

**Benelux Convention on Intellectual Property  
(Trademarks and Designs)\***

The Kingdom of Belgium,

The Grand Duchy of Luxembourg,

The Kingdom of the Netherlands,

*Inspired* by the desire to:

- replace the conventions, uniform laws and amending protocols relating to Benelux trademarks and designs with a single Convention systematically and transparently governing both trademark law and the law on designs;

- provide quick and effective procedures which will allow Benelux regulations to be brought into line with Community regulations and international treaties already ratified by the three High Contracting Parties;

- replace the Benelux Trademark Office and the Benelux Designs Office with the Benelux Organization for Intellectual Property (trademarks and designs) carrying out its duties through decision-making and executive bodies provided with their own and additional powers;

- provide the new Organization with a structure consistent with current views on international organizations, and guaranteeing its independence, in particular through a protocol on privileges and immunities;

- bring the new Organization together with companies by fully developing its powers to enable it to undertake new tasks in the field of intellectual property and open decentralized branches;

- provide the new Organization, non-exclusively, with powers of evaluation and a right of initiative in respect of the adjustment of Benelux law on trademarks and designs;

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

His Excellency Mr. K. de Gucht, Minister for Foreign Affairs,

His Excellency Mr. B. R. Bot, Minister for Foreign Affairs,

His Excellency Mr. J. Asselborn, Minister for Foreign Affairs,

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

## TITLE I: GENERAL AND INSTITUTIONAL PROVISIONS

### **Article 1.1 Abbreviated expressions**

The following meanings shall apply for the purposes of this Convention:

- Paris Convention: the Paris Convention for the Protection of Industrial Property of March 20, 1883;
- Madrid Agreement: the Madrid Agreement concerning the International Registration of Marks of April 14, 1891;
- Madrid Protocol: the Protocol relating to the Madrid Agreement concerning the International Registration of Marks of June 27, 1989;
- Nice Agreement: the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of June 15, 1957;
- Hague Agreement: the Hague Agreement concerning the International Deposit of Industrial Designs of November 6, 1925;
- Regulation on the Community Trade Mark: Council Regulation (EC) No. 40/94 of December 20, 1993 on the Community Trade Mark;
- Regulation on Community Designs: Council Regulation (EC) No. 6/2002 of December 12, 2001 on Community Designs;
- TRIPS Agreement: the Agreement on Trade-Related Aspects of Intellectual Property Rights of April 15, 1994; Annex 1C of the Agreement Establishing the World Trade Organization;
- International Bureau: the International Bureau of Intellectual Property established by the Convention Establishing the World Intellectual Property Organization of July, 14 1967.

### **Article 1.2 Organization**

1. A Benelux Organization for Intellectual Property (Trademarks and Designs), hereinafter referred to as “the Organization”, shall be established.
2. The executive bodies of the Organization shall be:
  - (a) the Committee of Ministers referred to in the Treaty establishing the Benelux Economic Union, hereinafter referred to as “the Committee of Ministers”;
  - (b) the Executive Board of the Benelux Intellectual Property Office (Trademarks and Designs), hereinafter referred to as “the Executive Board”;
  - (c) the Benelux Intellectual Property Office (Trademarks and Designs), hereinafter referred to as “the Office”.

### **Article 1.3 Objectives**

The Organization shall be responsible for:

- (a) putting this Convention and the Implementing Regulations into effect;
- (b) promoting the protection of trademarks and designs in Benelux countries;
- (c) performing additional tasks in other fields of intellectual property law as decided by the Executive Board;
- (d) continually evaluating and, if necessary, adapting Benelux law on trademarks and designs in the light of international, Community and other developments.

### **Article 1.4 Legal personality**

1. The Organization shall have an international legal personality with a view to performance of the duties entrusted to it.
2. The Organization shall have a national legal personality and shall therefore have, on the territory of the three Benelux countries, the legal powers recognized for national corporate bodies, insofar as is necessary for the accomplishment of its tasks and the fulfillment of its objectives, in particular the ability to enter into contracts, to acquire and dispose of movable and immovable assets, to receive and dispose of private and public funds and to be a party in court proceedings.
3. The Director General of the Office, hereinafter referred to as “the Director General”, shall represent the Organization in matters in and out of court.

### **Article 1.5 Headquarters**

1. The Organization shall have its headquarters in the Hague.
2. The Office shall be set up in the Hague.
3. Branches of the Office may be established elsewhere.

### **Article 1.6 Privileges and immunities**

1. The privileges and immunities necessary for the performance of the Organization's duties and achievement of its objectives shall be laid down in a protocol to be concluded between the High Contracting Parties.
2. The Organization may conclude supplementary agreements with one or more of the High Contracting Parties relating to the establishment of services of the Organization on the territory of that State or those States, with a view to implementing the provisions of the protocol adopted in accordance with the first paragraph in respect of that State or those States, as well as other arrangements in order to ensure the proper functioning of the Organization and the safeguarding of its interests.

### **Article 1.7 Powers of the Committee of Ministers**

1. The Committee of Ministers shall have the power to make such amendments to this Convention as are necessary to ensure that this Convention complies with an international treaty or with European Community regulations on trademarks and designs. Amendments shall be published in the Official Journal of each of the High Contracting Parties.
2. The Committee of Ministers shall have the power to order amendments to this Convention other than those mentioned in the first paragraph. These amendments shall be submitted to the High Contracting Parties for consent or approval.
3. The Committee of Ministers shall have the power, following consultation with the Executive Board, to provide the Director General with a mandate to negotiate on behalf of the Organization and, with its authorization, to conclude agreements with States and intergovernmental organizations.

### **Article 1.8 Composition and functioning of the Executive Board**

1. The Executive Board shall comprise members appointed by the High Contracting Parties, on the basis of one full board member and two deputy board members per country.
2. It shall take its decisions by unanimous vote.
3. It shall adopt its own rules of procedure.

### **Article 1.9 Powers of the Executive Board**

1. The Executive Board shall have the power to make proposals to the Committee of Ministers relating to amendments to this Convention which are essential in order to ensure that this Convention complies with an international treaty or European Community regulations, and relating to other amendments to this Convention which it considers desirable.
2. It shall draw up the Implementing Regulations.
3. It shall draw up the rules of procedure and financial regulations of the Office.
4. It shall designate additional tasks, as referred to in Article 1.3(c), in other fields of intellectual property law.
5. It shall decide on the establishment of branches of the Office.
6. It shall appoint the Director General and, following consultation with the Director General, the deputy Directors General, and shall exercise disciplinary powers in respect of such officials.
7. It shall adopt the annual income and expenditure budget, as well as any modifications or additions thereto, and shall specify in the financial regulations the manner in which the budgets and implementation thereof shall be supervised. It shall approve the annual accounts drawn up by the Director General.

### **Article 1.10 The Director General**

1. Management of the Office shall be the responsibility of the Director General who shall answer to the Executive Board with regard to the Office's activities.
2. The Director General shall have the power, following consultation with the Executive Board, to delegate exercise of some of the powers entrusted to him to the Deputy Directors General.
3. The Director General and the Deputy Directors General shall be nationals of the Member States. The three nationalities shall be represented in the Management.

### **Article 1.11 Powers of the Director General**

1. The Director General shall make proposals to the Executive Board with a view to amending the Implementing Regulations.
2. He shall take all steps, in particular administrative steps, to ensure that the tasks of the Office are properly performed.
3. He shall enforce the rules of procedure and financial regulations of the Office and shall make proposals to the Executive Board with a view to amending those regulations.
4. He shall appoint agents and exercise hierarchical authority and disciplinary powers with respect to them.
5. He shall prepare and enforce the budget and draw up the annual accounts.
6. He shall take all other steps which he considers to be appropriate in the interests of the functioning of the Office.

### **Article 1.12 Finances of the Organization**

1. The operating costs of the Organization shall be covered by its income.
2. The Executive Board may request a contribution from the High Contracting Parties to cover extraordinary expenditure. Half of this contribution shall be borne by the Kingdom of the Netherlands and half by the Belgium-Luxembourg Economic Union.

### **Article 1.13 Involvement of national authorities**

1. A percentage of the fees collected in respect of operations performed through the national authorities shall be distributed to the said offices to cover the cost of such operations; this percentage shall be fixed by the Implementing Regulations.
2. No national fees relating to these operations may be levied by national regulations.

### **Article 1.14 Acceptance of court decisions**

The authority of court decisions handed down in one of the three States pursuant to this Convention shall be recognized in the other two States and court ordered cancellation shall be carried out by the Office at the request of the most diligent party, if:

(a) in accordance with the legislation of the country in which the decision was handed down, the order resulting from it meets the conditions necessary for it to be enforceable;

(b) the decision is no longer subject to any opposition or appeal or referral to a high court of appeal.

