

**Benelux Convention on Intellectual Property  
(trademarks and designs)<sup>1</sup>**

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<sup>1</sup> This is the text of the BCIP as lastly amended by the Protocol of 22.07.2010. Entry into force: 01.10.2013. The official text of the BCIP is in French and Dutch. This English translation is provided by BOIP for information purposes. BOIP is not responsible for typing or translation errors.

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 design law;
- provide quick and effective procedures that 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 mission 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 closer to undertakings 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 a right of evaluation and initiative in respect of the adaptation of Benelux legislation 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;
- Community Trade Mark Regulation: Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark;
- Community Design Regulation: Council Regulation (EC) No 6/2002 of 12 December 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 Office for Intellectual Property (trademarks and designs), hereinafter referred to as "the Executive Board";
  - c. the Benelux Office for Intellectual Property (trademarks and designs), hereinafter referred to as "the Office".

### Article 1.3 Objectives

The Organization shall be responsible for:

- a. the execution of this convention and the implementing regulations;
- b. promoting the protection of trademarks and designs in the 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 legislation on trademarks and designs in the light of international, Community and other developments.

### Article 1.4 Legal personality

1. The Organization shall have international legal personality with a view to performance of the mission

entrusted to it.

2. The Organization shall have 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 located 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 accomplishment of the Organization’s tasks and the fulfilment 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 make 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 of 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 necessary 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 establish the implementing regulations.
3. It shall establish 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, including administrative steps, to ensure that the tasks of the Office are properly performed.
3. He shall execute 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 execute the budget and draw up the annual accounts.
6. He shall take all other steps that 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 administrations

1. A percentage of the fees collected in respect of operations performed through the national administrations shall be distributed to the said administrations 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 extract of the order resulting from it meets the conditions regarding its authenticity;

b. the decision is no longer open to opposition or appeal or to reversal by a court of cassation.

#### Article 1.15 Benelux Court of Justice

The Benelux Court of Justice as mentioned in Article 1 of the Treaty concerning 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 that may constitute a Benelux trademark

1. The names, drawings, imprints, stamps, letters, numerals, shapes of goods or packaging and all other signs that can be represented graphically and that serve to distinguish the goods or services of an undertaking shall be considered as being individual trademarks.
2. However, signs consisting solely of a shape which results from the nature of the goods, which gives a substantial value to the goods or which is necessary to obtain a technical result cannot be considered as being trademarks.
3. Without prejudice to the provisions of ordinary law, a patronymic name may serve as a trademark.

#### Article 2.2 Acquisition of the right

Without prejudice to the right of priority provided for by the Paris Convention or the TRIPS Agreement, the exclusive right in a trademark shall be acquired by registration of the trademark that has been filed in Benelux territory (Benelux filing) or results 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 on the part of the public a likelihood of confusion that includes the likelihood 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, irrespective of the use being made thereof, is contrary to accepted principles of morality or to public policy in one of the Benelux countries, or in respect of which article 6ter of the Paris Convention provides for refusal or invalidation;
- b. the registration of a trademark which is of such a nature as to deceive the public, for instance with regard to the nature, quality or geographical origin of the goods or services;
- c. the registration of a trademark that is similar to 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 that is similar to 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 nonconsenting third party;

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

1°. a filing in the knowledge 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°. a filing in the 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 has made of the trademark on Benelux territory;

g. the registration of trademarks for wines containing geographical indications to designate wines or that consist of such indications, or the registration of trademarks for spirits containing geographical indications to designate spirits or that consist of such indications in respect of wines or spirits that do not have such origin, unless the filing that led to such registration was made in good faith before 1 January 2000 or before the geographical indication concerned was protected in the country of origin or in the Community.

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

### Article 2.5 Filing

1. A Benelux application for trademarks shall be filed, either with the national administrations 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 the documents produced satisfy the conditions specified for fixing the filing date and the filing date shall be fixed. The applicant shall be informed, without delay and in writing, of the date of filing or, where applicable, of the grounds for not fixing a filing date.

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. The application 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 administration, the national administration shall forward the Benelux application to the Office, either without delay after receiving the application or after establishing that the application satisfies the specified conditions.

5. The Office shall publish the application, in accordance with the provisions of the implementing regulations, when the conditions for fixing 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 provided for by 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 in the month following filing, 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.



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

#### Article 2.7 Search

1. The Office may offer a search for prior registrations as a service.
2. The Director General will determine the modalities thereof.

