

Benelux Convention Concerning Trademarks

(of March 19, 1962)*

His Majesty the King of the Belgians,

Her Royal Highness the Grandduchess of Luxembourg,

Her Majesty the Queen of the Netherlands,

Inspired by the desire to review their legislation in respect of trademarks and to bring about unity in the trademark law of their countries;

Have resolved to enter into a Convention for the said purpose and *have designated* to that end as their Plenipotentiaries...

who, upon production of their full credentials found to be in due and proper form, *have agreed* upon the following provisions:

Article 1

The High Contracting Parties shall incorporate into their national legislation the Uniform Benelux Trademark Law, annexed to this Convention, in either one or both of the original texts, and shall establish an administrative office common to their countries under the name “Benelux Trademark Office” [*Benelux-Merkenbureau* or *Bureau Benelux des Marques*].

Article 2

Implementation of the Uniform Law shall be ensured by way of Executive Rules, laid down by mutual agreement by the High Contracting Parties, upon consultation of the Executive Board, provided for in [Article 3](#), of the Benelux Trademark Office, and by way of Administrative Regulations laid down by the said Board.

The Rules and Regulations shall become binding in each country in conformity with the provisions of its domestic law.

The Rules and Regulations shall be published in the Official Journal of each of the High Contracting Parties.

Article 3

The Benelux Trademark Office shall be entrusted with the implementation of the Uniform Law and the Rules and Regulations.

The Office shall be administered by an Executive Board composed of members appointed by the High Contracting Parties, namely, one administrator and one deputy administrator per country.

* *French title*: Convention Benelux en matière de marques de produits.

Entry into force: July 1, 1969.

Source: Communication from the Benelux Trademark Office.

The Executive Board shall annually elect its Chairman.

Article 4

The Executive Board shall regulate all matters incidental to the general operation of the Benelux Trademark Office.

It shall establish the Rules of Practice and the Financial Regulations of the Office as well as the Administrative Regulations.

It shall advise on and make proposals for the Executive Rules.

It shall appoint the Director of the Office, who must be a subject of one of the High Contracting Parties, and shall determine his duties.

It shall annually adopt the budget of income and expenditure, as well as any modifications thereof or additions thereto, and it shall specify, in the Financial Regulations, the manner in which superintendence of the budgets and the execution thereof shall be exercised. It shall approve the accounts drawn up by the Director.

The Board shall take resolutions by a unanimous vote.

Article 5

Half of the cost of establishing the Benelux Trademark Office shall be borne by the Kingdom of the Netherlands and the other half shall be borne by the Belgian-Luxembourg Economic Union.

The Executive Board may request the High Contracting Parties to make a contribution to cover extraordinary expenses; half of any such contribution shall be borne by the Kingdom of the Netherlands and the other half shall be borne by the Belgian-Luxembourg Economic Union.

Article 6

The operating expenses of the Office shall be defrayed out of its income, namely:

1. the fees collected under the Uniform Law;
2. the income accruing to the High Contracting Parties from application of the Madrid Agreement Concerning the International Registration of Marks, signed on April 14, 1891;
3. The charges for examinations made of prior registrations;
4. proceeds from the sale of publications and copies.

If necessary, the High Contracting Parties shall make a contribution to the Office; half of such contribution shall be borne by the Kingdom of the Netherlands and the other half shall be borne by the Belgian-Luxembourg Economic Union.

Article 7

A percentage of the fees collected in respect of operations performed through the intermediary of the national offices shall be distributed to the said offices to cover the costs which such operations entail; the said percentage shall be prescribed by the Rules.

No national fees in respect of such operations may be levied by national legislation.

The international fee in respect of applications for the international registration of marks shall be paid to the Benelux Trademark Office which shall take care of remittance to the International Bureau established by the Paris Convention for the Protection of Industrial Property, signed on March 20, 1883.

Article 8

The Benelux Trademark Office shall be placed under the protection of the Government of the Kingdom of the Netherlands; its seat shall be at The Hague.

Article 9

The authority of judicial decisions rendered in one of the three States pursuant to **Article 14 or 27** of the Uniform Law shall be recognized in the two other States, and cancellation ordered by the competent courts of law shall, at the request of the first mover and under the responsibility of the Executive Board, be effected by the Office if:

1. the transcript of the decision submitted meets, according to the laws of the country where such decision was made, the prescribed requirements as to authenticity;
2. the decision is no longer open to opposition, appeal, or cassation proceedings.

