

BOIP



Benelux Office for
**Intellectual
Property**

www.boip.int

Cancellation procedure

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Opposition / cancellation

Opposition (evaluation after 5 years):

- Expansion of the grounds (addition of 'sub c') (moment of filing is defining)
- Open suspension ground



Cancellation ("Doorhalingsprocedure")

- New invalidation / revocation procedure ("light version")
- (new chapter 6bis in title II BCIP (art. 2.30bis-2.30quater))



Legal effect

- Revocation: "Ex nunc"
- Invalidation: "Ex tunc"





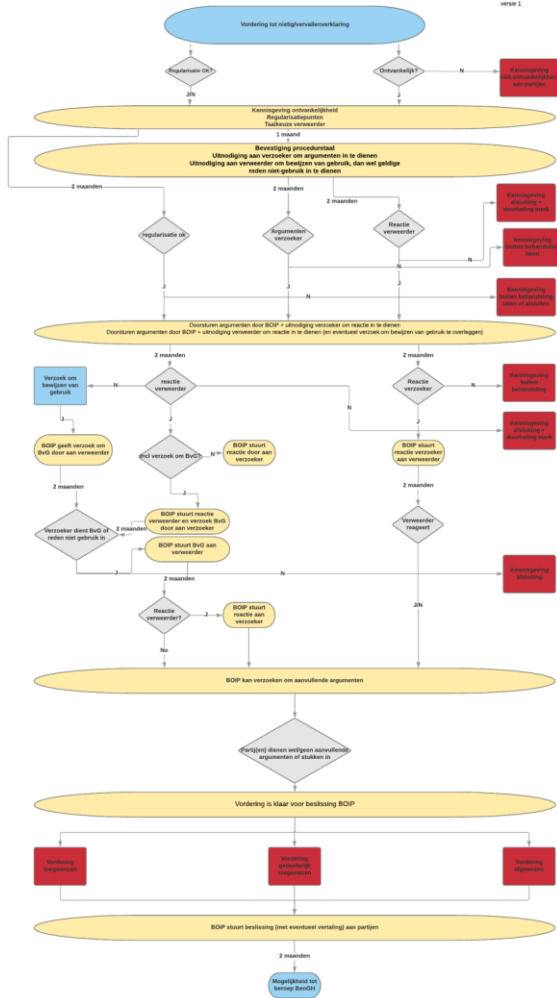
In the pipeline...

1. Protocol 15.10.2012 - BenGH NL (01.12.2016)
2. Protocol 21.05.2014 - BVIE Benelux-Gerechtshof (01.06.2018)
- 3. Protocol 16.12.2014 - oppositie / cancellation (01.06.2018)**
4. Protocol 11.12.2017 - implementatie MRL 2015/2436 (14.01.2019??)

"Dit Protocol treedt in werking op de eerste dag van de derde maand volgend op de datum van neerlegging van de derde akte van bekrachtiging, aanvaarding of goedkeuring ..." Zie www.benelux.int:

M_2014_8	Protocol houdende wijziging van het Benelux-verdrag inzake de intellectuele eigendom (merken en tekeningen of modellen), wat betreft de oppositie en de invoering van een administratieve procedure tot nietigverklaring of vervallenverklaring van merken	16-12-2014 ▲
Type document	Overeenkomst	
Domein	Markt	
Bestand	M20148_-NLProtocolGMVT.pdf	Download
Datum beslissing	16-12-2014	
Datum in werking		
Ratificatie Nederland		
Ratificatie België	01-09-2016	
Ratificatie Luxemburg	15-12-2016	
Referentie	M_2014_8	







2.30bis Initiation of the claim

Paragraph 1, sub a: by **any interested party**



i. **Absolute grounds** (reference to 2.28 BCIP)

(all of the grounds on which BOIP already made an assessment (2.11))



ii. **Revocation** (reference to 2.26 BCIP)

