



ICLG

The International Comparative Legal Guide to:

Trade Marks 2016

5th Edition

A practical cross-border insight into trade mark work

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EDITORIAL

Welcome to the fifth edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

Three general chapters. These are designed to provide readers with a comprehensive overview of key issues affecting trade mark laws and regulations, particularly from an EU and US perspective.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 41 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the contributing editor John Olsen of Locke Lord LLP for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

The *International Comparative Legal Guide* series is also available online at www.iclg.co.uk.

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Legaltree

1 Relevant Authorities and Legislation

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

The relevant authority is the Benelux Office for Intellectual Property (BOIP).

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

The Benelux Convention on Intellectual Property (BCIP) and the Implementing Regulations under the BCIP (IRBCIP).

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

In principle, 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 be a trademark.

2.2 What cannot be registered as a trade mark?

Signs which cannot be represented graphically and signs which fall within the absolute grounds for refusal cannot be registered.

2.3 What information is needed to register a trade mark?

- The name, address and contact information of the applicant (and its representative, if applicable);
- bank details;
- whether or not an accelerated procedure is requested;
- whether the application concerns an individual or collective trademark (if collective, see also question 2.16);
- an indication of the type of trademark (e.g. word/figurative/three-dimensional mark);
- if the mark contains colours, the colours must be explained in words. In addition, colour codes may be used. If the trademark consists of only colours ('colour mark'), it is compulsory to specify the colour codes;

- if priority is claimed, the information as mentioned under question 2.15; and
- class numbers and the description of goods and/or services.

2.4 What is the general procedure for trade mark registration?

Following application, the BOIP first examines if the minimum requirements (e.g. clear representation, applicant, clear description of goods and services) are met. If the application successfully passes this stage, it is published. The trademark will then be examined under the absolute grounds for registration by the BOIP (detailed in question 3.1). Once the application is published, opposition can be filed within two months. Opposition is a procedure whereby the owner of a prior trademark application or registration and/or licensee (with permission of the owner) can submit an objection with the BOIP against the registration of a more recent trademark. If the application also passes this stage, it is registered by the BOIP and the applicant will receive a registration certificate.

Alternatively, the registration of a trademark can be accelerated upon payment of an extra fee. In that event, the trademark will be registered as soon as the (administrative) formalities have been attended to. This procedure can be completed within a couple of days. However, the assessment on absolute grounds and any opposition will, in such case, take place after registration. Such later assessment can still lead to a registration being cancelled and deleted from the register.

2.5 How can a trade mark be adequately graphically represented?

According to Rule 13 of the Explanatory Notes on the application procedure:

- the representation must be of sufficient quality to allow electronic processing (scanning);
- the representation must be a (photo)graphic image of professional quality on matte paper with a rectangular or square format;
- the required size of the representation – not the paper itself – should be between 1.5cm × 1.5cm and 8cm × 8cm; and
- all elements of the trademark must be clear.

As to the question what is 'clear', the Sieckmann decision of the ECJ is relevant. In that case the ECJ ruled that a representation should be "clear, precise, self-contained, easily accessible, durable and objective" (Case C-273/00).

2.6 How are goods and services described?

Goods and services are classified according to the Nice Classification system of the WIPO. This classification consists of 45 classes (categories).

Goods and services are described by indicating the relevant class number and providing a standard or own description of the goods or services in question, e.g. "CI 35 Advertising; business management; business administration; office functions".

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

The BCIP covers the territories of the Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands in Europe. Overseas territories are not covered.

2.8 Who can own a trade mark in your jurisdiction?

The trademark can be owned by any (existing) natural person or legal entity.

2.9 Can a trade mark acquire distinctive character through use?

Yes, through use before the application of the trademark. The relevant factors to be taken into account have been detailed by the ECJ in its Chiemsee decision (Cases C-108/97 and C-109/97):

- market share held by the mark;
- how intensive, geographically widespread and long-standing the use of the mark has been;
- the amount invested by the undertaking in promoting the mark;
- the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and
- statements from chambers of commerce and industry or other trade and professional associations.

