




BOIP  
Benelux Office for  
Intellectual  
Property  
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# BOIP Recent Developments

WIPO Roving Seminar  
Brussels, September 2018




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## Benelux Convention on Intellectual Property (BCIP)

BCIP (2005) + Implementing regulations + Protocol privileges & immunities  
→ into force since 2006

Already modified twice:

- Decision 1 December 2006 → into force February 2007 (implementation EU Directive 2004/48 on Enforcement)
- Protocol 22 July 2010 → into force October 2013 (legal basis i-DEPOT, renewal by payment only, etc.)

June 2018, two new modifications:

1. Protocol 21 May 2014: new competences of the Benelux Court of Justice
2. Protocol 16 December 2014: invalidity and revocation, adaptation of the opposition procedure

Yet to come (2019):

Protocol 11 December 2017 implementing EU Directive 2015/2436 ('Trade Mark Package')








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# 1. Cancellation



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### Context

- Process started in 2008 with two elements: administrative cancellation procedure (BOIP initiative) and evaluation of opposition procedure (5 years after working into force)
- Cancellation = last of the 3 steps in substantive powers of BOIP, quick and easy procedure, equality with EUTM, expertise of BOIP lawyers... → towards a more reliable register!
- Broad consultation of interested circles
- Consensus on a 'light' procedure referring to existing competencies (starting phase)

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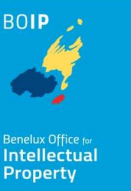







### Applicants and grounds

- Introduction by any interested party
  - Invalidation (absolute grounds)
  - Revocation (non-use, misleading or common name)
  
- Introduction by right-holder
  - Relative grounds
  - Confusion with well-known trade mark


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### Procedure


- Largely inspired by the opposition proceedings
- Language of defendant (if EN, applicant's choice)
- No timing for introduction (possible to regularize)
- No 'cooling off' but several suspension causes
- Differences in legal effect: *ex nunc* vs. *ex tunc*
- Fee: € 1.400 (up to 3 grounds and based on 3 rights)
- Appeal before BCJ (BOIP ≠ party)





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## 2. Benelux Court of Justice



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### Context

- Previous situation: appeals against decisions of BOIP lodged with Courts of Appeal of Brussels, The Hague or Luxembourg
- Disparity in case law > < unitary character of Benelux trade mark
- Legal uncertainty, forum shopping, higher cost... → negative impact for undertakings
- Existing Benelux Court of Justice, competent (inter alia) for interpretation of common rules
- 4 texts to enshrine the new competencies of the BCJ

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## New competencies

### Article 1.15bis Appeal

1. Any person who is a party to a procedure that has led a final decision by the Office in the execution of its official tasks pursuant to Titles II, III and IV of this Convention may lodge an appeal against that decision with the Benelux Court of Justice in order to have that decision annulled or reviewed. The timeframe for filing an appeal is two months from notification of the final decision.

2. The Organization may be represented in proceedings before the Benelux Court of Justice relating to decisions made by the Office by a member of staff appointed for this purpose.




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## Appeals

- Refusals: absolute grounds, ex parte, definitive refusal against +/- 6% of TM applications (1.250). BOIP is party in appeal.
  - Opposition: relative grounds, inter partes, opposition in +/- 5% of TM applications (1.100, of which 85% are settled), about 180 decisions per year. BOIP not involved in appeal.
  - Cancellation: absolute and relative grounds + revocation, inter partes, expectation +/- 140 filings per year. BOIP not involved in appeal.
  - Others: official tasks in application of Titles II, III and IV → to be read in conjunction with PPI
- In all cases: appeal in full jurisdiction.








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## Benelux Court of Justice

- ❖ Competencies of 2<sup>nd</sup> Chamber
- ❖ Appeal filed within two months after notification of BOIP final decision
- ❖ Proceedings mostly written
- ❖ Broader access to the Court
- ❖ Detailed Rules of Procedures: languages, electronic communication, instruction rules, procedural cost...

	REFUSAL	OPPOSITION	CANCELLATION
Legal basis	Absolute grounds (public interest)	Relative grounds (private interest)	Absolute + relative grounds + revocation
Competence	BOIP	Owner of earlier right	Owner of earlier right + any interested party
Subject	Application (before registration)	Application (before registration)	TM (after registration)
Procedure	<i>Ex parte</i>	<i>Inter partes</i>	<i>Inter partes</i>
Effects	Refusal of the application	Refusal of the application	Invalidity (ex tunc) or revocation (ex nunc) of a registration
BOIP in appeal	BOIP party in appeal	BOIP <u>not</u> party in appeal (Art 2.16 (4) BCIP)	BOIP <u>not</u> party in appeal (Art 2.30ter (4) BCIP)
Volume / introduction	+/- 11% prov. refusal (2.400)	+/- 5% of all applications (1.100 oppositions filed)	Projection: 140 dossiers (0,0378% of all active registrations)
Volume / decisions BOIP	5 à 6% final refusal (1.200 decisions)	160 à 200 decisions p/y	Decision (possibly strictly procedural) in 100% of the dossiers
Volume / appeal	4 à 8 appeals p/y	7% of the decisions are appealed (+/- 15 p/y (estim.))	Estim.: 10%+ of the decisions will be appealed (+/- 15 p/y) ??


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# 3. Trade Mark Package



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### Origin and scope

- IP landscape in the EU based on coexistence of TM systems
- 2008: announcement of a large study about the overall functioning of TM systems (Max Planck)
- TM Package: Regulation 2017/1001 (EUTM) and Directive 2015/2436 (national TM)
- Delicate trade-off between diverging interests
- Stronger TM systems (rights and obligations), modernization, further harmonization
- Deadline for transposition: January 14, 2019

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### Transposition in the Benelux

- Many mandatory provisions in the Directive → 'maximal' approach but reluctance vis-à-vis the optional provisions
- Alignment on EUTM → desire for consistency, inspiration in EUTMR
- Mutation of TM landscape in Europe → revise the structure of BCIP

### **Amending Protocol BCIP of December 11, 2017**

- Ratification completed in NL and LU
- Some questions from BE Council of State
- To finalize before end October for working into force on January 1, 2019


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### Key modifications in the BCIP


1. Deletion of the mandatory graphical representation
2. Exclusion of some shape TM ('other characteristics')
3. Stronger rights for holders (comparative advertising, goods in transit, reproduction in dictionaries...)
4. And stronger obligations (non-use as defence in cancellation, intervention in infringement proceedings...)
5. Collective vs. certification trade marks
6. Classification of goods and services
7. Extended grounds for opposition and cancellation
8. Fee structure (1-class-per-fee)







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# In Short & In Conclusion...





## Important modifications in the TM landscape for Belgian undertakings...





- ✓ Weight of IP in the economy, new technologies → **willingness to create modern and efficient TM systems**
- ✓ TM as monopolistic rights → **better balance between rights and obligations**
- ✓ Globalization, EU construction → **further harmonization and alignment of national TMs on EUTM**
- ✓ Importance of trade marks for SMEs → **tools and legal framework adapted to the Benelux situation**

**As a whole: substantial improvements for business!**

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Thank you for your attention.



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