



# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2018

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# Netherlands

Jaap Bremer



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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Benelux Office for Intellectual Property (The Hague, The Netherlands) (“BOIP”) deals with the registration of Benelux trade marks, opposition proceedings and forwarding international trade mark applications to the World Intellectual Property Organization (“WIPO”).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Benelux Convention on Intellectual Property (“BCIP”) governs Benelux trade mark registrations, while practical aspects are set out in the Implementing Regulations under the BCIP (“IRBCIP”).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Names, drawings, imprints, stamps, letters, numerals, shapes of goods or packaging and all other signs that can be represented graphically and that serve to distinguish the goods or services of an undertaking can enjoy Benelux trade mark protection (art. 2.1 sub 1 and 3 BCIP). Examples of such “other signs” include sounds, colours and colour schemes. The graphical representation requirement will be abandoned after the implementation of Directive (EU) 2015/2436 (“EUTMD”), which is likely to open the door to the registration of other non-traditional signs as trade marks.

### 2.2 What cannot be registered as a trade mark?

Signs consisting solely of a shape which (i) results from the nature of the goods, (ii) gives a substantial value to the goods, or (iii) is necessary to obtain a technical result cannot be registered (art. 2.1 sub 2 BCIP). Further, a trade mark can be refused on other absolute grounds (see question 3.1).

### 2.3 What information is needed to register a trade mark?

Besides its personal data, the applicant has to include a graphical representation of the trade mark, indicate whether it concerns an

individual or collective mark, describe the sort of mark (e.g. word, device, word-device, shape, colour, sound) and describe what colours or other distinctive elements (if applicable) the mark consists of.

The goods and services requested have to be described (based on the Nice Classification (see question 2.6)). To claim priority, evidence needs to be submitted. Optionally, details of the representative may be included (art. 1.1 sub 1 IRBCIP).

### 2.4 What is the general procedure for trade mark registration?

A form containing the information mentioned under question 2.3 has to be submitted to the BOIP. The BOIP will check whether the formal requirements have been fulfilled and whether the goods/services have been classified correctly and, if so, will publish the application. Thereafter, it will perform a substantive examination of the trade mark on absolute grounds.

After publication, third parties may file an opposition against the application. If the assessment on absolute grounds has been approved and no opposition has been filed, or if the opposition has been dismissed, the mark will be registered.

It is possible to file an accelerated application, resulting in immediate registration provided the formal requirements have been met. Substantive examination and opposition will take place after registration.

### 2.5 How is a trade mark adequately represented?

The application has to depict the word, word-device or device mark. A 3D mark or other type of mark “should be specified” (art. 1.1 sub 1 IRBCIP). Representation has to be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

### 2.6 How are goods and services described?

The applicant must specify the goods and services for which protection is requested. These will be automatically allocated by means of the Harmonised Database. Terms not featured in the database can be used, but require inspection by the BOIP.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A Benelux mark has a unitary character and is valid in Belgium,

The Netherlands and Luxembourg together. With respect to the special Dutch municipalities of Bonaire, Saint Eustatius and Saba, a separate application has to be filed via the CaribIE department of the BOIP ([www.caribie.nl](http://www.caribie.nl)), based on the BES Trade Mark Act (*Wet merken BES*).

## 2.8 Who can own a trade mark in your jurisdiction?

Natural and legal persons, domiciled in and outside the Benelux, can own a Benelux trade mark registration.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. If a trade mark lacks inherent distinctiveness, proof of distinctiveness acquired through use must be filed together with the application to the BOIP.

## 2.10 How long on average does registration take?

The application will usually be published within one working day after filing. If no opposition is filed, the mark will be registered soon after expiry of the two-month opposition period, which proceedings commence at the date of the publication of the application. If opposition proceedings have been initiated, registration will take considerably longer.