Article 10

As soon as a Benelux Court of Justice has been established, it shall take cognizance of any questions of interpretation of the Uniform Law.

Article 11

Application of this Convention shall be confined to the territories of the High Contracting Parties in Europe.

Article 12

This Convention shall be subject to ratification. The instruments of ratification shall be deposited with the Government of the Kingdom of Belgium.

Article 13

This Convention shall enter into force on the first day of the month following the deposit of the third instrument of ratification.

The Uniform Law shall enter into force 18 months after the entry into force of this Convention.

Article 14

This Convention is entered into for a period of 50 years. It shall remain in force thereafter for successive periods of 10 years, unless one of the High Contracting Parties should, within one year prior to the expiration of a given period, notify the other Contracting Parties of its intention to terminate the said Convention.

Any proposals for revision made after the expiration of a period of 10 years from the entry into force of this Convention and which have not secured the agreement of all of the High Contracting Parties shall be submitted to the Benelux Interparliamentary Advisory Council.

The right to denounce this Convention shall be conferred upon the High Contracting Party on whose proposals for revision the Benelux Interparliamentary Advisory Council has expressed a favorable opinion with which the two other Contracting Parties or one of them does not concur. Such right must be exercised within a reasonable period of time.

Denunciation shall not take effect until five years have elapsed from the date of the notice thereof given to the two other Contracting Parties.

In witness whereof the Plenipotentiaries have signed this Convention and affixed their seals thereto.

Done in Brussels this 19th day of March 1962 in triplicate in the Dutch and French languages, both texts being equally authentic.

II

Uniform Benelux Law on Marks

(of March 19, 1962, as amended on November 10, 1983)*

TABLE OF CONTENTS**

	<i>Articles</i>
Chapter I: Individual Marks	1 to 18
Chapter II: Collective Marks.....	19 to 28
Chapter III: Transitional Provisions.....	29 to 35
Chapter IV: General Provisions	36 to 38

* *French title:* Convention Benelux en matière de marques de produits and Loi uniforme Benelux sur les marques.

Entry into force (as between Belgium, Luxembourg and the Netherlands) of the Convention: July 1, 1969; entry into force of the Uniform Law as amended: January 1, 1987.

Source: Communication from the Benelux Trademark Office.

** Added by WIPO.

Chapter V: Service Marks

General Provisions	39
Transitional Provisions	40 to 43

Protocol Amending the Uniform Benelux Trademark Law

Chapter I Individual Marks

Article 1

The following shall be considered individual marks: designations, designs, prints, seals, letters, numbers, shapes of goods or their get-up, and any other symbols which serve to distinguish the goods or services of an enterprise.

However, shapes determined by the very nature of the goods or which affect their actual value or produce industrial results cannot be considered marks.

Article 2

Without prejudice to the provisions of ordinary civil law, a surname may serve as a mark.

However, the proprietor of such a mark may on no account oppose the use which persons bearing the same name might make thereof merely for the purpose of identification and without giving it the appearance of a mark.

Article 3

Without prejudice to the rights of priority provided for in the Paris Convention for the Protection of Industrial Property or in the Madrid Agreement Concerning the International Registration of Marks, an exclusive right to a mark shall be acquired by the first filing made within the Benelux territory (Benelux filing) or resulting from a registration with the International Bureau for the Protection of Industrial Property (international filing).

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

- (a) like individual marks filed in respect of similar goods or services;
- (b) like collective marks regardless of the goods or services in respect of which they were filed.

Article 4

Within the limits set by [Article 14](#), no right to a mark shall be acquired by:

1. the filing of a mark that, regardless of the use being made thereof, is contrary to morality or public policy in one of the Benelux countries, or in respect of which **Article 6ter** of the Paris Convention provides for refusal or invalidation;

2. a filing made for goods or services in respect of which use of the mark is likely to deceive the public;

3. the filing of a mark resembling a collective mark, regardless of the goods in respect of which it was filed, to which a right was attached which lapsed in the course of the three years preceding the filing;

4. the filing of a mark resembling an individual mark filed by a third party for similar goods or services and to which a right was attached which, on account of the expiration of the registration, lapsed in the course of the three years prior to the filing, unless the said third party gave his consent or there was non-use of the said mark as mentioned in **Article 5, item 3**;

