

**BOIP**



**Guidelines for Opposition Proceedings  
(version 1 November 2017)**

Benelux Office for  
**Intellectual  
Property**



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## 1 ABBREVIATIONS

BCIP	Benelux Convention on Intellectual Property
BCJ	Benelux Court of Justice
BOIP or the Office	Benelux Office for Intellectual Property
BORGIP	Benelux Organisation for Intellectual Property
BTMA	Benelux Trademark Act or Uniform Benelux Trademarks Act
CJEU	Court of Justice of the European Union
DG	Director General of the Benelux Office for Intellectual Property.
EUIPO	European Union Intellectual Property Office
EUTMR	Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark
GC/CFI	General Court, formerly the European Court of First Instance
GOP	Grant of Protection
IR	Implementing Regulations
WIPO or the INTERNATIONAL BUREAU	World Intellectual Property Organisation

## 2 INTRODUCTION

The opposition procedure is a fast and easy administrative procedure that offers the proprietor of an earlier trademark the opportunity to object to the registration of a later trademark conflicting with its own trademark. The opposition procedure enables conflicts between trademarks to be resolved at an early stage and is relatively inexpensive.

The basis for filing an opposition lies in the Benelux Convention on Intellectual Property (Article 2.14 BCIP). An opposition may be filed against a later trademark in the following cases:

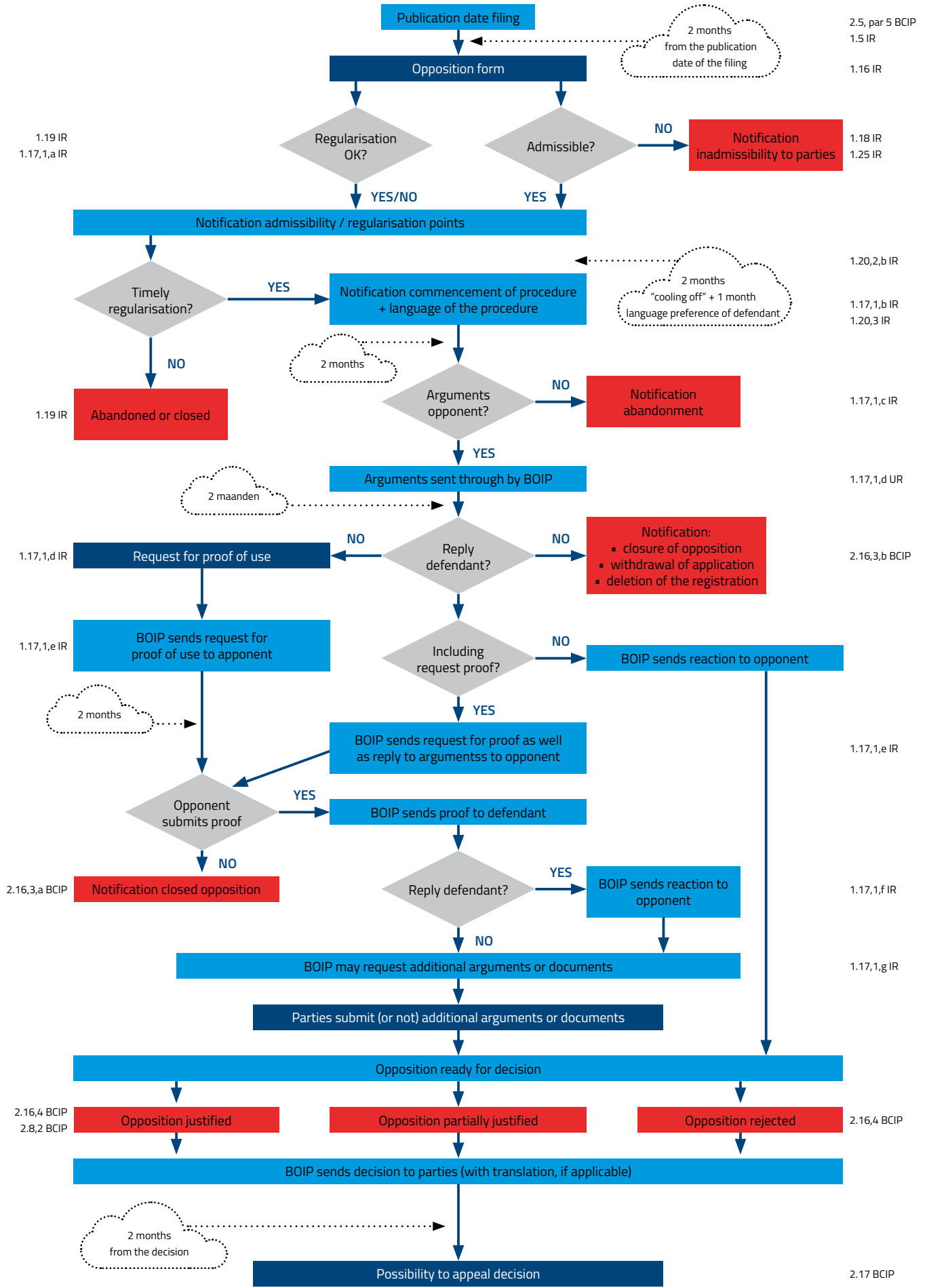
- a. if identical trademarks have been filed for identical goods or services;
- b. if identical or similar trademarks have been filed for identical or similar goods or services, and where there exists a likelihood of confusion on the part of the public, including the likelihood of association with the prior trademark;
- c. if the later trademark may give rise to confusion with a well-known trademark within the meaning of Article 6bis of the Paris Convention.

These guidelines explain the examination of oppositions in detail. The purpose of the guidelines is to inform the user in particular of the administrative procedure, explain the course of the proceedings and elaborate on a number of substantive aspects.

The information is set out in the order used in the Implementing Regulations (hereinafter: IR) and the BCIP as far as possible, in which the different aspects of each topic are discussed. This document is intended to serve as a reference document for specific questions on opposition proceedings. [Section 13 \(Course of the proceedings\)](#) summarises the course of the proceedings and should therefore be viewed as a general information section.

The guidelines are expressly intended to explain BOIP practice and are subordinate to the provisions in the BCIP, the IR and the Director General's (hereinafter DG) rules, which prevail at all times. If any changes in the BCIP or the IR necessitate amendment of the Guidelines, a new version of the Guidelines will be published. The latest version can always be found on the Office's website, together with information on a possible transitional arrangement, where necessary.

# **PART I: OPPOSITION PROCEEDINGS FLOW CHART**



# **PART II:**

# **LEGAL PROVISIONS**

### 3 LEGAL PROVISIONS

#### 3.1 The relevant articles from the BCIP:

##### Article 2.3 Order of priority for filings

In determining the order of priority for filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in:

- a. identical trademarks filed for identical goods or services;
- b. identical or similar trademarks filed for identical or similar goods or services, where there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark;

##### Article 2.14 Initiation of the procedure

1. The applicant or holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from publication of the application, against a trademark which:
  - a. in the order of priority, ranks after its own in accordance with Article 2.3 (a) and (b), or
  - b. may give rise to confusion with its well-known trademark within the meaning of Article 6bis of the Paris Convention.
2. A licensee shall have the same right if authorized by the holder:
3. Opposition may be based on one or more prior trademarks.
4. An opposition shall not be deemed to have been entered until the fees due have been paid.

##### 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 an application for a trademark;
  - b. where an action is brought with a view to a declaration of invalidity or revocation;
  - c. in the course of the proceedings for refusal on absolute grounds;
  - d. at the joint request of the parties.
3. The opposition proceedings shall be closed:
  - a. where the opponent has lost the capacity to act or has not, within the specified period, provided any documentation establishing that the right in its trademark cannot be revoked due to the lack of genuine use of the trademark, without a proper reason, within the meaning of this Convention or in relevant cases the Community Trade Mark Regulation;
  - b. where the defendant does not react to the opposition lodged. In this case the defendant shall be deemed to have renounced its rights concerning the application;
  - 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 prior trademark is no longer valid.

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. Otherwise, the opposition shall be rejected. The Office's decision shall only become final when it is no longer open to appeal or, if applicable, until the decision of the court of appeal is no longer open to reversal by a court of cassation.



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 2.17 Appeal**

1. Within two months following a decision on an opposition in accordance with Article 2.16 (4), the parties may lodge a request with the Brussels Cour d'appel, the The Hague Gerechtshof, or the Luxembourg Cour d'appel with a view to obtaining an order cancelling the Office's decision.
2. The court having territorial jurisdiction shall be determined by the address of the original defendant, the address of its representative or by the correspondence address as indicated in the application. If none of these addresses is located on Benelux territory, the court having territorial jurisdiction shall be determined by the address of the opponent or its representative. If neither the opponent nor its representative has an address or correspondence address on Benelux territory, the competent court shall be the court chosen by the party lodging the appeal.
3. The decision of the appeal court shall be open to referral to a court of cassation, which shall have suspensive effect.

#### **Artikel 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 an application has been made for the extension of protection to Benelux territory. Articles 2.14 and 2.16 shall apply.
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 2.17 and the relevant provisions of the implementing regulations.
3. The Office shall inform the International Bureau without delay, in writing and stating reasons, of a decision that is no longer open to appeal.

### **3.2 Relevant rules from the Implementing Regulations under the BCIP:**

#### **Rule 1.16 Information in the opposition**

1. The opposition should be submitted in a document containing the following information;
  - a. the opponent's name;
  - b. in relevant cases, it should state that the opponent is acting in the capacity of licensee of the earlier trademark;
  - c. information for the purpose of identifying the earlier trademark;
  - d. the goods and services pertaining to the invoked earlier trademark on which the opposition is based. If this information is not stated, it will be assumed that the opposition is based on all goods and services pertaining to the earlier trademark;
  - e. information for the purpose of identifying the trademark against which the opposition has been lodged;
  - f. the goods or services against which the opposition has been lodged. If this information is not stated, it will be assumed that the opposition has been lodged against all goods and services pertaining to the opposed trademark;
  - g. language preferences.
2. In relevant cases, documents evidencing the licensee's authorization should be submitted.
3. In relevant cases, the representative's name and address, or the correspondence address referred to in Rule 3.6 should be provided.
4. The information referred to in paragraph 1 (d) and (f) can be provided by stating only the numbers corresponding to the relevant classes of goods or services. The goods or services on which the opposition is based or against which the opposition has been lodged can be limited by the opponent until the time at which the decision referred to in Rule 1.17 (1) (i) is taken.

#### **Rule 1.17 Conduct of the proceedings**

1. The opposition will be examined in accordance with the following procedure:
  - a. the Office will decide whether the opposition is admissible in accordance with Rule 1.18 and will inform the parties or, in the case referred to in Article 2.18 of the Convention, the opponent and the International Bureau thereof;
  - b. the procedure will commence two months after the notification of admissibility, on condition that the due opposition fees have been paid in full. The Office will send the parties notification of the commencement of the procedure;
  - c. the opponent has a period of two months from the notification of commencement of the procedure referred to in b. to provide arguments and supporting documents substantiating the opposition, and in relevant cases, to submit documents proving that the earlier trademark is well-known. In the absence thereof, examination of the opposition will be abandoned. Arguments submitted before the start of the procedure are deemed to have been submitted upon commencement of the procedure;
  - d. the Office will send the opponent's arguments to the defendant, and will grant the defendant two months to respond in writing and to request proof of use, where applicable;
  - e. in relevant cases, the opponent will be given a period of two months to submit the requested proof of use or to substantiate that there is a valid reason for not using the trademark. If the trademark was only used for some of the goods and/or services for which it was registered, the Office's decision will be based on the goods and services for which use of the trademark has been proven;
  - f. if proof of use has been submitted, the Office will transmit it to the defendant and will grant the defendant two months to respond in writing to the proof of use, and to the opponent's arguments, if it had not yet done so when offered the opportunity described under d;
  - g. if the Office deems that there are relevant grounds, it may request one or more parties to submit additional arguments or documents within a term to be set for this purpose;
  - h. an oral hearing may take place pursuant to Rule 1.27;
  - i. a decision will be taken by the Office. If an opposition based on various earlier trademarks is allowed on the grounds of one of these trademarks, the Office will not take a decision on the other invoked trademarks.
2. 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).

#### **Rule 1.18 Admissibility requirements**

1. The opposition is admissible if it is filed within the period specified in Article 2.14 (1) or 2.18 (1) of the Convention and it meets the requirements set out in Rule 1.16 (1) (a)-(f) of these Regulations and Article 2.14 (4) of the Convention.
2. To establish whether the opposition is admissible, the requirements set out in Article 2.14 (4) of the Convention are deemed to have been met if 40% of the fees due have been paid.
3. Without prejudice to the provisions set out in the previous paragraph, the total fees due for filing an opposition may be paid upon filing the opposition. The previous paragraph does not alter the fact that the total fees payable must be paid by the end of the period specified in Rule 1.17 (1) (b).
4. If the opposition is based on more trademarks than the number of trademarks for which fees have been paid, the opposition will be examined, but only those trademarks for which the fees have been paid will be examined in the order stated upon filing the opposition.
5. If the information provided pursuant to Rule 1.16 (1) (a) and (b) does not correspond to the registered information relating to a Benelux trademark invoked pursuant to Rule 1.16 (1) (c), the Office will interpret the opposition filed also as a request to record a modification in the register. The provisions set out in Rule 3.1 apply *mutatis mutandis* on the understanding that the period specified in Rule 3.1 (5) shall be no more than two weeks. If the earlier trademark referred to in Rule 1.16(1)(c) concerns a Community trademark or an 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.

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.

#### **Rule 1.19 Regularisation of an opposition**

1. If the Office establishes that the notice of opposition does not meet requirements other than those referred to in Rule 1.18, it will inform the opponent thereof, granting the opponent a period of two months to remedy the deficiencies established. If the deficiencies are not remedied within the specified time limit, examination of the opposition will be abandoned.
2. If the Office establishes that documents filed by the parties other than those referred to in paragraph 1 do not meet the requirements referred to in these Regulations, it will inform the relevant party thereof, granting said party a period of two months to remedy the deficiencies established. If the deficiencies are not remedied within the specified time limit, the document concerned will be deemed not to have been filed.
3. If, upon commencement of the procedure, as set out in Rule 1.17 (1) (b), the opposition fees due have not been paid in full, examination of the opposition will be abandoned.

#### **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 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.

#### **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.

#### **Rule 1.22**

Repealed

#### **Rule 1.23 Change of language chosen**

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.
2. During the opposition procedure each party may advise in writing that it no longer requires a translation by the Office as referred to in Rule 1.21.

#### **Rule 1.24 Language of documents substantiating arguments or use of a trademark**

The provisions set out in Rules 1.20 up to and including 1.23 do not alter the fact that documents serving to substantiate arguments or prove the use of a trademark may be submitted in their original language. The documents will only be considered if the Office judges that they can be sufficiently understood, in the light of the reason for their submission.

#### **Rule 1.25 The principle of hearing both sides of the argument**

The observance of the principle of hearing both sides of the argument as referred to in Article 2.16 (1) of the Convention mainly entails the following:

- a. a copy of each relevant document submitted to the Office by a party will be sent to the other party, even if the opposition is inadmissible. If the arguments submitted pursuant to the provisions set out in Rule 1.21 are translated by the Office, they will be forwarded together with the translation;
- b. a copy of each relevant document sent to a party by the Office will also be sent to the other party;
- c. the opposition decision may only be taken on the grounds against which the parties have been able to put forward a defence;
- d. facts to which the other party did not respond will be deemed as undisputed;
- e. examination of the opposition will be limited to the arguments, facts and evidence put forward by the parties;
- f. the opposition decision will be drawn up in writing, stating reasons and will be sent to the parties.

#### **Rule 1.26 Suspension**

1. If the procedure is suspended pursuant to Article 2.16 (2) of the Convention, the Office will inform the parties thereof, stating the ground for suspension.
2. If the ground for suspension is withdrawn, the procedure will be resumed. The Office will inform the parties thereof, stating which activities should be performed at the relevant time during the procedure, and will, in relevant cases, establish an additional time limit.

3. Suspension at the joint request of the parties will apply for a period of four months, and may be extended by the same period each time. During a suspension period requested jointly by the parties, each party may at any time request that suspension be discontinued.
4. If the procedure has commenced, it will be suspended as soon as the Office receives the joint request. The Office will notify the parties thereof, stating the new time limit. If the procedure has not yet commenced, the joint request for suspension will be interpreted as an extension of the time limit referred to in Rule 1.17 (1)(b).
5. If suspension is jointly requested by the parties before the procedure commences, it will be free of charge for the first 12 months. A fee is payable for further extension of suspension before the procedure commences, for suspension during the procedure and extension thereof. If the fee is not paid upon requesting suspension, the Office will set a due date of one month. If payment is either not made or is overdue, the procedure will be resumed in accordance with paragraph 2.
6. Suspension of the opposition procedure does not discharge the parties from their obligations under Rule 1.19.

#### **Rule 1.27 Oral hearing**

1. An oral hearing may be held ex officio or at the parties' request if the Office deems there are grounds for a hearing.
2. The oral hearing will proceed in accordance with regulations drawn up by the Director General of the Office.

#### **Rule 1.28 Multiple oppositions**

3. If various oppositions have been filed against a trademark, the Office may decide, before the procedure commences, to examine one or more oppositions that are most likely to be allowed following an initial examination. The Office may in that case decide to defer examination of the other oppositions. The Office will inform the remaining parties of each relevant decision taken in the continued procedures.
4. If the opposition that has been examined is deemed well founded and the decision has become final, the deferred oppositions will be deemed to have become without cause.

