



Trademarks

in 43 jurisdictions worldwide

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1 Ownership of marks

Who may apply?

Belgian or foreign legal and natural persons may file applications for trademark registrations. The applicant must not conduct an industrial or commercial activity; consequently, holdings, non-profit organisations and foundations may apply for a trademark registration.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

Under the Benelux Treaty, the following can be registered as trademarks:

- denominations and names;
- drawings, prints and seals;
- letters and numbers;
- product shapes and packaging; and
- any other sign that is capable of being represented graphically and capable of distinguishing products or services.

Trademarks are usually divided into three categories:

- verbal, nominative or auditive trademarks;
- graphical or figurative trademarks; and
- complex or composed trademarks.

A new category has recently been established: olfactory trademarks.

Signs that exclusively consist of a shape that is determined by the nature of goods, that gives substantial value to goods, or that are necessary to obtain a technical result, cannot be registered as a trademark.

Finally, the following are also excluded from registration:

- signs that are contrary to public order or moral principles of one of the Benelux member states or whose prohibition or invalidation is provided by article 6ter of the Paris convention;
- signs that are deceptive (for example, relating to nature, quality or geographical origin of goods or services);
- signs that are similar to an earlier trademark registered for identical goods and services;
- signs that may be confused with a famous trademark;
- signs that have been applied for in bad faith; and
- signs used for wines and spirits containing a geographical indication of wines or spirits that do not originate from the geographical indication except if the application was made in good faith before 1 January 2000 or before the geographical indication was granted protection.

3 Obtaining a trademark

How long does it typically take, and how much does it typically cost to obtain a trademark registration?

If no opposition is filed, it generally takes four months from the application date to obtain the registration. The applicant can file an application online or fill out the form available on the website of the Benelux Office for Intellectual Property (BOIP) and send it to the BOIP by post. The application will be examined and published. Within two months following the publication, an opposition may be filed. After expiration of this two-month period, and subject to complying with all formalities (payment of taxes, examination, etc), the trademark will be registered.

The typical cost is €240 for obtaining an individual trademark registration up to three classes. A supplementary cost of €37 will be charged for each registration in an additional class. Registration of a collective trademark costs €373 for a maximum of three classes; additional class registrations cost €37 each.

4 Classification system

What classification system is followed, and what goods or services may be claimed?

Goods and services are classified according to the Nice Agreement concerning the International Classification of Goods and Services (the Nice Classification). The Nice Classification establishes 45 classes. The applicant may apply for multiple classes. The class number as well as the standard definition must be indicated in the application.

5 Conflicts with other trademarks

Are applications examined for conflicts with other trademarks? What is the procedure followed in the Trademark Office?

Before 1 January 2006, an examination of anteriority was made for each application. Nowadays, the BOIP does not make any anteriority examination unless it is requested by the applicant. When proceeding with an anteriority examination, the BOIP checks the *Recueil des marques Benelux*, the *Registre communautaire* and the *Registre international*. The Benelux Office informs the applicant of the results without taking any decision.

6 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before a registration is granted? Does proof of use have to be submitted? If registration is granted without use, is there a time by which use must begin to maintain the registration?

No particular use of a trademark needs to be claimed to obtain trademark protection. However, any third party may challenge the registration if the trademark is not normally used on Benelux territory

during an uninterrupted period of five years. To assess whether there has been a normal use of the trademark, all circumstances must be taken into account, such as the nature of the product and the type of company. The use must be related to the goods or services for which the trademark was registered.

Uses made by third parties and allowed by the trademark-holder as well as the mere apposition of the sign on goods or on their packaging intended to be exported are considered a normal use. The trademark-holder may avoid the invalidation of the trademark if it can demonstrate a 'proper reason'.

7 Appealing a denied application

Is there an appeal process if the application is denied?

If BOIP denies an application, the applicant may initiate appeal procedures before the Court of Appeal of Brussels, The Hague or Luxembourg.

8 Third parties

May a third party oppose registration or seek cancellation of a trademark or service mark? What are the procedures?

The applicant or the holder of a prior trademark may oppose the registration of a trademark:

- that is identical to its own trademark and registered for identical goods or services;
- that is identical or similar to its own trademark and registered for identical or similar goods or services when there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trademark; or
- that is likely to create confusion with a famous trademark as defined in article 6bis of the Paris Convention.

The opposition must be filed in writing. It must be filed with the BOIP within two months following the month of publication of the application and is subject to the payment of an opposition tax. The decision of the BOIP may be appealed with the Court of Appeal of Brussels, The Hague or Luxembourg.

Any third party may ask for the cancellation of a trademark on absolute and relative grounds of nullity. A cancellation decision is retroactive and has effect erga omnes. A third party may also ask for the invalidation of the trademark for absence of use (see question 6).

Cancellation procedures must be initiated before the commercial courts. The decision may be appealed with the competent Court of Appeal.