#### Article 2.8 Registration

1. Without prejudice to the application of Articles 2.11, 2.14 and 2.16, the filed trademark is registered for the goods or services indicated by the applicant if the requirements set out in the implementing regulations are met. The trademark holder is issued with a certificate of registration.
2. If all the requirements referred to in Article 2.5 have been met, the applicant may request the Office to proceed with the registration of the trademark without delay in accordance with the provisions of the implementing regulations. Articles 2.11, 2.12, 2.14, 2.16 and 2.17 apply to trademarks registered like this, on the understanding that the Office is authorised to decide to cancel the registration and the trademark holder can 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. The registration may be renewed for further periods of 10 years.
4. Renewal will take place upon payment of the fee determined for the purpose of renewal. The fee should be paid during the six months preceding expiry of the registration; the fee may still be paid within six months after the expiry date of the registration, if an additional fee is paid simultaneously. Renewal will take effect upon the date 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 holder of the trademark.
6. Reminders shall be sent to the last address of the holder 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 holder 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, in its opinion:
  - a. the sign cannot constitute a trademark pursuant to Article 2.1 (1) and (2);
  - b. the trademark is devoid of any distinctive character;
  - c. the trademark consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or performance of the service, or other characteristics of the goods or services;
  - d. the trademark consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
  - e. it is a trademark as referred to in Article 2.4 (a), (b) or (g).
2. Refusal to register a trademark must relate to the sign that constitutes a trademark as a whole. It may be restricted to one or more of the goods or services for which the trademark is intended.
3. The Office shall notify the applicant without delay, in writing and stating reasons, of its intention to wholly or partially refuse registration and shall allow the applicant to respond to such notification within a period laid down in the implementing regulations.
4. If the Office's objections to the registration are not resolved within such period, the registration of the trademark shall be wholly or partially refused. The Office shall notify the applicant of its refusal without delay, in writing, stating the grounds for refusal and mentioning the legal remedies against this decision as provided for by article 2.12.
5. The refusal shall not become final until such time as the decision is no longer open to appeal or, if applicable, until the decision of the court of appeal is no longer open to reversal by a court of cassation.

#### Article 2.12 Appeal against refusal

1. Within two months following the notification referred to in Article 2.11 (4), the applicant may lodge a request with the Brussels Cour d'appel, the The Hague Gerechtshof, or the Luxembourg Cour d'appel for an order to register the trademark.
2. In connection with these proceedings, the Office may be represented by a member of staff appointed for this purpose.
3. The court having territorial jurisdiction shall be determined by the address of the applicant or the address of its representative or by the correspondence address as indicated in the application. If neither the applicant nor its representative has an address or correspondence address within the Benelux territory, the competent court shall be that chosen by the applicant.
4. The decision of the appeal court shall be open to referral to a court of cassation, which shall have suspensive 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 as soon as possible of its intention to refuse registration, in writing and stating reasons, by means of a provisional total or partial refusal of protection for the trademark, at the same time allowing the applicant the opportunity to respond to said notice in accordance with the provisions of 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 address of the representative or by the correspondence address. If neither of these two addresses is on Benelux territory, the court having jurisdiction shall be that chosen by the applicant.
4. The Office shall inform the International Bureau without delay, in writing and stating reasons, of a decision that is no longer open to appeal.

## **Chapter 4. Opposition**

### Article 2.14 Initiation of the procedure

1. The applicant or holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from publication of the application, 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 holder:
3. Opposition may be based on one or more prior trademarks.
4. An opposition shall not be deemed to have been entered until the fees due have been paid.

### Article 2.15

*Repealed*

### Article 2.16 Course of the proceedings

1. The Office shall deal with an opposition within a reasonable timeframe in accordance with the provisions laid down in the implementing regulations and shall respect the principle that both sides should be heard.
2. The opposition proceedings shall be suspended:
  - a. where the opposition is based on an application for a trademark;
  - b. where an action is brought with a view to a declaration of invalidity or revocation;
  - 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 opponent 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 revoked due to the lack of genuine use of the trademark, without a proper reason, within the meaning of this Convention or in relevant cases the Community Trade Mark Regulation;

b. where the defendant does not react to the opposition lodged. In this case the defendant shall be deemed to have renounced its rights concerning the application;

c. where the opposition has become without cause, either because it has been withdrawn or because the application against which the opposition is directed has come to be without effect;

d. where the prior trademark is no longer valid.

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

4. After examination of the opposition is completed, the Office shall reach a decision as soon as possible. If the opposition is held to be justified, the Office shall refuse to register the trademark in whole or in part. Otherwise, the opposition shall be rejected. The Office's decision shall only become final when it is no longer open to appeal or, if applicable, until the decision of the court of appeal is no longer open to reversal by a court of cassation.

