

**Implementing Regulations under the Benelux Convention on Intellectual Property  
(Trademarks and Designs)\***

The Executive Board of the Benelux Trademark Office and the Executive Board of the Benelux Designs Office,

Considering Articles 5.5 and 6.2 of the Benelux Convention on Intellectual Property (Trademarks and Designs),

Hereby enact the present Regulations on June 1, 2006.

**Article I**

The Implementing Regulations under the Benelux Convention on Intellectual Property (Trademarks and Designs) are as follows:

**Title I: Trademarks**

**Chapter 1. The Benelux trademark**

**Rule 1.1 – Conditions of filing**

1. The Benelux filing of a trademark shall take place in French or Dutch, via the production of a document stating:
  - a. the applicant's name and address; if the applicant is a corporate body, its legal form must be indicated;
  - b. where appropriate, the agent's name and address or the postal address referred to in Rule 3.6;
  - c. the trademark;
  - d. the list of goods and services which the trademark is intended to cover, as far as possible with the numbers of classes of these goods and services, in accordance with the Nice Agreement;
  - e. an indication that the trademark is a verbal trademark, a figurative trademark, a semi-figurative trademark, a form trademark or any other type of trademark. In the latter case, the type of trademark should also be specified;
  - f. an indication of the color or colors in words; where appropriate, accompanied by the corresponding color code;
  - g. the signature of the applicant or his agent.
2. The document may provide a description (in 50 words or less) of the distinctive elements of the trademark.

**Rule 1.2 – Collective trademarks**

1. Where appropriate, an indication must be given that the filing concerns a collective trademark.

2. In this case, the filing must be accompanied by regulations for use and control.

### **Rule 1.3 – Setting of a filing date; regularization**

1. The conditions referred to in paragraph 1 of Article 2.5 of the Convention for setting a filing date are those laid down in paragraph 1 (a), (c), (d) and (e) of Rule 1.1 and of Rule 1.2, provided that the basic filing fees are paid within one month after the above-mentioned conditions have been satisfied.
2. A time limit of at least one month shall be granted to satisfy the other conditions mentioned in paragraph 2 of Article 2.5 of the Convention. This time limit may be extended *ex officio* and shall be extended on request, but may not exceed six months starting from the date the first warning was sent.

### **Rule 1.4 – Claiming priority**

1. If the right of priority arising under Article 2.6 of the Convention is claimed at the time of filing, the country, date, number and holder of the filing on which this right of priority is based must be indicated. In the event that the trademark applicant in the country of origin is not the party who has made the Benelux filing, the latter must attach to his filing a certificate of beneficiary.
2. The special declaration of the right of priority, referred to in paragraph 3 of Article 2.6 of the Convention, shall contain the name, address and signature of the applicant or of his agent or, where appropriate, the agent's name and address or the postal address referred to in Rule 3.6, an indication of the trademark and the information mentioned in paragraph 1.
3. An applicant claiming a right of priority shall present a copy of the documents providing entitlement to this right.
4. If the provisions of paragraphs 1, 2 and 3 and those of Rules 3.3 and 3.6 are not satisfied, the Office shall notify the person concerned without delay, setting a time limit of one month for remedying the deficiencies. This time limit may be extended *ex officio* and shall be extended on request, but may not exceed six months starting from the date the first warning was sent. Failure to respond within this time limit shall cause the right of priority to lapse.

### **Rule 1.5 - Publication of filing**

1. The Office shall publish, in accordance with the provisions of paragraph 5 of Article 2.5 of the Convention, the filings submitted, stating:
  - a. the date and number of filing;
  - b. the applicant's name and address;
  - c. where appropriate, the agent's name and address;
  - d. the trademark;
  - e. the goods and services, grouped together into classes according to the classification provided for by the Nice Agreement;
  - f. the type of trademark;

- g. where appropriate, a reference that a collective trademark is involved;
  - h. where appropriate, indications of the classification of figurative trademarks, as provided for by the Vienna Agreement of June 12, 1973 Establishing an International Classification of Figurative Elements of Marks;
  - i. where appropriate, a description of the distinctive elements provided by the applicant;
  - j. where appropriate, an indication of the color or colors in words; where appropriate, accompanied by the corresponding color code;
  - k. where appropriate, that, in accordance with Article 2.6 of the Convention, a right of priority has been claimed, with an indication of the date, number and country of this right of priority. Where appropriate, it shall be noted that the condition referred to in paragraph 3 of Rule 1.4 has not yet been satisfied;
- l. The date of expiry of the time limit for lodging an objection to the trademark.
2. If, at the time of publication of the information relating to a filing, as mentioned in paragraph 1, a mistake has been made which would provide the persons concerned with erroneous information for deciding whether or not to lodge an objection to the trademark concerned, the Office shall publish a rectified version. Accordingly, the time limit for lodging an objection to the trademark shall restart from this moment.
3. Where appropriate, objections already lodged further to the prior publication, rectified pursuant to paragraph 2, shall have no further effect at the claimant's request. Such a request shall be made before expiry of the time limit for lodging an objection, which has started again pursuant to the provision stipulated in paragraph 2. In this case, any fees already paid shall be refunded. If the claimant does not request that his objection shall have no further effect, it shall be deemed to have been lodged within the time limit prescribed.

#### **Rule 1.6 - Registration**

1. The Office shall register the filing by providing the following information:
- a. registration number;
  - b. the information referred to in paragraph 1 of Rule 1.5;
  - c. the date of expiry of the registration;
  - d. the date of registration of the trademark.
2. The Office shall enforce without delay the court rulings referred to in Articles 2.12 and 2.17 of the Convention, as soon as they are no longer subject to objection, appeal or referral to a higher court of appeal.
3. The date on which the Office notes that the filing satisfies all of the conditions set out in the Convention and these Regulations shall be deemed to be the date of registration.

### **Rule 1.7 – Expedited registration**

1. A request to proceed without delay to register the filing referred to in paragraph 2 of Article 2.8 of the Convention may be made at the time of filing or during the registration process.
2. The Office shall publish such registrations, mentioning the elements referred to in Rule 1.6.
3. Where appropriate, the publication referred to in paragraph 2 shall mention the date of expiry for lodging an objection to the trademark. Paragraphs 2 and 3 of Rule 1.5 shall apply.
4. The Office shall publish its decisions to proceed with the cancellation of registration, pursuant to paragraph 2 of Article 2.8 of the Convention. Such publication shall take place once the cancellation decision is no longer subject to objection, appeal or referral to a higher court of appeal.

