

Uniform Benelux Law on Marks*

(amended by the Protocol of November 10, 1983,
amending the Uniform Benelux Law on Trademarks
and by the Protocol of December 2, 1992,
amending the Uniform Benelux Law on Marks)

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Chapter I Individual Marks

Article 1

The following shall be considered individual marks: designations, designs, prints, seals, letters, numbers, shapes of goods or their get-up, and any other symbols which serve to distinguish the goods or services of an enterprise.

However, shapes determined by the very nature of the goods or which affect their actual value or produce industrial results cannot be considered marks.

Article 2

Without prejudice to the provisions of ordinary civil law, a surname may serve as a mark.

Article 3

1. Without prejudice to the rights of priority provided for in the Paris Convention for the Protection of Industrial Property or in the Madrid Agreement Concerning the International Registration of Marks, an exclusive right to a mark shall be acquired by the first filing made within the Benelux territory (Benelux filing) or resulting from a registration with the International Bureau for the Protection of Industrial Property (international filing).

2. In determining the order of priority of filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in:

- (a) identical marks filed for identical goods;
- (b) identical or similar marks filed for identical or similar goods where there exists in the public mind a likelihood of association between the marks;

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- (c) similar marks filed for goods that are not similar, which enjoy a reputation in the Benelux territory, where use without due cause of the later mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the earlier mark.

Article 4

Within the limits set by Articles 6*bis*, 6*ter* and 14, no right to a mark shall be acquired by:

1. the filing of a mark that, regardless of the use being made thereof, is contrary to morality or public policy in one of the Benelux countries, or in respect of which Article 6*ter* of the Paris Convention provides for refusal or invalidation;
2. a filing made for goods or services in respect of which use of the mark is likely to deceive the public;
3. the filing of a mark resembling a collective mark, filed for similar goods, to which a right was attached which lapsed in the course of the three years preceding the filing;
4. the filing of a mark resembling an individual mark filed by a third party for similar goods or services and to which a right was attached which, on account of the expiration of the registration, lapsed in the course of the two years prior to the filing, unless the said third party gave his consent or there was non-use of the said mark as mentioned in Article 5(2)(a);
5. the filing of a mark likely to cause confusion with a well-known mark, within the meaning of Article 6*bis* of the Paris Convention, and owned by a third party who has not given his consent;
6. filing effected in bad faith, including, *inter alia*:
 - (a) filing effected by a person who knows or has no valid excuse for not knowing that within the preceding three years a third party has, in good faith and in the normal manner, used a like mark for similar goods or services on Benelux territory, and the said third party has not given his consent;
 - (b) filing effected by a person who, as a result of direct relations with a third party, knows that during the preceding three years the said party has, in good faith and in the normal manner, used a like mark for similar goods or services outside the Benelux territory, unless the said third party has given his consent or such knowledge was obtained only after the person effecting the filing had started to use the mark within the Benelux territory.

Article 5

1. A right to a mark shall lapse:
 - (a) by voluntary cancellation or by expiration of the registration of the Benelux filing;
 - (b) by cancellation or expiration of the international registration, or by renunciation of protection within the Benelux territory or, in accordance with the provisions of Article 6 of the Madrid Agreement, as a result of the fact that the mark no longer enjoys legal protection in the country of origin;
2. The right in a mark shall be declared to have lapsed within the limits set by Article 14C:
 - (a) insofar as no normal use has been made of the mark on the Benelux territory for the goods for which the mark is registered, without valid reason, during an uninterrupted period of five years; in the event of a dispute, the court may place the burden of proof of use, in whole or in part, on the proprietor of the mark;
 - (b) insofar as the mark has, in consequence of acts or inactivity of the proprietor, become the common name of a product;

- (c) insofar as the mark, in consequence of the use made of it for the goods for which it is registered, is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods.
3. For the purposes of paragraph 2(a), use of a mark shall also mean:
- (a) use of the mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered;
 - (b) affixing of the mark to goods or to the packaging thereof solely for export purposes;
 - (c) use of the mark by another person with the consent of the proprietor of the mark.

Article 6

A.

1. Benelux filing of marks shall be effected either with the national offices or with the Benelux Trademark Office in the manner and on payment of the fees prescribed by the Rules. The authorities entrusted with receiving the filing shall ascertain whether the documents submitted meet the requirements for laying down the filing date and shall decide the filing date. The applicant shall be advised without delay and in writing of the filing date or, where appropriate, of the reasons for not affording a filing date.