The mark must have acquired distinctive character within the entire Benelux, unless the trademark consists of one or more words from one of the official languages in the Benelux. In that case it must be established that the mark has acquired distinctive character through use throughout that linguistic area (ECJ, 7 September 2006, Case C-108/05, *Europolis*).

2.10 How long on average does registration take?

Generally, the registration procedure lasts approximately three months. However, if opposition is filed against the application or a refusal on absolute grounds is pronounced by the BOIP, the period can last (much) longer.

In the event of an accelerated registration (explained in question 2.4), the trademark will be registered as soon as the formalities have been attended to. This procedure can be completed within a couple of days.

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

Applying online for an individual trademark in the Benelux, without the assistance of a trademark attorney, in three classes costs EUR 240. An application on paper costs EUR 276. The supplementary fee for an accelerated registration, up to three classes, is EUR 193 (online) or EUR 221 (paper).

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

Yes, a Community Trademark also provides protection in the Benelux. Moreover, a registration can be obtained via an international registration designating the Benelux, or the EU, under the Madrid Agreement or the Madrid Protocol.

2.13 Is a Power of Attorney needed?

No, this is not necessary.

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

Not applicable.

2.15 How is priority claimed?

Priority is claimed in the application stating the country, number, holder and application date of the older application. A copy of the earlier application must be submitted.

2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, a collective mark under the BCIP is a sign that distinguishes one or more common characteristics of goods or services. The holder of a collective trademark is not entitled to use the trademark itself but supervises the use of the trademark by others who have to fulfil certain criteria in order to use it. These criteria have to be laid down in 'regulations for use and control of the trademark', which have to be submitted when the trademark is filed. The costs related to a collective mark differ slightly from those related to an individual mark.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The BOIP shall refuse to register a trademark if:

- the sign cannot constitute a trademark (i.e. signs which cannot be represented graphically or signs consisting solely of a shape which results from the nature of the goods, which gives a substantial value to the goods or which is necessary to obtain a technical result);
- the trademark is devoid of any distinctive character;

- the trademark consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or performance of the service, or other characteristics of the goods or services;
- the trademark consists exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;
- the trademark is contrary to public policy or principles of morality in one of the Benelux countries;
- the trademark is misleading;
- it is a trademark for wine or spirits with an incorrect geographical designation; and
- article 6ter of the Paris Convention provides for refusal or invalidation (i.e. unauthorised use of armorial bearings, flags and other emblems of states and international intergovernmental organisations or official signs and hallmarks).

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

The way to overcome such objection is to successfully convince the BOIP (or eventually the appeal court) that the absolute ground in question does not apply and consequently that the objection should be withdrawn. Objections based on descriptive nature or lack of distinctive character may be overcome by demonstrating that the mark has acquired distinctive character through use.

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

The applicant has the right to appeal against a refusal of the BOIP, as outlined in the next question.

3.4 What is the route of appeal?

If the BOIP informs the applicant that it intends to refuse a registration, the applicant can submit a written objection against the intended refusal within six months. If the BOIP upholds the refusal, it will then take a definitive refusal decision. An appeal can be made against this definitive decision before the court of appeal in The Hague, assuming domicile in the Netherlands. Thereafter, parties can still appeal on points of law to the Dutch Supreme Court.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

The BOIP cannot refuse the registration of a trademark on relative grounds for refusal, but the applicant or holder of a prior trademark – or a licensee if authorised by the holder – can submit an opposition based upon these grounds during the registration procedure against an application of a trademark that:

- is identical to an earlier trademark filed for identical goods or services;
- is identical or similar to an earlier trademark filed for identical or similar goods or services, where a likelihood of confusion exists on the part of the public; and
- may give rise to confusion with a well-known (registered or unregistered) trademark within the meaning of Article 6bis of the Paris Convention.

