

BOIP



Guidelines opposition proceedings

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Benelux Office for
**Intellectual
Property**



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1 ABBREVIATIONS

BCIP	Benelux Convention on Intellectual Property
BenCJ	Benelux Court of Justice
BOIP or Office	Benelux Office for Intellectual Property
CJEU	Court of Justice of the European Union
DG	Director General of the Benelux Office for Intellectual Property
EEA	European Economic Area
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
EUTM	European Union Trade Mark
GC/CFI	General Court, formerly the European Court of First Instance
IR	Implementing Regulations
WIPO or International Bureau	World Intellectual Property Organization

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

The basis for filing an opposition lies in Article 2.14 BCIP. An opposition can be based on the following prior rights:

- a. An earlier registered trademark (Benelux, EUTM, or international mark designating either the Benelux or the EU);
- b. A well-known trademark within the meaning of Article 6bis of the Paris Convention;
- c. A protected designation of origin (PDO) or geographical indication (PGI).

An opposition can also be filed in case of an unauthorised filing by an agent or representative.

If the opposition is based on an earlier registered trademark, it can be based on the following grounds:

- a. The contested trademark is identical with an earlier trademark, and the goods or services for which the trademark is applied for or is registered are identical with the goods or services for which the earlier trademark is protected (Article 2.2ter(1)(a) BCIP);
- b. Due to the contested trademark's identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark (Article 2.2ter(1)(b) BCIP);
- c. The contested trademark is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark (Article 2.2ter(3)(a) BCIP).

These guidelines explain the examination of oppositions in detail. The purpose of the guidelines is to inform the user of the administrative procedure, and in particular to 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 BCIP and the IR 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 16 Course of the proceedings](#) summarises the course of the proceedings.

The guidelines are expressly intended to explain BOIP's practice and are subordinate to the provisions in the BCIP, the IR and the 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: LEGAL PROVISIONS

3.1 The relevant articles from the BCIP

Article 1.15bis Appeal

1. Any person who is a party to a procedure that has led to a final decision by the Office in the execution of its official tasks pursuant to Titles II, III and IV of this Convention may lodge an appeal against that decision with the Benelux Court of Justice in order to have that decision annulled or reviewed. The timeframe for filing an appeal is two months from notification of the final decision.
2. The Organisation may be represented in proceedings before the Benelux Court of Justice relating to decisions made by the Office by a member of staff appointed for this purpose.

Article 2.2ter Relative grounds for refusal or invalidity

1. A trademark shall, in case an opposition is filed, not be registered or, if registered, shall be liable to be declared invalid where:
 - a. it is identical with an earlier trademark, and the goods or services for which the trademark is applied for or is registered are identical with the goods or services for which the earlier trademark is protected;
 - b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.
2. 'Earlier trademarks' within the meaning of paragraph 1 means:
 - a. trademarks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the trademark, taking account, where appropriate, of the priorities claimed in respect of those trademarks:
 - i. Benelux trademarks and international trademarks designating the Benelux territory;
 - ii. EU trademarks, including international trademarks designating the European Union;
 - b. EU trademarks which validly claim seniority, in accordance with European Union trade mark regulation, of a trademark referred to under (a) (i), even when the latter trademark has been surrendered or allowed to lapse;
 - c. applications for the trademarks referred to under (a) and (b), subject to their registration;
 - d. trademarks which, on the date of application for registration of the trademark, or, where appropriate, of the priority claimed in respect of the application for registration of the trademark, are well-known in the Benelux territory, in the sense in which the words 'well-known' are used in Article 6bis of the Paris Convention.
3. Furthermore, a trademark shall, in case an opposition is filed, not be registered or, if registered, shall be liable to be declared invalid where:
 - a. it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark;
 - b. an agent or representative of the proprietor of the trademark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action;
 - c. and to the extent that, pursuant to Union legislation or the internal law of one of the Benelux countries providing for protection of designations of origin and geographical indications:
 - i. an application for a designation of origin or a geographical indication had already been submitted in accordance with Union legislation or the internal law of one of the Benelux countries prior to the date of application for registration of the trademark or the date of the priority claimed for the application, subject to its subsequent registration;
 - ii. that designation of origin or geographical indication confers on the person authorised under the relevant law to exercise the rights arising therefrom the right to prohibit the use of a subsequent trademark.

4. A trademark may not be refused registration or declared invalid where the proprietor of the earlier trademark or other earlier right consents to the registration of the later trademark.

Article 2.2quater Grounds for refusal or invalidity relating to only some of the goods or services

Where grounds for refusal of registration or for invalidity of a trademark exist in respect of only some of the goods or services for which that trademark has been applied or registered, refusal of registration or invalidity shall cover those goods or services only.

Article 2.14 Initiation of the procedure

1. Within two months following publication of the application, an opposition may be filed in writing at the Office on the relative grounds referred to in Article 2.2ter.
2. Opposition may be filed:
 - a. in the cases referred to in Article 2.2ter (1) and (3) (a), by the proprietors of earlier trademarks and the licensees authorised by those proprietors;
 - b. in the case referred to in Article 2.2ter (3) (b), by the proprietors of trademarks referred to therein. In this case, the assignment referred to in Article 2.20ter (1) (b), may also be requested;
 - c. in the case referred to in Article 2.2ter (3) (c), by persons authorised, under the applicable law, to exercise these rights.
3. Opposition may be filed on the basis of one or more earlier rights and on the basis of part or the totality of the goods or services in respect of which the earlier right is protected or applied for, and may be directed against part or the totality of the goods or services in respect of which the contested mark is applied for.
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 Article 2.14 (2) (a), if the earlier mark:
 - i. has not yet been registered;
 - ii. was registered without delay in accordance with Article 2.8 (2) and is the subject of proceedings for refusal on absolute grounds or opposition;
 - iii. is the subject of an action for invalidation or revocation;
 - b. where the opposition is based on Article 2.14 (2) (c), when it is based on an application for a designation of origin or geographical indication, until a final decision has been taken on it;
 - c. if the opposed trademark:
 - i. is the subject of proceedings for refusal on absolute grounds;
 - ii. was registered without delay in accordance with Article 2.8 (2) and is the subject of a judicial action for invalidation or revocation;
 - d. at the joint request of the parties;
 - e. if other circumstances justify such a suspension.
3. The opposition proceedings shall be closed:
 - a. where the opponent has lost the capacity to act;
 - b. where the defendant does not react to the opposition lodged. In this case the application shall come without effect;
 - 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 earlier trademark or earlier right is no longer valid;

- e. if the opposition is based on Article 2.14 (2) (a), and the opponent has not produced within the prescribed period proof of use of his earlier trademark as referred to in Article 2.16bis;
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 or shall decide to record in the Register the transfer referred to in Article 2.20ter (1) (b). Otherwise, the opposition shall be rejected. The Office shall inform the parties in writing and without delay, and will mention the right of appeal against this decision contained in Article 1.15bis. The decision of the Office will become final only once it is no longer subject to appeal. The Office will not be a party to any appeal against its decision.
- 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 2.16bis Non-use as defence in opposition proceedings

- 1. Where in opposition proceedings pursuant to Article 2.14 (2) (a), at the filing or priority date of the later trademark, the five-year period within which the earlier trademark must have been put to genuine use as provided for in Article 2.23bis had expired, at the request of the applicant, the opponent shall furnish proof that the earlier trademark has been put to genuine use as provided for in Article 2.23bis during the five-year period preceding the filing or priority date of the later trademark, or that proper reasons for non-use existed.
- 2. If the earlier trademark has been used in relation to only part of the goods or services for which it is registered, it shall, for the purpose of the examination of the opposition as provided for in paragraph 1, be deemed to be registered in respect of that part of the goods or services only.
- 3. Paragraphs 1 and 2 of this Article shall also apply where the earlier trademark is an EU trademark. In such a case, the genuine use shall be determined in accordance with Article 18 of the European Union trade mark regulation.

Article 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 protection in Benelux territory has been requested. Articles 2.14 to 2.16bis apply accordingly.
- 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 2.16bis and the relevant provisions of the implementing regulations.

Article 2.20ter Prohibition of the use of a trademark registered in the name of an agent or representative

- 1. Where a trademark is registered in the name of the agent or representative of a person who is the proprietor of that trademark, without the proprietor's consent, the latter shall be entitled to do either or both of the following:
 - a. [...]
 - b. demand the assignment of the trademark in his favour.
- 2. Paragraph 1 shall not apply where the agent or representative justifies his action.

3.2 Relevant rules from the Implementing Regulations under the BCIP

Rule 1.13 Information in the opposition

1. The opposition should be submitted in a document containing the following information:
 - a. the opponent's name;
 - b. information for the purpose of identifying the trademark against which the opposition has been lodged;
 - c. 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;
 - d. an indication whether the opposition is based on Article 2.14 (2) (a), (b) or (c) BCIP;
 - e. if the opposition is based on an earlier trademark or on an earlier right within the meaning of Article 2.14 (2) (c) BCIP, information for the purpose of identifying the earlier trademark or earlier right;
 - f. if the opposition is based on an earlier trademark, the goods or 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;
 - g. in relevant cases, it should be stated that the opponent is acting in the capacity of licensee of the earlier trademark;
 - h. 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 (c) 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 1.14 (1) (i) is taken.

Rule 1.14 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 1.15 and will inform the parties or, in the case referred to in Article 2.18 BCIP, 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. 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 of the earlier trademark as referred to in Article 2.16bis BCIP, 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 are proper reasons for not using the trademark;
 - 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 1.23;
 - i. a decision will be taken by the Office. Where an opposition based on several grounds is upheld on one of those grounds, the Office shall not decide on the other grounds relied on if they have the same legal effect. Where an opposition based on Article 2.14 (1) (a) BCIP and based on several earlier trademarks is allowed on the basis of one of those trademarks, the Office shall not decide on the other trademarks invoked either.
2. If the defendant does not have a place of residence or registered office within the European Economic Area, the provisions of Rule 3.6 must be complied with within the time limit stated in paragraph 1(d).

Rule 1.15 Admissibility requirements

1. The opposition is admissible if it is filed within the period specified in Article 2.14 (1) or 2.18 (1) BCIP and it meets the requirements set out in Rule 1.13 (1) (a)-(g) of these Regulations and Article 2.14 (4) BCIP.
2. To establish whether the opposition is admissible, the requirements set out in Article 2.14 (4) BCIP 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 1.14 (1) (b).
4. If the opposition is based on more trademarks or grounds than the number of trademarks or grounds for which fees have been paid, the opposition will be examined, but only those trademarks or grounds 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 1.13 (1) (a) and (g) does not correspond to the registered information relating to an earlier Benelux trademark invoked, 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 invoked concerns an EU 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 an EU 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 1.16 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 1.15, 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 1.14 (1) (b), the opposition fees due have not been paid in full, the Office shall grant the opponent a period of one month in which to pay it. Failing this, the examination of the opposition will be abandoned.

Rule 1.17 Language of the procedure

1. The language of the procedure 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 of the procedure 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 of the procedure 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 of the procedure. 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 of the procedure 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 of the procedure.
4. The language of the procedure 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 as language of the procedure;
 - 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 of the procedure.
6. The opposition decision will be drawn up in the language of the procedure.

Rule 1.18 Translation

1. Determination of the language of the procedure will not affect the parties' option to use one of the Office's other working languages in the opposition procedure instead of the language of the procedure.
2. If one of the parties submits arguments in one of the Office's working languages, not being the language of the procedure, the Office will translate the arguments into the language of the procedure, unless the other party has stated that it does not require a translation.
3. At a party's request, the Office will translate into one of the Office's other working languages the arguments submitted by the other party in the language of the procedure.
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 1.19 Change of language chosen

1. The choice of language pursuant to Rule 1.17 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 1.18.

Rule 1.20 Language of documents substantiating arguments or use of a trademark

The provisions set out in Rules 1.17 to 1.19 do not preclude 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 are sufficiently comprehensible, in the light of the reason for their submission.

Rule 1.21 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) BCIP 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 1.18 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 1.22 Suspension

- 1. If the procedure is suspended pursuant to Article 2.16 (2) BCIP, 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 1.14 (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 1.16.

Rule 1.23 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 1.24 Multiple oppositions

- 1. 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.
- 2. 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 1.25 Proof of use

- 1. The documents evidencing proof of use of the trademark referred to in Article 2.16bis BCIP shall be requested and submitted in accordance with the specific rules set out in Rule 1.14 (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.
- 3. The evidence should comply with the Director General's further rules for the submission of documents referred to in Rule 3.4.
- 4. The defendant may withdraw his request to provide proof of use or deem the evidence provided as adequate.

Rule 1.26 Public access to the opposition

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 1.27 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 or other rights 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. in relevant cases, 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 1.28 Determination of the costs of an opposition

1. The refund referred to in Article 2.16 (3) BCIP 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 1.15 (2), only 40% of the fees payable for the opposition have been paid.
3. The costs referred to in Article 2.16 (5) BCIP will be determined at an amount equalling the basic opposition fee.
4. For translation in accordance with Rule 1.18, 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 of the procedure or by the party who requires a translation in the other language of the Office, not being the language of the procedure. 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 1.29 Request not to execute a decision

After the decision referred to in Article 2.16 (4) BCIP and at the latest until it has become final, the parties may jointly request the Office not to execute the decision.