### **Rule 1.8 – International filings**

1. With regard to the registration of international filings of trademarks designating Benelux, the date of publication by the International Bureau of the declaration sent by the Office, as stipulated in paragraph (6)(a)(i) of Rule 17 of the Common Regulations under the Madrid Agreement and the Madrid Protocol, shall be deemed to be the date of registration.
2. As an exception to the provision contained in the previous paragraph, the date on which the request for registration was submitted to the Office, if the holder of the international filing asks the Office to proceed with registration without delay pursuant to paragraph 3 of Article 2.10 of the Convention, shall be deemed to be the date of registration. The Office shall publish the registration.
3. If the Office has sent the International Bureau a communication pursuant to paragraph 2 of Article 2.13, paragraph 2 of Article 2.18 or paragraph 2 of Article 2.36 of the Convention, the date of publication by the International Bureau of the declaration of withdrawal of rejection sent by the Office, as stipulated in paragraph 5(a)(i) of Rule 17 of the Common Regulations under the Madrid Agreement and the Madrid Protocol, shall be deemed to constitute the date of registration. If different grounds for refusal were found to apply and if they have been withdrawn at different points in time, the date of the last publication by the International Bureau of a declaration of withdrawal of refusal sent by the Office shall be deemed to constitute the date of registration.

### **Rule 1.9 - Renewal**

1. Requests for renewal of a Benelux registration shall be directed to the Office, and shall preferably be made by sending a copy of the reminder referred to in paragraph 5 of Article 2.9 of the Convention, signed by the claimant or, failing this, by means of a document which has been signed by the claimant and which must contain the following information:
  - a. the name and address of the holder of the trademark;
  - b. where appropriate, the agent's name and address or the postal address referred to in Rule 3.6;
  - c. if it is limited in comparison to the last publication, the list of goods and services drawn up in precise wording as far as possible, using the terms of the alphabetical list for the International Classification of Goods and Services, provided for by the Nice Agreement; in any event, the goods and services shall be grouped together by class and following the order of classes in the said Classification;

- d. the registration number.
2. Any fees due to this end shall be paid when the request for renewal is submitted.
3. A request for renewal shall be deemed to have been lodged with the Office once it satisfies the conditions stipulated in paragraphs 1 or 2. However, this shall not constitute dispensation, for the applicant, from the obligation to satisfy both paragraphs.

#### **Rule 1.10 - Regularization of renewal**

1. If, when the request for renewal is submitted, the provisions of Rules 1.9, 3.3 and 3.6 are not satisfied, the Office shall notify the applicant without delay and give him an opportunity to comply. Without prejudice to the provisions of paragraph 6 of Rule 1.18, the corresponding time limit shall be at least one month. This time limit may be extended *ex officio* and shall be extended on request, but may not exceed six months from the date the first warning was sent.
2. If the request is not regularized within the above-mentioned time limit, the request for renewal shall be without further effect.
3. At the time of renewal, the Office shall apply the most recent version of the Classification set out in the Nice Agreement.

#### **Rule 1.11 – Registration of renewal**

1. The Office shall register renewals by adding to the registration the date of renewal and the date on which the registration expires.
2. The Office shall send the holder a certificate of renewal of registration without delay.

### **Chapter 2. Requests for international registration or renewal**

#### **Rule 1.12 – International requests and renewals**

1. Any person who meets the conditions provided for by the Madrid Agreement or the Madrid Protocol may secure protection of his trademark in the member countries. In order to do so, he must send the Office a request for international registration or territorial extension of protection. The renewal of an international registration may be requested through the Office or submitted directly to the International Bureau.
2. Such a request shall be made by producing a document which contains all of the information required by the Common Regulations under the Madrid Agreement and the Madrid Protocol, and shall be accompanied, where appropriate, by the supporting documents provided for by said Regulations.
3. Rules 3.1, 3.3, 3.6 and 3.7 shall apply to such requests and to petitions for the amendment of an international registration.
4. When such requests and petitions are made, the fees provided for by the Madrid Agreement and Protocol shall be paid, provided that such fees have not been paid directly to the International Bureau, together with the Office's service fee, when it is due.

5. The Office shall immediately inform the International Bureau of any request or petition which satisfies the conditions of the present Rule.
6. The date of the request shall be that of its receipt by the Office.
7. Without prejudice to the provisions of Article 6, the date of a request based on the Madrid Agreement may not be prior to the date of registration of the Benelux trademark. In such cases, the Office shall postpone the date of the request to the date of registration of the Benelux trademark.
8. Without prejudice to the provisions of paragraphs 6 and 7, the International Bureau shall consider the date of the request to be the date on which the International Bureau receives the request, when more than two months have elapsed between receipt by the International Bureau and receipt by the Office.

#### **Rule 1.13 – Use of languages for requests based on the Madrid Protocol**

As an exception to the provisions of Rule 3.3, the requests and petitions under the Madrid Protocol covered by this chapter may also be drawn up in English.

#### **Rule 1.14 - Transformation**

The request for registration referred to in Article 9quinquies of the Madrid Protocol shall be accompanied by a document in support of the cancellation of the international registration.

### **Chapter 3. Refusal and opposition**

#### **Rule 1.15 – Time limit for responding to refusal**

1. The time limit laid down in paragraph 3 of Article 2.11 and paragraph 2 of Article 2.13 of the Convention for responding to notification of provisional refusal shall be less than one month; this time limit may be extended *ex officio* and shall be extended on request, but may not exceed six months from the date the first communication was sent.
2. Where appropriate, an applicant objecting to provisional refusal shall,, within the time limit laid down in paragraph 1, also satisfy the conditions of rules 3.6 and 3.7.
3. The Office shall enforce without delay the court rulings referred to in paragraph 1 of Article 2.12 of the Convention, as soon as they are no longer subject to referral to a higher court of appeal.

