

§ 32:56 Infringement actions—Procedures

Infringement proceedings in The Netherlands are often about an infringement within the meaning of article 5 of the Trade Name Act. As mentioned above, the rightful user of a prior trade name can also invoke article 5 of the Trade Name Act in proceedings pursuant to article 6 of the Trade Name Act. The special proceedings are application proceedings that are considered faster, simpler, and more cost efficient than summons proceedings. The rules in the Civil Code of Procedure regarding application proceedings (articles 261-302 of the Civil Code of Procedure) apply for proceedings pursuant to article 6 of the Trade Name Act.

Since the proceedings pursuant to article 6 Trade Name Act are brought before a subdistrict judge, parties also can act *pro se* without an attorney (article 278(3) of the Civil Code of Procedure). In addition, special procedural rules apply as stated in article 6 of the Trade Name Act. For example, according to article 6(3) of the Trade Name Act, a request must be served by the bailiff to the counterparty. Article 6(4) and (5) stipulates shorter terms for bringing in appeal to the appellate court or the Supreme Court. Article 6(2) of the Trade Name Act governs the rules regarding territorial jurisdiction. The primary rule

is that the request must be made to the Dutch court of the place of establishment of the undertaking that uses the forbidden trade name. In proceedings pursuant to article 6 of the Trade Name Act, only the modification of the infringing trade name can be requested from the subdistrict judge.

Other claims, such as for injunctions and compensation of damages, can only be claimed in regular summons proceedings. Such proceedings can be instituted before a court hearing a case on the merits (article 78 of the Civil Code of Procedure) or before the preliminary relief judge (article 254 of the Civil Code of Procedure). A court is obligated to order the losing party to pay actual costs of the counterparty in proceedings that fall within the scope of title 15 of the Civil Code of Procedure.

According to article 1019 of the Civil Code of Procedure, only proceedings concerning a violating of articles 5 or 5a of the Trade Name Act (and not articles 3, 4, or 5b of the Trade Name Act) fall within the scope of title 15 of the Civil Code of Procedure. Therefore, the subdistrict judge can make a cost order pursuant to article 1019h of the Civil Code of Procedure in either summons or application proceedings based on articles 5 or 5a of the Trade Name Act.

Summons proceedings before a court hearing the case on the merits or the preliminary relief judge also can be initiated for claims based on an infringement of a trade name due to the use of an younger conflicting trade mark if a likelihood of confusion exists. The rightful user of a prior trade name also can seek to declare a registered younger conflicting EU trade mark or Benelux trade mark invalid in administrative cancellation proceedings before the EUIPO, i.e., the Benelux Office of Intellectual Property by arguing that the trade mark application was submitted in bad faith because the trade mark owner had knowledge or should have had knowledge of a similar sign (article 59(1)(b) EU Trade Mark Act and 2.2 *bis* (2) of the Benelux Convention on Intellectual Property).¹ As appears from case law regarding trade mark applications submitted in bad faith, certain strict conditions must be met for a successful claim.

There are more possibilities to object to a registered EU trade mark based on a prior trade name. Unlike the Benelux Convention on Intellectual Property, the EU Trade Mark Regulation qualifies, under certain circumstances, a conflict between a trade mark application and an older sign that is used in economic trade and is “of more than a mere local significance” as a relative ground for refusal or invalidity (article 8(4) of the EU Trade Mark Regulation). This ground can be invoked in opposition proceedings and cancellation proceedings.

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¹Van Nispen, Huydecoper & Cohen Jehoram, *Industriële eigendom. Deel 3. Vornen, namen en reclame*, 2012/2.3.2.7 online, lastly updated on 1 March 2012).