With accelerated registration, the trade mark is registered as soon as the formalities have been completed. This procedure can be completed within a few days.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The BOIP charges a fee for filing an individual Benelux trade mark application (in three classes) of €248. The fee for a collective mark (in three classes) is €385. Per additional class, a supplement of €39 is charged. The supplement for an accelerated registration is €199 (three classes, plus a €31 supplement per additional class). Filing a description of the distinctive elements costs an extra €40. All costs are exclusive of professional representatives' fees.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No; the regular and accelerated routes mentioned under question 2.4 are the only ways.

## 2.13 Is a Power of Attorney needed?

When filing an application, a professional representative does not need to submit a Power of Attorney to the BOIP, which assumes that the representative is authorised to act on behalf of the interested party (art. 3.7 sub 1 IRBCIP). In case of doubt, the BOIP is allowed to ask for a Power of Attorney.

However, a request for surrender of a trade mark registration should come with a Power of Attorney (art. 3.7 sub 2 IRBCIP).

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not necessary.

## 2.15 How is priority claimed?

Priority shall be claimed with the application (art. 2.6 BCIP *io.* art. 1.4 sub 1 URBCIP). The country, date, number and holder of the priority application should be mentioned (art. 1.4 URBCIP). Priority may also be claimed in the month following filing, by a special declaration submitted to the BOIP.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

The BCIP provides for protection of Collective marks (art. 2.34 BCIP *io.* art. 1.2 IRBCIP). The BCIP does not specifically provide protection for Certification marks as such, but they are commonly considered to fall within the category of Collective marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The BOIP shall refuse to register sign which (art. 2.11 BCIP):

- (i) cannot constitute a trade mark (see question 2.1);
- (ii) is devoid of any distinctive character;
- (iii) consists exclusively of a sign that may serve to designate characteristics of the goods or services;
- (iv) consists exclusively of signs or indications that have become customary in the language or practices of trade;
- (v) is against the principles of morality or public policy;
- (vi) is of such nature that it will deceive the public; or
- (vii) contains specific misleading geographic indications.

### 3.2 What are the ways to overcome an absolute grounds objection?

The only way to overcome an absolute grounds objection is to bring forward a defence stating, e.g., that the mark will not deceive the public or that it is not necessary to obtain a technical result, etc.

Defending oneself against a refusal due to a lack of distinctive character is done by proving acquired distinctiveness in a large part of the Benelux territory where the mark lacks inherent distinctiveness. This can be done by taking into consideration, amongst others: market shares; how intensive, geographically widespread and long-standing use of the mark has been; the investments done in promoting the mark; and what part of the relevant public identifies goods/services as originating from a particular undertaking due to perceiving the mark.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An intention of a refusal on absolute grounds will be motivated and communicated in writing (art. 2.11 sub 3 BCIP). The applicant can respond thereto. The response term is at least one month, but may be extended to six months (art. 1.15 sub 2 IRBCIP). A refusal can be appealed by initiating appeal proceedings within two months before the Courts of Appeal (art. 2.12 BCIP). The court having territorial jurisdiction (in Brussels, Luxembourg or The Hague) is determined by the address of the applicant or its representative. If neither the applicant nor its representative is domiciled within the Benelux, the



applicant may choose a court (art. 2.12 sub 3 BCIP). A decision can be appealed in its entirety before the Courts of Appeal. The Supreme Court only deals with points of law.

### 3.4 What is the route of appeal?

Written submissions (a brief setting out the grounds of appeal, followed by a statement of defence) will be exchanged and are usually followed by an oral hearing. When the appeal decision is handed down, a further appeal to the Supreme Court is possible (art. 2.12 sub 4 BCIP).

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

A trade mark can be refused registration in light of an earlier trade mark, which (art. 2.14 sub 1 *io.* 2.3 sub a–b BCIP):

- (i) is identical and filed for identical goods or services;
- (ii) is identical or similar and is filed for identical or similar goods or services, if there is a likelihood of confusion; or
- (iii) may give rise to confusion with a well-known trade mark, as meant in art. 6*bis* of the Paris Convention.