#### **Rule 1.16 – Opposition elements**

1. An objection shall be lodged on the basis of a document which contains the following elements:
  - a. the claimant's name;
  - b. where appropriate, a statement that the claimant is acting as the licensee of the prior trademark;
  - c. references making it possible to identify the prior trademark;

- d. the goods or services of the prior trademark invoked, on which the objection is based. If such a reference is missing, the objection shall be presumed to be based on all of the goods and services covered by the prior trademark;
  - e. references making it possible to identify the trademark against which an objection has been lodged;
  - f. the goods or services against which the objection has been lodged. If such a reference is missing, the objection shall be presumed to be based on all of the goods and services covered by the trademark against which an objection has been lodged;
  - g. preferences concerning the use of languages.
2. Where appropriate, supporting documents establishing licensee capacity shall be transmitted.
  3. Where appropriate, the agent's name and address or the postal address covered by Rule 3.6 shall be mentioned in the document.
  4. The information covered by paragraph 1 (d) and (f) may be mentioned by indicating only the numbers of the classes of goods or services. The goods or services on which the objection is based or against which it has been lodged may be limited by the claimant, until the decision referred to in paragraph 1(i) of Rule 1.17 has been taken.

#### **Rule 1.17 – Conduct of the proceedings**

1. The objection shall be examined according to the following proceedings:
  - a. the Office shall decide in accordance with Rule 1.18 if the objection is admissible and shall inform the parties accordingly, or, in the case covered by Article 2.18 of the Convention, the claimant and the International Bureau;
  - b. the proceedings shall begin two months after notification of admissibility, provided that the fees due from the claimant have been paid in full. The Office shall notify the parties that the proceedings have begun;
  - c. the claimant shall be granted a time limit of two months as from the beginning of the proceedings covered by (b) to substantiate the objection with supporting arguments and documents and, where appropriate, to produce documents establishing the well-known nature of the prior trademark. Failing this, the objection shall be without further effect. The arguments introduced before the beginning of the proceedings shall be deemed to have been introduced at the beginning of the proceedings;
  - d. the Office shall send the claimant's arguments to the defendant and shall set a time limit of two months for the latter to respond in writing and request proof of use, as the case may be;
  - e. where appropriate, the claimant shall be given two months to produce proof of use or to justify that there are valid grounds for non-use in accordance with paragraph 2 of Article 2.26 of the Convention. If the trademark has only been used for part of the goods or services for which it was registered, the decision of the Office shall be based on the goods and services for which proof of use has been provided;

- f. if proof of use is produced, the Office shall forward it to the defendant, giving him two months to respond in writing to the proof of use and, if he has not yet done so in connection with the opportunity provided under (d), to the claimant's arguments;
  - g. if it deems it justified, the Office may ask one or more parties to submit additional arguments or supporting documents within a time limit set for this purpose;
  - h. oral proceedings may be organized in accordance with Rule 1.27;
  - i. the Office shall take a decision. If an objection which is based on several prior trademarks is admitted on the basis on one of these trademarks, the Office shall not rule on the other trademarks referred to.
2. Where appropriate, the defendant shall, within the time limit laid down in paragraph 1.d, appoint an agent or provide a postal address, as mentioned in Rule 3.6.

#### **Rule 1.18 - Conditions of admissibility**

1. An objection shall be admissible if it has been lodged within the time limit laid down in paragraph 1 of Article 2.14 or paragraph 1 of Article 2.18 of the Convention and satisfies the conditions set out in paragraph 1.a-f of Rule 1.16 of these Regulations, as well as paragraph 4 of Article 2.14 of the Convention.
2. The condition laid down in paragraph 4 of Article 2.14 of the Convention for determining the admissibility of an objection shall be satisfied if 40 per cent of the fees have been paid.
3. Without prejudice to the provision contained in the previous paragraph, the full amount due for lodging the objection may be paid when it is lodged. The previous paragraph shall not constitute dispensation from the obligation to pay the fee in full before the time limit laid down in paragraph 1.b of Rule 1.17.
4. If the objection is based on more trademarks than those for which the fees have been paid, the examination of the objection shall only take into consideration the trademarks for which the fees have been paid, following the order mentioned when the objection was lodged.
5. If the elements provided pursuant to paragraph 1.a and b. of Rule 1.16 do not correspond to the registered elements of a Benelux trademark invoked pursuant to paragraph 1.c. of Rule 1.16, the Office shall consider that the objection lodged is also a request to enter an amendment in the register. The provisions of Rule 3.1 shall apply, it being understood that the time limit set in paragraph 5 of Rule 3.1 shall be two weeks maximum.
6. If the validity of the Benelux trademark invoked expires before the end of the time limit for lodging an objection, the Office shall consider that the objection lodged also constitutes a request for renewal of the trademark. The provisions of Rule 1.10 shall apply, it being understood that the time limit set in paragraph 1 of Rule 1.10 shall be two weeks maximum.

#### **Rule 1.19 - Regularization of the objection**

1. Should the Office note that the document containing the objection does not satisfy conditions other than those provided for by Rule 1.18, it shall inform the claimant accordingly, inviting him to remedy the deficiencies noted within two months. If he fails to do so, the objection shall not have any further effect.



2. Should the Office note that supporting documents deposited by the parties other than those referred to in paragraph 1 do not satisfy the provisions of these Regulations, it shall inform the party concerned, inviting him to remedy the deficiencies noted within a time limit of two months. If he fails to do so, the supporting document in question shall be deemed not to have been submitted.
3. If the fees for the objection have not been paid in full when the objection-related proceedings begin, as provided for by paragraph 1.b. of Rule 1.17, no further action shall be taken with regard to the objection.

#### **Rule 1.20 – Language of the proceedings**

1. The language of the proceedings shall be one of the languages of the Office, namely Dutch or French. It shall be determined as follows:
  - a. the language of the proceedings shall be the language in which the defendant has filed. Nevertheless, if an international filing is involved, the language of the proceedings shall be the language of the Office chosen by the defendant within a period of one month from the date of notification of admissibility, and shall be French by default;
  - b. as an exception to what is stipulated under 1.a., the parties may, by mutual agreement, opt for the other language of the Office.
2. The choice of the language of the proceedings referred to in paragraph 1.b. shall be made as follows:
  - a. the claimant shall indicate in the objection application the language of the Office which he prefers as the language of the proceedings;
  - b. if the defendant accepts the claimant's choice of language, he shall inform the latter accordingly within a time limit of one month from the date of notification of the admissibility of the objection.
3. The Office shall inform the parties of the language of the proceedings.
4. The objection-related decision shall be drafted in the language of the proceedings.