5. Costs shall be borne by the losing party. They shall be fixed in accordance with the provisions of the implementing regulations. Costs shall not be due if the opposition is partly successful. The Office's decision concerning costs shall constitute an enforceable order. Its forced execution shall be governed by the rules in force in the State where it takes place.

#### Article 2.17 Appeal

1. Within two months following a decision on an opposition in accordance with Article 2.16 (4), the parties may lodge a request with the Brussels Cour d'appel, the The Hague Gerechtshof, or the Luxembourg Cour d'appel 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 representative or by the correspondence address as indicated in the application. If none of these addresses is located on Benelux territory, the court having territorial jurisdiction shall be determined by the address of the opponent or its representative. If neither the opponent nor its representative has an address or correspondence address on Benelux territory, the competent court shall be the court chosen by the party lodging the appeal.

3. The decision of the appeal court shall be open to referral to a court of cassation, which shall have suspensive effect.

#### Article 2.18 Opposition to international filings

1. During a period of two months to be calculated from publication by the International Bureau, an opposition may be submitted with the Office against an international filing for which 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 submitted opposition 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, in writing and stating reasons, of a decision that is no longer open to appeal.

### **Chapter 5. Rights of the holder**

#### Article 2.19 Obligation to register

1. With the exception of the holder 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 protection for 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 holder 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 its holder to prohibit any third party, without its consent, from:

a. using in the course of trade 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 the course of trade a sign in respect of which, because it is identical or similar to the trademark and the goods or services covered by the trademark and the sign are identical or similar, there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the trademark;

c. using in the course of trade 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, 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 trademark or a similar sign shall mean in particular:

a. affixing the sign to the goods or to the packaging thereof;

b. offering the goods, or putting them on the market or stocking them for these purposes under, or offering or supplying services under the sign;

c. importing or exporting goods under the sign;

d. using the sign on business papers and in 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 to a trademark expressed in one of the national or regional languages of the Benelux territory extends automatically to its translation into another of those languages. Evaluation of the similarity arising from translations into one or more languages foreign to the aforesaid territory shall be a matter for the courts.

#### Article 2.21 Compensation for damages and other actions

1. Subject to the same conditions as in Article 2.20 (1), the exclusive right in a trademark shall allow its holder to claim compensation for any prejudice which he has suffered following use within the meaning of that provision.

2. The court which sets the damages:

a. shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any unfair profits made by the infringer and, in appropriate cases, elements other than economic factors, such as the moral prejudice caused to the holder of the trademark as a result of the infringement; or

b. as an alternative to (a), it may, in appropriate cases, set the damages as a lump sum on the basis of elements such as at least the amount of royalties or fees which would have been due if the infringer had requested authorization to use the trademark.

3. Furthermore, the court may order, at the request of the holder of a trademark and by way of compensation, that ownership of goods which infringe a trademark right, as well as, in appropriate cases, the materials and implements principally used in the manufacture of those goods, be transferred to the holder of the trademark; the court may order that the transfer shall only take place upon payment by the claimant of a sum which it shall fix.

4. In addition to or instead of the action for compensation, the holder of a trademark may institute proceedings for transfer of the profits made following the use referred to in Article 2.20 (1), and for the provision 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.

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

6. The holder 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 date of publication of the filing and the date of registration of the trademark, insofar as the holder of the trademark has acquired exclusive rights in this regard.

#### Article 2.22 Additional claims

1. Without prejudice to any damages due to the holder of a trademark by reason of the infringement, and without compensation of any sort, the courts may order, at the request of the holder of a trademark, the recall from the channels of commerce, the definitive removal from the channels of commerce or the destruction of goods which infringe a trademark right, as well as, in appropriate cases, materials and implements principally used in the manufacture of those goods. Those measures shall be carried out at the expense of the infringer, unless there particular reasons for not doing so. In considering a request as referred to in this paragraph, the proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.

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

3. Insofar as not provided for by national law and at the request of the holder of a trademark, the courts may, under this provision, issue an interlocutory injunction against the alleged infringer or against an intermediary whose services are used by a third party to infringe a trademark right, in order to:

a. prevent any imminent infringement of a trademark right, or

b. forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment, the continuation of the alleged infringements of a trademark right, or

c. make continuation of the alleged infringements subject to the lodging of guarantees intended to ensure the compensation of the holder of the trademark.

4. At the request of the holder of a trademark in proceedings concerning an infringement of his rights, the courts may order the party infringing the holder's right to provide the holder with all information available concerning the origin and distribution networks of the goods and services which have

infringed the trademark and to provide him with all the data relating thereto, insofar as this measure seems justified and proportionate.