### **Article 1.15 Benelux Court of Justice**

The Benelux Court of Justice as mentioned in Article 1 of the Treaty relating to the establishment and status of a Benelux Court of Justice shall have the power to hear questions concerning the interpretation of this Convention and the Implementing Regulations, with the exception of questions of interpretation relating to the protocol on privileges and immunities mentioned in Article 1.6(1).

### **Article 1.16 Scope of application**

Application of this Convention shall be restricted to the territories of the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands in Europe, hereinafter referred to as “Benelux territory”.

## **TITLE II: TRADEMARKS**

### **Chapter 1. Individual trademarks**

#### **Article 2.1 Signs capable of constituting Benelux trademarks**

1. Names, designs, stamps, seals, letters, figures, shapes of products or packaging and all other signs able to be represented graphically and used to distinguish the goods or services of

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2. However, signs solely comprising a shape which is imposed by the very nature of a product, which gives the product substantial value, or which is necessary for obtaining a technical result, may not be regarded as trademarks.

3. Without prejudice to the provisions of ordinary law, a patronymic name may serve as a trademark.

### **Article 2.2 Acquisition of rights**

Without prejudice to the right of priority provided for by the Paris Convention or the right of priority resulting from the TRIPS Agreement, the exclusive right in a trademark shall be acquired by registration of the trademark through filing in Benelux territory (Benelux filing) or resulting from registration with the International Bureau (international filing).

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

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

- (a) identical trademarks filed for identical goods or services;
- (b) identical or similar trademarks filed for identical or similar goods or services, where there exists in the public mind a likelihood of confusion that includes the risk of association with the prior trademark;
- (c) similar trademarks filed for goods or services that are not similar, which enjoy a reputation in the Benelux territory, where use without due cause of the later mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier mark.

### **Article 2.4 Restrictions**

No right in a trademark shall be acquired by the following:

(a) the registration of a trademark which, regardless of the use made thereof, is contrary to morality or public policy in one of the Benelux countries or in respect of which rejection or invalidation is provided for by Article 6<sup>ter</sup> of the Paris Convention;

(b) the registration of a trademark which is likely to mislead the public, for example  
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(c) the registration of a trademark resembling a collective trademark registered for similar goods or services, which benefited from a right which lapsed during the three years preceding filing;

(d) the registration of a trademark resembling an individual trademark registered by a third party for similar goods or services, which benefited from a right which lapsed during the two years preceding filing as a result of expiry of the registration, unless the third party consents or there has been a failure to use the trademark as provided for in Article 2.26(2)(a);

(e) the registration of a trademark which might give rise to confusion with a well-known trademark, within the meaning of Article 6*bis* of the Paris Convention, belonging to a non-consenting third party;

(f) the registration of a trademark which was filed in bad faith, in particular:

1. filing in the knowledge of or in inexcusable ignorance of normal use in good faith of a similar trademark for similar goods or services by a non-consenting third party on Benelux territory during the last three years;

2. filing with knowledge, resulting from direct relationships, of the normal use in good faith of a similar trademark for similar goods or services by a third party outside Benelux territory during the last three years, unless the third party consents or the said knowledge was acquired only subsequent to the start of the use which the applicant would have made of the trademark on Benelux territory;

(g) the registration of a trademark for wines which includes a geographical indication identifying wines or which comprises such indication, or the registration of a trademark for spirits which includes a geographical indication identifying the spirits or which comprises such indication, in respect of wines or spirits which do not have that origin, unless the filing leading to such registration was made in good faith prior to January 1, 2000 or before onset of the protection of the said geographical indication in the country of origin or in the Community.

## **Chapter 2. Filing, registration and renewal**

### **Article 2.5 Filing**

1. Trademarks shall be filed within Benelux with national authorities or with the Office in the manner specified by the Implementing Regulations and against payment of the fees due. A

check shall be made to ensure that documents produced satisfy the conditions specified for fixing the filing date and the filing date shall be specified. The applicant shall be informed, without delay and in writing, of the date of filing or, where applicable, the grounds for rejection.

2. If other provisions of the Implementing Regulations are not satisfied at the time of filing, the applicant shall be informed without delay and in writing of the conditions which are not fulfilled and shall be given the opportunity to respond.

3. Filing shall have no further effect if the provisions of the Implementing Regulations are not satisfied within the period granted.

4. Where filing takes place with a national authority, the national authority shall forward the Benelux filing to the Office, either without delay after receiving the filing or after establishing that the filing satisfies the specified conditions.

5. The Office shall publish the filing, in accordance with the provisions of the Implementing Regulations, when the conditions for specifying a filing date have been fulfilled and the goods or services mentioned have been classified in accordance with the Nice Agreement.

#### **Article 2.6 Claiming priority**

1. A right of priority arising under the Paris Convention or the TRIPS Agreement shall be claimed at the time of filing.

2. The right of priority referred to in Article 4 of the Paris Convention shall also apply to service marks.

3. A right of priority may also be claimed by means of a special declaration submitted to the Office in the manner laid down by the Implementing Regulations and against payment of the fees due in the month following filing.

4. If no such claim is made, the right of priority shall lapse.

#### **Article 2.7 Search**

The Office shall carry out a priority search on request.

## **Article 2.8 Registration**

1. Without prejudice to the application of Articles 2.11, 2.14 and 2.16, the trademark filed shall be registered for the goods or services mentioned by the applicant if the provisions of the Implementing Regulations are satisfied. A registration certificate shall be submitted to the owner of the trademark.
2. If all the conditions specified in Article 2.5 are satisfied, the applicant may, in accordance with the provisions of the Implementing Regulations, request the Office to proceed with registration of the filing without delay. Articles 2.11, 2.12, 2.14, 2.16 and 2.17 shall apply to trademarks so registered, it being understood that the Office shall have the power to decide to cancel the registration and that the owner of the trademark may submit an appeal for the registration to be upheld.

## **Article 2.9 Term and renewal of registration**

1. Registration of a trademark filed in Benelux territory (Benelux filing) shall be for a period of 10 years with effect from the date of filing.
2. The sign constituting the trademark may not be modified either during the period of registration or at the time of its renewal.
3. Registration shall be renewed on request for further periods of 10 years in the manner specified by the Implementing Regulations and against payment of the fees due.
4. Renewals shall be requested and the fees paid during the six months preceding expiry of the registration. Renewals may still be requested and the fees paid during the six months following the expiry date of the registration, subject to simultaneous payment of an additional fee. Renewals shall take effect from the time of expiry of the registration.
5. Six months prior to the expiry of a registration, the Office shall provide a reminder of the expiry date through a written notice sent to the owner of the trademark.
6. Reminders shall be sent to the last address of the owner of the trademark known to the Office. Failure to send or receive such notices shall not constitute dispensation from the obligations resulting from paragraphs 3 and 4. It may not be invoked in court proceedings or against the Office.
7. The Office shall register renewals.

## Article 2.10 International filing

1. International filing of trademarks shall take place in accordance with the provisions of the Madrid Agreement and the Madrid Protocol. The fee provided for by Article 8(1) of the Madrid Agreement and the Madrid Protocol, and the fee provided for by Article 8(7)(a) of the Madrid Protocol, shall be specified by the Implementing Regulations.
2. Without prejudice to the application of Articles 2.13 and 2.18, the Office shall register international filings in respect of which application has been made for the extension of protection to Benelux territory.
3. The applicant may request the Office, in accordance with the provisions of the Implementing Regulations, to proceed with registration without delay. Articles 2.11, 2.12, 2.14, 2.16 and 2.17 shall apply to trademarks so registered, it being understood that the Office shall have the power to decide to cancel the registration and that the owner of the trademark may submit an appeal for the registration to be upheld.

## Chapter 3. Examination on absolute grounds

### Article 2.11 Refusal on absolute grounds

1. The Office shall refuse to register a trademark if it considers that:
  - (a) the sign may not constitute a trademark as defined in Article 2.1(1) and (2);
  - (b) the trademark is devoid of any distinctive character;
  - (c) the trademark comprises only signs or indications which may be used in trade to indicate the kind, quality, quantity, intended purpose, value, geographical origin or time of manufacture of the product or provision of the service, or other characteristics thereof;
  - (d) the trademark comprises only signs or indications which have become customary in everyday language or in the *bona fide* and established practices of the trade;
  - (e) the trademark is a trademark referred to under Article 2.4(a), (b) or (g).
2. Refusal to register shall relate to the sign constituting the trademark in its entirety. It may be restricted to one or more of the goods or services for which the trademark is intended.
3. The Office shall inform the applicant in writing without delay of its intention to refuse registration in whole or in part, shall state the grounds and shall provide the applicant with the

4. If the Office's objections against registration have not been lifted within the period laid down, registration of the trademark shall be refused in whole or in part. The Office shall inform the applicant in writing without delay, indicating the grounds for refusal, and advising of the remedy against that decision, referred to in Article 2.12.

5. Refusal shall only become final when the decision is no longer subject to appeal or, if appropriate, the decision of the appeal authority is no longer subject to referral to a high court of appeal.