#### **Rule 1.21 - Translation**

1. The determination of the language of the proceedings shall not affect the ability of the parties to use the other language of the Office in the opposition proceedings.
2. If one of the parties introduces arguments in the language of the Office that is not the language of the proceedings, the Office shall translate these arguments into the language of the proceedings, unless the opposing party does not wish a translation to be provided.
3. At the request of a party, the Office shall translate into the other language of the Office the arguments of the opposing party introduced in the language of the proceedings.
4. At the request of a party, the Office shall translate the objection-related decision into the other language of the Office.

5. Translation may be requested when the document containing the objection is submitted or in the defendant's communication referred to in paragraph 2.b. of Rule 1.20.
6. Without prejudice to rule 1.22, arguments which have not been introduced in one of the languages of the Office shall be deemed not to have been introduced.
7. If the arguments are translated by the Office pursuant to this Article, the document introduced in the original language shall be deemed authentic.

#### **Rule 1.22 – Use of English**

1. The determination of the language of the proceedings shall not affect the parties' ability to exchange arguments in English during the opposition proceedings, if they have jointly agreed to do so.
2. The joint choice of English shall be made as follows:
  - a. the claimant shall indicate when submitting the objection application that he wishes to express himself in English, if the defendant so agrees;
  - b. the defendant shall state in his communication provided for by paragraph 2.b of Rule 1.20 that he agrees to the use of English.
3. If the Office notes that English has been chosen jointly, it shall inform the parties accordingly.
4. Should English be chosen jointly:
  - a. the arguments introduced in another language shall be deemed not to have been introduced;
  - b. the Office shall not translate any of the parties' arguments.

#### **Rule 1.23 – Change in the choice of language**

1. The choices made pursuant to Rules 1.20 and 1.22 may be changed before the proceedings begin, following a joint request by the parties.
2. During the opposition proceedings, each party may inform the Office in writing that he no longer wishes to receive translations done by the Office, as provided for by Rule 1.21.

#### **Rule 1.24 – Language of the supporting documents utilized to substantiate arguments or use**

The provisions of Rules 1.20 to 1.23 do not preclude submission, in the original language, of the supporting documents utilized to substantiate arguments or use of a trademark. The Office shall only take such supporting documents into consideration if it deems that they are sufficiently understandable, in relation to the reason for which they were submitted.

#### **Rule 1.25 – Principle of due hearing of both parties**

Respect for the principle of due hearing of both parties, as mentioned in paragraph 1 of Article 2.16 of the Convention, shall in particular imply that:

- a. copies of all relevant supporting documents submitted to the Office by a party shall be forwarded to the other party, even if the objection is not admissible. If the arguments introduced are

translated by the Office pursuant to Rule 1.21, they shall be forwarded together with the translation;

- b. copies of all relevant supporting documents which the Office sends to one party shall be sent to the other party;
- c. the objection-related decision may only be based on grounds on which the parties have been able to express their views;
- d. the facts to which the opposing party has failed to respond shall be deemed to be undisputed;
- e. examination of the objection shall be limited to the arguments, facts and proof put forward by the parties;
- f. the objection-related decision shall be a written, reasoned statement and shall be forwarded to the parties.

### **Rule 1.26 - Suspension**

1. If the proceedings are suspended pursuant to paragraph 2 of Article 2.16 of the Convention, the Office shall inform the parties accordingly, indicating the grounds for suspension.
2. If there are no longer any grounds for suspension, the proceedings shall be resumed. The Office shall inform the parties accordingly, mention the operations to be carried out at that point in the proceedings and, where appropriate, extend the time limit to this end.
3. Suspension by joint request shall run for a period of two months and may be extended, each time for an identical period.
4. If the proceedings have begun, the suspension shall take effect when the Office receives the joint request. If the proceedings have not yet begun, the joint request for suspension shall be considered an extension of the two-month time limit following notification of admissibility, as stipulated in paragraph 1.b of Rule 1.17.
5. Before the proceedings have begun, suspension by joint request shall be free of charge during the first twelve months. A fee shall be due for the subsequent extension of suspension prior to the start of the proceedings, for suspension during the proceedings, and for extension of suspension. If this fee has not been paid by the time the request for suspension is submitted, the Office shall set a time limit of one month for payment. If payment is not made or is late, the proceedings shall resume, in accordance with paragraph 2.
6. Suspension of the objection-related proceedings shall not constitute dispensation, for the parties, from the obligations incumbent upon them under Rule 1.19.

### **Rule 1.27 – Oral proceedings**

1. Oral proceedings may be organized *ex officio* or at the request of the parties, if the Office deems it warranted.
2. Oral proceedings shall be conducted according to regulations set by the Director General.

### **Rule 1.28 – Multiple objections**

1. When several objections have been lodged against a trademark, the Office may decide, before the start of the proceedings, to take up one or more objections which, following a preliminary examination, seem to be the most likely to succeed. In this case, the Office may decide to postpone examination of the other objections. The Office shall inform the other claimants of any relevant decision taken with regard to the proceedings which have been resumed.
2. When the objection examined is found to be justified and this decision has become final, the deferred objections shall be deemed to have no further effect.

### **Rule 1.29 – Proof of use**

1. The supporting documents mentioned in paragraph 3(a) of Article 2.16 of the Convention, which are intended to prove use of the trademark shall be requested and produced according to the procedures provided for by paragraph 1.d-f of Rule 1.17.
2. Proof of use must include information as to the place, duration, scope and nature of the use made of the prior trademark for the goods and services on which the objection is based. The proof must demonstrate use during a period of five years prior to the date of publication of the trademark against which the objection has been lodged.
3. Such proof should preferably be limited to paper documents such as, packaging, labels, price lists, catalogues, invoices, photographs and newspaper advertisements. The cost of sending the supporting documents to the defendant shall be payable by the claimant if the total exceeds € 25.-.
4. The defendant may withdraw the request for proof of use or consider the proof supplied to be sufficient.
5. If the claimant does not request the return of the supporting documents submitted within two months after the objection-related decision has become final, the Office shall be authorized to destroy such documents. If the cost of returning the supporting documents exceeds € 25, it shall be borne by the claimant.

### **Rule 1.30 – Public nature of the objection-related decision**

The objection application and the objection-related decisions shall be public. The agreement of the parties shall be required to consult the arguments of the parties and any other supporting documents, whether presented orally or in writing.