5. the filing of a mark likely to cause confusion with a well-known mark, within the meaning of **Article 6bis** of the Paris Convention, and owned by a third party who has not given his consent;

6. filing effected in bad faith, including, *inter alia*:

(a) filing effected by a person who knows or has no valid excuse for not knowing that within the preceding three years a third party has, in good faith and in the normal manner, used a like mark for similar goods or services on Benelux territory, and the said third party has not given his consent;

(b) filing effected by a person who, as a result of direct relations with a third party, knows that during the preceding three years the said party has, in good faith and in the normal manner, used a like mark for similar goods or services outside the Benelux territory, unless the said third party has given his consent or such knowledge was obtained only after the person effecting the filing had started to use the mark within the Benelux territory.

Article 5

A right to a mark shall lapse:

1. by voluntary cancellation or by expiration of the registration of the Benelux filing;

2. by cancellation or expiration of the international registration, or by renunciation of protection within the Benelux territory, or, in accordance with the provisions of **Article 6** of the Madrid Agreement, as a result of the fact that the mark no longer enjoys legal protection in the country of origin;

3. insofar as, either within the three years following filing or for an uninterrupted period of five years, the proprietor of the mark or a licensee has failed to make any normal use of the mark within the Benelux territory without a valid reason; in case of litigation, the court may place the burden of proof of user, either wholly or in part, upon the proprietor of the mark; however, non-use during a period which precedes the issue of the writ of summons by more than six years must be proved by the party relying on it;

4. insofar as a mark, after having been duly acquired, has, by the proprietor's own doing, become the usual designation of a product.

Article 6

A. Benelux filing of marks shall be effected either with the national offices or with the Benelux Trademarks Office in the manner and on payment of the fees prescribed by the Rules. The authorities entrusted with receiving the filing shall ascertain that the documents submitted meet the requirements as to form and shall draw up the instrument of filing which shall indicate the date on which filing was effected.

B. Admissibility of the filing of a mark may, by Rule, be made conditional upon performance of one of the following acts, at the option of the person effecting the filing:

1. either the production of a document attesting to the fact that an examination of prior registrations was carried out by the Benelux Office within the three months preceding the filing of the mark, in accordance with the provisions laid down in the Rules;

2. or the submission, at the time of filing and through the intermediary of the authorities entrusted with receiving the filing, of a request for examination.

In the latter case the instrument of filing shall be provisional. It shall have legal effect only in the event that the person effecting the filing or his agent, upon receipt of the results of the examination of prior registrations and within a time limit to be prescribed by the Rules, announces his wish to maintain the filing. If and when the instrument of filing acquires legal force, it shall retain its original date.

C. The filing of a mark cannot give rise to any examination whatever as to substance the results of which might be invoked by the Benelux Office against the person having effected the filing.

D. Any claim to priority relied upon by virtue of [Article 4](#) of the Paris Convention shall be made in the instrument of filing or by way of a special declaration to be submitted to the Benelux Office, in the month following that of the filing of the mark, in the manner and on payment of the fees prescribed by the Rules. The absence of such a claim shall cause forfeiture of the right of priority.

Article 7

A. International filing shall be effected in conformity with the provisions of the Madrid Agreement. The national fee provided for in [Article 8\(1\)](#) of the Madrid Agreement shall be prescribed by the Rules.

B. However, if any Rule should make the admissibility of Benelux filings subject to the conditions mentioned in [Article 6B](#), then it may likewise provide that international filings shall be subjected *ex officio* to an examination for anticipation.

Article 8

The Benelux Office shall register, forthwith, instruments of Benelux filings for the goods or services indicated by the person having effected the filing and shall issue a

certificate of registration to the proprietor; it shall also register, in respect of the goods indicated by the persons who effected the filings, notices of international registrations in regard to which such persons have requested that the effects shall extend to the Benelux territory.

The legal date of registration shall be that of the Benelux or of the international filing.

The registration shall indicate the date of and the grounds for the priority, if any, which has been claimed.

Article 9

At the request of persons filing marks or of third parties, the Benelux Office shall, for a consideration, undertake any examination of prior registrations of marks in the Benelux Register.

