



Memo

To Frau Sylvia Gotzen
sylvia.gotzen@figiefa.eu

From Marcus Sacré
marcus.sacre@osborneclarke.de
Dr. Johannes Graf Ballestrem
johannes.ballestrem@osborneclarke.de

Cc

Office Innere Kanalstr. 15
D-50823 Köln

Matter Nr. GJB/1006061/G1366003/CVC

Date 18 October 2013

We have been asked to provide information on the registration of an EGEA-Label for newly defined EGEA aftermarket specifications for Mobile Air-conditioning Test Equipment as a collective (trade) mark. The EGEA label is suitable and a good choice to unequivocally qualify the services and products offered by the EGEA members on an EU wide basis.

In the following, we will briefly summarise the preconditions for registration of a collective trademark and the subsequent use by the members of the association. Furthermore we will provide a rough estimate for the costs for the registration.

1 General remarks

The EGEA label can be registered and used as a so called "collective trademark" (Kollektivmarke). The collective trademark is a sign that an industrial or trade association may use to gain trademark protection for its members (companies). Popular Examples for such trademarks is e.g. the Woolmark symbol.

We understand that the EGEA label shall not only be used as a common trademark but in particular as a quality-label (Gütezeichen) for goods and services re the Mobile Air-conditioning Test Equipment. Quality-labels are a subset of collective marks. Popular Examples for quality-labels are e.g. the "BIO label" for a certification process for producers of organic food and other organic agricultural products. Using such a quality-label implies certain additional obligations, in particular with re to avoiding misleading practices. This aspect is further addressed below (8).

2 Preconditions for application for a collective mark

The collective mark can either be registered nationally (e.g. for Germany following §§ 97 et seq. German Trademark Act) and/or for the European Union following §§ 66 et seq. Community Trademark Regulation.



For the sake of clarity, we assume that EGEA is primarily interested in a community trademark. Therefore the following explanation focuses on the collective community mark. Anyhow, the preconditions for a collective mark in Germany are very similar.

3 Applicant / Ownership

The collective mark can only be registered for legally established entities. This can i.a. be an association with legal status. We understand that "EGEA aisbl" is such a legal entity and therefore entitled to apply for a collective mark. EGEA would be the owner of the new label. In other words: The mark does not belong to several persons (members of EGEA) but to the legal entity EGEA.

4 Who is entitled to use the collective mark?

As a rule, the mere membership of the association does not imply the right to use the collective mark (if not explicitly stipulated in the statutes of the association). We assume that the current statutes of the EGEA association do not contain such formula. In any event the statutes of the collective mark need to lay down the conditions under which the members are allowed to use the collective mark.

5 Type of mark

A collective mark can be any mark (e.g. word, figurative, 3D, etc.), provided that it is used to distinguish the goods and services of the members of the association which owns the collective mark from those of other undertakings. Thus, in this respect the general conditions for protection as collective mark do not differ from those for individual community trademarks. Collective marks may be used together with the individual trademark of the member.

6 Application fees

The application fee for the EU is EUR 1.800,00. If the application should cover more than three classes of goods and services there is an additional fee of EUR 300,00 for each class exceeding three. Prolongation fees are double the amount for individual trademarks. The German application fee is EUR 900,00 and further EUR 150,00 for each class exceeding three.

The lawyer's fees costs for the application are calculated on a flat basis of EUR 750,00 per Trademark.



7 Specific requirements due to character of collective trademark according to Article 66 et seq. CTMR (Community Trademark Regulation)

The applicant must create a regulation governing the use of the mark ("Markensatzung"). These statutes must be provided to the OHIM along with the application form. The statutes are not published. However, a file inspection for interested third parties can be granted upon request.

The statutes need to contain at least the following regulations:

- 7.1 Name and seat of the EGEA
- 7.2 Information on the members authorized to use the collective trademark, including their names, addresses and seats (the list of members)
- 7.3 The conditions of membership
- 7.4 The conditions of use of the collective trademark
- 7.5 The rules relating to the control of the use of the collective trademark
- 7.6 The rights and duties of the members in case of infringements of the collective mark against unauthorized use of the collective trademark

8 Specific requirements when using collective mark as quality-label

We understand that EGEA will use the collective mark as a "quality-label", i.e. to designate the quality of specific products/services of the EGEA members.

8.1 Misleading use needs to be prevented

In this constellation it is necessary that the above statutes provide for specific rules to avoid any misleading practice. It has to be warranted in particular that the quality standard actually is independently being supervised on basis of on-going tests and following objective quality criteria.



8.2 Third parties might claim access

The significant promotional effect of using the quality label can also lead to a claim of non-members for being granted a licence to use the mark under the same conditions (OLG Celle GRUR 1985, 547 – Buskomfort referring to German competition law § 20 Abs. 6 GWB).