### **Rule 1.31 – Contents of the objection-related decision**

The objection-related decision shall contain the following elements:

- a. the number of the objection;
- b. the date of the decision;
- c. the names of the parties and, where appropriate, their representatives;
- d. the references to the trademarks at issue;

- e. a summary of the facts and the conduct of the proceedings;
- f. where appropriate, an analysis of the proof of use;
- g. a comparison of the trademarks and the goods or services to which they relate;
- h. the decision of the Office;
- i. the decision relating to the costs;
- j. the names of the member who is the rapporteur of the Opposition Division and the two other members who took part in the decision;
- k. the name of the agent in charge of the administrative follow-up to the case.

#### **Rule 1.32 – Apportionment of objection-related costs**

1. The refund of the fees stipulated in paragraph 3 of Article 2.16 of the Convention shall be set at an amount equal to 60 per cent of the basic fee for the objection, if it occurs before the proceedings start, and an amount equal to 40 per cent of the basic fee if it occurs after the proceedings start.
2. No refund shall be made if, in accordance with the provisions of paragraph 2 of Rule 1.18, only 40 per cent of the fees due for the objection have been paid.
3. The costs referred to in paragraph 5 of Article 2.16 of the Convention shall be fixed at an amount equal to the basic fee for the objection.
4. For the translation as per Rule 1.21, payment set by the Director General shall be due from the party which has introduced arguments in a language of the Office other than the language of the proceedings or by the party which has requested translation into the language of the Office other than the language of the proceedings. The Director General shall also set payment for the translation of the objection-related decision and for interpretation in the case of oral proceedings.

#### **Rule 1.33 – Appeal**

The Office shall enforce without delay the court rulings covered by paragraph 1 of Article 2.17 of the Convention as soon as they are no longer subject to objection or referral to a higher court of appeal.

### **Chapter 4. Conversion of Community trademarks**

#### **Rule 1.34 – Conversion**

1. In the case of a petition covered by Article 110 of the Regulation on the Community trade mark, the applicant must:
  - a. pay the fees for Benelux filing;
  - b. produce a translation of the petition and the documents attached thereto in one of the languages of the Office;

- c. Choose a domicile in the European Community or the European Economic Area, in accordance with Rule 3.6.
2. The time limit for this purpose shall be at least one month. This time limit may be extended *ex officio* and shall be extended on request, but may not exceed six months from the date the first warning is sent. If the provisions are not satisfied within the allotted time limit, the documents received shall be without further effect.

## Title II: Designs

### Rule 2.1 – Conditions of filing

1. The Benelux filing of a design shall take place in French or Dutch, via the production of a document giving:
  - a. the applicant's name and address; if the applicant is a corporate body, its legal form shall be indicated;
  - b. the representation(s) of the aspect of the product;
  - c. an indication of the product in which the design is or will be incorporated;
  - d. an indication of the color or colors of the design; where appropriate, accompanied by the corresponding color code;
  - e. the signature of the applicant or his agent.
2. The document may also contain:
  - a. a description, in 150 words or less, of the characteristic elements of the new aspect of the product;
  - b. the name of the real creator of the design;
  - c. A request for deferred publication of registration, as provided for in Rule 2.5.
3. Where appropriate, the agent's name and address or the postal address referred to in Rule 3.6 shall be mentioned.
4. The product in which the design is or will be incorporated shall be designated in specific wording, preferably using the terms of the alphabetical list of International Classification, provided for by the Locarno Agreement of October 8, 1968 Establishing an International Classification for Industrial Designs.

### Rule 2.2 – Multiple filing

A single Benelux filing may cover several designs, up to a total of 50. In this case, the provisions of paragraph 1.b, c and d, and paragraphs 2 and 4 of Rule 2.1 shall apply for each design. Each design must further bear a separate number.

### **Rule 2.3 – Setting of a filing date and a time limit for regularization**

1. The conditions laid down in paragraph 1 of Article 3.9 of the Convention for setting a filing date shall be those provided for by paragraph 1.a, b and c of Rule 2.1, provided that the filing fees are paid within one month after the above-mentioned conditions have been satisfied.
2. The time limit referred to in paragraph 2 of Article 3.9 of the Convention for satisfying the other conditions shall be at least one month. This time limit may be extended *ex officio* and shall be extended on request, but may not exceed six months from the date the first warning was sent.
3. In the case of multiple filings, paragraph 3 of Article 3.9 of the Convention shall apply only to non-regularized designs.

### **Rule 2.4 – Claiming priority**

1. If a right of priority as referred to in Article 3.10 of the Convention is claimed at the time of filing, the country, date, number and holder of the filing on which this right of priority is based shall be indicated. If the applicant in the country of origin is not the party who has made the Benelux filing, the latter shall attach a certificate of beneficiary.
2. The special declaration of right of priority mentioned in Article 3.10 of the Convention shall contain the name and address of the applicant, his signature or that of his agent, and where appropriate, the agent's name and address or the postal address referred to in Rule 3.6, an indication of the design and the information mentioned in paragraph 1.
3. An applicant claiming a right of priority shall present a copy of the documents providing entitlement to such a right.
4. If the conditions of paragraphs 1, 2 and 3 and those of Rules 3.3 and 3.6 are not satisfied, the Office shall inform the party concerned without delay, setting a time limit of one month for compliance. This time limit may be extended *ex officio* and shall be extended on request, but may not exceed six months from the date the first warning was sent. Failure to respond within the time limit shall cause the right of priority to lapse.

### **Rule 2.5 – Deferment of publication**

1. An applicant seeking deferred publication of registration shall make the corresponding request at the time of filing, indicating the period for which the deferment is requested.
2. Deferred publication of registration for a multiple filing may only be requested for the body of designs and for the same period.
3. If an applicant who has requested deferred publication of registration of a multiple filing informs the Office at the end of the period of deferment that he only wishes part of the designs to be published, he shall indicate the numbers of the designs he wishes to be published.
4. An applicant may at any time request that the period of deferment be terminated.

### **Rule 2.6 – Request for another publication**

The time limit mentioned in paragraph 3 of Article 3.11 of the Convention, during which the applicant may request the Office to make another publication of the design, shall be three months from the date of first publication.