### **Article 2.12 Appeal against refusal**

1. Within two months following the communication referred to in Article 2.11(4), the applicant may lodge a petition with the Court of Appeal in Brussels, the *Gerechtshof* in the Hague or the Court of Appeal of Luxembourg with a view to obtaining an order for registration of the trademark.

2. In the context of these proceedings, the Office may be represented by a member of staff appointed for that purpose.

3. The court having territorial jurisdiction shall be determined by the address of the applicant, the address of the agent or the postal address given at the time of filing. If neither the applicant nor the agent has an address or postal address on Benelux territory, the court having jurisdiction shall be the one selected by the applicant.

4. The ruling of the appeal court shall be open to referral to a high court of appeal, which shall have suspensory effect.

### **Article 2.13 Refusal of international filings on absolute grounds**

1. Article 2.11(1) and (2) shall apply to international filings.

2. The Office shall inform the International Bureau in writing without delay of its intention to refuse registration, indicating the grounds by means of notice of the total or partial provisional refusal of protection for the trademark and shall give the applicant the opportunity to respond in accordance with the provisions specified in the Implementing Regulations. Article 2.11(4) shall apply.

3. Article 2.12 shall apply, it being understood that the court having territorial jurisdiction shall be determined by the agent's address or the postal address. If neither of these two addresses is on Benelux territory, the court having jurisdiction shall be that selected by the

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4. The Office shall inform the International Bureau in writing without delay of decisions against which no further appeal may be made, and shall indicate the grounds therefor.

## Chapter 4. Objections

### Article 2.14 Initiation of the procedure

1. The applicant or the owner of a prior trademark may submit a written objection to the Office, within a period of two months following the first day of the month following publication of the filing, against a trademark which:

(a) in the order of priority, ranks after its own in accordance with Article 2.3(a) and (b), or

(b) may give rise to confusion with its well-known trademark within the meaning of Article 6*bis* of the Paris Convention.

2. A licensee shall have the same right if authorized by the owner:

3. The objection may be based on one or more prior trademarks.

4. An objection shall not be deemed to have been entered until the fees due have been paid.

### Article 2.15 Representation in objection-related proceedings

1. Subject to paragraph 2, no one shall be required to be represented before the Office.

2. Without prejudice to the second sentence of paragraph 3, individuals and corporate bodies which have no address for service or registered office or real and effective industrial or commercial establishment in the European Community or in the European Economic Area must be represented by an agent in the objection-related proceedings initiated through Articles 2.14 and 2.16.

3. Individuals and corporate bodies which have an address for service or registered office or a real and effective industrial or commercial establishment in the European Community or in the European Economic Area may act in the context of objection-related proceedings through the agency of an employee who must file a signed power of attorney with the Office, the form of which shall be laid down in the Implementing Regulations. The employee of a corporate

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4. In circumstances where there is representation, the following may act as agents:

- (a) an agent entered in the register with the Office;
- (b) a lawyer registered with the bar of a court or with the bar association or on a list of bar probationers located in Benelux territory;
- (c) a lawyer having the nationality of a Member State of the European Community or the European Economic Area who is empowered to exercise his profession on the territory of one of the Member States and who has his professional chambers in the European Community or the European Economic Area;
- (d) a person having the nationality of a Member State of the European Community or the European Economic Area who is empowered to act as a representative in the context of objection-related proceedings before the Office for Harmonization in the Internal Market (Trademarks and Designs);
- (e) a person having the nationality of a Member State of the European Community or the European Economic Area, who satisfies the requirement of a special professional qualification necessary for acting as a representative in objection-related proceedings before the central industrial property office of a Member State of the European Community or the European Economic Area and who has his professional address within the European Community or the European Economic Area;
- (f) a person having the nationality of a Member State of the European Community or the European Economic Area, who has habitually acted in the capacity of a representative in objection-related proceedings for at least five years before the central industrial property office of a Member State of the European Community or the European Economic Area where the power to do so is not subject to the requirement for a special professional qualification and who has his professional address within the European Community or European Economic Area.

#### **Article 2.16 Course of the proceedings**

1. The Office shall deal with an objection within a reasonable timeframe in accordance with the provisions laid down in the Implementing Regulations and shall respect the rule that both sides should be heard.



2. The objection-related proceedings shall be suspended:

- (a) where the objection is based on the filing of a trademark;
- (b) where an action is brought with a view to an annulment or disqualification;
- (c) in the course of the proceedings for refusal on absolute grounds;
- (d) at the joint request of the parties.

3. The opposition proceedings shall be closed:

- (a) where the party raising the objection has lost the capacity to act or has not, within the specified period, provided any documentation establishing that the right in its trademark cannot be declared to have lapsed under Article 2.26(2)(a);
- (b) where the defendant does not react to the objection lodged. In this case the defendant shall be deemed to have renounced its rights concerning the filing;
- (c) where the objection is no longer applicable, either because it has been withdrawn or because the filing constituting the subject matter of the objection has come to be without effect;
- (d) where the prior trademark is no longer valid.

In such circumstances, part of the fees paid shall be returned.

4. After examination of the objection is complete, the Office shall reach a decision as soon as possible. If the objection is held to be justified, the Office shall refuse to register the trademark in whole or in part. Otherwise, the objection shall be rejected. The Office's decision shall only become final when it is no longer subject to appeal or, where appropriate, the ruling of the appeal court is no longer open to referral to a high court of appeal.

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 an objection is partly successful. The Office's decision concerning costs shall constitute an order. Its forced implementation shall be governed by the rules in force in the State on the territory of which it takes place.

### **Article 2.17 Appeal**

1. Within two months following a decision on an objection in accordance with Article 2.16(4), the parties may submit a petition to the Court of Appeal in Brussels, the *Gerechtshof* in the Hague or the Court of Appeal in Luxembourg with a view to obtaining an order cancelling the Office's decision.
2. The court having territorial jurisdiction shall be determined by the address of the original defendant, the address of its agent or the postal address given at the time of filing. If none of these addresses is located on Benelux territory, the court having territorial jurisdiction shall be determined by the address of the party raising the objection or its agent. If neither that party nor its agent has an address or postal address on Benelux territory, the court having jurisdiction shall be the one chosen by the party bringing the appeal.
3. The ruling of the appeal court shall be open to referral to a high court of appeal, which shall have suspensory effect.

### **Article 2.18 Opposition to international filings**

1. During a period of two months with effect from the first day of the month following publication by the International Bureau, an objection may be raised with the Office against an international filing for which an application has been made for the extension of protection to Benelux territory. Articles 2.14 and 2.16 shall apply.
2. The Office shall inform the International Bureau of the objection raised without delay and in writing, mentioning the provisions of Articles 2.14 to 2.17 and the relevant provisions of the Implementing Regulations.
3. The Office shall inform the International Bureau without delay and in writing when a decision is no longer subject to appeal and shall indicate the grounds therefor.

## **Chapter 5. Owner's rights**

### **Article 2.19 Obligation to register**

1. With the exception of the owner of a trademark which is well known within the meaning of Article 6*bis* of the Paris Convention, and regardless of the nature of the action brought, no one may claim in court a sign deemed to be a trademark as defined in Article 2.1(1) and (2), unless that claimant can provide evidence of registration of the trademark which it has filed.

2. If appropriate, non-admissibility may be set aside *ex officio* by the judge.

3. The provisions of this title shall not in any way detract from the right of the users of a sign which is not regarded as a trademark within the meaning of Article 2.1(1) and (2), to invoke ordinary law insofar as this allows an objection to be raised to unlawful use of that sign.

### **Article 2.20 Scope of protection**

1. A registered trademark shall provide its owner with an exclusive right. Without prejudice to the possible application of ordinary law in matters of civil liability, the exclusive right to a trademark shall permit the owner to prevent any third party, without its consent, from:

(a) using in business a sign that is identical to the trademark for goods or services that are identical to those for which the trademark is registered;

(b) using in business a sign in respect of which, because it is identical or similar to the trademark and because the goods or services covered by the trademark and the sign are identical or similar, there is a risk of confusion in the mind of the public which includes the risk of association between the sign and the trademark;

(c) using in business a sign which is identical or similar to the trademark for goods or services which are not similar to those for which the trademark is registered, where the trademark enjoys a reputation in the Benelux territory and where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark;

(d) using a sign for purposes other than those of distinguishing the goods or services, where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trademark.

2. For the purposes of paragraph 1, use of a similar trademark or sign shall mean in particular:

(a) attachment of the sign to products or their packaging;

(b) offering, marketing or holding goods for these purposes or offering or providing services under the sign;

(c) importing or exporting goods under the sign;

(d) use of the sign in business papers and advertising.

3. The classification adopted for the registration of trademarks in accordance with the Nice Agreement shall not constitute a criterion for evaluating the similarity of goods or services.

