

# A solid mark

## The advantages and disadvantages of filing at the Benelux Trademark Office

Due to the demands of the examination procedure a trademark granted by the Benelux Trademark Office is usually considered a solid mark, as **Dominique Kaesmacher** of Kirkpatrick explains

**T**he event that gives rise to the trademark right is its registration. However, it is the time of filing which determines the order of priority of applications, the priority right and the term of validity of a trademark registration. Moreover, the Uniform Benelux Trademark Law (UBL) provides that the owner of the registration can claim reasonable compensation from a third party who performs acts reserved for the owner of the trademark during the period between publication of the application and the date of registration.

### Filing formalities

**Place of filing:** A Benelux application is filed directly with the Benelux Trademark Office in the Hague, or with one of the three national offices, which then forwards the application to the Benelux Trademark Office, all as laid down and subject to payment of the fees set in the UBL and its executive rules and administrative regulations<sup>1</sup>.

**Content of the filing:** A Benelux application must be filed in French or Dutch, using the form stated in the executive rules and administrative regulations.

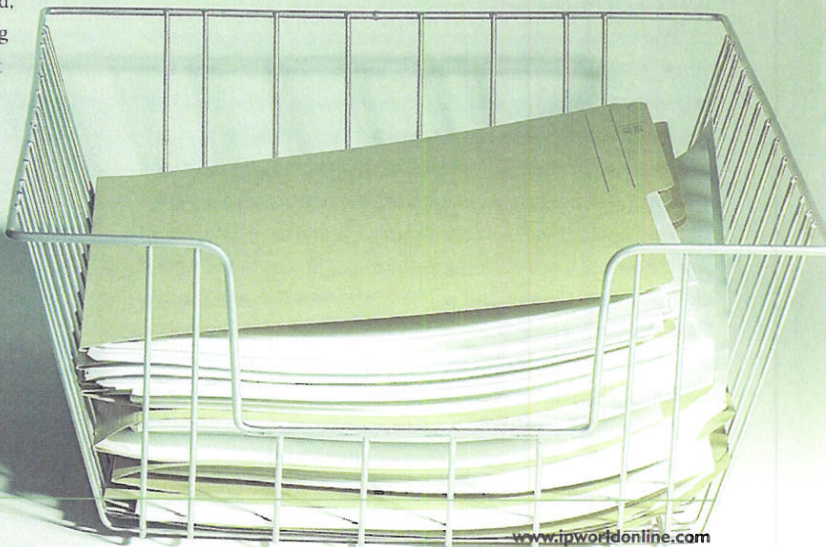
If the national office or the Benelux Trademark Office considers that the formal filing conditions are fulfilled, it informs the applicant, advising him of the filing date. If the conditions necessary for filing are not fulfilled, the applicant is asked to provide the missing information within a certain time limit. The application is no longer effective if the conditions are not met within the period granted.

**Publication of the application:** The Benelux Trademark Office then publishes the Benelux application, if the conditions for setting a filing date have been met and the goods and/or services listed have been classified in accordance with the Nice Agreement. The opposition period runs from publication.

### Examination

**Examination relating to absolute grounds for refusal:** The Benelux Trademark Office automatically checks whether the trademark comes under any of the absolute grounds for refusal of registration, ie whether:

- a) the sign is unable to constitute a trademark within the meaning of the UBL;
- b) the trademark is devoid of any distinctive character;
- c) the trademark consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;
- d) the trademark consists exclusively of signs or indications which have become common in the current language or in the bona fide and established practices of the trade;
- e) the trademark is contrary to public policy or to accepted principles of morality;
- f) the trademark is deceptive or contains a geographical designation for wines or spirits.



Where appropriate, the Benelux Trademark Office notifies the applicant or his agent of its decision of provisional refusal of protection. The applicant then has a period of six months to submit his observations. If he fails to do so or if the Office does not review its decision in the light of the applicant's observations, the refusal becomes 'final' and the application is rendered invalid in accordance with the refusal decision. Revocation of the filing only becomes effective on expiry of the time limit for appeal which the applicant may file against the 'final' refusal decision if the appeal is irrevocably dismissed.