PART II: PROCEDURAL ASPECTS

4 FILING AN OPPOSITION

(Article 2.14 BCIP, Rule 1.13 IR)

The opposition should be filed with BOIP within the opposition period using the electronic form (a designated online e-filing application, available at BOIP's website).

When an opposition is filed, this is reflected in the register. According to Rule 1.26 IR, the notice of opposition and the opposition decision are public. The notice of opposition cannot be retrieved from the register directly but can be requested by interested parties. All opposition decisions are published on BOIP's website. All other documents in the file, such as the arguments or evidence submitted by the parties, can only be accessed by third parties with the consent of the parties.

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. 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. If the opposition period ends on a closing day, Rule 3.9(3) IR stipulates that it will be extended until the end of the next day on which the Office is open. For further details, see [Section 11 Time limits](#).

4.1.1 Publication of a contested trademark

(Rule 1.5 IR)

If the opposition is directed against a Benelux trademark application, the publication date can be found on the BOIP trademark register. If the opposition period is still in force, it will be shown. If the opposition is directed against an international trademark designating the Benelux, the publication date can be found on the WIPO international trademark register.

4.1.2 Republication

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

In exceptional cases, a republication of the trademark application can occur.

This is the case where an error has been made by the Office in the publication of the information in a trademark application, as a result of which incorrect information could have been provided to interested parties which would have affect their decision on whether or not to file an opposition against the relevant trademark.

Some examples of reasons for republication:

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

A modification of the applicant's name does not lead to a republication, given that an opposition is filed against a trademark rather than an applicant.

Republication will also be done where the applicant has omitted a priority claim from their original application, and added such claim within one month after the filing date pursuant to Article 2.6(3) BCIP.

As a consequence of republication, a new period for filing an opposition against the trademark application will commence, to be calculated from the new publication date.

If an opposition has already been filed against the trademark application that has been 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 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

If an opposition is filed prior to the publication of the application - i.e. prior to commencement of the opposition period - it is considered to be filed prematurely and will be returned to the party filing the opposition, without notifying the other party. Self-evidently no fees are due for this opposition. The opposition may be resubmitted once the opposition period has in fact commenced.

4.2 Information in the opposition

(Rule 1.13 IR)

The IR sets out the information required for filing an opposition. The electronic form is designed in such a manner as to guide the opponent through this process.

N.B.: If the opposition period ends on a closing date, the opposition can still be filed until the end of the next day on which the Office is open. In such a case, the procedure set out in [Section 11.4 Office closing days](#) should be followed.

4.3 Opponent

(Rule 1.13(1)(a) IR, Rule 1.15(5) IR)

An opponent may be an individual or a corporate body. The opponent's details must correspond to the details of the owner (or licensee) of the invoked rights. Should this not be the case, the opposition will only be provisionally admissible and the Office will set a time limit of two weeks in which to remedy the deficiency (see [Section 5.5 Provisionally admissible opposition](#)). If the opponent fails to remedy the deficiency within the stipulated time limit, the opposition will be inadmissible for the invoked rights in question.

4.3.1 Transfer

(Article 2.31 BCIP, 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.

4.3.2 Name change

(Rule 3.1 IR)

In the event of a change of name, the status of an opposition is unaffected. 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.

4.3.3 EEA correspondence address

(Rule 1.13(3) IR, Rule 3.6 IR)

If an opponent does not have a corporate seat, address for service, or has not appointed a representative within the European Economic Area (EEA), a correspondence address within this territory must be provided. If no such address is given, a regularisation period of two months will be granted under Rule 1.16(1) IR (see [Section 6.2 EEA correspondence address](#)).

4.3.4 The opponent is a licensee

(Article 2.14(2)(a) BCIP, Rule 1.13(1)(g) and (2) IR)

According to Article 2.14(2)(a) BCIP, if the opposition is based on an earlier trademark, 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 electronic 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 5.5 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, 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 1.16 IR. These documents may consist of a statement from the trademark proprietor; alternatively, 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.

4.3.5 Earlier right in the name of multiple parties

If an invoked right has been registered in the name of multiple parties, each of the co-owners may individually lodge an 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.

4.4 Invoked rights - trademarks

(Rule 1.13(1)(e) IR)

An opposition may only be filed on the basis of an earlier trademark that is valid in the Benelux territory. This includes: a Benelux trademark, EUTM, an International trademark valid in the Benelux or in the European Union, or a (unregistered) well-known trademark within the meaning of Article 6bis of the Paris Convention.

In respect of registered trademarks, the registration number and the proprietor thereof must be stated. 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 10.2.1 Circumstances relating to the earlier trademark](#)).

If the opposition is based on an earlier registered trademark, the electronic form does not offer the possibility to indicate the ground(s) of the opposition (Article 2.2ter(1)(a), (b), or (3)(a) BCIP). This must be indicated and substantiated in the arguments to be submitted; for more information relating to legal bases, see [Section 17 Earlier registered trademark](#).

The opposition may be based on several rights. 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 rights on which an opposition is based exceeds the fees which have been paid, the opposition will still be examined. However, only those rights for which fees have been paid will be eligible for examination, in the order stated upon filing the opposition (see Rule 1.15(4) IR).

4.4.1 International trademark 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 electronic form. 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 10.2.1 Circumstances relating to the earlier trademark](#)).

4.4.2 Well-known trademark as an invoked right

(Articles 2.14(1) and 2.2ter(2)(d) BCIP, Rule 1.13(1)(e) IR)

A well-known trademark as defined in Article 6bis of the Paris Convention relates to an unregistered right, so there is no registration or filing number. Having a registered right does not preclude also invoking a well-known trademark; these may co-exist. Well-known trademarks as defined in the Paris Convention are rare in the Benelux. The concept of well-known trademark as defined in the Paris Convention must not be confused with the concept of a trademark with a reputation as defined in Article 2.2ter(3)(a) BCIP.

When invoking a well-known trademark in an opposition, the trademark must be represented in the appropriate section of the electronic form.

When submitting arguments, the opponent must demonstrate that the trademark is well-known by providing proof thereof (see [Section 19 Well-known mark](#)).

4.4.3 Conversion of an EU trademark as an invoked right

(Rule 1.46 IR, Article 139 EUTMR)

If an EUTM is converted into a Benelux application, it will receive the same filing or priority date as the original EUTM (see Article 139(3) EUTMR). Therefore, where an opposition is based on a converted EUTM, the original date of the EUTM will be decisive in determining the order of priority of the invoked right in relation to the contested mark.

If an opposition was originally based on an EUTM that was converted into a Benelux filing under Article 139 EUTMR during the course of the proceedings, the opposition will be maintained and the Benelux trademark created by the conversion will supersede the original EUTM invoked. As long as the converted application has not been registered, the opposition proceedings will be suspended.

4.4.4 Order of priority

The invoked right must predate that of the contested trademark. Where priority has been claimed, this will be taken into account.

4.4.5 Determining the order of priority in the event of the territorial extension of an international registration

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

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

Countries AT BX DE ES FR IT LI PT

~~151 Date of the registration~~
23.06.2013

~~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:

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

4.5 Goods and services on which an opposition is based

(Article 2.14(3) BCIP, Rule 1.13(1)(f) and (4) IR)

The opposition can be based either on all goods and/or services relating to the invoked trademark, or only part of them. This should be indicated in the appropriate section of the electronic form. Not only may a limited number of classes 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 which appear in the list of goods and services of the earlier trademark may be used.

4.5.1 Limitation of the list of goods or services during the proceedings

(Rule 1.13(4) IR)

It is also possible to submit a limitation for the goods or services on which the opposition is based after filing the opposition. This can be done when filing the arguments, or at any stage of the proceedings before the decision is rendered.

4.6 Other invoked rights – unauthorized filing by an agent or representative

(Article 2.2ter(3)(b) BCIP)

In case of opposition by the proprietor of a prior trademark against a trademark application filed by his agent or representative in his own name without the proprietor's authorisation, the details of the prior trademark must be stated.

4.7 Other invoked rights – PGIs and PDOs

(Article 2.2ter(3)(c) BCIP)

If the opposition is based on a protected designation of origin or geographical indication, it must be indicated on the electronic form. The instrument (Union legislation or the internal law of one of the Benelux countries) from which the protection results must be indicated, and a copy of this must be included with the filing of the opposition.

4.8 Other prior rights

The earlier rights that can be invoked in an opposition are listed comprehensively in the BCIP. It is therefore not possible to invoke any other rights, such as an earlier trade name or domain name registration, in opposition proceedings.

4.9 Contested trademark

(Article 2.14 BCIP, Rule 1.13(1)(b) IR)

An opposition may be filed against a Benelux trademark (application or accelerated registration), or an international trademark designating the Benelux. Details of the contested trademark must be provided to enable identification thereof. If all details have not been provided but it is sufficiently clear to the Office against which trademark the opposition is directed, the opposition will be admissible. If it is insufficiently clear against which trademark the opposition is directed, the opposition will be inadmissible.

4.9.1 Opposition against an international filing

(Article 2.18 BCIP)

An opposition against an international filing designating the Benelux may be filed with the Office within a period of two months, taking effect from the publication by the International Bureau (WIPO). The publication date can be found on WIPO's website.

BOIP will send the notification of admissibility to the opponent and the International Bureau, which will notify the proprietor of the contested trademark (the defendant). All other correspondence will be sent directly to both parties without the intervention of the International Bureau. Once the opposition decision has become final or the proceedings are terminated, a notification thereof will be sent to both parties and to the International Bureau. The latter will record the consequences in the International Register.

4.9.2 Opposition against conversion of an EUTM

If an EUTM is converted into a Benelux application, it will receive the same filing or priority date as the original EUTM (see Article 139(3) EUTMR). 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 a converted EUTM having a filing date from 1 January 2004 onwards. When examining whether the opposition may be filed against the relevant converted EUTM, account will be taken of the step-by-step opening of the opposition procedure before BOIP.

Step-by-step opening opposition procedure

Prior to 2004, no opposition procedure was foreseen by the BCIP. Proceedings were introduced step-by-step;¹ the intent of which was to prevent the Office from being unable to process the number of filed oppositions with the resources and experience available 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) was opened on 1 January 2004.

Series 2 (classes 6, 8, 13, 15, 17, 19 and 21) was opened on 1 January 2005.

Series 3 (the other classes) was opened on 1 January 2006.

If the contested trademark relates to any of these classes, an opposition may be filed against it in its entirety.

4.10 Goods and services against which the opposition is directed

(Article 2.14(3) BCIP, Rule 1.13(1)(c) IR)

The opposition can be directed against all goods and services relating to the contested trademark, or only part of them. This should be indicated in the appropriate section of the electronic form. Not only may a limited number of classes be opposed, but the opposition may also be limited to specific goods or services within the classes. In that case only the terms which appear in the list of goods and services of the contested trademark 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 trademark applies.

4.10.1 Limitation of the goods or services during the proceedings

(Rule 1.13(4) IR)

¹ Article III of the Protocol amending the Uniform Benelux Trademark Act of 11 December 2003.

It is also possible to submit a limitation for the goods or services against which the opposition is directed after filing the opposition. This can be done when filing the arguments, or at any stage of the proceedings before the decision is rendered.

It would be advisable to be selective in choosing the goods and services against which the opposition is directed. The defendant 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.

4.10.2 Limitation by the defendant of the goods or services of the contested trademark

A defendant may limit the goods or services of the contested trademark at any time. A limitation may, however, only be taken into account if it is unequivocally and unconditionally requested. When the limitation is recorded in the register, both parties will be notified by the Office.

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

4.11 Multiple oppositions against the same trademark application

(Rule 1.24 IR)

It may occur that several oppositions are filed against the same trademark application. In exceptional cases, 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 clearly more likely to be successful. The examination of the remaining oppositions will in that case be deferred.

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 become without cause. These oppositions will be closed and part of the costs will be refunded.

If the opposition that has been examined is declared (partially) unfounded, the subsequent opposition will be examined.

5 ADMISSIBILITY REQUIREMENTS

(Rule 1.15 IR)

To be admissible, the opposition must meet the minimum requirements set out in Rule 1.15 IR. If it fails to meet these minimum requirements, it will be inadmissible and will not be examined.

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 right;
- Information for the purpose of identifying the contested trademark;
- Payment of the fees (at least 40% of the fees).

5.2 No requirement to include the legal basis on the forms

If the opposition is based on an earlier registered trademark, the opponent must indicate the details of the trademark invoked when filing the opposition. However, the electronic form does not offer the possibility to indicate the ground(s) of the opposition (Article 2.2ter(1)(a),(b), or (3)(a) BCIP). This must be indicated in the arguments to be submitted; for more information relating to legal bases, see [Section 17 Earlier registered trademark](#).

5.3 Admissible opposition

If all the minimum requirements are sufficiently clear 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.

5.4 Inadmissible opposition

If information concerning one of the minimum requirements is missing or is incorrect, the opposition will be inadmissible. Under Rule 1.21 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.

If the opposition is found to be inadmissible, and the opposition period has not yet expired, the opponent can remedy the deficiencies during the remainder of the opposition period. The opposition may subsequently be declared admissible.

5.5 Provisionally admissible opposition

(Rule 1.15(5) and (6) IR)

There are two minimum requirements that can be remedied under the IR within a period of two weeks. These are the name of the opponent and the renewal of an expired invoked trademark (provided, of course, within the grace period [délai de grâce]).