4. The exclusive right in a trademark drafted in one of the national or regional languages of the Benelux territory shall extend to translations into another of these languages *ipso jure*. Evaluation of the similarity arising from translations, in the case of one or more languages foreign to the aforesaid territory, shall be a matter for the courts.

#### **Article 2.21 Compensation for loss and other actions**

1. Subject to the same conditions as in Article 2.20(1), the exclusive right in a trademark shall allow the owner to claim compensation for any loss which may have been incurred following use within the meaning of this provision.

2. In addition to or instead of the action for compensation, the owner of a trademark may institute proceedings for transfer of the profit made following such use, and for a delivery of accounts in this regard; the court shall reject the application if it considers that this use is not in bad faith or the circumstances of the case do not justify such an order.

3. The owner of a trademark may institute proceedings for compensation or transfer of profit in the name of the licensee, without prejudice to the right granted to the licensee in Article 2.32(4) and (5).

4. The owner of a trademark may require reasonable compensation from a party which has carried out acts such as those mentioned in Article 2.20 during the period between the publication date of the filing and the date of registration of the trademark, insofar as the owner of the trademark has acquired exclusive rights in this regard.

#### **Article 2.22 Additional claims**

1. The owner of a trademark shall have the option to claim ownership of movable goods which have adversely affected its right or assets which have been used for the production of these goods or to require that they be destroyed or rendered unserviceable. Such a claim may be made in respect of sums of money which are presumed to have been collected following infringement of the trademark right. Claims shall be rejected if the infringement was not made in bad faith.

2. The provisions of national law relating to steps to preserve rights and to the enforcement of judgments and officially recorded acts shall apply.

3. The courts may order that authority for enforcement shall be given only on payment by the claimant of a sum which they shall fix.

4. At the request of the owner of a trademark, the courts may order the party infringing the owner's right to provide the owner with all information available concerning the origin of the goods which have infringed the trademark and to provide him with all the data relating thereto.

### **Article 2.23 Restriction of exclusive right**

1. The exclusive right shall not imply the right to challenge a third party over the use in business of:

(a) its name and address;

(b) indications relating to the kind, quality, quantity, intended purpose, value, geographical origin or time of manufacture of a product or provision of a service or other characteristics thereof;

(c) the trademark, where it is necessary in order to indicate the purpose of a product or service, particularly as an accessory or spare part;

provided that such use is made in accordance with fair use in the conduct of industry or business.

2. The exclusive right to a trademark shall not imply the right to challenge use in business of a similar sign which draws its protection from a prior right of local scope, if such right is recognized by the legal provisions of any Benelux country, within the limits of the territory in which it is recognized.

3. The exclusive right shall not imply the right to challenge use of the trademark for goods which have been marketed in the European Community or European Economic Area under that trademark by the owner or with his consent, unless there are legitimate grounds for the owner to object to further marketing of the goods, in particular where the condition of the goods has been altered or adversely affected after they have been marketed.

### **Article 2.24 Loss of right through tolerance and objections to use**

1. The owner of a prior trademark who has tolerated the use of a later registered trademark during a period of five consecutive years and is aware of such use may no longer object to the use of the later trademark under Article 2.20(1)(a), (b) and (c) in respect of goods or services for which the trademark has been used, unless the later trademark was filed in bad faith.

2. Tolerance of the use of a later registered trademark as defined in paragraph 1 shall not give the owner of the later registered trademark the right to object to the use of the prior trademark.

## **Chapter 6. Cancellation, termination of right and nullity**

### **Article 2.25 Cancellation on request**

1. The owner of a Benelux trademark may request cancellation of its registration at any time.
2. However, if a license has been recorded, registration of the trademark may be cancelled only at the joint request of the owner of the trademark and the licensee. The provisions of the preceding sentence shall apply where a right of pledge or attachment has been recorded.
3. Cancellation shall have effect throughout Benelux territory.
4. Renunciation of the protection resulting from an international filing, which is restricted to part of Benelux territory, shall have effect for the whole of the territory, notwithstanding any statement to the contrary by the owner.
5. Voluntary cancellation may be restricted to one or more of the goods or services for which the trademark is registered.

### **Article 2.26 Lapse of right**

1. The right to a trademark shall lapse:
  - (a) through voluntary cancellation or expiry of the trademark's registration;
  - (b) through cancellation or expiry of the international registration, or through renunciation of protection for Benelux territory or, in accordance with the provisions of Article 6 of the Madrid Agreement and Madrid Protocol, as a result of the fact that the trademark no longer benefits from legal protection in the country of origin.
2. The right to a trademark shall be declared as lapsed within the limits laid down in Article 2.27 if, following the date of registration:
  - (a) there has been no normal use of the trademark, without due cause, on Benelux territory for the goods or services in respect of which the trademark is registered, for an uninterrupted period of five years; in the event of litigation, the courts may place all or part of the burden of proof on the owner of the trademark;

(b) the trademark has become the normal commercial description of a product or service for which it is registered as a result of the activity or inactivity of its owner;

(c) as a result of the use made of it by the owner or with his consent, in respect of the goods or services for which it is registered, the trademark is likely to mislead the public, particularly as regards the nature, quality or geographical origin of the goods or services.

3. For the purposes of paragraph 2(a), use of the trademark shall also be understood to mean:

(a) use of the trademark in a form which differs through elements which do not adversely affect its distinctive character in the form in which it has been registered;

(b) attachment of the trademark to goods or their packaging for the sole purpose of export;

(c) use of the trademark by a third party with the consent of the owner of the trademark.

### **Article 2.27 Invocation of the lapse of a right**

1. Any interested party may invoke lapse of the right in a trademark in the cases provided for by Article 2.26(2).

2. Lapse of the right in a trademark subject to the provisions of Article 2.26(2)(a), may no longer be invoked if the trademark has been the subject of the commencement or resumption of normal use between expiry of the period of five years and submission of the claim that it has lapsed. However, commencement or resumption of use within a period of three months prior to submission of a claim for lapse shall not be taken into consideration when the preparatory steps for commencement or resumption of use occur only after the proprietor has learnt that a claim for lapse may be submitted.

3. The owner of the right in a trademark whose lapse can no longer be invoked under the second paragraph shall have no grounds under Article 2.20(1)(a), (b) and (c) to contest the use of a trademark filed during the period in which the prior right in the trademark may have been declared void under Article 2.26(2)(a).

4. The owner of the right in a trademark whose lapse can no longer be invoked under the second paragraph may not, on the basis of the provisions of Article 2.28(3), claim the nullity of the registration of a trademark filed during the period in which the prior right in the trademark could have been declared as lapsed under Article 2.26(2)(a).

## Article 2.28 Actions for nullity

1. Any interested party, including the Public Prosecutor, may invoke the nullity of:

(a) registration of a sign which cannot constitute a trademark as defined in Article 2.1(1) and (2);

(b) registration of a trademark which is devoid of distinctive character;

(c) registration of a trademark which comprises solely signs or indications which may be used in commerce to indicate the nature, quality, quantity, intended purpose, value, geographical origin or time of manufacture of a product or provision of a service, or other characteristics thereof;

(d) registration of a trademark comprising solely signs or indications which have become customary in everyday language or in the *bona fide* and established practices of the trade;

(e) registration of a trademark under which no trademark right is acquired in accordance with Article 2.4(a), (b) and (g);

(f) registration of a trademark under which no trademark right is acquired in accordance with Article 2.4(c), provided that nullity is invoked within a period of five years following the date of registration.

2. The courts may decide that the trademarks referred to in paragraphs 1(b), (c) and (d), have acquired distinctive character following registration owing to the use which has been made of them.

3. Provided that the owner of the prior registration or the third party referred to in Article 2.4(d), (e) and (f), is a party to the action, any interested party may invoke the nullity of:

(a) registration of a trademark which ranks after that of a similar trademark in the circumstances provided for by Article 2.3;

(b) filing under which no trademark right is acquired in accordance with Article 2.4(d), (e) and (f); nullity under Article 2.4(d) must be invoked within a period of three years following expiry of the prior registration; nullity under Article 2.4(e) and (f) must be invoked within a period of five years following the date of registration. This period of five years shall not apply to trademark registrations referred to in Article 2.4(e), which were filed in bad faith.

4. When an action for nullity is brought by the Public Prosecutor, only the courts of Brussels, the Hague and Luxembourg shall have jurisdiction in the cases provided for by paragraph 1. Action brought by the Public Prosecutor shall stay any other action brought on the same grounds.



### **Article 2.29 Loss of right through tolerance and actions for nullity**

The owner of a prior trademark who has tolerated the use of a later registered trademark during a period of five consecutive years and is aware of such use may no longer invoke the nullity of the later trademark on the basis of its prior right under Article 2.28(3)(a), unless the later trademark was filed in bad faith.