The BOIP does not refuse registration based on relative grounds *ex officio*, but only if the owner of an earlier trade mark has filed an opposition.

It is noted that after registration, the owner of an earlier right can request the cancellation of the later registration in court proceedings, arguing that the later mark is:

- (i) identical or similar and filed for similar or dissimilar goods or services, provided the earlier mark enjoys a reputation in the Benelux and use of the later mark takes unfair advantage of or is detrimental to the distinctive character or repute of the earlier mark;
- (ii) similar to a collective mark registered for similar goods or services, which benefited from a right which lapsed during the three years prior to filing (art. 2.4 sub d BCIP); or
- (iii) a trade mark registered in bad faith, if the owner of the later trade mark had knowledge of use of a similar mark for similar goods or service over the past three years: (a) in the Benelux; or (b) outside the Benelux, due to a direct relationship with the owner of the earlier right.

### 4.2 Are there ways to overcome a relative grounds objection?

The way to overcome a relative grounds objection in opposition proceedings is to successfully put forward a defence, e.g. arguing that the marks and/or goods are dissimilar, that there is no likelihood of confusion, etc.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3.

### 4.4 What is the route of appeal?

See question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

See question 4.1, points (i) to (iii).

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Every natural or legal person owning a trade mark registration with validity in the Benelux, or the owner of an unregistered trade mark which is well-known in the Benelux, as meant in art. 6*bis* of the Paris Convention, can initiate opposition proceedings.

### 5.3 What is the procedure for opposition?

An opposition notice is submitted to the BOIP within two months after publication of the application (art. 2.14 sub 1 BCIP). An opposition fee of €1,030 must be paid (for a maximum of three rights; there is an additional fee of €103 per additional right).

If the opposition is admissible, the opponent is notified and a two-month cooling-off period commences after filing, to try and achieve an amicable settlement. Further suspension of the proceedings is possible (up to three times) upon joint request of the parties.

If no settlement has been reached, the opponent must file his opposition grounds. The applicant must reply within two months. He may request proof of use of the earlier mark, if the latter has been registered for more than five years. The term for submitting proof of use is two months. If proof of use is submitted, the applicant has two months to respond to the submitted proof and, if he has not already done so, to the opponent's arguments.

Thereafter, the BOIP will render a decision, usually within three to six months after the last submission has been made.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The BOIP will convert the application into a registration, which will be visible in the online register. The trade mark applicant receives a certificate of registration.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights will commence upon the registration date of the trade mark.

### 6.3 What is the term of a trade mark?

A Benelux registration is valid for 10 years and may be renewed for further periods of 10 years, provided the renewal fee is paid. After five years, a registration becomes vulnerable to cancellation if the mark has not been put to genuine use.

#### 6.4 How is a trade mark renewed?

The BOIP will notify the trade mark owner in a letter that the registration needs to be renewed.

A trade mark can be renewed from six months prior to the expiry date, and up to six months thereafter, by submitting a form via the MyBOIP online portal.

Renewal fees are €268 (for an individual mark, up to three classes) and €489 (for a Collective mark, up to three classes), with an additional fee of €48 for every additional class and €133 for renewal in the six months after the expiry date.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Any natural or legal person can register the assignment of a trade mark.

#### 7.2 Are there different types of assignment?

Due to the unitary character, it is not possible to partition the registration geographically and assign the Benelux registration, for instance, only insofar as it covers Belgium (art. 2.31 sub 2(b) BCIP). Such partial transfer is null and void.

It is, however, possible to transfer a trade mark in respect of a selection of the goods/services for which it is registered (art. 2.31 BCIP). The trade mark registration will then be divided into two or more separate ones.

#### 7.3 Can an individual register the licensing of a trade mark?

Any natural or legal person can register the licensing of a trade mark.