**Relative grounds for refusal – examination of earlier rights:** The Benelux Trademark Office proceeds with an examination of the earlier rights unless the applicant produces a certificate stating that such an examination was requested or performed for the trademark filed, in the three months preceding filing. For the purposes of this examination, the Benelux Trademark Office refers to the *Recueil des marques Benelux* (publication of Benelux trademarks), the Community Register and the International Register. The Benelux Trademark Office then forwards the result of its searches (similar trademarks) to the applicant without issuing a decision (refusal or acceptance).

If the applicant wishes to proceed with registration, he *confirms* his intention, in writing, to the Benelux Trademark Office within six months from the date the examination results are sent. In the absence of such a confirmation the application shall be revoked. During this period, the applicant is free to restrict the list of goods and services for which he wishes to register the trademark. After confirmation, the Benelux Trademark Office officially registers the trademark in the Benelux Register, subject to opposition proceedings as explained below.

**Opposition proceedings:** Within two months from the publication of a filing, the applicant for or owner of an earlier Benelux or Community trademark or international trademark designating Benelux (or the authorised licensee thereof) may file a written opposition with the Benelux Trademark Office<sup>1</sup> against a trademark which:

- has a lower order of priority than his own trademark, is identical or similar to it and is filed for identical or similar goods and/or services, or
- is likely to give rise to confusion with his well known – within the meaning of Article 6bis of the Paris Convention – trademark.

The opposition must be filed in writing and be supported by reasons, and the opposition fee must be paid. The Benelux Trademark Office processes the opposition within a reasonable period as provided for in the Executive Rules and complies with the principle of the right of both parties to be heard. If the opposition is deemed to be well founded, the Office refuses to register the trademark as a whole or in part. Otherwise, the opposition is dismissed. The Benelux Trademark Office's

decision may be the subject of an appeal before the Court of Appeal of Brussels, of the Hague or of Luxembourg, as well as of a further appeal.

### Registration and publication

**Principle:** When the Benelux trademark application meets the conditions of substance and no opposition is filed, or if any such opposition is dismissed by final decision, the trademark is registered and its registration published in the *Registre des marques Benelux* (Benelux trademark register – a copy of which may be consulted at each national trademark office), and in the publication *Recueil des marques Benelux* (published monthly by the Benelux Trademark Office in French and Dutch)<sup>1</sup>.

**Accelerated registration procedure:** The UBL allows the applicant to request accelerated registration of his trademark, without waiting for the results of the examination of earlier rights or the examination of absolute grounds for refusal and in spite of the possibility of an opposition being filed. The benefit of the accelerated procedure may be requested either at the time of application or later. If the benefit of the accelerated procedure is requested by the time of filing the application, the Benelux trademark may be registered very quickly (in 24 hours).

The aim of the system is mainly to allow the applicant to exercise his rights at an early stage, and in particular to proceed with an international filing under the Madrid System, within the priority time limit of six months, which could be compromised in light of the possible length of the "normal" registration procedure (ten to 12 months).

Accelerated registration is performed however at the applicant's risk, since a refusal on an absolute ground for refusal or an opposition could lead to it being later removed from the register. The owner may request the registration to be maintained through an appeal.

### Main differences to the CTM

The main differences are as follows.

There is no **accelerated procedure** for registration at Community level while this faculty is in our view one of the most important advantages of the Benelux system. It allows the applicant to quickly get a registration which will constitute an excellent basis for the international filing within the priority right.

Indeed, since the benefit of the accelerated procedure may be requested at the time of filing the application but also later, it is possible to first get the opinion of the Benelux Trademark Office on the possible absolute grounds for refusal of registration and even the results of its searches (similar prior trademarks) before deciding to request such an accelerated registration and the international protection.

With respect to **opposition**, it is not yet possible to bring opposition proceedings for all classes of goods and services in Benelux, while this is possible under the Community system.

As of September 15, 2005, only Benelux trademarks filed in classes 2, 20, 27, 6, 8, 13, 15, 17, 19 and 21 may form the subject of an opposition.