### **Article 2.30 Scope of cancellation, declaration of lapse of right and voluntary cancellation**

1. The cancellation of a registration, declaration of the lapse of a right to a trademark or voluntary cancellation of a registration shall apply to the sign constituting the trademark in its entirety.
2. Cancellation or a declaration of the lapse of a right shall be limited to one or more of the goods or services in respect of which the trademark is registered, if the grounds for nullity or lapse affect only some of the goods or services.

## **Chapter 7. Transfer, licensing and other rights**

### **Article 2.31 Transfer**

1. Independently of the transfer or all or part of a business, a trademark may be transferred in respect of all or some of the goods or services for which the trademark was filed or registered.
2. The following shall be null and void:
  - (a) assignments between living persons not laid down in writing;
  - (b) assignments or other transfers not made for the whole of Benelux territory.

### **Article 2.32 Licensing**

1. A trademark may be the subject of a license for all or some of the goods or services in respect of which the trademark was filed or registered.

2. The owner of a trademark may invoke the exclusive right to the trademark against a licensee who contravenes the clauses of the licensing contract in respect of its term, the form covered by the registration in which the trademark may be used, the goods or services for which the license is granted, the territory on which the trademark may be affixed or the quality of the goods or services marketed by the licensee.

3. Entry of licenses in the register may be cancelled only at the joint request of the owner of the trademark and the licensee.

4. In order to obtain redress for a loss directly incurred or to be allocated a proportion of a profit made by a defendant, a licensee shall have the right to act in an action brought by the owner of the trademark, as mentioned in Article 2.21(1) and (2).

5. A licensee may bring independent action as referred to in the preceding paragraph only if it has obtained the permission of the owner for that purpose.

6. A licensee shall be authorized to exercise the powers referred to under Article 2.22(1), provided that these are in order to protect the rights which it has been permitted to exercise and provided that it has obtained permission from the owner of the trademark for that purpose.

### **Article 2.33 Action against third parties**

The assignment or other transfer or the license shall become actionable against third parties only after filing of an extract from the document establishing this or a corresponding declaration signed by the parties involved has been registered in the manner specified by the Implementing Regulations and following payment of the fees due. The provision in the preceding sentence shall apply to rights of pledge and attachments.

## **Chapter 8. Collective marks**

### **Article 2.34 Collective marks**

1. All signs which are so designated at the time of filing and which are used to distinguish one or more common features of goods or services originating from different companies using the trademark under the control of the owner shall be regarded as collective marks.

2. The owner may not use the trademark for goods or services originating from its company or from a company in whose management or supervision it is directly or indirectly involved.

3. Any signs so designated at the time of filing and used to designate the geographical origin of goods or services in business shall also be regarded as collective marks. Such trademarks shall not authorize the owner to prevent a third party from using these signs in business in accordance with honest practice in industrial or commercial matters; in particular, such a trademark may not be invoked against a third party who is entitled to use such a geographical name.

### **Article 2.35 Application by analogy**

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

### **Article 2.36 Filing**

1. An exclusive right to a collective mark shall be acquired only if regulations on use and control thereof accompany the filing of the mark.
2. However, in the case of an international filing, the applicant shall have a period of six months following notification of the international registration provided for by Article 3(4) of the Madrid Agreement and Madrid Protocol to file those regulations.

### **Article 2.37 Regulations on use and control**

1. The regulations on use and control relating to a collective mark must indicate the common characteristics of the goods or services which the mark is intended to guarantee.
2. They shall also specify the manner in which proper and efficient control of those characteristics will be exercised, together with appropriate sanctions.

### **Article 2.38 Exception**

Article 2.4(c) shall not apply to the registration of a collective mark made by a former owner of the registration of a similar collective mark or by its agent.

### **Article 2.39 Refusal of registration**

The Office may not register a Benelux filing of a collective mark if the regulations on use and control relating to that mark have not been filed under the conditions provided for by Article 2.36.

### **Article 2.40 Amendment of the regulations on use and control**

1. The owners of collective marks must notify the Office of any amendments to the regulations on the use and control of a trademark.
2. This notification shall be recorded by the Office.
3. The amendments shall not enter into force prior to the notification specified in paragraphs 1 and 2.

### **Article 2.41 Persons having the power to claim the right to a trademark**

1. The right to institute proceedings to claim the protection of a collective mark shall be reserved for the owner of the mark.
2. However, the regulations on use and control may grant persons permitted to make use of the mark the right to act jointly together with the owner or to join or act in the action brought by or against the owner.
3. Likewise, the regulations on use and control may specify that, when acting alone, the owner may establish the special interest of those using the mark and include in its claim for redress any particular loss incurred by one or more of them.

### **Article 2.42 Persons empowered to claim the lapse of a right**

1. Without prejudice to the provisions of Article 2.27, any interested party, including the Public Prosecutor, may invoke the lapse of a right in a collective mark if the owner makes use of the mark under the conditions specified in Article 2.34(2), or authorizes or tolerates use contrary to the provisions of the regulations on use and control.
2. Where the action in respect of lapse is brought by the Public Prosecutor, the courts of Brussels, the Hague and Luxembourg shall have exclusive jurisdiction.

3. An action brought by the Public Prosecutor shall stay any other action brought on the same grounds.

#### **Article 2.43 Actions for nullity brought by the Public Prosecutor**

1. Without prejudice to the provisions of Article 2.28, the Public Prosecutor may invoke the nullity of the registration of a collective mark, where the regulations on use and control are contrary to public policy, or where they fail to comply with the requirements of Article 2.37.

2. The Public Prosecutor may also invoke the nullity of amendments to the regulations on use and control which would be contrary to public policy or to the provisions of Article 2.37 or which would have the effect of weakening the guarantees provided to the public by the regulations.

3. The courts of Brussels, the Hague and Luxembourg shall have exclusive jurisdiction to take decisions in such proceedings; they shall order *ex officio* the cancellation of void registrations or void amendments.

#### **Article 2.44 Prohibition on use**

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 2.38 has been made, shall on no account be used during the three years following the date of the registration of the lapse, nullification or cancellation or the expiration of the non-renewed registration, except by a party who can rely on a prior right in a similar individual mark.

### **Chapter 9. Provisions relating to Community trademarks**

#### **Article 2.45 Priority**

Articles 2.3 and 2.28(3)(a) shall apply where the registration is based on the prior filing of a Community trademark.

## **Article 2.46 Seniority**

Articles 2.3 and 2.28(3)(a) shall apply to Community trademarks for which seniority on the Benelux territory is validly claimed in accordance with the Regulation on the Community Trade Mark even if the Benelux or international registration on which seniority is based has been voluntarily cancelled or has expired.

## **Article 2.47 Action for nullity or the lapse of prior right**

Where the priority of a right in a prior trademark is claimed in respect of a Community trademark, the nullity or lapse of that prior right may be invoked even if that right has already lapsed through voluntary cancellation or expiry of the registration.

## TITLE III: DESIGNS

### **Chapter 1. Designs**

#### **Article 3.1 Designs**

1. A design shall receive protection only insofar as the design is novel and has individual character.
2. The appearance of a product or a part of a product shall be regarded as a design.
3. The appearance of a product shall be imparted, in particular, through the characteristics of the lines, contours, colors, shape, texture or materials of the product itself or of its ornamentation.
4. A product shall mean any industrial or craft article including, *inter alia*, parts designed to be assembled into a complex product, packaging, presentation, graphic symbol or typographic character. Computer programs shall not be regarded as a product.

### **Article 3.2 Exceptions**

1. The following shall be excluded from the protection provided for by this title:

(a) characteristics of the appearance of a product which are exclusively imposed by its technical function;

(b) characteristics of the appearance of a product whose shape and dimensions must necessarily be reproduced exactly dimensions in order for the product in which it is incorporated or to which the design is applied to be connected mechanically to another product, be placed within or around another product, or be placed in contact with another product in such a way that each product can fulfill its function.

2. Notwithstanding paragraph 1(b), characteristics of the appearance of a product the purpose of which is to permit multiple assembly or connection of interchangeable products within a modular system shall be protected by rights in a design complying with the conditions laid down in Article 3.1(1).

### **Article 3.3 Novelty and individual character**

1. A design shall be regarded as novel if, on the filing or priority date, no identical design has been disclosed to the public. Designs shall be regarded as being identical when their characteristics differ only in terms of insignificant details.

2. A design shall be regarded as having an individual character if the overall impression which the design produces on the informed user differs from that which any design which has been disclosed to the public prior to the filing or priority date has on such a user. In order to evaluate individual character, the creator's degree of freedom in preparing the design shall be taken into account.

3. In order to assess novelty and individual character, a design shall be deemed to have been disclosed to the public if the design has been published following registration or otherwise, or exhibited, used in trade or made public in any other way, unless such events could not in the normal practice of business reasonably be known to specialists within the sector concerned operating within the European Community or the European Economic Area prior to the filing or priority date. However, a design shall not be regarded as having been disclosed to the public solely because it has been disclosed to a third party subject to explicit or implicit conditions of secrecy.