#### **Rule 1.29 Proof of use**

1. The required documents evidencing proof of use of the trademark referred to in Article 2.16 (3) (a) of the Convention will be submitted in accordance with the specific rules set out in Rule 1.17 (1) (d), (e) and (f).
2. The proof of use should contain evidence of the place, duration, extent and manner of use of the earlier trademark for the goods and services on which the opposition is based. The evidence should prove use in the period of five years prior to the publication date of the trademark against which the opposition has been lodged.
3. The evidence should preferably be restricted to paper evidence, such as packaging, labels, price lists, catalogues, invoices, photographs and newspaper advertisements. If the costs for forwarding the evidence to the defendant exceed EUR 25, they will be borne by the opponent.
4. The defendant may withdraw his request to provide proof of use or deem the evidence provided as adequate.
5. The Office may destroy the evidence submitted if the opponent has not requested that it be returned within two months after the opposition decision has become final. If the costs for returning the evidence exceed EUR 25, they will be borne by the opponent.

#### **Rule 1.30 Public access to the opposition decision**

The notice of opposition and the opposition decision are public. The arguments and other documents submitted by the parties, irrespective of whether they have been put forward orally or in writing, may only be accessed by third parties with the consent of the parties.

### **Rule 1.31 Content of opposition decision**

An opposition decision contains the following information:

- a. the opposition number;
- b. the decision date;
- c. the parties' names and, in relevant cases, the names of their representatives;
- d. information relating to the trademarks relevant to the opposition procedure;
- e. a summary of the facts and the course of the procedure;
- f. in relevant cases, an analysis of the proof of use;
- g. a comparison of the trademarks and the goods and services to which the trademarks relate;
- h. the Office's decision;
- i. the decision concerning the costs;
- j. the name of the rapporteur and the other two persons that have taken part in the decision-making process;
- k. the name of the administrative officer handling the file.

### **Rule 1.32 Determination of the costs of an opposition**

1. The refund referred to in Article 2.16 (3) of the Convention will be determined at an amount equalling 60% of the fee payable for the opposition if it takes place before the procedure commences, and at an amount equalling 40% of the fee payable for the opposition if it takes place after that time.
2. No refund will be paid if, in conformity with the provisions set out in Rule 1.18 (2), only 40% of the fees payable for the opposition have been paid. A refund will also not be paid if the opposition is withdrawn after the Office has taken a decision in accordance with Article 2.16 (4) of the Convention.
3. The costs referred to in Article 2.16 (5) of the Convention will be determined at an amount equalling the basic opposition fee.
4. For translation Pursuant in accordance with to Rule 1.21, a fee determined by the Director General is payable by the party who has filed arguments in a language of the Office not being the language used for procedural purposes or by the party who requires a translation in the other language of the Office, not being the language used for procedural purposes. The Director General will also determine a fee for the translation of the opposition decision and for interpreter's services during an oral hearing.

### **Rule 1.33 Withdrawal after a decision and appeal**

1. The opposition may also be withdrawn after the decision referred to in Article 2.16 (4) of the Convention has been taken and until such decision becomes final at the latest.
2. The Office will implement the court decisions referred to in Article 2.17 (1) of the Convention without delay as soon as they are no longer open to opposition or to appeal in cassation.

# **PART III: PROCEDURAL ASPECTS**

## 4 FILING AN OPPOSITION

(Article 2.14(1) BCIP and Rule 1.16 IR)

The opposition should be filed with the BOIP within the opposition period using the designated online e-filing application, or the forms. These are available on [www.boip.int](http://www.boip.int).

### 4.1 Opposition period

(Article 2.14(1) BCIP)

The period in which an opposition may be filed is two months. The opposition period commences from the publication of the trademark application against which the opposition has been lodged. Rule 3.9(1) IR stipulates that the time limits expressed in months expire in the relevant month on the day corresponding to the day on which the time limits commence. In case this is a closing day, rule 3.9(3) IR stipulates that the opposition period will be extended until the end of the next day on which the Office is open. For further details, see [Section 10 Time limits](#).

#### 4.1.1 Publication of a contested sign

(Rule 1.5 IR)

The publication date of a Benelux trademark application can be found on the BOIP website (<https://www.boip.int/en/trademarks-register>). If the opposition period is still in force, it will be shown on the copy. International trademarks valid in the Benelux are published on the International Bureau's website (<http://www.wipo.int/madrid/monitor/en/>).

#### 4.1.2 Republication

(Rule 1.5(2) and (3) IR)

If the BOIP has made an error in publishing information about a trademark application, as a result of which incorrect information could have been provided to interested parties which would affect their decision on whether or not to file an opposition against the relevant trademark, the Office will correct the published information. This is referred to as republication. In that case a new period for filing an opposition against the trademark application will be determined, to be calculated from the new publication date.

The reasons for republication are as follows:

- modification of a trademark
- extended classification
- reclassification of the same goods or services but in other classes
- changed filing date of a trademark application
- adding priority

Given that an opposition is filed against a trademark rather than an applicant, and that the opposition period will recommence as a result of republication, it was decided that a trademark application will not be republished in the event of a name change.



It should be noted that the above information may only be modified after publication of the trademark application due to an omission made by the BOIP and not at the applicant's request. The addition of priority, however, forms an exception. Priority may be added within one month after the filing date, subject to payment of a fixed fee (Article 2.6(3) BCIP).

If an opposition has already been filed against the trademark application that is to be republished, the parties will be notified of republication in writing. The opponent will be granted a time limit in which to request that examination of the opposition be abandoned (Rule 1.5(3) IR), in which case the fees already paid will be refunded. The period granted to the opponent for this purpose coincides with the end of the effective new opposition period. If the opponent has not requested that examination of the opposition be abandoned, the opposition proceedings will continue. Incidentally, the time limits already in force will not be suspended pending the opponent's decision.

#### **4.1.3 Filing an opposition prematurely**

An opposition filed prematurely, i.e. prior to commencement of the opposition period, will be returned to the party filing the opposition, without notifying the other party. Self-evidently no fees are due for this opposition. The party filing the opposition may resubmit the opposition once the opposition period has in fact commenced.

## **4.2 Various oppositions against the same trademark application**

(Rule 1.28 IR)

Several oppositions may be filed against the same trademark application. Should this be the case, the BOIP may decide to examine one or more oppositions prior to the commencement of the proceedings. This will take place if there is an opposition which, on initial examination, is most likely to be successful. The examination of the other oppositions will in that case be deferred.

The BOIP will inform the remaining opponents of the final decision taken in the continuing proceedings.

If the opposition that has been examined is deemed well-founded and the decision has become final, the deferred oppositions will be deemed to have come without cause. These oppositions will be closed and part of the costs will be refunded.

If the opposition that has been examined is declared unfounded, the following opposition will be examined. If this opposition, in turn, is deemed well-founded, any other deferred oppositions will be deemed to have come without cause. Where an opposition is deemed unfounded, the following opposition will be examined, etc.

## **4.3 Information in the opposition**

(Rule 1.16 IR)

The IR set out the information required for filing an opposition. All the information can also be found in the online e-filing application and on the opposition form.

## 4.4 Opponent

(Rule 1.16(1)(a) IR in conjunction with Rule 1.18(5) IR)

An opponent may be an individual or a corporate body. The opponent's details must correspond to the details of the owner of the invoked trademarks recorded in the register. Should this not be the case, the opposition will be provisionally admissible and the Office will set a time limit of two weeks in which to remedy the deficiency (see [Section 5.4 et seq Provisionally admissible opposition](#)). If the opponent fails to remedy the deficiency within the stipulated time limit, the opposition will be inadmissible for the invoked trademarks in question.

### 4.4.1 Transfer

(Article 2.31 BCIP in conjunction with Rule 3.1 IR)

If the invoked right is transferred during the opposition proceedings and such assignment is recorded in the register, the new proprietor will be deemed to have succeeded to the rights of the original party filing the opposition, subject to notice of the contrary.

If several rights have been invoked and only a number of the invoked rights are transferred, the Office will send a letter to the opponent requesting the latter to inform the Office whether both parties wish to continue to be involved in the opposition. Should this be the case, this means there will be two opponents, who will jointly submit their arguments. Should this not be the case, all the invoked rights must be assigned to the same proprietor (or a licence may be entered in the register), or the opposition must be limited.

### 4.4.2 Name change

(Rule 3.1 IR)

The status of the opposition will remain unchanged in the event of a name change. The Office will record the name change and once it has been found to be correct, will notify both parties to the opposition of the change.

### 4.4.3 EU/EEA correspondence address

(Rule 1.16(3) in conjunction with Rule 3.6 IR)

If an opponent does not have a corporate seat or address for service, or has not appointed a representative within the European Community or the European Economic Area, a correspondence address within the above territories must be provided. If no such address is stated on the forms, a regularisation period of two months will be granted under Rule 1.19(1) IR (see [Section 6.2 Correspondence address](#)).

#### 4.4.4 The opponent is the licensee

(Article 2.14(2) BCIP in conjunction with Rule 1.16(1)(b) and (2) IR)

A licensee may act as the opponent if the trademark proprietor authorises the licensee to act as such. In that case it should be stated on the form that the opponent is acting in the capacity of licensee of the earlier trademark. The licence must be entered in the register. Should this not be the case, the Office will grant a time limit of two weeks for the purpose of regularisation (see [Section 5.4 et seq Provisionally admissible opposition](#)). In addition, documents must be submitted evidencing the licensee's authority. If these documents have not been submitted together with the opposition forms, this will not affect the admissibility of the opposition. However, the Office will grant a time limit of two months for the purpose of regularisation pursuant to Rule 1.19 IR. These documents may consist of a statement from the trademark proprietor. However, a copy of part of the licensing contract evidencing such consent will also suffice. Simply referring to the licensing contract that had already been recorded in the register will not suffice. If an opponent fails to respond or responds after the stipulated time limit to the above regularisation request from the Office, further examination of the opposition will be abandoned. In such case the opposition fees paid will remain due and will not be refunded.

#### 4.4.5 Opposition in the name of various parties

If an invoked right has been registered in the name of various parties, each of the co-owners may lodge an individual opposition. In such case the Office will not seek consent from the other proprietors since this will be deemed a defensive act for the purpose of the trademark.

### 4.5 Invoked rights

(Rule 1.16(1)(c) IR)

An opposition may only be filed on the basis of an earlier trademark granting a right in the Benelux territory. In other words: an application for or a registration of a Benelux, European Union or International trademark valid in the Benelux or the European Union and/or a well-known trademark.

In respect of trademark applications or registered trademarks, the number, the applicant or the trademark proprietor thereof must be stated. Furthermore it must also be stated whether the opposition relates to a Benelux filing, a Benelux registration, a European Union trademark or an International trademark. If the opposition is based on a trademark application, the proceedings will be suspended until such time as this trademark has been registered (see [Section 9.2.1 Opposition based on a trademark application](#)).

The opposition may be based on several rights. If more than three rights are invoked, Appendix B to the forms may be used. An additional fee is charged for each invoked right exceeding the third right. When calculating the number of invoked rights the well-known trademark as defined in Article 6bis of the Paris Convention is counted as a separately invoked right. If the number of trademarks on which an opposition is based exceeds the number for which fees have been paid, the opposition will be examined. However, only those trademarks for which the fees have been paid will be eligible for examination, in the order stated upon filing the opposition (see Rule 1.18(4) IR). The well-known trademark will in any case be considered as the final invoked right, in view of the order of the forms.

#### **4.5.1 International registration as an invoked right**

If the opposition is based on an international registration for which the registration number is not yet known, this should be stated on the forms. In that case the opposition will be suspended ex officio until such time as the international registration has been numbered and the trademark registered in the Benelux in accordance with Rule 1.8 IR (See [Section 9.2.1 Opposition based on a trademark application](#)).

#### **4.5.2 Well-known trademark as an invoked right**

(Article 2.14(1)(b) BCIP in conjunction with Rule 1.16(1)(c) IR)

If a well-known trademark as defined in Article 6bis of the Paris Convention is invoked, in principle this means that there is no registration or filing number with a validity in the Benelux. A registration or trademark application, however, does not preclude invoking a well-known trademark; these may be co-existing, separately invoked rights. Well-known trademarks as defined in the Paris Convention are rare in the Benelux. The box 'well-known trademark' as defined in the Paris Convention is expressly not intended to indicate whether the trademark applied for or the registered trademark has acquired a reputation (see [Section 15 Well-known trademark](#)).

When submitting arguments, the opponent must demonstrate that the trademark is well-known by providing proof thereof (see [Section 15 Well-known trademark](#)).

When invoking a well-known trademark containing figurative elements, three images of the trademark must be submitted, except if the online application was used to file the opposition.

#### **4.5.3 Conversion of a European Union trademark as an invoked right**

(Rule 1.34 IR and Article 139 European Union Trademark Regulation)

A converted trademark is a Benelux filing. The Benelux filing arising from the conversion of a European Union trademark will be assigned the same date as the trademark application or the priority date of the European Union trademark (see Article 139(3) EUTMR).

Where an opposition is based on the conversion of a European Union trademark, in determining the order of priority of the invoked right in relation to the contested sign, account will be taken of the original filing date of the European Union trademark.

If an opposition was originally based on a European Union trademark that was converted into a Benelux filing during the proceedings, the opposition will be maintained and the Benelux trademark thus created will supersede the European Union trademark.

#### **4.5.4 Invoked earlier trade name or domain name registration by the opponent**

In opposition proceedings the opponent cannot invoke an earlier trade name or domain name registration since no rights may be invoked other than the trademark rights forming part of the dispute (see Article 2.14(1) BCIP and Rule 1.16(1)(c) IR).

#### 4.5.5 Order of priority

The invoked right must predate that of the contested sign. It goes without saying that where priority may have been invoked, this will be taken into account.

#### 4.5.6 Determining the order of priority in the event of territorial extension

In some cases the invoked right may be an international trademark for which the Benelux or the European Union were only specified at a later stage by means of territorial extension.

To determine whether the invoked right effectively predates the contested sign, the 'date of registration/date de l'enregistrement' (code 151) should NOT be used:



Full details Summary By Office

808016 - mobile.bg expand all

Countries AT BX DE ES FR IT LI PT

~~151 Date of the registration~~  
23.06.2003

180 Expected expiration date of the registration/renewal  
23.06.2013

270 Language of the application  
French

Instead, the dates under 'subsequent designation/désignation postérieure' should be used. However, various dates are shown here.

What date should be selected?



▼ Désignation postérieure : 2011/44 Gaz, 24.11.2011, AT, BX, ES, FR, IT, LI, PT

450 Date et numéro de publication  
2011/44 Gaz, 24.11.2011

834 Désignation(s) selon le Protocole de Madrid en vertu de l'article 9sexies  
AT - BX - ES - FR - IT - LI - PT

580 Date de l'inscription (date de notification à partir de laquelle commence à courir le délai pour émettre le refus de protection)  
17.11.2011

891 Date de la désignation postérieure (règle 24.6) du règlement d'exécution commun  
02.12.2010

The date shown under code 580 (date de l'inscription) is the date of notification by the relevant countries (hence after the International Bureau has completed all the internal steps, including translation, for instance).

The date under code 891 (date of the subsequent designation) refers to the date of receipt by the International Bureau of the subsequent designation and therefore is the date on which it becomes valid. That date therefore is equivalent to the filing date. The date 2 December 2010 in this example must therefore be used to determine whether the invoked trademark effectively predates the contested sign.

## 4.6 Goods and services on which an opposition is based

(Rule 1.16(1)(d) IR)

The opponent may state on the form whether the opposition is based on all goods and/or services relating to the invoked right, but it is also possible to base the opposition on part of the goods and services. This should be indicated on Appendix C to the forms. Not only may a limited number of class numbers be invoked but the invoked rights may also be limited to specific goods and/or services within the classes. In that case only the terms in the goods and services list belonging to the trademark application or the registration may be used.

In the absence of a list of the goods and services, the opposition will be assumed to be based on all goods and services to which the earlier trademark applies.

### 4.6.1 Limitation of the list of goods and/or services during the proceedings

It is possible to submit a limitation request at a later stage for the goods and/or services on which the opposition is based, for instance when submitting arguments supporting the opposition.

## 4.7 Contested sign

(Rule 1.16(1)(e) IR) and Article 2.18 BCIP)

An opposition may be filed against a Benelux filing, an accelerated Benelux registration or an international registration/accelerated registration valid in the Benelux within the term set for opposition. Details of the applicant (the defendant) and the relevant trademark must be provided on the forms to enable identification of the opposed trademark. If all details have not been provided but it is sufficiently clear to the Office against which trademark the opposition has been filed, the opposition will be admissible. If it is insufficiently clear from the forms against which trademark the opposition has been filed, the opposition will be inadmissible.

### 4.7.1 Opposition against an international filing

(Article 2.18 BCIP)

An opposition against an international filing, for which extension of protection to the Benelux territory has been applied for, may be filed with the Office within a period of two months, taking effect from the publication by the International Bureau. The publication date can be found on the International Bureau's website (<http://www.wipo.int/madrid/monitor/en/>).

The BOIP will send the notification of admissibility to the International Bureau and the opponent. All other correspondence will be sent directly to both parties without the intervention of the International Bureau. In relevant cases, notification of closure of the opposition proceedings and the final results of the decision will be sent to both parties and the International Bureau. The latter will record the consequences in the International Register.