4.2 Are there ways to overcome a relative grounds objection?

The way to overcome an opposition based upon such ground is to successfully convince the BOIP (or eventually the appeal court) that the relative ground in question does not apply and consequently that the opposition should be withdrawn.

The applicant who faces the opposition can raise a non-use defence if the opponent's prior trademark has been registered for five years or more. The opponent must then prove that its trademark was used normally in the Benelux region for the goods and/or services on which the opposition is based in the five years prior to the publication date of the trademark that is the subject of the opposition filed.

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

Either party may lodge an appeal against the decision of the BOIP.

4.4 What is the route of appeal?

An appeal can be made against this opposition decision before the courts of appeal in The Hague, assuming domicile in the Netherlands. Thereafter, parties can still appeal on points of law to the Dutch Supreme Court.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

A trademark can be opposed during the registration procedure upon the relative grounds for refusal (see question 4.1).

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

Any natural or legal person, who can invoke a prior trademark right.

5.3 What is the procedure for opposition?

After a trademark application has been published, opposition can be filed within two months.

Upon receiving the opposition form, the BOIP will verify that the opposition is admissible and meets all additional legal requirements. First both parties are granted the opportunity during a two-month period to see whether they can resolve the conflict amongst themselves. This is referred to as the 'cooling-off period'. The cooling-off period begins once the BOIP has informed both parties in writing about the admissible opposition and can be extended by mutual request.

After the cooling-off period, the actual opposition proceedings will commence and the opponent should then submit its arguments within two months. Next, the defendant has two months to respond to these arguments and/or to request proof of use. If the defendant requests proof of use, the opponent has two months to submit these. Once the defendant receives the proof of use, it has two months to respond to these and, if it has not done so yet, the opponent's arguments. Thereafter, the BOIP may opt to invite parties to submit additional arguments or documents within a specified period of time. Once all documents have been submitted, the BOIP will render its decision.

6 Registration

6.1 What happens when a trade mark is granted registration?

The BOIP will send a registration certificate and the registration number and date will be shown in the public register of the BOIP.

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

As of the registration date.

6.3 What is the term of a trade mark?

A trademark registration is valid for 10 years counting from the filing date. The registration can be renewed for an unlimited number of successive 10-year periods.

6.4 How is a trade mark renewed?

A trademark registration can be renewed from six months before the expiry date up to six months after the expiry date upon payment of a renewal fee. Renewal in the six-month term after the expiration date is subject to an additional fee.

7 Registrable Transactions

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

Yes, by submitting a modification form and upon payment of a fee. A deed of the transfer of the trademark, or an extract of the original, signed by both the transferor and transferee, has to be included.

7.2 Are there different types of assignment?

A trademark can be partially assigned for only some of the goods and services for which it is registered.

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

Yes, by submitting a modification form and upon payment of a fee. Supporting documentation has to be included; e.g. an extract or summary of the original deed signed by both parties.

7.4 Are there different types of licence?

The BOIP differentiates between (main) licences and sublicences in its register. A licence can be exclusive or not. An exclusive licence permits the licensee to use the trademark to the exclusion of all others, including the owner.

7.5 Can a trade mark licensee sue for infringement?

Only the trademark owner has the right to do so. However, the trademark owner can grant the licensee a power of attorney to act on

its behalf. A licensee is, however, entitled to claim damages in its own name, if it has obtained permission from the trademark owner to do so.

7.6 Are quality control clauses necessary in a licence?

No, although it is advisable to include them.

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

Yes, by submitting a modification form and upon payment of a fee.

7.8 Are there different types of security interest?

Both pledges and attachments can be recorded. Supporting documentation has to be included; e.g. an extract of the original deed signed by both parties, or the attachment leave.