4. For the purposes of evaluating novelty and individual character, disclosure to the public of a design in respect of which protection has been claimed by means of registration shall not be taken into account if, during the twelve months preceding the filing or priority date:

(a) disclosure has been made by the creator or his beneficiary or by a third party on the basis of information provided or acts carried out by the creator or his beneficiary; or

(b) disclosure has been made following improper conduct with regard to the creator or his beneficiary.

5. Right of priority shall mean the right provided for under Article 4 of the Paris Convention. This right may be claimed by anyone who properly submits an application for a design or utility model in one of the countries which is a party to the said Convention or the TRIPS Agreement.

### **Article 3.4 Parts of complex products**

1. A design applied to a product or incorporated in a product which constitutes a part of a complex product shall be regarded as being novel and having an individual character only insofar as:

(a) the part, once incorporated in the complex product, remains visible during normal use of the product; and

(b) the visible characteristics of the part in themselves satisfy the conditions of novelty and individual character.

2. For the purposes of this title, complex product shall mean a product comprising multiple parts that may be replaced in such a way as to allow a product to be dismantled and reassembled.

3. Normal use as defined in paragraph 1 shall mean use by the end user with the exception of maintenance, servicing or repair.

### **Article 3.5 Acquisition of rights**

1. Without prejudice to the right of priority, the exclusive right to a design shall be acquired by registration of the filing on Benelux territory with the Office (Benelux filing) or with the International Bureau (international filing).

2. Where two or more filings are made for the same design, if the first filing is not followed by the publication provided for by Article 3.11(2) of this Convention or Article 6(3) of the Hague Agreement, the succeeding filing shall acquire the status of first filing.



### **Article 3.6 Restrictions**

Within the limits of Articles 3.23 and 3.24(2), registration shall not grant the right to a design where:

- (a) the design is in conflict with a prior design which has been the subject of disclosure to the public after the filing or priority date and which has been protected, since a prior date, by an exclusive right deriving from a Community design, the registration of a Benelux filing, or an international filing;
- (b) a prior trademark is used in the design without the consent of the owner of that trademark;
- (c) a work protected by copyright is used in the design without the consent of the copyright owner;
- (d) the design constitutes improper use of one of the elements listed in Article 6<sup>ter</sup> of the Paris Convention;
- (e) the design is contrary to morality or public policy in one of the Benelux countries;
- (f) the filing does not sufficiently reveal the characteristics of the design.

### **Article 3.7 Claim for filing**

1. During the five years following publication of the registration of a filing, the creator of the design or the person who, according to Article 3.8, is deemed to be the creator, may claim the right to the Benelux filing of that design or the rights in Benelux territory deriving from the international filing of that design, if the filing was made by a third party without the creator's consent; the creator may on the same grounds and at any time invoke the nullity of the registration of the filing or of the rights referred to. The action to claim the filing or the rights shall be registered with the Office at the applicant's request in the manner laid down by the Implementing Regulations and on payment of the fees due.

2. If the applicant referred to in the preceding paragraph has requested the total or partial cancellation of the registration of the Benelux filing or has renounced the rights in Benelux territory deriving from international filing, such cancellation or renunciation shall, subject to paragraph 3, not be binding on the creator or the person deemed under Article 3.8 to be the creator, provided that the filing has been claimed within one year from the date of publication of the cancellation or renunciation and before the expiry of the five-year period referred to in paragraph 1.

3. If, during the interval between the cancellation or renunciation referred to in paragraph 2 and the registration of the action to claim the filing or the rights, a third party, acting in good

faith, has used a product that is identical in appearance or that does not produce a different overall impression on an informed user, that product shall be considered to have been lawfully placed on the market.

### **Article 3.8 Rights of employers and commissioning parties**

1. If a design has been created by a worker or an employee in the course of his employment, the employer shall, unless specified otherwise, be regarded as the creator.
2. If a design has been created on commission, the commissioning party shall, unless specified otherwise, be regarded as the creator, provided that the commission was given with a view to commercial or industrial use of the product in which the design is incorporated.

## **Chapter 2. Filing, registration and renewal**

### **Article 3.9 Filing**

1. Designs shall be filed within Benelux with national authorities or with the Office in the manner specified by the Implementing Regulations and against payment of the fees due. Benelux filing may comprise either a single design (single filing) or several (multiple filing). A check shall be made to ensure that the documents produced satisfy the conditions specified for fixing the filing date and the filing date shall be specified. The applicant shall be informed, without delay and in writing, of the filing date or, where applicable, the grounds for rejection.
2. If other provisions of the Implementing Regulations are not satisfied at the time of filing, the applicant shall be informed without delay and in writing of the conditions which have not been satisfied and shall be given the opportunity to respond.
3. Filing shall have no further effect if the provisions of the Implementing Regulations are not satisfied within the period granted.
4. When filing takes place with a national authority, the national authority shall forward the Benelux filing to the Office, either without delay after receiving the filing, or after establishing that the filing satisfies the conditions specified in paragraphs 1 to 3.
5. Without prejudice in the case of Benelux filings to the application of Article 3.13, filings of designs may not be the subject, as far as substance is concerned, of any examination giving rise to findings which could be binding on the applicant by the Benelux Office.

### **Article 3.10 Claiming priority**

1. A right of priority shall be claimed at the time of filing or by special declaration submitted to the Office in the month following filing and in the manner laid down by the Implementing Regulations and subject to payment of the fees due.
2. If no such claim is made the right of priority shall lapse.

### **Article 3.11 Registration**

1. The Office shall register, without delay, Benelux filings and also international filings which have been the subject of publication in the "Bulletin International des dessins ou modèles – International Design Gazette" and in respect of which the applicants have requested that these should have effect in Benelux territory.
2. Without prejudice to the provisions of Articles 3.12 and 3.13, the Office shall publish registrations of Benelux filings in accordance with the Implementing Regulations as soon as possible.
3. If the publication does not sufficiently disclose the characteristics of the design, the applicant may request the Office to make another publication within the period specified for the purpose without charge.
4. Following publication of a design, the public may examine the registration and the documents produced at the time of filing.

### **Article 3.12 Postponement of publication on request**

1. When making a Benelux filing, the applicant may request that publication of the registration be postponed for a period of not more than twelve months from the date of filing or the date on which the right of priority arises.
2. If the applicant makes use of the right provided for under paragraph 1, the Office shall postpone publication in accordance with the request.

### **Article 3.13 Contraventions of public policy and morality**

1. The Office shall delay publication if it considers that the design falls within the scope of Article 3.6(e).

2. The Office shall notify the applicant of this and invite it to withdraw the filing within a period of two months.

3. If the party in question has not withdrawn the filing on the expiry of that period, the Office shall, within the shortest period possible, invite the Public Prosecutor to initiate an action to render the filing null and void.

4. If the Public Prosecutor considers that there are no grounds for initiating such an action, or if the action is rejected by a court ruling against which no further opposition or appeal or referral to a high court of appeal may be made, the Office shall publish the registration of the design without delay.

### **Article 3.14 Term of registration and renewal**

1. Benelux filings shall be registered for a term of five years from the date of filing. Without prejudice to the provisions of Article 3.24(2), the design to which a filing relates may not be modified either during the term of the registration or at the time of renewal.

2. It may be renewed for four successive periods of five years up to a maximum of 25 years.

3. Renewal shall be effected solely by payment of the fee specified for that purpose. This fee must be paid during the twelve months preceding expiry of the registration; it may still be paid during the six months following the expiry date of the registration, subject to simultaneous payment of an additional fee. Renewal shall have effect from expiry of the registration.

4. Renewal may be restricted to only part of the designs included in a multiple filing.

5. Six months before expiry of the first to the fourth periods of registration, the Office shall provide a reminder of that expiry date by means of notification addressed to the owner of the design and to third parties whose rights in the design have been entered in the register.

6. Office reminders shall be sent to the last known address of the interested parties. Failure to send or receive such notices shall not constitute dispensation from the obligations resulting from paragraph 3. It may not be invoked either in court proceedings or against the Office.

7. The Office shall register renewals and publish them in accordance with the Implementing Regulations.

### **Article 3.15 International filings**

International filings shall be made in accordance with the provisions of the Hague Agreement.

## **Chapter 3. Owner's rights**

### **Article 3.16 Scope of protection**

1. Without prejudice to the possible application of ordinary law relating to civil liability, the exclusive right in a design shall allow the owner to challenge the use of a product in which the design is incorporated or to which the design is applied, which has an identical appearance to the design as filed, or which does not produce a different overall impression on an informed user, having regard to the creator's degree of freedom in preparing the design.
2. Use shall mean, in particular, the manufacture, offer, marketing, sale, delivery, hire, importing, exporting, exhibiting, use or holding for one of those purposes.

