

IV. BENELUX TRADE AND SERVICE MARKS

§ 32:35 Nature—Creation of rights

In the Netherlands, a sign can be protected as a trademark through the grant of a Benelux trademark (“BTM”), EUTM or IR designating the Benelux/EU. Trademarks can be registered for goods as well as services (service marks). Since other chapters of *World Intellectual Property Rights and Remedies* discuss EUTMs and IRs, this paragraph will focus on BTMs.

Article 2.1 of the Benelux Convention on Intellectual Property¹ stipulates that any sign, in particular words (including personal names) or drawings, letters, numbers, sounds or colours, shapes or packaging of goods, may be registered as a trade mark if the sign is capable of distinguishing the goods or services of an undertaking from those of other undertakings and can be sufficiently represented in the trade mark register. The exclusive right to a trade mark can be acquired by registration of a sign that has been filed in the Benelux (Benelux filing).

The exclusive right also can result from an IR, designating the Benelux (article 2.2 of the Benelux Convention on Intellectual Property). European Trademark Rights provide trademark protection in the Netherlands. A Benelux filing can be submitted before the Benelux Office of Intellectual Property (located in The Hague, The Netherlands) or any of the designated national administrations of the Benelux member states (article 2.5(1) of the Benelux Convention on Intellectual Property).² The Benelux filing can be filed in the Dutch, French, or English language.

The applicant may claim priority rights, as provided for in the Paris Convention or the TRIPs Treaty, at the time of filing or—upon payment of an additional fee—by means of a special declaration in the month following the filing (article 2.6 of the Benelux Convention on Intellectual Property). Article 2.6(2) of the Benelux Convention on Intellectual Property makes clear that priority rights also may be claimed for service marks. An application for a Benelux filing must meet the formal conditions as laid down in the Benelux Convention on Intellectual Property and the Implementing Regulations regarding the Benelux Convention on Intellectual Property (the “Implementing Regulations”).³ Furthermore, the registration fees must be paid.

[Section 32:35]

¹Convention of 25 February 2005, as amended by the Protocol of 22 July 2020.

²In The Netherlands, The Netherlands Patent Office, also located in The Hague, is the designated national administration. National administrations will forward received requests to the Benelux Office of Intellectual Property (article 2.5 (4) of the Benelux Convention on Intellectual Property).

³Regulations of 13 February 2018, see <https://www.boip.int/system/files/documen>

THE NETHERLANDS

An application date will be granted to the applicant if the formal requirements are met (article 2.5(1) of the Benelux Convention on Intellectual Property). Subsequently, the application will be published in the Benelux trade mark register, and the Benelux Office of Intellectual Property will conduct a substantive examination of the application on absolute grounds for refusal as listed in article 2.2bis (1) of the Benelux Convention on Intellectual Property (article 2.11 Benelux Convention on Intellectual Property). Examples of absolute grounds for refusal are that a sign cannot form a trade mark within the meaning of article 2.1 of the Benelux Convention on Intellectual Property and that a sign lacks any distinctive character (article 2.2 *bis* (1)(a) and (b) of the Benelux Convention on Intellectual Property).

The Benelux Office of Intellectual Property will not conduct a preliminary examination to earlier conflicting trade mark rights or to the bad faith of the applicant. The applicant can object in writing within six months to any denial of the request for trade mark registration on absolute grounds (article 2.11(3) of the Benelux Convention on Intellectual Property and article 1.12 of the Implementing Regulations).⁴ Furthermore, after publication of the trade mark application, the opposition period of two months will start (article 2.14(1) of the Benelux Convention on Intellectual Property).

In this period, a proprietor of an older right as listed in article 2.2 *ter* Benelux Convention on Intellectual Property or another party listed in article 2.2 *ter* of the Benelux Convention on Intellectual Property can object to the Benelux filing based on relative grounds for refusal. Subsequently, the adversarial opposition proceedings will start before the Benelux Office of Intellectual Property. A party can bring an appeal against the opposition decision of the Benelux Office of Intellectual Property before the Benelux Court of Justice (article 1.15 *bis* of the Benelux Convention on Intellectual Property). If the application is not refused on absolute grounds and if no opposition is successfully lodged, the Benelux trade mark will be granted (article 2.8 of the Benelux Convention on Intellectual Property).

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⁴If the objection is denied, an appeal against the decision is possible to the Benelux Court of Justice.