2. If the other provisions of the Rules are not satisfied on filing, the authority that has received the filing shall advise the applicant without delay and in writing of the conditions that have not been met and shall afford the applicant the possibility of replying within the period of time prescribed by the Rules.

3. The filing shall have no further effect if, within the time limit set, the provisions of the Rules are not satisfied.

4. The national office shall transmit the Benelux filing to the Benelux Trademark Office once it has ascertained that the filing meets the prescribed conditions.

B. Admissibility of the filing of a mark shall be subject to accomplishment of one of the following formalities, at the discretion of the applicant:

- (a) Production of a certificate from the Benelux Trademark Office attesting to the fact that an anticipation search has been carried out or requested during the three months preceding the filing, in accordance with the requirements laid down by the Rules;
- (b) Submission of a request for examination at the same time as the application through the intermediary of the authority entrusted with receiving the filing.

C. Notwithstanding application of Article 6bis, a filed mark shall be registered for the goods stated by the applicant on condition that, after receipt of the results of the anticipation search referred to in Section B and within a period of time to be laid down by the Rules, he confirms his wish to maintain the filing. A registration certificate shall be issued to the proprietor of the mark.

D. Any claim to priority based on Article 4 of the Paris Convention shall be made at the time of filing or by means of a special declaration to be submitted to the Benelux Office, in the month following filing. The absence of such a claim shall cause forfeiture of the right of priority.

Article 6bis

1. The Benelux Trademark Office shall refuse to register a filing when it considers that:
- (a) the sign as filed does not constitute a mark within the meaning of Article 1, particularly due to lack of any distinctive character as provided in Article 6quinquies B(2) of the Paris Convention;
 - (b) the filing relates to a mark as referred to in Article 4, items 1 and 2.

2. Refusal to register shall relate to the sign constituting the mark as a whole. It may be limited to one or more of the goods for which the mark is intended.

3. The Benelux Office shall inform the applicant without delay and in writing of its intention to refuse registration in whole or in part, shall state the grounds and shall give him the possibility of responding within a period of time to be laid down in the Rules.

4. If the objections of the Benelux Office to registration have not been lifted within the fixed time limit, registration of the filing shall be refused in whole or in part. The Benelux Office shall inform the applicant without delay and in writing and state the grounds of refusal and advise of the remedy against such decision referred to in Article 6ter.

5. Refusal to register a filing for all goods or for some of the goods shall imply full or part invalidity of the filing. Such invalidity shall not take effect until the time limit for appeals referred to in Article 6ter has expired, without having been used, or until the request to order registration has been irrevocably rejected.

Article 6ter

The applicant may, within two months following the communication referred to in Article 6bis, paragraph 4, file with the Brussels *Cour d'appel*, The Hague *Gerechtshof* or the Luxembourg *Cour d'appel* a request for an order to register the filing. The court with territorial competence shall be determined by the address of the applicant, the address of his representative or the postal address given on filing.

Article 7

A. International filings shall be made in accordance with the provisions of the Madrid Agreement and the Protocol Relating to the Madrid Agreement of June 27, 1989, and the fee provided for in Article 8(7)(a) of the Protocol Relating to the Madrid Agreement shall be laid down in the Rules.

B. International filings shall be subject *ex officio* to anticipation searching.

Article 8

1. The Benelux Office shall register the international filings for which extension of protection to the Benelux territory has been requested. Article 6bis, paragraphs 1 and 2, shall apply to such filings.

2. The Benelux Office shall inform the International Bureau without delay and in writing of its intention to refuse a registration, shall state the grounds for refusal in a notice of provisional full or part refusal of protection for the mark and shall afford the applicant the faculty of replying thereto in accordance with the provisions laid down in the Rules. Article 6bis, paragraph 4, shall apply.

3. Article 6ter shall apply with the condition that the court's territorial competence shall be determined by the address of the representative or by the postal address.

4. The Benelux Office shall inform the International Bureau without delay and in writing of a decision that is no longer appealable and shall state the grounds.

Article 9

At the request of persons filing marks or of third parties, the Benelux Office shall, for a consideration, undertake any examination of prior registrations of marks in the Benelux Register.