### **Article 3.17 Compensation for loss and other actions**

1. The exclusive right shall allow the owner to claim compensation for the acts listed in Article 3.16 only if those acts took place after the publication referred to in Article 3.11, adequately disclosing the characteristics of the design.
2. In addition to or instead of the action for compensation, the owner of the exclusive right may bring an action for transfer of the profits made following the acts referred to in Article 3.16, under the circumstances mentioned in paragraph 1 of this Article, as well as the provision of accounts in this regard. The courts shall reject the claim if they consider that the acts in question were not carried out in bad faith or if the circumstances of the case do not justify an order for transfer of the profit unlawfully made.
3. The owner of the exclusive right in a design may bring an action for compensation or transfer of profit in the name of a licensee, without prejudice to the right granted to the licensee in Article 3.26(4).
4. With effect from the filing date, reasonable compensation may be required from a party which, being aware of the filing, has engaged in acts such as those mentioned in Article 3.16, insofar as the owner has acquired exclusive rights in this regard.

### **Article 3.18 Additional claims**

1. The owner of the exclusive right in a design shall have the option to claim ownership of movable goods which have adversely affected its right or assets which have been used for the production of these goods or to require that they be destroyed or rendered unserviceable. Such a claim may be made in respect of sums of money which are presumed to have been collected following infringement of the exclusive design right. Claims shall be rejected if the infringement was not made in bad faith.
2. The provisions of national law relating to steps to preserve rights and the enforcement of judgments and officially recorded acts shall apply.
3. The courts may order that authority for enforcement shall only be given against payment by the claimant of a sum which they shall fix.
4. At the request of the owner of the exclusive right in a design, the courts may order the party infringing the owner's right to provide the owner with all information available concerning the origin of the goods which have infringed the design and to provide all data relating thereto.

### **Article 3.19 Restriction of exclusive right**

1. The exclusive right to a design shall not imply the right to contest:
  - (a) acts engaged in privately and for non-commercial purposes;
  - (b) acts done for experimental purposes;
  - (c) acts of reproduction for the purposes of illustration or teaching, insofar as these acts are compatible with honest commercial practice, do not unduly prejudice normal use of the design and provided that the source is indicated.
2. Furthermore, the exclusive right in a design shall not imply the right to contest:
  - (a) equipment on ships or aircraft registered in another country when they temporarily enter Benelux territory;
  - (b) the import into Benelux territory of spare parts and accessories for the purpose of repairing such craft;
  - (c) the performance of repairs on such craft.

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right to contest use of the design for the purposes of repair of that complex product in order to  
return it to its initial appearance.

4. The exclusive right in a design shall not imply the right to contest the acts mentioned in  
Article 3.16 relating to products which have been placed in circulation in one of the Member  
States of the European Community or European Economic Area, either by the owner or with  
the owner's consent, or the acts mentioned in Article 3.20.

5. Actions may not relate to goods which were placed in circulation in Benelux territory prior  
to the filing.

### **Article 3.20 Right of personal possession**

1. A right of personal possession shall be recognized for third parties who, prior to the filing  
date for a design or to the priority date, manufactured on Benelux territory goods having an  
appearance identical to the design filed or goods which do not produce a different overall  
impression on an informed user.

2. The same right shall be recognized for those who, in the same conditions, have started to  
carry out their intention to manufacture.

3. However, this right shall not be recognized for third parties who have copied the design in  
question without the creator's consent.

4. The right of personal possession shall permit the owner to continue or, in the circumstances  
referred to in paragraph 2 of this Article, to undertake manufacture of those goods and to  
carry out all the other acts mentioned in Article 3.16, notwithstanding the right deriving from  
the registration, with the exception of importing.

5. The right of personal possession may be transferred only together with the establishment in  
which the acts which gave rise to it took place.

## **Chapter 4. Cancellation, lapse of right and nullity**

### **Article 3.21 Cancellation on request**

1. The owner of the registration of a Benelux filing may at any time request cancellation of  
that filing, unless third parties have legal contractual rights which have been notified to the  
Office.

2. In the case of multiple filings, cancellation may relate only to part of the designs included in the filing.
3. If a license has been recorded, registration of the design may be cancelled only at the joint request of the owner of the design and the licensee. The provision of the previous sentence shall apply where a pledge or attachment is registered.
4. Cancellation shall have effect for the whole of Benelux territory, notwithstanding any declaration to the contrary.
5. The rules laid down in this Article shall also apply to renunciation of the protection deriving for Benelux territory from an international filing.

### **Article 3.22 Lapse of rights**

Subject to the provisions of Article 3.7(2), the exclusive right in a design shall lapse:

- (a) through voluntary cancellation or expiry of the registration of the Benelux filing;
- (b) through expiry of the registration of the international filing or through renunciation of the rights for Benelux territory deriving from the international filing, or through *ex officio* cancellation of the international filing as referred to in Article 6(4)(c), of the Hague Agreement.

### **Article 3.23 Actions for nullity**

1. Any interested party, including the Public Prosecutor, may invoke the nullity of a design registration if:
    - (a) the design does not comply with the definition given under Article 3.1(2) and (3);
    - (b) the design does not satisfy the conditions specified in Article 3.1(1) and Articles 3.3 and 3.4;
    - (c) the design falls within the scope of Article 3.2;
    - (d) the registration does not grant a right in the design pursuant to Article 3.6(e) or (f).
  2. Only the applicant or the owner of an exclusive right in a design deriving from the registration of a Community design, a Benelux registration or an international filing may invoke the nullity of the registration of the later filing of a design which is in conflict with its right, if registration of the filing does not grant the right in the design in accordance with
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3. Only the owner of a right in a prior trademark or the owner of a prior copyright may invoke the nullity of the registration of the Benelux filing or of the rights deriving for Benelux territory from an international filing of the design, if no right in the design has been acquired in accordance with Article 3.6(b) or (c).
4. Only the interested party may invoke the nullity of the registration of a design, if no right in the design has been acquired in accordance with Article 3.6(d).
5. Only the creator of a design as referred to under Article 3.7(1) may, in the conditions referred to under that Article, invoke the nullity of the registration of the filing of a design made by a third party without his consent.
6. Registration of the filing of a design may be declared null and void even after the right has lapsed or been renounced.
7. When an action for nullity is brought by the Public Prosecutor, only the courts of Brussels, the Hague and Luxembourg shall have jurisdiction. Actions brought by the Public Prosecutor shall stay any other action brought on the same grounds.

#### **Article 3.24 Scope of annulment, declaration of lapse and voluntary cancellation**

1. Subject to the provisions of paragraph 2, annulment, voluntary cancellation and renunciation shall apply to the design in its entirety.
2. If the registration of the filing of a design may be cancelled in accordance with Article 3.6(b), (c), (d) or (e), or Article 3.23(1)(b) and (c), filing may be maintained in a modified form if, in that form, the design complies with the criteria for the grant of protection and the identity of the design is preserved.
3. Maintenance as referred to in paragraph 2 may be understood as registration accompanied by partial renunciation of the right by the owner or the registration of a court order which is no longer subject to opposition or appeal or to referral to a high court of appeal establishing that registration of the filing is partly void.

## **Chapter 5. Transfer, licensing and other rights**

### **Article 3.25 Transfer**

1. The exclusive right in a design may be transferred.
2. The following shall be void:
  - (a) assignments between living persons not laid down in writing;
  - (b) assignments or other transfers not made for the whole of Benelux territory.

### **Article 3.26 Licensing**

1. The exclusive right in a design may be the subject of a license.
2. The owner of a design may claim the exclusive right in a design against a licensee who infringes the clauses of the licensing contract in respect of its term, the form covered by the registration in which the design may be used, the goods for which the license has been granted and the quality of the goods marketed by the licensee.
3. Entry of a license in the register may be cancelled only at the joint request of the owner of the design and the licensee.
4. In order to obtain compensation for a loss directly incurred, or to be allocated a proportion of a profit made by a defendant, a licensee shall have the right to intervene in an action referred to in Article 3.17(1) and (2), brought by the owner of the exclusive right in a design. The licensee may initiate an independent action as defined in Article 3.17(1) and (2) only after it has obtained authorization from the owner of the exclusive right for that purpose.
5. A licensee shall be empowered to exercise the powers mentioned in Article 3.18(1), provided that this is in order to protect the rights which it has been allowed to exercise and provided that it has obtained authorization from the owner of the exclusive right to a design for that purpose.

### **Article 3.27 Action against third parties**

Assignment or other transfer or the license shall become actionable against third parties only after the filing of an extract from the document establishing this or a corresponding declaration signed by the parties involved has been registered in the manner specified by the Implementing Regulations and following payment of the fees due. The provision of the previous sentence shall apply to rights of pledge and attachments.

## **Chapter 6. Combination with copyright**

### **Article 3.28 Combination**

1. Authorization given by the creator of a work protected by copyright to a third party to file a design in which that work of art is incorporated shall imply the assignment of the copyright attached to that work insofar as it is incorporated in the design.
2. The party filing a design shall be presumed also to be the owner of the copyright relating thereto; this presumption shall not, however, apply in respect of the true creator or his beneficiary.
3. The assignment of the copyright relating to a design shall result in the assignment of the right in the design and vice versa, without prejudice to the application of Article 3.25.