9 Duration and maintenance of registration

How long does a registration last and what is required to maintain a registration?

The term of protection of a trademark is 10 years from the application date. The registration can be renewed indefinitely, for periods of 10 years. An application for renewal must be filed within the six months preceding the trademark's expiration. The tax must be paid within the same period. There is a six-months grace period if payment is not made by the renewal date. An additional fee will then have to be paid.

10 The benefits of registration

What are the benefits of registration?

The registration grants exclusive rights to the trademark-holder. Indeed, the registration also grants the exclusive right to prevent any third party not authorised by the trademark-holder from using:

- a sign that is identical to a trademark in relation to goods or services that are identical to those for which the trademark is registered;
- a sign that is identical or similar to a trademark in relation to goods or services that are identical or similar to those for which the trademark is registered, if there exists a likelihood of confusion on the part of the public, including the likelihood of association between the sign and the trademark;
- a sign that is identical or similar to a trademark in relation to goods and services that are not similar to those for which the trademark is registered, if the latter is well known in Benelux and if use of that sign, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the trademark; or
- a sign for another purpose than to distinguish goods or services, if use of that sign, without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trademark.

When a sign has not been registered as a trademark, one will not be able to claim any protection unless if the sign is a famous trademark as defined in article 6bis of the Paris Convention.

A trademark can also be assigned to third parties or be the subject of exclusive or non-exclusive licences.

11 Assignment

What can be assigned? Trademark with goodwill? Without goodwill?

All or some of the goods and services? Must other business assets be assigned to make it a valid transaction?

A trademark can be assigned with or without goodwill and in respect of all or part of the relevant goods or services. However, the assignment must apply to the entire territory of Benelux. In contrast, licences can be limited to part of the Benelux territory.

12 Assignment documentation

What documents are required?

An assignment must be made in writing in order to be valid. No specific format is required.

13 Validity of assignment

Must the assignment be recorded for validity?

The assignment need not be recorded to be valid. However, in order to be enforceable against third parties other than infringers, such as creditors, the assignment or licence must be notified to the BOIP, which shall make a public notice of such notification. The production of a copy or an extract of the agreement is sufficient. However, the BOIP may investigate further and ask for originals.

14 Security interests

Are security interests recognised?

In order to be binding enforceable against third parties, securities and garnishments must be notified to the BOIP, which shall make a public notice of such notification.

15 Markings

What words or symbols can be used to indicate trademark use or registration? Do these words or symbols have to be used? What are the benefits of using them and the risks of not using them?

There is no requirement to use a word or a symbol to indicate trademark use or registration. The use of a symbol or a sign does not

change a right into an application or registration. Conversely, such use does not reduce any right into an application or registration.

16 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce trademark rights against an infringer, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark enforcement?

The trademark-holder can initiate various types of civil proceedings to enforce its rights. The main proceedings are the following:

- The holder can initiate summary proceedings. The claim must be brought before the president of the competent commercial court.
- The holder can initiate fast track proceedings on the merits. The claim must also be brought before the president of the competent commercial court. In contrast to summary proceedings however, this is a proceedings on the merits. The holder may request the president for the termination of the infringement, but cannot request damages.
- The holder can initiate standard proceedings on merits where he cannot only request for the termination of the infringement, but can also request for damages, whether related to the period preceding the registration of the trademark or thereafter. In order to assess the damages, the judge can order the infringer to disclose any information on the origin of the infringement and on the distribution networks.
- The holder can also initiate a *saisie-contrefaçon*, a type of ex parte proceedings aimed at gathering evidence, where it can request for the description and seizure of infringing goods (see question 17).

Since 1 September 2007, only commercial courts are entitled to deal with trademark cases. The Belgian court system was amended so that the commercial court could become specialised in the field of intellectual property to allow a better handling of cases.

Criminal proceedings are also at hand and may even be initiated by any person that suffered damages because of the infringement. The infringer may be sentenced to up to three years of imprisonment and may be ordered to pay up to €100,000 in fines. Should the offence be repeated, these sentences may be doubled. The confiscation of the infringing goods can be ordered as well as their destruction. Finally, publication of the decision can be ordered.

To conclude, the trademark-holder and any holder of rights into the trademark may initiate a customs action against goods suspected of infringing the trademark rights.

17 Procedural format and timing

What is the format of the infringement proceeding? Is discovery allowed? Live testimony? Experts? Who decides the case? How long does the proceeding typically last? If there is a criminal enforcement mechanism, what is that procedure?

Before initiating any action, the trademark holder may initiate *saisie-contrefaçon*, a type of ex parte proceedings aimed at gathering evidence. If granted, a court-appointed expert may enter the premises where useful information on the infringement, including the infringing goods themselves, is suspected to be kept. In the framework of *saisie-description*, one can also obtain the seizure of the goods.