5. The order referred to in paragraph 4 may also be issued against anyone who is in possession of the infringing goods on a commercial scale, who has used the infringing services on a commercial scale or who has provided, on a commercial scale, services used in infringing activities.

6. The courts may, at the request of the holder of a trademark, issue an injunction for the cessation of services against intermediaries whose services are used by a third party to infringe its trademark right.

7. The courts may order, at the request of the claimant and at the expense of the infringer, that appropriate measures be taken to disseminate information concerning the decision.

#### Article 2.23 Limitation of the effects of the exclusive right

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

a. its name and address;

b. indications concerning the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or rendering of the service or other characteristics of the goods or services;

c. the trademark, where it is necessary to indicate the intended purpose of a product or service, in particular as an accessory or spare part;

provided that such use is made in accordance with honest practices in industrial or commercial matters.

2. The exclusive right to a trademark shall not imply the right to prohibit use in the course of trade 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 prohibit use of the trademark for goods which have been put on the market in the European Community or European Economic Area under that trademark by the holder or with his consent, unless there are legitimate reasons for the holder to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

#### Article 2.24 Acquiescence and objections to use

1. The holder of a prior trademark who has acquiesced, for a period of five successive years, in the use of a registered later trademark while being aware of such use, shall no longer be entitled to prohibit the use of the later trademark under Article 2.20 (1) (a), (b) and (c) in respect of goods or services for which that trademark has been used, unless the later trademark was filed in bad faith.

2. Acquiescence in the use of a registered later trademark as defined in paragraph 1 shall not give the holder of the later registered trademark the right to prohibit the use of the prior trademark.

### **Chapter 6. Surrender, revocation and invalidity**

#### Article 2.25 Surrender

1. The holder of a Benelux trademark may surrender its registration at any time.

2. However, if a license has been recorded, registration of the trademark may be surrendered only at the joint request of the holder 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. Surrender shall have effect for the whole of 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 holder.

5. Surrender 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 surrender 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 revoked within the limits laid down in Article 2.27 if, following the date of registration:

a. within a continuous period of five years, it has not been put to genuine use on Benelux territory in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use; in the event of litigation, the courts may place all or part of the burden of proof on the holder of the trademark;

b. in consequence of acts or inactivity of the holder, the trademark has become the common name in the trade for a product or service in respect of which it is registered;

c. in consequence of the use made of it by the holder of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;

b. affixing of the trademark to goods or to the packaging thereof solely for export purposes;

c. use of the trademark by a third party with the consent of the holder.

#### Article 2.27 Revocation

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

2. Revocation of the right in a trademark subject to the provisions of Article 2.26 (2) (a), may no longer be invoked where, during the interval between expiry of the five-year period and submission of the claim for revocation, genuine use of the trademark has been started or resumed. However, commencement or resumption of use within a period of three months prior to submission of the claim for revocation shall be disregarded where preparations for the commencement or resumption occur only after the holder becomes aware that the claim may be filed;

3. The holder of the right in a trademark whose revocation can no longer be invoked under paragraph 2, 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 revoked under Article 2.26 (2) (a).

4. The holder of the right in a trademark whose revocation can no longer be invoked under paragraph 2 may not, on the basis of the provisions of Article 2.28 (3), claim invalidity of the registration of a trademark filed during the period in which the prior right in the trademark could have been revoked under Article 2.26 (2) (a).

#### Article 2.28 Invalidation

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

- a. the registration of a sign which cannot constitute a trademark pursuant to Article 2.1 (1) and (2);
- b. the registration of a trademark which is devoid of any distinctive character;
- c. the registration of a trademark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or performance of the service, or other characteristics of the goods or services;
- d. the registration of a trademark which consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
- e. the registration of a trademark under which no trademark right is acquired in accordance with Article 2.4 (a), (b) or (g).
- f. the 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 after registration as a result of the use which has been made of them.

3. Provided that the holder 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 invalidity of:

- a. the registration of a trademark which ranks after that of a similar trademark in the circumstances provided for by Article 2.3;
- b. the registration of a trademark under which no trademark right is acquired in accordance with Article 2.4 (d), (e) and (f); invalidity under Article 2.4 (d) must be invoked within a period of three years following expiry of the prior registration; invalidity 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 invalidation 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 Acquiescence and invalidation

The holder of a prior trademark who has acquiesced, for a period of five successive years, in the use of a registered later trademark while being aware of such use, shall no longer be entitled to invoke the invalidity 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 invalidation, revocation and surrender

1. The invalidation of a registration or revocation of a right to a trademark or the surrender of a registration shall apply to the sign constituting the trademark in its entirety.