If an invoked right is subject to such a procedural deficiency, the Office will send a notification of provisional admissibility. If the deficiency is not remedied in the prescribed period, the opposition will be found inadmissible. In case the deficiency only affects part of the earlier rights invoked and is not remedied in the prescribed period, the opposition will be found admissible on the unaffected earlier rights only.

5.5.1 Name of the opponent

(Rule 1.15(5) IR)

The opponent's details must correspond to the details of the owner (or licensee) of the invoked rights. Should this not be the case, the opponent will be granted two weeks to remedy this deficiency. If the opponent fails to remedy the deficiency within the stipulated time limit, the opposition will be inadmissible.

If the invoked right is a Benelux trademark, the opposition will be interpreted as a request to enter a modification in the Benelux register and the opponent will be granted a time limit of two weeks to regularise such request in accordance with Rule 3.1 IR. 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 or the International Bureau respectively.

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

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

The most common situation is one 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 record a modification in the register within a period of two weeks, the opposition will subsequently be declared admissible. This may concern recordal of a licence, a name change, or a transfer.

- 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, this may also be remedied by means of a modification, insofar as there has been a change which has not yet been recorded in the Benelux register.

In the case of an EUTM or international trademark, where the legal form is not mentioned in the register, the opposition will be deemed to be admissible, as BOIP cannot require other registers to state specific details.

- 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 opponent's 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.

- The opposition is filed under a non-existent company name

Where a name that differs from that in the register is used on the opposition form, and is also not a new or former name, 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, in principle, the deficiency cannot be remedied, as there is no link between the owner of the earlier right and the opponent. Equally, if the difference only concerns an omitted word, or if the opponent's 'unofficial' name has been used, this may not be corrected. This is because the possibility of entering corrections is strictly limited to typo's or 'clerical errors attributable to the proprietor'.

5.5.2 Validity of the invoked trademark

(Rule 1.15(6) IR)

If the validity of the invoked trademark expires prior to the end of the opposition period and this trademark can still be renewed, the Office will grant the opponent a time limit of two weeks in which to renew this trademark.

(Rule 1.16 IR)

If the opposition is admissible but does not meet the other statutory requirements in the BCIP and IR, BOIP will send a 'notification concerning regularisation' and invite the parties to submit the necessary information. Such deficiencies may be remedied within a period of two months. The period within which regularisation must be completed 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 12 Termination of proceedings](#)).

6.1 Authority of the licensee

If the opponent acts in the capacity of licensee of the earlier trademark (see [Section 4.3.4 The opponent is a licensee](#)), the license must be entered into the register. In addition, documents evidencing the licensee's authority must be submitted. It will not suffice to refer to the licensing contract submitted to the register. A copy of the relevant provisions in the contract or any other documents evidencing the consent of the licensor must be submitted. If the above has not been regularised, examination of the opposition will be abandoned (see [Section 12.2 Examination abandoned](#)).

6.2 EEA correspondence address

If the opponent or the defendant does not have a place of residence or registered office, nor has not appointed a representative within the EEA, a correspondence address within this territory must be provided (Rule 3.6 IR). If no such address is given by the opponent, a regularisation period of two months will be granted under Rule 1.16(1) IR (see [Section 4.3.3 EEA Correspondence address](#)). If no such address is given by the defendant, this must be done at the latest when his arguments are filed, in accordance with Rule 1.14(2) IR.

If the opponent fails to regularise the opposition, examination of the opposition will be abandoned (see [Section 12.2 Examination abandoned](#)). If the defendant fails to respond to the regularisation request, the opposition proceedings will be closed and the disputed trademark will not be registered for the goods and services against which the opposition was directed (see [Section 12.1.2 The defendant fails to respond to the opposition filed](#)).

6.3 Change of parties or representatives

If any of the trademarks concerned are transferred during the opposition proceedings and this assignment is entered into the register, subject to notice to the contrary, the new proprietor will be deemed to have succeeded to the rights of the predecessor.

If either party appoints a new representative during the proceedings, the Office will inform the other party. If the new representative wishes to receive a copy of the documents in the file, these may be requested in accordance with Rule 3.6(3) IR, upon payment of the fee charged for copies.

7 SUBMISSION OF DOCUMENTS

(Rule 3.4, Rule 3.8 IR)

Arguments and other documents are submitted electronically via the MyBoip message box. In case of large files or if electronic submission is not possible, submission through the Contact Form or via hard copy is also allowed.

Submission directly via e-mail to BOIP staff e-mail addresses or to general mailboxes is not allowed. E-mails are regarded as a telephone call and any documents sent as e-mail attachments will be deemed not to have been submitted.²

The time of receipt of a document by the Office is decisive rather than the date of on which it was sent. The Office will confirm receipt of each document.

The transmission and receipt of documents and the time at which this took place are registered by the Office. This registration serves as evidence, barring evidence to the contrary. Evidence to the contrary can, for instance, consist of screenshot or a confirmation of receipt issued by the Office.

7.1 Documents submitted electronically

Documents submitted electronically must be in PDF format. Images of well-known trademarks may only be submitted in .jpg, .jpeg, or .gif format. Sound and video files should be submitted in mp3 and mp4 formats respectively. Any other formats will be rejected.

Submissions via the MyBoip message box must be in .pdf, .jpg, or .gif format. In a single action, a maximum of 10 files can be uploaded, each individual file not exceeding 15 Mb while the total size of the upload cannot exceed 100Mb.

Uploads via the Contact Form are limited to 15 Mb. These files must be in .pdf format and clearly labelled.

There are 3 tabs in the MyBoip message box: Inbox, Message sent, and Archive. All messages sent via the MyBoip message box can be viewed in the Message sent tab.

7.1.1 Time of receipt - electronic

Documents submitted electronically are received immediately.

7.2 Documents submitted in hard copy

Arguments and documents submitted via hard copy must be submitted in duplicate to enable the Office to send one copy to the other party. If the documents have not been submitted in duplicate, the Office will notify the relevant party and request that a second copy be submitted within a period of two months. Where two copies are submitted but they are not identical, they are not deemed to have been submitted in duplicate. Documents in black and white are not deemed to be duplicates of colour documents. If an identical duplicate is not received, that document will be deemed unsubmitted and only documents submitted in duplicate will be sent to the other party.

² DG rule 'Submitting electronically, further rules on the basis of rule 3.4 IR' of 10 May 2019.

USB sticks are treated as hard copies. They must therefore be submitted in duplicate – this is achieved by sending two identical USB sticks.

7.2.1 Time of receipt – postal

Documents delivered to the Office by post are deemed to have been received at 8.00 a.m. on the date of receipt. Documents delivered when the Office is closed, are assumed to have been received at 8.00 a.m. on the date the Office is open again.³

7.3 Supporting evidence and documents

If the parties wish to submit supporting documents or evidence, this must be submitted in a bundle. A bundle of documents must have a table of contents containing at least: a number or reference under which a given item can be found within the bundle, a brief description of each item, and a description of the facts proved by each item. Where passages relevant to the proceedings are part of larger document which is otherwise irrelevant (such as an advertisement in a periodical), these relevant passages should be highlighted or otherwise precisely indicated. When referencing evidence or documents, this should be consistent with the indexing and numbering used throughout the bundle.⁴

³ DG rule 'Time of receipt of documents delivered while the Office was closed' of 1 September 2006.

⁴ DG rule 'Submission of supporting documents and means of evidence' of 1 December 2020.

(Rules 1.17 – 1.20 IR)

Opposition proceedings can be conducted in one of the three working languages of the Office: Dutch, French or English. The language of the proceedings is determined as follows.

The opponent may indicate its language preferences in the appropriate section of the electronic form. This concerns both the preferred language of the proceedings, and whether or not translation of the defendant's arguments is required in the event that they are submitted in a language other than the opponent's preferred language.

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 preferred by 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 a working language but not an official language, which implies that neither party can be forced to use it.

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

8.1 Determination of the language of the proceedings – Benelux filing

If the opposition is filed against a Benelux trademark, 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 that language will be the language of the proceedings. If the language in which the trademark was filed does not correspond to the opponent's language preference, the defendant will be invited to confirm whether or not it agrees with the opponent's 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 classification 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.

8.2 Determination of the language of the proceedings – international filing

If the opposition is filed against an international trademark, 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. The defendant may choose between the languages of the Office, unless the opponent has indicated Dutch or French as the preferred language of the proceedings. 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.

8.3 Change of language chosen

(Rule 1.19 IR)

In accordance with Rule 1.19 IR the parties may jointly request until such time as the proceedings commence that the language chosen for the proceedings be changed.

8.4 Translations

(Rule 1.18 IR)

The parties may – regardless of the language determined for the proceedings – use any of the Office’s other languages for submitting their arguments. In that case, the Office can provide a translation. The document as submitted in its original language will, however, always be deemed authentic.

The opponent may only request translation when filing the opposition and the defendant may only request translation if invited to do so 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.

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

8.4.1 Costs incurred for translations

For translations, a fee must be paid by the party who has filed arguments in a language of the Office not being the language of the proceedings or by the party who requires a translation in a language of the Office other than the language of the proceedings (Rule 1.28(4) IR). The fee is calculated by page (or part of page), but for translation of arguments, the first four pages are free of charge. A page should cover no more than 30 lines containing no more than 80 characters. A full list of the current fees can be found on BOIP’s website.

8.5 Communication between the Office and the parties

Without prejudice to determining the language of the proceedings, the Office will communicate with parties in 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. Dutch, French or English.

8.6 Language of proof of use and other supporting documents

(Rule 1.20 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.

Invoices, for instance, are usually comprehensible as such; the same applies to advertising in most cases.

9.1 Opposition fees

(Rules 1.15(2), 1.16(3), and 5.1 IR)

A full list of fees can be found on the Office's website. There is a basic fee for filing an opposition, and supplementary fees can be due in the event that more than three earlier rights are invoked. The Administrative Council determines the fees, and may adjust the fees once a year.

As mentioned in Chapter 5, the payment of the opposition fees is an admissibility requirement. The opponent may opt to pay the fees in full 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 1.15(2) IR). The remaining 60% must be paid at the end of the cooling-off period, and prior to the commencement of proceedings. If the opponent fails to pay, they will be granted an additional month to pay the remaining balance. In the event the latter payment is not made, examination of the opposition will be abandoned (Rule 1.16(3) IR, see [Section 12.2 Examination abandoned](#)).

If more than three earlier rights have been invoked but an insufficient amount of the fees have been paid, the Office will only examine the earlier rights in the opposition for which fees have been paid and in the order stated in the opposition (Rule 1.15(4) IR).

9.2 Refunding

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

Where an opposition is admissible but the proceedings are closed, only part of the fees paid will be refunded. The exact amount depends on when the opposition is closed. If termination occurs prior to the commencement of the proceedings, 60% of the paid fees will be refunded. In the event that only 40% of the fee has been paid at this point, no refund will occur (Rule 1.28(2) IR). If termination occurs after the commencement of the proceedings, 40% of the paid fees will be refunded (Rule 1.28(1) IR).

The refund also includes the supplementary fees due for invoking additional rights, a proportional part of which will also be refunded in relevant cases.

If the opposition is not closed, but the opponent were to request the withdrawal of those additional rights as a basis for the opposition, the fees paid for those rights will not be refunded.

If examination of the opposition is abandoned, no refund will be made. Therefore, if the opponent decides to discontinue the proceedings, it would be better to withdraw the opposition (closure) rather than submit no arguments (abandonment).

Examples:

- The opponent invokes two rights when filing the opposition, and opts to pay 40% of the basic fee. The opposition is admissible, but 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 due, no refund will be made.
- The opponent invokes two rights when filing the opposition, and opts to pay 100% of the basic fee. The opposition is admissible, but 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 due, 60% will be refunded because the proceedings were closed prior to commencement.

- The opponent invokes two rights when filing the opposition, and opts to pay 100% of the basic fee. The opposition is admissible. Following the commencement of the proceedings, the defendant decides to withdraw its trademark application after reading the opponent's arguments. The opposition is therefore closed. As the opponent has paid 100% of the fees, 40% will be refunded because the proceedings were closed after commencement.
- The opponent invokes four rights when filing the opposition, listing three registered trademarks and a well-known trademark within the meaning of Article 6bis of the Paris Convention. The opponent opts to pay 100% of the fees due (basic + supplementary). The parties reach an amicable settlement during the cooling-off period and the opposition is closed prior to commencement. Consequently, 60% of the total fees (basic + supplementary fee) will be refunded.
- The opponent invokes four rights when filing the opposition, listing four registered trademarks. The opponent opts to pay 100% of the fees due (basic + supplementary). The opponent decides to withdraw the fourth registered trademark as a basis for the opposition but decides to proceed on the other invoked rights. No refund will be paid for the supplementary fee.

9.3 Payment of suspensions

The proceedings may be suspended on mutual request of the parties at any time. During the cooling-off period, the first three suspensions are free of charge. From the fourth suspension onward or if suspension is requested following the commencement of the proceedings, a fee will be charged.

The Office will follow the procedure set out below for payment:

- If both parties have a current account, these costs will be debited from their current account on a 50/50 basis as standard, unless one of the parties expressly states in their written request its willingness to pay the full suspension fee. However, no apportionment of costs other than on a 50/50 or 100% basis is possible.
- If one of the parties 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.