- **Non-usus**
- Becoming a generic indication
- Misleading by use





2.30bis Initiation of the claim

Paragraph 1, sub b: by (license)holder of prior trademark:



i. Relative grounds

Reference to 2.3 (order of priority) a, b **and** c

- Additional ground for opposition also implemented for cancellation
- With the limitation of 2.27, lid 4 and 2.29

ii. Relative cancellation ground: well-known trademark (art. 6bis PC)





Sub c

Grounds for opposition and therefore also invalidation grounds



Ground	<i>TM invoked</i>	<i>Contested sign</i>	<i>Extra condition</i>
Sub a	TM: X; G&S: Y	TM: X; G&S: Y	-
Sub b	TM: X; G&S: Y	TM: X'; G&S: Y'	Confusion
Sub c	TM: X; G&S: Y	TM: X'; G&S: ???	X enjoys a reputation + contested sign would take unfair advantage from X etc.



2.30ter Course of the proceedings

- 1. The Office shall deal with an action for invalidity or revocation 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.*



The course of the proceedings is arranged in more detail in the IR

The Office will notify the holder of the contested trademark/application

- By registered mail
- Language choice





2.30ter Course of the proceedings

Paragraph 2: Suspension



a. **Trademark** has not been registered

- Application
- Refused accelerated registration
- Or involved in Invalidation/Revocation proceedings

b. **Sign** has not been registered (if you missed the opposition deadline)

- Application
- Refused accelerated registration
- Or involved in Invalidation/Revocation proceedings before the Court

c. Joint **request**

d. **If it is appropriate...**





2.30ter Course of the proceedings

Paragraph 3: Closure of proceedings

- a. No reaction from the defendant
- b. The action has become without cause
 - The action has been withdrawn or the sign no longer exists
- c. Idem with opposition
 - Submitting party has lost the capacity to act
 - The trademark is no longer valid
 - No proof of genuine use has been submitted

Paragraph 4: Decision

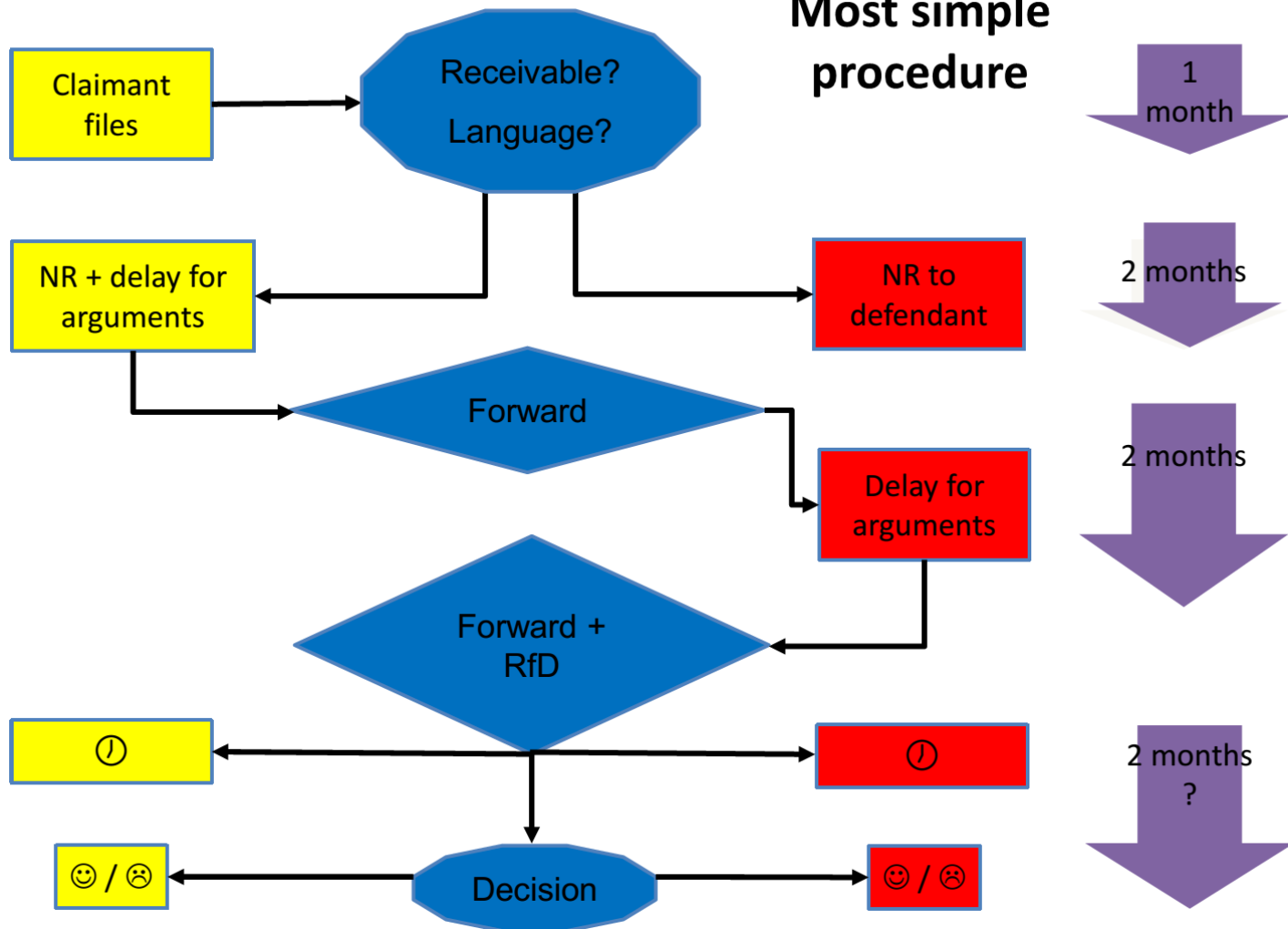
- Final when it is no longer open to appeal

