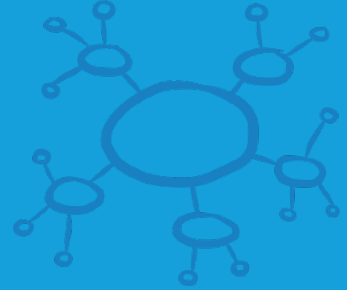


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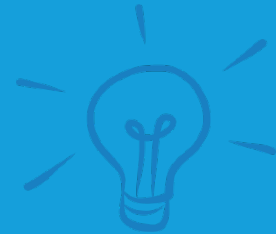
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BOIP inter partes proceedings

Interesting insights and lessons learned

Eline Schiebroek & Pieter Veeze
14 December 2021





Scope of the proceedings

Proof of use

Extra round

But first...



Question 1

How many opposition proceedings have been filed since 2007?



A. Less than 10.000



B. Between 10.000 and 15.000

C. More than 15.000





Some facts & figures: opposition

- **15 years** of opposition practice at BOIP
- A total of **17.593** oppositions filed (until 1 December 2021)
- A total of **2132** decisions published (until 1 December 2021)
 - *Justified 40%*
 - *Rejected 36%*
 - *Partial 24%*
- Around **140** decisions a year (average)





Some facts & figures: cancellation

- **3,5** years of cancellation practice at BOIP
- A total of **378** cancellations filed (until 1 December 2021)
- A total of **70** decisions published (until 1 December 2021)
 - *Revocation (mostly non-usus) 52,8%*
 - *Absolute grounds 35,9%*
 - *Relative grounds 47,7%*





Some facts and figures: Benelux Court of Justice

Opposition cases 52 appeals received:

- 30 decisions published
 - *13 rejected*
 - *3 granted*
 - *6 partial (different outcome regarding G&S)*
 - *8 settlements*
- Cancellation cases 17 appeals received:
 - 6 decisions published
 - *3 rejected*
 - *1 granted*
 - *1 settlements and 1 voluntary withdrawn*





Scope of the proceedings

Proof of use

Extra round



Scope of the proceedings

- Position of BOIP during inter partes proceedings and the assessment on absolute grounds is different
- The scope of the proceedings is what parties bring to the table:
 - Distinctiveness
 - Knowledge of the public
 - Similarity of goods and services
 - Level of attention
 - Bad faith





Scope of the proceedings

Legal framework (Rule 1.21 and 1.37 IR):



- *the decision may only be taken on the **grounds** against which the parties have been able to **put forward a defence**;*
- *facts to which the other party **did not respond** will be deemed as undisputed*
- ***examination** of the case will be **limited** to the arguments, facts and evidence put forward by the parties*





Lessons learned

- Differences between cancellation and opposition
- Cancellation proceedings concern a registered (valid) trademark



- Pure Draught (3000033)
 - *Mere reference to dictionary not enough*
 - *Perception of the relevant public needs to be taken into account*





Question 2

How would this Greek word be written in our alphabet?



A. TOEIKOV



B. TOGIKON

C. TOXIKON



D. TOXIKOV

ΤΟΞΙΚΟΝ



Lessons learned



- Toxikon (20 October 2020, C-2019/9 +10)
 - Knowledge of the relevant public regarding Greek letters
 - Arguments of the claimant were not disputed sufficiently





Scope of the proceedings

Proof of use

Extra round



Request for proof of use

Legal framework concerning the **request**



- Article 2.16bis BCIP:

*“(...) at the **request** of the applicant, the opponent shall furnish proof that the earlier trademark has been put to genuine use (...)”*



- Article 2.30 quinquies BCIP:

*“(...) if the proprietor of the later trademark so **requests**, the proprietor of the earlier trademark shall furnish proof that (...)”*



