

**BOIP**



Benelux Office for  
**Intellectual  
Property**



## **Benelux Convention on Intellectual Property (trademarks and designs)<sup>1</sup>**

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<sup>1</sup> As amended by the Protocol of 11-12-2017 (into force: 01-03-2019). The official text of the BCIP is in French and Dutch. This English translation is provided by BOIP for information purposes. BOIP is not responsible for typing or translation errors.

The Kingdom of Belgium,

The Grand Duchy of Luxembourg,

The Kingdom of the Netherlands,

Inspired by the desire to:

- replace the conventions, uniform laws and amending protocols relating to Benelux trademarks and designs with a single convention systematically and transparently governing both trademark law and design law;
- provide quick and effective procedures that will allow Benelux regulations to be brought into line with Community regulations and international treaties already ratified by the three High Contracting Parties;
- replace the Benelux Trademark Office and the Benelux Designs Office with the Benelux Organization for Intellectual Property (trademarks and designs) carrying out its mission through decision-making and executive bodies provided with their own and additional powers;
- provide the new Organization with a structure consistent with current views on international organizations and guaranteeing its independence, in particular through a protocol on privileges and immunities;
- bring the new Organization closer to undertakings by fully developing its powers to enable it to undertake new tasks in the field of intellectual property and open decentralized branches;
- provide the new Organization, non-exclusively, with a right of evaluation and initiative in respect of the adaptation of Benelux legislation on trademarks and designs;

Have resolved to enter into a convention for the said purpose and have designated to that end as their Plenipotentiaries:

His Excellency Mr. K. de Gucht, Minister for Foreign Affairs,

His Excellency Mr. B. R. Bot, Minister for Foreign Affairs,

His Excellency Mr. J. Asselborn, Minister for Foreign Affairs,

who, upon production of their full credentials found to be in due and proper form, have agreed upon the following provisions:

## TITLE I: GENERAL AND INSTITUTIONAL PROVISIONS

### Article 1.1 Abbreviated expressions

The following meanings shall apply for the purposes of this convention:

- Paris Convention: the Paris Convention for the Protection of Industrial Property of March 20, 1883;
- Madrid Agreement: the Madrid Agreement concerning the International Registration of Marks of April 14, 1891;
- Madrid Protocol: the Protocol relating to the Madrid Agreement concerning the International Registration of Marks of June 27, 1989;
- Nice Agreement: the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957;
- Hague Agreement: the Hague Agreement concerning the International Deposit of Industrial Designs of November 6, 1925;
- European Union trade mark regulation: Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (codification);
- EU trademark: a European Union trade mark, as provided for in the European Union trade mark regulation;
- Union legislation: legislation of the European Union;
- Community Design Regulation: Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs;
- TRIPS Agreement: the Agreement on Trade-Related Aspects of Intellectual Property Rights of April 15, 1994; Annex 1C of the Agreement Establishing the World Trade Organization;
- International Bureau: the International Bureau of Intellectual Property established by the Convention Establishing the World Intellectual Property Organization of July 14, 1967.

### Article 1.2 Organization

1. A Benelux Organization for Intellectual Property (trademarks and designs), hereinafter referred to as "the Organization", shall be established.
2. The executive bodies of the Organization shall be:
  - a. the Committee of Ministers referred to in the Treaty establishing the Benelux Union, hereinafter referred to as "the Committee of Ministers";
  - b. the Administrative council of the Benelux Office for Intellectual Property (trademarks and designs), hereinafter referred to as "the Administrative council";
  - c. the Benelux Office for Intellectual Property (trademarks and designs), hereinafter referred to as "the Office".

### Article 1.3 Objectives

The Organization shall be responsible for:

- a. the execution of this convention and the implementing regulations;
- b. promoting the protection of trademarks and designs in the Benelux countries;
- c. performing additional tasks in other fields of intellectual property law as decided by the Administrative council;
- d. continually evaluating and, if necessary, adapting Benelux legislation on trademarks and designs in the light of international, Community and other developments.

#### **Article 1.4      Legal personality**

1. The Organization shall have international legal personality with a view to performance of the mission entrusted to it.
2. The Organization shall have national legal personality and shall therefore have, on the territory of the three Benelux countries, the legal powers recognized for national corporate bodies, insofar as is necessary for the accomplishment of its tasks and the fulfillment of its objectives, in particular the ability to enter into contracts, to acquire and dispose of movable and immovable assets, to receive and dispose of private and public funds and to be a party in court proceedings.
3. The Director General of the Office, hereinafter referred to as "the Director General", shall represent the Organization in matters in and out of court.

#### **Article 1.5      Headquarters**

1. The Organization shall have its headquarters in The Hague.
2. The Office shall be located in The Hague.
3. Branches of the Office may be established elsewhere.

#### **Article 1.6      Privileges and immunities**

1. The privileges and immunities necessary for the accomplishment of the Organization's tasks and the fulfilment of its objectives shall be laid down in a protocol to be concluded between the High Contracting Parties.
2. The Organization may conclude supplementary agreements with one or more of the High Contracting Parties relating to the establishment of services of the Organization on the territory of that State or those States, with a view to implementing the provisions of the protocol adopted in accordance with the first paragraph in respect of that State or those States, as well as other arrangements in order to ensure the proper functioning of the Organization and the safeguarding of its interests.

#### **Article 1.7      Powers of the Committee of Ministers**

1. The Committee of Ministers shall have the power to make such amendments to this convention as are necessary to ensure that this convention complies with an international treaty or with European Union regulations on trademarks and designs. Amendments shall be published in the official journal of each of the High Contracting Parties.
2. The Committee of Ministers shall have the power to make amendments to this convention other than those mentioned in the first paragraph. These amendments shall be submitted to the High Contracting Parties for consent or approval.
3. The Committee of Ministers shall have the power, following consultation with the Administrative council, to provide the Director General with a mandate to negotiate on behalf of the Organization and, with its authorization, to conclude agreements with States and intergovernmental organizations.

#### **Article 1.8      Composition and functioning of the Administrative council**

1. The Administrative council shall comprise of members appointed by the High Contracting Parties, on the basis of one full board member and two deputy board members per country.
2. It shall take its decisions by unanimous vote.
3. It shall adopt its own rules of procedure.

#### **Article 1.9 Powers of the Administrative council**

1. The Administrative council shall have the power to make proposals to the Committee of Ministers relating to amendments to this convention, which are necessary in order to ensure that this convention complies with an international treaty or European Union regulations, and relating to other amendments to this convention which it considers desirable.
2. It shall establish the implementing regulations.
3. It shall establish the rules of procedure and financial regulations of the Office.
4. It shall designate additional tasks, as referred to in Article 1.3 (c), in other fields of intellectual property law.
5. It shall decide on the establishment of branches of the Office.
6. It shall appoint the Director General and, following consultation with the Director General, the deputy Directors General, and shall exercise disciplinary powers in respect of such officials.
7. It shall adopt the annual income and expenditure budget, as well as any modifications or additions thereto, and shall specify in the financial regulations the manner in which the budgets and implementation thereof shall be supervised. It shall approve the annual accounts drawn up by the Director General.

#### **Article 1.10 The Director General**

1. Management of the Office shall be the responsibility of the Director General who shall answer to the Administrative council with regard to the Office's activities.
2. The Director General shall have the power, following consultation with the Administrative council, to delegate exercise of some of the powers entrusted to him to the Deputy Directors General.
3. The Director General and the Deputy Directors General shall be nationals of the Member States. The three nationalities shall be represented in the management.

#### **Article 1.11 Powers of the Director General**

1. The Director General shall make proposals to the Administrative council with a view to amending the implementing regulations.
2. He shall take all steps, including administrative steps, to ensure that the tasks of the Office are properly performed.
3. He shall execute the rules of procedure and financial regulations of the Office and shall make proposals to the Administrative council with a view to amending those regulations.
4. He shall appoint agents and exercise hierarchical authority and disciplinary powers with respect to them.
5. He shall prepare and execute the budget and draw up the annual accounts.
6. He shall take all other steps that he considers to be appropriate in the interests of the functioning of the Office.

#### **Article 1.12 Finances of the Organization**

1. The operating costs of the Organization shall be covered by its income.
2. The Administrative council may request a contribution from the High Contracting Parties to cover extraordinary expenditure. Half of this contribution shall be borne by the Kingdom of the Netherlands and half by the Belgium-Luxembourg Economic Union.

#### **Article 1.13 Involvement of national administrations**

1. A percentage of the fees collected in respect of operations performed through the national administrations shall be distributed to the said administrations to cover the cost of such operations; this percentage shall be fixed by the implementing regulations.
2. No national fees relating to these operations may be levied by national regulations.

#### **Article 1.14 Acceptance of court decisions**

The authority of court decisions handed down in one of the three States pursuant to this convention shall be recognized in the other two States and court ordered cancellation shall be carried out by the Office at the request of the most diligent party, if:

- a. in accordance with the legislation of the country in which the decision was handed down, the extract of the order resulting from it meets the conditions regarding its authenticity;
- b. the decision is no longer open to opposition or appeal or to reversal by a court of cassation.

#### **Article 1.15 Benelux Court of Justice**

The Benelux Court of Justice as mentioned in Article 1 of the Treaty concerning the establishment and status of a Benelux Court of Justice shall have the power to hear questions concerning the interpretation of this convention and the implementing regulations, with the exception of questions of interpretation relating to the protocol on privileges and immunities mentioned in Article 1.6 (1).

#### **Article 1.15bis Appeal**

1. Any person who is a party to a procedure that has led to a final decision by the Office in the execution of its official tasks pursuant to Titles II, III and IV of this Convention may lodge an appeal against that decision with the Benelux Court of Justice in order to have that decision annulled or reviewed. The timeframe for filing an appeal is two months from notification of the final decision.
2. The Organisation may be represented in proceedings before the Benelux Court of Justice relating to decisions made by the Office by a member of staff appointed for this purpose.

#### **Article 1.16 Scope of application**

Application of this convention shall be restricted to the territories of the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands in Europe, hereinafter referred to as "Benelux territory".

## TITLE II: TRADEMARKS

### Chapter 1. Validity of a trademark

#### Article 2.1 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.

#### Article 2.2 Acquisition of the right

Without prejudice to the right of priority provided for by the Paris Convention or the TRIPS Agreement, the exclusive right in a trademark under this convention shall be acquired by registration of the trademark that has been filed in Benelux territory (Benelux trademark) or results from registration with the International Bureau designating the Benelux territory (international trademark).