9.4 Award of costs

The losing party will be ordered to pay the costs. This is a fixed amount, equaling the basic opposition fee. No costs will be incurred if the opposition is only partially successful.

The Office's decision concerning costs constitutes an enforceable order. Its enforcement is governed by the rules in force in the State where execution takes place; the Office is not a party to enforcement (see also [Section 16.6.1 Award of costs](#)).

If the proceedings are terminated without a decision being taken by the Office (as a result of closure or abandonment), no award of costs will take place.

10 SUSPENSION

(Article 2.16(2) BCIP, Rule 1.22 IR)

10.1 Suspension of the proceedings by joint request

The parties may submit a joint request to suspend the proceedings. A suspension has a duration of four months. Multiple suspensions can be requested.

A joint request for a suspension is preferably made in a single document, signed by both parties. However, two separate documents are also accepted.

Either party can opt-out of the suspension at any time via a written request.

Suspension does not affect the regularisation periods granted under Rule 1.16 IR or the period granted to the defendant in the notification of admissibility for indicating the preferred language of the proceedings.

10.1.1 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 prior to commencement during the cooling-off period, the cooling-off period will be extended by four months (see also [Section 11.5 Date of commencement of the proceedings](#)).

10.1.2 Opt-out of suspension during the cooling-off period

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 of the opposition fees has not yet been received by the Office, a time limit of one month will be granted to pay this second instalment (see [Section 9.1 Opposition Fees](#) and [Section 12.2 Examination abandoned](#)).

10.1.3 Suspension after commencement of the proceedings

A fee is charged for any joint suspension requested after the proceedings have commenced.

If both parties have a current account, these costs will be debited from their current account on a 50/50 basis as standard, unless one of the parties expressly states in their written request its willingness to pay the full suspension fee. 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 9.3 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 as if the request for suspension was not filed, with no change to the remaining time limits prior to the request. The Office will notify the parties thereof and in the relevant cases an additional time limit will be granted in accordance with Rule 1.22(2) IR.

10.1.4 Opt-out of suspension 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 prior to the suspension a time limit was still running, this remaining time will be granted after opting-out of the suspension 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 1.22(2) IR.

NB: If a party files arguments during suspension, this is not considered to be an implicit opt-out request. Consequently, the arguments will only be sent to the other party after the end of the suspension. Opt-out requests must be made explicitly.

10.2 Ex officio suspension

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

- Where the opposition is based on an earlier trademark, if the earlier trademark:
 - i. has not yet been registered;
 - ii. was registered without delay in accordance with Article 2.8 (2) BCIP and is the subject of proceedings for refusal on absolute grounds or opposition;
 - iii. is the subject of an action for invalidation or revocation;
- Where the opposition is based on an application for a designation of origin or geographical indication, until a final decision has been taken on it;
- Where the opposed trademark:
 - i. is the subject of proceedings for refusal on absolute grounds;
 - ii. was registered without delay in accordance with Article 2.8 (2) BCIP and is the subject of a judicial action for invalidation or revocation;
- Where other circumstances justify such a suspension.

The first two grounds relate to the validity of an earlier right invoked as a basis for the opposition. The third ground relates to the contested trademark. The last ground is a fall back that can be applied in (exceptional) cases where the other grounds do not apply but the circumstances justify a suspension.

10.2.1 Circumstances relating to the earlier trademark

A ground for ex officio suspension arises when the validity of the trademark upon which the opposition is based is uncertain.

If the opposition is based on an application for a Benelux trademark that has not yet been registered, or an accelerated registration that is subject to proceedings for refusal on absolute grounds or opposition, the proceedings will be suspended ex officio. The Office will notify the parties of the commencement of as well as the end of the ex officio suspension.

If the opposition is based on an application for an international trademark or an EUTM, the Office will notify the parties of the commencement of the ex officio suspension, but will ask the parties to inform the Office of the registration of the invoked trademark, 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 trademark has meanwhile been registered.

If a judicial or administrative invalidation or revocation action has been filed against one or more of the earlier trademarks upon which the opposition is based, the proceedings will be suspended ex officio. Ex officio suspension shall also take place in the case of an unprocessed application for surrender or restriction of goods which deprives the opposition of its basis. Parties are urged to inform the Office if any of these situations arise.

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. The opponent is at liberty to renounce the relevant invoked right to enable the proceedings to resume.

10.2.2 Circumstances relating to the earlier PGI or PDO

Likewise, a ground for ex officio suspension arises where the validity of the designation of origin of geographical indication upon which the opposition is based is uncertain.

Where the opposition is based on an application for a PGI or PDO, the proceedings will be suspended ex officio until the final decision on protection has been reached. The parties are urged to inform the Office.

10.2.3 Circumstances relating to the contested trademark

Furthermore, a ground for ex officio suspension arises where the status of the contested trademark is uncertain.

A Benelux trademark application will be published if the requirements for determining the filing date have been met, and the goods and/or services have been classified correctly. Consequently, an opposition can be filed against a Benelux trademark application for which examination on absolute grounds has not yet been completed. If a provisional refusal is issued, the opposition proceedings will be suspended ex officio. In the event the provisional refusal is reconsidered, the opposition proceedings will be resumed and parties will be notified. If the refusal has become final (no longer subject to appeal), the opposition proceedings will be closed as they have come to be without cause.

It should be noted that judicial actions always prevail over proceedings before the Office. Proceedings are therefore suspended ex officio where the contested trademark is an accelerated registration subject to a judicial action for invalidation or revocation. The parties are urged to inform the Office of this.

10.2.4 Other circumstances justifying suspension

The last ground for ex officio suspension is a fall back that can be applied in (exceptional) cases where the other grounds do not apply but the circumstances justify a suspension. For example, this could be the case where one of the affected trademarks is subject to proceedings concerning its ownership (rather than its validity as discussed above), or if the parties are involved in proceedings concerning the interpretation of a coexistence agreement.

10.3 Ex officio suspension in the notification of admissibility

After the Office has received the opposition, it inspects the file to determine the admissibility of the opposition (see [Section 5 Admissibility requirements](#)).

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

10.4 Ex officio suspension during the proceedings

If the Office establishes one of the above grounds for ex officio suspension during the proceedings, it will notify both parties of the suspension. If the ground for suspension is resolved, the proceedings will either be resumed or terminated. The Office will notify the parties thereof and state what action, if any, should be taken. If only a limited time remains, the Office will grant an additional time limit in accordance with rule 1.22(2) IR.

10.5 Provisional ex officio suspension

If either party submits information to the Office indicating that there is a reason for an ex officio suspension, the Office will transmit this to the other party, and will grant a time limit of one month to respond, during which time the proceedings will be provisionally suspended.

If the other party does not contest the information, the proceedings will remain suspended.

If the other party contests the information, the Office will invite the party that submitted the information to submit evidence relating to the ground for ex officio suspension within a period of one month.

If this evidence is not submitted, the ex officio suspension will be considered to have not occurred and the opposition proceedings will be resumed as if they had not been provisionally suspended. The time limits will have continued to elapse normally during this period. However, if the other party is adversely affected, the Office may decide to grant an additional time limit.

If the evidence is submitted, it will be forwarded to the other 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.

10.5.1 Examination of the submitted documents

If on examination the documents indicate a basis for an ex officio suspension, the proceedings will remain suspended.

However, if the evidence submitted shows that the ground for ex officio suspension only occurred after the date the Office received the submission, the effective date of ex officio suspension will be the date on which the ground actually occurred.

Where the Office examines the evidence submitted and establishes that there was no basis for an ex officio suspension, the opposition proceedings will be resumed as if they had not been provisionally suspended. Therefore, the time limits will be deemed to have elapsed normally during this period. In relevant cases, the Office may elect to grant an additional time limit.

The Office will notify the parties of its decision relating to the ex officio suspension.

11 TIME LIMITS

(Rule 3.9 IR)

11.1 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 apply.

A time limit can initiate following a number of different events. This usually refers to a letter sent by the Office, whose date is taken to be the start of the time limit. The end of the time limit will also usually be mentioned in the letter. The opposition period forms an exception to the above, as this takes effect on the publication date of the contested trademark application (see [Section 4.1 Opposition period](#)).

When a party responds, any remaining time will be deemed to have expired with the submission and the response will be forwarded to the other party. If the relevant party explicitly indicates that it wishes to use the remaining period, the Office will wait to forward the submission to the other party until the expiry of the time limit.

N.B. the rules concerning the date of receipt of submitted documents are applicable (see [Section 7 Submission of documents](#)). Documents submitted electronically are received immediately. Documents delivered to the Office by post are deemed to have been received at 8.00 a.m. on the date of receipt.

11.2 Time limits in months

A time limit expressed in months expires at the end of the day (11:59 p.m.) which, in the relevant month, corresponds to the date on which the time limit started. If the relevant month does not have a corresponding day, the time limit expires at the end of the last calendar day of that month.

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.

11.3 Time limits in weeks

A time limit expressed in weeks expires at the end of the day (11:59 p.m.) which, during the relevant week, corresponds to the day on which the time limit started.

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.

11.4 Office closing dates

If the Office is closed on the last day of a time limit, the time limit will be extended until the end of the next day on which the Office is open. The closing dates are posted on our website under 'Contact'.

Examples:

- A time limit ends on a Saturday. This means that documents may be submitted until end of day Monday.
- A time limit ends on Sunday, 26 April. The Office is closed 27 April. Documents may be submitted until end of 28 April.

Similarly, if the opposition period expires on a closing day, it will be extended until the end of the next day on which the Office is open. In that case, on the electronic form in step 1 (opposed trademark), 'add manually' should be chosen instead of 'import' and the publication date should be left blank when entering the data.

11.5 Date of commencement of the proceedings

In opposition proceedings a distinction must be made between the cooling-off period and the commencement of the proceedings.

There is a cooling-off period of two months. 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.

The date of commencement of the proceedings is of particular importance in the event of a joint request for suspension. If the parties wish to suspend proceedings during the cooling-off period, the joint-request must be submitted prior to the commencement of the proceedings, in other words, at the latest on the final day of the cooling-off period. Requests for suspension made following the commencement of the proceedings automatically incur a fee (see [Section 10.1 Suspension of the proceedings by joint request](#)).

Example:

- The notification of admissibility is sent on 21 March. The cooling-off period ends on 21 May, and the proceedings therefore commence on 22 May. A joint 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 end of the cooling-off period (and therefore the deadline to file the joint request) will be extended until the end of the next day the Office is open.

11.5.1 Submission of arguments prior to commencement of proceedings

(Rule 1.14(1)(c) IR)

If an opponent submits arguments (or other documents) prior to commencement of the proceedings, the Office will hold them. On commencement of the proceedings the Office will invite the opponent to either confirm that no additional argumentation will be submitted, or to submit any further arguments.

To that end the opponent will have the same time limit of two months as if arguments had not been prematurely submitted. If no answer is received, the Office will forward the arguments to the defendant following the expiry of the stipulated period.

In all other cases, the Office will return prematurely submitted arguments to the submitting party.

11.6 Late submission of arguments

Arguments received by the Office after the expiry of the time limit will not be taken into account. In this context it should be recalled that the date on which the Office receives the documents is decisive rather than the date on which the documents were sent.

Opposition proceedings can be terminated prior to the Office rendering a decision, via closure or abandonment of proceedings.

12.1 Closure

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 9 Financial information](#)).

12.1.1 The opponent has lost the capacity to act

This ground for closing the proceedings rarely occurs. Examples could be the case where the defendant has become the owner of the earlier right invoked by the opponent, or the case where the licensee lost the authority to proceed.

12.1.2 The defendant fails to respond to the opposition filed

If the defendant fails to respond, the opposition proceedings will be closed and the contested trademark will be deemed not have been applied for. Two cases can be distinguished here: the defendant fails to respond to regularisation or the defendant fails to respond to the opposition in its entirety.

In the first case, the defendant has been granted a time limit of two months to remedy deficiencies relating to the appointment of a representative, or a correspondence address in the EEA.

In the second case, the defendant did not react to the opposition. A reaction within the meaning of Article 2.16(3)(b) BCIP is taken to mean a response on the substance of the opposition. Purely procedural submissions are therefore not considered a 'reaction' within the meaning of Article 2.16(3)(b) BCIP.⁵

Examples of 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;
- limiting the list of goods and services of the contested trademark application.

12.1.3 The opposition has come to be without cause

The opposition will be closed if it has become without cause, either because the opposition has been withdrawn or because the application against which the opposition is directed has come to be without effect. The latter also includes cases where the defendant has limited the application, as a result of which it no longer applies to the goods and services against which the opposition was directed.

⁵ DG rule 'Interpretation of Article 2.16(3)(b) BCIP (closing the opposition proceedings due to the defendant's failure to respond)' of 23 March 2011.

12.1.4 Earlier right is no longer valid

If the earlier right becomes invalid during the proceedings, for instance as a result of a successful and definitive cancellation 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.

12.1.5 The opponent has failed to submit proof of use

If the opposition is based on an earlier trademark subject to an obligation of use, the defendant can request proof of use. If the opponent fails to submit any evidence within the time limit stipulated by the Office in Rule 1.14(1)(e) IR, the opposition proceedings will be closed.

