

Intellectual Property in the Netherlands
Registration of Marks
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Introduction

This article will discuss the registration of marks. Particular attention will be paid to the requirements for registration of a mark, the registration procedure and the possibilities for taking action against infringement of the registered mark by a third party.

The Uniform Benelux Law on Marks

In 1962 the three Benelux countries – Belgium, the Netherlands and Luxembourg – signed a treaty to uniform their national trademark legislations: the Benelux Treaty on Trademarks. This led to the Uniform Benelux Law on Marks taking effect in 1971 (hereafter to be referred to as: the Benelux Trade Mark Act). The national legislations of the Benelux countries were repealed when this Act took effect. It is therefore no longer possible to defend a trademark in only one Benelux country; protection in one of the three countries simultaneously offers protection in the other two countries.

The Benelux Trademarks Office

The Benelux Trademarks Office is the official body responsible for the implementation of the Uniform Benelux Law on Marks. The Benelux Trademarks Office determines whether a mark is eligible for registration and ensures the final registration of a mark in the Benelux Trademark Register.

Requirements for registration of a mark

- What is a mark?

The Benelux Trade Mark Act determines that as a mark will be considered any sign with the capability to be represented graphically, which can distinguish the products of a company. For example: a drawing, a seal, a logo, a symbol, a colour, a form or a combination of these signs. Furthermore, a mark should be distinctive to prevent confusion on the part of the public.

The Benelux Trade Mark Act distinguishes between individual marks and collective marks. An individual mark is a sign that distinguishes the products of a separate company. The objective of a collective mark is to distinguish one or more collective characteristics of products from different companies. These different companies bring the mark under the supervision of the proprietor. The proprietor may not use the mark for products from its own company or companies in which management or supervisory body it directly or indirectly participates.

- Grounds for refusal of the Benelux Trademarks Office

The Benelux Trademarks Office has the right to refuse registration of a mark pursuant to article 6bis of the Benelux Trade Mark Act. Some examples of grounds for refusal are:

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1. the sign cannot form a mark within the meaning of the Benelux Trade Mark Act;
2. the mark lacks distinctive character;
3. the mark is contrary to morality or the public order;
4. the mark is misleading.

The Benelux Trademarks Office immediately informs the party requesting registration of its intention to refuse registration in whole or in part. The latter will then be given the opportunity to reply within a term provided by implementing regulations.

If the Benelux Trademarks Office maintains its intention to refuse, the aggrieved party may within two months of the notification by means of a petition apply to the Appeals Court, Brussels, the Gerechtshof, The Hague, or the Luxembourg Court of Appeal to obtain an order for registration. An appeal from the decision lies to the Supreme Court.

The Registration Proceedings

- General

The first use of a mark does not give rise to the right to a mark. The mere use does not protect the user. Firstly, the user of the mark shall file the first application at the Benelux Trademarks Office. Without an application, there is no action against third parties using an identical or similar mark for the same or similar products.

- Application

Article 3, paragraph 1 of the Benelux Trade Mark Act determines that the exclusive right to a mark is acquired by registration of the mark whereof the application is filed within the Benelux area (Benelux application).

In addition, by means of one application protection of the mark can be applied for in all member states of the European Union (community trade mark). Finally, on the basis of the Benelux registration, protection of a mark can be obtained through one application, in a number or all countries which are members of the Madrid Agreement and the Madrid Protocol. If the application is filed within six months of the application for the Benelux registration, this so-called international registration will bear the same date as the Benelux application.

To register a mark, Form B provided by the Benelux Trademarks Office shall be completed and sent to the Benelux Trademarks Office. This form can be downloaded from www.bmb.-bbm.org. Applications may now be electronically filed using the online service of the Benelux Trademarks Office, BMBCconnect.

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To achieve admissibility of an application a number of formal requirements have to be satisfied. Form B shall state

1. the name and address of the proprietor;
2. the mark itself;
3. the products and/or services for which the mark is used;
4. whether it is an individual or collective mark.

In addition, the established application fees shall be paid within one month.

- Application costs

The Benelux Trademarks Office has a fee list (also to be downloaded from www.bmb-bbm.org) to determine the amount of the application fee. This depends on the nature of the mark and the kind of procedures to be followed. For instance, an additional application fee is charged in the event of an urgent procedure. In addition to the application fee, the costs to investigate previous registrations in the Benelux Trademark Register have to be considered. This investigation is mandatory and forms an integral part of the application to be made.

- Further procedures

After receipt of Form B, an investigator from the Benelux Trademarks Office investigates whether the application complies with the minimum requirements and awards an application date.

If it concerns a logo then the logo will be classified according to the international classification of Vienna. This classification is made to be able to compare the logo elements in the system of the Benelux Trademarks Office with identical or similar logo elements.

The given classification of goods and services is also checked. The classification must comply with the requirements established in the international classification of Nice. Using the international classification of Nice has the advantage that registration is conducted according to one uniform classification system, thus creating one uniform term in all member countries.

It is furthermore determined whether or not there are grounds for refusal and whether the other administrative requirements have been complied with. Finally, there is an investigation of the word and/or logo.

Upon receipt of the application, the date and hour of receipt is stated on the form and confirmation is sent to the proprietor. If the application complies with the relevant requirements, the period of protection will take effect on the date of the application.

Infringement by a third party

The period of validity of the registration of a Benelux application is ten years and may be renewed indefinitely at the request of the proprietor, but each time for a ten-year period.

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The proprietor itself shall take action against a third party if during the period of validity of the registration this third party improperly uses or infringes its registered mark. The Benelux Trademarks Office has no authority to take such action.

However, it is possible that the proprietor of an older mark, within a two-month period after publication of the application, files a written opposition at the Benelux Trademarks Office against a mark that:

1. ranks below its own mark;
2. may create confusion with its own well-known mark.

This opposition procedure only applies in situations in which registration of the younger mark has been requested. In all other cases in which a third party infringes the proprietor's mark, the manner in which the proprietor may take action depends on the circumstances of the case.

If an out-of-court settlement of the dispute is not to be expected, the court will have to decide whether there is an infringement or violation of a trademark right.

Unless there is a specific agreement to the contrary, jurisdiction of the court is based on the domicile of the Respondent or the place where the obligation giving rise to the litigation originated or was or is to be performed. The place where a mark was deposited or registered may on no account serve in itself as a basis for the determination of jurisdiction.

Where these criteria are insufficient for the determination of jurisdiction, the plaintiff may bring the action before the Court of Brussels, The Hague or Luxembourg, at its option.

After exhausting national remedies a proprietor may furthermore petition the national court which decided the dispute in the last instance to submit a pre-judicial question to the Benelux Court of Justice or, if it concerns a community trade mark: The European Court of Justice.

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