

IP ALERT:

Enlargement of the opposition procedure regarding Benelux trade marks
Upcoming registration of ".eu" domain names.

1. Enlargement of the opposition procedure

Since January 1, 2004, Benelux has had a trade-mark opposition procedure. This procedure enables "owners" of earlier trade marks (Benelux or Community or international trade marks designating Benelux) to oppose applications for registration of signs resembling their trade marks for identical or similar goods or services.

Progressive entry into force of the procedure was foreseen. Thus, since January 1, 2004, it has been possible to lodge an opposition against applications made in Classes 2, 20 and/or 27.

As of **January 1, 2005**, the same applies to applications made in Classes 6, 8, 13, 15, 17, 19 and/or 21.

2. Registration of ".eu" domain names.

In **March 2005**, ICANN (International organization in charge with the management of the domain name system) approved the extension ".eu". Registration of ".eu" domain names will consequently become soon a reality. This new extension will not replace so-called geographical extensions such as ".be" or ".fr", but will provide the opportunity for more "European" domain names.

Holders of prior rights, particularly trade marks, will given special treatment by the system, under certain conditions.

What will happen?

A pre-registration ("Sunrise Period") phase for holders of prior rights

An initial **four-month** period is foreseen by Regulation (EC) No 874/2004, during which holders of certain rights will be able to claim priority over their corresponding ".eu" domain name.

Thus, during the first two months, owners of registered Community or national **trade marks**, geographical indications, names and acronyms of public bodies will be able to apply for registration of their trade mark or name as a ".eu" domain name. During the following two months, all holders of prior rights will be able to arrange for registration of the domain name corresponding to their right. These "prior rights" are, apart from those mentioned above, unregistered trade marks, trade names, business identifiers, company names, names of individuals and distinctive titles of protected literary and artistic work insofar as these rights are protected by the national law of the applicant's Member State.

If several persons are entitled to claim prior rights for the same domain name, the "*first-come-first-served*" rule will apply.

In order to verify the validity of the (prior) rights claimed, the validation agents appointed by EURid (the EU-appointed body managing ".eu" domain names) will examine the documents provided by the applicant for a domain name in support of the application. When an application for a domain name has been filed, that name is "blocked" pending validation. On **March 22, 2005**, EURid announced that it had appointed PriceWaterhouseCoopers as Sunrise Validation agent.

The registration phase

After this initial four-month period, the "normal" domain-name registration phase will start. Any individual or association residing in or established in the European Community and any company having its registered office or principal place of business in the EC will then be able to apply for registration of the domain name of its choice in accordance with the "*first-come-first-served*" principle. Provisions fight up speculative and abusive registration of domain names are, however, contained in Article 21 of Commission Registration (EC) 874/2004.

What is the timetable?

According to the most recent information, the Sunrise Period should begin in **October 2005**, with generalized opening frozen in early 2006.

Do we need to use an agent ?

Registration applications may be filed only by EURid-accredited service providers. The accreditation procedure should start in **May 2005**.

It is therefore not possible now to pre-register a ".eu" domain name. The opportunity to reserve domain names offered by certain operators on the Internet are thus by no means guaranteed!

How much will it all cost?

EURid will charge a maximum of EUR 10 + VAT for registration of a domain name. The prices charged by accredited service providers and any sub-contractors will obviously vary a great deal. It will be worthwhile, therefore, to study the various offers that will be placed on the market.

Our advice – What to do now ?

To ensure that you are fully prepared for the impending race for ".eu" domain names, we would advise early filing of trade marks that you wish to see registered as ".eu" domain names (if appropriate, via the "accelerated" procedure in Benelux) and updating of your trade mark portfolio (renewal, change of addresses of the owners, etc.). You will thus be able to take advantage of the "Sunrise Period".

It is also advisable to update your trade-mark portfolio and prepare an electronic copy of documentary evidence to make it easier to send to the validation agent (to be done within 40 days of the application for the domain name) and also easier for the validation agent to examine.

Further we would advise owners of trade marks or holders of other rights to monitor EURid's on-line timetable (<http://www.eurid.org>).