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World-wide Certification-Mark Registration A Certifiable Nightmare

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What Are Certification Marks?

Increasingly, consumers demand proof that the products and services they spend their hard-earned money on are safe, healthy, reliable, eco-friendly, humanely raised or produced, and verifiably of the advertised geographic origin. To address such demands, businesses are seeking to advertise their products and services as being "certified" to possess the desired characteristics. As a result, many trade associations and non-profit organizations are offering certification programs that license proprietary "certification marks" to businesses whose products and services meet the programs' criteria. For the certification programs to work, the certification marks must be protected from counterfeiting and infringement through the world's existing trademark law systems. In many cases, however, the certifying entities are finding that the growing market for new certification marks has outpaced the ability of many countries' legal systems to effectively protect certification marks. In response, the World Intellectual Property Organization's (WIPO) Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT) recently began an in-depth study of this growing problem. The SCT held discussions in Geneva, Switzerland in February and November 2009, with the goal of creating a textual resource outlining the problems and disparities in various countries' certification mark systems. Once published, the SCT's text could be an invaluable resource to certification-mark owners. In the meantime, this article analyzes the common obstacles that certification mark owners face when attempting to protect their marks worldwide.

Registration of Certification Marks in the United States

In the United States, the Lanham Act assures the integrity of certification marks by imposing four restrictions on certification-mark owners. First, the owner must set the relevant certified standards for quality, safety, purity, or other desirable characteristics, and then exercise control over the use of the mark by certified parties. To satisfy this requirement, U.S. applicants must submit a copy of the regulations for the certification program to the U.S. Patent and Trademark Office (USPTO). Second, the owner must preserve its objectivity by declaring that it will not engage in the production or marketing of any goods or services to which the certification mark is applied. Third, the owner must not permit the use of the mark for purposes other than to certify. Fourth, the owner cannot discriminate in its certification program. That is, the owner must apply the criteria consistently and certify or continue to certify the goods

or services of all persons or entities that meet its standards. Once these basic certification requirements are met, the USPTO will examine the certification-mark application in the same manner as any ordinary trademark application.

Navigating the Maze of Inconsistent Laws

Certification mark protection varies a great deal from country-to-country and U.S. certification-mark owners frequently encounter roadblocks when trying to register their marks abroad. The most basic roadblock lies in countries whose laws do not provide for the registration of certification marks at all. But even countries that do allow registration of certification marks vary greatly in their application requirements. Typically, the differences in application requirements fall into three categories: (a) proof of authority/experience to certify, (b) submission and approval of regulations, and (c) classification of the goods and services. For the reader's convenience, the following chart summarizes the inconsistent certification laws of various countries that will be reflected throughout this article.

Inconsistencies in Global Certification-Mark Registration

Country	Provisions for certification mark registration	Term of art	Applicant must have proof of authority to certify	Regulations must be approved by governmental body	Amendments must be approved by governmental body	Regulations must contain provisions relating to grievances, disputes, or sanctions
Argentina ¹	Yes	Service mark guaranteeing features	-	-	-	-
Australia ²	Yes	Certification mark	-	Yes	Yes	Yes
Brazil ³	Yes	Certification mark	-	-	-	-
Canada ⁴	Yes	Certification mark	-	-	-	-
Chile	No	-	-	-	-	-
China ⁵	Yes	Certification mark	Yes	-	-	-
Czech Republic	No	-	-	-	-	-
Denmark ⁶	Yes	Guarantee mark	-	-	-	-
European Union	No	-	-	-	-	-
France ⁷	Yes	Collective certification mark	-	-	-	-
India ⁸	Yes	Certification mark	Yes	Yes	-	-

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Ireland ⁹	Yes	Certification mark	-	Yes	Yes	Yes
Israel ¹⁰	Yes	Certification mark	Yes	-	-	-
Japan	No	-	-	-	-	-
Mexico	No	-	-	-	-	-
New Zealand ¹¹	Yes	Certification mark	Yes	Yes	-	-
Russia	No	-	-	-	-	-
South Korea	No	-	-	-	-	-
Spain ¹²	Yes	Certification mark	-	Yes	-	Yes
Switzerland ¹³	Yes	Guarantee mark	-	Yes	-	Yes
Taiwan ¹⁴	Yes	Certification mark	Yes	-	-	Yes
United Arab Emirates ¹⁵	Yes	Quality control mark	-	Yes	-	-
United Kingdom ¹⁶	Yes	Certification mark	-	-	-	-
United States ¹⁷	Yes	Certification mark	-	-	-	-

No Provisions for Registration. A number of countries do not provide for the registration of certification marks at all, including Chile, Czech Republic, Japan, Mexico, Russia, South Korea, and the European Community. In such countries, U.S. mark owners are forced to register the mark either for "quality-assurance services," or for the goods or services being certified. Both options are problematic. First, the mark may not be enforceable in an infringement context because the actual use does not precisely match the goods and services listed in the registration. Second, the owner may register the mark for "quality-assurance services," only to have the application rejected because the marks are really used "on the certified goods" rather than for applicant's certification services.