#### 4.7.2 Opposition against conversion of a European Union trademark

A converted trademark is deemed a Benelux filing. The filing date is the date of the application for the European Union trademark. Due to the fact that the opposition procedure is only open to trademarks submitted after 1 January 2004, an opposition may only be filed against converted European Union trademarks having a filing date from 1 January 2004 onwards. When examining whether the opposition may be filed against the relevant converted European Union trademark, account will be taken of step-by-step opening of the opposition procedure in the Benelux.

##### 4.7.2.1 Step-by-step opening opposition procedure

Opening the opposition procedure step-by-step was provided for in Article III of the Protocol amending the Uniform Benelux Trademark Act of 11 December 2003. The intent of the step-by-step system was to preclude the Office from being unable to process the number of filed oppositions with the resources and experience available to the Office at that time. Consequently it was only possible to file an opposition against trademarks filed in a class 'open to opposition proceedings'

- Series 1 (classes 2, 20 and 27) were opened on 1 January 2004.
- Series 2 (classes 6, 8, 13, 15, 17, 19 and 21) were opened on 1 January 2005
- Series 3 (the other classes) were opened on 1 January 2006.

The trademark application, the registration or the well-known trademark on which the opposition is based do not need to be grouped in these classes. Should the defendant's trademark application contain several classes, an opposition may be filed against the trademark application in its entirety.

#### 4.7.3 Details of the defendant

The defendant is similarly required to designate a representative or correspondence address as defined in Rule 3.6 IR within a period of two months, if it does not have a corporate seat, address for service or a representative within the European Union or the European Economic Area (see [Section 6.2 Correspondence address](#)). The defendant will be granted a period of two months for this purpose, taking effect from the notification of admissibility in accordance with Rule 1.17(2) IR.

##### 4.7.3.1 Transfer and name change

(Article 2.31 BCIP in conjunction with Rule 3.1 IR)

If the contested trademark applied for is transferred during the opposition proceedings and such assignment is entered in the register, the new proprietor will be deemed to have succeeded to the rights of the original party filing the opposition, subject to notice of the contrary.

## 4.8 Goods and services against which the opposition is directed

(Rule 1.16(1)(f) IR)

The opponent may state on the form whether the opposition is directed against all the goods and/or services relating to the contested sign, but it is also possible to direct the opposition against part of the goods and services. This should be indicated on Appendix A to the forms. Not only may an opposition be filed against a limited number of class numbers but a limited opposition may also be filed against products and/or services within the classes. In that case only the descriptions in the goods and services list belonging to the contested trademark application or accelerated registration may be used.

If a list of the goods and services is not provided, the opposition will be assumed to have been filed against all goods and services to which the contested sign applies.

### 4.8.1 Limitation of the goods and/or services during the proceedings

It is possible to submit a limitation request at a later stage for the goods and/or services against which the opposition is directed, for instance when submitting arguments supporting the opposition.

It would be advisable to be selective in choosing the goods and services against which the opposition is directed. After all, the other party will only be ordered to pay the costs if the opposition is deemed well-founded for all the goods and services against which an opposition has been filed.

### 4.8.2 Limitation by the defendant of the goods to which the contested sign applies

A defendant may limit the goods to which the contested sign applies at all times. A limitation of goods may, however, only be taken into account if the Office is unequivocally and unconditionally requested to do so (in this context see also GC, Trenton). In this case – after such limitation of goods has been recorded in the register – both parties will be notified thereof by the Office.

If the opposition comes to be without cause as a result of such limitation of goods, the Office will communicate the closure of the proceedings to the parties.

### 4.8.3 No requirement to include the legal basis on the forms

The opponent may state on the forms on which invoked rights the opposition is based and against which sign. However, the forms do not offer the opportunity to state on which ground the opponent has based the opposition (for more information relating to legal bases, see [Section 14](#)). Consequently, stating the legal ground of the opposition is not an admissibility requirement. The reason being that it will be sufficiently clear from the invoked rights, the contested sign and the opponent's arguments on which legal ground the opponent has based the opposition.



## 5 ADMISSIBILITY REQUIREMENTS

(Rule 1.18 IR)

If the opposition fails to meet the minimum requirements, it will be inadmissible and will not be examined. The admissibility requirements are set out in Rule 1.8 IR and will be assessed by the Office on the basis of the information provided on the forms.

### 5.1 Minimum requirements

The minimum requirements are summarised below. For details of the application of these points, see [Section 4 Filing an opposition](#).

- Filing within the opposition period;
- The name of the opponent;
- Information for the purpose of identifying the earlier trademark;
- Information for the purpose of identifying the trademark against which the opposition is directed;
- Payment of the fees (at least 40% of the fees).

### 5.2 Admissible opposition

If all the minimum requirements are sufficiently known and correct, the opposition will be admissible. The Office will send the notification of admissibility to both parties, together with a copy of all the relevant information.

### 5.3 Inadmissible opposition

If information concerning one of the minimum requirements is missing or is incorrect, the opposition will be inadmissible, subject to a reason for provisional admissibility (see [Section 5.4 Provisionally admissible opposition](#)). Under Rule 1.25 IR which provides for hearing both sides of the argument, a notification of inadmissibility will be sent to both parties, together with a copy of all the relevant information.

Incidentally, should the opposition period not yet have expired, the opponent will be offered the opportunity to remedy the deficiencies found within the opposition period and the opposition may subsequently be declared admissible.

## 5.4 Provisionally admissible opposition

(Rule 1.18(5) and (6) IR)

Two minimum requirements are explicitly highlighted in the IR which may be remedied at the time they were found to be incorrect, viz. the opponent's name and the renewal of a lapsed invoked right (provided this is carried out within the grace period [délai de grâce]). A period of two weeks will be granted for remedying such deficiencies.

If all invoked rights are subject to such a procedural defect, the Office will send a notification of provisional admissibility. If this concerns only a number of the invoked rights, the Office will send a notification of provisional admissibility pertaining to the relevant number of invoked rights.

### 5.4.1 Name of the opponent

(Rule 1.18(5) IR)

If the details of the opponent on the forms do not correspond to the details entered in the register for an invoked Benelux trademark, the Office will construe the opposition filed as a request to enter a modification in the register. The Office will send a notification of provisional admissibility to both parties while the opponent will be granted a two-week period to complete the request for modification in accordance with Rule 3.1 IR. This is referred to as an implicit request for modification.

If the invoked right concerns a European Union or international trademark, the opponent will be granted two weeks to demonstrate that a complete and correct request for the name change was submitted to the EUIPO and the International Bureau respectively.

A number of situations can be distinguished as set out below.

#### 5.4.1.1 An opposition is filed under the new name while the former name is still shown in the register

In principle the implicit request applies to the situation in which the opposition is filed under the new name while the former name is still shown in the register. If the opponent demonstrates that it has submitted a request to enter a modification in the register within a period of 14 days, the opposition will subsequently be declared admissible. This may concern entering a licence, a name change or a transfer.

#### 5.4.1.2 The opposition is filed under the correct name but the type of company has not been stated, or another type of company has been stated

If the opposition is filed under the correct name but the type of company has not been stated, or another type of company has been stated, in relevant cases this may also be remedied by means of a modification, insofar as the former type of company still appears in the register.

However, if the legal form has not been entered in a register other than the Benelux Register, viz. that of the EUIPO or the International Office, this does not imply that a notification of provisional admissibility will be sent. In such cases the opposition will be admissible with immediate effect as the BOIP cannot require other registers to state specific details.

#### **5.4.1.3 The opposition is filed under the opponent's former name but the register meanwhile shows the new name**

If the opposition is filed under the former name but the register meanwhile shows the new name, the opponent must file documents that clearly show the opponent's authority and the nature of the transmission.

The documents will be assessed on a case-by-case basis to determine whether they are sufficiently clear and provide conclusive evidence for the purpose of establishing whether the opponent stated on the form, is in fact the same as the party recorded in the register. To that end, among other things, account will be taken of documents containing a clear timeline and history.

#### **5.4.1.4 The opposition is filed under a non-existent company name**

Here, a name that differs from that in the register is used on the opposition form, and is also not the new or former name. In this case the Office will send a notification of provisional admissibility and will request that the entry in the register be modified to reflect the information provided on the opposition form.

However, if this concerns a minor matter that has been overlooked (a word left out when filling in the form) or if the company's 'unofficial' name has been used, this may not be corrected on the form and consequently it will not be evident from any of the documents that the party submitting the opposition form also is the proprietor of the invoked right. This is because the possibility of entering corrections is limited to correcting 'clerical errors attributable to the proprietor' ('s-Hertogenbosch District Court, Viking case). This decision clearly delineates the room for entering corrections and reduces these to an absolute minimum. In this context, reference is also made to the decision by the Leeuwarden Court of Appeal in the Weeva-Mensa case).

#### **5.4.2 Validity of the invoked right**

(Rule 1.18(6) IR)

If the validity of the invoked Benelux trademark expires prior to the end of the opposition period, the Office will also construe the opposition filed as a request to renew the trademark. The provisions set out in Rule 1.10 IR equally apply on the understanding that the period specified in Rule 1.10(1) IR is a period of no more than two weeks.

## 6 REGULARISATION OF THE OPPOSITION

(Rule 1.16 IR)

If the opposition does not meet the other statutory requirements, the BOIP will explain in a written 'notification concerning regularisation' what information is still required for the file. Such deficiencies may be remedied within a period of two months. The period within which regularisation must be arranged, can never be suspended or postponed. If regularisation is not arranged within this period, examination of the opposition will be abandoned or the opposition proceedings closed (see [Section 11 Termination](#)).

### 6.1 Authority of the licensee

In addition to entering the licence, if the opponent acts in the capacity of licensee of the earlier trademark (see [Section 4.4.4 The opponent is the licensee](#)), documents evidencing the licensee's authority must be submitted. It will not suffice to refer to the licensing contract submitted, a copy of the relevant provisions in the contract or any other documents evidencing the consent of the licensor. If the above has not been regularised, examination of the opposition will be abandoned (see [Section 11.2 Examination abandoned](#)).

### 6.2 Correspondence address

If the opponent or the defendant do not have a corporate seat or address for service, or have not appointed a representative within the European Community or the European Economic Area, a correspondence address within the above territories must be provided. If no such address is stated on the forms, a regularisation period of two months will be granted under Rule 1.19(1) IR (see [Section 4.4.3 EU/EEA Correspondence address](#) and [Section 4.7.3 Details of the defendant](#)). If the opponent fails to arrange regularisation, examination of the opposition will be abandoned (see [Section 11.2 Examination abandoned](#)). On the other hand, if the defendant fails to respond to the regularisation request, the opposition proceedings will be closed and the disputed sign will not be registered for the goods and services against which the opposition was directed (see [Section 11.1.3 The defendant fails to respond to the opposition filed](#)).

### 6.3 Single documents

Arguments and documents must be submitted in duplicate to enable the Office to send one copy to the other party. If the Office finds that documents have not been submitted in duplicate, it will notify the relevant party and request that a second identical copy be submitted within a period of two months. If a duplicate is not received, the relevant document will be deemed unsubmitted.

For the sake of good order, the Office would like to point out that documents may now also be submitted electronically using the contact form, in which case hard copy documents no longer need to be submitted in duplicate (see [Section 10.7.1 Submission of documents using the contact form](#)).

#### 6.4 Documents are not identical

If the Office finds, when comparing the arguments and documents submitted in duplicate, that certain documents are not identical, it will request in writing that a second identical copy of the relevant documents be submitted. The party concerned will be granted a period of two months (taking effect from the date of the letter) for submitting a second identical copy. If a duplicate is not received or again is not identical, the relevant document will be deemed unsubmitted. The documents/other documents that were submitted in duplicate will be sent to the other party.

NB: The parties are responsible for submitting two identical copies of the arguments and documents. While the Office will list the documents that are not identical, it will not return the documents if it is unclear which documents were submitted in what manner.

#### 6.5 Colour and black and white documents

If the Office finds that two copies of the arguments and documents were submitted but that one copy is black and white while the other is in colour, it will not deem these as two identical copies. The relevant party will then be granted a period of two months in which to submit a second identical copy. Failure to arrange regularisation means that only the identical documents will be considered while the other documents that are not identical will be deemed not to have been submitted.

#### 6.6 Submission of arguments and documents using the contact form

If parties use the contact form on the Office's website (<https://www.boip.int/en/contact/contact-form>), all documents may be sent as attachments. Only one copy of the document should be attached and submitted. It is no longer necessary to send a duplicate by post. The party submitting the documents will receive an automated confirmation of receipt which will be sent to the e-mail address provided by the party.

#### 6.7 Submission of arguments and documents by fax

If the arguments are submitted by fax, these must also be received in duplicate. One copy submitted by fax and one sent by post as confirmation are deemed to be two copies.

Any appendices must also be received within the stipulated time limit. In the arguments submitted by fax it is not possible to refer solely to a list of enclosures that were sent by post. Only if these documents are received within the stipulated time frame will they be considered by the Office.

If the fax is of such poor quality that it hampers the readability of the documents, the Office will offer the opportunity to resubmit these documents, on condition that these will still be received within the original time limit. This will no longer be possible after the original time limit has expired. The party submitting the documents is responsible for ensuring that the documents are legible and sufficiently clear.

## 7 LANGUAGE REGIME

(Rules 1.20 – 1.23 IR)

The opponent may indicate its language preference when submitting the opposition form. This concerns the opponent's preference for the language of the proceedings on the one hand, and whether the opponent would like a translation if the defendant's arguments are submitted in a language other than the opponent's preferred language, on the other.

In general, the language of the proceedings will be the filing language of the defendant's application. This is the language used for the classification of the application. The defendant, however, can also agree to the language of preference of the opponent. In that case, this language will become the language of the proceedings. An exception to the general rule, that the language of the proceedings is the language of the defendant's application, is made when the contested application has been filed in English. English is considered a working language, which implies that neither party can be forced to use English.

When sending the notification of admissibility the opponent's language preferences will be communicated to the defendant who will be requested to respond within a period of one month after the letter has been sent. Failing a response, the IR provides for a fall-back procedure as set out in detail below.

With respect to the language of the proceedings, a choice may be made between the three languages of the Office: English, French and Dutch.

### 7.1 Determination of the language of the proceedings – Benelux filing

If the opposition has been filed against a Benelux filing, account will be taken of the language of the classification used in the relevant filing. If it corresponds to the opponent's language preference, the Office will determine that the proceedings will be conducted in that language. If the language in which the trademark has been filed does not correspond to the opponent's language preference, the defendant will be invited to confirm whether or not it agrees with this proposal. Should a response not be received within the stipulated one-month time limit, the language of the proceedings will be determined on the basis of the language of the classifications in the defendant's trademark application. In case the language of the contested application is English, the defendant will not be able to indicate a preference if the opponent's language preference is Dutch or French. The opponent's preferred language will in that case immediately become the language of the proceedings.

### 7.2 Determination of the language of the proceedings – international filing

If an opposition is filed against an international filing, the language of the proceedings cannot be determined automatically. The notification of admissibility addressed to the International Bureau will always indicate the languages chosen by the opponent and the defendant will be asked to respond within a period of one month. Here too, the defendant may choose between the languages of the Office, unless the opponent has indicated Dutch or French as his preferred language. In that case the defendant cannot choose English as the language of the proceedings. Should a response not be received with the stipulated period, the proceedings will automatically be conducted in the opponent's preferred language.

### 7.3 Choosing English

As of 1 October 2013, English is a working language of the Office. If according to the rules set out above, English has been chosen as the language of the proceedings, this is considered to be a full language of the proceedings. Parties will exchange arguments in English, communicate with the Office in English and the opposition decision will be drawn up in English.

### 7.4 Change of language chosen

(Rule 1.23 IR)

In accordance with Rule 1.23 IR the parties may jointly request until such time as the proceedings commence that the language chosen for the proceedings be changed.

### 7.5 Translations

(Rule 1.21 IR)

The parties may - regardless of the language determined for the proceedings - use the Office's other languages.

The opponent may only ask for a translation when filing the opposition form and the defendant may only do so if asked in the notification of admissibility. If the defendant fails to respond to the preferred language stated in the notification of admissibility, in relevant cases the Office will assume that the defendant would like a translation. Each party may state at any time during the proceedings that they no longer wish to receive a translation.

If either party submits arguments in the other language of the Office (English, French or Dutch), not being the language of the proceedings, the Office will translate the arguments into the language of the proceedings on condition that the other party has indicated that it would like a translation. The document as submitted in the original language will, however, be deemed authentic.

The parties may also request that the opposition decision be translated into another language used by the Office.

If, for that matter, the Office finds that a document fails to comply with the procedural requirements, for instance if the arguments were not submitted in duplicate (see [Section 6.3 Single documents](#)), the Office will first proceed to regularise the procedural requirement. After all, failure to arrange regularisation may give cause to abandon examination of the relevant document, which would render translation redundant.

### 7.5.1 Costs incurred for translations

Costs may be incurred for translations. A distinction should be made between the costs incurred for translating arguments and the decision:

The translation of the first four pages of arguments is free of charge, each page or part of a page exceeding the fourth page costs EUR 55. A page should cover no more than 30 lines and contain no more than 80 characters. The translation of a decision costs EUR 45 per page (starting from the first page) or part of a page.