2. The declaration of invalidity or revocation shall be limited to one or more of the goods or services in respect of which the trademark is registered, if the grounds for invalidity or revocation affect only some of the goods or services.

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

### Article 2.31 Transfer

1. Independently of the transfer or all or part of an undertaking, a trademark may be transferred in respect of all or some of the goods or services for which it 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 Licence

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

2. The holder of a trademark may invoke the exclusive right to the trademark against a licensee who contravenes the clauses of the licensing agreement 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 licence is granted, the territory on which the trademark may be affixed or the quality of the goods or services put on the market by the licensee.

3. Entry of a licence in the register may be cancelled only at the joint request of the holder of the trademark and the licensee.

4. The licensee shall have the right to act in an action brought by the holder of the trademark, as mentioned in Article 2.21 (1) to (4), in order to obtain compensation for a prejudice directly incurred by him or to be allocated a proportion of the profit made by the defendant.

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

6. The 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 holder of the trademark for that purpose.

### Article 2.33 Opposability against third parties

The assignment or other transfer or the licence shall become opposable 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. Any signs so designated at the time of filing and used to distinguish one or more common characteristics of goods or services originating from different companies using the trademark under the control of the holder shall be regarded as collective marks.
2. The holder may not use the trademark for goods or services originating from its own undertaking or from an undertaking in whose management or supervision it is directly or indirectly involved.
3. Any signs so designated at the time of filing and which serve in trade to designate the geographical origin of goods or services shall also be regarded as collective marks. Such a mark does not entitle the holder to prohibit a third party from using in the course of trade such signs, provided he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a mark may not be invoked against a third party who is entitled to use 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 holder of the registration of a similar collective mark or by its successor in title.

#### 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 holders of collective marks must notify the Office of any amendment to the regulations on the use and control of a trademark.
2. This notification shall be recorded by the Office.
3. The amendment 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 holder 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 holder or to join or act in the action brought by or against the holder.
3. Likewise, the regulations on use and control may specify that, when acting alone, the holder may establish the special interest of those using the mark and include in its claim for damages any particular prejudice incurred by one or more of them.

#### Article 2.42 Revocation by interested parties

1. Without prejudice to the provisions of Article 2.27, any interested party, including the Public Prosecutor, may invoke the revocation of a right in a collective mark if the holder 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 for revocation 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 Invocation of invalidity by the Public Prosecutor

1. Without prejudice to the provisions of Article 2.28, the Public Prosecutor may invoke the invalidity 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 invalidity 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 registrations or amendments that have been declared invalid.

#### Article 2.44 Prohibition on use

Collective marks which have been revoked, invalidated or surrendered, 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 revocation, invalidation or surrender 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 Order of 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 for the Benelux territory is validly claimed in accordance with the Community Trade Mark Regulation even if the Benelux or international registration on which seniority is based has been surrendered or has expired.

#### Article 2.47 Invocation of invalidity or revocation of the prior right

Where the seniority of a prior trademark right is claimed in respect of a Community trademark, the invalidity or revocation of that prior right may be invoked even if that right has already lapsed through surrender or expiry of the registration.

## **TITLE III: DESIGNS**

### **Chapter 1. Designs**

#### Article 3.1 Designs

1. A design shall be protected to the extent that it is new and has individual character.
2. The appearance of the whole 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 features of the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation.
4. A product shall mean any industrial or handicraft item, including inter alia parts intended to be assembled into a complex product, packaging, get-up, graphic symbols and typographic typefaces. Computer programs shall not be regarded as a product.

#### Article 3.2 Exception

1. The following shall be excluded from the protection provided for by this title:
  - a. the features of appearance of a product which are solely dictated by its technical function.
  - b. the features of appearance of a product which must necessarily be reproduced in their exact form and dimensions in order to permit the product in which the design is incorporated or to which it is applied to be mechanically connected to or placed in, around or against another product so that either product may perform its function.
2. Notwithstanding paragraph 1 (b), the features of appearance of a product serving the purpose of allowing multiple assembly or connection of mutually interchangeable products within a modular system shall be protected as a design, under the conditions laid down in Article 3.1 (1).