The Office shall likewise undertake the examinations provided for in Article 6B and Article 7B of prior registrations of marks in the Benelux Register.

It shall transmit the results of the examination to the party having made the request without any statement of reasons or conclusions whatever.

With a view to examination thereof, registered marks shall be classified according to a system established by the Benelux Office.

Article 10

The registration of a Benelux filing shall be for a term of 10 years, to be counted from the filing date.

The symbol constituting the mark may be modified neither during the term of the registration nor on the occasion of the renewal thereof.

The registration shall be renewed, upon request, for further periods of 10 years in the manner and on payment of the fees prescribed by the Rules.

Renewal must be applied for and the fees paid within the six months preceding expiry of the registration. Renewals may be requested and fees paid within six months following the date of expiry of the registration, subject to simultaneous payment of a surcharge to be laid down in the Rules. Renewals shall have effect as of expiry of the registration.

Six months before expiry of the registration, the Benelux Office shall issue a written reminder of the date of expiry addressed to the proprietor of the mark.

Reminders shall be sent to the last address of the proprietor of the mark known to the Benelux Office. Failure to dispatch or to receive such notices shall not exonerate the said parties from effecting the renewal within the prescribed time limits; no reliance can be placed on such failure either before the courts of law or before the Office.

The Office shall record the renewals.

Article 11

A. Independently of the transfer of the business or a part thereof, the exclusive right to a mark may be transferred, or may be the subject of a license, for all or part of the goods or services in respect of which the said mark was filed.

The following shall be null and void:

1. any assignments *inter vivos* not laid down in writing;
2. any assignments or other transfers not made for the entire Benelux territory.

B. The proprietor of a mark may invoke the exclusive right in the mark against a licensee who contravenes any provision in his licensing contract with regard to its duration, the form covered by the registration in which the mark may be used, the goods for which the license is granted, the territory in which the mark may be affixed or the quality of the goods put on the market by the licensee.

C. An assignment or other transfer or a license may be invoked against third parties only after an entry has been made in the Register of an abstract of the instrument by which such transfer or such license is evidenced, or of a statement relating thereto and signed by the parties concerned, and such entry has been made in the manner and on payment of the fees prescribed by the Rules. The provision set out in the preceding sentence shall apply to securities and to seizures.

D. A licensee shall be entitled, for the purpose of obtaining compensation for damages he has directly suffered or to obtain a proportional share of the profits obtained by the defendant, to intervene in proceedings under Article 13A, paragraphs 3 and 4, brought by the proprietor of the mark.

A licensee may not institute independent proceedings as referred to above without having obtained the authorization of the proprietor to that end.

Article 12

A. Regardless of the nature of the action instituted, no one may judicially claim protection for a symbol which is considered a mark within the meaning of Article 1 unless he has filed it in due form and, where applicable, has had the registration renewed.

Inadmissibility may be pronounced *ex officio* by the court. It shall be removed by a filing or renewal effected during the proceedings.

Damages can on no account be awarded for facts which occurred prior to filing.

B. The provisions of this Law shall be without prejudice to the right of users of a symbol not regarded as a mark within the meaning of Article 1 to rely on the provisions of ordinary civil law insofar as the latter provisions allow opposition to be made to the unlawful use of such symbol.

Article 13

A.

1. Without prejudice to the possible application of ordinary civil law in matters of civil liability, the proprietor of a mark may, by virtue of his exclusive right, prohibit:

- (a) any use in the course of trade made of the mark for goods for which the mark is registered;
- (b) any use in the course of trade made of the mark or of a similar sign for goods for which the mark is registered or for similar goods where there exists a likelihood of association on the part of the public between the sign and the mark;
- (c) any use in the course of trade, without due cause, made of a mark that has a reputation in the Benelux territory, or of a similar sign, for goods that are not similar to those for which the mark is registered, where use of such sign takes unfair advantage of or is detrimental to the distinctive character or the repute of the mark;
- (d) any use in the course of trade, without due cause, of a mark or a similar sign in any way other than to distinguish goods where use of such sign takes unfair advantage of or is detrimental to the distinctive character or the repute of the mark.

2. For the purposes of paragraph 1, use of a mark or a similar sign shall mean, in particular:

- (a) the affixing of the sign on goods or on their packaging;
- (b) the offering, putting on the market or stocking of goods for such purposes under that sign;
- (c) importing or exporting the goods under that sign;
- (d) using the sign on business papers and in advertising.

