

## **Protocol amending the Implementing Regulations under the Benelux Convention on Intellectual Property (trademarks and designs)<sup>1</sup>**

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

having regard to the Benelux Convention on Intellectual Property (trademarks and designs) (BCIP) as most recently amended by the Protocol of 22 July 2010,

having regard to its powers as set out in Article 1.9(2) BCIP,

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

during its 16th meeting held on 22 March 2013 passed a decision to amend the Implementing Regulations as follows:

**A.** *This amendment does not apply to the English version.*

**B.** *This amendment does not apply to the English version.*

**C.** Rule 1.9 is replaced by the following:

### **'Rule 1.9 – Renewal**

1. Renewal of the registration will take place upon payment of the renewal fee due to the Office.
2. The Office will register renewal of the registration by changing the expiry date of the registration.
3. The Office will send a confirmation of renewal to the party that has paid the fee due.

**D.** Rules 1.10 and 1.11 are repealed.

**E.** Rule 1.17 is amended as follows:

1. In paragraph 1(e) the words 'as set out in Article 2.26(2) of the Convention' are deleted.

2. Paragraph 2 is replaced by:

'If the defendant does not have a place of residence or registered office within the European Union or European Economic Area, the provisions of Rule 3.6 must be complied with within the time limit stated in paragraph 1(d).'

**F.** Rule 1.18 is amended as follows:

1. *This amendment does not apply to the English version.*

2. The following sentence is added at the end of paragraph 5:

'If the earlier trademark referred to in Rule 1.16(1)(c) concerns a Community trademark or an

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<sup>1</sup> 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.

international trademark, the Office will grant the opponent a time limit of two weeks to demonstrate that it has taken the necessary action to bring the information in the relevant register into line with the information the opponent provided when submitting the opposition.'

**3.** Paragraph 6 is replaced by the following provision:

'6. If the validity of an invoked earlier trademark expires before the end of the opposition period and this trademark can still be renewed under the applicable statutory provisions, the Office will grant the opponent a time limit of two weeks in which to renew this trademark. If the relevant earlier trademark is a Community trademark or an international trademark, the Office will set a time limit of two weeks to demonstrate that the necessary action has been taken to renew the trademark.'

**G.** Rule 1.26 is amended as follows:

**1.** The word 'two' in the first sentence of paragraph 3 is replaced by the word 'four'.

**2.** The following sentence is added at the end of paragraph 3:

'During a suspension period requested jointly by the parties, each party may at any time request that suspension be discontinued.'

**3.** *This amendment does not apply to the English version.*

**4.** The following sentence is added after the first sentence of paragraph 4:

'The Office will notify the parties thereof, stating the new time limit.'

**5.** In the last sentence of paragraph 4, the words 'the period of two months following the notification of admissibility referred to' are deleted and replaced with the words 'time limit referred to'.

**H.** *This amendment does not apply to the English version.*

**I.** Rule 1.31(j) is replaced by the following:

'j. the name of the rapporteur and the other two persons that have taken part in the decision-making process;'

**J.** In Rule 1.34(1)(c) the word 'Community' is replaced by the word 'Union'.

**K.** *This amendment does not apply to the English version.*

L. *This amendment does not apply to the English version.*

M. Rule 2.12 is replaced by the following:

**‘Rule 2.12 – Renewal of registration**

1. The Office will register renewal of the registration by changing the expiry date of the registration.
2. The Office will send a confirmation of renewal to the party that has paid the fee due.’

N. In paragraphs 2 and 4 of Rule 3.6 the word ‘Community’ is replaced by the word ‘Union’.

O. In Rule 3.9(4) the words ‘1.10(1)’ are deleted.

P. In Rule 3.13(a) the numbers ‘1.11’ are replaced by the numbers ‘1.9’.

Q. Part IV ‘Fees and charges’ is renumbered to Part V ‘Fees and charges’ and Rules 4.1 through 4.12 are renumbered to 5.1 through 5.12.

R. After Part III a new Part IV is added, which reads as follows:

**‘Part IV: i-DEPOT**

**Rule 4.1 – Types of i-DEPOT**

There are two types of i-DEPOT as referred to in Article 4.4 bis BCIP, a physical version, which is the i-DEPOT envelope, and the electronic version, which is the online i-DEPOT.

**Rule 4.2 – Submission of the i-DEPOT envelope**

1. An i-DEPOT envelope comprises two identical, linked compartments and may be obtained from the Office upon payment of a fee.
2. An i-DEPOT envelope can be submitted by returning to the Office the two linked compartments which must both contain the same documents; the envelope must show the name and address of the submitting party.
3. In accordance with Rule 3.8 the Office determines the time of receipt of the i-DEPOT envelope without checking its contents, adds a confirmation of receipt to both compartments of the envelope and returns one of these compartments to the submitting party.