#### Article 2.2bis Absolute grounds for refusal or invalidity

1. The following shall not be registered or, if registered, shall be liable to be declared invalid:
  - a. signs which cannot constitute a trademark;
  - b. trademarks which are devoid of any distinctive character;
  - c. trademarks which consist 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 services;
  - d. trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
  - e. signs which consist exclusively of:
    - i. the shape, or another characteristic, which results from the nature of the goods themselves;
    - ii. the shape, or another characteristic, of goods which is necessary to obtain a technical result;
    - iii. the shape, or another characteristic, which gives substantial value to the goods;
  - f. trademarks which are contrary to public policy or to accepted principles of morality in one of the Benelux countries;
  - g. trademarks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service;
  - h. trademarks which have not been authorised by the competent authorities and are to be refused or invalidated pursuant to Article 6ter of the Paris Convention;
  - i. trademarks which are excluded from registration pursuant to Union legislation or the internal law of one of the Benelux countries, or to international agreements to which the European Union is party or which have effect in a Benelux country, providing for protection of designations of origin and geographical indications;
  - j. trademarks which are excluded from registration pursuant to Union legislation or international agreements to which the European Union is party, providing for protection of traditional terms for wine;
  - k. trademarks which are excluded from registration pursuant to Union legislation or international agreements to which the European Union is party, providing for protection of traditional specialities guaranteed;

- i. trademarks which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or the internal law of one of the Benelux countries, or international agreements to which the European Union is party or which have effect in a Benelux country, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species.
2. A trademark shall be liable to be declared invalid where the application for registration of the trademark was made in bad faith by the applicant.
3. A trademark shall not be refused registration in accordance with paragraph 1 (b), (c) or (d) if, before the date of application for registration, following the use which has been made of it, it has acquired a distinctive character. A trademark shall not be declared invalid for the same reasons if, before the date of application for a declaration of invalidity, following the use which has been made of it, it has acquired a distinctive character.

#### **Article 2.2ter Relative grounds for refusal or invalidity**

1. A trademark shall, in case an opposition is filed, not be registered or, if registered, shall be liable to be declared invalid where:
  - a. it is identical with an earlier trademark, and the goods or services for which the trademark is applied for or is registered are identical with the goods or services for which the earlier trademark is protected;
  - b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.
2. 'Earlier trademarks' within the meaning of paragraph 1 means:
  - a. trademarks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trademark, taking account, where appropriate, of the priorities claimed in respect of those trademarks:
    - i. Benelux trademarks and international trademarks designating the Benelux territory;
    - ii. EU trademarks, including international trademarks designating the European Union;
  - b. EU trademarks which validly claim seniority, in accordance with European Union trade mark regulation, of a trademark referred to under (a) (i), even when the latter trademark has been surrendered or allowed to lapse;
  - c. applications for the trademarks referred to under (a) and (b), subject to their registration;
  - d. trademarks which, on the date of application for registration of the trademark, or, where appropriate, of the priority claimed in respect of the application for registration of the trademark, are well known in the Benelux territory, in the sense in which the words 'well-known' are used in Article 6bis of the Paris Convention.
3. Furthermore, a trademark shall, in case an opposition is filed, not be registered or, if registered, shall be liable to be declared invalid where:
  - a. it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark;
  - b. an agent or representative of the proprietor of the trademark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action;
  - c. and to the extent that, pursuant to Union legislation or the internal law of one of the Benelux countries providing for protection of designations of origin and geographical indications:
    - i. an application for a designation of origin or a geographical indication had already been submitted in accordance with Union legislation or the internal law of one of the Benelux countries prior to the date of application for registration of the trademark or the date of the priority claimed for the application, subject to its subsequent registration;
    - ii. that designation of origin or geographical indication confers on the person authorised under the relevant law to exercise the rights arising therefrom the right to prohibit the use of a subsequent trademark.
4. A trademark may not be refused registration or declared invalid where the proprietor of the earlier trademark or other earlier right consents to the registration of the later trademark.



#### **Article 2.2quater** Grounds for refusal or invalidity relating to only some of the goods or services

Where grounds for refusal of registration or for invalidity of a trademark exist in respect of only some of the goods or services for which that trademark has been applied or registered, refusal of registration or invalidity shall cover those goods or services only.

#### **Article 2.3**

Repealed

#### **Article 2.4**

Repealed

### **Chapter 2. Filing, registration and renewal**

#### **Article 2.5** Filing

1. A Benelux trademark shall be filed, either with the national administrations or with the Office, in the manner specified by the implementing regulations and against payment of the fees due. A check shall be made to ensure that the documents produced satisfy the conditions specified for fixing the filing date and the filing date shall be fixed. The applicant shall be informed, without delay and in writing, of the date of filing or, where applicable, of the grounds for not fixing a filing date.
2. If other provisions of the implementing regulations are not satisfied at the time of filing, the applicant shall be informed without delay and in writing of the conditions which are not fulfilled and shall be given the opportunity to respond.
3. The application shall have no further effect if the provisions of the implementing regulations are not satisfied within the period granted.
4. Where filing takes place with a national administration, the national administration shall forward the application to the Office, either without delay after receiving the application or after establishing that the application satisfies the specified conditions.
5. The Office shall publish the application, in accordance with the provisions of the implementing regulations, when the conditions for fixing a filing date have been fulfilled and the goods or services mentioned have been classified in accordance with Article 2.5bis.

#### **Article 2.5bis** Designation and classification of goods and services

1. The goods and services in respect of which trademark registration is applied for shall be classified in conformity with the system of classification established by the Nice Agreement ('the Nice Classification').
2. The goods and services for which protection is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought.
3. For the purposes of paragraph 2, the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision set out in this Article.
4. The Office shall reject an application in respect of indications or terms which are unclear or imprecise, where the applicant does not suggest an acceptable wording within a period set by the Office to that effect.
5. The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term. The use of such terms or indications shall not be interpreted as comprising a claim to goods or services which cannot be so understood.

6. Where the applicant requests registration for more than one class, the applicant shall group the goods and services according to the classes of the Nice Classification, each group being preceded by the number of the class to which that group of goods or services belongs, and shall present them in the order of the classes.
7. Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification. Goods and services shall not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

#### **Article 2.6 Claiming priority**

1. A right of priority provided for by the Paris Convention or the TRIPS Agreement shall be claimed at the time of filing.
2. The right of priority referred to in Article 4 of the Paris Convention shall also apply to service marks.
3. A right of priority may also be claimed in the month following filing, by means of a special declaration submitted to the Office in the manner laid down by the implementing regulations and against payment of the fees due.
4. If no such claim is made, the right of priority shall lapse.

#### **Article 2.7 Search**

1. The Office may offer a search for prior registrations as a service.
2. The Director General will determine the modalities thereof.

#### **Article 2.8 Registration**

1. Without prejudice to the application of Articles 2.11, 2.14 and 2.16, the filed trademark is registered for the goods or services indicated by the applicant if the requirements set out in the implementing regulations are met. The Office shall confirm the registration to the proprietor of the trademark.
2. If all the requirements referred to in Article 2.5 have been met, the applicant may request the Office to proceed with the registration of the trademark without delay in accordance with the provisions of the implementing regulations. Articles 2.11, 2.14 and 2.16 apply to trademarks registered in this manner, on the understanding that the Office is authorised to decide to cancel the registration.

#### **Article 2.9 Term and renewal of registration**

1. Registration of a Benelux trademark shall be for a period of 10 years, with effect from the date of filing.
2. The sign constituting the trademark may not be modified either during the period of registration or at the time of its renewal.
3. The registration may be renewed for further periods of 10 years by the proprietor of the trademark or any person authorised to do so by law or by contract.
4. Renewal will take place upon payment of the renewal fees. Where the fees are paid in respect of only some of the goods or services for which the trademark is registered, registration shall be renewed for those goods or services only. The fees should be paid within a period of six months immediately preceding the expiry of the registration or of the subsequent renewal thereof. Failing that, the fees can be paid within a further period of six months immediately following the expiry of the registration or of the subsequent renewal thereof, if an additional fee is paid simultaneously.
5. Six months prior to the expiry of a registration, the Office shall send a reminder of the expiry date to the proprietor of the trademark.

6. For this reminder, the Office uses the latest contact details of the proprietor of the trademark known to the Office. Failure to send or receive such reminder shall not constitute dispensation from the obligations resulting from paragraphs 3 and 4. It may not be invoked in court proceedings or against the Office.
7. Renewal shall take effect from the day following the date on which the existing registration expires. The Office shall record the renewal in the register.

#### **Article 2.10 International filing**

1. International filing of trademarks shall take place in accordance with the provisions of the Madrid Agreement and the Madrid Protocol. The fee provided for by Article 8 (1) of the Madrid Agreement and the Madrid Protocol, and the fee provided for by Article 8 (7) (a) of the Madrid Protocol, shall be specified by the implementing regulations.
2. Without prejudice to the application of Articles 2.15bis, 2.13 and 2.18, the Office shall register international filings in respect of which application has been made for the extension of protection to Benelux territory.
3. The applicant may request the Office, in accordance with the provisions of the implementing regulations, to proceed with registration without delay. Article 2.8 (2), applies to trademarks registered in this manner.

### **Chapter 3. Examination on absolute grounds**

#### **Article 2.11 Refusal on absolute grounds**

1. The Office shall refuse to register a trademark if, in its opinion, one of the absolute grounds referred to in Article 2.2bis (1) applies.
2. Refusal to register a trademark must relate to the sign that constitutes a trademark as a whole.
3. The Office shall notify the applicant without delay, in writing and stating reasons, of its intention to wholly or partially refuse registration and shall allow the applicant to respond to such notification within a period laid down in the implementing regulations.
4. If the Office's objections to the registration are not resolved within such period, the registration of the trademark shall be wholly or partially refused. The Office shall notify the applicant of its refusal without delay, in writing, stating the grounds for refusal and mentioning the legal remedies against this decision as provided by Article 1.15bis.
5. The refusal shall not become final until such time as the decision is no longer subject to appeal.

#### **Article 2.12**

Repealed

#### **Article 2.13 Refusal of international filings on absolute grounds**

1. Article 2.11 (1) and (2) shall apply to international filings.
2. The Office shall inform the International Bureau as soon as possible of its intention to refuse registration, in writing and stating reasons, by means of a provisional total or partial refusal of protection for the trademark, at the same time allowing the applicant the opportunity to respond to said notice in accordance with the provisions of the implementing regulations. Article 2.11 (4) and (5) shall apply.
3. Repealed
4. Repealed

**Article 2.14 Initiation of the procedure**

1. Within two months following publication of the application, an opposition may be filed in writing at the Office on the relative grounds referred to in Article 2.2ter.
2. Opposition may be filed:
  - a. in the cases referred to in Article 2.2ter (1) and (3) (a), by the proprietors of earlier trademarks and the licensees authorised by those proprietors;
  - b. in the case referred to in Article 2.2ter (3) (b), by the proprietors of trademarks referred to therein. In this case, the assignment referred to in Article 2.20ter (1) (b), may also be requested;
  - c. in the case referred to in Article 2.2ter (3) (c), by persons authorised, under the applicable law, to exercise these rights.
3. Opposition may be filed on the basis of one or more earlier rights and on the basis of part or the totality of the goods or services in respect of which the earlier right is protected or applied for, and may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.
4. An opposition shall not be deemed to have been entered until the fees due have been paid.