3. Subject to the conditions set out in paragraph 1, the proprietor may, by virtue of that right, claim indemnification for any damage sustained by him as a result of any use within the meaning of paragraph 1.

4. In addition to proceedings for damages or in lieu of such proceedings, the proprietor of a mark may institute proceedings for surrender of the profits obtained by reason of such use together with submission of the relevant accounts; the court shall refuse the petition if it holds that the use was not made in bad faith or that the circumstances of the case do not call for such sentence.

5. The proprietor of a mark may institute proceedings for damages or for surrender of profits on behalf of a licensee, without prejudice to the right afforded licensees under Article 11D.

6. The exclusive right shall not include the right to prohibit use by another person in the course of trade:

- (a) of his own name and address;

(b) of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or other characteristics of the goods;

(c) of the mark where it is necessary to indicate the intended purpose of a product, in particular as accessories or spare parts,

provided that such use is made in accordance with honest practice in industrial or commercial matters.

7. The exclusive right in a mark shall not include the right to prohibit use in the course of trade of a similar sign deriving its protection from an earlier right of local scope if such right is recognized under the statutory provisions of one of the Benelux countries and within the limits of the territory on which it is recognized.

8. The exclusive right shall not include the right to prohibit use of a mark for goods which have been put on the market in the European Economic Community under that mark by the proprietor or with his consent, unless there exist legitimate reasons for the proprietor to oppose further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

B. In judging the similarity of goods or services, the administrative classification adopted for the registration of marks shall not be used as a criterion.

C. The exclusive right to a mark worded in one of the national or regional languages of the Benelux territory shall extend as of right to its translation into any other of the said languages.

Judgment of resemblance resulting from translations involving one or more languages foreign to the said territory shall be vested in the court.

Article 13bis

1. The proprietor of a mark shall have the faculty of claiming ownership of any moveable goods that have infringed his right or of goods that have served to produce such goods or to demand that they be destroyed or rendered unusable. Such claim may also be asserted with regard to the amounts of money presumed to have been obtained as a result of the infringement of the right in the mark. The petition shall be rejected if the infringement was not made in bad faith.

2. The provisions of domestic law relating to withholding measures and enforcement of court decisions and authentic acts shall be applicable.

3. The court may order that surrender shall be subject to payment by the plaintiff of an indemnity that it shall determine.

4. A licensee shall be entitled to exercise the faculties referred to in paragraph 1 where their purpose is to protect the rights whose exercise has been assigned to him and subject to having obtained the authorization of the proprietor of the mark to such end.

5. At the request of the proprietor of a mark, the court may order the person who has infringed his right to supply to the proprietor all information at his disposal with respect to the origin of the objects that have infringed the mark and to communicate to him all relevant data.

Article 14

A. Any interested party, including the Crown's Attorney and Public Prosecutor, may invoke the nullity:

1.

(a) of the filing of a symbol which, pursuant to Article 1, is not considered a mark, in particular where it is devoid of any distinctive character within the meaning of Article 6*quinquies* B(2) of the Paris Convention;

(b) [deleted];

(c) of a filing under which, pursuant to Article 4, items 1 and 2, of this Law, no trademark right is acquired;

2. of a filing under which, pursuant to Article 4, item 3, no trademark right is acquired, subject to the condition that nullity must be invoked within a period of five years from the filing date.

Where the action for nullity is instituted by the Crown's Attorney and Public Prosecutor, the Courts of Brussels, The Hague and Luxembourg shall have exclusive jurisdiction in the cases mentioned hereinabove. The institution of action by the Crown's Attorney and Public Prosecutor shall stay any other suit instituted on the same grounds.

B. Provided that the proprietor of the prior registration or the third party referred to in Article 4, items 4, 5 and 6, is a party to the proceedings, any interested party may invoke the nullity:

1. of a registration which, in the order of priority, ranks after that of a like mark according to the provisions of Article 3, second paragraph;
2. of a registration in respect of a filing under which, pursuant to Article 4, items 4, 5 and 6, no trademark right is acquired; nullity under the provisions of the said item 4 must be invoked within a period of three years from the expiration of the prior registration, whereas nullity under the provisions of the said items 5 and 6 must be invoked within a period of five years from the filing date.