The translation costs will be borne by the party requesting the translation, insofar as the other party has also used the language of the proceedings. If a party thus uses the Office's other languages rather than the language of the proceedings and the other party has asked for a translation, the party submitting the arguments must bear the costs (see Rule 1.32(4) IR).

### 7.6 Communication between the Office and the parties

Without prejudice to determining the language of the proceedings, the Office will communicate with parties the language of their preference. The letters to the parties will therefore be written in the relevant parties' preferred language, regardless of the language of the accompanying documents. The language of the communication will be one of the working languages used by the Office, viz. English, Dutch and French.

### 7.7 Language of proof of use and other supporting documents

(Rule 1.24 IR)

Documents serving to substantiate arguments or as proof of use of a trademark do not necessarily need to be drawn up in the language of the proceedings or one of the languages used by the Office. These documents may be submitted in their original language. The documents will only be considered, however, if the Office judges that they can be sufficiently understood, in the light of the reason for their submission.

The nature of invoices, for instance, means they can easily be identified and the same applies to advertising in most cases.



## 8 FINANCIAL INFORMATION

### 8.1 Opposition fees

(Rule 1.18(2) and Rule 1.19(3) IR)

The basic fee charged for filing an opposition is EUR 1,000. Three trademark rights may be invoked for this fee. A well-known trademark is deemed a separately invoked right.

An additional fee of EUR 100 is charged for each invoked right exceeding the third right.

The opponent may opt to pay the opposition fees at once or in two instalments. For admissibility purposes, however, 40% of the total fees due must be paid prior to expiry of the opposition period (Rule 1.18(2) IR). The other 60% must be paid no later than before the proceedings actually commence. In the event the latter payment is not made, examination of the opposition will be abandoned (Rule 1.19(3) IR, see [Section 11.2 Examination abandoned](#)).

If an insufficient amount has been paid for all the invoked rights, the Office will only examine the trademarks in the opposition for which the fees have been paid and in the order stated upon submission (Rule 1.18(4) IR and see [Section 4.5 Invoked rights](#)).

### 8.2 Refunding opposition fees

If the opposition is declared inadmissible, the opposition fees already paid will be refunded.

On condition that the opponent has paid all the opposition fees due when submitting the opposition, depending on the time at which the opposition is closed, part of the fees paid will be refunded. Sixty per cent of the fees will be refunded in the event the opposition is closed prior to commencement of the proceedings. If the event of closure after commencement of the proceedings, 40% will be refunded (Rule 1.32(1) and (2) IR). This also includes the additional invoked rights exceeding the third right, part of which will also be refunded in relevant cases. However, if the opponent were to request that an additional invoked right exceeding the third should not be considered, the fees already paid will not be refunded.

Examples:

The opponent pays for two invoked rights when filing the opposition, and opts to pay 40%. The parties reach an amicable settlement during the cooling-off period and the opposition is closed. As the opponent has only paid 40% of the fees, no refund will be made.

The opponent pays for two invoked rights when filing the opposition, and opts to pay 100%. The parties reach an amicable settlement during the cooling-off period and the opposition is closed. As the opponent has paid 100% of the fees, 60% will be refunded because the proceedings were closed prior to commencement.

The opponent pays for two invoked rights when filing the opposition. The defendant decides after having received the opponent's arguments to withdraw its trademark application. As the opponent has meanwhile paid 100% of the fees (the proceedings have already commenced), 40% will be refunded because the proceedings were closed after commencement.

The opponent pays for four invoked rights when filing the opposition and invokes three registrations plus one well-known trademark. The opponent opts to pay 100%. The parties reach an amicable settlement during the cooling-off period and the opposition is closed. As the opponent had already paid EUR 1,100, 60% of both the basic opposition fee and the additional fee for the invoked right exceeding the third right will be refunded, i.e. EUR 660.

If examination of the opposition is abandoned, no refund will be made. If the opponent therefore decides to discontinue the proceedings, it would be better for the opponent to opt to request the Office to withdraw the opposition rather than submit no arguments. After all, in accordance with Rule 1.17(1)(c) IR, the latter case represents a ground for abandoning examination of the opposition.

Therefore no refund will be made if only 40% of the opposition fees due have been paid (Rule 1.32(2) IR).

A refund will also not be made if the opposition is withdrawn after the Office has issued a decision (Rule 1.32(2) IR).

### 8.3 Payment of suspensions

During the cooling-off period, the proceedings may be suspended three times at the most free of charge. After suspending the proceedings a third time, hence from the fourth request onward, a fee of EUR 150 will be charged for each suspension.

A fee of EUR 150 is always charged each time for any suspension request received starting from the date of commencement of the proceedings.

The parties may determine by mutual agreement which party will bear the costs thereof. If nothing is mentioned about the costs in the request for suspension, the Office will follow the procedure set out below.

If two parties (or if their representative acts on their behalf) have a current account with the Office, the fees will be divided equally (on a 50/50 basis) between the parties.

If either party does not have a current account or has a current account deficit, the Office will state in the confirmation of suspension that the full suspension fee must be paid within a period of one month, taking effect from the date of the confirmation letter. In the event the payment is not made, the suspension request will be deemed not to have been submitted and the opposition period will consequently continue.

### 8.4 Award of costs

The losing party will be ordered to pay the costs. The costs will be determined in accordance with the provisions of the Implementing Regulations, viz. a sum equalling the basic opposition fee, which is EUR 1,000. No costs will be incurred if the opposition is partially successful.

The Office's decision concerning determination of the costs constitutes an enforceable order. Its forced execution will be governed by the rules in force in the State where execution takes place, to which the Office is not a party (see also [Section 13.9.2 Award of costs](#)).

## 9 SUSPENSION

(Article 2.16(2) BCIP and Rule 1.26 IR)

### 9.1 Suspension of the proceedings by joint request

The parties may submit a joint request to suspend the proceedings. Suspension covers a period of four months and may be extended each time for a further four-month period.

The parties may request suspension by submitting a joint request in one letter, signed by both parties. However, the parties also have the option to submit a separate request.

Cancellation of suspension by joint request can be requested in writing by each of the parties at any given time during the suspension. This is called an opt-out of suspension.

Suspension does not affect the regularisation periods granted under Rule 1.19 IR or the period granted to the defendant in the notification of admissibility for indicating the latter's language preference.

#### 9.1.1 Suspension prior to commencement of the proceedings

Suspension based on a joint request by the parties prior to commencement of the proceedings is free of charge for three suspensions but a fee is charged for the fourth suspension onwards. As a result of suspending the proceedings at the joint request of the parties prior to commencement, in other words during the cooling-off period, the cooling-off period will be extended by four months (see also [Section 10.6 Commencement and suspension of the proceedings](#)).

#### 9.1.2 Opt-out prior to commencement of the proceedings

In case the Office receives an opt-out request prior to commencement of the proceedings, it will determine the stage of the opposition. As a matter of fact, the cooling-off period of two months is a legally defined period which cannot be shortened. If the opt-out is requested during the initial cooling-off period (which starts from the notification of admissibility), the Office will let the procedure commence after the expiration of this two-month cooling-off period. If the cooling-off period has already expired at the time of the opt-out, the procedure will commence. In case payment of the second instalment has not yet been received by the Office, a time limit of one month will be granted to pay this second instalment. Please be aware that this is an exception to the rule. In all other situations when payment of the second instalment is not received on time, the examination of the opposition will be abandoned (see [Section 11.2 Examination abandoned](#)).

### 9.1.3 Suspension after commencement of the proceedings

A fee is charged for suspension based on a joint request made after the proceedings have commenced. The costs amount to EUR 150 for each suspension. If both parties have a current account, these costs will be debited from their current account on a 50/50 basis as standard, unless expressly stated otherwise by the parties in their written request. One of the parties may indicate that it will pay all the costs. However, no apportionment of costs other than on a 50/50 or 100% basis is possible.

If the current account balance is insufficient or if one of the parties does not have a current account and payment has not yet been made, regularisation will need to be arranged (see also [Section 8.3 Payment of suspensions](#)). The parties will be granted a time limit of one month in which to pay for suspension. If payment is not received, the request for suspension will be deemed not to have been submitted and the proceedings will be resumed with effect from the stage of the proceedings at the time suspension was requested. The Office will notify the parties thereof and in the relevant cases an additional time limit will be granted in accordance with Rule 1.26(2) IR.

### 9.1.4 Opt-out after commencement of the proceedings

In case the Office receives an opt-out request after the commencement of the proceedings, it will determine the stage of the opposition. The effect of a suspension is that the proceedings are stopped in the current phase and the consequence of the lifting of the suspension is that it will continue from the point at which it was stopped. In other words, if after the lifting of the suspension there is remaining time, this time will be granted to perform the action concerned (e.g. filing of arguments). If only a limited time remains, the Office will grant an additional time limit in accordance with rule 1.26(2) IR.

Please be aware that the Office does not consider the filing of arguments as an implicit opt-out request of the suspension. The arguments will only be sent to the other party after the expiration of the suspension. If by filing arguments you wish to indicate that you want an opt-out of the suspension, please do so explicitly.

## 9.2 Ex officio suspension

The opposition proceedings will be suspended ex officio in the following cases:

- where the opposition is based on a trademark application;
- where an invalidation or revocation action has been instituted;
- during the course of the proceedings for refusal on absolute grounds.

### 9.2.1 Opposition based on a trademark application

If the opposition is based on an application for a Benelux trademark that has not yet been registered, the Office will notify the parties of the commencement as well as the end of the ex officio suspension. The parties do not need to notify the Office of the registration of the trademark applied for since the Office administers such entries in the Benelux register.

If the opposition is based on an international filing or a European Union trademark, however, the Office will notify the parties of the commencement of the ex officio suspension, but will ask the parties to notify the Office of the registration of the invoked right since such register entries are not administered by the Office. The Office will then confirm the end of the ex officio suspension to the parties. The Office will, however, periodically check the relevant registers to establish whether the invoked right has meanwhile been registered.

### 9.2.2 Invalidation or revocation action

If an invalidation or revocation action has been filed against one or more of the trademarks against which proceedings were instituted, the parties are required to notify the Office thereof. Only in the event an invalidation action has been filed with the EUIPO will this be known to the Office when it checks the invoked right in the register.

An invalidation or revocation action is also taken to mean an application submitted to but not yet processed by the International Office to renounce protection in the Benelux in the event of an international registration (referred to as 'renunciation'). An application for a limitation of goods which has been submitted to but not yet processed by the EUIPO or the International Office on account of which the opposition has come to be without cause, is also treated as an invalidation or revocation action. For further information on the administrative treatment of such ex officio suspension, see [Section 9.3 Provisional ex officio suspension](#).

If several rights have been invoked in an opposition, but only one such right is subject to ex officio suspension, the entire opposition proceedings will be suspended. Self-evidently, the opponent is at liberty to renounce the relevant invoked right to enable the proceedings to resume.

### 9.2.3 Refusal of the contested sign on absolute grounds

A trademark application will be published if the requirements for determining the filing date have been met and the goods or services have been classified correctly. Consequently, it is possible to file an opposition against a trademark application, examination of which on absolute grounds has not yet been completed. If a provisional refusal has been issued, this means that the opposition proceedings will be suspended.

In the event the provisional refusal is reconsidered, the opposition proceedings will be resumed and parties will be notified thereof.

If the refusal has become final, the opposition proceedings will be closed as they have come to be without cause.

### 9.2.4 Ex officio suspension in the event of notification of admissibility

After the Office has received the forms it will proceed to inspect the file to determine the admissibility of the opposition (see [Section 5 Admissibility requirements](#)).

If the Office establishes one of the above grounds, it will notify both parties of suspension in the notification of admissibility, stating the ground for suspension. If the ground for suspension has been revoked, the Office will communicate termination of the ex officio suspension to the parties and the commencement of the cooling-off period.

### 9.2.5 Ex officio suspension during the proceedings.

If one party notifies the Office during the opposition proceedings of a ground for ex officio suspension, the Office will send notice of 'provisional ex officio suspension'. For further information on the administrative treatment of the above, see [Section 9.3 Provisional ex officio suspension](#).

If there is a ground for ex officio suspension, the Office will notify the parties thereof. If the ground for suspension is revoked, the proceedings will be resumed or terminated. The Office will notify the parties thereof and - in relevant cases - state what action needs to be taken. An additional time limit will be granted for this purpose, if necessary.

### 9.3 Provisional ex officio suspension

If either the opponent or the defendant in opposition proceedings notifies the Office that an invalidation or revocation action has been filed, the Office will provisionally suspend the opposition proceedings ex officio (DG communication: 'Procedure for ex officio suspension; examination of an opposition if an invalidation or revocation action has been filed (Article 2.16(2)(b) BCIP) of 15 October 2007).

The Office will notify the parties of the decision concerning provisional ex officio suspension and will offer them the opportunity to respond within one month. Failing a response, the provisional ex officio suspension will tacitly transform into definitive suspension of the opposition. If there are any reasons to query the accuracy of the notification concerning the action, the parties may request that documentary evidence be submitted. The Office will forward the request for documentary evidence to the other party, granting a time limit of one month to submit such evidence. If the above documents are not submitted, ex officio suspension will be deemed unsubmitted (for further details see [Section 9.4 Ex officio suspension deemed unsubmitted](#)). If the documents are received, however, they will be forwarded to the requesting party, who will be granted a time limit of one month in which to submit a response to the merits of the ex officio suspension.

### 9.4 Ex officio suspension deemed unsubmitted

If it emerges that the action has not actually been instituted, the Office will resume the proceedings. In that case ex officio suspension will be deemed unsubmitted. The Office will notify the parties thereof. In principle in the event of termination of the ex officio suspension, the time limits will be deemed to have been completed in the period in which the opposition was erroneously suspended ex officio. However, in relevant cases the Office may decide to grant an additional period in which to perform the activity that should have been performed at that time.

If the documents show that the action was instituted later than the date on which the Office received notification of ex officio suspension, the effective date of ex officio suspension will apply as the date on which the action was actually instituted. The Office will notify the parties thereof.

## 10 TIME LIMITS

(Rule 3.9 IR)

### 10.1 Applicability of general rules

The time limits granted in opposition proceedings are set out in the IR, specifically in the provisions relating to opposition. The general rules concerning time limits and closing dates (Rule 3.9 IR) apply. This section includes a table showing all the time limits in opposition proceedings as well as examples.

### 10.2 Time limits in months

The time limits expressed in months take effect from the day on which the relevant activity takes place, and expire in the relevant month on the day corresponding to the day on which the time limits take effect. If the relevant month does not have a corresponding day, the time limit expires on the last calendar day of that month.

The above activity usually refers to the letter sent by the Office, the date of which letter prevails. The opposition period forms an exception to the above. It takes effect on the publication date of the contested trademark application (see [Section 4.1 Opposition period](#)).

The time limits granted in opposition proceedings therefore end on the day stated in the letter. If a party responds within the stipulated time limit, the response will be forwarded to the other party, as a result of which the time limit will also have expired. Only if the relevant party explicitly indicates that it also wishes to use the remaining period, will examination of the arguments and/or documents that have already been submitted be deferred until the expiry of the time limit.

Examples:

The date of the letter is 1 June and a time limit of two months has been granted. The time limit expires on 1 August.

The date of the letter is 31 December and a time limit of two months has been granted. The time limit expires on 28 (or 29) February.

### 10.3 Time limits in weeks

The time limits expressed in weeks take effect from the day on which the relevant activity takes place, and expire in the relevant week on the day corresponding to the day on which the time limits take effect.

The above activity refers to the letter sent by the Office, the date of which letter prevails.

Example:

The date of the Office's letter is Friday, 1 June and a time limit of two weeks has been granted. The time limit expires on Friday, 15 June.

#### 10.4 Office closing dates

(Rule 3.9 IR)

If the Office is closed on the last day of a stipulated time limit, the time limit will be extended until the end of the next day on which it is open (hence at 11.59 p.m.). The closing dates of the Office have been posted on our website under 'Contact' (<https://www.boip.int/en/contact/address-opening-hours/>).

Examples:

A time limit ends on Saturday, which means that documents may be submitted until 11.59 p.m. on Monday.

A time limit ends on Sunday, 29 April 2012, which means that the documents may be submitted up to and including 2 May 2012, because the Office is officially closed on 30 April and 1 May.

#### 10.5 Applicability to time limits stipulated in the opposition

In opposition proceedings account must be taken of the difference between the duration of the cooling-off period and the commencement of the proceedings.

There is a two-month cooling-off period. The proceedings commence after these two months have expired. The date of commencement of the proceedings should therefore be calculated as two months plus one day, taking effect from the date of the notification of admissibility.

Example:

The notification of admissibility is sent on 21 March, the proceedings commence on 22 May.

#### 10.6 Commencement and suspension of proceedings

Calculating the date of commencement of the proceedings is particularly important in the event of a request for suspension. The request must be received on the last day of the cooling-off period. In that case the request for suspension must in fact be submitted prior to commencement of the proceedings, which means that suspension is free of charge.

Example:

The notification of admissibility is sent on 21 March, the proceedings commence on 22 May. The request for suspension must be received prior to commencement of the proceedings, no later than 21 May. If 21 May is a date on which the Office is closed, the opportunity to submit a request for suspension will be extended until the next day on which the Office is open, which is 22 May.



