

International

Benelux completes implementation of trademark opposition procedure

The phased introduction of the Benelux trademark opposition procedure will finally be completed on January 1 2006. The Benelux Trademark Office (TO) has announced that, as of January 1 2006, all new Benelux trademark applications may be subject to third-party opposition.

The first phase of the procedure was launched in 2004, when oppositions could be filed only against applications in Classes 2, 20 or 27 of the Nice Classification; this covered only 767 of approximately 23,000 applications filed that year. In 2005 seven further classes were added. From 2006, applications in all classes will be open to opposition. In the meantime, if a respondent's filing covers classes other than those for which an opposition can presently be filed, the entire filing may be opposed. The phased introduction, similar to that implemented by the French Trademark Office when introducing its opposition system, was adopted in order to give the TO time to gain experience and adapt its internal organization.

An opposition may be filed by the holder of a Benelux, Community or international trademark application or registration. Licensees are also entitled to file oppositions, provided that they have the holder's explicit consent.

An opposition must be filed within two months of the first day of the month following that in which the application is published. In principle, opposition proceedings begin two months after the TO has notified the parties in writing that an admissible opposition has been filed. This two-month period is intended to give the parties time to try to resolve the matter without the intervention of the TO; it may be extended if the parties so request.

Opposition proceedings begin once this cooling-off period expires. The petitioner (ie, the party opposing the trademark) has two months in which to file its arguments. The respondent has the same amount of time in which to reply. The respondent may demand proof of the use of the trademark that forms the basis of the opposition, in which case the petitioner has two further months in which to produce such evidence. The respondent must then submit its response within two months.

Once the parties have filed all relevant arguments and evidence, the TO may request additional information from either party and organize a hearing before rendering its decision. Decisions may be appealed within two months to the courts of appeal in the Hague, Brussels or Luxembourg. The respective jurisdiction of these courts depends, in descending order of importance, on:

- the respondent's address;
- the address of the respondent's representative; and
- the correspondence address indicated in the filing.

If none of these address is in a Benelux country, the petitioner's address or that of its representative is taken into consideration. If no relevant Benelux address can be found, the appellant may choose one of the three courts mentioned above.

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