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New : opposition procedure for Benelux trademarks

The trademark opposition procedure will come into force in Benelux on January 1, 2004. This new procedure will allow owners of trademark registrations to react against subsequent applications for Benelux trademarks that may infringe their prior rights. This procedure will come into force gradually (in a first stage, only 3 classes of goods and services will be involved) but of course all owners of trademark rights are concerned.

Procedure : particulars and advantages

The opposition procedure is an administrative procedure: this means that it is faster and cheaper than a judicial action before the Court. It gives the owners of prior trademark rights the right to react against possibly infringing subsequent marks prior to the granting of the allegedly infringing mark.

The opposition procedure may be initiated by the applicant, the owner and – under certain conditions - by the licensee:

- of an identical prior mark designating identical goods and/or services;
- of an identical or similar prior mark designating identical or similar goods and/or services, if there is in the public's

mind, a risk of confusion which includes the risk of association;

- of a prior well-known mark, as foreseen in art 6bis of the Paris Convention

The deadline for filing an opposition is 2 months, as from the 1st day of the month after publication of the application.

Phased coming into force

The law foresees that this procedure will come into force gradually for the following applications:

- as from January 1, 2004 : applications covering classes 2, 20 and/or 27;
- as from July 1, 2005 : applications covering classes 6,8,13,15,17,19 and/or 21 will be added;
- as from January 1, 2007: applications covering classes 4,7,11,12,14,18,22-26,28-34 will be added;
- as from January 1, 2008: all applications.

The management board of the Benelux Trademark office will most likely shorten the deadlines.

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Our recommendations :

Two practical consequences for you:

- With respect to your existing trademark rights: in order to be informed of any potentially infringing trademark, we recommend to enter your marks in our watching system. We will timely advise you of the best possible action.
- With respect to your new applications: it is essential more than ever to proceed with complete availability searches before filing a new application as the risk of reaction of a prior owner (or licensee or applicant) will increase. We can take care of these searches.

Should you wish to receive future issues by e-mail, please notify us at :
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