#### 7.4 Are there different types of licence?

A trade mark may be licensed for all or a selection of the goods or services for which it is registered (art. 2.32 sub 1 BCIP), as well as with respect to a part of the Benelux territory. Further, the licence may be granted on an exclusive basis (possibly with the exclusion of the trade mark owner itself) or on a non-exclusive basis.

#### 7.5 Can a trade mark licensee sue for infringement?

A licensee cannot take action to stop an infringement of a trade mark, for instance by claiming an injunction and/or a removal of infringing products from circulation, unless the trade mark owner has given the licensee Power of Attorney to take such action on his behalf.

However, a licensee has the right to join the trade mark owner in proceedings for the recovery of damages or missed profits, initiated by the trade mark owner (art. 2.32 sub 4 *io.* art. 2.21 sub 1–4 BCIP). A licensee may only bring such action independently, if it has obtained the permission of the holder for that purpose (art. 2.32 sub 5 BCIP).

#### 7.6 Are quality control clauses necessary in a licence?

No, this is not obligatory.

#### 7.7 Can an individual register a security interest under a trade mark?

Trade mark rights can be pledged. In order to ensure that the pledge can be invoked *vis-à-vis* third parties, the pledge should be registered by submitting a copy or extract of the deed of pledge to the BOIP (art. 2.33 BCIP).

#### 7.8 Are there different types of security interest?

The only security right that can be established on trade mark rights is a pledge.

### 8 Revocation

#### 8.1 What are the grounds for revocation of a trade mark?

There are three grounds for revocation (art. 2.26 sub 2 BCIP):

- (i) No genuine use of the mark for a continuous period of five years after registration, without proper reasons for non-use.
- (ii) Due to acts or inactivity of the owner, the mark has become a common name.
- (iii) Due to use or consent by the owner, the mark has become liable to mislead the public.

#### 8.2 What is the procedure for revocation of a trade mark?

Revocation proceedings are conducted before the District Court. The grounds for revocation are set out in the writ of summons. The trade mark proprietor will subsequently file a statement of defence setting out why the registration should not be revoked. He may also submit a counterclaim. If the trade mark proprietor files a counterclaim, the claimant will be allowed to submit a statement of defence against the counterclaim. Generally, an oral hearing will be held following the exchange of written submissions. In most cases, the District Court will hand down its judgment within two to four months after the hearing.

#### 8.3 Who can commence revocation proceedings?

Any interested party, being a natural or a legal person, may commence such proceedings. Representation by a Dutch attorney-at-law is required.

#### 8.4 What grounds of defence can be raised to a revocation action?

The trade mark owner can put forward formal defences (e.g. that the court does not have jurisdiction or that the claim is inadmissible) as well as defences as to the merits (e.g. that the mark has been genuinely used or that there is justification for the lack of genuine use, that the mark is still distinctive, that the mark is not misleading, etc.).

### 8.5 What is the route of appeal from a decision of revocation?

Appeal proceedings have to be initiated before the Court of Appeal having jurisdiction within three months after the judgment at first instance. Parties may also lodge a further appeal against the decision of the Court of Appeal to the Supreme Court. It is not required to request leave for such further appeal.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

A trade mark may be invalidated based on absolute or relative grounds (art. 2.28 sub 1 and 3 BCIP) (see questions 2.2, 3.1 and 4.1).

### 9.2 What is the procedure for invalidation of a trade mark?

See question 8.2.

### 9.3 Who can commence invalidation proceedings?

See question 8.3.

### 9.4 What grounds of defence can be raised to an invalidation action?

Besides the formal defences as mentioned above (question 8.4), the trade mark proprietor can put forward material defences demonstrating, insofar as absolute grounds are concerned, that the mark is distinctive, that the application has not been filed in bad faith, etc. In case of an attack based on relative grounds, besides arguing that the marks and/or the goods and services are dissimilar, that there is no likelihood of confusion, that the earlier mark does not have a reputation, that the use of the later mark does not take unfair advantage of or cause detriment to the distinctive character or repute of the earlier mark and/or that there is due cause for the use of the later mark, the trade mark proprietor can, in addition, challenge the validity of the trade mark invoked by the party claiming invalidation.

### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A Benelux trade mark owner can initiate final relief proceedings before one of the 11 District Courts, jurisdiction being based on either the place of domicile of the defendant or on the location of the infringement. In the case of EU trade marks, the District Court of The Hague has exclusive jurisdiction.

A preliminary relief action is heard by one judge of the District Court, the so-called Provisions Judge (in Dutch: *voorzieningenrechter*).

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The stages depend on the sort of proceedings.

- (i) Preliminary injunction (“PI”) proceedings are commenced by service of a writ of summons on the defendant, setting out the claims, the arguments to support such claims and the evidence. Depending on the urgency of the matter and the availability of the judge, a hearing will be held within a couple of days to approximately three weeks. Generally, a judgment is rendered within two to four weeks after the hearing.
- (ii) Final relief proceedings are also commenced through service of a writ of summons, summoning the defendant to (formally) appear on a certain date. Depending on where the defendant is domiciled, this date must be at least one week (Dutch resident), at least one month (EU resident) or at least three months (non-EU resident) after service. The defendant must submit his statement of reply (including evidence) within six to 10 weeks. A hearing will often take place within one to three months after the statement of reply. Thereafter, judgment is generally rendered within two to four months.

For completeness’ sake, it is also worth mentioning *ex parte* PI proceedings. These proceedings will be initiated by means of a request by the rights owner. The court will *ex parte* take a decision within 24–72 hours.

### 10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Yes; please see question 10.2. A party will only be able to obtain preliminary relief if he establishes that he has an urgent interest in obtaining such relief. The urgent interest is generally assumed to be present in cases of imminent or ongoing infringement.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Unlike in the UK or the US, there is no such thing as pre-trial discovery or disclosure. However, a party may claim (in a PI action or as a provisional claim in final relief proceedings) that the opposing party be ordered to provide access to specific documents, provided the claimant establishes that: (i) there is a legitimate interest; (ii) there is a “legal relationship” between parties (which includes liability for alleged IP infringement); and (iii) the documents requested are sufficiently specified. “Fishing expeditions” are not allowed.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions are presented in writing, as well as evidence (such as proof of the infringement, witness statements, etc.). At the oral hearing, parties can orally explain their positions. Witnesses and experts may be brought to the hearing, so that the court can ask them questions if it wishes. Such witnesses and experts are not cross-examined at the hearing.

Dutch civil procedure law does allow a party to request, or the court to order, a hearing of witnesses. This is done in a separate hearing, in which the witnesses will be questioned by the court and by both parties’ lawyers.



### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

A court may stay infringement proceedings if invalidity of the trade mark has been raised as a defence and proceedings to invalidate the Benelux trade mark are pending in another court.

As for EU trade marks, the Dutch Court is obliged to stay the proceedings if a counterclaim for revocation is filed after an application for revocation or for a declaration of invalidity of the EU mark has been filed with the EUIPO.

### 10.7 After what period is a claim for trade mark infringement time-barred?

A trade mark owner has acquiesced in the use of an infringing sign and is no longer entitled to prohibit the use if, whilst being aware of this use, he has not taken any action during a period of five consecutive years.

In final relief proceedings, there is no other time bar for a claim for trade mark infringement. A trade mark owner may commit certain acts which may be considered as a forfeiture of its right to act against the infringement, but mere lapse of time is generally considered insufficient proof of such forfeiture.

Concerning PI proceedings, there is no strict time period either. There is case law which suggests that proceedings have to be initiated within six months after the infringement has been discovered, or else the PI judge may rule that the claimant no longer has an urgent interest in obtaining the preliminary injunction. Claims for *ex parte* injunctions must generally be filed within two to three weeks after discovery of the infringement.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are. Sanctions include imprisonment and monetary penalties.