Paragraph 5: Decision on the costs



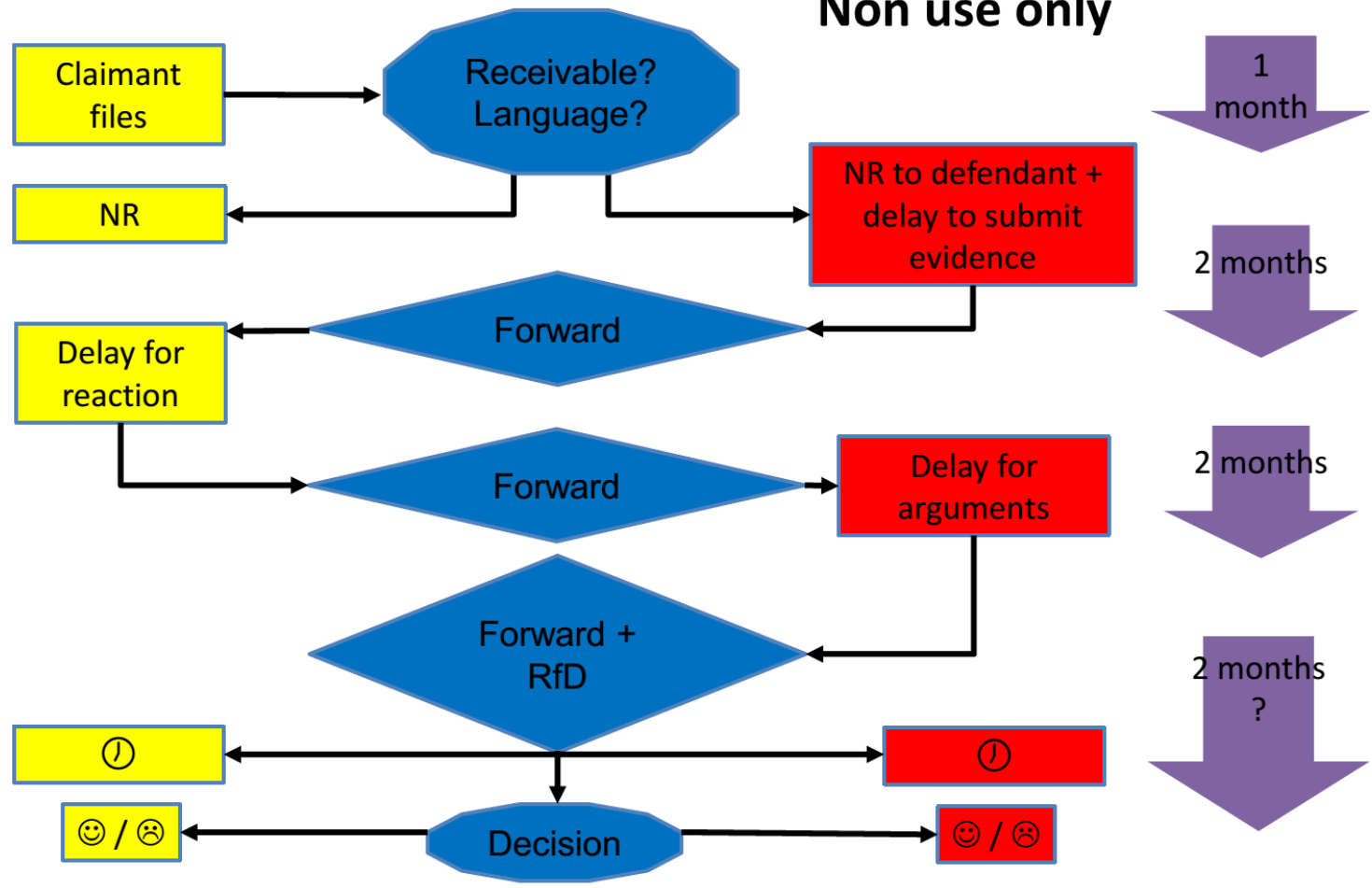


Most simple procedure



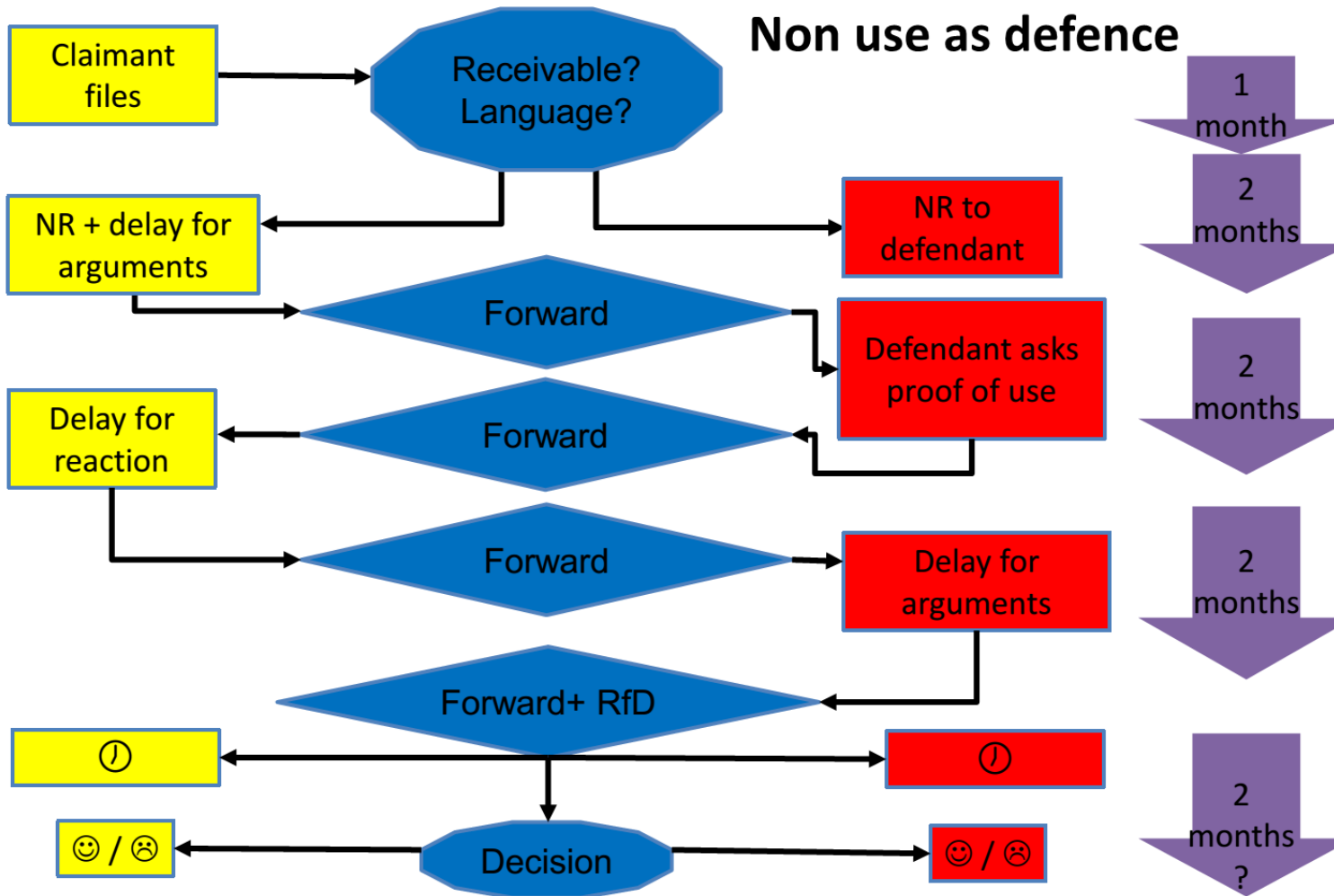


Non use only





Non use as defence





IR: proceedings – a few highlights

- Proceedings are inspired by opposition
 - but there is no 'cooling off'
 - More flexible (not limited to a strict time period)
- Time period of 2 months, suspension for 4 months + 'opt out' (first year free)
- Language regime the same as opposition
- Fees: € 1.400 (max 3 grounds / 3 prior trademarks)
 - + € 140 per extra trademark or **ground**





Possible restitution

Action not admissible		Full restitution
No arguments claimant	Abandonment of the proceedings	No restitution
No arguments defendant	Closure	50% restitution
Action has become without cause - either the action has been withdrawn or the sign no longer exists	Closure	50% restitution