Proof of Authority to Certify. Some countries, such as China, India, Israel, New Zealand, and Taiwan, require that applicants provide proof of "authority" to run a certification program, without explaining what "authority" means. In some cases, the trademark offices appear to demand governmental sanction for the program. Of course, most U.S. certifiers do not have a governmental sanction, so it is very difficult to meet this requirement. One possible strategy is to come up with evidence that is analogous to the required "authority," and present that evidence in lieu of actual authority or sanction. In other cases, trademark offices want an exhaustive explanation of the applicant's expertise in the field. Since this requirement is nebulous and changes from country to country, it can be time-consuming to develop documentation to satisfy a particular trademark office's "expertise" requirements. The most efficient strategy for applicants is to create a single document summarizing the certifying body's history, size, experience, special knowledge, and equipment, in the hope that the information will satisfy the authority/expertise requirement in the majority of countries of interest.

Regulations. Nearly all countries that provide for certification-mark registration require applicants to file "regulations" detailing the rules of the certification program. Depending on the depth and breadth of a particular country's requirements, this too can lead to major problems and delays. In the United States, the applicant simply submits a copy of the program regulations that it provides to prospective certification candidates.

However, some countries require that the regulations incorporate additional matter not usually included in the regulations. For example, some countries require a description of the appeal process available to failed certification candidates (or worse, impose an appeal process on the applicant). Other countries also want the specific technical data regarding the certification standards. Not only can such data encompass huge volumes of information, but also a particular trademark office may not have the expertise required to review it. If the latter is true, a mark-owner may be well-served to offer the examiner a summary of how the certification standards are measured and enforced as opposed to technical data. That way, the owner can educate the examiners on what they want or need to know without the burden of collecting, distilling, and evaluating any technical data.

A further problem exists in countries that reserve the right to approve or reject the initial regulations as well as any later amendments. And worse still, some countries do not allow the application to be filed before the regulations, which can significantly delay filing dates as conforming regulations are drafted.

Classification. In the U.S., certification-mark classification is relatively easy considering the two-class system: Class A for goods and Class B for services. But classification abroad can be problematic. International classification under the Nice Convention greatly increases the time, effort, and cost required to classify a certification mark abroad. Some applicants certify hundreds of different products covering dozens of different classes. Thus, it can be prohibitively expensive to register the certification mark for all the products being tested and certified in every country in which the products are sold. As such, applicants are forced to select and register only their "top products."

Proposed Solutions

As noted above, none of the strategies used to address the problems presented by the inconsistent rules are truly satisfactory. The only way to effectively remedy the problems facing world-wide certifying bodies is to harmonize the laws of the various countries. This can be accomplished two ways: (a) lobbying for changes on a country-by-country basis; or (b) holding a diplomatic conference with a goal of reaching an international agreement with respect to certification marks.

Lobbying country-by-country is probably the most likely scenario to effectuate change. Individual certifying bodies can work with WIPO, INTA¹⁸, AIPLA¹⁹, ECTA²⁰, AIPPI²¹, and other international trademark organizations to persuade the various national trademark offices to reduce roadblocks facing certification-mark owners.

While efficient, pursuing an international agreement or convention with respect to certification marks would be the most difficult way to achieve uniformity. Given the relatively small percentage of trademark owners affected by the problems with certification marks, it may be difficult to generate a critical mass of interested countries.

Furthermore, European countries are hostile towards certification marks because they view them as threatening the European system of protecting geographic indications. In the U.S. system, certification programs frequently involve private trade organizations guaranteeing that products originate from a specific geographic region (e.g., Idaho Potatoes, Washington Apples, Florida Oranges). But in Europe, the geographic indications (e.g., Champagne, Scotch Whiskey, Roquefort Cheese) are protected by the government free of charge through labeling laws. European food and beverage producers thus may oppose strengthening a certification-mark system at the expense of the current governmental protection.