## 10.7 How to submit documents and aspects to bear in mind

(Rule 3.4 IR)

The parties in opposition proceedings may submit their arguments and documents to the Office by fax, post, in person or using the contact form on the BOIP website. There are several ways of submitting documents to the Office. However, the Office would like to take the opportunity to point out that documents may now also be submitted using the contact form. This would be the preferred route as it is user friendly and secure; the submitting party can rest assured that the Office has received the documents (a confirmation of receipt will be sent) and there is no need to submit the documents in duplicate.

### 10.7.1 Submission of documents using the contact form

Documents submitted using the contact form on the BOIP's website, must be submitted in PDF format. Documents in any other formats will be rejected. Images of well-known trademarks submitted electronically may only be submitted in .jpg or .jpeg format. Images in any other formats will be rejected. The advantage of submitting documents using the contact form is that only one copy of the document needs to be submitted. Furthermore, an automated confirmation of receipt will be sent to the e-mail address provided by the submitting party.

E-mail policy is fully applicable to all documents submitted by e-mail to BOIP staff e-mail addresses or general mailboxes. Such e-mails are regarded as a telephone call and any documents sent as e-mail attachments will be deemed not to have been submitted (see DG communication 'Electronic submission of documents of 24 October 2011, as well as 'E-mail policy', <https://www.boip.int/en/ip-professionals/contact/email-policy>).

### 10.7.2 Submission of documents by fax

In accordance with Rule 3.4 IR the parties in opposition proceedings may submit their arguments and documents by fax. The fax must be received by the Office no later than on the last day of the stipulated time limit. If arguments and documents are submitted in duplicate by fax, they do not need to be sent by post for the purpose of confirmation. Documents of which one copy is submitted by fax and one copy by post are deemed to have been submitted in duplicate.

All documents must be received by the Office no later than on the last day of the stipulated time limit.

Documents that are subsequently delivered to the Office but later than the stipulated time limit will be deemed a late submission. This also applies if notification of these documents has been given in a fax that was in fact submitted on a timely basis. Hence, in a fax it is not possible to refer to documents sent later by post.

However, it is possible to communicate by fax that documents are being sent later, because they are in colour, for instance, subject to the following two conditions imposed by the Office:

- a. All subsequently submitted documents must also already have been received by the Office by fax;
- b. Proof must be provided that these documents were sent on the same day as the above fax.

If the original copy of a document sent by fax contains colours, the Office will examine the colour copies of the documents sent as confirmation by post. The copies sent as confirmation by post must be sent on the same day as the fax, proof of which must be provided by the parties.

### 10.7.3 Submission of documents by post

Documents delivered to the Office by post are deemed to have been received at 8.00 a.m. on the date of receipt thereof. Documents delivered when the Office is closed, are assumed to have been received at 8.00 a.m. on the date on which the Office again is open (DG communication 'Time of receipt of documents delivered while the Office was closed' 1 September 2006).

Self-evidently, this does not apply to documents submitted by fax or electronically.

### 10.8 Premature submission of arguments

(Rule 1.17(1)(c) IR)

If an opponent submits arguments and/or documents prior to commencement of the proceedings, they will be deemed to have been submitted upon the commencement of the proceedings (Rule 1.17(1) (c) IR). The Office will therefore hold these arguments. However, on commencement of the proceedings the arguments will not be forwarded to the defendant immediately; the opponent will be offered the opportunity to add any further arguments. To that end the opponent will be granted the regular time limit of two months in which to either submit further arguments or to confirm that the arguments were complete. The Office will forward the arguments and/or documents to the defendant following the opponent's response or after the expiry of the stipulated period.

In all other cases the Office will not consider any arguments and/or documents submitted prematurely but will return these to the submitting party.

### 10.9 Late submission of arguments

Examination of arguments received by the Office after the expiry of the time limit will be abandoned. In this context the Office would like to point out that the date on which the Office receives the documents is decisive rather than the date on which the documents were sent.

#### 10.9.1 Confirmation of receipt of documents

(Rule 3.8 IR)

The Office will register the fact that documents have been sent and received. Registration serves as evidence of documents having been sent and received, and the time at which this took place, barring evidence to the contrary.

Consequently the time of receipt of the documents by the Office is decisive rather than the date of on which they were sent.

The user has the opportunity to provide proof of another date, by means of a fax report, for instance, or a confirmation of receipt signed by a staff member of the Office.

PERIOD	TAKES EFFECT	DURATION	ENDS	CONSEQUENCES	EXAMPLES
Opposition period	from publication of the contested trademark application.	Two months	tot en met de eerste van de maand	Admissibility.	Publication on 27 January, the opposition period takes effect on 27 January and ends on 27 March.
Cooling-off period	From the provisional notification of admissibility of the opposition.	Two months	Up to and including the date calculated from the notification date.	Important for suspension by request.	The notification of admissibility is sent on 21 March, the duration of the cooling-off period is up to and including 21 May. The request for suspension must be submitted up to and including 21 May!
Commencement (this is not a time limit with a stipulated duration, but determines the commencement date)	From the notification of provisional admissibility of the opposition.	The commencement date is set at two months plus one day taking effect from the notification of admissibility.	On the date stipulated in the letter.	Important for suspension.	The notification of admissibility is sent on 21 March, the proceedings commence on 22 May.
Regularisation	May be requested at any time during the proceedings and takes effect from the notification date.	Two months	Up to and including the date calculated from the notification date.	If a response is not received: abandon examination of the opposition if the opponent was required to respond, and closure if the defendant was required to respond.	Regularisation on 22 February means the party concerned has up to and including 22 April to respond. The time limit CANNOT be extended!
Arguments	From the notification date (the notification serves as an invitation to the party to submit arguments).	Two months	Up to and including the date calculated from the notification date.	<ul style="list-style-type: none"> <li>▪ If the opponent fails to submit arguments: abandon examination of the opposition.</li> <li>▪ If the opponent fails to submit proof of use: closure.</li> <li>▪ If the defendant fails to respond: closure</li> </ul>	On 22 March the opponent is invited to submit arguments and will be granted a time limit up to and including 22 May to do so.
Suspension by joint request	From the date of receipt of the request.	Four months	The cooling-off period will be extended by two months. The proceedings will be terminated after the cooling-off period. In practice, the time limit already in effect will also be extended by two months in the event of suspension after the proceedings have commenced.		Takes effect on 8 March, the request for suspension must be received on 8 February; new time limit prior to commencement of the proceedings takes effect on 8 May.
Implicit request	From the notification of provisional admissibility.	Two weeks	The time limit will be stipulated in the letter.	Definitively admissible/ inadmissible.	The notification of provisional admissibility is sent on 21 March, the time limit runs up to and including on 4 April.
Time limit granted to the defendant to respond to language preference	From the notification of provisional admissibility.	One month	Up to and including the date calculated from the notification date.	If the defendant fails to respond: English will not be used and the language of the proceedings will be the language in which the defendant's trademark application has been filed, or French in the event an international filing applies.	The notification of admissibility is sent on 21 March, the defendant has up to and including 21 April to respond to the opponent's language preference.

## 11 TERMINATION

This section discusses all possible reasons for terminating opposition proceedings.

### 11.1 Closure

(Article 2.16(3) BCIP)

The parties may jointly, or the opponent may individually, end the opposition at any time during the proceedings and request closure.

With the exception of the case referred to above, Article 2.16(3) BCIP provides for an exhaustive list of the grounds for closing the opposition proceedings. If any such cases occur, the proceedings will end and part of the fees paid will be refunded where appropriate (to find out the amount of the refund, see [Section 8 Financial information](#)).

#### 11.1.1 The opponent has lost the capacity to act

Since this ground for closing the proceedings rarely occurs, no examples from day-to-day practice are available. However, once such case might be illustrated by a licensee who loses the authority to proceed with the opposition during the proceedings. The opposition would in this case be closed.

#### 11.1.2 The opponent has failed to submit proof of use

If the opponent fails to submit documents within the time limit stipulated by the Office in Rule 1.17 IR evidencing that the right to its trademark may not be declared lapsed in accordance with Article 2.26(2)(a) BCIP, the Office will close the opposition proceedings, insofar as it relates to all the rights.

#### 11.1.3 The defendant fails to respond to the opposition filed

Two cases can be distinguished here, viz. the defendant fails to respond to regularisation and the defendant fails to respond to the opposition in its entirety.

In the first case, the defendant must remedy the deficiencies within a time limit of two months, taking effect from the date of the notification of admissibility. This relates specifically to the appointment of a representative, or to communicating a correspondence address in the EU/EEA (see [Section 4.7.3 Details of the defendant](#)). If the defendant fails to do so, the opposition proceedings will be closed and the defendant will be deemed to have renounced its rights to the trademark applied for.

As regards failure to respond to the opposition in its entirety, with effect from 6 December 2006 the Office has given a very restrictive interpretation of this provision in Article 2.16(3)(b) BCIP (opposition decision 2000061, Campina). The Office deemed that any possible response from the defendant sufficed to decide that there was no question of 'failure [to respond] to the opposition filed'. Even if the response merely related to procedural aspects (such as the language of the proceedings) the Office proceeded to take a final decision. Hence, only if the defendant had not undertaken any action at all for the purpose of the opposition, would the opposition be closed and the defendant's trademark application revoked.

As a result of the numerous responses received from interested parties on the evaluation of the effectiveness of the opposition procedure, it was decided that this interpretation was found to be too strict and that the defendant should at least provide a substantive response, if Article 2.16(3)(b) BCIP were to be inapplicable.

As a result, for oppositions filed after 1 April 2011 the Office decided that a substantive response must be received. Consequently, the Office will only apply Article 2.16(3)(b) BCIP if the defendant fails to provide a substantive response to the opposition. In that case the opposition proceedings will be closed and the contested trademark application will be cancelled (DG communication 'Interpretation of Article 2.16(3)(b) BCIP (closing the opposition proceedings due to the defendant's failure to respond) of 23 March 2011).

The Office applies the following definition to non-substantive responses:

- responding to a proposed language preference
- requesting submission of proof of use;
- requesting extension of the cooling-off period, or a suspension;
- appointing a representative to examine the opposition;
- limiting the list of goods and services of the contested trademark application as a result of the opposition.

#### **11.1.4 Ground for the opposition has come to be without cause**

The ground for the opposition may come to be without cause for the following reasons:

- the opposition was withdrawn by the opponent;
- the trademark application against which the opposition was filed has come to be without effect;
- the defendant has implemented a limitation of goods, as a result of which it no longer requires protection for the goods and services against which the opposition was directed.

The opponent may withdraw the opposition at any time during the proceedings, even after the Office has taken a decision. A request to that end submitted to the Office will suffice. If the opposition is withdrawn after the final decision, part of the fees paid will not be refunded (see [Section 13.9.3 Withdrawal of the opposition after the decision has been issued](#)).

The defendant may furthermore decide to limit the goods and services against which the opposition is directed. The Office will in that case establish that the ground for the opposition has come to be without cause and will close the opposition. Part of the fees paid will be refunded to the opponent, where appropriate.

Lastly, the trademark application against which the opposition is directed may have come to be without effect during the proceedings. Logically, here too the ground for the opposition will cease to exist and the proceedings will be closed.

#### **11.1.5 Older trademark is no longer valid**

If the validity of the invoked right lapses during the proceedings, for instance based on a successful (and definitive) invalidation action or if renewal has failed to take place, the Office will – when notified thereof – close the opposition insofar as the opposition is based solely on this single invoked right.

### 11.1.6 Consequences of closure for an opposition against an international filing

If an opposition against an international filing is closed, the Office will notify the International Bureau accordingly by letter. The consequences of closing the opposition for the contested international filing will also be stated.

## 11.2 Examination abandoned

In a number of cases examination of the opposition will be abandoned. The difference between the grounds for closing an opposition is that part of the fees paid may be refunded in the latter case whereas this is not the case if examination of the opposition is abandoned.

The reasons for abandoning examination of the opposition are as follows:

- The opponent fails to respond (within the stipulated time limit) to regularisation of the opposition in the event of a notification of admissibility (see Rule 1.19(1) IR and [Section 6 Regularisation of the opposition](#));
- The opponent has failed to submit arguments (see Rule 1.17(1)(c) IR);
- The opponent has failed to pay the second portion of the opposition fees (see also [Section 9.1.2 Op-out prior to commencement of the proceedings](#)).

## 11.3 Decision

Notwithstanding appeal or the withdrawal of the opposition after the final decision (see [Section 12 Appeal](#) and [Section 13.9.3 Withdrawal of the opposition after the decision has been issued](#), respectively), the final decision will be issued during the last phase of the opposition proceedings. In respect of the final decision there are three possible alternatives, viz.:

- justified in its entirety
- rejected in its entirety
- partially justified.

Where the opposition is justified in its entirety, the opponent will be the successful party and the contested sign will not be registered for the goods and services against which the opposition was filed. Where the opposition is rejected in full, the defendant will be the successful party and the contested sign will be registered.

An opposition will be partially justified only where the opposition was too broad and the Office is of the opinion that while there is a likelihood of confusion between the two signs, this does not apply to part of the goods and/or services specified in the trademark application.

In the event an opposition is justified or rejected in its entirety, the losing party will be ordered to pay the costs. Costs will not be due if the opposition is partially justified (see Article 2.16(5) BCIP as well as [Section 13.9.2 Award of costs](#)).

The Office is neither bound by its own decisions, nor decisions issued by other authorities in similar or other cases.

The Office is required to take an independent decision on the basis of the applicable statutory law and case law in the Benelux (in this context see also GC, Curon).

## 12 APPEAL

(Article 2.17(1) BCIP)

An appeal may be filed with the competent Court of Appeal against a final decision rendered by the Office within a time limit of two months, taking effect from the date of the decision with a view to obtaining an order cancelling the Office's decision (Article 2.17(1) BCIP). The competent Courts of Appeal are the Court of Appeal in Brussels, the Court of Appeal in The Hague and the Court of Appeal in Luxembourg.

### 12.1 Competent Court of Appeal

(Article 2.17(2) BCIP)

The court having territorial jurisdiction will be determined by the address of the original defendant, the address of its representative or by the correspondence address as indicated in the trademark application. If none of these addresses are located in Benelux territory, the court of appeal having territorial jurisdiction will be determined by the address of the opponent or that of its representative. If neither the opponent nor its representative has an address or correspondence address on Benelux territory, the competent Court of Appeal will be the Court of Appeal chosen by the party filing the appeal.

### 12.2 Decision by the Office

In accordance with the judgment of the BCJ in the JTEKT case, the term 'decision' should not only be taken to mean 'decision' in the strict sense of the word, but also the decision to 'abandon examination of the opposition' if it is established that the BOIP will no longer further consider the opposition. This self-evidently also applies to closing the opposition.

### 12.3 Procedure

The parties may lodge a request with the competent court of appeal. The provision setting out that the parties may file an application with one of the courts referred to in Article 2.17.1 BCIP does not preclude initiating an action for annulling the decision in another manner if permitted by national procedural law (see BCJ, JTEKT).

The Court of Appeal must render judgment whereby its decision will overrule the Office's annulled opposition decision, provided that the Court of Appeal only considers the information on the grounds on which the opposition decision was taken or should have been taken by the Office (see BCJ, JTEKT).

If a decision to abandon further examination is reversed by the Court of Appeal, the relevant Court of Appeal must offer the opponent the opportunity to substantiate its opposition further, with due observance of the principles of hearing both sides of the argument (see BCJ, JTEKT).

#### 12.4 The Office is not a party

If a party decides to appeal against an opposition decision issued by the Office, this is deemed a procedure relevant to the parties involved in the opposition. The Office or the BOIP may not be involved as a party to the appeal proceedings, nor as a party to third-party proceedings (see JTEKT judgment).

#### 12.5 Appeal to the Supreme Court

(Article 2.17(3) BCIP)

The decision of the court of appeal will be open to referral to the Supreme Court, which will have suspensive effect.

#### 12.6 Implementation by the Office

(Rule 1.33 IR)

If the judgment passed by the Court of Appeal in an appeal case is no longer open to opposition or to appeal to the Supreme Court, the Office will implement the Court's decision without delay.

However, there are some differences between the procedural rules concerning the court decision acquiring the authority of a final decision in the various Benelux countries. The Office may only proceed to implement the court decision after this decision proves to have the force of a final decision. In the Netherlands this occurs by the mere expiry of the period for taking an appeal to the Supreme Court (three months), whereas this period only takes effect in Belgium and Luxembourg after service. In these countries the period for bringing an appeal against such matters to the Supreme Court is three and two months respectively.

The Office will similarly proceed to implement the decision if it has received confirmation that the parties accept the judgment.



# **PART IV: THE PROCEEDINGS IN CHRONOLOGICAL ORDER**

## 13 COURSE OF THE PROCEEDINGS

(Article 2.16 BCIP and Rule 1.17 IR)

This section sets out the opposition proceedings in chronological order, from the filing of the opposition to the final decision.

### 13.1 Receipt of forms

On receipt of the opposition form the BOIP examines the completeness and accuracy of the information provided (see [Section 5 Admissibility requirements](#)). If the opposition is inadmissible, it will not be examined. The parties will be notified thereof. If the opposition is admissible, however, it will be examined. The BOIP verifies whether the opposition satisfies the minimum legal requirements.

### 13.2 Cooling-off period

From the moment the BOIP has sent the information relating to the admissible opposition to both parties, they will be given the opportunity over a period of two months to determine whether they will be able to resolve their dispute by mutual agreement without the intervention of the BOIP. This is known as the cooling-off period. If the cooling-off period results in an amicable settlement, the opposition can be closed and the BOIP must be notified thereof. In relevant cases part of the fees already paid (i.e. in the event all the fees were paid when filing the opposition) will be refunded (see [Section 8.2 Refunding opposition fees](#)). Self-evidently, parties may also reach an amicable settlement at a later stage. During the cooling-off period, the defendant will be granted one month, taking effect from the notification of admissibility, to indicate whether it agrees with the opponent's language preference.