**Article 2.15**

Repealed

**Article 2.16 Course of the proceedings**

1. The Office shall deal with an opposition within a reasonable timeframe in accordance with the provisions laid down in the implementing regulations and shall respect the principle that both sides should be heard.
2. The opposition proceedings shall be suspended:
  - a. where the opposition is based on Article 2.14 (2) (a), if the earlier mark:
    - i. has not yet been registered;
    - ii. was registered without delay in accordance with Article 2.8 (2) and is the subject of proceedings for refusal on absolute grounds or opposition;
    - iii. is the subject of an action for invalidation or revocation;
  - b. where the opposition is based on Article 2.14 (2) (c), when it is based on an application for a designation of origin or geographical indication, until a final decision has been taken on it;
  - c. if the opposed trademark:
    - i. is the subject of proceedings for refusal on absolute grounds;
    - ii. was registered without delay in accordance with Article 2.8 (2) and is the subject of a judicial action for invalidation or revocation;
  - d. at the joint request of the parties;
  - e. if other circumstances justify such a suspension.

3. The opposition proceedings shall be closed:
  - a. where the opponent has lost the capacity to act;
  - b. where the defendant does not react to the opposition lodged. In this case the application shall come without effect;
  - c. where the opposition has become without cause, either because it has been withdrawn or because the application against which the opposition is directed has come to be without effect;
  - d. where the earlier trademark or earlier right is no longer valid;
  - e. if the opposition is based on Article 2.14 (2) (a), and the opponent has not produced within the prescribed period proof of use of his earlier trademark as referred to in Article 2.16bis;In such circumstances, part of the fees paid shall be refunded.
4. After examination of the opposition is completed, the Office shall reach a decision as soon as possible. If the opposition is held to be justified, the Office shall refuse to register the trademark in whole or in part or shall decide to record in the Register the transfer referred to in Article 2.20ter (1) (b). Otherwise, the opposition shall be rejected. The Office shall inform the parties in writing and without delay, and will mention the right of appeal against this decision contained in Article 1.15bis. The decision of the Office will become final only once it is no longer subject to appeal. The Office will not be a party to any appeal against its decision.
5. Costs shall be borne by the losing party. They shall be fixed in accordance with the provisions of the implementing regulations. Costs shall not be due if the opposition is partly successful. The Office's decision concerning costs shall constitute an enforceable order. Its forced execution shall be governed by the rules in force in the State where it takes place.

#### **Article 2.16bis Non-use as defence in opposition proceedings**

1. Where in opposition proceedings pursuant to Article 2.14 (2) (a), at the filing or priority date of the later trademark, the five-year period within which the earlier trademark must have been put to genuine use as provided for in Article 2.23bis had expired, at the request of the applicant, the opponent shall furnish proof that the earlier trademark has been put to genuine use as provided for in Article 2.23bis during the five-year period preceding the filing or priority date of the later trademark, or that proper reasons for non-use existed.
2. If the earlier trademark has been used in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the opposition as provided for in paragraph 1, be deemed to be registered in respect of that part of the goods or services only.
3. Paragraphs 1 and 2 of this Article shall also apply where the earlier trademark is an EU trademark. In such a case, the genuine use shall be determined in accordance with Article 18 of the European Union trade mark regulation.

#### **Article 2.17**

Repealed

#### **Article 2.18 Opposition to international filings**

1. During a period of two months to be calculated from publication by the International Bureau, an opposition may be submitted with the Office against an international filing for which protection in Benelux territory has been requested. Articles 2.14 to 2.16bis apply accordingly.
2. The Office shall inform the International Bureau of the submitted opposition without delay and in writing, mentioning the provisions of Articles 2.14 to 2.16bis and the relevant provisions of the implementing regulations.
3. Repealed

**Article 2.19 Obligation to register**

1. With the exception of the holder of a trademark which is well known within the meaning of Article 6bis of the Paris Convention, and regardless of the nature of the action brought, no one may claim in court protection for a sign deemed to be a trademark as defined in Article 2.1, unless that claimant can provide evidence of registration of the trademark which it has filed.
2. If appropriate, non-admissibility may be raised ex officio by the court.
3. The provisions of this title shall not in any way detract from the right of the users of a sign which is not regarded as a trademark within the meaning of Article 2.1, to invoke ordinary law insofar as this allows an objection to be raised to unlawful use of that sign.

**Article 2.20 Rights conferred by a trademark**

1. The registration of a trademark referred to in Article 2.2 shall confer on the proprietor exclusive rights therein.
2. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trademark, and without prejudice to the possible application of ordinary law in matters of civil liability, the proprietor of that registered trademark shall be entitled to prevent all third parties not having his consent from using any sign where such sign:
  - a. is identical with the trademark and is used in the course of trade in relation to goods or services which are identical with those for which the trademark is registered;
  - b. is identical with, or similar to, the trademark and is used in the course of trade in relation to goods or services which are identical with, or similar to, the goods or services for which the trademark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trademark;
  - c. is identical with, or similar to, the trademark irrespective of whether it is used in relation to goods or services which are identical with, similar to, or not similar to, those for which the trademark is registered, where the latter has a reputation in the Benelux territory and where use in the course of trade of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark;
  - d. is used for purposes other than those of distinguishing goods or services, where use of the sign without due cause, would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark.
3. The following, in particular, may be prohibited under paragraph 2 (a) to (c):
  - a. affixing the sign to the goods or to the packaging thereof;
  - b. offering the goods or putting them on the market, or stocking them for those purposes, under the sign, or offering or supplying services thereunder;
  - c. importing or exporting the goods under the sign;
  - d. using the sign as a trade or company name or part of a trade or company name;
  - e. using the sign on business papers and in advertising;
  - f. using the sign in comparative advertising in a manner that is contrary to Directive 2006/114/EC of the European Parliament and of the Council of 12 December 2006 concerning misleading and comparative advertising.
4. Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trademark, the proprietor of that registered trademark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the Benelux territory, without being released for free circulation there, where such goods, including the packaging thereof, come from third countries and bear without authorisation a trademark which is identical with the trademark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trademark.

The entitlement of the trademark proprietor pursuant to the first subparagraph shall lapse if, during the proceedings to determine whether the registered trademark has been infringed, initiated in accordance with Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003, evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trademark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

5. Where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trademark is affixed, could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of a trademark under paragraph 2 and 3, the proprietor of that trademark shall have the right to prohibit the following acts if carried out in the course of trade:
  - a. affixing a sign identical with, or similar to, the trademark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed;
  - b. offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.
6. The exclusive right to a trademark expressed in one of the national or regional languages of the Benelux territory extends automatically to its translation into another of those languages. Evaluation of the similarity arising from translations into one or more languages foreign to the aforesaid territory shall be a matter for the courts.

#### **Article 2.20bis** Reproduction of trademarks in dictionaries

If the reproduction of a trademark in a dictionary, encyclopaedia or similar reference work, in print or electronic form, gives the impression that it constitutes the generic name of the goods or services for which the trademark is registered, the publisher of the work shall, at the request of the proprietor of the trademark, ensure that the reproduction of the trademark is, without delay, and in the case of works in printed form at the latest in the next edition of the publication, accompanied by an indication that it is a registered trademark.

#### **Article 2.20ter** Prohibition of the use of a trademark registered in the name of an agent or representative

1. Where a trademark is registered in the name of the agent or representative of a person who is the proprietor of that trademark, without the proprietor's consent, the latter shall be entitled to do either or both of the following:
  - a. oppose the use of the trademark by his agent or representative;
  - b. demand the assignment of the trademark in his favour.
2. Paragraph 1 shall not apply where the agent or representative justifies his action.

#### **Article 2.21** Compensation for damages and other actions

1. Subject to the same conditions as in Article 2.20 (2), the exclusive right in a trademark shall allow its proprietor to claim compensation for any prejudice which he has suffered following use within the meaning of that provision.
2. The court which sets the damages:
  - a. shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any unfair profits made by the infringer and, in appropriate cases, elements other than economic factors, such as the moral prejudice caused to the proprietor of the trademark as a result of the infringement; or
  - b. as an alternative to (a), it may, in appropriate cases, set the damages as a lump sum on the basis of elements such as at least the amount of royalties or fees which would have been due if the infringer had requested authorization to use the trademark.
3. Furthermore, the court may order, at the request of the proprietor of a trademark and by way of compensation, that ownership of goods which infringe a trademark right, as well as, in appropriate cases, the materials and implements principally used in the manufacture of those goods, be transferred to the proprietor of the trademark; the court may order that the transfer shall only take place upon payment by the claimant of a sum which it shall fix.
4. In addition to or instead of the action for compensation, the proprietor of a trademark may institute proceedings for transfer of the profits made following the use referred to in Article 2.20 (2), and for the provision of accounts in this regard. The court shall reject the application if it considers that this use is not in bad faith or the circumstances of the case do not justify such an order.
5. The proprietor of a trademark may institute proceedings for compensation or transfer of profits in the name of the licensee, without prejudice to the right granted to the licensee in Article 2.32 (5) and (6).

6. The proprietor of a trademark may require reasonable compensation from a party which has carried out acts such as those mentioned in Article 2.20 (2) during the period between the date of publication of the filing and the date of registration of the trademark, insofar as the proprietor of the trademark has acquired exclusive rights in this regard.