- BOIP: the request must be done **explicitly**



Proof of use – in practice

- If there is a request, BOIP invites the opponent to submit evidence
 - This request should be clearly presented
 - The examiner should not have to 'search' for the PoU request
- Assessment of the contents of the arguments happens after the file is 'ready for decision' and the case is appointed to a lawyer
- Separate the PoU request from the other defence arguments





Lessons Learned

Lunoo (19 February 2021, C-2019/19):

- The defendant stated in his arguments (*translated*):

“the applicant/opposer must prove that the trademark relied on has been put to genuine use within a period of five years prior to the date of publication of the application against which the opposition is directed. There is no such evidence. Probabilities and conjectures do not suffice”

- BCIP and IR provide no formal requirements

- *Should there be?*

- Unlike BOIP, the Court found this to be an explicit request





Opinion Poll (question 3)

Do you think BOIP should introduce a formal requirement for the proof of use request?



A. YES



B. NO

C. NO OPINION





Proof of use – tips and tricks

- Submission of supporting documents and means of evidence
 - Communication Director General (1 December 2020)
- The evidence will be assessed as a whole:
 - Not only invoices or only examples of use in practice
 - No probabilities and presumptions





Proof of Use – interesting insights

- CAMEL (5 October 2021, C-2020/10)
 - Use of the trademark on ‘foreign’ websites
 - Goods are offered ‘outside of the Benelux’
- DIREKTBANK (6 September 2021, C-2020/7 + 8)
 - Genuine use despite no new products/services are offered
 - Testarossa (ECJ C-720/18 and C-721/18)





Proof of use – Valid reason

- AIWA cancellation 3000021:



- Iconic trademark AIWA (taken over by Sony)
- However, it's no longer used
- (presumed) intention to revive AIWA trademark
- However, another company (using the name 'Aiwa') started cancellation proceedings in several European countries and sent 'warning letters'



- Valid reason for non-usus?



Case law on valid reason

- Strict interpretation (ECJ, C-246/05, Häupl, 14 June 2007)
 - Only obstacles which have a sufficiently direct relationship with the TM
 - Making its use impossible or unreasonable
 - Which arises independently of the will of the TM owner





Question 4

Is fear for legal 'trademark' consequences a valid reason?



A. YES



B. NO

C. I DON'T KNOW





Valid reason – interesting insights

- ECJ C-252/15, 17 March 2016 (Naazneen Investments)
 - A pending cancellation does not prevent the TM owner from using it.
 - Although it is possible that a successful cancellation leads to an action for damages, this is not a direct consequence of the cancellation proceedings.
- If a TM owner makes a commercial decision to no longer use the trademark
- The consequence is that the TM is exposed to a non-usus claim
- ECJ C-668/17, 3 July 2019 (Viridis)
 - If by the owner's decisions, use of the TM is not possible, no valid reason



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AND FINALLY,
TIME FOR AN EXTRA ROUND?



Extra round?

- BOIP inter partes proceedings in principle offer 1 round
- Exception: Non-usus claim in cancellations (1,5 round)
 - In case additional proof of use is filed with the last reply of the defendant
- If a new argument is introduced which influences the outcome of the case, both parties need to be able to respond.





Possibilities in appeal

- In appeal additional evidence and facts are possible
 - Sportsdirect (18 October 2019, C-2018/8)
- However no possibility for new grounds
 - Castart (23 January 2020, C-2019/3)
 - See also A 2013/1 and A 2008/1
- Offer to submit evidence, not possible
 - Nutrilife (26 February 2020, C-2018/2)



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Q&A

Discussion, questions, answers...





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 - Confirmation e-mail
 - Code word (for the BMM)
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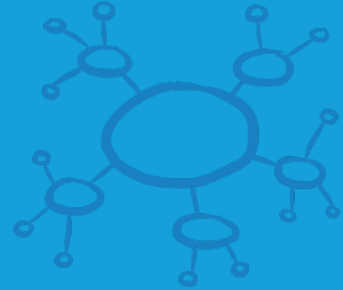
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Thank you for joining us!

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