

BOIP



Benelux Office for  
**Intellectual  
Property**

[www.boip.int](http://www.boip.int)



# An insight in the Benelux trademark and some practicalities.

22 October 2020

Tineke Van Hoey



BOIP



Benelux Office for  
**Intellectual  
Property**

[www.boip.int](http://www.boip.int)

# Benelux Office for Intellectual Property (BOIP)





## Activities BOIP



### TRADEMARK

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



### DESIGN

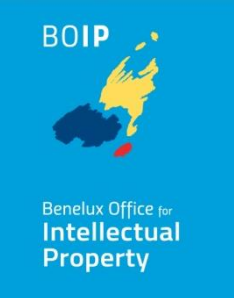
- Application
- Publication
- Registration
- Modifications
- Renewal



### IDEA

- i-Depot
- Transfer
- Publication





## Where to register?

- ✓ Benelux → Benelux Office for Intellectual Property (BOIP)

Website: [www.boip.int](http://www.boip.int)



- ✓ In 28 EU countries → European Union Intellectual Property Office (EUIPO), Spanje.

Website: [www.euipo.europa.eu](http://www.euipo.europa.eu)



- ✓ Extension of registration from Benelux to over 90 countries → World Intellectual Property Organization (WIPO), Switzerland.

Website: [www.wipo.int](http://www.wipo.int)



BOIP



Benelux Office for  
**Intellectual  
Property**

[www.boip.int](http://www.boip.int)

# Trademarks



## Why apply for TM protection?



Monopoly (exclusive right)



Financial considerations

Huge brand value (Forbes, 2019)

#1	Apple	US\$ 205B
#2	Google	US\$ 167B
#3	Microsoft	US\$ 125B

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

## Word mark

A word mark consists only of words, letters, numbers or any other characters that can be typed.

## Figurative mark

A figurative mark consists only of an image. A figurative mark does not contain text (letters, numbers or other characters).

## Sound mark

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.

## Position mark

A position mark consists of the specific way in which the mark is placed or affixed on the goods.

## Figurative mark with word elements

A figurative mark containing word elements consists of an image with text. Select this type of mark also if the text has a certain layout (font, colour, foreign characters).

## Shape mark

A shape mark consist of an image of a shape in 3D, such as the actual product or its packaging.

## Multimedia mark

A multimedia mark consists, or extends to, the combinations of images and sound.

## Hologram mark

A hologram mark consists of elements with holographic characteristics.

## Shape mark with word elements

A shape mark with word elements consists of an image which combines the use of a 3D shape with text.

## Colour mark

A colour mark consist of an image which contains of one or more colours without contours. Do not confuse this with a figurative mark in colour.

## Motion mark

A motion mark consists of, or extends to, a movement or a change in the position of the elements of a mark.

## Pattern mark

A pattern mark consists exclusively of a set of elements which are repeated regularly.

Other







## Benelux trademark - characteristics



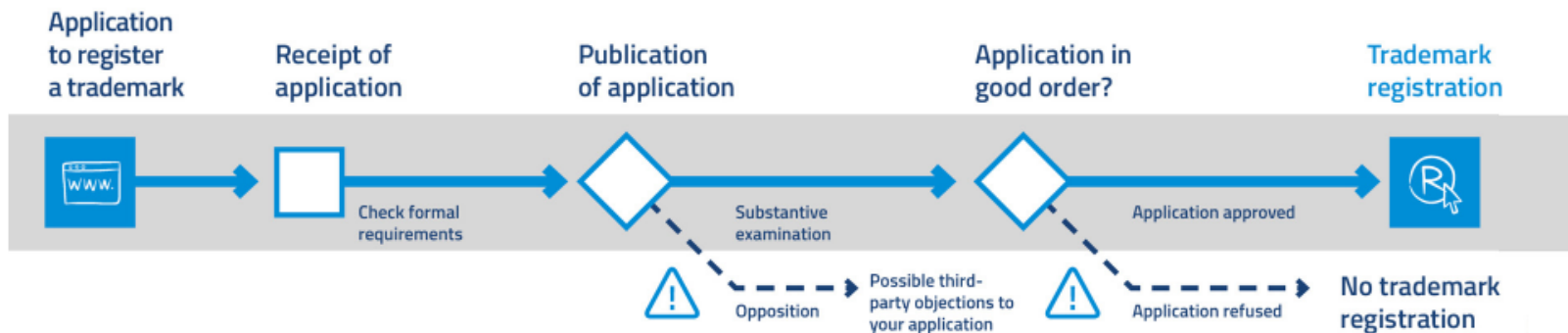
- 244 EUR (1 class)
  - 2<sup>nd</sup> class + 27 EUR
  - 3<sup>rd</sup> class and above + 81 EUR
- 10 years (forever and ever)
- For specific goods and services
- For a certain territory





# Trademark application procedure

## What happens to your application?





## TMs – Absolute grounds examination (art. 2.2bis BCIP)





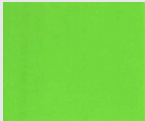

The Office shall **not register** signs which are :

- 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**



2.2bis (1)	What?	Example
b.	Distinctive character	I LOVE CATS for T-shirts  
c.	Descriptiveness	BioPetfood 24/7 PharmaLUX, Wave to pay  
d.	Customary in language or trade	Aerobic for fitness services  LEAN-SIX SIGMA for management training



## However... shall not be refused

2.2bis (1)	What?	Example
2.2bis (3)	Acquired distinctiveness - solely applicable to (b) (c) and (d) !	Elixir d'Anvers





## 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'ts

- 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



BOIP



Benelux Office for  
Intellectual  
Property

[www.boip.int](http://www.boip.int)

# 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<sup>st</sup> TM 56 EUR; 2<sup>nd</sup> to 5<sup>th</sup> 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)



BOIP



Benelux Office for  
Intellectual  
Property

[www.boip.int](http://www.boip.int)

Thank you for your attention!



[tvanhoey@boip.int](mailto:tvanhoey@boip.int)

