



BENELUX TRADEMARKS OFFICE
BENELUX DESIGNS OFFICE

THE BENELUX CONVENTION ON INTELLECTUAL PROPERTY
AND ITS CONSEQUENCES



JULY 2006

NOTE TO READERS

THE NEW BENELUX CONVENTION ON INTELLECTUAL PROPERTY IS ABOUT TO COME INTO FORCE. THE BCIP, AS WE WILL BE CALLING THE NEW CONVENTION, WILL BRING WITH IT MANY CHANGES THAT YOU, THE AGENT, HAVE TO BE AWARE OF.

WE WILL BE USING THIS BROCHURE TO INTRODUCE OURSELVES, THE NEW BENELUX ORGANISATION FOR INTELLECTUAL PROPERTY, TO YOU. WE WILL INFORM YOU ABOUT THE EFFECT THAT THE NEW CONVENTION WILL HAVE.

WHAT ARE THE MOST IMPORTANT LEGAL TEXTS?

HOW ARE THEY TO BE INTERPRETED?

WHAT ARE THE MAIN FEATURES OF THE NEW CONVENTION?

AND WHAT CHANGES HAVE BEEN MADE TO THE IMPLEMENTING REGULATIONS?

DEAR READER,

The Benelux Offices are undergoing great change. The new Benelux Convention on Intellectual Property (BCIP) will come into force on 1 September 2006. This will have major consequences for our organisation. The current, somewhat artificial division between the Trademarks Office and the Designs Office has been abolished, with a number of powers now being officially assigned to the new Benelux Organisation for Intellectual Property. This has put an end to the ambiguity about the Offices' legal status, with the new Benelux Organisation for Intellectual Property being an international organisation.

Naturally, we are delighted about these developments, as they will enable us to operate more effectively and efficiently. From now on, we will be able to focus even more than before on the needs and desires of you, the user. The new instruments that we have been given mean that we now have the tools we need to respond more quickly and more pro-actively to the needs of Benelux businesses. From now on, we will be able to implement the EU's - and other international - rules and regulations quickly. The decision to delegate a number of powers means that in future we will be able to consult directly with all stakeholders regarding any necessary changes to the intellectual property system. In the coming months, we will be developing the first initiatives in this direction.

This brochure will inform you about all the immediate consequences of the new Convention, and about what these consequences will mean for you and your business. Naturally, our Service & Information department is standing by to answer any further questions you may have. Please see our website for details of the legal basis for all these changes. On our website you will also find the complete text of the BCIP and of the new Implementing Regulations.

I hope that I will soon be greeting you as a visitor to, and/or customer of, the Benelux Organisation for Intellectual Property.

EDMOND SIMON



ARTICLE 1.2 ORGANISATION

(NB. Original text of the articles on page 4,6,8 and 10 is in the Dutch and French language)

1. A Benelux Organisation for Intellectual Property (trademarks and designs, hereinafter 'the Organisation', is established.

ARTICLE 1.4 LEGAL PERSONALITY

1. The Organisation has an international legal personality for the purposes of exercising the tasks that it has been assigned.
(...)
3. The Director General of the Office, hereinafter referred to as 'the Director General', represents the Organisation in legal process and extrajudicially.

EXPLANATORY NOTES

The implementation of the new Benelux Convention on Intellectual Property (BCIP) also involves the establishment of a new international organisation, namely the Benelux Organisation for Intellectual Property (the 'Organisation'). This organisation is replacing both the Benelux Trademarks Office and the Benelux Designs Office.

In other words, the new Organisation is basically resulting in the merger of both Offices. This will have certain practical consequences, especially within our organisation. This is because since their inception, both Offices have really been acting as a single office. However, since the two organisations each had their own legal status, we still had to prepare two separate sets of annual accounts, have different representatives in the Management Boards and officially maintain two separate management teams. The new Convention makes these measures unnecessary, a move that simplifies our operations.