#### **Article 2.22 Additional claims**

1. Without prejudice to any damages due to the proprietor of a trademark by reason of the infringement, and without compensation of any sort, the courts may order, at the request of the proprietor of a trademark, the recall from the channels of commerce, the definitive removal from the channels of commerce or the destruction of goods which infringe a trademark right, as well as, in appropriate cases, materials and implements principally used in the manufacture of those goods. Those measures shall be carried out at the expense of the infringer, unless there particular reasons for not doing so. In considering a request as referred to in this paragraph, the proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.
2. The provisions of national law relating to steps to preserve rights and the enforcement of judgments and officially recorded acts shall apply.
3. Insofar as not provided for by national law and at the request of the proprietor of a trademark, the courts may, under this provision, issue an interlocutory injunction against the alleged infringer or against an intermediary whose services are used by a third party to infringe a trademark right, in order to:
  - a. prevent any imminent infringement of a trademark right, or
  - b. forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment, the continuation of the alleged infringements of a trademark right, or
  - c. make continuation of the alleged infringements subject to the lodging of guarantees intended to ensure the compensation of the proprietor of the trademark.
4. At the request of the proprietor of a trademark in proceedings concerning an infringement of his rights, the courts may order the party infringing the proprietor's right to provide the proprietor with all information available concerning the origin and distribution networks of the goods and services which have infringed the trademark and to provide him with all the data relating thereto, insofar as this measure seems justified and proportionate.
5. The order referred to in paragraph 4 may also be issued against anyone who is in possession of the infringing goods on a commercial scale, who has used the infringing services on a commercial scale or who has provided, on a commercial scale, services used in infringing activities.
6. The courts may, at the request of the proprietor of a trademark, issue an injunction for the cessation of services against intermediaries whose services are used by a third party to infringe its trademark right.
7. The courts may order, at the request of the claimant and at the expense of the infringer, that appropriate measures be taken to disseminate information concerning the decision.

#### **Article 2.23 Limitation of the effects of the exclusive right**

1. A trademark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:
  - a. the name or address of the third party, where that third party is a natural person;
  - b. signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services;
  - c. the trademark for the purpose of identifying or referring to goods or services as those of the proprietor of that trademark, in particular, where the use of the trademark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts;provided that such use is made in accordance with honest practices in industrial or commercial matters.
2. A trademark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality, if that right is recognised by the law of one of the Benelux countries and the use of that right is within the limits of the territory in which it is recognised.



3. A trademark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the European Economic Area under that trademark by the proprietor or with the proprietor's consent, unless there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

#### **Article 2.23bis Genuine use of the trademark**

1. If, within a period of five years following the date of the completion of the registration procedure, the proprietor has not put the trademark to genuine use in the Benelux territory in connection with the goods or services in respect of which it is registered, or if such use has been suspended during a continuous five-year period, the trademark shall be subject to the limits and sanctions provided for in Article 2.16bis (1) and (2) 2.23ter, 2.27 (2) and 2.30quinquies (3) and (4), unless there are proper reasons for non-use.
2. In the case referred to in Article 2.8 (2), the five-year period referred to in paragraph 1 shall be calculated from the date when the mark can no longer be subject of a refusal on absolute grounds or an opposition or, in the event that a refusal has been issued or an opposition has been lodged, from the date when a decision decision lifting the Office's objections on absolute grounds or terminating the opposition proceedings became final or the opposition was withdrawn.
3. With regard to international trademarks having effect in the Benelux territory, the five-year period referred to in paragraph 1 shall be calculated from the date when the mark can no longer be subject to refusal or opposition. Where an opposition has been lodged or when a refusal on absolute grounds has been notified, the period shall be calculated from the date when a decision terminating the opposition proceedings or a ruling on absolute grounds for refusal became final or the opposition was withdrawn.
4. The date of commencement of the five-year period, as referred to in paragraphs 1 and 2, shall be entered in the register.
5. The following shall also constitute use within the meaning of paragraph 1:
  - a. use of the trademark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trademark in the form as used is also registered in the name of the proprietor;
  - b. affixing of the trademark to goods or to the packaging thereof in the Benelux territory solely for export purposes.
6. Use of the trademark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

#### **Article 2.23ter Non-use as defence in infringement proceedings**

The proprietor of a trademark shall be entitled to prohibit the use of a sign only to the extent that the proprietor's rights are not liable to be revoked pursuant to Article 2.27 (2) to (5) at the time the infringement action is brought. If the defendant so requests, the proprietor of the trademark shall furnish proof that, during the five-year period preceding the date of bringing the action, the trademark has been put to genuine use as provided in Article 2.23bis in connection with the goods or services in respect of which it is registered and which are cited as justification for the action, or that there are proper reasons for non-use, provided that the registration procedure of the trademark has at the date of bringing the action been completed for not less than five years.

#### **Article 2.23quater Intervening right of the proprietor of a later registered trademark as defence in infringement proceedings**

1. In infringement proceedings, the proprietor of a trademark shall not be entitled to prohibit the use of a later registered mark where that later trademark would not be declared invalid pursuant to Article 2.30quinquies (3), Article 2.30sexies or Article 2.30septies (1).
2. In infringement proceedings, the proprietor of a trademark shall not be entitled to prohibit the use of a later registered EU trademark where that later trademark would not be declared invalid pursuant to Article 60 (1), (3) or (4), Article 61 (1) or (2) or Article 64 (2) of the European Union trade mark regulation.
3. Where the proprietor of a trademark is not entitled to prohibit the use of a later registered trademark pursuant to paragraph 1 or 2, the proprietor of that later registered trademark shall not be entitled to prohibit the use of the earlier trademark in infringement proceedings, even though that earlier right may no longer be invoked against the later trademark.

## Article 2.24

Repealed

## Chapter 6. Termination of the right

### Article 2.25 Surrender

1. The proprietor of a Benelux trademark may surrender its registration at any time.
2. However, if a license has been recorded, registration of the trademark may be surrendered only at the joint request of the proprietor of the trademark and the licensee. The provisions of the preceding sentence shall apply where a right in rem or a levy of execution has been recorded.
3. Surrender shall have effect for the whole of Benelux territory.
4. Renunciation of the protection resulting from an international filing, which is restricted to part of Benelux territory, shall have effect for the whole of the territory, notwithstanding any statement to the contrary by the proprietor.
5. Surrender may be restricted to one or more of the goods or services for which the trademark is registered.

### Article 2.26 Lapse of the right

The right to a trademark shall lapse:

- a. through surrender or expiry of the trademark's registration;
- b. through cancellation or expiry of the international registration, or through renunciation of protection for Benelux territory or, in accordance with the provisions of Article 6 of the Madrid Agreement and Madrid Protocol, as a result of the fact that the trademark no longer benefits from legal protection in the country of origin.
2. Repealed
3. Repealed

### Article 2.27 Revocation of the right

1. A trademark shall be liable to revocation if, after the date on which it was registered:
  - a. as a result of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered;
  - b. as a result of the use made of it by the proprietor of the trademark or with the proprietor's consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
2. A trademark shall also be liable to revocation if no genuine use has been made of it in accordance with Article 2.23bis.
3. Revocation of the right in a trademark in accordance with paragraph 2, may no longer be invoked where, during the interval between expiry of the five-year period referred to in Article 2.23bis and submission of the claim for revocation, genuine use of the trademark has been started or resumed. However, commencement or resumption of use within a period of three months prior to submission of the claim for revocation shall be disregarded where preparations for the commencement or resumption occur only after the holder becomes aware that the claim may be filed;
4. The proprietor of the right in a trademark whose revocation can no longer be invoked under paragraph 3, shall have no grounds under Article 2.20 (1) (a), (b) and (c) to contest the use of a trademark filed during the period in which the prior right in the trademark could have been revoked pursuant to paragraph 2.

5. The proprietor of the right in a trademark whose revocation can no longer be invoked under paragraph 3 may not, on the basis of the provisions of Article 2.28 (2), claim invalidity of the registration of a trademark filed during the period in which the prior right in the trademark could have been revoked pursuant to paragraph 2.

#### Chapter 6bis. Invalidation or revocation action filed before the courts

##### Article 2.28 Invocation of invalidity or revocation before the courts

1. Invalidity on absolute grounds may be invoked by any interested party, including the Public Prosecutor.
2. Invalidity on relative grounds may be invoked by any interested party where the proprietor of the earlier trademark referred to in Article 2.2ter (1) and (3) (a) or (b) or the person who, under the applicable law, is entitled to exercise the rights referred to in Article 2.2ter (3) (c), participates in the proceedings.
3. When an action for invalidation pursuant to paragraph 1 is brought by the Public Prosecutor, only the courts of Brussels, the Hague and Luxembourg shall have jurisdiction. Action brought by the Public Prosecutor shall stay any other action brought on the same grounds.
4. Revocation of the right in a trademark may be invoked by any interested party.

##### Article 2.29

Repealed

##### Article 2.30

Repealed

#### Chapter 6ter. Invalidation or revocation action filed with the Office

##### Article 2.30bis Lodging of the application

1. An application for invalidation or revocation of the registration of a trademark may be filed with the Office:
  - a. based on the absolute grounds for invalidity referred to in Article 2.2bis and on the grounds for revocation referred to in Article 2.27, by any natural or legal person and any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers of services, traders or consumers, and which, under the terms of the law governing it, has the capacity to sue in its own name and to be sued;
  - b. based on the relative grounds for invalidity referred to in Article 2.2ter:
    - i. in the cases referred to in Article 2.2ter (1) and (3) (a), by the proprietors of earlier trademarks and the licensees authorised by those proprietors;
    - ii. in the case referred to in Article 2.2ter (3) (b), by the proprietors of trademarks referred to therein. In this case, the assignment referred to in Article 2.20ter (1) (b), may also be requested;
    - iii. in the case referred to in Article 2.2ter (3) (c), by persons authorised, under the applicable law, to exercise these rights.
2. An application for invalidation or revocation is deemed to have been lodged only after payment of the applicable fees.

#### **Article 2.30ter Course of the proceedings**

1. The Office will process the application for invalidation or revocation within a reasonable timeframe in accordance with the provisions of the implementing regulations and shall respect the principle that both sides should be heard.
2. The procedure shall be suspended:
  - a. where the application is based on Article 2.30bis (1) (b) (i) and the earlier trademark:
    - i. has not yet been registered;
    - ii. was registered without delay in accordance with Article 2.8 (2) and is the subject of proceedings for refusal on absolute grounds or opposition;
    - iii. is the subject of an action for invalidation or revocation;
  - b. where the application is based on Article 2.30bis (1) (b) (iii), when it is based on an application for a designation of origin or geographical indication, until a final decision has been taken on it;
  - c. if the challenged trademark:
    - i. has not yet been registered;
    - ii. was registered without delay in accordance with Article 2.8 (2) and is the subject of proceedings for refusal on absolute grounds or opposition;
    - iii. is the subject of a judicial action for invalidation or revocation;
  - d. at the joint request of the parties;
  - e. if other circumstances justify such a suspension.
3. The procedure shall be closed:
  - a. if the applicant has lost the capacity to act;
  - b. if the defendant does not respond to the application lodged. In this case, the registration shall be cancelled;
  - c. if the application has become without cause, either because it has been withdrawn, or because the registration against which the application is directed has become without effect;
  - d. if the application is based on Article 2.30bis (1) (b), and the earlier trademark or earlier right is no longer valid;
  - e. if the application is based on Article 2.30bis (1) (b) (i), and the applicant has not produced within the prescribed period proof of use of his earlier trademark as referred to in Article 2.30quinquies;In these situations, part of the fees paid shall be refunded.
4. After the examination of the application for invalidation or revocation is completed, the Office shall reach a decision as soon as possible. If the application is held to be justified, the Office shall fully or partially cancel the registration or shall decide to record in the Register the transfer referred to in Article 2.20ter (1) (b). Otherwise, the application shall be rejected. The Office will inform the parties in writing and without delay, and will mention the right of appeal against this decision contained in Article 1.15bis. The decision of the Office will become final only once it is no longer subject to appeal. The Office will not be a party to any appeal against its decision.
5. Costs shall be borne by the unsuccessful party. They shall be fixed in accordance with the provisions of the implementing regulations. Costs shall not be due if the application is only partially successful. The Office's decision concerning costs shall constitute an enforceable order. Its forced execution shall be governed by the rules in force in the State where it takes place.