### **Rule 2.7 – Registration**

1. The Office shall register the filing by mentioning:
  - a. the registration number;
  - b. the filing date and number;
  - c. the information referred to in Rule 2.1;
  - d. where appropriate, the right of priority claimed, indicating the country, the date, the number and the holder of the filing on which the right of priority claimed is based, in accordance with paragraph 1 of Rule 2.4;
  - e. in the case of deferred publication of registration, the information referred to in paragraph 1 of Rule 2.5;
  - f. the date of expiry of the registration;
  - g. the number of the class and the sub-class of the international classification, provided for by the Locarno Agreement, under which the product in which the design is or will be incorporated has been placed;
  - h. the registration date.
2. The date on which the Office has established that the filing satisfies all of the conditions laid down in the Convention and the present regulations shall be deemed to be the registration date.
3. A certificate of registration shall be sent without delay to the holder by the Office.

### **Rule 2.8 - Registration date for international filings**

The publication date referred to in paragraph 1 of Article 3.11 of the Convention shall be deemed to be the registration date for international filings of designs.

### **Rule 2.9 – Registration of maintenance in a modified form**

A request for registration of partial renunciation by the holder or the court order referred to in paragraph 3 of Article 3.24 of the Convention shall be addressed to the Office and shall include the name and address of the holder, his signature or that of his agent, and where appropriate, the agent's name and address or the postal address referred to in Rule 3.6, as well as the registration number.

### **Rule 2.10 – Registration of the action to claim the filing and cancellation of such registration**

1. A request for registration of the action to claim the filing referred to in paragraph 1 of Article 3.7 of the Convention shall include the name and address of the applicant, his signature or that of his



agent, and, where appropriate, the agent's name and address or the postal address referred to in Rule 3.6, as well as the holder's name and address and the registration number of the Benelux or international filing of the design.

2. Registration of the action to claim the filing referred to in paragraph 1 of Article 3.7 of the Convention shall be cancelled at the request of the most diligent party if such a party produces either a court order which is no longer subject to appeal or referral to a higher court of appeal, or a document proving that the action has been withdrawn.

#### **Rule 2.11 - Renewal**

Renewal of registration shall be effected solely by payment to the Office of the fee specified for that purpose. However, if the holder of a multiple filing wishes to avail himself of the possibility offered by paragraph 4 of Article 3.14 of the Convention, he shall indicate the numbers of the designs for which he wishes to renew registration.

#### **Rule 2.12 – Registration of renewal**

1. The Office shall register renewals by adding the renewal date and the registration's date of expiry to the registration.
2. The Office shall send the holder a certificate of renewal of registration without delay.

### **Title III: Provisions Common to Trademarks and Designs**

#### **Chapter 1. Amendment of registrations**

##### **Rule 3.1 – Amendments to the register**

1. Any request for amendments to the Benelux register relating to a Benelux filing or registration shall be addressed to the Office and shall contain the registration number, the name and address of the right holder, his signature or that of his agent and, where appropriate, the agent's name and address or the postal address referred to in Rule 3.6. Where appropriate, the request shall be accompanied by a supporting document.
2. If such a request relating to the registration of a multiple filing of designs does not concern all of the designs, it shall indicate the numbers of the designs involved. If the assignment or other transfer relates to exclusive rights to one or more designs which are part of a multiple filing, this part shall henceforth be considered a separate filing.
3. Cancellation of registration of a right of pledge or attachment shall be carried out on the basis of a supporting document.
4. Producing a copy of the act establishing an assignment or other transfer, a licence or a right of pledge as mentioned in Articles 2.33 and 3.27 of the Convention may suffice. If the Office has reason to doubt the accuracy of the amendment requested, it may request other information, in particular the submission of original documents or certified copies of such documents.

5. If it is not satisfied with the provisions of these regulations relating to a request covered by this Rule or if the fees and payments due have not been paid at all or in full, the Office shall inform the party concerned without delay. Without prejudice to the provisions of paragraph 5 of Rule 1.18, it shall set a time limit of at least one month for compliance. This time limit may be extended *ex officio* and shall be extended on request, but may not exceed six months from the date the first warning was sent. If the prescribed conditions are not satisfied within the time limit set, the documents received shall have no further effect.

## **Chapter 2. International filing**

### **Rule 3.2 – International filing with an extension in Benelux**

1. With regard to international filings in respect of which applicants have requested extension of protection to Benelux territory, the Office shall register the notifications of the International Bureau provided for in Article 2.10 and 4.4 of the Convention, without prejudice to the application of Rules 1.8 and 2.8.
2. If the international filing of a collective trademark is not accompanied by regulations for use and control, the Office shall inform the applicant without delay of his obligation to produce such regulations within the time limit provided for in paragraph 2 of Article 2.36 of the Convention. For collective trademarks the register shall mention the production, lack of production and amendments to regulations for use and control.
3. In addition, and to the extent to which it relates to the Benelux territory, the register shall mention information concerning decisions regarding cancellation or lapse as well as licenses, rights of pledge and attachment for designs.
4. Rule 3.1 shall apply to the registration of the information covered by paragraph 3.

## **Chapter 3. Administrative provisions**

### **Rule 3.3 – Languages of the Office**

1. The languages of the Office shall be Dutch and French.
2. All documents forwarded to the Office shall be drawn up in either of these languages. The provisions of Rules 1.22 and 1.24 shall constitute an exception in this respect.
3. Supporting documents for a right of priority, a change of name, extracts from documents establishing assignment or another form of transfer, a license or a right of pledge, declarations relating thereto, regulations for use and control and amendments thereto drawn up in another language shall also be accepted if they are presented in English or German.
4. The documents which are referred to in paragraph 3 and which have been drawn up in another language shall also be accepted if they are accompanied by a translation into one of the languages of the Office or English or German.

### **Rule 3.4 – Forwarding of documents**

1. Documents to be forwarded to the Office or to the national administrations may be sent by mail or fax; they may also be forwarded electronically, in accordance with the provisions of Rule 3.5.
2. When a document which has been produced with a view to its entry in the Benelux register or the register of international registrations maintained by the International Office has been signed by a corporate body, the signatory shall indicate its name and capacity.

### **Rule 3.5 – Electronic transmission**

1. The transmission of filings, international registration applications, petitions for amendments to the register, requests for the renewal of registration and objection-related proceedings may also be done electronically. Such operations shall comply with the Rules set by the Director General.
2. The documents, supporting documents and annexes accompanying the operations referred to in paragraph 1 shall also satisfy the relevant provisions laid down by the Director General. Any transmission by electronic means that does not comply with the above-mentioned provisions shall be deemed not to have been received by the Office.