The foundation of a new international organisation also puts an end to the previous 'neither one thing nor another' status that the Offices found themselves in. When the Offices were founded in the 1970s, it was decided to refrain from granting them an international status, even though that's what they really had to be as autonomous organisations serving three countries. It was even neglected to give the Offices a legal personality. Even though a separate protocol drawn up in the 1980s rectified this last point, the Offices continued to have a strange hybrid form. They were not government departments governed by the laws of one of the Benelux countries, but were instead government agencies that performed a public service for these three countries and could not undertake any activity apart from this.

The establishment of the Benelux Organisation for Intellectual Property as a new international organisation underlines the fact that our organisation is independent of all three Benelux countries. This can also be seen from the granting of representative authority to the Director General. He is the only person authorised to represent the organisation in legal process and extrajudicially.

ARTICLE 1.2 ORGANISATION

2. The Organisation's component bodies are:
 - a. the Committee of Ministers as referred to in the Treaty establishing the Benelux Economic Union, hereinafter 'the Committee of Ministers';
 - b. the Management Board of the Benelux Office for Intellectual Property (trademarks and designs), hereinafter 'the Management Board'; and
 - c. the Benelux Office for Intellectual Property (trademarks and designs), hereinafter 'the Office'.

EXPLANATORY NOTES

Although the Benelux Organisation for Intellectual Property contains more than one body, it will be the Benelux Office for Intellectual Property that will be the most visible element of the Organisation. The new Convention assigns all aspects of the application of the rules, regulations and legislation pertaining to trademarks and designs to the Office.

It's the Office that handles your applications and handles your renewals. The Office examines your application on absolute grounds and handles 'oppositions'. In addition, all international applications must be submitted to the Office. In other words, the Benelux Office for Intellectual Property is the right partner for you and other users of the system of intellectual property.

ARTICLE 1.7 POWER OF THE COMMITTEE OF MINISTERS

1. The Committee of Ministers is authorised to make those amendments to this Convention needed to ensure the conformity of this Convention with an international treaty or with the legislation of the European Community regarding trademarks and designs. The amendments will be published in the official journal of each of the High Contracting Parties.
2. The Committee of Ministers is authorised to adopt amendments to this Convention other than those referred to in the first paragraph. These will be submitted to the High Contracting Parties for their assent or approval. (...)

ARTICLE 1.9 POWERS OF THE MANAGEMENT BOARD

1. The Management Board (the 'Board') is authorised to submit proposals to the Committee of Ministers regarding amendments to this Convention needed to ensure the conformity of this Convention with an international treaty or with the legislation of the European Community, and also to submit other amendments to this Convention that the Board deems desirable.
2. The Board will lay down the Implementing Regulations.
3. The Board will lay down the Office's standing rules and financial rules.
4. The Board will assign additional tasks as referred to in Article 1.3 under c, in other areas of intellectual property law.
5. The Board will decide on the establishment of additional branches of the Office. (...)

ARTICLE 1.11 POWERS OF THE DIRECTOR GENERAL

1. The Director General will submit proposals to the Management Board in respect of amendments to the Implementing Regulations. (...)
6. He will take all other measures that he deems to be desirable to ensure that the Office can operate effectively.

EXPLANATORY NOTES

The ability to design efficient procedures and to promote an effective allocation of powers: this was one of the basic ideas behind the drawing up of the Benelux Convention on Intellectual Property (BCIP). It was also the reason why it was decided to delegate some powers as far down in the hierarchic structure as possible. We have naturally ensured that the new procedures still offer the necessary administrative and legal safeguards.

For instance, from now on the Committee of Ministers of the Benelux Economic Union will itself be able to adapt the law to bring it into line with European directives and international treaties/conventions. This only relates to adjustments that the Benelux countries are obliged to implement: as before, optional adjustments, or adjustments not related to international regulations, will require parliamentary assent.

The power to lay down the Implementing Regulations has been assigned to a lower-level body too, in this case the Management Board. We expect this step to speed up the procedure by about six months. In this way, we will be able to implement desired adjustments more quickly. This will make the intellectual property system more flexible and dynamic.

The application regulation has been abolished. From now on, we will publish the practical rules contained therein as decisions by the Director General. These rules describe such matters as the ways in which the Office wishes to receive certain information, how many images the Office needs to receive, and what the Office's opening times are.