If required, the Office shall likewise undertake the examinations provided for in [Article 6B](#) and [Article 7B](#) of prior registrations of marks in the Benelux Register.

It shall transmit the results of the examination to the party having made the request without any statement of reasons or conclusions whatever.

With a view to examination thereof, registered marks shall be classified according to a system established by the Benelux Office.

Article 10

The registration of a Benelux filing shall be for a term of 10 years, to be counted from the filing date.

The symbol constituting the mark may be modified neither during the term of the registration nor on the occasion of the renewal thereof.

The registration shall be renewed, upon request, for further periods of 10 years in the manner and on payment of the fees prescribed by the Rules.

Renewal must be applied for within the period of six months prior to the expiration of the registration. It shall be operative as from the end of that period.

Six months prior to the expiration of the registration, the Benelux Office shall remind the proprietor of the mark in writing, as well as the agent, if any, mentioned in the instrument of filing, of the precise date of such expiration.

The Office shall dispatch the said reminders to the last known address of the parties concerned. Failure to dispatch or to receive such notices shall not exonerate the said parties from effecting the renewal within the prescribed time limits; no reliance can be placed on such failure either before the courts of law or before the Office.

The Office shall record the renewals.

Article 11

A. Independently of the transfer of the business or a part thereof, the exclusive right to a mark may be transferred, or may be the subject of a license, for all or part of the goods or services in respect of which the said mark was filed.

The following shall be null and void:

1. any assignments *inter vivos* or licenses not laid down in writing;
2. any assignments or other transfers not made for the entire Benelux territory.

B. No limitation of a license, other than a restriction as to its duration or to part of the goods or services in respect of which the mark was filed, shall have any effect regarding the application of this Law.

C. An assignment or other transfer or a license may be invoked against third parties only after an entry has been made in the Register of an abstract of the instrument by which such transfer or such license is evidenced, or of a statement relating thereto and signed by the parties concerned, and such entry has been made in the manner and on payment of the fees prescribed by the Rules.

D. Provided that he acts jointly with the proprietor, the licensee shall be competent to claim compensation for all damage sustained by him as a result of the unlawful use of the mark by a third party.

Article 12

A. Regardless of the nature of the action instituted, no one may judicially claim protection for a symbol which is considered a mark within the meaning of Article 1 unless he has filed it in due form and, where applicable, has had the registration renewed.

Inadmissibility may be pronounced *ex officio* by the court. It shall be removed by a filing or renewal effected during the proceedings.

Damages can on no account be awarded for facts which occurred prior to filing.

B. The provisions of this Law shall be without prejudice to the right of users of a symbol not regarded as a mark within the meaning of [Article 1](#) to rely on the provisions of ordinary civil law insofar as the latter provisions allow opposition to be made to the unlawful use of such symbol.

Article 13

A. Without prejudice to the possible application of ordinary civil law in matters of civil liability, the proprietor of a mark may, by virtue of his exclusive right, oppose:

1. any use made of the mark or of a like symbol for the goods or services in respect of which the mark is registered, or for similar goods or services;
2. any other use, in economic intercourse, of the mark or of a like symbol made without a valid reason under circumstances likely to be prejudicial to the proprietor of the mark.

Subject to the same conditions, the proprietor may, by virtue of the said right, claim indemnification for any damage sustained by him as a result of such use.

The exclusive right to the mark shall not, however, include the right to oppose the use of the mark for goods or the right to oppose the use of the mark for goods or services brought into circulation under the said mark by the proprietor or his licensee, provided, however, that the condition of the goods or services has not been altered.

B. In judging the similarity of goods or services, the administrative classification adopted for the registration of marks shall not be used as a criterion.

C. The exclusive right to a mark worded in one of the national or regional languages of the Benelux territory shall extend as of right to its translation into any other of the said languages.

Judgment of resemblance resulting from translations involving one or more languages foreign to the said territory shall be vested in the court.

Article 14

A. Any interested party, including the Crown's Attorney and Public Prosecutor, may invoke the nullity:

- 1(a) of the filing of a symbol which, pursuant to [Article 1](#), is not considered a mark, in particular where it is devoid of any distinctive character within the meaning of [Article 6quinquies B\(2\)](#) of the Paris Convention;
- (b) of a filing which, in the order of priority, ranks after that of a like collective mark according to the provisions of [Article 3,second paragraph](#), of this Law;
- (c) of a filing under which, pursuant to [Article 4,items 1](#) and [2](#), of this Law, no trademark right is acquired;

2. of a filing under which, pursuant to [Article 4,item 3](#), no trademark right is acquired, subject to the condition that nullity must be invoked within a period of five years from the filing date.

