

Protocol repealing Protocol II of 8 December 2011 and amending the Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs)¹

The Executive Board of the Benelux Office for Intellectual Property (trademarks and designs),

having regard to its powers as set out in Article 1.9(2) of the Benelux Convention on Intellectual Property (trademarks and designs),

in accordance with the Director General's proposal as set out in Article 1.11(1) of this Convention,

passed the following decision during its 14th meeting held on 21 and 22 June 2012:

1. Protocol II amending the Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs) that was adopted on 8 December 2011 is repealed.

2. The Implementing Regulations are amended as follows:

A.

In rule 1.1(1) the words 'in the Dutch or French language' are replaced by the words 'in the Dutch, French or English language'.

B.

Rule 1.13 is repealed.

C

Rule 1.20 is replaced by the following:

'Rule 1.20 – Language for procedural purposes

1. The language for procedural purposes is one of the Office's working languages. In respect of an opposition against a Benelux trademark application, the language will be determined in the following manner:
 - a. the language for procedural purposes will be the language in which the defendant's trademark application has been filed;
 - b. contrary to the provisions set out under a above, the language for procedural purposes will be chosen by the opponent if the defendant's trademark application has been filed in the English language.
2. In the event of an opposition against an international trademark application, the opponent will choose one of the Office's working languages as the language for procedural purposes. If the opponent chooses one of the Office's official languages, the defendant may state within a period of one month after the date of the notification of admissibility that it does not agree with

¹ The official text of this Protocol 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 choice of language and may choose the Office's other official language. If the opponent chooses the English language, the defendant may state within a period of one month after the date of the notification of admissibility that it does not agree with the choice of language and may choose one of the Office's official languages. Should the defendant not respond to the opponent's choice of language, the language for procedural purposes will be the language chosen by the opponent.

3. Contrary to the provisions of paragraphs 1 and 2 above, the parties may jointly choose another language for procedural purposes.
4. The language for procedural purposes will be chosen as follows:
 - a. the opponent will state in the notice of opposition which of the Office's working languages the opponent prefers to use for procedural purposes;
 - b. if the defendant agrees with the language chosen by the opponent, the defendant will communicate this within a period of one month after the date of the notification of admissibility of the opposition.
5. The Office will inform the parties of the language used for procedural purposes.
6. The opposition decision will be drawn up in the language used for procedural purposes.'

D.

Rule 1.21 is replaced by the following:

Rule 1.21 – Translation

1. Determination of the language used for procedural purposes will not affect the parties' option to use one of the Office's other working languages in the opposition procedure instead of the language used for procedural purposes.
2. If one of the parties submits arguments in one of the Office's working languages, not being the language used for procedural purposes, the Office will translate the arguments into the language used for procedural purposes, unless the other party has stated that it does require a translation.
3. At a party's request, the Office will translate into one of Office's other working languages the arguments submitted by the other party in the language used for procedural purposes.
4. At a party's request, the Office will translate the opposition decision into the other working language of the Office.
5. A translation may be requested at the time of submission of the notice of opposition or at the time of the defendant's communication as referred to in Rule 1.20 (4)(b).
6. Arguments that have not been submitted in one of the Office's working languages will be deemed not to have been submitted.

7. If arguments are translated by the Office pursuant to this rule, the document drawn up in the language in which it was submitted applies as the authentic version.

E.

Rule 1.22 is repealed.

F.

Rule 1.23(1) is replaced by the following:

'1. 'The choice of language pursuant to Rule 1.20 can be changed at the parties' mutual request until such time as the procedure commences.'

G.

Rule 1.34(1)(b) is replaced by the following:

'b. submit a translation of the request and the accompanying documents in one of the Office's working languages;'

H

In rule 2.1(1) the words 'in the Dutch or French language' are replaced by the words 'in the Dutch, French or English language'.

I.

Rule 3.3 is replaced by the following:

Rule 3.3 – Languages of the Office

1. The official languages of the Office are Dutch and French. The working languages of the Office are Dutch, French and English.
2. All documents submitted to the Office should be drawn up in one of the Office's working languages. The provisions set out in Rule 1.24 form an exception to the above.
3. Documents evidencing a right of priority, a name change, extracts from deeds evidencing assignment, another transfer, a licence or a right of pledge, the declarations relating thereto, the regulations concerning use and control, and amendments thereof, will also be accepted if they have been drawn up in German.
4. The documents referred to in paragraph 3 that have been drawn up in another language will also be accepted if a translation thereof in one of the working languages of the Office or a German translation is submitted together with the documents.
5. On request, the Office will provide a translation into one of the Office's official languages of

any published Benelux trademark application or registration drawn up in English, such a translations being subject to a fee.

J.

A paragraph 5 is added to Rule 4.5 and reads as follows:

'5. Translation of a published trademark application or registration from English into an official language of the Office

0.20 per word'

K.

A paragraph 4 is added to Rule 4.9 and reads as follows:

'4. Translation of a published trademark application or registration from English into an official language of the Office

0.20 per word'

This amending protocol will enter into force subject to two conditions. Publication as referred to in Article 6.5(1) of the Convention is required to have taken place and the Director General is required to have decided to allow the amendment to enter into force. The Director General will announce his decision concerning entry into force, stating the date thereof, in an additional rule as referred to in Rule 3.14 of the Implementing Regulations.

Decision

The Executive Board has decided to repeal Protocol II amending the Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs) of 8 December 2011 and to amend the Implementing Regulations in accordance with the proposed protocol.

Brummen, 21 and 22 June 2012

The Executive Board

J. Debrulle, Chairman

J. Kaufhold, Director

G. Broesterhuizen, Director