C.

1. Any interested party may invoke the lapse of a right in a mark in the cases referred to in Article 5, paragraph 2. Lapse of the right in a mark under the provision contained in Article 5, paragraph 2(a) may no longer be invoked if, between the expiry of that period of five years and the submission of the request for revocation normal use of the mark has been begun or resumed. However, any beginning or resumption of use that takes place within the three months preceding submission of the request for revocation shall not be taken into consideration if the preparation for beginning or resuming use only took place after the proprietor had learnt that a request for revocation could be submitted.

2. The proprietor whose right in a mark of which the lapse may no longer be invoked under subparagraph 1 may not invoke nullity of a filing in accordance with the provision in paragraph B where such filing has been made during the period during which the earlier right in the mark could be declared to have lapsed under Article 5, paragraph 2(a) nor prohibit use of the mark thus filed under Article 13A, paragraph 1(a), (b) and (c).

Article 14bis

1. Where the proprietor of an exclusive right in a mark has acquiesced, for a period of five consecutive years, in the use of a later mark while being aware of such use, he shall no longer be entitled to invoke nullity of the later filing on the basis of his earlier right under Article 14B, paragraph 1 nor prohibit use of the later mark under Article 13A, paragraph 1(a), (b) and (c) in respect of the goods for which such mark has been used, unless the filing of the later mark has been made in bad faith.

2. Acquiescence in the use of a later mark within the meaning of paragraph 1 shall not entitle the proprietor of the later mark to prohibit use of the earlier mark.

Article 15

A. The proprietor of a registration effected in respect of a Benelux filing may at any time request the cancellation of his registration. However, if a license is on record, then cancellation of the registration of the mark or the license can only be requested jointly by the proprietor of the registration and the licensee. The provision in the preceding sentence concerning cancellation of the registration of a mark shall apply in the event of registration of a security or of a seizure.

B. The cancellation shall be effective throughout the Benelux territory.

C. A renunciation—limited to part of the Benelux territory—of the protection resulting from an international filing shall be effective throughout the said territory, notwithstanding any statement to the contrary made by the proprietor.

Article 16

A declaration of nullity of a filing, a declaration that a right to a mark has lapsed, and a voluntary cancellation of a registration must relate to the entire symbol constituting the mark.

A declaration of nullity or of lapsing of rights must be limited to a given number of the goods or services in respect of which the mark is registered, in the event that the grounds for the nullity or lapsing of rights only relate to part of such goods or services.

Voluntary cancellation may be restricted to a given number of the goods or services in respect of which the mark is registered.

Article 17

A. Over and above the duties conferred on it by the provisions of the preceding Articles, the Benelux Office shall be entrusted with:

1. introducing modifications in registrations, either at the request of the proprietor, or as a result of notifications from the International Bureau for the Protection of Industrial Property or of court decisions, as well as, where appropriate, notifying the International Bureau thereof;
2. issuing a monthly publication in the Dutch and French languages in which registrations of Benelux filings shall appear and which shall contain all other indications prescribed by the Rules;
3. providing copies of registrations at the request of any interested party.

B. The amount of the fees to be collected for the operations referred to in paragraph A of this Article, as well as the prices of the monthly publication and of the copies, shall be fixed by Rule.

Article 18

By virtue of this Law, nationals of the Benelux countries, as well as nationals of countries outside the Union established by the Paris Convention who have their domicile or a real and effective industrial or commercial activity in the Benelux territory, may claim the benefits, throughout the said territory, of the provisions of the said Convention and of the Madrid Agreement.

Chapter II Collective Marks

Article 19

Collective marks shall be considered to be all symbols designated as such at the time of filing and which serve to distinguish one or more common features of goods or services originating from different enterprises that affix the mark under the control of the proprietor.

The proprietor shall not be allowed to make use of the mark for goods or services originating from his own enterprise or from enterprises in the management or superintendence of which he participates either directly or indirectly.

All signs so designated on filing shall also be considered collective marks if they serve in the course of trade to designate the geographical origin of goods. Such mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs in accordance with

honest practice in industrial or commercial matters; in particular, such a mark may not be invoked against a third party who is entitled to use such a geographical name.

Article 20

Unless otherwise provided, individual and collective marks shall be subject to the same rules.