Where the action for nullity is instituted by the Crown's Attorney and Public Prosecutor, the Courts of Brussels, The Hague and Luxembourg shall have exclusive jurisdiction in the cases mentioned hereinabove. The institution of action by the Crown's Attorney and Public Prosecutor shall stay any other suit instituted on the same grounds.

B. Provided that the proprietor of the prior registration or the third party referred to in [Article 4, items 4](#), [5](#) and [6](#), is a party to the proceedings, any interested party may invoke the nullity:

1. of a registration which, in the order of priority, ranks after that of a like individual mark according to the provisions of [Article 3, second paragraph](#);

2. of a registration in respect of a filing under which, pursuant to [Article 4, items 4](#), [5](#) and [6](#), no trademark right is acquired; nullity under the provisions of the said [item 4](#) must be invoked within a period of three years from the expiration of the prior registration, whereas nullity under the provisions of the said [items 5](#) and [6](#) must be invoked within a period of five years from the filing date.

C. Any interested party may invoke the lapse of a right to a mark in the cases provided for in [Article 5, items 3](#) and [4](#).

D. The courts shall have exclusive competence to give judgment in proceedings based on this Law; they shall *ex officio* order the cancellation of registrations of filings declared null and void, as well as of filings that have given rise to rights declared to have lapsed.

Article 15

A. The proprietor of a registration effected in respect of a Benelux filing may at any time request the cancellation of his registration. However, if a license is on record, then cancellation of the registration of the mark or the license can only be requested jointly by the proprietor of the registration and the licensee.

B. The cancellation shall be effective throughout the Benelux territory.

C. A renunciation—limited to part of the Benelux territory—of the protection resulting from an international filing shall be effective throughout the said territory, notwithstanding any statement to the contrary made by the proprietor.

Article 16

A declaration of nullity of a filing, a declaration that a right to a mark has lapsed, and a voluntary cancellation of a registration must relate to the entire symbol constituting the mark.

A declaration of nullity or of lapsing of rights must be limited to a given number of the goods or services in respect of which the mark is registered, in the event that the grounds for the nullity or lapsing of rights only relate to part of such goods or services.

Voluntary cancellation may be restricted to a given number of the goods or services in respect of which the mark is registered.

Article 17

A. Over and above the duties conferred on it by the provisions of the preceding Articles, the Benelux Office shall be entrusted with:

1. introducing modifications in registrations, either at the request of the proprietor, or as a result of notifications from the International Bureau for the Protection of Industrial Property or of court decisions, as well as, where appropriate, notifying the International Bureau thereof;

2. issuing a monthly publication in the Dutch and French languages in which registrations of Benelux filings shall appear and which shall contain all other indications prescribed by the Rules;

3. providing copies of registrations at the request of any interested party.

B. The amount of the fees to be collected for the operations referred to in [paragraph A](#) of this Article, as well as the prices of the monthly publication and of the copies, shall be fixed by Rule.

Article 18

By virtue of this Law, nationals of the Benelux countries, as well as nationals of countries outside the Union established by the Paris Convention who have their domicile or a real and effective industrial or commercial activity in the Benelux territory, may claim the benefits, throughout the said territory, of the provisions of the said Convention and of the Madrid Agreement.

Chapter II

Collective Marks

Article 19

Collective marks shall be considered to be all symbols designated as such at the time of filing and which serve to distinguish one or more common features of goods or services originating from different enterprises that affix the mark under the control of the proprietor.

The proprietor shall not be allowed to make use of the mark for goods or services originating from his own enterprise or from enterprises in the management or superintendence of which he participates either directly or indirectly.

Article 20

Unless otherwise provided, individual and collective marks shall be subject to the same rules.

Article 21

An exclusive right to a collective mark shall be acquired only if the mark is accompanied, when filed, by regulations for use and control thereof.

However, where international filing is concerned, the applicant may still file such regulations during a period of six months from the notification of the international registration provided for in [Article 3\(4\)](#) of the Madrid Agreement.