#### **Article 2.30quater Application for invalidation or revocation of international filings**

1. An application for invalidation or revocation may be lodged with the Office against an international filing for which protection in the Benelux territory has been requested. Articles 2.30bis and 2.30ter apply accordingly.
2. The Office shall inform the International Bureau of the application submitted, in writing and without delay, mentioning the provisions of Articles 2.30bis and 2.30ter, as well as the related provisions in the implementing regulations.

**Article 2.30quinquies Non-use as a defence in proceedings seeking a declaration of invalidity**

1. In proceedings for a declaration of invalidity based on a registered trademark with an earlier filing date or priority date, if the proprietor of the later trademark so requests, the proprietor of the earlier trademark shall furnish proof that, during the five-year period preceding the date of the application for a declaration of invalidity, the earlier trademark has been put to genuine use, as provided for in Article 2.23bis, in connection with the goods or services in respect of which it is registered and which are cited as justification for the application, or that there are proper reasons for non-use, provided that the registration process of the earlier trademark has at the date of the application for a declaration of invalidity been completed for not less than five years.
2. Where, at the filing date or date of priority of the later trademark, the five-year period within which the earlier trademark was to have been put to genuine use, as provided for in Article 2.23bis, had expired, the proprietor of the earlier trademark shall, in addition to the proof required under paragraph 1 of this Article, furnish proof that the trademark was put to genuine use during the five-year period preceding the filing date or date of priority, or that proper reasons for non-use existed.
3. In the absence of the proof referred to in paragraphs 1 and 2, an application for a declaration of invalidity on the basis of an earlier trademark shall be rejected.
4. If the earlier trademark has been used in accordance with Article 2.23bis in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the application for a declaration of invalidity, be deemed to be registered in respect of that part of the goods or services only.
5. Paragraphs 1 to 4 of this Article shall also apply where the earlier trademark is an EU trademark. In such a case, genuine use of the EU trademark shall be determined in accordance with Article 18 of the European Union trade mark regulation.

**Article 2.30sexies Lack of distinctive character or of reputation of an earlier trademark precluding a declaration of invalidity of a registered trademark**

An application for a declaration of invalidity on the basis of an earlier trademark shall not succeed at the date of application for invalidation if it would not have been successful at the filing date or the priority date of the later trademark for any of the following reasons:

- a. the earlier trademark, liable to be declared invalid pursuant to Article 2.2bis (1) (b), (c) or (d), had not yet acquired a distinctive character as referred to in Article 2.2bis (3);
- b. the application for a declaration of invalidity is based on Article 2.2ter (1) (b) and the earlier trademark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of Article 2.2ter (1) (b);
- c. the application for a declaration of invalidity is based on Article 2.2ter (3) (a) and the earlier trademark had not yet acquired a reputation within the meaning of Article 2.2ter (3) (a).

**Article 2.30septies Preclusion of a declaration of invalidity due to acquiescence**

1. Where the proprietor of an earlier trademark as referred to in Article 2.2ter (2) or (3) (a) has acquiesced, for a period of five successive years, in the use of a later registered trademark while being aware of such use, that proprietor shall no longer be entitled on the basis of the earlier trademark to apply for a declaration that the later trademark is invalid in respect of the goods or services for which the later trademark has been used, unless registration of the later trademark was applied for in bad faith.
2. In the case referred to in paragraph 1, the proprietor of a later registered trademark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later trademark.

#### **Article 2.30octies Invocation of invalidity or revocation of a trademark on which seniority has been claimed**

Where the seniority of a trademark registered under this convention, which has been surrendered or allowed to lapse, is claimed for an EU trademark, the invalidity or revocation of the trademark providing the basis for the seniority claim may be established a posteriori, provided that the invalidity or revocation could have been declared at the time the mark was surrendered or allowed to lapse.

#### **Article 2.30nonies Significance of invalidity and revocation**

1. Invalidity or revocation shall apply to the sign constituting the trademark in its entirety.
2. An application for a declaration of invalidity or revocation may be directed against some or all of the goods or services for which the contested trademark is registered and may be based on one or more earlier rights, provided that they all belong to the same proprietor.
3. Where a ground for invalidity or revocation of a trademark exists in respect of only some of the goods or services for which that trademark has been registered, invalidity or revocation shall cover those goods or services only.
4. A registered trademark shall be deemed not to have had, as from the date of the application for revocation, the effects specified in this convention, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.
5. A registered trademark shall be deemed not to have had, as from the outset, the effects specified in this convention, to the extent that the trademark has been declared invalid.

### **Chapter 7. Trademarks as objects of property**

#### **Article 2.31 Transfer**

1. A trademark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered.
2. The following shall be null and void:
  - a. assignments between living persons not laid down in writing;
  - b. assignments or other transfers not made for the whole of Benelux territory.
3. A transfer of the whole of the undertaking shall include the transfer of the trademark except where there is agreement to the contrary or circumstances clearly dictate otherwise. This provision shall apply to the contractual obligation to transfer the undertaking.

#### **Article 2.32 Licence**

1. A trademark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Benelux territory. A licence may be exclusive or non-exclusive.
2. The proprietor of a trademark may invoke the rights conferred by that trademark against a licensee who contravenes any provision in his licensing contract with regard to:
  - a. its duration;
  - b. the form covered by the registration in which the trademark may be used;
  - c. the scope of the goods or services for which the licence is granted;
  - d. the territory in which the trademark may be affixed; or
  - e. the quality of the goods manufactured or of the services provided by the licensee.
3. Entry of a licence in the register may be cancelled only at the joint request of the proprietor of the trademark and the licensee.

4. Without prejudice to the provisions of the licensing contract, the licensee may bring proceedings for infringement of a trademark only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trademark, after formal notice, does not himself bring infringement proceedings within an appropriate period.
5. The licensee shall have the right to intervene in an action brought by the proprietor of the trademark, as referred to in Article 2.21 (1) to (4), in order to obtain compensation for damages directly incurred by him or to be allocated a proportion of the profit made by the defendant.
6. The licensee may bring independent action as referred to in the preceding paragraph only if he has obtained the permission of the proprietor of the trademark for that purpose.
7. The licensee shall be authorized to exercise the powers referred to under Article 2.22 (1), provided that these are in order to protect the rights which he has been permitted to exercise and provided that it has obtained permission from the proprietor of the trademark for that purpose.

#### **Article 2.32bis Rights in rem and levy of execution**

1. A trademark may, independently of the undertaking, be given as security or be the subject of rights in rem.
2. A trademark may be levied in execution.

#### **Article 2.33 Opposability against third parties**

The assignment or other transfer or the licence shall become opposable against third parties only after recordal of an extract from the document establishing this or a corresponding declaration signed by the parties involved in the manner specified by the implementing regulations and following payment of the fees due. The provision in the preceding sentence shall apply to rights in rem and levy of execution as referred to in Article 2.32bis.

#### **Article 2.33bis Applications for a trademark as an object of property**

Articles 2.31 to 2.33 shall apply to applications for trademarks.

### **Chapter 8. Collective marks**

#### **Article 2.34bis Collective marks**

1. A collective mark is a trademark which is described as such when the mark is applied for and is capable of distinguishing the goods or services of the members of an association which is the proprietor of the mark from the goods or services of other undertakings. Associations of manufacturers, producers, suppliers of services or traders, which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations, to make contracts or accomplish other legal acts, and to sue and be sued, as well as legal persons governed by public law, may apply for collective marks.
2. By way of derogation from Article 2.2bis (1) (c), signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective marks. Such a collective mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, such signs or indications, provided that third party uses them in accordance with honest practices in industrial or commercial matters. In particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.
3. Unless provided otherwise in this chapter, collective marks shall be subject to all the provisions of this convention that apply to trademarks.

#### **Article 2.34ter Regulations governing use of a collective mark**

1. An applicant for a collective mark shall submit regulations governing use with the application.
2. However, in the case of an international filing, the applicant shall have a period of six months following notification of the international registration provided for by Article 3 (4) of the Madrid Agreement and Madrid Protocol to file those regulations.
3. The regulations governing use shall specify at least the persons authorised to use the mark, the conditions of membership of the association and the conditions of use of the mark, including sanctions. The regulations governing use of a mark referred to in Article 2.34bis (2) shall authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.

#### **Article 2.34quater Refusal of an application**

1. In addition to the grounds for refusal provided for in Article 2.2bis, with the exception of Article 2.2bis (1) (c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, an application for a collective mark shall be refused where the provisions of Article 2.34bis or 2.34ter are not satisfied, or where the regulations governing use of that collective mark are contrary to public policy or to accepted principles of morality.
2. An application for a collective mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.
3. An application shall not be refused if the applicant, as a result of amendment of the regulations governing use of the collective mark, meets the requirements referred to in paragraphs 1 and 2.

#### **Article 2.34quinquies Use of collective marks**

The requirements of Article 2.23bis shall be satisfied where genuine use of a collective mark in accordance with that Article is made by any person who has authority to use it.

#### **Article 2.34sexies Amendments to the regulations governing use of a collective mark**

1. The proprietor of a collective mark shall submit to the Office any amended regulations governing use.
2. Amendments to the regulations governing use shall be mentioned in the register unless the amended regulations do not satisfy the requirements of Article 2.34ter or involve one of the grounds for refusal referred to in Article 2.34quater.
3. For the purposes of this convention, amendments to the regulations governing use shall take effect only from the date of entry of the mention of those amendments in the register.

#### **Article 2.34septies Persons entitled to bring an action for infringement**

1. Article 2.32 (4) and (5) shall apply to every person who has the authority to use a collective mark.
2. The proprietor of a collective mark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where those persons have sustained damage as a result of unauthorised use of the mark.



