the applicant is also the proprietor of ordinary trade marks for similar goods or services to that sought by the certification or collective mark application.

2.5 Misleading as to the nature of the mark

2.5.1 When will objection be raised?

Paragraph 4 of Schedule 1 and Paragraph 5 of Schedule 2 indicate, respectively, that collective and certification marks shall not be registered if the mark would mislead the public as regards its character or significance, in particular if it is likely to be taken as something other than a collective or certification mark.

In practice, this means that an objection will be raised if the mark is likely to be taken as something other than its true designation i.e. that it is more likely to be taken as an ordinary trade mark as opposed to its true designation. The following examples aim to illustrate the practice:

AMCF – ASSOCIATION OF MASTER CARPET FITTERS (collective mark for carpet fitting services)

The nature of the mark sends a clear message that the services offered stem from a group of traders belonging to the particular association. General consumer knowledge is likely to appreciate that an association does not normally offer the services themselves and therefore the sign is likely to be perceived as a badge of membership. No objection will be raised.

AMCF (collective mark for carpet fitting services)

The answer here is less clear cut. Combinations of letters are commonly used as ordinary trade marks, but they are also commonly used to denote the name of an association. It is therefore equally plausible that the mark may be seen as an ordinary trade mark as it is to being seen as a collective mark. In the circumstances, it is difficult to say that the mark is likely to be taken as an ordinary trade mark as opposed to its true designation and therefore an objection is unlikely to be raised.

PREMIER CARPET FITTERS (collective mark for carpet fitting services)

There is little in this mark to indicate to the public that it is collective mark. It is therefore likely that it will be taken as an ordinary trade mark as opposed to its true designation. An objection will therefore be raised.

2.5.2 Overcoming any objections

An objection of the above nature can be overcome by adding to the mark the words “certification mark” or “collective mark”. This form of amendment is permissible irrespective of the provisions of Section 39 of the Act.

Alternatively, the regulations governing the use of the mark may include a clause (which should be entered under the category of “conditions of use of the mark”) stipulating that when in use the mark will be used in conjunction with an indication of its nature. The following form of wording has been adopted in many past applications:

“It is a condition of use that the mark shall not be used in any printed advertisements or printed publicity material directed primarily to the market in the United Kingdom and in the Isle of Man or in retail points of sale display cards distributed by the Registered Proprietor for use within the United Kingdom or in the Isle of Man without indicating that is a collective/certification mark.”

Applicants are not limited to the above form of wording. As long as the mark in use, as described by the clause, is unlikely to be taken as an ordinary trade mark.

2.6 Series applications for certification or collective marks

An application for a series of certification or collective marks can be made in the same way as a series of ordinary trade marks. The criteria for assessing them is also the same being governed by Section 41(2) of the Act. Further guidance on the acceptability of series marks is provided in Chapter 3 of this Manual.

Common forms of series applications, particularly in relation to collective marks, are applications for marks that include classes of membership e.g.

FELLOW OF
MEMBER OF...
ASSOCIATE OF....

The Registrar's normal practice when considering these types of series is that the class of membership is regarded as a non-distinctive element of the mark and as such they do not substantially affect the identity of the marks. The above marks will be accepted as a valid series.

2.7 Specifications of goods and services

Specification must reflect intended use by authorised users

The goods and services of collective and certification marks should reflect the goods and services that the association's members will trade in (collective marks) or the goods and services whose characteristics are being certified (certification marks). Previous practice required that the applicant make a statement to this effect, however, this will no longer be requested – it will now be assumed, upon receiving a duly completed and signed application form, that this is the case. It should be noted that revocation procedures exist (upon application by a third party) if the mark is not used in this manner.

Certification services

The term “certification services” is commonly requested in Class 42 of applications for both ordinary trade marks and in respect of certification marks. Even if the term is applied for as part of an application for an ordinary trade mark then no objection will be raised. This is because an ordinary trade mark may legitimately be used to identify the origin of certification services. It should be noted that an application for an ordinary trade mark in respect of certification services may not in itself give any right to prevent the use of the mark in respect of the goods and services that are actually being certified

The Registrar may, as a matter of customer care, raise the above issue with the applicant for an ordinary trade mark. However, an application for an ordinary trade mark in respect of certification services cannot be converted into a certification mark for the goods and services certified in view of the amendment that would be required to the specification of the application.

It should also be noted that an ordinary trade mark for certification services is liable for revocation if the mark is used solely in relation to the goods and services so certified. Similarly, if attempting to prove acquired distinctiveness of an ordinary trade mark in respect of certification services, use solely in relation to the goods and services certified is unlikely to be of assistance.