### **Rule 3.6 – Appointment of an agent**

1. All operations concerning the Office or a national authority may be carried out by a representative acting as an agent.
2. Such an agent shall have a domicile or a head office in the European Community or the European Economic Area.
3. All communications concerning these operations shall be addressed to the agent.
4. Any person who has neither a head office nor a domicile in the European Community or the European Economic Area and has not appointed an agent shall provide a postal address in this territory.

### **Rule 3.7 - Powers**

1. Any person claiming to be acting as a representative of an interested person for the conduct of an operation with the Office shall be presumed to have been authorized to do so by the interested person.
2. When a representative asks the Office to cancel a registration, he shall submit a power of attorney issued to that end.
3. If the Office has reason to doubt a representative's authorization, regardless of the operation, it may request the submission of a power of attorney. The time limit for submitting such power shall be one month. This time limit may be extended by one month on request. In the case of failure to respond within the time limit set, the request shall remain without further effect.

### **Rule 3.8 - Confirmation of receipt of documents**

1. The Office shall acknowledge receipt of all documents intended for entry in the Benelux register or in the register of international registrations kept by the International Bureau.

2. Upon receipt by the competent authority, all documents shall be dated, indicating the time, day, month and year of receipt.
3. The Office shall record the dispatching and receipt of documents. Such recording shall, unless there is evidence to the contrary, constitute proof of dispatching and receipt as well as the time when these operations took place.

### **Rule 3.9 – Time limits and public holidays**

1. The time limits provided for in these Regulations and expressed in months shall start from the day on which the event is deemed to take place and shall expire, in the month to be taken into consideration and on the day corresponding to the day on which the time limit began to run; however, if the month to be taken into consideration does not have a corresponding day, the time limit shall expire on the last day of the month.
2. The time limits provided for in these regulations and expressed in weeks shall start from the day on which the event considered takes place and shall expire, in the week to be taken into consideration and on the day corresponding to the day on which the time limit began.
3. If the service of the competent authority is closed on the last day before a time limit provided for in the Convention or these regulations, such time limit shall be extended until the end of the first opening day of this service.
4. If normal postal delivery in one of the Benelux countries is disrupted on at least one out of the five working days prior to the expiry of the time limit provided for in paragraphs 1 and 2 of Rule 1.3, paragraph 4 of Rule 1.4, paragraph 1 of Rule 1.10, paragraphs 1 and 2 of Rule 2.3, paragraph 4 of Rule 2.4, and paragraph 5 of Rule 3.1, and the time limits provided for in Chapter 3 of Title I, supporting documents received by the competent authority after expiry of the time limits set under the above-mentioned articles may be handled by this authority as though they had been introduced within the time limits set, provided that it can be reasonably accepted that the disruption of normal postal delivery was the reason why the supporting documents were received after the above-mentioned time limits had expired.

### **Rule 3.10 – Information and copies**

1. On the basis of the Benelux register, the Office shall provide the interested parties with information and copies. The national authorities, acting in the name of and on behalf of the Office, shall supply the same information and copies, provided they have access thereto.
2. The register may be consulted on the terms set by the Director General or in the form of a subscription, the terms of which are set by the Director General.
3. The documents providing entitlement to the right of priority provided for in D.3 of Article 4 of the Paris Convention shall be forwarded to the interested parties by the Office or, as the case may be, by the national administrations. Such documents may only be issued if the filing date were set in accordance with the provisions of paragraph 1 of Rule 1.3 and paragraph 1 of Rule 2.3.

### **Rule 3.11 – Provision of forms**

The Office and the national authorities shall make available to interested parties forms for making international and Benelux filings, registration of amendments to the register and requests for renewal

and objections. The Director General shall decide on the corresponding model forms which shall be published on the Office's Internet site.

### **Rule 3.12 – Benelux Register**

1. The Benelux Register shall comprise two parts:
  - a. The Register of Benelux filings;
  - b. The Register of international filings.
2. The Benelux Register and documents produced as proof of the entries registered may be consulted free of charge at the Office.
3. The Benelux Register may also be consulted free of charge via the Belgian and Luxembourg national administrations.

### **Rule 3.13 - Publication**

The Office shall publish, in accordance with the provisions of Article 4.4(b) of the Convention and drafted solely in the language of registration:

- a. all of the indications registered relating to Benelux filings, provided for in Rules 1.5, 1.6, 1.7, 1.11, 2.7, 2.12 and 3.1. In the case of limited renewal of the registration of a multiple filing of designs, publication of such renewal shall mention the numbers of the designs maintained;
- b. all of the indications registered relating to the international filings of trademarks, provided for in paragraph 2 of rule 1.8;
- c. all of the indications registered relating to the international filings of designs, provided for in paragraph 3 of Rule 3.2;
- d. registration of the partial renunciation or the court order provided for in Rule 2.9;
- e. registration of the action to claim provided for in Rule 2.10.

### **Rule 3.14 – Additional rules**

The Director General may set additional rules for filing documents with the Office. Such rules shall be published.

## **Title IV: Fees**

### **Chapter 1. General remarks**

#### **Rule 4.1 – Fee setting**

1. Pursuant to paragraph 1 of Article 1.13 of the Convention, the Office shall pay the national authorities 20 per cent of the amount of the fees charged for operations conducted through them.

2. The Executive Board shall set fees. It may only adjust fees set once a year.
3. Article 6.5 of the Convention shall apply to the publication of new fees.

#### **Rule 4.2 - Payment**

1. Fees due shall be paid before the Office carries out operations.
2. After receiving a request that is subject to fees, the Office shall send an invoice for fees due. Failure to send or receive such an invoice shall have no legal effect.

#### **Rule 4.3 – Fees charged for occasional operations**

1. The fees for the operations provided for in the Convention and these regulations to be carried out by and with the Office shall be those listed under this title.
2. The Director General shall set fees for so-called occasional operations to be carried out by and with the Office, which are not provided for under this title.
3. The Director General shall brief the Executive Board on fees for operations of a more structural nature. The Executive Board may decide to include such fees under this title.