8 Revocation

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

A trademark can be revoked if:

- within a continuous period of five years, it has not been put to genuine use in Benelux territory in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use;
- in consequence of acts or inactivity of the owner, the trademark has become the common name in the trade for a product or service in respect of which it is registered; and
- in consequence of the use made of it by the owner of the trademark or with its consent in respect of the goods or services for which it is registered, the trademark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

In the context of the first bullet point, the trademark should be used as filed or at least in a form that does not alter the distinctive character of the mark in the form in which it was registered.

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

A civil action for revocation of a registered trademark can be filed with the district court. If the court revokes the trademark, the BOIP will cancel the trademark upon request as soon as the judgment becomes final. Judicial cancellations must be accompanied by a bailiff's notification and a copy of the court's decision.

An amendment of the BCIP is currently under ratification by the Benelux countries. As soon as this amendment comes into effect, an action for revocation can alternatively be filed with the BOIP.

8.3 Who can commence revocation proceedings?

Any interested party may invoke revocation of the right in a trademark.

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

Normally, the defendant will argue that the grounds for revocation do not apply, for instance by demonstrating 'genuine use' through

the submission of evidence of use. Use by a licensee also qualifies as use of the trademark. In case of non-use or becoming a common name in the trade, revocation can be resisted if the owner can show 'proper reasons' for non-use or that it has actively been acting against descriptive use of its trademark. 'Proper reasons' normally relate to matters outside the owner's control.

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

A decision of the district court can be appealed to the court of appeal. Thereafter, parties can still appeal on points of law to the Dutch Supreme Court.

9 Invalidity

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

An invalidity action can be based upon the absolute grounds or relative grounds for refusal (see questions 3.1 and 4.1), as well as if the trademark:

- is similar to a collective trademark registered for similar goods or services, which benefitted from a right which lapsed during the three years preceding filing;
- is similar to an earlier trademark filed for goods or services 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 reputation of the earlier mark;
- is similar to an individual trademark registered by a third party for similar goods or services, which benefitted from a right which lapsed during the two years preceding filing as a result of expiry of the registration, unless the third party consents or there has been a failure to genuinely use the trademark; or
- was filed in bad faith.

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

A civil action for invalidation of a registered trademark can be filed with the district court. If the court invalidates the trademark, the BOIP will cancel the trademark at request as soon as the judgment becomes final. Judicial cancellations must be accompanied by a bailiff's notification and a copy of the court's decision.

An amendment of the BCIP is currently under ratification by the Benelux countries. As soon as this amendment comes into effect, an action for invalidation can alternatively be filed with the BOIP.

9.3 Who can commence invalidation proceedings?

In case of an absolute ground for refusal or the ground mentioned in question 9.1 under the first bullet point, any interested party, including the Public Prosecutor. In case any of the other grounds apply, any interested party, provided that the prior right owner is a party to the action.

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

Normally the defendant will argue that the grounds for invalidity

do not apply. The grounds of defence depend on the grounds for invalidation; in this respect please see questions 3.2 and 4.2. In addition, invalidation action may be overcome if the owner of the earlier right has consented to registration of the mark in question or if the earlier mark asserted is itself successfully invalidated or revoked. In respect of an alleged registration in bad faith, the owner may adduce evidence to demonstrate that the application was made in good faith.

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

A decision of the district court can be appealed to the court of appeal. Thereafter, parties can still appeal on points of law to the Dutch Supreme Court.

10 Trade Mark Enforcement

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

An infringer can be sued before any competent district court. Generally, this is the court in which district the defendant is domiciled or where the obligation in dispute has arisen, or has been or should be executed. Particularly this last ground, considering infringement often takes place in a widespread territory, gives the opportunity to choose.

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

There are no formal pre-trial procedural stages under Dutch Civil Procedure. Nevertheless, unless there is danger of embezzlement, it is recommended to first send a cease-and-desist letter before serving the writ upon the infringer. Service without any prior notice may result in an award of cost for the account of the claimant, even if he prevails. Also, some protective measures, e.g. seizures, may be taken first in order to secure evidence or funds. Witnesses can provisionally be heard in order to obtain evidence in litigation or in order to be able to assess one's chances in possible litigation.