#### **Article 2.34octies Additional grounds for revocation**

In addition to the grounds for revocation provided for in Article 2.27, the rights of the proprietor of a collective mark shall be revoked on the following grounds:

- a. the proprietor does not take reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use laid down in the regulations governing use, including any amendments thereto mentioned in the register;
- b. the manner in which the mark has been used by authorised persons has caused it to become liable to mislead the public in the manner referred to in Article 2.34quater (2);
- c. an amendment to the regulations governing use of the mark has been mentioned in the register in breach of Article 2.34 sexies (2), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of that Article.

#### **Article 2.34nonies Additional grounds for invalidity**

In addition to the grounds for invalidity provided for in Article 2.2bis, with the exception of Article 2.2bis (1) (c) concerning signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, and Article 2.2ter, a collective mark which is registered in breach of Article 2.34quater shall be declared invalid unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of Article 2.34quater.

### **Chapter 8bis. Certification marks**

#### **Article 2.35bis Certification marks**

1. An certification mark is a trademark which is described as such when the mark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, with the exception of geographical origin, from goods and services which are not so certified.
2. Any natural or legal person, including institutions, authorities and bodies governed by public law, may apply for certification marks provided that such person does not carry on a business involving the supply of goods or services of the kind certified.
3. Unless provided otherwise in this chapter, certification marks shall be subject to all the provisions of this convention that apply to trademarks.

#### **Article 2.35ter Regulations governing use of a certification mark**

1. An applicant for a certification mark shall submit regulations governing use with the application.
2. However, in the case of an international filing, the applicant shall have a period of six months following notification of the international registration provided for by Article 3 (4) of the Madrid Agreement and Madrid Protocol to file those regulations.
3. The regulations governing use shall specify the persons authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark. Those regulations shall also specify the conditions of use of the mark, including sanctions.

#### **Article 2.35quater Refusal of the application**

1. In addition to the grounds for refusal provided for in Article 2.2bis, an application for a certification mark shall be refused where the conditions set out in Articles 2.35bis and 2.35ter are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.
2. An application for an certification mark shall also be refused if the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.
3. An application shall not be refused if the applicant, as a result of an amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.

#### **Article 2.35quinquies Use of the certification mark**

The requirements of Article 2.23bis shall be satisfied where genuine use of a certification mark in accordance with that Article is made by any person who has authority to use pursuant to the regulations governing use referred to in Article 2.35ter.

#### **Article 2.35sexies Amendment of the regulations governing use of the mark**

1. The proprietor of a certification mark shall submit to the Office any amended regulations governing use.
2. Amendments shall not be mentioned in the register where the regulations as amended do not satisfy the requirements of Article 2.35ter or involve one of the grounds for refusal referred to in Article 2.35quater.
3. For the purposes of this convention, amendments to the regulations governing use shall take effect only as from the date of entry of the mention of the amendment in the register.

#### **Article 2.35septies Transfer**

By way of derogation from Article 2.31 (1), a certification mark may only be transferred to a person who meets the requirements of Article 2.35bis (2).

#### **Article 2.35octies Persons who are entitled to bring an action for infringement**

1. Only the proprietor of a certification mark, or any person specifically authorised by him to that effect, shall be entitled to bring an action for infringement.
2. The proprietor of a certification mark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where they have sustained damage as a consequence of unauthorised use of the mark.

#### **Article 2.35nonies Additional grounds for revocation**

In addition to the grounds for revocation provided for in Article 2.27, the rights of the proprietor of a certification mark shall be revoked on the following grounds:

- a. the proprietor no longer complies with the requirements set out in Article 2.35bis (2);
- b. the proprietor does not take reasonable steps to prevent the certification mark being used in a manner that is incompatible with the conditions of use laid down in the regulations governing use, including any amendments thereto mentioned in the register;
- c. the manner in which the certification mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in Article 2.35quater (2);
- d. an amendment to the regulations governing use of the certification mark has been mentioned in the register in breach of Article 2.35sexies (2), unless the proprietor of the mark, by further amending the regulations governing use, complies with the requirements of that Article.

#### **Article 2.35decies Additional grounds for invalidity**

In addition to the grounds for invalidity provided for in Articles 2.2bis and 2.2ter, a certification mark which is registered in breach of Article 2.35quater shall be declared invalid, unless the proprietor of the mark, by amending the regulations governing use, complies with the requirements of Article 2.35quater.

#### **Chapter 9.** *(Repealed)*

#### **Article 2.45**

Repealed

#### **Article 2.46**

Repealed

#### **Article 2.47**

Repealed

## TITLE III: DESIGNS

### Chapter 1. Designs

#### Article 3.1 Designs

1. A design shall be protected to the extent that it is new and has individual character.
2. The appearance of the whole or a part of a product shall be regarded as a design.
3. The appearance of a product shall be imparted, in particular, through the features of the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.
4. A product shall mean any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces. Computer programs shall not be regarded as a product.

#### Article 3.2 Exception

1. The following shall be excluded from the protection provided for by this title:
  - a. the features of appearance of a product which are solely dictated by its technical function.
  - b. the features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.
2. Notwithstanding paragraph 1 (b), the features of appearance of a product serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system shall be protected as a design, under the conditions laid down in Article 3.1 (1).

#### Article 3.3 Novelty and individual character

1. A design shall be considered new if no identical design has been made available to the public before the date of filing of the application or the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.
2. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing or the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.
3. In order to assess novelty and individual character, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Community or the European Economic Area, before the date of filing or the date of priority. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.

4. In order to assess novelty and individual character, a disclosure shall not be taken into consideration if a design for which protection is claimed under a registered design right has been made available to the public during the 12-month period preceding the date of filing of the application or the date of priority:
  - a. by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer, or his successor in title; and
  - b. if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.
5. Right of priority shall mean the right provided for under Article 4 of the Paris Convention. This right may be claimed by anyone who properly submits an application for a design or utility model in one of the countries which is a party to the said Convention or the TRIPS Agreement.

#### **Article 3.4      Parts of complex products**

1. A design applied to or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:
  - a. if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and
  - b. to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.
2. For the purposes of this title, complex product shall mean a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.
3. Normal use within the meaning of paragraph 1 shall mean use by the end user, excluding maintenance, servicing or repair work.

#### **Article 3.5      Acquisition of rights**

1. Without prejudice to the right of priority, the exclusive right in a design shall be acquired by registration of the application that has been filed in Benelux territory with the Office (Benelux filing) or with the International Bureau (international filing).
2. Where two or more filings are made for the same design, if the first filing is not followed by the publication provided for by Article 3.11 (2) of this convention or Article 6 (3) of the Hague Agreement, the succeeding filing shall acquire the status of first filing.

#### **Article 3.6      Restrictions**

Within the limits of Articles 3.23 and 3.24 (2), registration shall not grant the right to a design where:

- a. the design is in conflict with a prior design which has been made available to the public after the date of filing or the date of priority, and which is protected from a date prior to the said date by an exclusive right deriving from a Community design, the registration of a Benelux filing, or an international filing;
- b. a prior trademark is used in the design without the consent of proprietor of that trademark;
- c. a work protected by copyright is used in the design without the consent of the copyright owner;
- d. the design constitutes an improper use of any of the items listed in Article 6ter of the Paris Convention;
- e. the design is contrary to public policy or to accepted principles of morality in one of the Benelux countries;
- f. the filing does not sufficiently reveal the features of the design.

### Article 3.7 Claim of the application

1. During a period of five years following publication of the registration of a filing, the designer of the design or the person who, under to Article 3.8, is deemed to be the designer, may claim the right to the Benelux application or the rights in Benelux territory deriving from the international filing of that design, if the filing was made by a third party without the designer's consent; the designer may on the same grounds and at any time invoke the invalidity of the registration of the filing or of the rights referred to. The action to claim shall be registered with the Office at the claimant's request in the manner laid down by the implementing regulations and on payment of the fees due.
2. If the applicant referred to in paragraph 1 has requested the total or partial surrender of the registration of the Benelux filing or has renounced the rights in Benelux territory deriving from an international filing, such surrender or renunciation shall, subject to paragraph 3, not have effects vis-à-vis the designer or the person deemed to be the designer under Article 3.8, provided that the filing has been claimed within one year from the date of publication of the surrender or renunciation and before the expiry of the five-year period referred to in paragraph 1.
3. If, during the interval between the surrender or renunciation referred to in paragraph 2 and the registration of the action to claim, a third party, acting in good faith, has exploited a product that is identical in appearance or that does not produce a different overall impression on an informed user, that product shall be considered to have been lawfully put on the market.

### Article 3.8 Rights of employers and commissioning parties

1. If a design has been developed by an employee in the execution of his duties, the employer shall, unless otherwise agreed, be deemed to be the designer.
2. If a design has been created on commission, the commissioning party shall, unless specified otherwise, be deemed to be the designer, provided that the commission was given with a view to commercial or industrial use of the product in which the design is incorporated.

## Chapter 2. Filing, registration and renewal

### Article 3.9 Filing

1. A Benelux application for designs shall be filed, either with the national administrations or with the Office, in the manner specified by the implementing regulations and against payment of the fees due. A Benelux application may comprise either a single design (single filing) or several (multiple filing). A check shall be made to ensure that the documents produced satisfy the conditions specified for fixing the filing date and the filing date shall be fixed. The applicant shall be informed, without delay and in writing, of the date of filing or, where applicable, of the grounds for not fixing a filing date.
2. If other provisions of the implementing regulations are not satisfied at the time of filing, the applicant shall be informed without delay and in writing of the conditions which are not fulfilled and shall be given the opportunity to respond.
3. The application shall have no further effect if the provisions of the implementing regulations are not satisfied within the period granted.
4. Where filing takes place with a national administration, the national administration shall forward the Benelux application to the Office, either without delay after receiving the application or after establishing that the application satisfies conditions specified in paragraphs 1 to 3.
5. Without prejudice in the case of Benelux filings to the application of Article 3.13, filings of designs may not be the subject, as far as substance is concerned, of any examination giving rise to findings which could be binding on the applicant by the Office.

#### **Article 3.10 Claiming priority**

1. A right of priority shall be claimed at the time of filing or in the month following filing, by means of a special declaration submitted to the Office in the manner laid down by the implementing regulations and against payment of the fees due.
2. If no such claim is made, the right of priority shall lapse.

#### **Article 3.11 Registration**

1. The Office shall register, without delay, Benelux filings and also international filings which have been the subject of publication in the "Bulletin International des dessins ou modèles – International Design Gazette" and in respect of which the applicants have requested that these should have effect in Benelux territory.
2. Without prejudice to the provisions of Articles 3.12 and 3.13, the Office shall publish registrations of Benelux filings in accordance with the implementing regulations as soon as possible.
3. If the publication does not sufficiently disclose the features of the design, the applicant may request the Office to make another publication within the period specified for the purpose without charge.
4. Following publication of a design, the public may inspect the registration and the documents produced at the time of filing.