### 13.3 Commencement

When the cooling-off period has ended and the second instalment of the opposition fees have been paid, the BOIP will notify both parties thereof and the actual opposition proceedings will commence. This is referred to as the commencement of the proceedings.

### 13.4 Exchange of arguments

In principle the opposition proceedings provide for one round per party. The Office functions as a 'post office box' in the administrative phase of the inter partes proceedings within the scope of the IR (see also [Section 17.6.2 Defendant asks for proof of use but the invoked right is not subject to the obligation to be put to genuine use](#)).

### 13.4.1 Opponent's arguments

(Rule 1.17(1)(c) IR)

The opponent has a period of two months, taking effect from the notification of commencement of the proceedings, in which to submit arguments and/or supporting documents to substantiate the opposition and, in relevant cases, to submit documents proving that the earlier trademark is well-known. The Office will then send the opponent's arguments to the defendant, and will grant the defendant two months in which to respond in writing and request proof of use, if necessary; If no arguments are submitted, examination of the opposition will be abandoned.

### 13.4.2 Defendant's arguments

(Rule 1.17(1)(d)(e)(f) IR)

The defendant will be granted a period of two months in which to respond to the opponent's arguments. The defendant's response will be forwarded to the opponent on receipt. The file will be set for a decision.

Insofar as one or more invoked rights are subject to an obligation to be put to genuine use, the defendant will have several opportunities in which to respond on receipt of the Office's letter accompanying the opponent's arguments.

#### 13.4.2.1 No request made for proof of use

There are no invoked rights which are subject to an obligation to be put to genuine use, or the defendant decides against requesting proof of use because the defendant, for example, is convinced of genuine use based on personal observation. The defendant provides a substantive response to the opponent's arguments without delay. This response will be forwarded to the opponent, and the parties will be notified that a decision is set to be taken on the opposition.

#### 13.4.2.2 Requesting proof of use and not yet providing a substantive response

The defendant initially asks for proof of use (see also [Section 17.6 Request by the defendant to submit proof of use](#)) and decides to wait until it receives these documents before providing a substantive response with a view to responding to both the proof of use and the opponent's arguments simultaneously. The Office will forward this request to the opponent and will grant the latter a period of two months in which to submit the requested proof of use or to substantiate that there is no valid reason for non-use (in accordance with Article 2.26(2) BCIP).

If the opponent has failed to submit proof of use, the opposition will be closed (see also [Section 11.1.2 The opponent has failed to submit proof of use](#)) or will only be examined further on the basis of the remaining invoked rights that are not subject to an obligation to be put to genuine use.

If the opponent does submit proof of use, it will be sent to the defendant by the Office. The defendant will be granted a period of two months in which to respond to the proof of use submitted as well as the arguments already forwarded. This response will be forwarded to the opponent, and the parties will be notified that a decision is set to be taken on the opposition.

#### **13.4.2.3 Simultaneously providing a substantive response and requesting proof of use**

The defendant has already provided a substantive response and also asks for proof of use (see [Section 11.1.2 The Opponent has failed to submit proof of use](#)). The Office will forward the defendant's response as well as the defendant's request to the opponent and will grant the latter a period of two months in which to submit the requested proof of use or to substantiate that there is a valid reason for non-use (in accordance with Article 2.26(2) BCIP). It will expressly not be given the opportunity to discuss the defendant's substantive response. This is because only one round is available to each party for this purpose. If the opponent nonetheless does so, the Office will not take this into account when taking the final decision.

If the opponent has failed to submit proof of use, the opposition will be closed or will only be examined further on the basis of the remaining invoked rights that are not subject to an obligation to be put to genuine use.

If the opponent does submit proof of use, it will be sent to the defendant by the Office. The defendant will be granted a period of two months in which to respond to the proof of use submitted. The defendant will not be given any other opportunity to provide further substantive arguments. This response from the defendant will be forwarded to the opponent, and the parties will be notified that a decision is set to be taken on the opposition.

#### **13.4.2.4 The defendant fails to respond**

(Article 2.16(3)(b) BCIP)

Article 2.16(3)(b) BCIP provides that opposition proceedings will be closed if 'the defendant fails to respond to the opposition filed. In this case the defendant will be deemed to have renounced its rights to the trademark applied for'.

In respect of oppositions filed up to and including March 2011, the Office proceeded to take a final decision, even if the response only related to procedural aspects (language preference, for instance). However, a substantive response is required in respect of oppositions filed from 1 April 2011; a purely procedural response from the defendant is no longer deemed a response within the meaning of Article 2.16(3)(b) BCIP (see [Section 11.1.3 The defendant fails to respond to the opposition filed](#)).

##### **13.4.2.4.1 Situation for oppositions filed from 1 April 2011 onwards**

The Office will only apply Article 2.16(3)(b) BCIP to oppositions filed after 1 April 2011 if the defendant fails to provide a substantive response to the opposition. In that case the opposition proceedings will be closed and the contested trademark will not be registered for the goods and/or services against which the opposition was directed (interpretation of Article 2.16(3)(b) BCIP (DG communication: 'Closing an opposition due to the defendant's failure to respond' of 23 March 2011)).

The Office considers these to be non-substantive responses, e.g.:

- responding to a proposed language preference
- requesting submission of proof of use;
- requesting extension of the cooling-off period, or a suspension;
- appointing a representative to examine the opposition;
- limiting the list of goods and services of the contested trademark application as a result of the opposition.

### 13.5 Further arguments when a decision is set to be taken on an opposition

(Rule 1.17(1)(g))

If the Office deems that there are relevant grounds, it may request one or more parties to submit additional arguments or documents for that purpose within a stipulated time limit.

If the parties have failed to express an opinion on the distinctive character of the invoked right, or if the defendant has only done so, while the Office believes that this could play a decisive role in the review of the final decision, in accordance with the principles of hearing both sides of the argument, the Office will offer the parties the opportunity to do so. This practice has resulted from the judgment rendered by the Court of Appeal in The Hague on the Digipass case.

### 13.6 The principle of hearing both sides of the argument

(Rule 1.25 IR)

The Office will observe the principle of hearing both sides of the argument by sending a copy of each relevant document submitted to the BOIP by one party to the other party, even if the opposition is inadmissible. Moreover an opposition decision may only be taken on the grounds against which the parties have put forward a defence and examination of the opposition will be limited to the arguments, facts and evidence submitted by the parties. Facts for which no response has been received from the other party will be deemed undisputed. Incidentally, account will be taken of the fact that whether or not there is a likelihood of confusion is a point of law and must therefore be answered by the Office (GC, AMS). In answering this question the Office may also consider the facts concerning the trademark being well-known (GC, Picaro).

### 13.7 Transfer of opposition to the other party, or the representative

If either party appoints a representative or a different representative during the proceedings, the Office will confirm this to the parties. The Office will not send to the new party all the documents already submitted. If the new party wishes to receive these documents, copies of the documents may be requested in accordance with Rule 4.5(3)(b) IR. In all other cases, the arguments and other documents submitted by the parties, irrespective of whether they have been put forward orally or in writing, may only be accessed by third parties with the consent of the parties, as provided for in Rule 1.30 IR.

### 13.8 Hearing

(Rule 1.27 IR)

A hearing may be held ex officio or at the parties' request if the Office deems there are grounds for a hearing. The hearing will proceed in accordance with the regulations drawn up by the DG ('Regulations concerning the hearing in opposition proceedings' of 1 September 2006).

## 13.9 Decision

(Rules 1.30 and 1.31 IR)

After the examination of the opposition has been completed, the Office will reach a decision as soon as possible (see [Section 11.3 Decision](#) and [Section 12.2 Decision by the Office](#)). If the opposition is held to be justified, the Office will refuse to register the trademark in whole or in part. Otherwise, the opposition will be rejected. The notice of opposition and the opposition decision are public. However, the notice of opposition will not be published on the Office's website but is available on request.

Opposition decisions are published on the BOIP's website. An opposition decision contains the following information:

- a. the opposition number
- b. the decision date
- c. the parties' names and, in relevant cases, the names of their representatives
- d. information relating to the trademarks relevant to the opposition proceedings
- e. a summary of the facts and the course of the proceedings
- f. in relevant cases, an analysis of the proof of use
- g. a comparison of the trademarks and the goods and services to which the trademarks relate
- h. the Office's decision
- i. the decision concerning the costs
- j. the name of the rapporteur from the Opposition Department and the other two members that have taken part in the decision-making process
- k. the name of the administrative officer handling the file.

### 13.9.1 Final decision

The Office's decision will only become final when it is no longer open to appeal or, if applicable, until the decision of the Court of Appeal is no longer open to reversal by the Supreme Court (see [Section 12 Appeal](#)).

### 13.9.2 Award of costs

(Article 2.16(5) BCIP and Rule 1.32 IR)

The losing party will be ordered to pay the costs. The costs will be determined in accordance with the provisions of the Implementing Regulations, viz. a sum equalling the basic opposition fee, which is EUR 1,000. No costs will be incurred if the opposition is partially justified.

The Office's decision concerning determination of the costs will constitute an enforceable order. Its forced execution will be governed by the rules in force in the State where execution takes place (see [Section 8.4 Award of costs](#)).

### 13.9.3 Withdrawal of oppositions after the decision has been issued

(Rule 1.32(2) IR)

In accordance with Rule 1.32(2) IR as well as the rule laid down by the DG on 9 September 2008, opponents may withdraw any oppositions they have filed in their entirety until such time as the Office's decision, pursuant to Article 2.16(4) BCIP, becomes final.

The only consequences of withdrawing oppositions as referred to above – after the Office has taken a final decision – is that the Office will not implement its decision. This does not mean that the ground for ordering payment of the costs (Article 2.16(5) BCIP) will come to be without cause.

Moreover in the event of withdrawal after a decision has been issued as referred to above, the opposition fees paid will not be refunded.

### 13.10 Course of the proceedings step-by-step

- Filing an opposition and payment of at least the first portion of the opposition fees
- Establishing admissibility and/or regularising the opposition
- Notifying both parties of the admissibility or inadmissibility of the opposition
- The defendant has one month in which to confirm agreement or disagreement with the opponent's language preference
- Commencement of cooling-off period (a period of two months, which may be extended at the parties' joint request)
- Payment of the second portion of opposition fees
- Commencement of the proceedings and notification thereof to the parties
- Submitting arguments and supporting documents, or if the opposition was based on a well-known trademark evidence must be provided by the opponent proving that the trademark is well-known (time limit: two months)
- Counter-arguments must be submitted by the defendant and, if desired, proof of use of the older trademark requested (time limit: two months)
- In relevant cases, the opponent must submit proof of use of the older trademark (time limit: two months)
- In relevant cases, the defendant must submit proof of use of the older trademark (time limit: two months)
- The BOIP may request parties to submit further arguments or documents
- A possible hearing
- Decision by the BOIP.

# **PART V: SUBSTANTIVE ASPECTS**



## 14 BASIS FOR THE OPPOSITION

(Article 2.14(1)(a) and/or (b) BCIP in conjunction with Article 2.3(a) and/or (b) BCIP)

The basis for the opposition lies in Article 2.14(1)(a) and/or (b) BCIP in accordance with the provisions of Article 2.3(a) and/or (b) BCIP.

### 14.1 In what cases can an opposition be filed?

An opposition may be filed against a later trademark in the following cases:

- a. if identical trademarks have been filed for identical goods or services;
- b. if identical or similar trademarks have been filed for identical or similar goods or services, and there is a likelihood of confusion on the part of public, including the likelihood of association with the earlier trademark;
- c. if the later trademark is likely to cause confusion with a well-known trademark as defined in section 6bis of the Paris Convention.

#### 14.1.1 Identical trademarks filed for identical goods or services

In order to base an opposition on Article 2.3(a) BCIP, two cumulative conditions must be fulfilled, viz. identical signs and identical goods or services.

The criterion for the identity of a trademark and a sign is very strict; a sign is only identical to a trademark if it reflects all the elements of the trademark without any modifications or additions, or when looking at the sign as a whole it shows differences that are so insignificant they may escape the notice of the average consumer (see CJEU, LTJ Diffusion v Sadas Vertbaudet).

If the goods or services relating to the invoked right comprise the goods or services for which an application was filed for the contested sign, these goods or services will be deemed identical (see GC, Aventis Pharma/OHIM – Nycomed GmbH).

#### 14.1.2 Identical or similar trademarks filed for identical or similar goods or services plus the likelihood of confusion

If Article 2.3(b) BCIP is invoked, the following three conditions must be fulfilled:

- a. identical or similar signs
- b. identical or similar goods or services
- c. confusion on the part of the public.

The above conditions are cumulative conditions (see CJEU, Il Ponte Finanziaria/OHIM – F.M.G. Textiles).

According to established case law concerning the interpretation of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, the likelihood of confusion on the part of the public, which is defined as the likelihood that the public may believe that the relevant goods or services are from the same undertaking or, in relevant cases, from economically connected undertakings, must be assessed globally, having regard for all relevant circumstances relating to the specific case (see inter alia CJEU, Canon and Lloyd Schuhfabrik Meyer).

It follows from the wording of Article 5(1)(b) of the Directive (compare Article 2.3(b) BCIP), according to which 'there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier mark,' that the impression left with the average consumer of the type of goods or services concerned, plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its details (CJEU, Sabel).

A likelihood of confusion has to be assessed globally, taking into account the visual, aural or conceptual similarity of the signs, based on the overall impression evoked by the trademarks, and inter alia with reference to their distinctive and dominating components (see CJEU, Sabel and Lloyd Schuhfabrik Meyer).

In the context of an opposition under Article 2.14(1)(a) BCIP in conjunction with Article 2.3(b) BCIP, it is assessed whether there is a likelihood of confusion. Consequently, in the context of opposition proceedings an opponent is not required to demonstrate that confusion in fact occurred.

#### **14.1.3 Confusion with a well-known trademark**

An opposition may furthermore be filed if the proprietor of a well-known trademark believes that the trademark applied for can give rise to confusion with its own well-known trademark (see [Section 15 Well-known trademark](#)).

In the context of opposition proceedings the scope of a well-known trademark in accordance with Article 6bis of the Paris Convention is limited to the situations in which there is a likelihood of confusion. This is expressly set out in Article 2.14(1)(b) BCIP in conjunction with Article 6bis of the Paris Convention as well as in the Joint Recommendations of the International Bureau. The cases in which there is no likelihood of confusion can therefore also not be at issue in oppositions examined by the Office. Benelux oppositions which are based on an unregistered trademark are subject to the same criteria as oppositions based on a registered trademark, in other words the opposition must be assessed on the basis of following criteria: the identity or similarity of the signs, the identity or similarity of the goods and/or services and the likelihood of confusion (BOIP opposition decision, Formula 1, 2000149, 27 February 2009).

There is only a likelihood of confusion if two (cumulative) conditions have been fulfilled: the trademarks must be similar and the goods or services must be similar. If one of these conditions is not satisfied, this means there is no likelihood of confusion.

#### **14.1.4 Unfair advantage or detrimental to the distinctiveness or reputation of the earlier trademark has no basis**

Reference to Article 2.3(c) BCIP has explicitly not been incorporated in Article 2.14(1)(a) BCIP.

Consequently, it is not possible to file an opposition on the basis of a well-known trademark against a contested sign for goods or services that are not similar.

#### **14.1.5 Bad faith**

The argument that an invoked right was said to have been acquired in bad faith cannot play a role in opposition proceedings. The Office's opposition procedure is designed as a fast and easy way to resolve conflicts between trademark proprietors. For this reason, the procedure is limited to specific grounds as explained above. The applicability of these articles is only assessed on the basis of the entries that appear in the Trademarks Register.

## 15 WELL-KNOWN TRADEMARK

### 15.1 Legislation

In accordance with Article 2.14 BCIP the applicant or proprietor of an older trademark may file within a period of two months, to be calculated from the publication of the trademark applied for, an opposition in writing with the Office against a trademark, the order of priority of which ranks after that of the applicant or proprietor, in accordance with the provisions of Article 2.3(a) and (b) BCIP, or which may create confusion with its well-known trademark as defined in Article 6bis of the Paris Convention. Under Rule 1.17 IR the opponent is granted a period of two months in which to submit, concurrently with the arguments, documents evidencing that the earlier trademark is well-known.

Article 6bis of the Paris Convention reads as follows:

The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of an industrial or other trademark, which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well-known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

Account must furthermore be taken of Article 16(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter: TRIPs Agreement). The link with the TRIPs Agreement is associated with the judgment of the Court in The Hague on 'Marie Claire v Ipko-Amcor: 'Having regard to the wording and scope of Article 16 of the TRIPs Agreement, the Court ruled that that provision has direct effect.'

Article 16(2) of the TRIPs Agreement provides for the following:

... In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark. Hence it is key that the trademark is well-known in the sector of the public relevant to that product.

Joint Recommendations of the International Bureau

The term 'well-known trademark' must additionally be assessed in the light of the 'Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks' approved by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at de Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO from 20 to 29 September 1999.