Preliminary injunction proceedings take roughly four to 10 weeks from serving the writ until judgment, although in very urgent cases an interlocutory decision can be obtained in a matter of days. Proceedings on the merits (in first instance) typically take between six and 18 months.

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

Yes, both are available.

In case of urgency, an interim injunction can be requested in *inter partes* summary proceedings. An *ex parte* injunction can be requested if the need for an injunction is so urgent that irreparable damage will be suffered by the applicant in the case the injunction is not ordered. In accordance with article 50(6) Trips, interim injunction proceedings have to be timely followed up by proceedings on the merits.

In proceedings on the merits, in case of infringement or real threat thereof, Dutch courts are in principle obliged to issue a permanent injunction.

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

Dutch law does not provide for discovery. Nevertheless, some measures can be taken if one knows what to look for. Evidence can be seized upon leave of the court. Also, a request for disclosure of specific documents or evidence (also evidence which was seized first) can be made under conditions, provided that the request is not a 'fishing expedition'.

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

Written submissions play an important role under Dutch Civil Procedural Law. In proceedings on the merits, parties have to present their arguments in writing first before an oral hearing takes place. In preliminary injunction proceedings, the defendant may submit a defence brief in response to the writ before the hearing, although that option is rarely used in trademark cases. Normally, evidence is presented by submitting documents of all kinds, including witness statements. As a basic rule, all evidence can be used as such. There are no restrictions.

Witnesses can be heard in separate witness hearings, although this rarely happens in trademark cases. Cross-examination, as practised in Anglo-American legal systems, is not used in the Netherlands. However, after the court has examined the witness, parties can ask questions.

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

In proceedings on the merits, claiming invalidity may be a defence in counterclaim. Should the invalidity and the injunction be claimed before different courts, then it is generally believed that the infringement court should stay the proceedings, awaiting a final decision in the infringement case. Alternatively, it may also be possible to merge both proceedings if handled in the same instance. By its nature, preliminary injunction proceedings will never be stayed.

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

In principle, such claim is never time-barred. Nevertheless, under circumstances like persistent tolerance of infringement, the trademark owner may have forfeited its rights. A mere 'standing still', however, does not result in a forfeiture of rights.

10.8 Are there criminal liabilities for trade mark infringement?

Yes, the Dutch Criminal Code contains one provision which stipulates that intentional – in short – trade of goods containing another's trademark or a similar sign may constitute a criminal offence. The maximum sentences are four years' imprisonment or a fine of EUR 82,000. In practice, trademark cases are seldom prosecuted and if so, only in typical counterfeit cases.

10.9 If so, who can pursue a criminal prosecution?

The public prosecutor may pursue criminal prosecution, after the offence is reported to the police.

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

If the threat is serious, the trademark owner may obtain an injunctive relief, whether or not preliminary.

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?

The defence will depend on the facts and allegations in the case. Defence arguments can, for instance, be that:

- the invoked trademark is not a valid trademark;
- the opposed sign is not used in the course of trade;
- the use in question is not use as a trademark (e.g. descriptive use);
- the use is in relation to goods or services that do not fall within the scope of the trademark registration;
- there is no likelihood of confusion considering the dissimilarity of signs and/or goods or services;
- in the case of a mark 'with a reputation', the mark does not have such reputation or that the use does not take unfair advantage of, or is detrimental to, the distinctive character or the reputation of the mark;
- if there is use outside the course of trade, such use does not take unfair advantage of or is not detrimental to the distinctive character or the reputation of the mark;
- exhaustion of rights (e.g. in case of inter-EU parallel trade); and/or
- the opposed sign has prior use and is protected by a local right (e.g. trade name).