#### Article 3.3 Novelty and individual character

1. A design shall be considered new if no identical design has been made available to the public before the date of filing of the application or the date of priority. Designs shall be deemed to be identical if their features differ only in immaterial details.
2. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing or the date of priority. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.
3. In order to assess novelty and individual character, a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the European Community or the European Economic Area, before the date of filing or the date of priority. The design shall not, however, be deemed to have been made available to the public for the sole reason that it has been disclosed to a third person under explicit or implicit conditions of confidentiality.
4. In order to assess novelty and individual character, a disclosure shall not be taken into consideration if a design for which protection is claimed under a registered design right has been made available to the public during the 12-month period preceding the date of filing of the application or the date of priority:

a. by the designer, his successor in title, or a third person as a result of information provided or action taken by the designer, or his successor in title; and

b. if the design has been made available to the public as a consequence of an abuse in relation to the designer or his successor in title.

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 or incorporated in a product which constitutes a component part of a complex product shall only be considered to be new and to have individual character:

a. if the component part, once it has been incorporated into the complex product, remains visible during normal use of the latter; and

b. to the extent that those visible features of the component part fulfil in themselves the requirements as to novelty and individual character.

2. For the purposes of this title, complex product shall mean a product which is composed of multiple components which can be replaced permitting disassembly and re-assembly of the product.

3. Normal use within the meaning of paragraph 1 shall mean use by the end user, excluding maintenance, servicing or repair work.

#### Article 3.5 Acquisition of rights

1. Without prejudice to the right of priority, the exclusive right in a design shall be acquired by registration of the application that has been filed in 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 made available to the public after the date of filing or the date of priority, and which is protected from a date prior to the said 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 holder 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 an improper use of any of the items listed in Article 6<sup>ter</sup> of the Paris Convention;

e. the design is contrary to public policy or to accepted principles of morality in one of the Benelux countries;

f. the filing does not sufficiently reveal the features of the design.

### Article 3.7 Claim of the application

1. During a period of five years following publication of the registration of a filing, the designer of the design or the person who, under to Article 3.8, is deemed to be the designer, may claim the right to the Benelux application 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 designer's consent; the designer may on the same grounds and at any time invoke the invalidity of the registration of the filing or of the rights referred to. The action to claim shall be registered with the Office at the claimant'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 paragraph 1 has requested the total or partial surrender of the registration of the Benelux filing or has renounced the rights in Benelux territory deriving from an international filing, such surrender or renunciation shall, subject to paragraph 3, not have effects vis-à-vis the designer or the person deemed to be the designer under Article 3.8, provided that the filing has been claimed within one year from the date of publication of the surrender or renunciation and before the expiry of the five-year period referred to in paragraph 1.
3. If, during the interval between the surrender or renunciation referred to in paragraph 2 and the registration of the action to claim, a third party, acting in good faith, has exploited 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 put on the market.

### Article 3.8 Rights of employers and commissioning parties

1. If a design has been developed by an employee in the execution of his duties, the employer shall, unless otherwise agreed, be deemed to be the designer.
2. If a design has been created on commission, the commissioning party shall, unless specified otherwise, be deemed to be the designer, 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. A Benelux application for designs shall be filed, either with the national administrations or with the Office, in the manner specified by the implementing regulations and against payment of the fees due. A Benelux application 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 fixed. The applicant shall be informed, without delay and in writing, of the date of filing or, where applicable, of the grounds for not fixing a filing date.
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. The application 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 administration, the national administration shall forward the Benelux application to the Office, either without delay after receiving the application or after establishing that the application satisfies 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 Office.



#### Article 3.10 Claiming priority

1. A right of priority shall be claimed at the time of filing or in the month following filing, 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.
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 features 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 inspect the registration and the documents produced at the time of filing.

#### Article 3.12 Deferment of publication on request

1. When making a Benelux filing, the applicant may request that publication of the registration be deferred 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 possibility provided for under paragraph 1, the Office shall defer publication in accordance with the request.

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

1. The Office shall defer 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 application within a period of two months.
3. If the party in question has not withdrawn the application on the expiry of that period, the Office shall, within the shortest period possible, invite the Public Prosecutor to initiate an action to invalidate the application.
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 which is no longer open to opposition or appeal or to reversal by a court of cassation, the Office shall publish the registration of the design without delay.

#### Article 3.14 Term and renewal of registration

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

3. Renewal shall be effected 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 holder 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. Rights of the holder**

#### Article 3.16 Scope of protection

1. Without prejudice to the application of ordinary law relating to civil liability, the exclusive right in a design shall allow its right holder to challenge the use of a product in which the design is incorporated or on 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, taking into consideration the designer's degree of freedom in developing the design.

2. Use shall cover, in particular, the making, offering, putting on the market, sale, delivery, hire, importing, exporting, exhibiting, or using or stocking for one of those purposes.