Article 22

The regulations for use and control of a collective mark must state the common features of the goods or services which the mark is intended to guarantee.

They must also set forth the manner in which proper and efficient control of such features is to be exercised, together with the adequate sanctions incidental thereto.

Article 23

[Article 4, item 3](#), shall not apply to the filing of a collective mark by the former proprietor of the registration of a like collective mark or by his successor in title.

Article 24

Without prejudice to the application of [Article 6](#), the Benelux Office shall not be allowed to register the Benelux filing of a collective mark if the regulations for use and control of the said mark have not been filed in accordance with the provisions of [Article 21](#).

Article 25

The proprietors of collective marks shall be obliged to notify one of the three national offices or the Benelux Office of any modification of the regulations for the use and control of the mark. Such notification shall be recorded by the Benelux Office.

The modification shall not become operative prior to the notification prescribed in the preceding paragraph.

Article 26

The right to institute legal proceedings for the protection of a collective mark shall exclusively accrue to the proprietor of such mark.

Without prejudice to the provisions of [Article 13](#), the proprietor of a collective mark may, by virtue of his exclusive right, oppose any use whatever being made of the mark of a like symbol, regardless of the goods or services in respect of which such use is made, save use by a person who can rely on a prior right to a like individual mark.

The proprietor of the mark may, subject to the same conditions, claim indemnification for any damages sustained by him as a result of such use.

The regulations for use and control may, however, confer on persons to whom the use of the mark has been granted the right to bring a claim jointly with the proprietor or to become party to any action or to intervene in any proceedings instituted by or against the latter.

Likewise, the regulations for use and control may also provide that the proprietor, acting alone, may assert the individual interests of the users of the mark and may incorporate in his claim for indemnification particular damages sustained by one or more of them.

Article 27

A. Without prejudice to the provisions of [Article 14](#), any interested party, including the Crown's Attorney and Public Prosecutor, may invoke the lapse of a right to a collective mark in the event that the proprietor uses the mark in the circumstances referred to in [Article 19, second paragraph](#), or agrees to a use in violation of the provisions of the regulations for use and control, or tolerates such use.

Where the action for forfeiture is instituted by the Crown's Attorney and Public Prosecutor, the Courts of Brussels, The Hague and Luxembourg shall have exclusive jurisdiction.

The institution of action by the Crown's Attorney and Public Prosecutor shall stay any other suit instituted on the same grounds.

B. The Crown's Attorney and Public Prosecutor may invoke the nullity of the filing of a collective mark whenever the regulations for use and control are contrary to public policy or are not in accordance with the provisions of [Article 22](#). The Crown's Attorney and Public Prosecutor may also invoke the nullity of modifications of the regulations for use and control if they conflict with public policy or the provisions of [Article 22](#), or if they would result in impairing the guarantees given to the public by the said regulations.

The Courts of Brussels, The Hague and Luxembourg shall have exclusive jurisdiction in such proceedings; they shall *ex officio* order the cancellation of registrations of filings or modifications declared null and void.

Article 28

Collective marks which have lapsed, have been declared null and void or have been cancelled, as well as those in respect of which no renewal has taken place and no restoration as provided for in [Article 23](#) has been made, shall, during the three years following the date of the recording of the lapse, nullification or cancellation, or the expiration of the non-renewed registration, on no account be used save by a person who can rely on a prior right to a like individual mark.

Chapter III Transitional Provisions

Article 29

Subject to the conditions laid down in [Article 30](#), the exclusive rights to individual and collective marks acquired under national law in any one of the Benelux countries prior to the date of the entry into force of this Law, and which have not expired at that date, shall be maintained. As from the said date, this Law shall apply to such rights.

An exclusive right shall also be deemed to have been acquired by the first use of a symbol which serves to distinguish the goods or services of an enterprise and which would have constituted a mark if [Articles 1](#) and [2](#) of this Law had been applicable. An exclusive right thus deemed to have been acquired shall, however, not be capable of being invoked against any person who used the said symbol prior to the date of the entry into force of this Law, unless the use relied upon was followed by non-use for an uninterrupted period of five years.