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

Other grounds of defence may involve challenging the validity of registration, like registration in bad faith or non-use of the mark for more than five years. Also, forfeiture of rights (see question 10.7) may be a defence argument.

12 Relief

12.1 What remedies are available for trade mark infringement?

Besides an injunction, a court may award compensation for damages, which can also consist of the transfer to the trademark owner of the infringing goods, or the materials principally used in the manufacture of those goods. In addition to or instead of the action for compensation, the holder of a trademark may claim for

transfer of the profits made following the infringing use, and for the provision of accounts in this regard. Further remedies include an order for information, rectification, inspection, recall or destruction.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

Parties can seek an order for reimbursement of full costs in trademark cases. However, a protocol of indicative rates applies. While not binding, courts generally use these rates as a yardstick.

13 Appeal

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

A decision of the district court can be appealed in full to the court of appeal. Thereafter, parties can only appeal on points of law to the Dutch Supreme Court.

There is a financial threshold to appeal of EUR 1,750. However, this threshold generally plays no role in trademark cases which are in principle considered cases of 'indeterminate value' without any indication of a value of less than the threshold.

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

New evidence can always be added at the appeal stage.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

Border control measures are governed by EU Regulation 608/2013, the Anti-Piracy Regulation. On the basis of this regulation, customs authorities can prevent, *ex officio* or by request, counterfeit or otherwise infringing products from being imported into or exported from the EU market. When customs authorities notice that imported goods are suspected to be infringing, they suspend the release and notify the holder or its representative, giving the opportunity to inspect the goods and, if considered infringing, to take action. Action by customs authorities, if challenged by the alleged infringer, has to be timely followed up by civil proceedings. If the owner of the goods does not oppose the requested destruction, consent is deemed to be given.

15 Other Related Rights

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

In principle, unregistered trademarks are not protected. However, well-known trademarks within the meaning of Article 6bis of the Paris Convention enjoy protection, even if they are not registered.

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

Based upon the Dutch Trade Name Act, a company obtains (local) protection against the later use of a confusingly similar trade name by another company, given the nature of both companies and the places in which they are both active.

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

Titles of individual books and films are part of a good and are, therefore, considered not to be used as a trademark. Titles of newspapers or magazines do, however, distinguish constantly changing content, and can therefore function as a trademark.

Furthermore, copyrights (including portrait rights), designs, patents, databases and plantbreeders' rights confer IP protection.

16 Domain Names

16.1 Who can own a domain name?

Anyone can register a .nl domain name through a .nl registrar.

16.2 How is a domain name registered?

Through one of the registrars affiliated to SIDN, the internet registry for .nl domain names (<https://www.sidn.nl/registrars/>).

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

As such it does not grant any rights. However, if a domain name is used as a trade name, it affords trade name protection.

17 Current Developments

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

A significant development is the revised EU Trademark Directive, which has to be implemented in the BCIP ultimately on 14 January 2019. It will have a significant impact on prosecution and enforcement matters. The revision will, *inter alia*, allow registration of marks which cannot be presented graphically (e.g. smell marks) and affect the possibilities to oppose the transit of counterfeit goods.

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

In 2015 there have been a few relevant decisions from the Dutch Supreme Court. Firstly, the Supreme Court ruled on 20 February (IEF 14684, *Ajax / Promosports*) that – considering the interdependence between all relevant factors – a court always has to fully assess whether likelihood of confusion exists if there is similarity between the trademark and the alleged infringing sign, regardless of how small such similarity may be.

The Dutch Supreme Court further ruled in its decision of 3 April 2015 (IEF 14835, *Geen Stijl / Sanoma*) that copyrights and freedom of speech are two equal fundamental rights. The freedom of speech has not already been incorporated in the legal restrictions to copyrights. Although this case concerned a copyright case, it is believed that this principle also applies to other intellectual property rights like trademarks.