#### **Article 3.12 Deferment of publication on request**

1. When making a Benelux filing, the applicant may request that publication of the registration be deferred for a period of not more than twelve months from the date of filing or the date on which the right of priority arises.
2. If the applicant makes use of the possibility provided for under paragraph 1, the Office shall defer publication in accordance with the request.

#### **Article 3.13 Contraventions of public policy and morality**

1. The Office shall defer publication if it considers that the design falls within the scope of Article 3.6 (e).
2. The Office shall notify the applicant of this and invite it to withdraw the application within a period of two months.
3. If the party in question has not withdrawn the application on the expiry of that period, the Office shall refuse to publish the registration. The Office shall inform the applicant in writing and without delay, indicating the reasons for the refusal to publish and mentioning the right of appeal against this decision contained in Article 1.15bis.
4. The refusal to publish shall become final only once the decision of the Office is no longer subject to appeal. This will result in the nullity of the application.

#### **Article 3.14 Term and renewal of registration**

1. Benelux filings shall be registered for a term of five years from the date of filing. Without prejudice to the provisions of Article 3.24 (2), the design to which a filing relates may not be modified either during the term of the registration or at the time of renewal.
2. The registration may be renewed for four successive periods of five years up to a maximum of 25 years.
3. Renewal shall be effected by payment of the fee specified for that purpose. This fee must be paid during the twelve months preceding expiry of the registration; it may still be paid during the six months following the expiry date of the registration, subject to simultaneous payment of an additional fee. Renewal shall have effect from expiry of the registration.
4. Renewal may be restricted to only part of the designs included in a multiple filing.
5. Six months before expiry of the first to the fourth periods of registration, the Office shall provide a reminder of that expiry date by means of notification addressed to the holder of the design and to third parties whose rights in the design have been entered in the register.

6. Office reminders shall be sent to the last known address of the interested parties. Failure to send or receive such notices shall not constitute dispensation from the obligations resulting from paragraph 3. It may not be invoked either in court proceedings or against the Office.
7. The Office shall register renewals and publish them in accordance with the implementing regulations.

#### **Article 3.15 International filings**

International filings shall be made in accordance with the provisions of the Hague Agreement.

### **Chapter 3. Rights of the holder**

#### **Article 3.16 Scope of protection**

1. Without prejudice to the application of ordinary law relating to civil liability, the exclusive right in a design shall allow its right holder to challenge the use of a product in which the design is incorporated or on which the design is applied, which has an identical appearance to the design as filed, or which does not produce a different overall impression on an informed user, taking into consideration the designer's degree of freedom in developing the design.
2. Use shall cover, in particular, the making, offering, putting on the market, sale, delivery, hire, importing, exporting, exhibiting, or using or stocking for one of those purposes.

#### **Article 3.17 Compensation for damages and other actions**

1. The exclusive right shall allow the holder to claim compensation for the acts listed in Article 3.16 only if those acts took place after the publication referred to in Article 3.11, adequately disclosing the features of the design.
2. The court which sets the damages:
  - a. shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any unfair profits made by the infringer and, in appropriate cases, elements other than economic factors, such as the moral prejudice caused to the holder of the exclusive right in a design as a result of the infringement; or
  - b. as an alternative to (a), it may, in appropriate cases, set the damages as a lump sum on the basis of elements such as at least the amount of royalties or fees which would have been due if the infringer had requested authorization to use the design.
3. Furthermore, the court may order, at the request of the holder of the exclusive right in a design and by way of compensation, that ownership of goods which infringe a design right, as well as, in appropriate cases, the materials and implements principally used in the manufacture of those goods, be transferred to this holder; the court may order that the transfer shall only take place upon payment by the claimant of a sum which it shall fix.
4. In addition to or instead of the action for compensation, the holder of the exclusive right in a design may institute proceedings for transfer of the profits made following the use referred to in Article 3.16, and for the provision of accounts in this regard. The court shall reject the application if it considers that this use is not in bad faith or the circumstances of the case do not justify such an order.
5. The holder of the exclusive right in a design may institute proceedings for compensation or transfer of profits in the name of the licensee, without prejudice to the right granted to the licensee in Article 3.26 (4).
6. With effect from the filing date, reasonable compensation may be required from a party which, being aware of the filing, has engaged in acts such as those mentioned in Article 3.16, insofar as the holder has acquired exclusive rights in this regard.



### Article 3.18 Additional claims

1. Without prejudice to any damages due to the holder of the exclusive right in a design by reason of the infringement, and without compensation of any sort, the courts may order, at the request of the holder of the exclusive right in a design, the recall from the channels of commerce, the definitive removal from the channels of commerce or the destruction of goods which infringe a design right, as well as, in appropriate cases, materials and implements principally used in the manufacture of those goods. Those measures shall be carried out at the expense of the infringer, unless there particular reasons for not doing so. In considering a request as referred to in this paragraph, the proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.
2. The provisions of national law relating to steps to preserve rights and the enforcement of judgments and officially recorded acts shall apply.
3. Insofar as not provided for by national law and at the request of the holder of the exclusive right in a design, the courts may, under this provision, issue an interlocutory injunction against the alleged infringer or against an intermediary whose services are used by a third party to infringe a design right, in order to:
  - a. prevent any imminent infringement of a design right, or
  - b. forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment, the continuation of the alleged infringements of a design right, or
  - c. make continuation of the alleged infringements subject to the lodging of guarantees intended to ensure the compensation of the holder.
4. At the request of the holder of the exclusive right in a design in proceedings concerning an infringement of his rights, the courts may order the party infringing the holder's right to provide the holder with all information available concerning the origin and distribution networks of the goods and services which have infringed the design and to provide him with all the data relating thereto, insofar as this measure seems justified and proportionate.
5. The order referred to in paragraph 4 may also be issued against anyone who is in possession of the infringing goods on a commercial scale, who has used the infringing services on a commercial scale or who has provided, on a commercial scale, services used in infringing activities.
6. The courts may, at the request of the holder of the exclusive right in a design, issue an injunction for the cessation of services against intermediaries whose services are used by a third party to infringe its design right.
7. The courts may order, at the request of the claimant and at the expense of the infringer, that appropriate measures be taken to disseminate information concerning the decision.

### Article 3.19 Limitation of the effects of the exclusive right

1. The exclusive right to a design shall not imply the right to contest:
  - a. acts done privately and for non-commercial purposes;
  - b. acts done for experimental purposes;
  - c. acts of reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.
2. Furthermore, the exclusive right in a design shall not imply the right to contest:
  - a. the equipment on ships and aircraft registered in a third country when these temporarily enter the Benelux territory;
  - b. the importation in the Benelux territory of spare parts and accessories for the purpose of repairing such craft;
  - c. the execution of repairs on such craft.
3. The exclusive right in a design constituting a part of a complex product shall not imply the right to contest use of the design for the purposes of repair of that complex product in order to restore to its initial appearance.
4. The exclusive right in a design shall not imply the right to contest the acts mentioned in Article 3.16 relating to products which have been placed in circulation in one of the Member States of the European Community or European Economic Area, either by the holder or with the holder's consent, or the acts mentioned in Article 3.20.
5. Actions may not relate to products which were put on the market in Benelux territory prior to the filing.

#### **Article 3.20 Rights of prior use**

1. A right of prior use shall be recognized for third parties who, prior to the filing date for a design or to the priority date, manufactured on Benelux territory products that are identical in appearance to the design filed or that do not produce a different overall impression on an informed user.
2. The same right shall be recognized for those who, in the same conditions, have started to carry out their intention to manufacture.
3. However, this right shall not be recognized for third parties who have copied the design in question without the designer's consent.
4. The right of prior use shall permit the holder of it to continue or, in the circumstances referred to in paragraph 2, to undertake manufacture of those products and to carry out all the other acts mentioned in Article 3.16, notwithstanding the right deriving from the registration, with the exception of importing.
5. The right of prior use may be transferred only together with the business in which the acts which gave rise to it took place.

### **Chapter 4. Surrender, lapse and invalidity**

#### **Article 3.21 Surrender**

1. The holder of the registration of a Benelux filing may at any time request surrender of that registration, unless third parties have legal contractual rights which have been notified to the Office.
2. In the case of multiple filings, surrender may relate only to part of the designs included in the filing.
3. If a license has been recorded, registration of the design may be surrendered only at the joint request of the holder of the design and the licensee. The provisions of the previous sentence shall apply where a pledge or attachment has been recorded.
4. Surrender shall have effect for the whole of Benelux territory, notwithstanding any declaration to the contrary.
5. The rules laid down in this Article shall also apply to renunciation of the protection deriving for Benelux territory from an international filing.

#### **Article 3.22 Lapse of right**

Subject to the provisions of Article 3.7 (2), the exclusive right in a design shall lapse:

- a. through surrender or expiry of the registration of the Benelux filing;
- b. through expiry of the registration of the international filing or through renunciation of the rights for Benelux territory deriving from the international filing, or through ex officio cancellation of the international filing as referred to in Article 6 (4) (c), of the Hague Agreement.

#### **Article 3.23 Invalidation**

1. Any interested party, including the Public Prosecutor, may invoke the invalidity of the registration of a design if:
  - a. if the design does not correspond to the definition under Article 3.1 (2) and (3);
  - b. the design does not satisfy the conditions specified in Article 3.1 (1) and Articles 3.3 and 3.4;
  - c. the design falls within the scope of Article 3.2;
  - d. the registration does not grant a right in the design pursuant to Article 3.6 (e) or (f).
2. Only the applicant or the holder of an exclusive right in a design deriving from the registration of a Community design, a Benelux registration or an international filing may invoke the invalidity of the registration of the later filing of a design which is in conflict with its right, if registration of the filing does not grant the right in the design in accordance with Article 3.6 (a).
3. Only the holder of a prior trademark right or the owner of a prior copyright may invoke the invalidity of the registration of the Benelux filing or of the rights deriving for Benelux territory from an international filing of the design, if no right in the design has been acquired in accordance with Article 3.6 (b) or (c).

4. Only the interested party may invoke the invalidity of the registration of a design, if no right in the design has been acquired in accordance with Article 3.6 (d).
5. Only the designer of a design as referred to under Article 3.7 (1) may, in the conditions referred to under that Article, invoke the invalidity of the registration of the filing of a design made by a third party without his consent.
6. Registration of the filing of a design may be declared invalid even after the right has lapsed or been surrendered.
7. When an action for invalidation is brought by the Public Prosecutor, only the courts of Brussels, The Hague and Luxembourg shall have jurisdiction. Action brought by the Public Prosecutor shall stay any other action brought on the same grounds.