### 10.9 If so, who can pursue a criminal prosecution?

The public prosecutor can pursue a criminal prosecution, either *ex officio* or upon report of the crime by the trade mark owner. However, taking action against trade mark infringement is not treated as a priority, as it is considered primarily a matter of civil law, except in certain exceptional circumstances, e.g. when there is a threat to public health and safety, or in case of large-scale counterfeiting or organised crime.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

It is unlawful to threaten trade mark infringement action if one does not own a trade mark right or if one knows that there is a serious chance that the trade mark invoked is invalid or that there is no infringement. In such case, making demands under threat of legal action for trade mark infringement may give rise to liability to pay damages.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Without limitation, the defendant can:

- (i) dispute having committed any infringing acts;
- (ii) deny that the sign has been used in the course of trade;
- (iii) argue that the signs and/or the goods and services are dissimilar;
- (iv) argue that there is no likelihood of confusion; and
- (v) argue that its use of the sign does not negatively affect any of the functions of the allegedly infringed trade mark,

and, insofar as the trade mark owner claims that his mark has a reputation:

- (vi) deny the reputation of the invoked mark;
- (vii) argue that there is due cause for the use of the sign;
- (viii) dispute that the use of the sign takes unfair advantage of or causes detriment to the distinctive character or repute of the mark; and
- (ix) assert that there is a need to use the trade mark, *inter alia* to designate (characteristics of) the goods and services.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The counterparty can:

- (i) challenge the validity of the trade mark (see question 8.2);
- (ii) claim that the trade mark rights are exhausted; and
- (iii) claim that the trade mark owner has acquiesced in the use of the later mark (see question 10.7).

Besides material defences, one can bring forward formal defences, e.g. by challenging the jurisdiction of the court or the admissibility of the claim.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Remedies, all subject to a penal sum in case of non-compliance if claimed, include:

- (i) cease and desist from infringement;
- (ii) recall and destruction;
- (iii) rectification;
- (iv) disclosing details with respect to suppliers and customers, as well as financial details (e.g. products sold, net profit, etc.);
- (v) payment of damages and/or surrender of profits; and
- (vi) reimbursement of legal costs.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

In cases of trade mark enforcement, the prevailing party is entitled to compensation of actually incurred legal costs. The courts have set guidelines for the maximum amount to be reimbursed, depending on complexity (EUR 6,000 to 25,000 for PI proceedings; EUR 8,000

to 40,000 for final relief proceedings). This usually comes down to about 50–100% of the costs actually incurred. Higher cost orders can be awarded in exceptional cases.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

In appeal proceedings, the Court of Appeals will assess the matter in its entirety, assessing both the facts and the law in *de novo* proceedings.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

There is no restriction on filing new evidence in appeal proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Pursuant to Regulation EU 608/2013, a trade mark owner may request the Dutch Customs Authorities to detain infringing goods coming into the EU through The Netherlands. Dutch Customs is known for being very effective in identifying and seizing infringing goods. If possibly infringing goods are identified, Dutch Customs notifies the rights owner within one day upon discovery.

If the general request for assistance has been approved by the customs authorities, within 10 days after the notification of the possible identification of infringing goods the rights owner has to respond to the findings (demonstrate that there is an infringement; and approve the destruction of the goods). The infringer has to respond within 10 days as well. If no objection is received and the rights owner has provided the authorities with the aforesaid information, the goods will be destroyed by the Customs Authorities. The term can be extended once by 10 days at the request of the rights owner. If an objection is raised, legal proceedings have to be started by the rights owner.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Benelux trade mark law does not provide for unregistered trade mark protection, except for well-known trade marks (art. 6bis Paris Convention).

### 15.2 To what extent does a company name offer protection from use by a third party?

If the company name is registered as a trade mark, it enjoys trade mark protection.

If the company name is used in the course of trade, the Dutch Trade Name Act stipulates that the company using such name can object to the use of later, confusingly similar trade names of third parties.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Such titles may be protected by copyright, provided they comply with the requirements for protection (pursuant to art. 1 *io*. 10 Dutch Copyright Act).