Article 21

An exclusive right to a collective mark shall be acquired only if the mark is accompanied, when filed, by regulations for use and control thereof.

However, where international filing is concerned, the applicant may still file such regulations during a period of six months from the notification of the international registration provided for in Article 3(4) of the Madrid Agreement.

Article 22

The regulations for use and control of a collective mark must state the common features of the goods or services which the mark is intended to guarantee.

They must also set forth the manner in which proper and efficient control of such features is to be exercised, together with the adequate sanctions incidental thereto.

Article 23

Article 4, item 3, shall not apply to the filing of a collective mark by the former proprietor of the registration of a like collective mark or by his successor in title.

Article 24

Without prejudice to the application of Articles 6, 6bis and 8, the Benelux Office shall not be allowed to register the Benelux filing of a collective mark if the regulations for use and control of the said mark have not been filed in accordance with the provisions of Article 21.

Article 25

The proprietors of collective marks shall be obliged to notify the Benelux Office of any modification of the regulations for the use and control of the mark. Such notification shall be recorded by the Benelux Office.

The modification shall not become operative prior to the notification prescribed in the preceding paragraph.

Article 26

The right to institute legal proceedings for the protection of a collective mark shall exclusively accrue to the proprietor of such mark.

The regulations for use and control may, however, confer on persons to whom the use of the mark has been granted the right to bring a claim jointly with the proprietor or to become party to any action or to intervene in any proceedings instituted by or against the latter.

Likewise, the regulations for use and control may also provide that the proprietor, acting alone, may assert the individual interests of the users of the mark and may incorporate in his claim for indemnification particular damages sustained by one or more of them.

Article 27

A. Without prejudice to the provisions of Article 14, any interested party, including the Crown's Attorney and Public Prosecutor, may invoke the lapse of a right to a collective mark in the event that the proprietor uses the mark in the circumstances referred to in Article 19, second paragraph, or agrees to a use in violation of the provisions of the regulations for use and control, or tolerates such use.

Where the action for forfeiture is instituted by the Crown's Attorney and Public Prosecutor, the Courts of Brussels, The Hague and Luxembourg shall have exclusive jurisdiction.

The institution of action by the Crown's Attorney and Public Prosecutor shall stay any other suit instituted on the same grounds.

B. The Crown's Attorney and Public Prosecutor may invoke the nullity of the filing of a collective mark whenever the regulations for use and control are contrary to public policy or are not in accordance with the provisions of Article 22. The Crown's Attorney and Public Prosecutor may also invoke the nullity of modifications of the regulations for use and control if they conflict with public policy or the provisions of Article 22, or if they would result in impairing the guarantees given to the public by the said regulations.

The Courts of Brussels, The Hague and Luxembourg shall have exclusive jurisdiction in such proceedings; they shall *ex officio* order the cancellation of registrations of filings or modifications declared null and void.

Article 28

Collective marks which have lapsed, have been declared null and void or have been cancelled, as well as those in respect of which no renewal has taken place and no restoration as provided for in Article 23 has been made, shall, during the three years following the date of the recording of the lapse, nullification or cancellation, or the expiration of the non-renewed registration, on no account be used save by a person who can rely on a prior right to a like individual mark.

Chapter III
Transitional Provisions

Article 29

Subject to the conditions laid down in Article 30, the exclusive rights to individual and collective marks acquired under national law in any one of the Benelux countries prior to the date of the entry into force of this Law, and which have not expired at that date, shall be maintained. As from the said date, this Law shall apply to such rights.

An exclusive right shall also be deemed to have been acquired by the first use of a symbol which serves to distinguish the goods or services of an enterprise and which would have constituted a mark if Articles 1 and 2 of this Law had been applicable. An exclusive right thus deemed to have been acquired shall, however, not be capable of being invoked against any person who used the said symbol prior to the date of the entry into force of this Law, unless the use relied upon was followed by non-use for an uninterrupted period of five years.

Article 30

A right acquired to a mark shall terminate with retroactive effect to the date of the entry into force of this Law if, at the expiration of a period of one year from that date, no Benelux filing of the mark has been effected claiming the existence of the right acquired and indicating, for purposes of information, the nature and date of the facts which caused it to come into existence and, where

applicable, the filings and registrations made in respect of such mark. This filing shall take the place of filings made of the mark in one or more of the Benelux countries, without prejudice to rights acquired as a result of such filings. However, if the person effecting the filing should claim any acquired right when he knows or has no valid excuse for not knowing that such a right does not exist, the filing shall be deemed to have been made in bad faith.

