An insight in the Benelux trademark and some practicalities.

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Benelux Office for Intellectual Property (BOIP)
Activities BOIP

**TRADEMARK**
- Application
- Publication
- Examination AG
- Opposition
- Registration
- Cancellation
- Modifications
- Renewal

**DESIGN**
- Application
- Publication
- Registration
- Modifications
- Renewal

**IDEA**
- i-Depot
- Transfer
- Publication
Where to register?

✓ Benelux → Benelux Office for Intellectual Property (BOIP)
   Website: www.boip.int

✓ In 28 EU countries → European Union Intellectual Property Office (EUIPO), Spanje.
   Website: www.euipo.europa.eu

✓ Extension of registration from Benelux to over 90 countries → World Intellectual Property Organization (WIPO), Switzerland.
   Website: www.wipo.int
Trademarks
Why apply for TM protection?

Monopoly (exclusive right)

Financial considerations

Huge brand value (Forbes, 2019)

<table>
<thead>
<tr>
<th>Rank</th>
<th>Company</th>
<th>Value</th>
</tr>
</thead>
<tbody>
<tr>
<td>#1</td>
<td>Apple</td>
<td>US$ 205B</td>
</tr>
<tr>
<td>#2</td>
<td>Google</td>
<td>US$ 167B</td>
</tr>
<tr>
<td>#3</td>
<td>Microsoft</td>
<td>US$ 125B</td>
</tr>
</tbody>
</table>

Also for SME’s!

Registration can discourage counterfeiters
Article 2.1 BCIP  Signs that may constitute a trademark

A trademark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

a. distinguishing the goods or services of one undertaking from those of other undertakings; and
b. being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.
## Types of TM

<table>
<thead>
<tr>
<th>Word mark</th>
<th>Figurative mark</th>
<th>Sound mark</th>
</tr>
</thead>
<tbody>
<tr>
<td>A word mark consists only of words, letters, numbers or any other characters that can be visualised.</td>
<td>A figurative mark consists only of an image. A figurative mark does not contain text (letters, numbers or other characters).</td>
<td>A sound mark consists exclusively of a sound or a combination of sounds. It can be submitted as an audio file reproducing the sound or by an accurate representation of the sound in musical notation.</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Position mark</th>
<th>Multimedia mark</th>
<th>Hologram mark</th>
</tr>
</thead>
<tbody>
<tr>
<td>A position mark consists of the specific way in which the mark is placed or affixed on the goods.</td>
<td>A multimedia mark consists, or extends to, the combinations of images and sound.</td>
<td>A hologram mark consists of elements with holographic characteristics.</td>
</tr>
</tbody>
</table>

<table>
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<tr>
<th>Shape mark with word elements</th>
<th>Colour mark</th>
<th>Motion mark</th>
<th>Pattern mark</th>
</tr>
</thead>
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<tr>
<td>A shape mark with word elements consists of an image which combines the use of a 3D shape with text.</td>
<td>A colour mark consists of an image which contains one or more colours without contours. Do not confuse this with a figurative mark in colour.</td>
<td>A motion mark consists of, or extends to, a movement or a change in the position of the elements of a mark.</td>
<td>A pattern mark consists exclusively of a set of elements which are repeated regularly.</td>
</tr>
</tbody>
</table>

| Other |
Benelux trademark - characteristics

- 244 EUR (1 class)
  - 2\(^{nd}\) class + 27 EUR
  - 3\(^{rd}\) class and above + 81 EUR
- 10 years (forever and ever)
- For specific goods and services
- For a certain territory
Trademark application procedure

What happens to your application?

Application to register a trademark → Receipt of application → Publication of application → Application in good order? → Trademark registration

- Check formal requirements
- Substantive examination
- Possible third-party objections to your application
- Application refused
- Application approved
- No trademark registration
The Office shall **not register** signs which are:

- devoid of distinctive character
- descriptive
- customary in the current language or in the established practices of trade
- consist of the shape, or another characteristic, which results from the nature of the goods/is necessary to obtain a technical result/gives substantial value to the goods
- contrary to public policy or to accepted principles of morality
- misleading
- contain a flag, emblem of state or coat of arms (except when authorised)
- conflict with geographical indications
- consist of an earlier plant variety denomination

=> Result: Provisional refusal of the TM (possibility to object)
Definitive refusal = No TM protection & taxes are **not** refunded
<table>
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<th>2.2bis (1)</th>
<th>What?</th>
<th>Example</th>
</tr>
</thead>
<tbody>
<tr>
<td>b.</td>
<td>Distinctive character</td>
<td>I LOVE CATS for T-shirts</td>
</tr>
<tr>
<td>c.</td>
<td>Descriptiveness</td>
<td>BioPetfood 24/7 PharmaLUX, Wave to pay</td>
</tr>
<tr>
<td>d.</td>
<td>Customary in language or trade</td>
<td>Aerobic for fitness services LEAN-SIX SIGMA for management training</td>
</tr>
</tbody>
</table>
However... shall not be refused

<table>
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<th>2.2bis (1)</th>
<th>What?</th>
<th>Example</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>2.2bis (3) Acquired distinctiveness - solely applicable to (b) (c) and (d) !</td>
<td>Elixir d´Anvers</td>
</tr>
</tbody>
</table>
How to avoid a refusal?

• Check is the sign distinctive/not descriptive
• Pay attention to classification
  • No disclaimers (see ECJ Postkantoor)
  • Less is more
  • Avoid general terms
    • Ex.: „eyecatcher“ (for make-up vs. for mascara)
• Geographical indications
  • Known? / Link G/S and place economically realistic?
    • Ex.: „PAXI“ (for software vs. for touristic services)
Possibility to object a refusal: Do´s and don´t s

- File ASAP
- References to case law
- Own merits
- Acquired distinctiveness
  - Together with application
  - Relevant market and TM´s position (ECJ Chiemsee)
  - Whole of the Benelux
Trademarks & licences in the Benelux

Need to know’s
Licence

Characteristics (art. 2.32 BCIP)
- All/part of G/S
- All/part of Benelux ! (>< transfer 2.31.2.b BCIP)
- Exclusive or not

Opposability (art. 2.33 BCIP)
- registration
  (Sub-licence can only be recorded if the initial licence was registered)
- Copy of licensing agreement, signed by both parties (or extract!) = public!
- Fee: 1\textsuperscript{st} TM 56 EUR; 2\textsuperscript{nd} to 5\textsuperscript{th} TM 28 EUR, each subsequent TM free
Good to know

• Authorised licensee can file an opposition (art. 2.14.2.a. BCIP)
• Authorised licensee can file an application for revocation on relative grounds (art. 2.30bis.b.i. BCIP)
• Entry of a licence in the register can only be cancelled at joint request (art. 2.32.3 BCIP)
• Licensee may bring proceedings for infringement of a trademark only if its proprietor consents thereto (NEW since 2019!: holder of an exclusive licence may bring such proceedings himself IF after formal notice no action) (art. 2.32.4 BCIP)
• Intervene in an action brought by the proprietor of the trademark in order to obtain compensation for damages or be allocated proportion of the defendant’s profit (art. 2.32.5 BCIP) or bring an independent action if authorised (art. 2.32.6 BCIP)
Thank you for your attention!

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