

BOIP



Benelux Office for  
**Intellectual  
Property**

[www.boip.int](http://www.boip.int)



# Absolute grounds

Webinar, 22 November 2022

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# Programme



Facts & figures

Peek behind the scenes

Tips & tricks

Interesting cases 2022

Q & A





## Question 1

**How many rulings on absolute ground refusals were issued by the BenCJ in 2022?**



I. <5

II. 5-10

III. 10-15

IV. >15





## Some facts & figures

### Refusal (ex parte)

Applications (2021):	23,969	
Provisional refusal (2021):	1,581	(6,6%)
Final refusal (2021):	1,083	(4,5%)
<b>BenCJ rulings (2022):</b>	<b>0</b>	(4 still pending)



### Cancellation (inter partes)

Cancellation decisions (2022): 19

**BOIP on absolute grounds :** **3**

BenCJ rulings (2022): 9

**BenCJ absolute grounds:** **2**

**Cases we will discuss:** **5**

(bad faith out of scope)





# Peek behind the scenes

## Sources:



- BCIP
- Implementing Regulations
- Guidelines
- CP
- Caselaw





## Peek behind the scenes

### CP's involving absolute grounds:



-CP3

Combined word device marks containing descriptive or non-distinctive words



-CP9

Distinctiveness of shape marks. When the shape is not-distinctive and contains a distinctive element



-CP11

Examination of formal requirements and grounds for refusal regarding new trademark types

Multimedia mark



Click on the image to reproduce

# Peek behind the scenes

## CP's involving absolute grounds:



-C13 (new)  
Trademark applications in bad faith



-CP14 (new)  
Trademarks contrary to public policy or contrary  
to accepted principles of morality.

Feedback: 25 November 2022

See: [www.tmdn.org](http://www.tmdn.org)





# Peek behind the scenes

## Application

- Ex officio examination
- As close to (economic) reality
- Operations (examiners)
- Committee of Lawyers
- Proofreading by legal



## Cancellation

- Inter partes proceedings
- Presumption of validity
- Cancellation - 3 lawyers
- 1 rapporteur, 2 proofreaders







# Peek behind the scenes

## Information centre

Core value: customer centric



- Legal questions
- Technical questions



078 052 242 (from Belgium)  
070 349 12 42 (from the Netherlands)  
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# Tips & tricks

## Applications:

- Specify description of goods/services
- Evidence of acquired distinctiveness at filing



## Responses to provisional refusals:

- Quality over quantity
- Factual arguments



## Cancellations:

- Principle of hearing both sides (2.30bis (1) BCIP; 1.37 / 1.21 IR)
- Examination limited to arguments of parties
- Facts to which party did not respond – undisputed





## Question 2

What is the percentage of word marks + word figurative marks?



I. <75%



II. 75-85%

III. 85-95%



IV. >95%

TYPE
Word mark
Figurative mark with word elements
Figurative mark
Motion mark
Shape mark
Shape mark with word elements
Pattern mark
Position mark
Sound mark
Multimedia mark
Hologram mark
Colour mark
Other



## Question 2: **96.81%** word + word/figurative marks

TYPE		
Word mark	10.668	48,75%
Figurative mark with word elements	10.519	48,06%
Figurative mark	658	3,01%
Motion mark	3	0,01%
Shape mark	3	0,01%
Shape mark with word elements	13	0,06%
Pattern mark	2	0,01%
Position mark	7	0,03%
Sound mark	4	0,02%
Multimedia mark	2	0,01%
Hologram mark	0	0,00%
Colour mark	1	0,00%
Other	5	0,02%





# Programme



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# Recent caselaw

## Cancellation 3000217 of 13 January 2022 (Kamer van Koophandel / UBO)



### Word mark UBO

*'The claimant argues that the designation UBO stands for 'ultimate beneficial owner'. Irrespective of the fact that the claimant has provided sufficient evidence of the aforementioned meaning, it should be noted that the defendant does not dispute the fact that UBO stands for 'ultimate beneficial owner', so that this has to be regarded as an established fact between the parties and the Office must take it as a starting point'*



### Appeal pending



## Recent caselaw

**Cancellation 3000257 of 8 April 2022  
(Van Haren / Airwair)**



### Position mark

*The trade mark consists of the combination of a black welt (Pantone 19-3909 TCX) that runs along the perimeter of a boot's outsole and a yellow stitch (Pantone 3965 XGC) applied to the welt in the manner as shown.*

*The matter shown in dotted lines, being the outline of the boot's upper and outsole, are not part of the trade mark but serve to show the positioning of the trade mark*

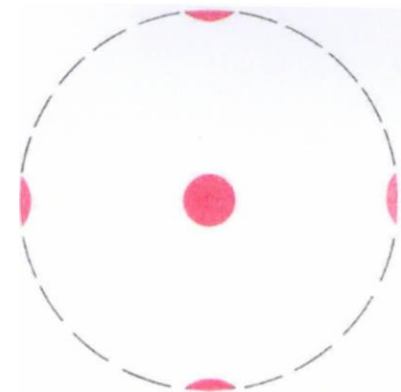
**Appeal pending**





## Recent caselaw

**Cancellation 3000125 of 31 October 2022  
(Hector Cue Sports / Saluc)**



### **Position mark**

*Red, white. The mark is made up of red dots, each of which is placed at the intersection of two circumference lines. The dotted surface is the billiard ball or the bowling ball.*



**Appeal period pending**





# Recent caselaw

**IK WIL VAN MIJN AUTO AF**

**Application 1358332 of 28 July 2017**

**Cancellation 3000010 of 3 June 2019  
(WijKopenAutos / Dealerdirect Global)**

**Appeal cancellation C 2019/14 of 27 January 2022  
(Dealerdirect Global / WijKopenAutos)**





# Recent caselaw

## GOODBYE YELLOW

**Cancellation 3000166 of 25 August 2020  
(Henkel AG & Co / Good-Bye)**



**Appeal cancellation C 2020/16 of 13 May 2022  
(Good-Bye / Henkel AG & Co)**



## PET'S BUDGET

*'Immediately and without further thought'?*





## Question 3

**Which trademark(s) did BOIP accept?**

(You can tick more than one box)



**I. EDUCATION IS A MARATHON, NOT A SPRINT...**  
(*education*)



**II. THE DUTCH WAY TO SAY CHEESE**  
(*cheese*)



**III. TAKE ANOTHER LOOK**  
(*glasses*)

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# Q & A



# Thank you for joining!

- Next week:  
Relative grounds  
(Eline Schiebroek / Camille Janssen)
- PE Points
  - Confirmation e-mail
  - Code word (BMM): **November**
- Survey, please fill it out



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# Claiming PE points: In the BMM portal only!



The screenshot shows a web browser window with the URL `intranet.bmm.nl/nl/app/education/create`. The page header includes the BMM logo (Benelux Vereniging voor Merken- en Modellenrecht) and navigation links: Keurmerk, Evenementen, Nieuws, Leden, Informatie, Commissies, Contact. The user is logged in as CAMILLE JANSSEN (NL). The main heading is "Anmelden voor nieuwe opleidingspunten". The form contains the following fields:

- Opleiding: BOIP Webinar (dropdown menu)
- Aantal punten: 1 (text input)
- Omschrijving: CODE WORD (text input)
- Datum opleiding behaald: (empty text input)
- Opleidingsbewijs 1: Choose File No file chosen
- Opleidingsbewijs 2: Choose File No file chosen
- Opleidingsbewijs 3: Choose File No file chosen

At the bottom, there are two buttons: "OPSTAAAN" and "TERUG".

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