3 EXAMINATION OF REGULATIONS GOVERNING USE OF CERTIFICATION/COLLECTIVE MARKS

3.1 Regulations and their approval

The requirement to file regulations governing the use of collective and certification marks exist for a number of reasons. There is a need that regulations governing the marks use are clear and accessible so that anyone intending to make use of the mark can easily access the relevant information (regulations are open for public inspection once the application is published) and can understand the requirements that must be met before an authorised user can make use of it.

Furthermore, the Registrar has what can be described as a public interest role in ensuring that the regulations are not contrary to public policy or to accepted principles of morality. This later point is particularly important when considering the regulations governing the use of certification marks; the registration of a certification mark may introduce into the market an important industry standard, the Registrar must therefore be certain that the regulations do not unfairly restrict the use of the mark (by, for example, charging excessively high fees) which would have anti-competitive results.

Prior to accepting the mark for registration the regulations must be approved by the Registrar. The regulations must comply with required content, must not be contrary to public policy or morality, and, in respect of certification marks, the applicant must be competent to certify. Further details on these requirements are given below.

3.2 Time & manner of filing

The Act states that regulations for both collective and certification marks must be filed within nine months of the date on which the application was made. In practice, the examination of regulations does not take place until after the initial examination matters have been resolved, therefore, applicants may request an extension of the nine month period for this reason. If the initial examination matters have been resolved within the nine month period, extensions of time can still be requested if further time is required to compile the regulations; as with any extension of time, the request should be accompanied by adequate reasons explaining why further time is required.

The regulations themselves must be accompanied by a Form TM35 together with a fee of £200. If the regulations cover more than one application only one form and one fee will be required.

Once filed, the regulations are examined. If found to be unacceptable, they may be revised until they are in a form acceptable to the Registrar. For ease of reference and clarity, the regulations should preferably consist of a self standing document providing the required information (see below). However, it is acceptable to annex further documents to them which can then be cross referenced.

3.3 Collective mark regulations

3.3.1 Status of the applicant

Applicant must be an association

A collective mark distinguishes the goods and services of members of the association which is the proprietor of the mark from those of other undertakings (Section 49(1) of the Act). This means that an association with members should be the proprietor of the mark.

The term “association” is not defined in the Act. When considering whether an applicant qualifies as an association, the key factor to consider will be whether the claimed association has a form of membership and can point toward the normal indications present in any form of association with members, examples include payment of membership fees, issuing of membership card/numbers, membership meetings, conditions of membership. The fact that an association may be a Limited Company has no bearing on this matter; it is the manner of organisation and operation of the applicant that is important.

It is likely that any concerns the Registrar will have on this aspect will only surface when examining the content of the regulations. Any concerns the Registrar does have will be expressed to the applicant who will then be given an opportunity to provide information (and to amend their regulations) demonstrating that they do operate as an association with members.

Capacity to hold property rights

It should also be noted that, as with any trade mark, the applicant must have sufficient legal personality to hold it in their name. Unincorporated associations do not normally have the capacity to hold property rights (although partnerships do). The Registrar will not routinely question the property holding capacity of the applicant unless it is readily apparent from their name or from the content of the regulations that the association has no legal personality.

3.3.2 Content of regulations

The information that is required in the regulations is detailed in Schedule 1 paragraph 5 of the Act. The distinct pieces of information are:

The persons authorised to use the mark

Here the category of persons authorised to use the mark must be detailed. Is it simply every member of the applicant association or is it limited to certain sub-categories of membership? If there are any other requirements (save for the conditions of membership of the association) that a would-be authorised user must possess (e.g. a certain qualification) then these should also be detailed.

Previous practice has required that the regulations identify the exact persons who at any given time are authorised users. This will no longer be required. However, if the

applicant wishes to make reference to the existence of a register of authorised users (and its location) then this may still be done under this heading.

The conditions of membership of the association

Associations will normally have conditions of membership that must be met before a member can be admitted to it. For example, it may be a condition of membership that a person must have worked in the particular field for set period of time before being permitted to join. All the conditions of membership of the association must be detailed in order that would be users of the collective mark can clearly and objectively see what conditions they must fulfil before being allowed to join the association and to subsequently use the collective mark.

Similarly, if the collective mark is to be used to identify only certain members of the association, e.g. to identify a particular class of membership, the conditions that apply to these members should also be detailed.

Conditions of use of the mark (if any exist)

Conditions of use, if any exist, relate to the manner in which the members of the association may use the collective mark. For example, if the collective mark may only be used on printed matter in a size not exceeding certain limits, then this, together with any other such conditions should be detailed.

Any clauses that are formulated to overcome an objection that the mark is misleading as to its significance should also be entered under this heading (see paragraph 3.2.2 for further information).

Sanctions against misuse of the mark (if any exist)

If the association intends to impose any sanctions (such as expulsion from the association) against a member who misuses the mark then these should be detailed under this heading. Misuse of the mark would include using it in a manner that does not meet the conditions of use or using the mark when not permitted to do so.