If the opposition is based on multiple prior rights, the opposition may proceed based on any remaining earlier rights not affected.

This ground for closure is strictly interpreted – it refers to the situation where no evidence (or arguments regarding a proper reason for non-use) was submitted at all. If the opponent submitted evidence but such evidence is insufficient to establish genuine use, this is not a ground for closure but will be relevant in the substantive decision.

12.1.6 Closure for an opposition against an international filing

If an opposition against an international filing is closed, the Office will notify the International Bureau by letter of the outcome of the opposition and the application.

12.2 Examination abandoned

Besides the grounds for closure discussed above, there are a number of other circumstances in which proceedings terminate. Examination of the opposition is abandoned in the following cases:

- The opponent fails to respond (within the stipulated time limit) to regularisation of the opposition following a notification of admissibility (see Rule 1.16(1) IR and [Section 6 Regularisation of the opposition](#));
- The opponent has failed to submit arguments (see Rule 1.14(1)(c) IR);
- The opponent has failed to pay the second portion of the opposition fees (see also [Section 9.1 Opposition fees](#)).

The difference between closure and abandonment is that in the case of closure, part of the fees paid can be refunded, whereas in the case of abandonment no refund can occur.

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. This means that arguments are transmitted to the other party without examination of the contents. Only after the exchange of arguments will the substantive examination of the opposition start.

It is the responsibility of the submitting party that supporting documents are presented in such a way that it is clear what each document actually demonstrates and to which ground or argument a document relates. Documents that fall short in this respect will not be taken into consideration (see [Section 7.3 Supporting evidence and documents](#)).⁶

13.1 Opponent's arguments

(Rule 1.14(1)(c) IR)

The opponent has a period of two months from the commencement of the proceedings to submit arguments and supporting documents. Upon submission, the Office will then send the opponent's arguments to the defendant.

If no arguments are submitted, examination of the opposition will be abandoned (see [Section 12.2 Examination abandoned](#)).

13.2 Defendant's arguments

(Rule 1.14(1)(d), (e) and (f) IR)

The defendant will be granted a period of two months in which to respond to the arguments of opponent. Upon receipt of defendant's response, the Office will forward the response to the opponent, and the parties will be notified that a decision is set to be taken on the opposition.

13.2.1 Requesting proof of use

If the opposition is based on an earlier trademark subject to an obligation of use, the defendant can request proof of use. This can occur in a number of different ways (see [Section 18.3 Defendant's request for proof of use](#)).

The defendant can ask for proof of use in a separate request and wait until receiving these documents before providing a substantive response, or submit the request along with their substantive arguments. It is in most cases recommendable that defendants request proof of use in a separate request, so as to submit the defendant's arguments alongside the reaction to the proof of use.

The Office will forward the request to the opponent and grant a period of two months in which to submit the requested proof of use or to substantiate that there is a proper reason for non-use (in accordance with Article 2.16bis BCIP).

When the opponent submits proof of use, it will be sent to the defendant. The defendant will then be granted a period of two months in which to respond to the proof of use submitted (as well as the opponent's arguments if applicable). 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.

⁶ DG rule 'Submission of supporting documents and means of evidence' of 1 December 2020.

The opponent's submission and the defendant's reaction should only relate to proof of use, and not to any other substantive issues raised in the proceedings. This is because, in principle, there is only one round of argumentation in opposition proceedings. If the parties nonetheless submit additional substantive arguments, the Office may not take these into consideration when taking the decision.

If the opponent fails to submit any proof of use (or arguments regarding a proper reason for non-use) within the time limit stipulated in Rule 1.14(1)(e) IR, the opposition proceedings will be closed (see also [Section 12.1.5 The opponent has failed to submit proof of use](#)). If the opposition is based on multiple prior rights, the opposition may proceed based on any remaining earlier rights not affected.

If the opponent has submitted evidence of use and the defendant does not respond to it, genuine use is considered uncontested and the Office will therefore not assess it (see [Section 13.5 The principle of hearing both sides of the argument](#)).

13.2.2 The defendant fails to react

If the defendant fails to react to the opposition, the proceedings will be closed. A reaction within the meaning of Article 2.16(3)(b) BCIP is taken to mean a response on the substance of the opposition (see [Section 12.1.2 The defendant fails to respond to the opposition filed](#)).

13.3 Additional round of arguments

(Rule 1.14(1)(g) IR)

In principle, opposition proceedings provide for only one round per party. However, where there are relevant grounds, and in light of the principle of hearing both sides of the argument, the Office may request one or more parties to submit additional arguments or documents for that purpose within a stipulated time limit.

13.4 Hearing

(Rule 1.23 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.⁷

13.5 The principle of hearing both sides of the argument

(Article 2.16(1) BCIP, Rule 1.21 IR)

The Office observes the principle of hearing both sides of the argument by sending a copy of each relevant document submitted to BOIP by one party to the other party, even if the opposition is inadmissible.

Opposition proceedings are inter partes proceedings. Therefore, an opposition decision can only be taken on grounds against which the parties have been able to put forward a defence and the examination of the opposition is limited to the arguments, facts and evidence submitted by the parties. In this, facts to which the other party did not respond are deemed to be undisputed.

⁷ DG rule 'Regulations concerning the hearing in opposition proceedings' of 1 September 2006.

After examination of the opposition is completed, the Office shall reach a decision as soon as possible. The Office shall inform the parties of the decision in writing and without delay, and will mention the right of appeal against this decision contained in Article 1.15bis BCIP. All decisions are made public on the Office's website.

Rule 1.27 IR stipulates that an opposition decision must contain 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 or other rights 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. in relevant cases, 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.

14.1 Outcome

In respect of the final decision there are three possible alternatives, viz.:

- The opposition is justified in its entirety;
- The opposition is rejected in its entirety;
- The opposition is partially justified.

Where the opposition is justified in its entirety, then the opponent will be the successful party; once the decision becomes final, the contested trademark will not be registered for the goods and services against which the opposition was directed. Where the opposition is rejected in full, the defendant will be the successful party; once the decision becomes final, the contested trademark will be registered if there are no other outstanding oppositions against it.

An opposition can also be found to be partially justified. In that case, and once the decision becomes final, the opposed mark will be registered for only part of the goods and/or services.

An opposition only concerns the validity of the contested trademark. The validity of an earlier registered right invoked is not an issue in opposition proceedings. Thus, a defendant holding an even earlier right cannot challenge, as a defence, the validity of the right invoked by the opponent, but must institute separate proceedings for that purpose before the competent authority. Such proceedings constitute grounds for suspension of the opposition (see [Section 10.2 Ex officio suspension](#)).

14.1.1 Costs

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 found to be partially justified (see Article 2.16(5) BCIP). Therefore, parties are encouraged to be precise when deciding against which goods and/or services an opposition is filed and avoid including baseless claims.

14.2 Joint request not execute a decision

(Rule 1.29 IR)

After the Office reaches a decision and until such a time as it becomes final under Article 2.16(4) BCIP, the parties may jointly request that the Office not execute the decision. The decision will become final only once it is no longer subject to appeal.

14.3 Precedents

Each case is considered on its own merits. The Office is neither bound by its own decisions, nor decisions issued by other authorities in similar or other cases.

15 APPEAL

(Article 1.15bis(1) BCIP)

An appeal may be filed with the Benelux Court of Justice against any final decision rendered by the Office within a time limit of two months, calculated from notification of the decision, in order to have that decision annulled or reviewed. The term 'final decision' should not only be taken to mean decision in the sense discussed in [Section 14 Decision](#) of these guidelines, but also terminations as discussed in [Section 12 Termination of proceedings](#).

15.1 Scope of Appeal before the Second Chamber of the BenCJ

The Second Chamber of the BenCJ will fully examine an appeal against a final decision taken by the Office. Submission of supplementary evidence at the appeal stage is allowed, provided it supports grounds or defenses that were already invoked before the Office.⁸

For more information on the BenCJ's rules of procedure, the BenCJ's website can be consulted.

15.2 The Office is not a party

(Article 2.16(4) BCIP)

The Office is not a party to any appeal against its decision in opposition proceedings. In this respect, the system of the BCIP differs from the appeal procedure set out in the EUTMR.

15.3 Further appeal to the First Chamber of the BenCJ

A decision of the Second Chamber of the BenCJ may be brought before the First Chamber of the BenCJ on the ground of violation of the law. This has suspensive effect.

15.4 Implementation by the Office

(Rule 1.6(2) IR)

The decision of the Office will become final only once it is no longer subject to appeal. If the judgment passed by the Second Chamber of the BenCJ in an appeal case is no longer open to opposition or to appeal to the First Chamber, or the First Chamber has rendered a decision which has become final, the Office will, if it has been informed thereof, implement the Court's decision without delay.

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

⁸ BenCJ (second chamber) 18 October 2022, C 2021/14, point 14 (Benrus I).

PART III: THE PROCEEDINGS IN CHRONOLOGICAL ORDER

16 COURSE OF THE PROCEEDINGS

(Article 2.16 BCIP, Rule 1.14 IR)

This section sets out the opposition proceedings in chronological order, from the filing of the opposition to the decision. It serves as a summary of the previous sections. A detailed flowchart summarising the course of the proceedings can be found on BOIP's website.

16.1 Receipt of the electronic forms

On receipt of the opposition, BOIP examines the completeness and accuracy of the information provided to see if it satisfies the minimum legal requirements (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, it will be examined and a notification of admissibility will be sent to both parties.

16.2 Cooling-off period

From the notification of admissibility, a two-month period will start, during which time the parties may attempt to resolve their dispute via mutual agreement without the intervention of BOIP. This is called the cooling-off period.

If the cooling-off period results in an amicable settlement, BOIP must be notified thereof and the opposition can be closed. In relevant cases, part of the fees already paid will be refunded (see [Section 9.2 Refunding opposition fees](#)).

Self-evidently, parties may also reach an amicable settlement at a later stage.

16.2.1 Regularisation and language preferences

During the cooling-off period, there may also be time limits running for regularisation (see [Section 6 Regularisation of the opposition](#)) or to determine the language of the proceedings (see [Section 8 Language regime](#)). These periods run concurrently.

16.3 Commencement of proceedings

When the cooling-off period has ended and the second instalment of the opposition fees has been paid (see [Section 9 Financial information](#)), BOIP will notify both parties thereof and the actual opposition proceedings will start. This is referred to as the commencement of the proceedings.

16.4 Exchange of arguments

The opposition proceedings provide for one round per party. The opponent has a period of two months from the commencement of the proceedings to submit arguments and supporting documents (see [Section 13 Exchange of arguments](#)).

Upon receipt of the grounds of the opposition, the defendant will then be granted a period of two months in which to respond. The defendant's response will be forwarded to the opponent, and the parties will be notified that a decision is set to be taken on the opposition.

16.4.1 Requesting proof of use

The defendant can also request proof of use during this stage of the proceedings (see [Section 18 Proof of use](#)); this can be done either as a separate request or simultaneously with the submission of arguments. It is in most cases recommendable that defendants request proof of use in a separate request, so as to submit the defendant's arguments alongside the reaction to the proof of use.

The Office will forward the request to the opponent and will grant a period of two months in which to submit the requested proof of use or to substantiate that there is a proper reason for non-use (in accordance with Article 2.16bis BCIP). When the opponent submits proof of use, the defendant will then be granted a period of two months in which to respond to the proof of use submitted.

16.4.2 The defendant fails to react

(Article 2.16(3)(b) BCIP)

If the opponent has submitted evidence of use and the defendant does not respond to it, genuine use is considered uncontested and the Office will therefore not assess it (see [Section 13.5 The principle of hearing both sides of the argument](#)).

If the defendant does not react to the opposition at all, the proceedings will be closed. A reaction within the meaning of Article 2.16(3)(b) BCIP is taken to mean a response on the substance of the opposition (see [Section 12.1.2 The defendant fails to respond to the opposition filed](#)).

16.4.3 Additional round of arguments

(Rule 1.14(1)(g) IR)

If the Office deems that there are relevant grounds, and in light of the principle of hearing both sides of the argument, it may request one or more parties to submit additional arguments or documents for that purpose within a stipulated time limit (see [Section 13.3 Additional round of arguments](#)).

16.5 Hearing

(Rule 1.23 IR)

A hearing may be held ex officio or at the parties' request, if the Office deems there are grounds for a hearing (see [Section 13.4 Hearing](#)).

16.6 Decision

(Article 2.16(4) BCIP, Rule 1.27 IR)

After the examination of the opposition has been completed, the Office will reach a decision as soon as possible (see [Section 14 Decision](#)). If the opposition is held to be justified, the Office will refuse to register the trademark in whole or in part.⁹ If the opposition is held not to be justified, it will be rejected.

⁹ Or decides to enter the transfer referred to in Article 2.20ter(1)(b) BCIP in the register.

16.6.1 Award of costs

(Article 2.16(5) BCIP, Rule 1.28 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. No costs will be incurred if the opposition is partially justified (see [Section 9.4 Award of costs](#)). The Office's decision concerning determination of the costs will constitute an enforceable order.

16.6.2 Possibility of appeal

(Article 1.15bis(1) BCIP)

An appeal may be lodged with the Benelux Court of Justice against any final decision rendered by the Office within a time limit of two months, calculated from notification of the decision, in order to have that decision annulled or reviewed (see [Section 15 Appeal](#)).