US-style discovery is inexistent in Belgian procedural law. All parties must however cooperate in the provision of evidence. A judge may order a party to submit evidence it is suspected to hold.

Although allowed, live testimony is very unusual. Experts may be appointed by the court.

On the merits, a claim can be brought before the commercial court. In the first instance, the procedure may last from one to two years. The court may ask an expert to assess the damages, the existence and the scope of the infringing activities, the notoriety or reputation of a trademark or other points where the intervention of an expert may be appropriate.

As a result of the Act dated 15 May 2007, criminal prosecution is no longer subject to the prior filing of a complaint by the holder. However, this Act now also provides in a possibility for settlement. As a result, the case will not go to trial.

18 Burden of proof

What is the burden of proof to establish infringement or dilution?

The plaintiff must first prove that it is the rights-holder of a valid trademark, and must also prove that the trademark has been infringed and that such infringement caused damages.

Damages can be demonstrated on the basis of the production of expert reports, accountancy documents and through the *saisie-contrefaçon* procedure.

The party which claims that the trademark is diluted must provide the relevant evidence thereof.

19 Standing

Who may seek a remedy and under what conditions? Who has standing to bring a criminal complaint?

Trademark-holders may initiate claims aimed at the enforcement of the trademark and the payment of damages. Licensees may always join the claim brought by the trademark holder in order to seek compensation for damages. Licensees may initiate damage proceedings on their own initiative if they have obtained the holder's explicit consent.

Any person suffering damages because of an infringement may file a criminal complaint.

20 Foreign activities

Can activities that take place outside the country support a charge of infringement or dilution?

Activities that exclusively take place outside Belgium cannot justify legal action before Belgian courts. Nevertheless, actions implying the same parties and concerning the same object, brought before different Benelux courts, may be joined and brought before the court that was first seized. Actions taking place exclusively outside Belgium may be relevant in legal actions brought before Belgian courts.

21 Discovery

What discovery devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

The plaintiff may request, even before the commencement of any proceeding on the merits, that a court orders protective measures to preserve evidence.

The main procedure is the *saisie-contrefaçon*. Under this procedure, the court may order the detailed description, the taking of samples and the physical seizure of the infringing goods and the materials and implements used in the production or distribution of these goods as well as any documents relating thereto. This procedure typically involves the appointment of an expert who must draft a report. Within the month of the release of the expert's report, the plaintiff must initiate proceedings on the merits before the competent court.

The court may also order the infringer to disclose any information related to the origin of the infringement and distribution networks.

22 Timing

What is the typical time frame for an infringement or dilution action, at the trial level and on appeal?

In first instance, cases generally last from one to two years. Appeal procedures equally last from one to two years. The timing may vary considerably depending on the circumstances of the case, the court's workload and the parties responsiveness.

23 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

Costs can range from €15,000 to €30,000 for each step in a procedure, but can be partially recouped (see question 25).

24 Appeals

What avenues of appeal are available?

Appeal procedures may be initiated with the competent court of appeal. A case can finally be brought before the Supreme Court. The Supreme Court examines questions of law and the application of the law to the particular elements of fact. However, the Supreme Court does not review the facts of a case. If the Supreme Court overrules a decision, the case is brought before another court of appeal.

25 Defences

What defences are available to a charge of infringement or dilution?

In addition to denying actual infringement, the defendant may also request that the trademark be invalidated.

Benelux trademark law also accepts acquiescence if the holder was aware of the infringing use for a period of five successive years and exhaustion, albeit the latter being limited to exhaustion in the EU.

The trademark shall also not entitle the holder to prohibit a third party from using, in the course of trade:

- its own name or address;
- indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods

or of rendering of the service, or other characteristics of goods or services; and

- the trademark, where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts (provided he uses them in accordance with honest practices in industrial or commercial matters).

Finally, the trademark shall not entitle the holder to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognised by the law and within the limits of the territory in which it is recognised.

26 Remedies

What remedies are available to a successful party in an action for infringement or dilution? How is monetary relief apportioned? Is injunctive relief available, preliminarily or permanently, and in what circumstances and under what conditions? What criminal remedies exist?

The trademark holder or licensee is entitled to remedies. The successful plaintiff may request the payment of damages for the loss suffered because of the infringing activities. However, damages are often difficult to assess. Courts frequently grant a lump sum. The plaintiff may request the transfer of profits made by the infringer and the publication of the decision.

According to a new law passed in 2007, the losing party may be ordered to pay the other party's attorneys' fees and costs. However, the system works with lump sums, which are generally insufficient for a full recouping. The amounts vary from a minimum of €150 up to a maximum of €30,000.

27 ADR

Are ADR techniques available and commonly used? What are the benefits and risks?

The Benelux Treaty provides that courts shall have exclusive jurisdiction in proceedings based on the Benelux Treaty. However, legal commentators share the view that the Treaty does not prevent any mediation or arbitration. ADR is not commonly used.



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