3.4 Certification mark regulations

3.4.1 Status and competence of the applicant

Unlike collective marks (the proprietor of which must be an association with members) there is no limitation on who can be a proprietor of a certification mark except that the applicant/proprietor must have a legal personality. However, certification marks are normally applied for by trade associations or other similar bodies who have an interest in monitoring and maintaining standards in their particular field.

It is important to note that the proprietor of the certification mark cannot be engaged in the supply of the goods being certified. The Registrar does not investigate the applicant's position in the market, but potential applicants should be wary that if this requirement is not met then the mark may be challenged by a third party through invalidity or revocation procedures. A *prima facie* objection will however be raised if the applicant for a certification mark is also the owner of an ordinary trade mark for the same goods and services as those being certified (see paragraph 2.4 above).

An additional requirement is that the applicant must be competent to certify the goods and services for which the mark is to be registered. If the Registrar is not satisfied on this point then the mark shall not be registered (Para 7 (1)(b) of Schedule 2 of the Act). If the applicant is an established trade body or Government Department then it is unlikely that the Registrar will raise any questions relating to their competency. Save for the aforementioned circumstances, the applicant will, as part of the examination process, be asked to provide information to clarify why they are competent to certify. There is no set manner of providing this information, but an explanation of the applicant's history in the particular field will often suffice.

3.4.2 Content of regulations

The required content of regulations governing the use of a certification mark is listed in Paragraph 6(2) of Schedule 2 of the Act. The information required is detailed below:

Who is authorised to use the mark

Most certification marks are available for use by any person whose goods or services demonstrate the relevant characteristic being certified. If this is the case then this should be stated. If, however, due to the nature of the goods/services being certified the mark is only available to certain types of person, for example only those with particular qualifications, then this should likewise be detailed. To illustrate this, if a certification mark is intended to certify a characteristic of a particular legal service, then the use of the mark may be limited to practising solicitors.

Previous practice has required that the regulations identify the exact persons who at any given time are authorised users. This will no longer be required. However, if the applicant wishes to make reference to the existence of a register of authorised users (and its location) then this may still be done under this heading.

The characteristics to be certified by the mark

This is the key element of a certification mark. What is the specific characteristic of the goods or services that the proprietor is certifying as being present? The regulations should not simply list the goods and services being certified, they should explain what characteristic present in the goods and services is being certified. For example, if the proprietor is certifying that the goods (apples) are all the origin of a particular area (Normandy) then the characteristic being certified by the mark is:

“The characteristic being certified by the mark is that the goods in question, apples, are all the produce of Normandy, France.”

The aim of the regulations on this aspect is to provide a clear and objective statement that would allow anyone reading them to know precisely what characteristic is being certified.

How the certifying body is to test those characteristics and supervise the use of the mark

Here, an explanation of how the proprietor will test the presence of the characteristic will be needed. Testing does not need to be carried out by the proprietor themselves, but if this is the case an explanation of who (and how) will carry out the testing on their behalf will be needed. An explanation should be given as to how the proprietor will subsequently supervise the use of the mark.

The aim of the regulations on this point is two-fold. Firstly, anyone wishing to use the certification mark will be able to see what testing regime they will be subject to; secondly, the Registrar, from a public interest point, needs to be satisfied that adequate testing takes place to ensure that the public can have confidence that the mark and its proprietor is truly carrying out a certification process.

The fees, if any, to be paid in connection with the operation of the mark

The fees, if any, charged in connection with the scheme should be listed in the regulations or attached as an annex to them. This information not only allows would be users to have clear access to the fees information, but the Registrar, from a public interest point, can ensure that fees are not excessively high so as to prevent would be users from accessing the scheme.

There is no requirement that the certification scheme should be operated on a “not for profit” basis. The fees should however be proportionate to the nature of certification necessary, particularly where the holder’s mark is the *de facto* standard for the goods and services concerned.

The procedures for resolving disputes

Disputes in this context normally means a dispute between the proprietor of the mark and an authorised user (or would be authorised user) regarding the proprietor’s decision not to allow use of the mark. It is important that an appeal mechanism against the proprietor’s decision is in place to ensure fairness and equality. Such a

mechanism should allow an ultimate view on the matter to be taken by an independent person or body such as a specialist arbitrator or tribunal. Please note that the Registrar cannot fulfil this function in view of its statutory role in examining certification marks and their regulations.

4 POST REGISTRATION MATTERS

4.1 Amendment of regulations

Once a mark (and its regulations) have been accepted and published for opposition purposes, the proprietor may request that the regulations governing use of the mark be amended. Any such request must be accompanied by a Form TM36 together with the appropriate fee (currently £100).