This is certainly a weak point of the Benelux system since the opposition procedure is much quicker and cheaper than a judicial action before the Court. Furthermore, it gives the owners of prior trademark rights the right to react against possible infringing posterior marks *before* the allegedly infringing mark is granted.

Nevertheless, further to a recent decision of the Benelux Board, the opposition procedure will be open to all classes in Benelux as from January 1, 2006 for filings performed after that date.

As regards **languages**, a Benelux trademark must be filed in French or Dutch whereas a Community trademark may be filed in any of the official languages of the European Union (i.e. one of the languages of the 25 EU Member States)<sup>4</sup>.

The registration of a trademark in one language at the Benelux Trademark Office automatically implies protection for the trademark in the other official national languages of the Benelux countries.

As regards the **International system of trademark protection**, Benelux is part of the Madrid Protocol and the Madrid Agreement, while the CTM is only part of the Protocol.

Finally, with respect to **the duration** of the procedure, the Benelux procedure is much shorter than the Community procedure: the Benelux registration procedure normally, i.e. in 80% of cases, takes ten months, whereas obtaining a Community registration takes 15 months in 80% of cases. This is due in particular to the higher number of earlier rights to be taken into account and the languages.

### Practice and case law

The Benelux Trademark Office has published *Guidelines* providing a detailed description of its practices<sup>5</sup>.

Moreover, experience shows that the Benelux Trademark Office is very strict when it comes to the recognition of distinctive character of three-dimensional trademarks, slogans and colours. In general, it requires that the applicant provides proofs of long-term, intensive use of this kind of trademark before its filing.

For example, the Benelux Trademark Office refused to register the colour turquoise for Belgacom while the OHIM allowed KPN to register the colour orange.

### Advantages of registering in Benelux

Granted only after a thorough examination by the Benelux Trademark Office (which is very demanding) and subject to opposition proceedings (which have left their teething problems behind), a registered Benelux trademark is usually considered to be a **solid trademark**, in other words a mark which is rather unlikely to be further cancelled by judges during a possible

cancellation procedure or a infringement procedure (in which the defendant invokes the nullity of the trademark).

**Rapidity and reasonable costs** are its additional advantages: it can normally be registered in a ten month term and, if necessary, even in 24 hours, thanks to the 'accelerated registration' procedure. However we point out, once again, that this is done at the applicant's risks since the registration could be revoked later. This tool should therefore be exercised with caution and preferably reserved for 'strong' trademarks (i.e. mainly not descriptive).

Moreover, should the applicant wish to get an **international protection** of his trademark, he certainly has to seriously consider basing it on a first filing/registration in Benelux. As indicated above, since the benefit of the accelerated procedure may be requested at the time of filing the application but also later, we usually recommend our client to first get the opinion of the Benelux Trademark Office on the possible absolute grounds for refusal of registration and even analyse the results of its searches before deciding to request such an accelerated registration and the international protection within the priority term. It will allow the applicant to greatly reduce the risk of a successful "central attack" by third parties (i.e. ask for the cancellation of the first filing/registration in the country of origin, being Benelux, with the result of the cancellation of the whole international trademark since the life of the latter is linked to the existence of the original national filing for a period of five years).

One also has to consider **tax aspects** when deciding to register a trademark. To that regard, The Netherlands offer various favourable tax systems to Benelux trademark owners. ■

### Notes

- 1 Official taxes amount to 240 euros for a trademark in one up to 3 classes.
- 2 Article 6 quater, nouveau, UBL, partially effective from 1 January 2004 and fully effective from 1 January 2006.
- 3 Article 17(A)(2) UBL. The Benelux trademark register may also be consulted online on the Benelux Trademark Office's website (<http://www.bmb-bbm.org>).
- 4 With an indication of a second language which must be one of the five languages of the OHIM (English, French, German, Italian or Spanish).
- 5 <http://www.bmb-bbm.org>.

### About the author

**Dominique Kaesmacher** is Chief IP Counsel of Kirkpatrick. Established in Belgium since 1852, Kirkpatrick is an intellectual property firm with multilingual engineers and lawyers providing advice on all issues related to patents, trademarks, designs, copyrights, licences, domain names etc.