**Rule 4.3 – Retention of the i-DEPOT envelope**

1. The Office will retain one of the compartments of the i-DEPOT envelope for a period of five or ten years, depending on the period chosen by the submitting party.
2. The retention period may be extended by further five-year periods.

3. Two months prior to the expiry of the retention period the Office will send the submitting party a reminder to inform the party of the possibility of extending the retention period.
4. The retention period will be extended upon payment of the relevant fee. The fee must be paid no later two months after the expiry of the retention period.
5. The Office will destroy any i-DEPOT envelopes, the retention period of which has not been extended on a timely basis.
6. During the retention period the submitting party may request the Office to send him the compartment of the i-DEPOT envelope retained on file by the Office. Retention of the i-DEPOT by the Office will terminate as a result of sending this compartment.

#### **Rule 4.4 – i-DEPOT envelope as means of evidence**

Both the compartment of the i-DEPOT envelope returned by the Office and the compartment retained on file by the Office represent evidence within the meaning of Article 4.4bis BCIP.

#### **Rule 4.5 – Submission of an online i-DEPOT**

1. An online i-Depot comprises a file containing an electronic security and verification mechanism affixed by the Office, which guarantees that its contents have not changed from the time of receipt by the Office.
2. When submitting an online i-DEPOT the name and address of the submitting party must be provided.
3. In addition when submitting an online i-DEPOT:
  - a. a description thereof should be provided, or
  - b. one or more could be files added, or
  - c. a combination of the elements referred to under a and b.
4. The Office will assign a number to the online i-DEPOT, determine a time of receipt for the online i-Depot in accordance with Rule 3.8 and will send the submitting party the electronic file referred to in paragraph 1. This file contains the components referred to in paragraphs 2 and 3, the number of the online i-DEPOT as well as the date and time of receipt by the Office.

#### **Rule 4.6 – Online i-DEPOT as means of evidence**

The electronic file referred to in Rule 4.5 represents evidence within the meaning of Article 4.4bis BCIP.

#### **Rule 4.7 – Retention of an online i-DEPOT**

1. The Office will retain an online i-DEPOT for a five-year period. The retention period may be extended by further periods of five years.
2. Two months prior to the expiry of the retention period the Office will send the submitting party a reminder to inform the party of the possibility of extending the retention period.

3. The retention period will be extended upon payment of the relevant fee. The fee must be paid no later than two months after the expiry of the retention period.
4. The Office will destroy any online i-DEPOTs, the retention period of which has not been extended on a timely basis.
5. During the retention period the submitting party may request the Office to send the online i-DEPOT evidence on a data carrier upon payment of the fee due. Based on this request the submitting party gives the Office consent to view the contents of the online i-DEPOT.
6. The submitting party may at any time request the Office to terminate retention of the online i-DEPOT and to destroy the latter.

#### **Rule 4.8 – Activities relating to the online i-DEPOT**

Activities relating to an online i-DEPOT may only be carried out by using the means specified by the Director General and made available on the Office's website.

#### **Rule 4.9 – Time Limits**

Rule 3.9 applies *mutatis mutandis* to the time limits referred to in Rules 4.3 and 4.7.'

S. The following sentence is added to Rule 5.2(1) (previously 4.2(1)):

'All fees and charges due that have been paid will not be refunded under any circumstances.'

T. Rule 5.4 (previously 4.4) is amended as follows:

1. *This amendment does not apply to the English version.*
2. *This amendment does not apply to the English version.*
3. *This amendment does not apply to the English version.*
4. *This amendment does not apply to the English version.*

5. In paragraph 2(c) the words 'one year' are replaced by the words 'three times'.

6. The word 'two' in paragraph 2(d) is replaced by the word 'four' and the number '100' by the number '150'.

7. *This amendment does not apply to the English version.*

8. *This amendment does not apply to the English version.*

9. Paragraph 4(c) is replaced by the following:

'c. change of representative, including the representative's appointment after registration of the trademark application

first trademark	22
second to fifth trademark having the same holder	11
each following trademark having the same holder	free of charge
second to fifth trademark having different holders	11
each following trademark having different holders	2'

U. Rule 5.5 (previously 4.5) is amended as follows:

*The amendments do not apply to the English version.*

V. Rule 5.8 (previously 4.8) is amended as follows:

*The amendments do not apply to the English version.*

W. Rule 5.12 (previously 4.12) is amended as follows:

*The amendments do not apply to the English version.*

This Protocol enters into force on the same date as the Protocol amending the Benelux Convention on Intellectual property of 22 July 2010.

## **Decision**

The Executive Board has decided to amend the Implementing Regulations in accordance with the

proposed protocol.

The Hague, 22 March 2013

The Executive Board

J. Kaufhold, Chairman

J. Debrulle, Director

G. Broesterhuizen, Director