It is important to note that the amendment will not be recorded automatically. The Registrar will firstly need to approve the amended regulations and will consequently examine them in the same way as newly filed regulations (see Paragraph 3 above). Amended regulations will have no effect unless approved by the Registrar – see Schedule 2 Paragraph 11 (certification marks) and Schedule 1 Paragraph 10 (collective marks).

Furthermore, if the Registrar considers it appropriate, the amended regulations will be published for opposition purposes. In practical terms, all but the most insignificant of amendments will be published as amendments could potentially affect the accessibility of current and prospective users to the mark. Publication is not required for minor amendments such as changing the applicant's address.

If publication is required a notice will be placed in the Trade Marks Journal stating that a request to amend the regulations has been proposed. Any third party may then request to inspect the amended regulations (via the Office's Central Enquiry Unit) and may oppose the proposed amendment during the three month opposition period. If an opposition is received then the opposition procedure outlined in Rule 13 of the Trade Mark Rules 2000 (as amended) will be followed. If no opposition is received then the regulations will then become effective.

4.2 Assignment of registration

Certification and collective marks may be assigned to a new owner in the same way as ordinary trade marks. However, Schedule 2 Paragraph 12 states, in respect of certification marks, that an assignment is not effective without the consent of the Registrar. This is to ensure that the new proprietor has the necessary competence to run the certification scheme; consequently, the assignee will need to meet the requirements as outlined in paragraph 3.4.1 before consent to the assignment will be given.

A change in ownership of either a collective or certification mark will also necessitate the amendment of the regulations. The amendments will need to reflect the new name of the proprietor together with any other amendments that may be required to reflect the new entity owning the mark e.g. amended conditions of membership etc. The request to amend should be made in the manner detailed in paragraph 4.1 above and should be filed at the same time as the request to record the assignment.

4.3 Invalidity of registration

Section 47 of the Trade Marks Act provides that a mark may be declared invalid if it was registered in breach of Section 3 or 5 of the Act. This provision applies equally to collective and certification marks as it does to ordinary trade marks. However, collective and certification marks face further potential grounds for invalidity if the mark was registered in breach of:

- i) Schedule 2 Paragraph 4 – proprietor (certification marks only) carrying on a business in the kind of goods or services certified.
- ii) Schedule 2 Paragraph 5(1) & Schedule 1 Paragraph 4(1) – the public is liable to be misled as to the character or significance of the mark.
- iii) Schedule 2 Paragraph 7(1) & Schedule 1 Paragraph 6(1) – approval of regulations, i.e., that the regulations did not contain the required information, that they were against public policy or morality or, that (in relation to certification marks) the proprietor was not competent to certify the goods and services sought.

The procedure for filing an application for invalidity is detailed in Rule 33 of the Trade Marks Rules 2000 (as amended).

4.4 Revocation of registration

Section 46 of the Act lists various grounds upon which a trade mark may be revoked. These grounds apply equally to certification and collective marks as they do to ordinary trade marks. However, certification and collective mark may be revoked on the additional grounds contained in Schedule 1 Paragraph 14 and Schedule 2 Paragraph 16; these can be summarised as:

- i) Schedule 2 Paragraph 4 (certification marks only) – that the proprietor of the mark has begun to carry on a business in the supply of the goods or services certified.
- ii) Schedule 2 Paragraph 5 (1) & Schedule 1 Paragraph 4(1) – that the manner in which the mark is used has caused it to become misleading as regards its character or significance.
- iii) That the proprietor has failed to observe or secure the observance of the regulations governing the use of the mark.
- iv) That an amendment has been made to the regulations so that they no longer comply with Schedule 2 Paragraph 6(2) (certification marks) or Schedule 1 Paragraph 5(2) (collective marks) relating to the content of the regulations governing use of the mark, or that the amended regulations are contrary to public policy or accepted principles of morality (certification marks).

- v) That the proprietor is no longer competent to certify the goods or services for which it is registered (certification marks).

It should also be noted that one of the basic grounds of revocation of any form of trade mark concerns whether a mark has been put to genuine use within the five year period following its registration (or any other five year period). It is important to note here that the use of a mark solely on goods and services that have been certified as possessing a particular characteristic is unlikely to count as use in relation to a specification in respect of the actual service of certification.

4.5 Infringement of registration

The proprietor of a collective or certification mark has the same rights to prevent an infringement of their mark as the proprietor of an ordinary trade mark does. Infringement proceedings in general are detailed in Section 10 of the Act. Authorised users of collective and certification marks are given particular powers to raise infringement proceedings in their own name (as opposed to relying on the proprietor of the mark to do so). More detailed information on this can be seen in Paragraph 11 of Schedule 1 (collective marks) and Paragraph 13 of Schedule 2 (certification marks).

4.6 Merger of marks

Nothing prevents the merging of either collective or certification marks. However, mergers cannot be entertained for marks performing different functions e.g. it is not possible to merge a collective mark with a certification mark or an ordinary trade mark.