#### Article 3.17 Compensation for damages and other actions

1. The exclusive right shall allow the holder 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 features of the design.

2. The court which sets the damages:

a. shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any unfair profits made by the infringer and, in appropriate cases, elements other than economic factors, such as the moral prejudice caused to the holder of the exclusive right in a design as a result of the infringement; or

b. as an alternative to (a), it may, in appropriate cases, set the damages as a lump sum on the basis of elements such as at least the amount of royalties or fees which would have been due if the infringer had requested authorization to use the design.

3. Furthermore, the court may order, at the request of the holder of the exclusive right in a design and by way of compensation, that ownership of goods which infringe a design right, as well as, in appropriate cases, the materials and implements principally used in the manufacture of those goods, be transferred to this holder; the court may order that the transfer shall only take place upon payment by the claimant of a sum which it shall fix.

4. In addition to or instead of the action for compensation, the holder of the exclusive right in a design may institute proceedings for transfer of the profits made following the use referred to in Article 3.16, and for the provision 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.

5. The holder of the exclusive right in a design may institute proceedings for compensation or transfer of profits in the name of the licensee, without prejudice to the right granted to the licensee in Article 3.26 (4).

6. 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 holder has acquired exclusive rights in this regard.

#### Article 3.18 Additional claims

1. Without prejudice to any damages due to the holder of the exclusive right in a design by reason of the infringement, and without compensation of any sort, the courts may order, at the request of the holder of the exclusive right in a design, the recall from the channels of commerce, the definitive removal from the channels of commerce or the destruction of goods which infringe a design right, as well as, in appropriate cases, materials and implements principally used in the manufacture of those goods. Those measures shall be carried out at the expense of the infringer, unless there particular reasons for not doing so. In considering a request as referred to in this paragraph, the proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties shall be taken into account.

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

3. Insofar as not provided for by national law and at the request of the holder of the exclusive right in a design, the courts may, under this provision, issue an interlocutory injunction against the alleged infringer or against an intermediary whose services are used by a third party to infringe a design right, in order to:

a. prevent any imminent infringement of a design right, or

b. forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment, the continuation of the alleged infringements of a design right, or

c. make continuation of the alleged infringements subject to the lodging of guarantees intended to ensure the compensation of the holder.

4. At the request of the holder of the exclusive right in a design in proceedings concerning an infringement of his rights, the courts may order the party infringing the holder's right to provide the holder with all information available concerning the origin and distribution networks of the goods and services which have infringed the design and to provide him with all the data relating thereto, insofar as this measure seems justified and proportionate.

5. The order referred to in paragraph 4 may also be issued against anyone who is in possession of the infringing goods on a commercial scale, who has used the infringing services on a commercial scale or who has provided, on a commercial scale, services used in infringing activities.

6. The courts may, at the request of the holder of the exclusive right in a design, issue an injunction for the cessation of services against intermediaries whose services are used by a third party to infringe its design right.

7. The courts may order, at the request of the claimant and at the expense of the infringer, that appropriate measures be taken to disseminate information concerning the decision.

### Article 3.19 Limitation of the effects of the exclusive right

1. The exclusive right to a design shall not imply the right to contest:
  - a. acts done privately and for non-commercial purposes;
  - b. acts done for experimental purposes;
  - c. acts of reproduction for the purpose of making citations or of teaching, provided that such acts are compatible with fair trade practice and do not unduly prejudice the normal exploitation of the design, and that mention is made of the source.
2. Furthermore, the exclusive right in a design shall not imply the right to contest:
  - a. the equipment on ships and aircraft registered in a third country when these temporarily enter the Benelux territory;
  - b. the importation in the Benelux territory of spare parts and accessories for the purpose of repairing such craft;
  - c. the execution of repairs on such craft.
3. The exclusive right in a design constituting a part of a complex product shall not imply the right to contest use of the design for the purposes of repair of that complex product in order to restore 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 holder or with the holder's consent, or the acts mentioned in Article 3.20.
5. Actions may not relate to products which were put on the market in Benelux territory prior to the filing.

### Article 3.20 Rights of prior use

1. A right of prior use shall be recognized for third parties who, prior to the filing date for a design or to the priority date, manufactured on Benelux territory products that are identical in appearance to the design filed or that 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 designer's consent.
4. The right of prior use shall permit the holder of it to continue or, in the circumstances referred to in paragraph 2, to undertake manufacture of those products 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 prior use may be transferred only together with the business in which the acts which gave rise to it took place.