Different factors are taken into consideration in the Joint Recommendations, such as degree of familiarity or recognition of the trademark in the relevant sector of the public, the duration, the intensity and geographical extent of the use or the promotion of the trademark or the value attached to the trademark. Other references may also be relevant, such as the duration and geographical extent of registration or any application for registration of the trademark reflecting the use or recognition of the trademark, a list showing the successful enforcement of trademark rights and the degree to which the trademark was recognised as a well-known trademark by the competent authorities.

The above factors serve as guidelines for determining whether a trademark is well-known, but do not serve as conditions and hence are not exhaustive. The circumstances must be examined on a case-by-case basis. In some cases all factors will apply while in other cases only a number of the factors will apply.

## 15.2 Case law

The Chevy (CJEU) case concerned the question of how to interpret the meaning of the concept of a ‘trademark with a reputation’ in Article 5(3)(a) of the Directive, on the one hand, and on the other, the question of whether this condition should have been met in the whole of the Benelux territory or whether it is sufficient that the trademark has a reputation in only part of that territory.

The answer to the first part of the question is that when examining whether a trademark has a reputation all relevant circumstances of the case must be taken into consideration, particularly factors such as the market share of the trademark, the intensity, the geographic extent and the duration of use, and the size of the investments made by the undertaking in promoting it (CJEU, Chevy).

The answer to the second part of the question is that a Benelux trademark cannot be required to enjoy a reputation throughout the whole of the Benelux territory. The fact that the trademark has a reputation in a substantial part of the territory will suffice, which in relevant cases may be part of one of the Benelux countries (CJEU, Chevy).

The opinion delivered by the Advocate General in the Chevy case held the following in respect of grounds 32 and 33: “In order to understand the relationship between the terms ‘well-known’ and ‘reputation’ it is useful to consider the terms and purpose of the protection afforded to well-known trademarks under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs):” ...‘The purpose of the protection afforded to well-known trademarks under these provisions appears to have been to provide special protection for well-known trademarks against exploitation in countries where they have not yet been registered. The protection of well-known trademarks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded even to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation.”

The manner in which ‘reputation’ is defined in the Chevy case and a comparison of the definition of ‘well-known’ trademarks in the Joint Recommendations show that there is considerable overlap between the legal concepts of a well-known trademark and a mark with a reputation.

## 15.3 Definition of the public

The relevant sectors of the public may comprise the following:

- (i) actual and potential consumers of the type of goods and/or services to which a trademark applies;
- (ii) persons involved in distribution channels of the type of goods and/or services to which a trademark applies;
- (iii) business circles dealing with the type of goods and/or services to which a trademark applies;

Where a mark is determined to be well-known in at least one relevant sector of the public in the Member State, the mark will be considered by the Member State to be a well-known mark. Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark will be considered by the Member State to be a well-known mark. A Member State may also determine that a mark is a well-known mark even if the mark is not well-known/known in any relevant sector of the public in the Member State in accordance with the conditions set out in the Joint Recommendations, Article 2(2)(iii).

This concerns the mark being known by the public at large in the Member State, both consumers and non-consumers. Simply being known at the level of the relevant branch of trade or interested circles is insufficient (Supreme Court of the Netherlands [Hoge Raad der Nederlanden], *Orchidee*). This was upheld by the Court of Appeal in Brussels in its judgment in *Panoxyl v Pannogel*.

#### 15.4 Time of determination of being well-known

It must be determined whether the trademark was well-known at the time the opposed trademark was filed.

A reputation acquired later no longer constitutes a threat to the trademark applied for. Incidentally this is upheld by the doctrine and the EUIPO too pursues this practice<sup>1</sup>.

#### 15.5 Well-known trademarks but not for dissimilar goods and services

In the context of opposition proceedings the scope of a well-known trademark in accordance with Article 6bis of the Paris Convention is limited to the situations where there is a likelihood of confusion. This is expressly set out in Article 2.14(1)(b) BCIP in conjunction with Article 6bis of the Paris Convention as well as in the Joint Recommendations of the International Bureau. The cases in which there is no likelihood of confusion can therefore also not be at issue in oppositions examined by the Office. Benelux oppositions which are based on an unregistered trademark are subject to the same criteria as oppositions based on a registered trademark, in other words the opposition must be assessed on the basis of following criteria: the identity or similarity of the signs, the identity or similarity of the goods and/or services and the likelihood of confusion (BOIP opposition decision, Formula 1, 2000149, 27 February 2009).

<sup>1</sup> Gielen, Ch. and Verkade, D.W.F., *Tekst & Commentaar Intellectuele Eigendom*, Kluwer Deventer 2005 and inter alia opposition decision B 535502 OHIM 21 December 2005.

## 16 COMPARISON OF SIGNS, THE GOODS AND SERVICES AS WELL AS GLOBAL ASSESSMENT

As stated earlier in [Section 14 Basis for the opposition](#), whether the signs are identical and the goods and services are similar are cumulative conditions. Therefore there is no likelihood of confusion if the signs are not similar in at least one respect, even if the goods and services would be identical (see in this context: GC, easyHotel and YoKaNa).

For this reason, when taking a decision - and for the sake of judicial efficiency – the Office will not discuss the comparison of the goods or services if it has already been established that the signs are not similar (and vice versa). Under the provisions of Article 2.3(b) BCIP there is no likelihood of confusion if the signs are not similar (and vice versa).

### 16.1 Comparison of signs

A likelihood of confusion has to be assessed globally, taking into account the visual, aural or conceptual similarity of the signs, based on the overall impression evoked by the trademarks, and inter alia with reference to their distinctive and dominating components (see *Sabel and Lloyd Schuhfabrik Meyer*).

When comparing the signs, the Office uses the signs as entered in the respective registers and therefore cannot take account of the way in which they are used on the market.

### 16.2 Comparison of goods and/or services

In assessing the similarity of the goods or services concerned, account must be taken of all the relevant factors distinguishing the connection between the goods or services. These not only include their nature, destination and use but also whether they are in competition or complementary (CJEU, *Canon*).

The Office applies the following gradations to the comparison of goods or services:

- identical
- high degree of similarity/strong similarity
- similar
- slightly similar
- not similar/different.

#### 16.2.1 Use of class headings

All goods and services for which trademarks may be registered are grouped in classes according to an international standard referred to as the Nice Classification. The notes to this classification refer to the various classes by means of a system of shortened titles, which use general terms to describe the types of goods and services that fall into a given class (known as 'class headings'). A more detailed classification instrument is the alphabetical list of goods and services, which list is also administered by the International Bureau.

On 19 June 2012, the European Court of Justice ruled on three points of law in the case referred to as *IP Translator*. In its ruling the CJEU first and foremost stated that the goods and services for which the protection of the trade mark is sought must be identified by the applicant with 'sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trademark'.

The general indications of the class headings may only be used if they are sufficiently clear and precise to identify the goods and services for which trademark protection is sought. If this is not the case, the applicant must specify which goods and services in that class are intended to be covered. The use of class headings does not mean that all goods or services automatically fall into the relevant class. The trademark is deemed to have been applied solely for those goods or services stated in the heading. See for more information 'DG communication regarding the classification and use of class headings' of 22 August 2012.

### **16.2.2 Consequences of the lack of clarity and precision of a term**

The responsibility for an accurate description of goods and services always rests with the trademark proprietor. It is up to him to determine the extent of the protection he wishes to claim and to do so in terms that are sufficiently clear and precise for others to understand them.

Existing registrations can be restricted at the request of the holder. If a registration contains a term that is insufficiently clear and precise, BOIP will allow a restriction to goods or services that are sorted in the same class and can be considered to fall under the natural and usual meaning of that term. It is up to the parties in an opposition proceeding to take the initiative to restrict the list of goods or services of their registration or application if they deem that to be appropriate. BOIP will not actively invite them to do so, since this would be at odds with the role BOIP should fulfil as deciding authority in inter partes proceedings and with the principle that it is up to the parties to determine the extent of the dispute and their pleas.

In oppositions BOIP will apply the general rule that the consequences of the lack of clarity and precision of a term are borne by the party that uses it. So in case of an opposition in which one party invokes vague terms and the other party terms that are sufficiently clear and precise, BOIP will rule in favour of the latter.

### **16.2.3 Classification purely for administrative purposes**

The classification is used solely for administrative purposes and Article 2.20(3) BCIP expressly provides that the classification under the Nice Agreement is not taken into account in the assessment of the similarity of the goods or services. The latter therefore do not need to appear in the same class or even in a specific category of the same class to reach the conclusion that there is a similarity or that there is no similarity between these goods and services (in this context, see also GC, Manso de Velasco).

#### **16.2.3.1 Complementarity**

Complementarity only exists if the goods and/or services are interdependent to such a degree that a product or service is indispensable or important for the use of the other so that consumers might believe that the two products and services are produced by the same undertaking (in this context, see GC, The O Store, Sissi Rossi, Pam Pluvial and Pirañam).

#### **16.2.3.2 In particular**

The phrase 'in particular' does not at all rule out that the component referred to before the phrase forms part of the list of goods or services (GC, Tuffride v Nu-Tride). The above therefore does not concern a limitation of the list of goods or services.

#### **16.2.3.3 Entries in the register rather than actual use are important**

The actual use of the relevant signs cannot be taken into account in opposition proceedings as the signs are only compared on the basis of entries in the register and in relevant cases on the basis of proof of use. Factors such as marketing and sales formulas, which moreover may change over time, therefore do not play a role in an opposition (CJUE, Quantum, O2 Holdings Limited and GC, Ferromix, etc.).

## 16.3 Global assessment

The global assessment of the likelihood of confusion assumes there is a certain degree of interdependence between the factors to be taken in account, particularly between the similarity of the signs and the similarity of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa (CJUE, Canon and Lloyd Schuhfabrik Meyer).

### 16.3.1 Distinctive character

The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (CJEU, Canon, Sabel and Lloyd Schuhfabrik Meyer).

### 16.3.2 A weak distinctive character does not preclude the likelihood of confusion

It cannot be concluded from European Court of Justice case law that by definition there is no likelihood at all of confusion due to the weak distinctive character of the invoked right. Even though the distinctive character of the marks does indeed play a role in assessing the likelihood of confusion, this is but one of the elements factored into the assessment (CJEU, Ferromix).

There may even be a likelihood of confusion in the case of an earlier mark with little distinctive character because the signs are identical and the goods and services are similar (CJUE, Compressor technology and GC, Pages Jaunes).

### 16.3.3 A fanciful name does not necessarily imply greater distinctiveness

The fact that a trademark has a fanciful name does not imply that its distinctiveness is greater than usual and the scope of the protection broader than usual. After all, as set out in Article 2.1(1) BCIP by definition a mark must have distinctive character (in this context, see also Roxstar, Court of Appeal The Hague [Gerechtshof 's-Gravehage]).



## 17 PROOF OF USE

(Article 2.16(3) BCIP and Rule 1.29 IR)

If an invoked mark – calculated from the publication date of the contested trademark application – has been registered for five years or more, the trademark in question is subject to an obligation to be put to genuine use.

Rule 1.29(1) IR provides that the documents evidencing proof of use of the trademark referred to in Article 2.16(3)(a) BCIP be requested and submitted in accordance with the rules laid down in Rule 1.17(1)(d)(e) and (f) IR. Hence, when it is the defendant's turn to respond to the opponent's arguments, it is up to the defendant to either request or not request proof of use in the course of the proceedings. This request may relate to all or only some of the invoked rights which are subject to an obligation to be put to genuine use, or to all or some of the goods and services on which the opposition is based. Such a request must, however, always be formulated explicitly. If the defendant so requests, the Office will grant the opponent a time limit of two months in which to submit the requested proof of use.

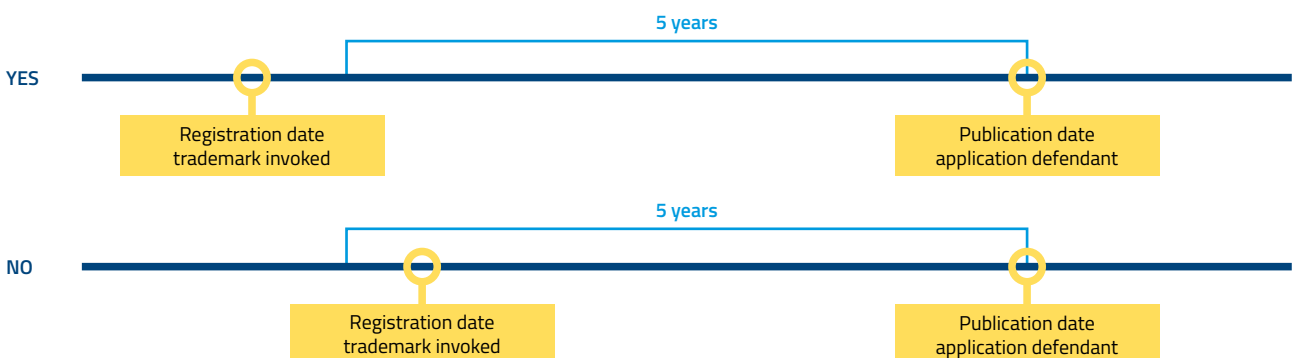
The proof of use should contain references to the location, duration, extent and method of use of the earlier trademark for the goods and services on which the opposition is based. The evidence must prove use in the period of five years prior to the publication date of the trademark against which the opposition is directed. This period is not required to be a consecutive period.

### 17.1 Calculating the time limit

The starting point for calculating the obligation to be put to genuine use to which the invoked right is subject is the publication date of the contested trademark application. The five preceding years should then be calculated from that date.

If the registration date of the opponent's invoked right is an earlier date, this means that it is subject to an obligation to be put to genuine use and the opponent must submit proof of use at the defendant's request. However, if the registration date falls within this five-year period, the invoked right in this opposition is not subject to the above obligation and the defendant cannot request proof of use.

The diagram below shows the calculation (YES = subject to an obligation to be put to genuine use; NO = not subject to this obligation).



## 17.2 Determining the registration date

The Office has not always determined a registration date due to the fact that determination of a registration date only entered into force on 1 January 2004.

### 17.2.1 For trademarks filed up to and including 31 December 1995

The Benelux Trademark Act (article 8) which applied until that date provided that the filing date would also apply as the registration date.

### 17.2.2 For trademarks filed between 1 January 1996 up to and including 31 December 2003

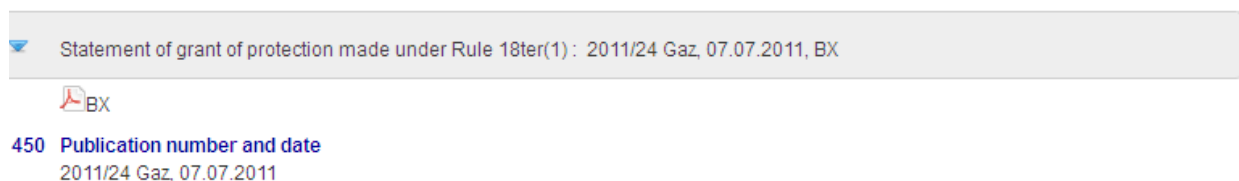
No registration date was determined for the above trademarks. In relevant cases, the BOIP can issue a statement about the date that would have applied as the registration date of the relevant trademark by operation of the IR currently in force, i.e. the date on which the officer handling the filing establishes that a file is ready (see DG communication 'Determination of the registration date' of 21 December 2005). This procedure was also upheld in the CJEU judgment in Häupl. The above date will also be used in the assessment of the period of five years which is relevant for requesting proof of use for oppositions.

### 17.2.3 For trademarks filed from 1 January 2004 onwards


The registration date of a trademark is the day on which the officer handling the trademark applied for establishes that a file has been finalised on completion of all the administrative processes. The date on which this is established is important rather the time at which this could have been established. This procedure is set out in Rule 1.6(3) IR. The registration date is published in the online Trademarks Register.

#### 17.2.3.1 Determining the registration date of an international trademark application valid in the Benelux

As explained above, the Office allocates a registration date to the Benelux portion of an international trademark application which is valid in the Benelux. The registration can be found in the International Register of the International Bureau, referred to as the Grant of Protection (GOP). The applicable registration date is the date of publication by the International Bureau of the GOP, and is shown as follows in the International Trademark Database ([Madrid Monitor](#)):



▼ Statement of grant of protection made under Rule 18ter(1) : 2011/24 Gaz, 07.07.2011, BX

 BX

**450 Publication number and date**  
2011/24 Gaz, 07.07.2011

The date of registration in the Benelux of the above international registration is 7 July 2011.


### 17.2.3.2 Determining the registration date of an international trademark application valid in the European Union

The EUIPO determines registration for the European Union. For the purpose of recording registration in the International Register, the EUIPO sends confirmation of registration – by means of a GOP – to the International Bureau. Here too, the publication date of the GOP in the International Register applies as the registration date, and hence not the date of the EUIPO's letter, for instance (see Articles 151 and 152 EUTMR).

However, please bear in mind that the EUIPO sends two communications to the International Bureau, one on completion of the review on absolute grounds and the other when the opposition period or any oppositions filed have expired.

The first communication (... subject to opposition...) is NOT the correct registration date:

▼ Ex Officio examination completed but opposition or observations by third parties still possible, under Rule 18bis(1) : 2011/13 Gaz, 21.04.2011, EM

 EM

**450 Publication number and date**  
2011/13 Gaz, 21.04.2011

**Opposition end date**  
25.12.2011

However, the second communication (the GOP) is the correct registration:

▼ Statement of grant of protection made under Rule 18ter(1) : 2012/4 Gaz, 16.02.2012, EM

 EM

**450 Publication number and date**  
2012/4 Gaz, 16.02.2012

The date of registration in the European Union of the above international registration is 16 February 2012.