Claimant has lost the capacity to act	Closure	50% restitution
Older trademark is no longer valid	Closure	50% restitution
No proof of genuine use has been submitted	Closure	50% restitution
Withdraw after decision		No restitution





IR: proceedings – a few highlights

- Expansion of grounds is possible
 - Until arguments of claimant
 - You have to pay extra if...
- Several cancellation proceedings
 - For procedural reasons...sometimes BOIP will not decide on all proceedings
 - However, *ex nunc* (revocation) / *ex tunc* (invalidity)
- Possible restitution: 50%
- Cost order = basic fee (only with if claim is fully granted or rejected)





Preparations BOIP

- Website
 - Including amending the IR numbers
- Forms
 - Unfortunately no e-filing yet
- Amending standard letters
- Informing the public
- Internal policy regarding the 'lost' defendant





Workload expectation

- We don't know exactly
- Expectation is 100-150 cases per year (???) (not many settlements)
 - Compared to EUIPO numbers on the basis of 'willingness' to proceedings in oppositions
 - 0.04% over the whole register (see oppositions: 4.57% of the applications)





Impact of the Trademark Directive

Art. 45 jo 4 and 5 TMD – end of 'light' proceedings, extra grounds:

- Bad faith
- Application of an agent (also bad faith)
- GI's



Art. 46: higher standards for proof of use (additional proof)



BOIP will organize another seminar on the impact of the TM Directive

- Fall 2018



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Thank you for your attention!

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