16.6.3 Decision becomes final

The decision of the Office will become final only once it is no longer subject to appeal (see [Section 15.4 Implementation by the Office](#)).

16.6.4 Joint request not to execute a decision

(Rule 1.29 IR)

After the Office reaches a decision and until such a time as it becomes final under Article 2.16(4) BCIP, the parties may jointly request that the Office not execute the decision. The decision of the Office will become final only once it is no longer subject to appeal (see [Section 14.2 Joint request not execute a decision](#)).

PART IV: LEGAL GROUNDS AND SUBSTANTIVE ASPECTS

On the basis of Article 2.14(2)(a) BCIP in conjunction with Article 2.2ter(1) and (3)(a) BCIP opposition may be filed by the proprietors of earlier trademarks and the licensees authorized by those proprietors. They may file an opposition in the following cases:

- a. the contested trademark is identical with an earlier trademark, and the goods or services for which the trademark is applied for or is registered are identical with the goods or services for which the earlier trademark is protected (Article 2.2ter(1)(a) BCIP);
- b. due to the contested trademark's identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark (Article 2.2ter(1)(b) BCIP);
- c. the contested trademark is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark (Article 2.2ter(3)(a) BCIP).

The earlier registered trademark can be a Benelux, EUTM or an international trademark designating either the Benelux or the EU.

The three grounds for opposition mentioned above are briefly explained below.

17.1 Double identity

(Article 2.2ter(1)(a) BCIP)

In case an opposition is based on Article 2.2ter(1)(a) BCIP, two cumulative conditions must be fulfilled, namely identical signs and identical goods or services.

The criterion for the identity of signs is very strict. A sign is identical with a trademark where it reproduces, without any modification or addition, all the elements constituting the trademark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.¹⁰

Identity of goods or services exists if goods or services for which the earlier trademark is registered appear expressis verbis in the list of goods and services of the contested trademark. In addition, goods or services are considered to be identical when:

- i. goods or services covered by the earlier trademark include goods or services covered by the contested trademark;
- ii. goods or services for which the contested trademark is applied for belong to a general category of goods or services that includes goods or services for which the earlier mark is registered.¹¹

In practice, this ground is not often invoked in oppositions.

17.2 Likelihood of confusion

(Article 2.2ter(1)(b) BCIP)

In case an opposition is based on Article 2.2ter(1)(b) BCIP, the following three conditions must be fulfilled:

¹⁰ CJEU 20 March 2003, C-291/00, ECLI:EU:C:2003:169, point 54 (Diffusion/Sadas Vertbaudet).

¹¹ GC 2 February 2022, T-694/20, ECLI:EU:T:2022:45, point 31 and the case-law mentioned there (Labello) and BenCJ (second chamber) 18 April 2023, C-2021/19, point 46 (ZM Zo mooi).

- a. Identical or similar signs
- b. Identical or similar goods or services
- c. Likelihood of confusion

These conditions are cumulative.¹² If there are no identical or similar signs or no identical or similar goods or services, no likelihood of confusion can be assumed. Therefore, the Office will not make a global assessment of the likelihood of confusion if conditions a or b are not met.

In case there is no identity or similarity in respect of a part of the goods or services for which the contested trademark is applied for, the opposition cannot succeed with regard to those goods or services.

17.2.1 Comparison of the signs

To assess the degree of similarity between the conflicting signs, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.¹³

Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.¹⁴ The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.¹⁵

The assessment of the similarity between the signs, regarding the visual, phonetic and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, *inter alia*, their distinctive and dominant components.

In the exceptional case in which the conflicting signs are conceptually different and at least one of the signs has from the perspective of the relevant public a clear and specific meaning which can be grasped immediately by that public, the conceptual difference may counteract phonetic and visual similarities between the signs. In that situation, the global assessment of the likelihood of confusion may be dispensed with, despite the existence of certain elements of similarity visually or phonetically.¹⁶

When comparing the signs, the Office considers the signs as entered in the respective registers and does not take account of the way in which they are used on the market.

The Office applies the following gradations to the comparison of the signs:

- 1. Identical
- 2. High degree of similarity
- 3. Similar
- 4. Certain degree of similarity

¹² CJEU 13 September 2007, C-234/06 P, ECLI:EU:C:2007:514, point 48 and the case-law mentioned there (Bainbridge).

¹³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

¹⁴ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

¹⁵ GC 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 and 35 (Matratzen) and 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

¹⁶ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 75 and the case-law mentioned there (Equivalenza).

5. Low degree of similarity
6. Not similar

17.2.2 Comparison of the goods and services

In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. These factors include, inter alia, their nature, their end-users, and their method of use and whether they are in competition with each other or are complementary.¹⁷

Complementary goods or services are those between which there is a close connection, in the sense that one is indispensable or important for the use of the other with the result that the public may think that the same undertaking is responsible.¹⁸ For instance, clothing (class 25) is indispensable for retail services for clothing (class 35).

In comparing the goods and services, the goods and services shall be considered in the terms set out in the register and not the actual or intended use.¹⁹

According to the IP Translator decision of the CJEU the goods and services of the trademark registration should be sufficiently clear and precise.²⁰ In case the goods and services of the invoked trademark or contested trademark are insufficiently clear and precise the consequences 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. It is up to the parties to take the initiative to restrict the list of goods or services of the registration or application if they deem that to be appropriate. The Office will not actively invite them to do so.²¹

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

1. Identical
2. High degree of similarity
3. Similar
4. Certain degree of similarity
5. Low degree of similarity
6. Not similar

The grouping into classes according to the Nice Classification only serves an administrative purpose and is not determinative of whether or not goods or services are similar (see Article 2.5bis(7) BCIP).

17.2.3 Global assessment of the likelihood of confusion

A likelihood of confusion exists if the public may believe that the goods or services designated by the trademark invoked and those covered by the contested trademark come from the same undertaking or, where appropriate, from undertakings which are economically linked.²²

¹⁷ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹⁸ GC 2 February 2022, T-694/20, ECLI:EU:T:2022:45, point 30 and the case-law mentioned there (Labello).

¹⁹ GC 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

²⁰ CJEU 19 June 2012, C-307/10, ECLI:EU:C:2012:361, point 49 (IP Translator).

²¹ Rule DG 'Communication regarding classification: insufficiently clear and precise terms in class headings' of 20 November 2013.

²² CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

According to settled case-law of the CJEU, the existence of a likelihood of confusion must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.²³

The global assessment must be made by reference to the average consumer, who is reasonably well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer only rarely has the opportunity to make a direct comparison between the different trademarks but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.²⁴

If the relevant public consists of different categories of consumers with different levels of attention, the public with the lowest level of attention should be considered.²⁵

The more distinctive the earlier trademark, the greater the risk of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a less distinctive character.²⁶

It is not necessary to establish the existence of actual confusion, but the existence of a likelihood of confusion.²⁷

In case an opposition is based on a number of earlier trademarks that share common characteristics that allow them to be considered part of the same 'family' or 'serie', this may under circumstances also be a relevant factor in the global assessment of the likelihood of confusion. This requires proof that the trademarks belonging to the 'family' or 'serie' are present on the market.²⁸

The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be considered and, in particular, between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.²⁹

17.3 Taking unfair advantage of, or be detrimental to the distinctive character or the repute of the trademark with a reputation

(Article 2.2ter(3)(a) BCIP)

In case an opposition is based on Article 2.2ter(3)(a) BVIE the following conditions must be fulfilled:

- a. Identical or similar signs
- b. The earlier trademark has a reputation
- c. A link between the signs
- d. The use of the contested trademark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark
- e. There is no due cause for using the contested sign

The abovementioned conditions are cumulative. The absence of any one of them will lead to the rejection of the opposition based on this ground.

²³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

²⁴ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

²⁵ BenCJ (second chamber) 18 April 2023, C-2021/19, point 26 (ZM Zo mooi).

²⁶ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

²⁷ GC 24 November 2005, T-346/04, ECLI:EU:T:2005:420, point 69 (Arthur et Felice).

²⁸ CJEU 13 September 2007, C-234/06 P, ECLI:EU:C:2007:514, points 64-66 (Bainbridge).

²⁹ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 (Equivalenza) and the case-law mentioned there.

This ground can be applied irrespective of whether the goods or services concerned are identical, similar or not similar.

17.3.1 Identical or similar signs

For the assessment of this condition see [Section 17.2.1 Comparison of the signs](#).

17.3.2 The earlier trademark has a reputation

The concept of ‘reputation’ assumes a certain degree of knowledge amongst the relevant public, which must be considered to be reached when the trademark is known by a significant part of the public concerned by the products or services covered by that trademark.³⁰

In examining this condition all the relevant facts of the case need to be taken in consideration, in particular the market share held by the trademark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.³¹

In the case the invoked earlier trademark is a Benelux trademark or an international trademark designating the Benelux, the condition of reputation is fulfilled, as far as the territorial aspect is concerned, when the trademark has a reputation in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries.³²

In case the invoked earlier trademark is a EUTM or an international trademark designating the EU, the condition of reputation is fulfilled, as far as the territorial aspect is concerned, when the trademark has a reputation in a substantial part of the territory of the EU and such a part may, in some circumstances, correspond to the territory of a single Member State. The proprietor of that trademark is not required to produce evidence of that reputation in the Benelux when opposition is filed against a Benelux application.³³ However, if the invoked earlier trademark has no reputation in the Benelux, the use of the contested trademark will in principle not take unfair advantage of, or be detrimental to the distinctive character or the repute of the invoked earlier trademark.³⁴

17.3.3 A link between the signs

Article 2.2ter(3)(a) BCIP requires a certain degree of similarity between the earlier and the contested trademark, by virtue of which the relevant section of the public makes a connection between those two trademarks, that is to say, establishes a link between them even though it does not confuse them.³⁵ This concerns an additional requirement arising from case-law of the CJEU for the application of Article 2.2ter(3)(a) BCIP.

The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case. Those factors include: (i) the degree of similarity between the conflicting marks; (ii) the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public; (iii) the strength of the earlier mark’s reputation; (iv) the degree of the earlier mark’s distinctive character, whether inherent or acquired through use; (v) the existence of the likelihood of confusion on the part of the public.³⁶

³⁰ CJEU 3 September 2015, C-125/14, ECLI:EU:C:2015:539, point 17 and the case-law mentioned there (Iron & Smith/Unilever).

³¹ CJEU 3 September 2015, C-125/14, ECLI:EU:C:2015:539, point 18 and the case-law mentioned there (Iron & Smith/Unilever).

³² CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 29 (Chevy).

³³ CJEU 3 September 2015, C-125/14, ECLI:EU:C:2015:539, points 19-20 (Iron & Smith/Unilever).

³⁴ CJEU 3 September 2015, C-125/14, ECLI:EU:C:2015:539, point 29 (Iron & Smith/Unilever).

³⁵ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 30 (Intel Corporation).

³⁶ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, points 41-42 (Intel Corporation).

The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the contested trademark would call the earlier trademark to mind is tantamount to the existence of such a link.³⁷

17.3.4 Use would take unfair advantage of, or be detrimental to the distinctive character or the repute of the earlier trademark

The condition 'taking unfair advantage of, or be detrimental to the distinctive character or the repute of the earlier trademark' includes according to the CJEU three types of injury:

- Detriment to the distinctive character of the earlier trademark (dilution, whittling away or blurring);
- Detriment to the repute of the earlier trademark (tarnishment or degradation);
- Taking unfair advantage of the distinctive character or the repute of the trademark (parasitism or free riding).³⁸

According to the CJEU one of these three types of injury suffices.³⁹

It is not required to provide evidence of actual detriment. Demonstrating a serious risk of such detriment is sufficient.

As regard the proof of detriment to the distinctive character of the earlier trademark the CJEU held that evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier trademark was registered, consequent on the use of the contested mark, or a serious likelihood that such a change will occur in the future, must be provided.⁴⁰ In this respect logical deductions can be used.⁴¹

The existence of one of the mentioned types of injury, or a serious risk that such an injury will occur in the future, must – just as the existence of a link between the conflicting marks – be assessed globally, taking into account all factors relevant to the circumstances of the case.⁴²

17.3.5 Use without due cause

An opposition cannot succeed under Article 2.2ter(3)(a) BCIP if the defendant demonstrates that it has a due cause for using the contested trademark. The CJEU has held that the concept of 'due cause' may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the trademark with a reputation.⁴³

The mere fact that the contested trademark contains applicant's forename does not constitute a due cause.⁴⁴

³⁷ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 60 (Intel Corporation).

³⁸ CJEU 18 June 2009, C-487/07, ECLI:EU:C:2009:378, points 38-41 (L'Oréal/Bellure).

³⁹ CJEU 18 June 2009, C-487/07, ECLI:EU:C:2009:378, point 42 (L'Oréal/Bellure).

⁴⁰ CJEU 14 November 2013, C-383/12 P, ECLI:EU:C:2013:741, point 34 and the case-law mentioned there (Environmental Manufacturing/Wolf).

⁴¹ CJEU 14 November 2013, C-383/12 P, ECLI:EU:C:2013:741, points 42-43 (Environmental Manufacturing/Wolf).

⁴² CJEU 3 September 2015, C-125/14, ECLI:EU:C:2015:539, point 32 (Iron & Smith/Unilever).