### **Article 3.29 Copyright of employers and commissioning parties**

Where a design is created in the circumstances referred to in Article 3.8, the copyright relating to the design shall belong to the party regarded as the creator, in accordance with the provisions of that Article.

## TITLE IV: PROVISIONS COMMON TO TRADEMARKS AND DESIGNS

### **Chapter 1. Register of agents**

#### **Article 4.1 General provisions concerning the register of agents**

1. In accordance with the provisions specified by the Implementing Regulations, the Office shall maintain a register of agents for trademarks and designs through which it can be determined who satisfies the requirements for ability to engage in the activity of an agent for trademarks and designs under this Convention. The register shall be made available to the public free of charge.

2. Anyone who possesses:

(a) a diploma recognized by the Executive Board or similar documentary evidence, or

(b) a certificate issued by the Director General showing that he has passed an ability test, or

(c) an exemption to the obligation to produce a document as referred to under (a) or (b), granted by the Director General,

may on request be entered in the register referred to in the first paragraph.

3. The Executive Board shall recognize a diploma as mentioned in paragraph 2(a), if it considers that the examination organized by the authority issuing the diploma leads to sufficient knowledge of Benelux regulations and of the main international instruments in the field of trademark law and the law on designs, as well as to sufficient capacity to apply them.

#### **Article 4.2 Appeal against refusal of entry in the register or recognition of a diploma**

1. If registration or exemption is refused or if an entry in the register is cancelled, or if recognition of a diploma is refused or recognition is withdrawn, the party involved may file an appeal with the Court of Appeal of Brussels, the Gerechtshof of the Hague or the Court of Appeal of Luxembourg within two months following the refusal, cancellation or withdrawal, in order to obtain an order for entry in the register or recognition of a diploma.

2. In the context of this procedure, the Office may be represented by a member of its staff appointed for that purpose.

3. The ruling of the appeal court shall be subject to referral to a high court of appeal, which shall have suspensory effect.

### **Article 4.3 Misrepresentation by non-registered persons**

Persons other than those whose names are entered in the register mentioned in Article 4.1(1) shall be prohibited from making themselves known in business as if they were entered in the aforementioned register. The Implementing Regulations shall lay down the applicable rules.

## **Chapter 2. Other Office tasks**

### **Article 4.4 Tasks**

In addition to the tasks entrusted to it by the preceding titles the Office shall be responsible for:

- (a) making amendments to filings and registrations which are required by owners, or which result from notifications by the International Bureau or from court orders, and, where appropriate, informing the International Bureau of these;
- (b) publishing registrations of Benelux filings of trademarks and designs, as well as all other reports required by the Implementing Regulations;
- (c) issuing a copy of registrations at the request of any interested party;
- (d) providing information extracted from the register of agents for trademarks and designs to any party on request, including rules relating to the registration of agents for trademarks and designs which are ordered by or pursuant to this Convention.

## **Chapter 3. Jurisdiction**

### **Article 4.5 Settlement of disputes**

1. Only the courts shall have jurisdiction to rule upon actions brought on the grounds of this Convention.
2. Inadmissibility deriving from failure to register the filing of a trademark or design shall be

3. Judges shall order *ex officio* the cancellation of void or lapsed registrations.

#### **Article 4.6 Territorial jurisdiction**

1. Unless the territorial jurisdiction of the courts is expressly stated in a contract, this shall be determined in cases involving trademarks or designs by the address for service of the defendant or by the place where the obligation in dispute has arisen, or has been or should be enforced.

The place in which the trademark or design is filed or registered shall not under any circumstances be used as the sole basis for determining territorial jurisdiction.

2. Where the criteria mentioned above are insufficient to determine territorial jurisdiction, the petitioner may bring the case before the court of his address for service or residential address, or, if he has no address for service or residential address in Benelux territory, before the court of his choice, in either Brussels, the Hague or Luxembourg.

3. The courts shall apply *ex officio* the rules specified in paragraphs 1 and 2 and shall expressly confirm their jurisdiction.

4. The court before which the main claim is pending shall receive applications for warranty, applications for inclusion and related applications, as well as applications for appeals, unless it does not have jurisdiction over the matter.

5. The courts of one of the three countries shall, if one of the parties so requests, refer disputes brought before them to the courts of one of the other two countries where these disputes are already pending there or when they are associated with other disputes placed before these courts. Referral may only be requested when the actions are pending at first instance. This shall apply to the benefit of the first court in which an action is initially brought, unless another court has given a decision in the matter other than an internal provision, in which case referral shall be to the other court.

### **Chapter 4. Other provisions**

#### **Article 4.7 Direct effect**

Nationals of Benelux countries and nationals of countries that are not members of the Union established by the Paris Convention, who are resident in or who have real and effective industrial or commercial establishments on Benelux territory may, in the context of this Convention, claim application of the provisions of the said Convention, the Madrid

Agreement and Madrid Protocol, the Hague Agreement and the TRIPS Agreement for their benefit throughout the said territory.

#### **Article 4.8 Other applicable rights**

The provisions of this Convention shall not adversely affect application of the Paris Convention, the TRIPS Agreement, the Madrid Agreement and Madrid Protocol, the Hague Agreement and the provisions of Belgian, Letzeburgisch or Dutch law giving rise to prohibitions on the use of a trademark.

#### **Article 4.9 Fees and time limits**

1. All fees due in respect of operations carried out with the Office or by the Office shall be laid down in the Implementing Regulations.
2. All time limits applicable to operations carried out with the Office or by the Office which are not specified in the Convention shall be laid down in the Implementing Regulations.

### **TITLE V: TRANSITIONAL PROVISIONS**

#### **Article 5.1 The Organization as successor to the Benelux Offices**

1. The Organization shall be the successor to the Benelux Trademark Office established under Article 1 of the Benelux Convention Concerning Trademarks of March 19, 1962 and the Benelux Designs Office established under Article 1 of the Benelux Designs Convention of October 25, 1966. The Organization shall be the successor to the Benelux Trademark Office and the Benelux Designs Office in respect of all rights and all obligations with effect from the date on which this Convention enters into force.
2. The Protocol relating to the legal personality of the Benelux Trademark Office and the Benelux Designs Office of November 6, 1981 shall be repealed with effect from the date on which this Convention enters into force.

### **Article 5.2 Repeal of the Benelux Conventions relating to trademarks and designs**

The Benelux Convention Concerning Trademarks of March 19, 1962 and the Benelux Designs Convention of October 25, 1966 shall be repealed with effect from the date on which this Convention enters into force.

### **Article 5.3 Maintenance of existing rights**

The rights which existed under the Uniform Benelux Law on Marks and the Uniform Benelux Designs Law respectively shall be maintained.

### **Article 5.4 Initiation of objection-related proceedings by class**

Article III of the Protocol amending the Uniform Benelux Law on Marks of December 11, 2001 shall continue to apply.

### **Article 5.5 First Implementing Regulations**

As an exception to Article 1.9(2), the Executive Board of the Benelux Trademark Office and the Executive Board of the Benelux Designs Office shall have the power jointly to draw up the first Implementing Regulations.

## **TITLE VI: FINAL PROVISIONS**

### **Article 6.1 Ratification**

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



### **Article 6.2 Entry into force**

1. Subject to paragraphs 2 and 3, this Convention shall enter into force on the first day of the third month after the third ratification instrument has been deposited.
2. Article 2.15, Chapter 1 of Title IV and Article 4.4(d), shall enter into force on a date laid down by the Implementing Regulations, and different dates may be fixed for these various provisions.
3. Article 5.5 shall apply on a provisional basis.

### **Article 6.3 Term of the Convention**

1. This Convention shall be entered into for an unspecified period.
2. This Convention may be denounced by each of the High Contracting Parties.
3. Denunciation shall take effect no later than on the first day of the fifth year following the year of receipt of notification by the other two High Contracting Parties, or on some other date fixed by joint agreement between the High Contracting Parties.

### **Article 6.4 Protocol on privileges and immunities**

The protocol on privileges and immunities shall be an integral part of this Convention.

### **Article 6.5 Implementing Regulations**

1. This Convention shall be implemented through Implementing Regulations. These shall be published in the Official Journal of each of the High Contracting Parties.
2. If there should be any inconsistencies between the text of this Convention and the text of the Implementing Regulations, the text of the Convention shall prevail.

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

*Done* at The Hague on February 25, 2005, in triplicate in the French and Dutch languages, both texts being equally authentic.

*For the Kingdom of Belgium:*

*K. de Gucht*

*For the Kingdom of the Netherlands:*

*B.R. Bot*

*For the Grand Duchy of Luxembourg:*

*J. Asselborn*

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\* Translation by the International Bureau of WIPO