## 16 Domain Names

### 16.1 Who can own a domain name?

Natural and legal persons can own a domain name.

### 16.2 How is a domain name registered?

If the name is available according to the Dutch domain name authority (“SIDN”) ([www.sidn.nl](http://www.sidn.nl)), the domain name can be registered via a registrar – who will submit a request to SIDN. Within one hour, and if the general terms of SIDN are accepted, the domain name will be included in the “.nl” domain by SIDN. Ownership records can be checked via the “Whois” page of SIDN.

### 16.3 What protection does a domain name afford *per se*?

Owning a domain name *per se* does not afford any protection against the use of similar (domain) names. However, use of a domain name may, depending on how they are used, qualify as use as a trade name, which may lead to protection against confusingly similar trade names (see section 15 above) and against confusingly similar domain names (art. 2 SIDN Dispute Resolution).

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The coming into force of the EU Trade Mark Regulation (“EUTMR”) has been the most significant development over 2017–2018, since it has directly affected EU trade marks – which are valid in the Benelux as well.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Aside from the relevant case law of the European Court of Justice, the following judgments have been of particular importance:

- Supreme Court, 5 January 2018, ECLI:NL:HR:2018:10 (*Primagaz*): refilling empty gas bottles with non-branded gas without informing the consumer constitutes trade mark infringement. *Primagaz*’ rights are not exhausted.
- Court of Appeals Amsterdam, 20 December 2017, case 200.174.903/01 (*Capri Sun/Riha Wesergold*): the 3D mark for an aluminium stand-up pouch is considered null and void, since its essential characteristics are considered to be necessary to obtain a technical result.
- CJEU, 6 December 2017, case C-230/16 (*Coty/Akzente*): European competition law does allow a luxury brand trade mark owner to prohibit its authorised resellers from selling luxury goods on online platforms (such as Amazon).

### 17.3 Are there any significant developments expected in the next year?

Eventually, on 14 January 2019, the European Union Trade Mark Directive (Directive (EU) 2015/2436) will have to be implemented into Benelux law. Therefore, the BCIP's, IRBCIP's and BOIP's practice will have to be amended (e.g. amending the trade mark register in such a way that it will be suitable for accommodating non-traditional marks).



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### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Recently, a large amount of interest in 3D marks has arisen, which has led to interesting case law. Further, in accelerated *ex parte* PI proceedings, regional courts with less experience in IP matters are being assisted by specialised judges of the IP court of The Hague, which is leading to decisions of higher quality and greater consistency.



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## BarentsKrans

BarentsKrans is an independent Dutch law firm located in The Hague. With over 75 lawyers and civil-law notaries, the firm has an excellent reputation in IP, dispute resolution, M&A, real estate and finance. The firm offers a dedicated service, with a keen eye for its clients' business goals. Through the firm's strong referral practice, it services internationally active companies in addition to its domestic clientele in various sectors. BarentsKrans' lawyers are regularly involved in groundbreaking cases before various tribunals, including the EUIPO and the Dutch Supreme Court. They also assist in complex transactions and are used to working in multi-jurisdictional teams.

The firm is widely acknowledged as leading player in IP litigation, having successfully represented multinational clients in the field of life sciences, (wireless) telecoms, fast-moving consumer goods, nutrition, chemicals, social media, household appliances and outdoor media in trade mark, copyright, unfair competition, licensing and advertising matters in The Netherlands. A number of reputable international law firms regularly refer their clients to BarentsKrans for IP cases. The firm continues to attract a growing share of complex, high-end IP work in the market.

## Current titles in the ICLG series include:

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- Aviation Law
- Business Crime
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- Class & Group Actions
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- Corporate Recovery & Insolvency
- Corporate Tax
- Cybersecurity
- Data Protection
- Employment & Labour Law
- Enforcement of Foreign Judgments
- Environment & Climate Change Law
- Family Law
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