⁴³ CJEU 6 February 2014, C-65/12, ECLI:EU:C:2014:49, point 45 (Leidseplein Beheer/Red Bull).

⁴⁴ CJEU 30 May 2018, C-85/16 P and C-86/16 P, ECLI:EU:C:2018:349, point 94 (KENZO).

(Articles 2.16bis, 2.16(3)(e), and 2.23bis BCIP, Rule 1.25 IR)

The basic principle is that a registered trademark must be used. In opposition proceedings, the defendant may request proof of use (Article 2.16bis BCIP). This is only possible if the opposition is based on an earlier registered trademark that, on the date of filing or priority of the contested trademark, has been registered for more than five years (i.e. is subject to a 'use obligation'). In that case, the opponent must prove that the invoked trademark has been put to genuine use as referred to in Article 2.23bis BCIP, or that there were proper reasons for non-use. If genuine use (or proper reasons for non-use) is not established, the invoked trademark will not be taken into account in the decision. If it is the only invoked right on which the opposition is based, the opposition will be rejected.

18.1 The concept of genuine use

The purpose of the obligation to make genuine use of a trademark is to reduce the total number of trademarks registered and protected and, consequently, the number of conflicts which arise between them. Therefore, a registered trademark should only be protected in so far as it is actually used in connection with the goods or services for which it is registered and it should not enable its proprietor to oppose or invalidate a later trademark the earlier mark has not been put to genuine use.⁴⁵

According to settled case-law, there is genuine use of a trademark where the mark, in accordance with its essential function to guarantee the identity of the origin of the goods or services for which it is registered, is used to create or preserve an outlet for those goods or services, not including token use for the sole purpose of preserving the rights conferred by the mark.⁴⁶ When assessing whether use of the trademark is genuine, regard must be had for all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.⁴⁷ In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly.⁴⁸

Use of the mark may in some cases be sufficient to establish genuine use, even if that use is not quantitatively significant.⁴⁹ In interpreting the concept of genuine use, account should be taken of the fact that the *ratio legis* of the requirement of genuine use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trademark protection to the case where large-scale commercial use has been made of the marks.⁵⁰

The use of a trademark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, shall also constitute use. For more information about this see Common Communication CP8 of the Convergence Program, to be found on the website of BOIP.

Genuine use of a trademark cannot be proven by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned.⁵¹

⁴⁵ Recitals 31 and 32 of the Directive 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.

⁴⁶ CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 and the case-law mentioned there (Viridis).

⁴⁷ CJEU 31 January 2019, C-194/17, ECLI:EU:C:2019:80, point 83 and the case-law mentioned there (Pandalis).

⁴⁸ GC 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 29 and the case-law mentioned there (Testa Rossa).

⁴⁹ CJEU 16 October 2003, C-259/02, ECLI:EU:C:2004:50, point 21 (La Mer).

⁵⁰ GC 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

⁵¹ GC 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

Following Rule 1.25(2) IR the proof of use should contain evidence of the place, duration, extent and manner of use of the trademark invoked for the goods on which the opposition is based.

18.1.1 Territory of use

Genuine use must be proven within the territory where the trademark is protected. In case of a Benelux trademark (or an international trademark designating the Benelux) this is the Benelux territory. In case of an EUTM (or an international trademark designating the EU) this is the EU, and genuine use must be determined in accordance with Article 18 EUTMR.

An EUTM need not necessarily have been used within the Benelux territory. However, the EU territory is much larger than the Benelux territory, so the relevant territory for establishing genuine use is proportionally larger. Therefore, as a rule, the territorial threshold for genuine use of an EUTM is higher than that 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.

In this respect, according to the case-law, national frontiers must be disregarded when assessing genuine use of an EUTM. Further, it was held that, whilst it is reasonable to expect that an EUTM should – because it enjoys more extensive territorial protection than a national trademark – be put to use in a larger area than the territory of a single Member State in order for that use to be capable of being deemed to be ‘genuine use’, it is not necessary that the mark should be used in an extensive geographic area for the use to be deemed genuine, since such a qualification will depend on the characteristics of the product or service concerned on the corresponding market.⁵² It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU for the goods and services covered by it, taking into account all relevant facts and circumstances such as 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 its frequency and regularity.⁵³

18.1.2 Proper reason for non-use

The concept of a proper reason is the exception to the rule that a trademark must be put to genuine use. It must therefore be interpreted restrictively. According to case law, only to obstacles which have a sufficiently direct connection with a trademark, make the use of that trademark impossible or unreasonable, and which occur beyond the control of the proprietor constitute a proper reason for non-use.⁵⁴

These must be external circumstances independent of the proprietor of the trademark and not circumstances related to commercial problems. The fact that revocation proceedings have been brought against a trademark does not constitute a proper reason for non-use.⁵⁵

18.1.3 Consequences of (partial) non-use

(Article 2.16bis(2) BCIP)

If genuine use is not established, then the earlier trademark will not be taken into account when rendering the decision. When this is the only earlier right upon which the opposition is based, the opposition will be rejected. If genuine use is only established for some of the goods or services for which the earlier trademark is registered, the decision will be based on only those goods or services.

⁵² CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, points 50 and 54 (ONEL).

⁵³ CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, point 58 (ONEL).

⁵⁴ CJEU 14 June 2007, C-246/05, ECLI:EU:C:2007:340, points 50-55 (Häupl).

⁵⁵ GC 18 March 2015, T-250/13, ECLI: EU:C:2016:178, point 71 (SMART WATER).

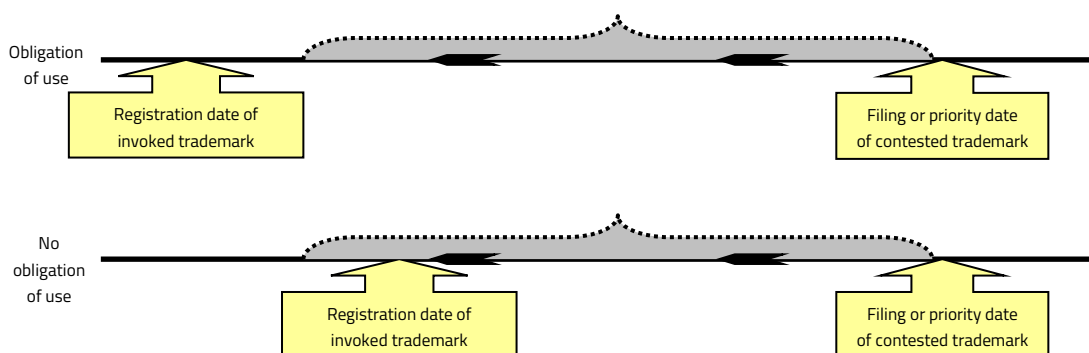
If a trademark has been registered for a broad category of goods or services within which it is possible to identify a number of distinct sub-categories, the proprietor of the earlier trademark must adduce proof of genuine use for each of those autonomous subcategories. This is because the proprietor's interest in enjoying the protection of the earlier mark for those goods or services cannot prevail over competitors' interests.⁵⁶ However, a subcategory should not be defined too narrowly, so as to not undermine the proprietor's legitimate interest in being able, in future, to extend its range of goods or services while enjoying the protection which registration of that trademark confers.⁵⁷

N.B.: failing to establish genuine use does not result in the earlier trademark being revoked. This falls outside the scope of the opposition proceedings, which only concerns the validity of the defendant's trademark. If the defendant wishes to have the earlier mark revoked, separate cancellation proceedings should be initiated.

18.2 Use obligation and calculating the relevant period

(Article 2.23bis BCIP)

The earlier mark is only subject to a use obligation, or in other words use must be proven, if it has been registered for more than five years at the time of filing (or priority date) of the contested trademark. Genuine use must then be proven for the past five years. The starting point for calculating this period is the filing date or priority date of the contested trademark application⁵⁸; the five preceding years should be calculated from that date.



As follows from the scheme above, it is important to determine the registration date of the invoked trademark to establish whether it is subject to an obligation of use.

For Benelux trademarks and EUTMs, the registration date is shown in the relevant register. In case of an accelerated registration of a Benelux trademark, since 1 March 2019, the registration date is no longer decisive to determine the obligation of use. Instead, the five-year period is calculated from the date when the trademark can no longer be subject of a refusal or an opposition or, in the event that a refusal or opposition has occurred, from the date when a decision lifting the objections became final (including the withdrawal of an opposition). In relevant cases, this date is shown on the register under 'Status accelerated registration'.

⁵⁶ CJEU 16 July 2020, C-714/18 P, ECLI:EU:C:2020:573, point 43 (TAIGA).

⁵⁷ EGC 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 61 (Kremezin).

⁵⁸ For oppositions filed before 1 March 2019, the starting point for calculating this period was the date of publication of the contested trademark.

18.2.1 Registration date under previous Benelux legislation

Historically, the rules concerning the registration date of a Benelux trademark have been changed several times. For trademarks filed since 1 January 2004, a registration date has been established and is recorded in the register. Prior to this date, previous Benelux legislation did not foresee the establishment of a registration date. Although this is a long time ago, it may, in exceptional cases, still be necessary to establish if an earlier trademark is subject to an obligation of use.

Between 1 January 1996 up to and including 31 December 2003, the applicable legislation provided that the exclusive right to the trademark commenced at the moment of registration. However, the establishment of a registration date was not foreseen. So for Benelux trademarks filed during this period, no registration date is reflected in the register. A notional registration date for such a mark can be calculated by applying current procedural rules, in order to determine the relevant period. In this case and on request, BOIP can issue a statement about this.

For trademarks filed prior to 1 January 1996, the applicable legislation explicitly states that the registration date is the date of filing.

18.2.2 Registration date of international trademarks

For international trademarks designating the Benelux, the date of registration is governed by Rule 1.8 IR. In most cases, this will be the date of publication by the International Bureau of the statement of grant of protection issued by BOIP. However, where there was initially an objection (e.g. refusal or opposition) to the registration which was subsequently lifted, the registration date will be the date of publication by the International Bureau of the Office's declaration that all objections to the registration have been lifted.

For international trademarks designating the EU, the registration date is determined by the EUTMR. The EUIPO republishes international registrations, and sends communications of this to the International Bureau. Normally, there are two republications. The first occurs when the ex officio examination has been completed but opposition is still possible, and the second occurs upon completion of all procedures when the international registration is protected, at least in part, within the EU. This second publication date is taken to be the registration date (see Articles 190(2) and 203 EUTMR), and is mentioned in the EUIPO's notification of the International Bureau.

The difference between these situations is that an international trademark designating the Benelux takes the date of publication by WIPO as the registration date, whereas an international trademark designating the EU takes the date of publication by the EUIPO (which is mentioned in the notification sent to WIPO) as the registration date. All notifications relating to international trademarks are shown in the international trademark register.

18.3 Defendant's request for proof of use

It is up to the defendant to request proof of use in the course of the proceedings. The defendant can ask for proof of use in a separate request and wait until receiving these documents before providing a substantive response to the opponent's arguments, or submit the request for proof of use along with their substantive arguments. It is in most cases recommendable to request proof of use in a separate request, so that defendants can coordinate the reaction to the proof of use with the main arguments of the case.

In either case, requests for proof of use must be presented as an explicit, unconditional and clear request, in a separate document exclusively devoted to that matter. Requests for proof of use that do not satisfy these conditions are not valid.⁵⁹

The request for proof of use may relate to all or only some of the invoked trademarks which are subject to an obligation of use, or to all or some of the goods and services on which the opposition is based.

⁵⁹ DG rule 'Requests for proof of use of a trademark invoked in cancellation and opposition proceedings' of 13 September 2022; for opposition proceedings which were filed prior to 13 September 2022, there are no requirements as to the form of the request - see BenCJ (second chamber) 19 February 2021, C 2019/19 (SCC Consulting - NV LUNOO).

18.3.1 The defendant requests proof of use but the invoked trademark is not subject to an obligation of use

If the Office receives a defendant's request for proof of use, it will not check whether the earlier registered trademark is subject to an obligation to be put to genuine use. The Office will forward the request to the opponent and grant a two-month time limit for response.

If the opponent notes that the invoked trademark is not yet subject to an obligation to be put to genuine use, it is advisable to submit a written response stating this as soon as possible. The Office will then notify the defendant and in relevant cases proceed to take a final decision (see [Section 14 Decision](#)).

If the opponent nonetheless submits proof of use, and the Office subsequently establishes when rendering the decision that the invoked trademark was not subject to an obligation to be put to genuine use, the Office will consider that the request was unfounded and the submitted evidence will not be examined.

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

If the opponent has, when filing arguments, already submitted evidence relating to the use of the invoked trademark, the defendant is still at liberty to request that proof of use be submitted. The opponent can then submit additional evidence to substantiate genuine use.

If the opponent believes that sufficient proof of use has already been submitted, it will in that case suffice for the opponent to refer to this in their response. Equally, the opponent may refer to documents that have previously submitted for other purposes (such as substantiating the reputation of the invoked trademark) as proof of use in the assessment of genuine use.

18.4 Opponent's reaction

If proof of use is requested, the Office will grant the opponent a time limit of two months in which to submit the requested evidence, or to establish that proper reasons for non-use existed. 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 within the five-year period prior to the application (or priority) date of the trademark against which the opposition is directed. This need not be a continuous usage of the mark throughout the five years. The presentation of proof of use must conform with the Office's rules on submissions (see [Section 7.3 Supporting evidence and documents](#)).