Following the referral decision of the ECJ, the Dutch Supreme Court (27 November 2015, IEF 15458, *Hauck / Stokke*) considered that the three grounds for absolute refusal of shape marks (e.g. shape resulting from the nature of goods; shape that is necessary for technical result; shape that gives substantial value) operate independently of one another. Consequently, a shape can only be denied registration as long as any one of those grounds *fully* applies to that shape. The different grounds for refusal of registration may not be applied in combination.

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

See question 17.1. Even though the revised EU Trademark Directive is not expected to be implemented into national law shortly, some of the changes in the corresponding revised Community Trademark Regulation have already taken effect on 23 March 2016 in all Member States. As a result, it may be expected that the soon-to-be-implemented trademark provisions of the Directive are already being taken into consideration in national proceedings to some extent.

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

In the past two years there has been debate about the question whether a plaintiff, who sues in preliminary injunction proceedings but withdraws the case just before the court hearing, can be liable for legal costs made by the defendant in preparation for the defence. The Court of Appeal of The Hague (25 November 2014, 458406/KGZA14-53, *Containerbox v. Citybox*) answered this question in the affirmative in a trademark case. Nevertheless, in another case in first instance, the court referred this question to the Dutch Supreme Court. Although that case has meanwhile been settled by parties, the Dutch Supreme Court considers the answer to this question of such importance that it will give its ruling nonetheless. A decision is expected in 2016.

The reason for this debate is that while parties can legally claim reimbursement of full legal costs in IP cases (contrary to other civil cases), on the other hand, under Dutch Civil Procedural Law preliminary injunction proceedings are, officially, not introduced to court before the court hearing. In other words: officially the proceedings start at the hearing, but in preliminary injunction proceedings in first instance it basically all boils down to that one hearing. Also, in the same sense, the Procedural Regulations provide that the court shall not give an order for costs if the preliminary injunction proceedings are withdrawn.



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Even before he started working as an attorney (*advocaat*) in 1999, Olav Schmutzer was focused on intellectual property law. More than 15 years down the road, he has become a legal specialist in copyrights, designs, trademarks and trade names. From 2008 to 2011 he worked as an in-house counsel, and was general counsel for an international apparel company.

Based on this wide experience, working for both law firms and commercial companies, Olav's forte is assessing his client's strategic interests whilst providing thorough and comprehensible legal advice.

Olav has extensive experience with domestic and international IP disputes, including disputes regarding so-called slavish imitations, and litigating such matters. He is often engaged in commercial (international) collaborations, especially in the fashion industry. Clients vary from SMEs to large multinationals.

Olav is an active member of various IP associations, including the AIPPI and Marques.

He joined Legaltree as partner in 2014.



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Being the co-author of the Dutch serial IP-guide for entrepreneurs and companies '*IE in Bedrijf*' ('IP in business'), a respected publisher in newspapers, IP magazines and blogs, and working for many (well-known) designers, authors, artists, advertising agencies and (multinational) companies, Marjolein Driessen has positioned herself as a true specialist in intellectual property and advertising law. Her creative and innovative clients are active in the fashion, furniture, sports, film, and travel industries.

She is an experienced litigator in court procedures, oppositions and procedures at the Dutch Advertising Code Committee. She provides her clients with practical and valuable advice before conflicts may arise, and is a sparring partner in starting up and maintaining trademark/design portfolios.

Before joining Legaltree in 2011 as partner, Marjolein worked for 10 years as a trademark attorney and as an attorney (*advocaat*) with a main focus on copyright, trademarks, designs and advertising law.



The Dutch law firm Legaltree consists exclusively of 23 senior partners who provide – individually and as a team – tailor-made legal services for respected national and international clients. Legaltree partners are selected with great care and have a minimum of 10 years' experience as an attorney. The unique business concept and culture at Legaltree guarantees clients' personal attention at partner level, ensuring high-quality service at all times. Legaltree is known for its unique vision and modern way of operating. Our credo is: 'Quality is personal'.

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