#### **Article 3.24 Scope of invalidity, surrender and renunciation**

1. Subject to the provisions of paragraph 2, invalidation, surrender and renunciation shall apply to the design in its entirety.
2. If the registration of the filing of a design may be invalidated in accordance with Article 3.6 (b), (c), (d) or (e), or Article 3.23 (1) (b) and (c), filing may be maintained in an amended form if, in that form, the design complies with the requirements for protection and the identity of the design is retained.
3. Maintenance as referred to in paragraph 2 may be understood as registration accompanied by a partial disclaimer by the holder or the registration or a court order which is no longer open to opposition or appeal or to reversal by a court of cassation declaring the partial invalidity of the right.

### **Chapter 5. Transfer, licence and other rights**

#### **Article 3.25 Transfer**

1. The exclusive right in a design may be transferred.
2. The following shall be null and void:
  - a. assignments between living persons not laid down in writing;
  - b. assignments or other transfers not made for the whole of Benelux territory.

#### **Article 3.26 Licence**

1. The exclusive right in a design may be the subject of a license.
2. The holder of a design right may invoke the exclusive right in a design against a licensee who contravenes the clauses of the licensing agreement in respect of its term, the form covered by the registration in which the design may be used, the products for which the licence is granted and the quality of the products put on the market by the licensee.
3. Entry of a licence in the register may be cancelled only at the joint request of the holder of the design right and the licensee.
4. The licensee shall have the right to act in an action brought by the holder of the exclusive right in a design, as mentioned in Article 3.17 (1) to (4), in order to obtain compensation for a prejudice directly incurred by him or to be allocated a proportion of the profit made by the defendant. The licensee may bring independent action as mentioned in Article 3.17 (1) to (4) only if it has obtained the permission of the holder of the exclusive right for that purpose.
5. The licensee shall be authorized to exercise the powers referred to under Article 3.18 (1), provided that these are in order to protect the rights which it has been permitted to exercise and provided that it has obtained permission from the holder of the exclusive right in a design for that purpose.

### **Article 3.27**    **Opposability against third parties**

The assignment or other transfer or the licence shall become opposable against third parties only after filing of an extract from the document establishing this or a corresponding declaration signed by the parties involved has been registered in the manner specified by the implementing regulations and following payment of the fees due. The provision in the preceding sentence shall apply to rights of pledge and attachments.

## **Chapter 6.**    **Cumulation with copyright**

### **Article 3.28**    **Cumulation**

1. Authorization given by the designer of a work protected by copyright to a third party to file a design in which that work is incorporated shall imply the assignment of the copyright attached to that work insofar as it is incorporated in the design.
2. The party filing a design shall be presumed also to be the owner of the copyright relating thereto; this presumption shall not, however, apply in respect of the true designer or his beneficiary.
3. The assignment of the copyright relating to a design shall result in the assignment of the right in the design and vice versa, without prejudice to the application of Article 3.25.

### **Article 3.29**    **Copyright of employers and commissioning parties**

Where a design is created in the circumstances referred to in Article 3.8, the copyright relating to the design shall belong to the party deemed to be the designer, in accordance with the provisions of that Article.

## TITLE IV: OTHER PROVISIONS

### Chapter 1. *(Repealed)*

#### Article 4.1

Repealed

#### Article 4.2

Repealed

#### Article 4.3

Repealed

### Chapter 2. **Other tasks of the Office**

#### Article 4.4 **Tasks**

In addition to the tasks entrusted to it by the preceding titles the Office shall be responsible for:

- a. making modifications to filings and registrations which are required by holders, or which result from notifications by the International Bureau or from court orders, and, where appropriate, informing the International Bureau of these;
- b. publishing registrations of Benelux filings of trademarks and designs, as well as all other reports required by the implementing regulations;
- c. issuing copies of registrations at the request of any interested party;
- d. Repealed.

#### Article 4.4bis **i-DEPOT**

1. The Office may provide proof under the heading 'i-DEPOT' of the existence of documents on the date of receipt thereof.
2. The documents will be retained on file by the Office for a certain period of time. This will take place on a strictly confidential basis, unless the party submitting the documents explicitly waives confidentiality.
3. The modalities of this service will be provided for in implementing regulations.

## Chapter 3. Jurisdiction

### Article 4.5 Settlement of disputes

1. Without prejudice to the provisions of Articles 2.14 and 2.30bis, only the courts shall have jurisdiction to rule upon actions brought on the grounds of this convention.
2. Inadmissibility deriving from absence of registration of the filing of a trademark or design shall be covered by registration or renewal of the trademark or design in the course of proceedings.
3. The court shall order ex officio the cancellation of registrations that have been declared invalid or revoked.

### Article 4.6 Territorial jurisdiction

1. Unless the territorial jurisdiction of the courts is expressly stated in a contract, this shall be determined in cases involving trademarks or designs by the address for service of the defendant or by the place where the obligation in dispute has arisen, or has been or should be executed. The place in which the trademark or design is filed or registered shall not under any circumstances be used as the sole basis for determining territorial jurisdiction.
2. Where the criteria mentioned above are insufficient to determine territorial jurisdiction, the petitioner may bring the case before the court of his address for service or residential address, or, if he has no address for service or residential address in Benelux territory, before the court of his choice, in either Brussels, the Hague or Luxembourg.
3. The courts shall apply ex officio the rules specified in paragraphs 1 and 2 and shall expressly confirm their jurisdiction.
4. The court before which the main claim is pending shall receive applications for warranty, applications for inclusion and related applications, as well as reconventional claims, unless it does not have jurisdiction over the matter.
5. The courts of one of the three countries shall, if one of the parties so requests, refer disputes brought before them to the courts of one of the other two countries where these disputes are already pending there or when they are associated with other disputes placed before these courts. Referral may only be requested when the actions are pending at first instance. This shall apply to the benefit of the first court in which an action is initially brought, unless another court has given a decision in the matter other than just an internal provision, in which case referral shall be to the other court.

## Chapter 4. Other provisions

### Article 4.7 Direct effect

Nationals of Benelux countries and nationals of countries that are not members of the Union established by the Paris Convention, who are resident in or who have a real and effective industrial or commercial establishment on Benelux territory may, in the context of this convention, claim application of the provisions of the Paris Convention, the Madrid Agreement and Madrid Protocol, the Hague Agreement and the TRIPS Agreement for their benefit throughout the said territory.

### Article 4.8 Other applicable rights

The provisions of this convention shall not adversely affect application of the Paris Convention, the TRIPS Agreement, the Madrid Agreement and Madrid Protocol, the Hague Agreement and the provisions of Belgian, Letzeburgisch or Dutch law giving rise to prohibitions on the use of a trademark.

#### **Article 4.8bis Applicable rights on trademarks and designs as objects of property**

1. A trademark or a design as an object of property shall be governed in its entirety, and for the whole Benelux territory, by the internal law of the Benelux country in which, according to the Register:
  - a. the proprietor had his seat or his domicile on the filing date of the application for registration;
  - b. where point (a) does not apply, the proprietor had an establishment on the filing date of the application for registration.
2. In cases which are not provided for by paragraph 1, the law of the Kingdom of the Netherlands shall apply.
3. If two or more persons are mentioned in the register as joint proprietors, paragraph 1 shall apply to the joint proprietor first mentioned; failing this, it shall apply to the subsequent joint proprietors in the order in which they are mentioned. Where paragraph 1 does not apply to any of the joint proprietors, paragraph 2 shall apply.

#### **Article 4.9 Fees and time limits**

1. All fees due in respect of operations carried out with the Office or by the Office shall be laid down in the implementing regulations.
2. All time limits applicable to operations carried out with the Office or by the Office which are not specified in this convention shall be laid down in the implementing regulations.

## TITLE V: TRANSITIONAL PROVISIONS

### Article 5.1 The Organization as successor to the Benelux Offices

1. The Organization shall be the successor to the Benelux Trademark Office established under Article 1 of the Benelux Convention Concerning Trademarks of March 19, 1962 and the Benelux Designs Office established under Article 1 of the Benelux Designs Convention of October 25, 1966. The Organization shall be the successor to the Benelux Trademark Office and the Benelux Designs Office in respect of all rights and all obligations with effect from the date on which this convention enters into force.
2. The Protocol relating to the legal personality of the Benelux Trademark Office and the Benelux Designs Office of November 6, 1981 shall be repealed with effect from the date on which this convention enters into force.

### Article 5.2 Repeal of the Benelux Conventions relating to trademarks and designs

The Benelux Convention Concerning Trademarks of March 19, 1962 and the Benelux Designs Convention of October 25, 1966 shall be repealed with effect from the date on which this convention enters into force.

### Article 5.3 Maintenance of existing rights

The rights which existed under the Uniform Benelux Law on Marks and the Uniform Benelux Designs Law respectively shall be maintained.

### Article 5.4 Initiation of opposition-related proceedings by class

Article III of the Protocol amending the Uniform Benelux Law on Marks of December 11, 2001 shall continue to apply.

### Article 5.5 First Implementing Regulations

As an exception to Article 1.9 (2), the Administrative council of the Benelux Trademark Office and the Administrative council of the Benelux Designs Office shall have the power jointly to establish the first implementing regulations.



## TITLE VI: FINAL PROVISIONS

### Article 6.1 Ratification

This convention shall be ratified. The ratification instruments shall be deposited with the Government of the Kingdom of Belgium.

### Article 6.2 Entry into force

1. Subject to paragraphs 2 and 3, this convention shall enter into force on the first day of the third month after the third ratification instrument has been deposited.
2. Repealed.
3. Article 5.5 shall apply on a provisional basis.

### Article 6.3 Term of the Convention

1. This convention shall be entered into for an unspecified period.
2. This convention may be denounced by each of the High Contracting Parties.
3. Denunciation shall take effect no later than on the first day of the fifth year following the year of receipt of notification by the other two High Contracting Parties, or on some other date fixed by joint agreement between the High Contracting Parties.

### Article 6.4 Protocol on privileges and immunities

The protocol on privileges and immunities shall be an integral part of this convention.

### Article 6.5 Implementing regulations

1. This convention shall be implemented through implementing regulations. The Director General shall publish these on the Office's website.
2. If there should be any inconsistencies between the text of this convention and the text of the implementing regulations, the text of the convention shall prevail.
3. Amendments to the implementing regulations will not take effect until such time as publication has taken place as referred to in paragraph 1.
4. The High Contracting Parties shall also announce these amendments in their official journals.