18.4.1 Documents substantiating genuine use

(Rule 1.25 (3) IR)

The general rules for the submission of documents apply to documents submitted to substantiate genuine use (see [Section 7 Submission of documents](#)).

The evidence should preferably be submitted digitally.

If this is not possible, files on digital carriers, such as USBs, may also be submitted. Physical evidence is also admissible; this should, if possible, be limited to items on paper (such as packaging, labels, price lists, catalogues, invoices, photographs, and newspaper advertisements). Submission of physical evidence or via digital carrier must be done in duplicate, so that one copy may be forwarded to the other party. If the costs of forwarding the physical evidence to the defendant exceed EUR 25, they will be borne by the opponent.

18.4.2 Undated documents or documents outside the relevant period

The evidence should be dated and relate to the relevant period. However, the mere fact that a document is undated or dates from after the relevant period does not necessarily mean that it cannot be taken into account. Even when a document post-dates the date of filing the application, it may enable the drawing of conclusions on the situation as it was on that date.⁶⁰ Such documents may confirm or contribute to a better assessment of the extent of use of the trademark in question during the relevant period.⁶¹ The Office will assess all the documents submitted as a whole to determine whether the mark is genuinely used.

18.4.3 Language of the supporting documents

(Rule 1.20 IR)

Evidence serving to support arguments or to prove the use of a trademark do not necessarily need to be submitted in the language of the proceedings but may be submitted in their original language. The evidence will only be considered if the Office judges that it can be sufficiently understood, in the light of the reason for their submission.

Invoices, for instance, are usually comprehensible as such; the same applies to advertising in most cases.

18.4.4 Renunciation of invoked trademarks

Where an opposition is based on multiple prior trademarks, only some of which are subject to an obligation to be put to genuine use, the opponent may renounce the trademark subject to the proof of use request. The opposition will then proceed solely based on the remaining invoked trademarks, and the opponent will not be obliged to submit proof of use.

18.4.5 No reaction to proof of use request

(Article 2.16(3) BCIP)

Where the opponent does not react to the proof of use request, the proceedings will be closed. If the opposition is based on multiple prior rights, the opposition may proceed based on any remaining earlier rights not affected.

This ground for closure is strictly interpreted – it refers to the situation where no evidence at all (or arguments relating to a proper reason for non use) was submitted. If the opponent submitted evidence but such evidence is insufficient to establish genuine use, this is not a ground for closure but will be relevant in the substantive decision.

18.4.6 Proof of use may not be used to substantiate reputation

The opponent may indicate that evidence that was previously submitted for other purposes, such as to substantiate the reputation of an earlier registered trademark or the existence of a well-known trademark within the meaning of Article 6bis of the Paris Convention, is to be taken into account as proof of use. However, the opponent cannot use the submission of proof of use as an opportunity to remedy a lack of supporting evidence that should have been submitted with their argumentation under Rule 1.14(1)(c) IR.

⁶⁰ CJEU 17 July 2008, C-488/06, ECLI:EU:C:2008:420, point 71 (Aire Limpio).

⁶¹ CJEU 27 January 2004, C-259/02, ECLI:EU:C:2004:50, point 31 (La Mer).

18.5 Defendant's reaction

18.5.1 Reaction to proof of use

If the opponent submits proof of use, it will be sent to the defendant. The defendant will then be granted a period of two months to respond to the submitted proof of use. If the defendant has asked for proof of use in a separate request, he can respond to the arguments as well as the proof of use. However, if the defendant has asked for proof of use together with his arguments, he may only respond to the proof of use. This is because, in principle, there is only one round of argumentation in opposition proceedings.

18.5.2 No reaction to proof of use

(Rule 1.21(d) IR)

If the defendant does not reply to the proof of use submitted by the opponent, the genuine use of the trademark is deemed to be undisputed and the Office will not examine the proof of use in its decision.

If the defendant does not react to the opposition at all, the proceedings will be closed. A reaction within the meaning of Article 2.16(3)(b) BCIP is taken to mean a response on the substance of the opposition (see [Section 12.1.2 The defendant fails to respond to the opposition filed](#)). A request for proof of use is not considered to be a response on the substance of the opposition

18.5.3 Withdrawal of request for proof of use

(Rule 1.25(4) IR)

The defendant may withdraw its request to submit proof of use. 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.

(Article 2.2ter(2)(d) BCIP)

Pursuant to Article 2.2ter(2)(d) BCIP, 'earlier trademarks' within the meaning of Article 2.2ter(1) of the BTIP (also) means:

- d. trademarks which, on the date of application for registration of the trademark, or, where appropriate, of the priority claimed in respect of the application for registration of the trademark, are well known in the Benelux territory, in the sense in which the words 'well-known' are used in Article 6bis of the Paris Convention.

When filing the opposition, the opponent must indicate on the electronic form that it is invoking a well-known mark within the meaning of Article 6bis of the Paris Convention and attach a representation of that mark. Evidence showing that the mark is actually well known in the Benelux territory should be submitted together with the arguments (Rule 1.14(1)(c) UR). As clearly indicated in Article 2.2ter(2)(d) BCIP, the reference date for being a well-known mark is the date of application (or priority) of the contested trademark.

Article 6bis was included in the Paris Convention (in 1925), with the aim of preventing the registration or use of a trademark likely to cause confusion with an already existing well known mark, even if this well known mark was not or not yet protected by registration in that country. The provision thus offers protection to non-registered trademarks and in this sense constitutes an exception to the principal rule that trademark rights arise from registration (attributive system). The threshold for this is high; the mark must be well-known throughout the Benelux territory or in a substantial part of it.⁶²

A well-known mark within the meaning of Article 6bis of the Paris Convention constitutes a separate basis for opposition and, although its evidence amounts to more or less the same thing, must be distinguished from reputation within the meaning of Article 2.2ter(3)(a) BCIP (see [Section 17.3.2 The earlier trademark has a reputation](#)). In the case of a reputation within the meaning of Article 2.2ter(3)(a) BCIP, it concerns a registered trademark that enjoys broader protection under certain conditions, including for non-similar goods or services. In the case of a well-known mark within the meaning of Article 6bis of the Paris Convention, it concerns a non-registered trademark, on the basis of which the holder can only invoke the grounds referred to in Article 2.2ter(1) BCIP: identical trademarks for identical goods or services or likelihood of confusion in the case of similar trademarks and goods or services. Therefore, although this is not ruled out in principle, it makes little sense in an opposition to invoke a well-known mark within the meaning of Article 6bis of the Paris Convention in addition to a registered earlier mark. Indeed, the registered mark with a reputation offers broader protection than the unregistered well-known mark.

Well-known marks are not subject to an obligation of use as referred to in Articles 2.16bis and 2.23bis BCIP, because these provisions only relate to trademarks that have been (longer than five years) registered. However, the opponent must prove that it concerns a well-known trademark within the Benelux territory, which is normally the result of (long and intensive) use.

⁶² CJEU 22 November 2007, C-328/06, ECLI:EU:C:2007:704 (Nieto Nuño).

(Articles 2.2ter(3)(b), 2.14(2)(b) and 2.20ter(1)(b) BCIP)

According to Article 2.2ter(3)(b) BCIP, a trademark shall, in case an opposition is filed, not be registered, where 'an agent or representative of the proprietor of the trademark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action'. Article 2.14(2)(b) BCIP provides that opposition on this ground may be filed 'by the proprietors of trademarks referred to therein' and that in the opposition, in addition to refusal of the registration, its transfer can also be claimed.

The purpose of this provision is 'to prevent the misuse of the earlier mark by the agent or representative of the proprietor of that mark, as those persons may exploit the knowledge and experience acquired during their business relationship with that proprietor and may therefore improperly benefit from the effort and investment which the proprietor himself has made'.⁶³

Application of this provision is subject to the following cumulative conditions:⁶⁴

- i. The opponent is the proprietor of an earlier trademark.⁶⁵
- ii. The defendant is or was an agent or representative of the proprietor of the trademark.
- iii. The application was filed in the name of the agent or representative without the proprietor's consent and without there being legitimate reasons to justify the agent's or representative's action.
- iv. The application relates in essence to identical or similar signs and goods.

For condition i, when filing the opposition on the electronic form, the opponent has to mention the details of the earlier mark (protected outside the Benelux). In its arguments, the opponent will have to demonstrate that the other conditions are met.

The terms 'agent or representative' (condition ii) are to be interpreted broadly: 'all forms of relationship based on a contractual agreement under which one of the parties represents the interests of the other, with the result that it is sufficient [...] that there is some agreement or commercial cooperation between the parties of a kind that gives rise to a fiduciary relationship by imposing on the applicant, whether expressly or implicitly, a general duty of trust and loyalty as regards the interests of the proprietor of the earlier mark'.⁶⁶

For condition iii, consent or legitimate reasons are essentially defences and so, for example, it is for the defendant to show that consent exists and that it is clear, specific and unconditionally granted.⁶⁷

For condition iv, while the marks and goods or services need not be identical, the assessment of similarity according to the criteria for likelihood of confusion is also not required. The assessment must take into account the purpose pursued by the provision, which is to prevent misuse of the earlier trademark by the agent or representative of the proprietor of that trademark.⁶⁸

⁶³ CJEU 11 November 2020, C-809/18 P, ECLI:EU:C:2020:902, point 72 (MINERAL MAGIC).

⁶⁴ GC 13 April 2011, T-262/09, ECLI:EU:T:2011:171, point 61 (First Defense Aerosol Pepper Projector).

⁶⁵ Normally, it concerns a trademark not protected in the Benelux. Indeed, if the opponent would possess a trademark protected within the Benelux, it would be more likely to base the opposition on that.

⁶⁶ CJEU 11 November 2020, C-809/18 P, ECLI:EU:C:2020:902, point 85 (MINERAL MAGIC).

⁶⁷ GC 6 September 2006, T-6/05, ECLI:EU:T:2006:241, point 40 (First Defense Aerosol Pepper Projector).

⁶⁸ CJEU 11 November 2020, C 809/18 P, ECLI:EU:C:2020:902, point 72 et seq. (MINERAL MAGIC).

(Articles 2.2ter(3)(c), 2.14(2)(c) and 2.16(2)(b) BCIP)

The essential function of PGIs or PDOs is to guarantee the consumer the geographical origin of goods and the particular qualities associated with that origin.⁶⁹

It is the applicable national or European Union legislation that determines the granting conditions and the scope of the protection of geographical indications and designation of origin.⁷⁰

According to article 2.2ter (3)(c) BCIP, a trademark shall, in case an opposition is filed, not be registered where and to the extent that, pursuant to Union legislation or the internal law of one of the Benelux countries providing for protection of designations of origin and geographical indications:

- i. an application for a designation of origin or a geographical indication had already been submitted in accordance with Union legislation or the internal law of one of the Benelux countries prior to the date of application for registration of the trademark or the date of the priority claimed for the application, subject to its subsequent registration;
- ii. that designation of origin or geographical indication confers on the person authorised under the relevant law to exercise the rights arising therefrom the right to prohibit the use of a subsequent trademark.

The second paragraph implies that the question whether a PGI or PDO can be successfully invoked as a basis for opposition is not governed by concepts of trademark law such as similarity or likelihood of confusion. Instead, it must be established whether the legal instrument by which the designation of origin or geographical indication is protected confers the right to prohibit the use of a subsequent trademark.

In general, PGI's and PDO's are protected against:

1. any use of the PGI or PDO (direct or indirect):
 - in respect of comparable products that do not comply with the product specification; or
 - insofar as such use exploits, weakens or dilutes the reputation of the PGI or PDO;
2. any misuse, imitation or evocation;
3. any other false or misleading indications or practices.

Evocation concerns situations in which the contested trademark does not use the geographical indication as such but suggests it in such a way that the consumer is led to establish a sufficient link of proximity between this sign and the PGI or PDO.⁷¹

A PGI or PDO is protected against any usurpation, imitation or evocation even if the true origin of the goods or services is indicated or if the protected name is accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation', 'flavour' or similar expression.⁷²

The opponent must submit evidence of the existence of the PGI or PDO invoked, as well as evidence of its entitlement to file the opposition, namely, that it is authorised under the relevant law to exercise the rights arising from a PGI or PDO.

Where an opposition is based on an application for a PGI or PDO, the opposition proceedings are suspended ex officio until a final decision has been reached in the registration procedure (see [Section 10.2.2. Circumstances relating to the earlier PGI or PDO](#)).

⁶⁹ CJEU 29 March 2011, C-96/09 P, EU:C:2011:189, point 147 (Bud).

⁷⁰ See for example Regulation (EU) No 1308/2013 in respect of *wines*; Regulation (EU) 2019/787 in respect of *spirit drinks*; Regulation (EU) No 1151/2012 in respect of *agricultural products and foodstuffs*.

⁷¹ CJEU 7 July 2018, C-44/17, ECLI:EU:C:2018:415, point 51 (Scotch Whisky).

⁷² Article 103 of the EU Regulation No 1308/2013; Article 21 of the EU Regulation No 2019/787; Article 13 of the EU Regulation No 1151/2012.

Trademarks containing PGIs and PDOs may also, in certain circumstances, be subject to obstacles based on absolute grounds (see for this purpose BOIP guidelines on absolute grounds).