Where, on the date of the entry into force of this Law, a right to a mark results from an international filing based on a registration of origin outside the Benelux territory, maintenance of such right shall be independent of the conditions prescribed in the preceding paragraph.

A right acquired to a collective mark shall, moreover, terminate with retroactive effect to the date of the entry into force of this Law if no regulations for use and control are submitted with the Benelux filing referred to in the first paragraph hereinabove. Articles 22, 24 and 27B shall apply in such cases.

Where a right to a collective mark results from an international filing based on a registration of origin outside the Benelux territory, such right shall terminate with retroactive effect to the date of the entry into force of this Law if, at the expiration of a period of one year from the said date, the proprietor of the collective mark has not filed regulations for use and control. Articles 22 and 27B shall apply in such cases.

Article 31

Notwithstanding the provisions of Article 10, the first registration of the Benelux filings referred to in Article 30 shall have a term of from one to 10 years. The said term shall expire, in the month and on the day of the Benelux filing, in the year which comprises the same final digit as that of the year in which the right acquired and relied upon originated.

The first renewal of such registrations may be requested at the time of filing for the duration provided for in Article 10.

Article 32

An exclusive right to a mark maintained under Articles 29 and 30 shall extend to the entire Benelux territory as from the date of the entry into force of this Law.

This right shall not, however, extend to the territory of those Benelux countries:

- (a) where it would constitute an infringement of a right acquired by a third party and maintained under Articles 29 and 30;
- (b) where it emerges that there is a ground for nullity as referred to in Article 14A.1(a) and (c) and 2, in Article 14B.2, and in Article 27B.

Where two persons possess respective rights that have been acquired in the same mark in two of the Benelux countries, extension to the third country shall be effected for the benefit of the person who, prior to the entry into force of this Law, first used the mark in a normal manner in the said country. In case of non-use of the mark in the said country at the time of the entry into force of this Law, extension shall be effected for the benefit of the person whose acquired right is older.

Article 33

Where any mark belongs, by virtue of Article 32, to different proprietors in two or three of the Benelux countries, the proprietor of the mark in any one of those countries may not oppose importation of goods or services bearing the same mark and originating from another Benelux country, or claim damages for such importation, if the mark was affixed in the other country by the proprietor of the mark or with his authorization and relations of an economic nature exist between the two proprietors in respect of the exploitation of the goods or services concerned.

Article 34

A. As from the day following the date of the entry into force of this Law, the Benelux Register shall be open for the filing of marks. As from the date of the said entry into force, national filings of marks shall no longer be admissible.

B. The Benelux filings referred to in Article 30 shall be exempt from the payment of any fees and shall be effected in the manner prescribed by the Rules. The registration of the said filings shall mention the claim to the acquired right and the indications relevant thereto.

C. International filings based on a registration of origin outside the Benelux territory and existing on the date of the entry into force of this Law shall be entered *ex officio* in the Benelux Register free of charge, unless the proprietors have renounced the protection resulting therefrom for all Benelux countries.

Article 35

The Benelux filings referred to in Article 30, regardless of their actual date, and the international filings entered in the Benelux Register as provided for in Article 34C, shall, for the determination of their order of priority with respect to Benelux filings effected without a claim to an acquired right, be deemed to have been made on the date of the entry into force of this Law.

The order of priority of the rights acquired in a Benelux country within the meaning of Article 29 shall be determined in that country in accordance with the national law obtaining prior to the entry into force of this Law.

Chapter IV
General Provisions

Article 36

In this Law, the expression “Benelux territory” refers to the joint territories of the Kingdom of Belgium, the Grandduchy of Luxembourg and the Kingdom of the Netherlands within Europe.

Article 37

A. Unless otherwise expressly stipulated by contract, jurisdiction in respect of mark cases shall be determined by the domicile of the defendant or by the place where the undertaking giving rise to the litigation originated or was or is to be performed. The place where a mark was filed or registered can on no account serve in itself as a basis for the determination of jurisdiction.