Finally, a diplomatic conference on certification marks poses a potential threat to some of the advantages U.S. certification-mark owners currently enjoy. For example, it is conceivable that a certification-mark convention could result in the loss of classes A and B, requiring applicants to use the more costly Nice Classification System. Regardless, although there is some speculation that WIPO will pursue a diplomatic conference in wake of SCT's recent meetings, it remains unclear if and when such a conference will take place. For now, certification-mark owners must continue to navigate the divergent national systems to register and protect their marks.

Endnotes

¹ 1 Ethan Horwitz, *World Trademark Law and Practice*, Argentina § 5.02 (2d. ed. Supp. 2007).

² Trade Marks Act of 1995 § 169; 1 *Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World*, Australia 41–42 (Arnold Siedsma, ed., Supp. 2005); 1 Ethan Horwitz, *World Trademark Law and Practice*, Australia § 5.02 (2d. ed. Supp. 2007).

³ 1 Ethan Horwitz, *World Trademark Law and Practice*, Brazil § 5.02 (2d. ed. Supp. 2007).

⁴ 1 Ethan Horwitz, *World Trademark Law and Practice*, Canada § 5.02 (2d. ed. Supp. 2007).

⁵ Trademark Law, Art. 3, Administrative Regulations on Registration of Collective Marks and Certification Marks; 2 *Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World*, China 40 (Arnold Siedsma, ed., Supp. 2005); 1 Ethan Horwitz, *World Trademark Law and Practice*, China § 5.02 (2d. ed. Supp. 2004).

⁶ Trademark Act § 10(1); 2 *Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World*, Denmark 39 (Arnold Siedsma, ed., Supp. 2005); 2 Ethan Horwitz, *World Trademark Law and Practice*, Denmark § 5.04 (2d. ed. Supp. 2008).

⁷ Law 91-7 of 1991, Art. L. 715-1; 2 *Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World*, France 53–54 (Arnold Siedsma, ed., Supp. 2006); 2 Ethan Horwitz, *World Trademark Law and Practice*, France § 5.04 (2d. ed. Supp. 2007).

⁸ Trade and Merchandise Marks Act of 1994 § 70; 3 *Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World*, India 27–28 (Arnold Siedsma, ed., Supp. 2005); 3 Ethan Horwitz, *World Trademark Law and Practice*, India § 5.02 (2d. ed. Supp. 2006).

⁹ Trade Marks Act of 1996 § 55(1); 3 Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World, Ireland 46 (Arnold Siedsma, ed., Supp. 2006); 3 Ethan Horwitz, World Trademark Law and Practice, Ireland § 5.02 (2d. ed. Supp. 1999).

¹⁰ Trademark Ordinance 5732-1972, § 14(a); 3 Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World, Israel 19 (Arnold Siedsma, ed., Supp. 2001); 3 Ethan Horwitz, World Trademark Law and Practice, Israel § 5.02 (2d. ed. Supp. 2006).

¹¹ 4 Ethan Horwitz, World Trademark Law and Practice, New Zealand § 5.02 (2d. ed. Supp. 2007).

¹² Trademark Act No. 17 of 2001, Art. 62(1); 5 Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World, Spain 47–48 (Arnold Siedsma, ed., Supp. 2006); 4 Ethan Horwitz, World Trademark Law and Practice, Spain § 5.02 (2d. ed. Supp. 2006).

¹³ Trademark Law of 1992 § 21(1); 6 Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World, Switzerland 37 (Arnold Siedsma, ed., Supp. 2006); 5 Ethan Horwitz, World Trademark Law and Practice, Switzerland § 5.02 (2d. ed. Supp. 2007).

¹⁴ 5 Ethan Horwitz, World Trademark Law and Practice, Taiwan § 5.02 (2d. ed. Supp. 2007).

¹⁵ Law No. 8 of 2002; 6 Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World, United Arab Emirates 18 (Arnold Siedsma, ed., Supp. 2002).

¹⁶ Trade Marks Act of 1994, Schedule 2, Section 3(1); 6 Manual For the Handling of Applications For Patents, Designs and Trade Marks Throughout the World, United Kingdom 46 (Arnold Siedsma, ed., Supp. 2006); 5 Ethan Horwitz, World Trademark Law and Practice, United Kingdom § 5.02 (2d. ed. Supp. 2008).

¹⁷ Lanham Act §§ 4, 14 (15 U.S.C. §§ 1054, 1064).

¹⁸ International Trademark Association (www.inta.org).

¹⁹ American Intellectual Property Law Association (www.aipla.org).

²⁰ European Communities Trade Mark Association (www.ecta.org).

²¹ International Association for the Protection of Intellectual Property (www.aippi.org).