Article 30

A right acquired to a mark shall terminate with retroactive effect to the date of the entry into force of this Law if, at the expiration of a period of one year from that date, no Benelux filing of the mark has been effected claiming the existence of the right acquired and indicating, for purposes of information, the nature and date of the facts which caused it to come into existence and, where applicable, the filings and registrations made in respect of such mark. This filing shall take the place of filings made of the mark in one or more of the Benelux countries, without prejudice to rights acquired as a result of such filings. However, if the person effecting the filing should claim any acquired right when

he knows or has no valid excuse for not knowing that such a right does not exist, the filing shall be deemed to have been made in bad faith.

Where, on the date of the entry into force of this Law, a right to a mark results from an international filing based on a registration of origin outside the Benelux territory, maintenance of such right shall be independent of the conditions prescribed in the preceding paragraph.

A right acquired to a collective mark shall, moreover, terminate with retroactive effect to the date of the entry into force of this Law if no regulations for use and control are submitted with the Benelux filing referred to in the first paragraph hereinabove. [Articles 22](#), [24](#) and [27B](#) shall apply in such cases.

Where a right to a collective mark results from an international filing based on a registration of origin outside the Benelux territory, such right shall terminate with retroactive effect to the date of the entry into force of this Law if, at the expiration of a period of one year from the said date, the proprietor of the collective mark has not filed regulations for use and control. [Articles 22](#) and [27B](#) shall apply in such cases.

Article 31

Notwithstanding the provisions of [Article 10](#) the first registration of the Benelux filings referred to in [Article 30](#) shall have a term of from one to 10 years. The said term shall expire, in the month and on the day of the Benelux filing, in the year which comprises the same final digit as that of the year in which the right acquired and relied upon originated.

The first renewal of such registrations may be requested at the time of filing for the duration provided for in [Article 10](#)

Article 32

An exclusive right to a mark maintained under [Articles 29](#) and [30](#) shall extend to the entire Benelux territory as from the date of the entry into force of this Law.

This right shall not, however, extend to the territory of those Benelux countries:

- (a) where it would constitute an infringement of a right acquired by a third party and maintained under [Articles 29](#) and [30](#);
- (b) where it emerges that there is a ground for nullity as referred to in [Article 14A.1\(a\)](#) and (c) and [2](#), in [Article 14B.2](#), and in [Article 27B](#).

Where two persons possess respective rights that have been acquired in the same mark in two of the Benelux countries, extension to the third country shall be effected for the benefit of the person who, prior to the entry into force of this Law, first used the mark in a normal manner in the said country. In case of non-use of the mark in the said country at the time of the entry into force of this Law, extension shall be effected for the benefit of the person whose acquired right is older.

Article 33

Where any mark belongs, by virtue of [Article 32](#) to different proprietors in two or three of the Benelux countries, the proprietor of the mark in any one of those countries may not oppose importation of goods or services bearing the same mark and originating from another Benelux country, or claim damages for such importation, if the mark was affixed in the other country by the proprietor of the mark or with his authorization and relations of an economic nature exist between the two proprietors in respect of the exploitation of the goods or services concerned.

Article 34

A. As from the day following the date of the entry into force of this Law, the Benelux Register shall be open for the filing of marks. As from the date of the said entry into force, national filings of marks shall no longer be admissible.

B. The Benelux filings referred to in [Article 30](#) shall be exempt from the payment of any fees and shall be effected in the manner prescribed by the Rules. The registration of the said filings shall mention the claim to the acquired right and the indications relevant thereto.

C. International filings based on a registration of origin outside the Benelux territory and existing on the date of the entry into force of this Law shall be entered *ex officio* in the Benelux Register free of charge, unless the proprietors have renounced the protection resulting therefrom for all Benelux countries.

Article 35

The Benelux filings referred to in [Article 30](#) regardless of their actual date, and the international filings entered in the Benelux Register as provided for in [Article 34C](#), shall, for the determination of their order of priority with respect to Benelux filings effected without a claim to an acquired right, be deemed to have been made on the date of the entry into force of this Law.

The order of priority of the rights acquired in a Benelux country within the meaning of [Article 29](#) shall be determined in that country in accordance with the national law obtaining prior to the entry into force of this Law.

Chapter IV General Provisions

Article 36

In this Law, the expression “Benelux territory” refers to the joint territories of the Kingdom of Belgium, the Grandduchy of Luxembourg and the Kingdom of the Netherlands within Europe.