## **Chapter 4. Surrender, lapse and invalidity**

### Article 3.21 Surrender

1. The holder of the registration of a Benelux filing may at any time request surrender of that

registration, unless third parties have legal contractual rights which have been notified to the Office.

2. In the case of multiple filings, surrender 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 surrendered only at the joint request of the holder of the design and the licensee. The provisions of the previous sentence shall apply where a pledge or attachment has been recorded.

4. Surrender 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 right

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

a. through surrender 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 Invalidation

1. Any interested party, including the Public Prosecutor, may invoke the invalidity of the registration of a design if:

a. if the design does not correspond to the definition 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 holder 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 invalidity 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 Article 3.6 (a).

3. Only the holder of a prior trademark right or the owner of a prior copyright may invoke the invalidity 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 invalidity 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 designer of a design as referred to under Article 3.7 (1) may, in the conditions referred to under that Article, invoke the invalidity 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 invalid even after the right has lapsed or been surrendered.

7. When an action for invalidation is brought by the Public Prosecutor, only the courts of Brussels, The Hague and Luxembourg shall have jurisdiction. Action brought by the Public Prosecutor shall stay any other action brought on the same grounds.

#### Article 3.24 Scope of invalidity, surrender and renunciation

1. Subject to the provisions of paragraph 2, invalidation, surrender and renunciation shall apply to the design in its entirety.
2. If the registration of the filing of a design may be invalidated in accordance with Article 3.6 (b), (c), (d) or (e), or Article 3.23 (1) (b) and (c), filing may be maintained in an amended form if, in that form, the design complies with the requirements for protection and the identity of the design is retained.
3. Maintenance as referred to in paragraph 2 may be understood as registration accompanied by a partial disclaimer by the holder or the registration or a court order which is no longer open to opposition or appeal or to reversal by a court of cassation declaring the partial invalidity of the right.

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

#### Article 3.25 Transfer

1. The exclusive right in a design may be transferred.
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 3.26 Licence

1. The exclusive right in a design may be the subject of a license.
2. The holder of a design right may invoke the exclusive right in a design against a licensee who contravenes the clauses of the licensing agreement in respect of its term, the form covered by the registration in which the design may be used, the products for which the licence is granted and the quality of the products put on the market by the licensee.
3. Entry of a licence in the register may be cancelled only at the joint request of the holder of the design right and the licensee.
4. The licensee shall have the right to act in an action brought by the holder of the exclusive right in a design, as mentioned in Article 3.17 (1) to (4), in order to obtain compensation for a prejudice directly incurred by him or to be allocated a proportion of the profit made by the defendant. The licensee may bring independent action as mentioned in Article 3.17 (1) to (4) only if it has obtained the permission of the holder of the exclusive right for that purpose.
5. The licensee shall be authorized to exercise the powers referred to under Article 3.18 (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 holder of the exclusive right in a design for that purpose.

#### Article 3.27 Opposability against third parties

The assignment or other transfer or the licence shall become opposable 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 6. Cumulation with copyright**

### Article 3.28 Cumulation

1. Authorization given by the designer of a work protected by copyright to a third party to file a design in which that work 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 designer 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 deemed to be the designer, in accordance with the provisions of that Article.

## **TITLE IV: OTHER PROVISIONS**

### **Chapter 1. *Repealed***

#### Article 4.1

*Repealed*

#### Article 4.2

*Repealed*

#### Article 4.3

*Repealed*

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

#### Article 4.4 Tasks

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

- a. making modifications to filings and registrations which are required by holders, 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 copies of registrations at the request of any interested party.

#### Article 4.4bis i-DEPOT

1. The Office may provide proof under the heading 'i-DEPOT' of the existence of documents on the date of receipt thereof.
2. The documents will be retained on file by the Office for a certain period of time. This will take place on a strictly confidential basis, unless the party submitting the documents explicitly waives confidentiality.
3. The modalities of this service will be provided for in implementing regulations.

### **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 absence of registration of the filing of a trademark or design shall be covered by registration or renewal of the trademark or design in the course of proceedings.



3. The court shall order ex officio the cancellation of registrations that have been declared invalid or revoked.

#### 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 executed. 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 reconventional claims, 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 just 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 a real and effective industrial or commercial establishment on Benelux territory may, in the context of this convention, claim application of the provisions of the Paris 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 this 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 opposition-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 establish 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. *Repealed*

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. The Director General shall publish these on the Office's website.

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.

3. Amendments to the implementing regulations will not take effect until such time as publication has taken place as referred to in paragraph 1.

4. The High Contracting Parties shall also announce these amendments in their official journals.