### **Chapter 2. Trademarks**

#### **Rule 4.4 – Fees for filing, renewal and amendment**

1. Filing of a trademark:
  - a. basic fee individual trademark, up to 3 classes (Rule 1.1) 240
  - b. basic fee collective trademark, up to 3 classes (Rule 1.2) 373
  - c. additional fee for each class in addition to the third 37
  - d. additional fee for expedited registration, up to 3 classes (Rule 1.7) 193
  - e. additional fee for expedited registration by class in addition to the third 30
  - f. additional fee for the description of distinctive elements (Rule 1.1, para 2) 39
  - g. registration of declaration of a right of priority (Rule 1.4, para 2) 15
2. Objections (Rules 1.16 ff.)
  - a. basic fee for objections 1000
  - b. additional fee per right invoked in addition to the third 100
  - c. suspension on request and its extension before proceedings begin (one year maximum) (Rule 1.26) free

d. suspension on request and its extension in other cases, by two months (Rule 1.26)	100
e. translation of arguments (Rule 1.21)	
first four pages*	free
each page or part of a page* in addition to the fourth	55
f. Translation of the decision, by page* or part of a page (Rule 1.21)	45
* One page: 30 lines maximum of 80 characters maximum.	
3. Renewal of trademarks (Rule 1.9)	
a. Basic fee individual trademark, up to 3 classes	260
b. Basic fee collective trademark, up to 3 classes	474
c. Additional fee per class in addition to the third	46
d. Additional fee for renewal during the six months following the expiry date (Article 2.9, para 4 of the Convention)	129
4. Amendments (Rule 3.1)	
a. Assignment or other transfer, license, right of pledge or attachment	
first trademark	54
second to fifth trademark	27
each following trademark	free
b. Entry relating to the limit on goods and services	44
c. Change of agent, including his appointment following registration of the filing	
first trademark	22
second to fifth trademarks	11
each following trademark	free
d. Change in the name or address of a holder, agent or licensee	free
e. Post-registration correction of slips of the pen attributable to the holder	
first trademark	18
each following trademark	9

#### **Rule 4.5 – Other fees (trademarks)**

1. Prior art search:	
a. Basic examination fee, up to 3 classes	150
b. Additional fee per class in addition to the third	20
2. Annual subscription for prior trademarks:	
a. Basic subscription fee, up to 3 classes	50
b. Additional fee per class in addition to the third	8

3. Copies:	
a. Non-certified, by registration	4
b. Non-certified, others by page	5
c. Certified, by registration	15
d. Certified, others by page	17
e. Priority documents (Rule 3.10)	15
4. Information:	
a. Less than one hour	23
b. More than one hour, by hour	55

#### **Rule 4.6 - Transmission of international and Community trademarks**

1. International trademark; introduction of a request for registration or renewal	80
2. Community trademark (para 2, Article 25 of the Regulations on Community trademarks):	
a. introduction of the request	80
b. if postage is more than €25	postage

#### **Rule 4.7 – Individual fees for international trademarks**

The amount of the individual fee provided for in Article 8.7(a) of the Madrid Protocol shall be set as follows:

1. International filing:	
a. basic fee individual trademark, up to 3 classes	159
b. basic fee collective trademark, up to 3 classes	227
c. additional fee per class in addition to the third	16
2. Renewal of international registration:	
a. basic fee individual trademark, up to 3 classes	260
b. basic fee collective trademark, up to 3 classes	474
c. additional fee per class in addition to the third	46

### **Chapter 3. Designs**

#### **Rule 4.8 – Fees for filing, renewal and amendments**

1. Single filing of a design (Rule 2.1):	
a. single filing	108
b. publication by representation	10
c. publication by description of characteristic elements	40
2. Multiple filing (Rule 2.2):	
a. filing of first design	108
b. 2nd to 10th design, by design	54
c. 11th to 20th design, by design	27
d. 21st to 50th design, by design	22
e. publication by representation	10
f. publication by description of characteristic elements by design	40



3. Deferment of publication (Rule 2.5)	39
4. Registration of the declaration of a right of priority (para 2, Rule 2.4)	12
5. Renewal of a single registration (Rule 2.11)	95
6. Renewal of a multiple registration (Rule 2.11):	
a. Renewal of the 1st design	95
b. 2nd to 10th design, by design	48
c. 11th to 20th design, by design	24
d. 21st to 50th design, by design	20
7. Additional fee for renewal during the six months following expiry (Article 3.14, para 3 of the Convention)	12
8. Amendments (Rule 3.1):	
a. assignment or transfer, license, right of pledge or attachment	
first design	24
each following design	12
b. change of agent, including appointment after registration of filing	
first design	9
each following design	5
c. change of name and/or address of a holder, agent or licensee	free
d. post-registration correction of slips of the pen attributable to the owner	
first design	9
each following design	5
e. registration of an action to claim (Rule 2.10)	12

#### **Rule 4.9 – Other fees (designs)**

1. Copies:	
a. non-certified, by registration	4
b. non-certified, others by page	2
c. certified, by registration	18
d. certified, others by page	5
e. priority documents (Rule 3.10)	12
2. Information:	
a. less than one hour	17
b. more than one hour, by hour	30
3. Compendium of Benelux Designs (CD-ROM edition):	
a. on Benelux territory, by fascicle	8
b. on Benelux territory, annual subscription	79
c. outside Benelux territory, by fascicle	9
b. outside Benelux territory, annual subscription	87

#### **Rule 4.10 – Amendments to international designs**

Entry of a license, right of pledge or attachment for international designs	
a. first design	24
b. each following design	12

## Rule 4.11 - Transmission of a Community design

Community design:

- a. introduction of a request (paragraph 2 of Article 35 of the Regulation on Community designs) 71
- b. if postage is more than €25 postage

## Chapter 4. Other services

### Rule 4.12 - i-filing

I-filing envelope:

- a. period of conservation five years 45
- b. period of conservation ten years 65
- c. five-year extension of the period of conservation 45

### **Article II**

The additional fee laid down in paragraph 1(e) of Rule 4.4 shall be due as from January 1, 2007.

### **Article III**

The Implementing Regulations of the Benelux Uniform Law on Trademarks and the Implementing Regulations of the Benelux Uniform Law on Designs are hereby repealed.

### **Article IV**

These regulations shall enter into force on the same date as the Benelux Convention on Intellectual Property (Trademarks and Designs). These regulations shall replace the Implementing Regulations of the Benelux Uniform Law on Trademarks and the Implementing Regulations of the Benelux Uniform Law on Designs.

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\* Translation by the International Bureau of WIPO