If the criteria laid down hereinabove should be insufficient for the determination of jurisdiction, then the plaintiff may file the action before the court of his domicile or residence, or, if he has no domicile or residence within the Benelux territory, before the Courts of Brussels, The Hague or Luxembourg, at his option.

B. The courts shall apply the rules of paragraph A *ex officio* and shall explicitly establish and record their competency.

C. The court before which the principal claim referred to in paragraph A is pending shall take cognizance of requests that the plaintiff put up security, requests for intervention, incidental claims and counterclaims, unless it should be incompetent on the ground of *ratione materiae*.

D. The courts of any one of the three countries shall, at the request of one of the parties, transfer disputes brought before them to the courts of one of the other two countries if such disputes are already pending before the latter courts or are fundamentally related to other disputes submitted to the said latter courts. Such transfer may only be requested if the causes are pending in first instance. It shall be made to the court before which the case was first brought by a declaration instituting

action, unless another court has given an earlier judgment in the matter concerned-and such judgment does not merely relate to internal procedure-in which case the transfer shall be made to such other court.

Article 38

The provisions of this Law shall be without prejudice to the application of the Paris Convention, the Madrid Agreement, and Belgian, Luxembourg or Netherlands legal provisions which might entail a prohibition to use a given mark.

Chapter V Service Marks

GENERAL PROVISIONS

Article 39

Chapters I, II, IV, VI and VII shall apply, *mutatis mutandis*, to signs which serve to distinguish services, hereinafter “service marks,” it being understood that services and goods may also be similar.

The priority right provided for in Article 4 of the Paris Convention may also be claimed in respect of service marks.

TRANSITIONAL PROVISIONS

Article 40

A. Any person who, on the date of entry into force of the present Protocol Amending the Uniform Benelux Trademark Law, uses a service mark on Benelux territory and who, within one year as from that date, files a Benelux application for registration of that mark, shall be deemed, for the purpose of determining his priority, to have filed the application on the said date.

B. The provisions of this Chapter shall not alter the rights resulting from the use of a service mark on Benelux territory on the said date.

C. The nullity of a service mark filing mentioned under A may not be invoked for the sole reason that its date is later than that of a similar trademark.

Article 41

On making the Benelux filing mentioned in Article 40, which shall be made according to the formalities and accompanied by the payment of the official fees prescribed in the Regulations, the applicant shall also:

- claim the existence of the acquired right;
- state, solely for the purpose of Article 42, the year of first use of the service mark.

However, if the applicant claims an acquired right for the service mark knowing, or with no valid excuse for not knowing, that the right does not exist, the filing shall be deemed to have been effected in bad faith.

Article 42

Notwithstanding the provision of Article 10, the first registration of the Benelux filings provided for in Article 40 shall have a term of validity from one to 10 years. The said term shall

expire on the anniversary date of the Benelux filing during the year whose last digit is the same as that of the year during which the first use stated has taken place.

The first renewal of such registrations may, for the duration provided for in Article 10, be applied for on the occasion of the filing.

Article 43

The Benelux Register shall be open for the filing of service marks on the day following the date of entry into force of the Protocol mentioned in Article 40.

The registration of the Benelux filings provided for in Article 40 shall mention the claim of an acquired right and the year of first use of the service mark.

Chapter VI **Provisions on Community Trade Marks**

Article 44

Article 3, paragraph 2 and Article 14B, paragraph 1 shall apply where the registration is based on the prior filing of a Community trade mark.

Article 45

Article 3, paragraph 2 and Article 14B, paragraph 1 shall apply to Community trade marks for which seniority on the Benelux territory is validly claimed in accordance with the Regulation on the Community trade mark even if the Benelux or international registration on which seniority is based has been voluntarily cancelled or has expired.

Article 46

Where the seniority of a right in an earlier mark is invoked with respect to a Community trade mark, nullity or revocation of such earlier right may be invoked even if the right has already lapsed due to voluntary cancellation or to expiry of the registration.

Article 47

The Benelux Trademark Office shall enter in the Benelux Register those marks that are registered in accordance with the Regulation on the Community trade mark.

Article 48

The provisions of this Law shall not affect application of the Regulation on the Community trade mark.

Chapter VII **Provisions on International Filings**

Article 49

The provisions of this Law on international filings made under the Madrid Agreement shall apply to international filings made under the Protocol Relating to the Madrid Agreement of June 27, 1989.