Article 37

A. Unless otherwise expressly stipulated by contract, jurisdiction in respect of mark cases shall be determined by the domicile of the defendant or by the place where the

undertaking giving rise to the litigation originated or was or is to be performed. The place where a mark was filed or registered can on no account serve in itself as a basis for the determination of jurisdiction.

If the criteria laid down hereinabove should be insufficient for the determination of jurisdiction, then the plaintiff may file the action before the court of his domicile or residence, or, if he has no domicile or residence within the Benelux territory, before the Courts of Brussels, The Hague or Luxembourg, at his option.

B. The courts shall apply the rules of paragraph A *ex officio* and shall explicitly establish and record their competency.

C. The court before which the principal claim referred to in paragraph A is pending shall take cognizance of requests that the plaintiff put up security, requests for intervention, incidental claims and counterclaims, unless it should be incompetent on the ground of *ratione materiae*.

D. The courts of any one of the three countries shall, at the request of one of the parties, transfer disputes brought before them to the courts of one of the other two countries if such disputes are already pending before the latter courts or are fundamentally related to other disputes submitted to the said latter courts. Such transfer may only be requested if the causes are pending in first instance. It shall be made to the court before which the case was first brought by a declaration instituting action, unless another court has given an earlier judgment in the matter concerned—and such judgment does not merely relate to internal procedure—in which case the transfer shall be made to such other court.

Article 38

The provisions of this Law shall be without prejudice to the application of the Paris Convention, the Madrid Agreement, and Belgian, Luxembourg or Netherlands legal provisions which might entail a prohibition to use a given mark.

Chapter V Service Marks

GENERAL PROVISIONS

Article 39

[Chapters I](#), [II](#) and [IV](#) shall apply, *mutatis mutandis*, to signs which serve to distinguish services, hereinafter “service marks,” it being understood that services and goods may also be similar.

The priority right provided for in [Article 4](#) of the Paris Convention may also be claimed in respect of service marks.

TRANSITIONAL PROVISIONS

Article 40

A. Any person who, on the date of entry into force of the present Protocol Amending the Uniform Benelux Trademark Law, uses a service mark on Benelux territory and who, within one year as from that date, files a Benelux application for registration of that mark, shall be deemed, for the purpose of determining his priority, to have filed the application on the said date.

B. The provisions of this Chapter shall not alter the rights resulting from the use of a service mark on Benelux territory on the said date.

C. The nullity of a service mark filing mentioned under A may not be invoked for the sole reason that its date is later than that of a similar trademark.

Article 41

On making the Benelux filing mentioned in [Article 40](#), which shall be made according to the formalities and accompanied by the payment of the official fees prescribed in the Regulations, the applicant shall also:

- claim the existence of the acquired right;
- state, solely for the purpose of [Article 42](#) the year of first use of the service mark.

However, if the applicant claims an acquired right for the service mark knowing, or with no valid excuse for not knowing, that the right does not exist, the filing shall be deemed to have been effected in bad faith.

Article 42

Notwithstanding the provision of [Article 10](#) the first registration of the Benelux filings provided for in [Article 40](#) shall have a term of validity from one to 10 years. The said term shall expire on the anniversary date of the Benelux filing during the year whose last digit is the same as that of the year during which the first use stated has taken place.

The first renewal of such registrations may, for the duration provided for in [Article 10](#), be applied for on the occasion of the filing.

Article 43

The Benelux Register shall be open for the filing of service marks on the day following the date of entry into force of the Protocol mentioned in [Article 40](#).

The registration of the Benelux filings provided for in [Article 40](#) shall mention the claim of an acquired right and the year of first use of the service mark.

Protocol Amending the Uniform Benelux Law on Trademarks¹

....

¹ Provisions not incorporated in the above text (*Editor's note*).

II. Pursuant to **Article 1, subsection 1**, of the Treaty on the establishment and the statute of a Benelux Court of Justice, the provisions of this Protocol are designated as common legal rules for the application of **Chapters III and IV** of the said Treaty.

III. This Protocol shall be ratified. The instruments of ratification shall be deposited with the Government of the Kingdom of Belgium.

IV. This Protocol shall enter into force on the first day of the third month following the month in which the third instrument of ratification is deposited.

In witness whereof, the undersigned, being duly authorized thereto, have signed this Protocol.

Done at Brussels on November 10, 1983, in triplicate, in the Dutch and French languages, both texts being equally authentic.