



European IPR Helpdesk

Case Study

The new European Union certification mark: a perfect tool for protection of certification seals

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PGM Prüfungsgemeinschaft Mauerbohrer e. V.

Association/Certification body

Certification of drill bits for safe anchor installations

www.pgm.eu



1. Background

Since 1978, PGM certifies drill bits for concrete and masonry to ensure that the drill bits produce holes with the right tolerances for safe anchor installations. Certified drill bits are marked with a certification seal.

Like other certification bodies, PGM has to protect its certification seal against misuses by companies and/or for products which do not fulfil the requirements. Based on a German trade mark registration, the PGM seal was registered almost worldwide as individual or collective trade marks.

2. Problem faced

Individual or collective trade marks are not the perfect solution for certification bodies. An individual mark has to be used commercially by its owner for the products or services for which it is registered. This is not the case for certification bodies, because their seal is used by the companies offering certified products and not by the certification body itself.

On the other hand, a collective mark is also not the right choice for certification bodies, because such a mark is intended to be used only by members of a certain organisation (association), which is the owner of this mark. However, membership of an association may not be a prerequisite of a certification.

Since 1 October 2017, the new EU certification mark offers a perfect solution for this dilemma. This kind of mark can be registered for the same goods and services as conventional trade marks, but in essence, the EU certification marks relate to the “guarantee” of specific characteristics of certain goods and services. Therefore, it is tailor-made for the needs of certification bodies, as such marks may be used by anyone who has certified that its products comply with the standards defined by the certification body that owns the mark.

3. Possible actions to be undertaken in this situation

To get an EU certification mark, the certification body has to prove to the European Union Intellectual Property Office (EUIPO) that its certification system meets a minimum set of requirements and that the trade mark is registered only for goods and/or services, which are sufficiently covered by its certification system.

For this examination, the applicant has to submit to the EUIPO:

- all regulations etc. describing how the certifying body is to test the characteristics and supervise the use of the EU certification mark;
- standards or other documents describing the characteristics of the goods or services to be certified by the EU certification mark, such as the material, mode of manufacture of the goods or performance of the services, quality or accuracy;
- the conditions governing the use of the EU certification mark, including sanctions; and
- the (natural or legal) persons authorised to use the EU certification mark.

These documents are examined by the EUIPO according to the dedicated [“Guidelines for examination of European Union Trade Marks”](#).

Before the application for the EU certification mark, PGM analysed its certification regulations and concluded that they would meet these requirements. However, the PGM requirements are split into several documents, which would make EUIPO’s analysis less simple.

To make EUIPO’s check of the above prerequisites easier, an umbrella document was created, which strictly follows the structure of the Guidelines, and which gives references to the relevant chapters of the PGM documents where these requirements are covered, with additional explanations where necessary.

4. Outcome

As a result of this preparatory work, the PGM mark was the very first EU certification mark which passed the examination process and which was finally registered.

The registration as an EU certification mark strengthens the legal position of PGM against possible cases of misuse of its certification seal. It provides more legal certainty to PGM than an individual or a collective mark.

The EU certification mark can now be used as the basis for registrations in other countries via an international registration.

It can also be introduced into the European Enforcement Database (EDB)¹.

Because the certification system was examined by the EUIPO, an official agency of the European Union, a certification mark offers higher confidence for consumers of certified goods or services.

5. Lessons learnt and suggestions

The application of an EU certification mark can also be handled successfully by small-sized certification bodies. The requirements are clearly defined and most certification bodies should be able to fulfil them.

There are two important limitations for an EU certification mark:

- i. It cannot be owned by a person carrying out a business involving the supply of the goods and services of the kind certified. The owner of a certification mark is precluded from using the mark for the certified goods or services covered.
- ii. It cannot be filed for the purpose of distinguishing goods or services certified in respect of the geographical origin.

The checks of regulations governing the use of the certification mark and of the characteristics of the goods or services to be certified by the EU certification mark by the EUIPO are key in the whole application process. In order to speed up the whole certification procedure, it is a best practice to follow the relevant Guidelines for examination of European Union Trade Marks, and to prepare the application documents in a manner which eases the process.

¹ For more information about the European Enforcement Database (EDB), please click [here](#).

GET IN TOUCH

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The European IPR Helpdesk aims at raising awareness of Intellectual Property (IP) and Intellectual Property Rights (IPR) by providing information, direct advice and training on IP and IPR matters to current and potential participants of EU funded projects. In addition, the European IPR Helpdesk provides IP support to EU SMEs negotiating or concluding transnational partnership agreements, especially through the Enterprise Europe Network. All services provided are free of charge.

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Website: On our website you can find extensive information and helpful documents on different aspects of IPR and IP management, especially with regard to specific IP questions in the context of EU funded programmes.

Newsletter and Bulletin: Keep track of the latest news on IP and read expert articles and case studies by subscribing to our email newsletter and Bulletin.

Training: We have designed a training catalogue consisting of nine different modules. If you are interested in planning a session with us, simply send us an email at training@iprhelphdesk.eu.

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