## 17.3 Documents substantiating genuine use

(Rule 1.29 (3) IR)

The documentary evidence should preferably be limited to items on paper, such as packaging, labels, price lists, catalogues, invoices, photographs and newspaper advertisements. If the costs for forwarding the documentary evidence to the defendant exceed EUR 25, they will be borne by the opponent (Rule 1.29(3) IR).

If necessary, files on digital carriers, such as CDs, CD-ROMs and DVDs may also be submitted. Two identical copies of the above carriers must also be submitted. If you are uncertain about whether a certain carrier or medium will be accepted, please contact the Office.

### 17.3.1 Concept of 'genuine use'

In the judgment rendered by the European Court of Justice of 11 March 2003 (CJEU, *Ansul*) 'genuine use' must be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trademark, which is to guarantee the identity of the origin of the goods or services for which it has been registered in order to create or preserve an outlet for those goods or services. In this context the requisite genuine use of the mark means that that this mark as protected on the relevant territory, is used publicly and in the outside world (see also *GC, Silk Cocoon, Vitafruit and Charlott*).

The Court held that the use of the earlier mark need not always be quantitatively significant for it to be deemed genuine use (*GC, Hipoviton and Sonia Sonia Rykiel*). The concept of genuine use does not seek to assess the commercial success of or to monitor the economic strategy of the undertaking, nor to limit trademark protection to the cases in which quantitatively significant commercial use is made of the trademark (*GC, Vitafruit*).

In addition the Court ruled that genuine use of a mark cannot be assumed on the basis of probability or presumptions but that genuine use must be proven on the basis of concrete and objective facts proving the actual and sufficient use of the mark in the relevant market (*GC, Hiwatt, Vitakraft and Sonia Sonia Rykiel*; see also *inter alia* BOIP opposition decision in *European Yellow Pages*).

The smaller the commercial exploitation of the trademark, the greater the need for the trademark proprietor to bring additional facts to remove any doubts about the genuine use of the relevant trademark (*GC, Vogue*). Following on from the above, the Court of Appeal in Brussels ruled in the *Appassionato Arte* case that the extent of use, in terms of volume as well as frequency and intensity, must be compared against the market.

### 17.3.2 Undated documents or documents outside the relevant period

The opponent determines which documents to submit to substantiate the genuine use of its mark during the relevant period of use. The fact that a number of documents may not contain a date or fall outside the relevant period does not necessarily mean that the Office will not examine these documents. Even if a document dates after a certain date, in some cases conclusions may be drawn from them about a situation that occurred before that date (CJEU, *Aire Limpio*). Moreover these documents could support the other items of evidence put forward (*GC, Vitafruit*). Consequently, the Office will always assess all the documents submitted on a case-by-case basis to determine whether the mark is genuinely used.

## 17.4 Territory of use

### 17.4.1 Benelux or international trademark

If the invoked right, which is subject to an obligation to be put to genuine use, is a Benelux or international mark, the opponent is required to prove the genuine use of the mark in the Benelux territory (Article 2.16(3)(a) in conjunction with Article 2.26(2)(a) BCIP).

## 17.4.2 European Union trademark

If the invoked right that is subject to an obligation to be put to genuine use is a European Union trademark, such obligation is governed by Article 18 EUTMR, which provides as follows:

‘If within a period of five years following registration, the Proprietor has not put the European Union trademark to genuine use in the European Union in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the European Union trademark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use.’

For proof of use of European Union trademarks, contrary the provisions of Article 2.26(2)(a) BCIP, the mark therefore does not need to have been used on Benelux territory during the relevant period.

However, the opponent must prove that the mark was put to genuine use within the European Union in that period. In its opposition decision in the *Onel* case and the following decisions in the *Robertson*, *ONE* and *Simson* cases, the Office established that national borders within the European Union should not play a role and that all relevant circumstances of the case must be taken into consideration to establish whether the mark has been put to genuine use. A key factor in the above is the market in which the opponent operates with its invoked right.

In its judgment of 19 December 2012 (*Onel*), the CJEU ruled on the interpretation of Article 18 EUTMR. Concerning the phrase ‘within the Community’ the Court found that there is a difference between the territorial scope of the protection afforded to national trademarks and the protection afforded to European Union marks. A European Union trademark enjoys broader protection in terms of territory than a national trademark. As a result a European Union trademark can reasonably be expected to be used across a larger territory, notwithstanding the (exceptional) case that the market for the relevant goods and services in practice is limited territorially. The territorial borders of the Member States should be abstracted. The Court ruled as follows:

“A Community trademark<sup>2</sup> is ‘put to genuine use’ within the meaning of Article 15(1)<sup>3</sup> CTMR 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the EU for the goods or services covered by it. It is for the referring courts to assess on a case by case basis and in the main proceedings whether the conditions are met, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trademark, and the territorial extent and the scale of the use, as well as frequency and regularity.”

The threshold for the genuine use of a European Union trademark as a rule is therefore higher than for the genuine use of a national (or Benelux) trademark. It must be demonstrated that the trademark is used to maintain or acquire market share in the European Union, taking account of all the relevant facts and circumstances.

## 17.5 Language of the supporting documents

(Rule 1.24 IR)

Documents serving to support arguments or to prove the use of a trademark may be submitted in their original language. The documents will only be considered if the Office judges that they can be sufficiently understood, in the light of the reason for their submission.

Invoices, for instance, can easily be identified due to their nature, just as advertising in most cases.

<sup>2</sup> Now called: European Union trademark. <sup>3</sup> Now: article 18 Regulation 2017/1001.

## 17.6 Request by the defendant to submit proof of use

After receipt of the opponent's arguments, the defendant may request proof of use, which may be combined with a substantive response or otherwise (see [Section 13.4.2 Defendant's arguments](#)).

### 17.6.1 The defendant must expressly request proof of use

The defendant must expressly request the opponent to submit proof of use as provided for in Rule 1.17(1)(d)(e)(f) IR. If a defendant responds to the opponent's documents, which have not been submitted as proof of use, but which were understood to be such documents by the defendant, the Office will not take the defendant's response to mean an implicit request to the Opponent to submit proof of use.

### 17.6.2 The defendant requests proof of use but the invoked right is not subject to an obligation to be put to genuine use

If the defendant requests proof of use, the Office will at all times forward this request to the opponent and grant the latter a time limit of two months for response. The Office acts in the administrative phase of the inter partes proceedings as a 'post office box' within the scope of the IR. If the opponent establishes that the invoked right is not yet subject to an obligation to be put to genuine use, in view of the pace of the proceedings it would be advisable to communicate this in writing as soon as possible. The Office will then notify the defendant and in relevant cases proceed to take a final decision (see [Section 13.9 Decision](#)).

If the invoked right is not yet subject to the above obligation, when taking the final decision the Office will consider that the defendant's request was unfounded. Even if the opponent had responded to the defendant's request and submitted proof of use, the Office will not further examine the latter.

### 17.6.3 The defendant requests proof of use but the opponent has already submitted documents

If an opponent has already submitted arguments to prove use, the defendant is still at liberty to request that proof of use be submitted. After all, Rule 1.17 IR expressly sets out the course of the proceedings. It will in that case suffice – if the opponent believes that sufficient proof of use has already been submitted – for the opponent to refer to the documents previously submitted. This concerns inter partes proceedings and the parties themselves must therefore determine which arguments and means that they put forward. The opponent may also refer to documents previously submitted for the assessment of genuine use, even though they had originally been submitted for other purposes, such as substantiating the reputation of the invoked right.

#### 17.6.3.1 Proof of use may not be used to substantiate reputation

As explained above, the opponent may refer to documents that were submitted to substantiate the reputation of an invoked right or the invoked well-known trade mark, where applicable. By contrast, when submitting proof of use the opponent cannot indicate that it equally serves as evidence of reputation. Under Rule 1.17(1)(c) IR such documents must always accompany the arguments.

#### 17.6.3.2 The opponent may renounce invoked rights

If all the invoked rights are not subject to an obligation to be put to genuine use, the opponent may renounce one or more invoked rights to enable the opposition to proceed without submitting proof of use. In that case the opposition decision will be based solely on the remaining invoked rights (which are not subject to the above obligation).

### 17.7 The defendant may withdraw the request

(Rule 1.29(4) IR)

The defendant may withdraw its request to submit proof of use (Rule 1.29(4) IR). The Office will notify the opponent in relevant cases. If the defendant has not yet provided a substantive response to the opponent's arguments, the defendant will be granted a time limit of two months in which to do so. If the defendant had already provided a substantive response, the Office will take a final decision as soon as possible.

### 17.8 The defendant has not responded to proof of use (agreed between the parties)

If the defendant has not provided any further response to the proof of use submitted by the opponent, the Office will not assess the proof of use either. Rule 1.25(d) IR provides that 'facts to which the other party has not responded will be deemed undisputed'. If the defendant has not responded to the proof of use submitted, the parties clearly agree that the invoked right has been put to genuine use.

### 17.9 The Office may not invoke revocation failing proof of use

The Office does not have the authority to invoke the revocation of a trademark failing proof of use; this falls to the jurisdiction of the court. The Office does not have such authority, inter alia because the opposition proceedings only apply to the issue of whether the defendant's trademark is valid (see also: ['Explanatory notes of the Benelux Office to Titles II, III and IV of the Benelux Convention on Intellectual Property'](#)).

If the trademark was only used for some of the goods and/or services for which it was registered, the Office's final decision will be based on the goods and services for which use of the trademark has been proven (Rule 1.17(1)(e) IR).

In the above context, see also GC, Aladdin:

The concept of partial use serves to ensure that trademarks that are not used for a given category of goods or services are not rendered unavailable. It must not however, result in the proprietor of the earlier trademark being stripped of all protection for goods or services, although not strictly identical to those in respect of which he succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner.

### 17.10 Well-known trademarks are not subject to an obligation to be put to genuine use

A well-known trademark within the meaning of Article 6bis of the Paris Convention is not subject to the above obligation. The word 'use' in the Article does not provide for maintaining use. Article 2.26(2)(a) BCIP refers to a registered trademark and therefore is inapplicable. It furthermore follows from Article 2(3) of the WIPO Joint Recommendations concerning Provisions on the Protection of Well-Known Marks' of 20-29 September 1999 that well-known marks are not subject to an obligation to be put to genuine use.

## 18 SERIES OF TRADEMARKS

If the opposition is based on a number of earlier trademarks and these trademarks possess features as a result of which they may be deemed to form part of one and the same 'series' or 'family', this circumstance may form a relevant factor in assessing whether there is a likelihood of confusion. In particular this may be the case if the earlier trademarks feature the same distinctive element to which a graphical or word element has been added so that they can be distinguished from each other, or feature a prefix or a suffix from a basic mark (see GC, *Bainbridge*).

### 18.1 Conditions attached to a series mark

The following two conditions must be cumulatively fulfilled.

The first is that proof must be provided that the trademarks that belong to a series, or a part of the trademarks, are used. The trademarks belonging to the series must be available on the market (upheld by CJEU, *Bainbridge*).

The second condition is that the trademark applied for is not only identical to the marks belonging to the series but also contains features enabling it to be associated with the series.



## 19 REPUTATION

### 19.1 Reputation - distinctive character

Due to the fact that a trademark enjoys a reputation, the intrinsic distinctive character may grow and consequently the scope of the protection may increase. According to case law, an earlier trademark enjoys a reputation if it is known among a substantial part of the public for which the goods and services offered under that particular mark are intended, in other words – depending on the product or service offered – among the general public or among a more specific public, such as a certain profession. In examining whether this condition has been fulfilled, account must be taken of all relevant circumstances of the case, in particular the market share of the trademark, the intensity, the geographical extent and the duration of the use of the trademark, and the size of the investments made by the undertaking in promoting it, without requiring that the trademark is known among a certain percentage of the public so determined, or that it is known across the entire territory, insofar as it is known in a substantial part of the territory (see GC, Emilio Pucci and Boomerang).

### 19.2 Reputation is not a ground to presume a likelihood of confusion

The reputation of the invoked rights established by the opponent will not be examined if the signs are not identical. According to case law the reputation of a trademark after all is an element that must be considered when assessing whether the signs are sufficiently identical or the goods and services are sufficiently similar to create the likelihood of confusion. The reputation of an earlier trademark must therefore be taken into consideration when assessing whether the likelihood of confusion exists as soon as it has been established that the trademarks are identical, but not for the purpose of proving they are identical (in this context, see judgment GC, LAM and CJEU, TiMi Kinderjoghurt).

Hence the reputation of a trademark is not a ground for presuming there is a likelihood of confusion, only because the likelihood of association exists in a narrow sense (CJUE, Marca mode). Even if the trademark and the sign could be associated with each other, the consumer will still be able to distinguish between them and will not automatically assume that both are of a common origin, merely because they feature an element that enjoys a reputation among the public.

### 19.3 Reputation will not be further examined if there is a likelihood of confusion

Any broader scope of protection arising from the reputation of the invoked right will not need to be further examined if it does not affect the outcome of the proceedings, due to the fact that the likelihood of confusion had already been established.

### 19.4 The defendant may not appeal to reputation

During opposition proceedings a defendant cannot appeal to the reputation of the trademark filed by the defendant (CJEU, La Española).

## 20 CASE LAW

- A LA CARTE (BCJ, A 2010/7/8, 6 October 2011)
- Aire Limpio (CJUE, C-488/06, 17 July 2008)
- Aladdin (GC, T-126/03, 14 July 2005)
- AMS (GC, T-425/03, 18 October 2007)
- Apassionato Arte (Court of Appeal Brussels, 2009/AR/2755, 12 October 2010)
- Aventis Pharma/OHIM – Nycomed GmbH (GC, T-95/07, 21 October 2008)
- Bainbridge (GC, T-194/03, 26 February 2006)
- Bainbridge (CJUE, C-234/06, 13 September 2007)
- Barbara Becker (GC, T-212/07, 2 December 2008)
- Boomerang (GC, T-420/03, 17 June 2008)
- Brouwerij Haacht/Grandes Sources belges (BCJ, A 98/3, 2 October 2000)
- CAMPINA (BOIP opposition decision 2000061, 6 December 2006)
- Canon (CJUE, C-39/97, 29 September 1998)
- Charlott (GC, T-169/06, 8 November 2007)
- Chevy (CJUE, C-357/97, 14 September 1999)
- Compressor technology (CJUE, C-43/15, 8 November 2016)
- Curon (GC, T-353/04, 13 February 2007)
- Digipass (Court of Appeal The Hague, 200.027.729/01, 2 November 2010)
- easyHotel (GC, T-316/07, 22 January 2009)
- ECOBLUE (GC, T-281/07, 12 November 2008)
- El Charcutero Artesano (GC, T-242/06, 13 December 2007)
- Emilio Pucci (GC, T-8/03, 13 December 2004)
- European Yellow Pages (BOIP opposition decision 2000284, 16 June 2008)
- Ferromix (CJUE, C-579/08, 15 January 2010)
- Ferromix e.a (GC, T-305/06-T-307/06, 15 October 2008)
- Flügel-bottle (Supreme Court of The Netherlands [Hoge Raad der Nederlanden], C02/133HR, 14 November 2003)
- Formula 1 (BOIP opposition decision 2000149, 27 February 2009)
- Häupl (CJUE C-246/05, 14 June 2007)
- Hipoviton (GC, T-334/01, 8 July 2004)
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- IP TRANSLATOR (CJUE, C-307/10, 19 June 2012)
- JTEKT (KOYO/KOYA) (BGH, A 2008/1, 26 June 2009)
- La Española (CJUE, C-498/07 P, 3 September 2009)
- LAM (GC, T-194/09, 8 February 2011)
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- Limonchello (CJUE, C-334/05 P, 12 June 2007)
- Lloyd Schuhfabrik Meyer (CJUE, C-342/97, 22 June 1999)
- LTJ Diffusion/Sadas Vertbaudet (CJUE, C-291/00, 20 March 2003)
- Manso de Valasco (GC, T-259/06, 16 December 2008)
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- Marca Mode/Adidas (BGH, A 98/5, 7 June 2002)
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- Matratzen (GC, T-6/01, 23 October 2002)
- O2 Holdings Limited (CJUEC-533/06, 12 June 2008)
- ONE (BOIP opposition decision 2004931, 17 October 2011)
- ONEL (BOIP opposition decision 2004448, 15 January 2010)
- Onel (CJUE, C-149/11, 19 December 2012)
- Orchidee (Supreme Court of The Netherlands [Hoge Raad der Nederlanden], 20 March 1958)
- Pages Jaunes (GC, T-134/06, 13 December 2007)
- Pam Pluvial (GC, T-364/05, 22 March 2007)
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- Picaro (GC, T-185/02, 22 June 2004)
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- Roxstar (Court of Appeal The Hague, 200.044.463/01, 30 March 2010)
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- Vitafruit (GC, T-203/02, 8 July 2004)
- Vitakraft (GC, T-356/02, 6 October 2004)
- Vogue (GC, T-382/08, 18 January 2011)
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- Westlife (GC, T-22/04, 4 May 2005)
- YOKANA (GC, T-103/06, 13 April 2010)

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All judgments of the CJUE can be found on <http://curia.europa.eu>

All judgments of the BCJ can be found on <http://www.courbeneluxhof.be>