

EUIPO clarifies rules on collective trademarks

Margherita Barié and Giulia Panigazzi
Carnelutti Studio Legale Associato
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- Different types of marks reproducing the same sign can co-exist as long as each mark meets the requirements specific to each type
- The possibility for proprietors of collective marks to rectify irregularities by amending the regulations of use does not constitute a violation of the principle of equal treatment
- A collective mark will not be considered misleading simply because the regulations governing its use include specific conditions regarding the quality of the goods and services protected

On 28 November 2024 the Fourth Board of Appeal of the EUIPO rendered its decision in *Ecosphere SA v Association Eco Entretien* ([Case R 2100/2023-4](#)). The decision shows that a collective trademark can consist of a sign registered as an individual or certification mark, provided that it meets the relevant requirements and serves the essential function specific to that type of trademark.

Background

The case involved Ecosphere SA (the cancellation applicant and appellant) and Association Eco Entretien (the EUTM proprietor and respondent). The dispute centered around the figurative collective trademark depicted below (No 15234339), filed on 18 March 2016 and registered on 11 January 2017 for goods and services related to vehicles:



On 14 December 2021 Ecosphere sought a declaration of invalidity of the trademark, alleging that it was misleading and therefore invalid under Article 82 of Regulation 2017/1001, in conjunction with Articles 74 and 76. Specifically, Ecosphere argued that:

- the collective trademark could mislead the public into perceiving it as an individual or certification mark; and
- the regulations governing the use of the collective mark, at the time of its filing, lacked the necessary information required by law, including the identification of the association members and the membership conditions.

Following a rejection of the invalidity request by the Cancellation Division on 18 August 2023, Ecosphere appealed the decision on 16 October 2023, asking for its annulment.

Board of Appeal decision

The Fourth Board of Appeal upheld the original decision on the following grounds.

No overlap between mark types

Ecosphere argued that the public might confuse the contested collective mark with an individual trademark, particularly since the same sign had previously been filed as an individual EU trademark (No 12215828). However, the Board of Appeal emphasised that different types of marks, reproducing the same sign, can co-exist as long as each meet the legal and functional requirements specific to their type.

Amending the regulations governing use of a collective trademark is permissible

Under Article 74 of the regulation (Article 82), a collective trademark can be invalidated if the regulation governing its use fails to meet the requirements of Article 76. Ecosphere highlighted that the original regulations lacked:

1. a list of the association members authorised to use the collective trademark;
2. clear conditions for membership; and
3. provisions barring the licensing of the collective trademark to third parties outside the association.

The board noted, however, that the EUTM proprietor had remedied these shortcomings by subsequently updating the regulation governing use to include the missing details. Specifically, the board observed that the possibility for proprietors of collective marks to rectify irregularities through amendments to the regulations of use does not constitute a violation of the principle of equal treatment, as such amendments do not alter the trademark itself, therefore receiving the same treatment as individual marks.

No misleading use as a certification mark

Ecosphere also contended that the mark functioned as a certification mark, rather than as a collective mark. The board observed that certification marks did not exist under EU law at the time the contested mark was filed. When they were later implemented under the regulation, no procedure was established to allow the 'transformation' of a collective mark into a certification mark. In any case, the board found no evidence of misleading use: the regulation governing the collective mark at issue clearly specified its usage conditions, which may include product or service quality standards, without automatically qualifying as a misleading certification use of the trademark.

The Fourth Board of Appeal therefore upheld the Cancellation Division's original decision, rejecting the invalidity request and confirming the contested collective trademark's validity.

Margherita Barié

Equity partner
Carnelutti Studio Legale Associato
mbarie@carnelutti.com

[View full biography](#)

Giulia Panigazzi

Senior associate
Carnelutti Studio Legale Associato
gpanigazzi@carnelutti.com

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