

§ 32:39 Nature—Cancellation

A Benelux trade mark or IR with designating the Benelux (as far as it concerns the Benelux) will be cancelled for all or part of the goods and services for which the trade mark is registered due to revocation of the trade mark or after the trade mark is declared invalid. Cancellation can be claimed in administrative cancellation proceedings before the Benelux Office of Intellectual Property (article 2.30 *bis* (1) and article 2.30 *quater* of the Benelux Convention on Intellectual Property) or as a claim or counterclaim in substantive proceedings before a civil court (article 2.28(4) of the Benelux Convention on Intellectual Property).

Cancellation cannot be claimed in preliminary relief proceedings.¹ Appeal against a final decision of the Benelux Office of Intellectual Property in cancellation proceedings is possible before the Benelux Court of Justice (article 1.15 *bis* of the Benelux Convention on Intellectual Property). Appeal against the decision of a civil court is possible before the competent appellate court. The consequence of revocation of a trade mark is that the trade mark will be deemed not to have the consequences as mentioned in the Benelux Convention on Intellectual Property as of the date of a claim for revocation. The consequence of a declaration of invalidity of a trade mark right is that the trade mark will be considered as not having the consequences as mentioned in the Benelux Convention on Intellectual Property from the beginning (article 2.30nonies (4) and (5)) of the Benelux Convention on Intellectual Property. Pursuant to article 2.27(1) and (2) of the Benelux Convention on Intellectual Property, the Benelux Office of Intellectual Property or the court can revoke a trade mark when:

1. The trade mark has become, due to the conduct or omission of the trade mark owner, a common name in the trade for a good or service for which the trade mark is registered;
2. The trade mark can, because of the use of it by or with the

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¹A defendant in infringement proceedings before the preliminary relief judge can however defend against the alleged trade mark infringement with the claim that there is a “serious and real chance” that the trade mark will be declared invalid in cancellation proceedings and therefore, the claims of the plaintiff should be rejected. Court of The Hague, 2 October 2015, ECLI:NL:RBDHA:2015:12421, paragraph 4.13.

permission of the trade mark owner for the goods and services for which the trade mark is registered, mislead the public, in particular concerning the nature, capacity or the place of origin of those goods and services; or

3. The trade mark has not been put to genuine use.

A natural person or legal person and certain interest groups² may claim revocation of the trade mark before the Benelux Office of Intellectual Property (article 2.30 *bis* (1)(a) of the Benelux Convention on Intellectual Property). Furthermore, an interested party can start civil proceedings for revocation of a trade mark. “An interested party” is interpreted broadly as a party who could be affected in any interest that is intended to be protected by the Benelux Convention on Intellectual Property if the trade mark would be maintained.³ Associations of trade mark owners and consumer associations also are recognized as an interested party.⁴

A trade mark can be declared invalid by the Benelux Office of Intellectual Property or the court based on absolute grounds and relative grounds for invalidity. The absolute grounds are stated in article 2.2 *bis* (1) and (2) of the Benelux Convention on Intellectual Property. A trade mark also can be declared invalid on the absolute ground that a trade mark application has been submitted in bad faith (article 2.2 *bis* (2) of the Benelux Convention on Intellectual Property). The relative grounds for invalidity are stated in article 2.2 *ter* of the Benelux Convention on Intellectual Property and concern the grounds based on which a party could start opposition proceedings against a trade mark application, such as conflict with a prior EUTM, Benelux trade mark, IR with designation the EU/Benelux, or protected geographical indications or designation of origin.

In administrative proceedings before the Benelux Office of Intellectual Property, a claim based on absolute grounds can be submitted by the same parties that also are authorized to claim revocation of a trade mark right before the Benelux Office of Intellectual Property (article 2.30 *bis* (1)(a) of the Benelux Convention on Intellectual Property, *see* previous paragraph). Only specific parties, listed in article 2.30 *bis* (1)(b) of the Benelux Convention on Intellectual Property, can commence cancellation proceedings before the Benelux Office of Intellectual Property based on relative grounds for invalidity. Any interested party, including the Public Prosecution Service, can request a civil court to declare a trade mark invalid based on absolute grounds (article 2.28(1) of the Benelux Convention on Intellectual Property).

²An interest group or entity for the representation of the interests of manufacturers, producers, service providers, traders, and consumers that is pursuant to the applicable national laws in competent to start proceedings in its own name.

³Gielen and others, *Kort begrip van het intellectuele eigendomsrecht*, 2020/434 (online: lastly updated on 1 June 2020).

⁴Supreme Court, 14 June 1991, ECLI:NL:HR:1991:ZC0279, NJ 1992/393 (NI-VAK).

In addition, an invalidity claim based on relative grounds can be submitted before the civil court by any interested party, but only if the respective owner of or the party entitled to the prior right is participating in the proceedings (article 2.28(2) of the Benelux Convention on Intellectual Property). The Public Prosecution Service does not have competence to file a claim for invalidity based on relative grounds. The Benelux Office of Intellectual Property or the court must order the cancellation of trade marks that are revoked or declared invalid (article 2.30 bis (4) of the Benelux Convention on Intellectual Property and article 4.5(3) of the Benelux Convention on Intellectual Property).