Lower-level bodies now have the power to submit proposals to higher-level bodies. This will not only make our work more dynamic in nature but will also make it more user-friendly. Proposals based on practical experience will ensure that we can fine-tune the entire intellectual property system to the needs and wishes of its users.

**ARTICLE 5.1 THE ORGANISATION AS LEGAL SUCCESSOR
TO THE OFFICES**

1. The Organisation is the legal successor to the Benelux Trademarks Office established under Article 1 of the Benelux Convention on Trademarks of 19 March 1962 as well as to the Benelux Designs Office established by virtue of Article 1 of the Benelux Convention on Designs of 25 October 1966. On the day on which this Convention comes into force, all rights and obligations of the Benelux Trademarks Office and the Benelux Designs Office shall pass to the Organisation.

**ARTICLE 5.2 TERMINATION OF THE BENELUX CONVENTIONS
REGARDING TRADEMARKS AND DESIGNS**

On the day that this Convention comes into force, the Benelux Convention on Trademarks of 19 March 1962 and the Benelux Convention on Designs of 25 October 1966 shall be repealed.

ARTICLE 5.3 RESPECTING EXISTING RIGHTS

The rights that existed under the uniform Benelux Trade Mark Act and the Benelux Designs Act with regard to trademarks and designs respectively shall remain in force.

The Benelux Convention on Intellectual Property (BCIP) replaces the Benelux Convention on Trade Marks and the Benelux Convention on Designs. The BCIP only makes a single change to the substantive law ensuing from both Acts, namely the abolition of the requirement for a preliminary search for previous registrations in the case of a trademark filing. Naturally, this also means the abolition of the requirement to send a request for maintaining the application.

If a client requests it, the Office can still carry out a preliminary search for previous trademarks. In fact, the Office is even under an obligation to do this. To enable applicants and potential applicants to find any possibly conflicting anteriorities, the Trademarks Register can be consulted free of charge on the Offices' website. We have also expanded the range of search options for January 2006 the online Trademarks Register, allowing you to simultaneously search the European and international registers for trademarks that have legal force in the Benelux region.

In practice, the greatest change arises from the numbering used in the new Convention. The fact that the BCIP is replacing both Acts necessitated a change in the numbering system. A more logical structure has been chosen, which means that the order of the Articles has been changed. In fact, some paragraphs of some Articles have even been moved to other Articles, in order to make the whole easier to read. If you have used the Acts for years without having to read them, then you will have to skim through the Convention again in order to familiarise yourself with the new numbering. However, the user who is less familiar with it should find the new system more accessible. The new Convention naturally contains a table of concordance that shows where the Articles from the old conventions and existing Acts have been placed in the new Convention.

THE NEW STRUCTURE OF THE CONVENTION

The new basic structure of the Benelux Convention for Intellectual Property (BCIP) distinguishes five main Parts of the [Dutch and French language] Treaty.

The five Parts are:

- I: General and institutional provisions
- II: Trademarks
- III: Drawings or designs
- IV: Provisions that apply to both trademarks and drawings/designs
- V: Transitional provisions

Each individual Part is subdivided into chapters and the chapters themselves are subdivided into Articles. Each Article has a number that consists of two elements, the first element being the number of the Part in which the Article is found. In this way, all Articles numbered '2.x' relate to trademarks and all those numbered '3.x' relate to drawings or designs. Each Article is given a heading such as 'Organisation' or 'Refusal on absolute grounds' that summarises the content of that Article.

The Articles themselves are subdivided into paragraphs, each of which is given a number. The paragraphs are subdivided into subparagraphs that are indicated with lower-case letters.

THE NEW STRUCTURE OF THE IMPLEMENTING REGULATIONS

We have also chosen a new, more logical structure for the [Dutch and French language] Implementing Regulations (the 'Uitvoeringsbepalingen'), which are now grouped by subject. The regulations are first divided into four Parts:

The four Parts are:

- I: Trademarks
- II: Drawings or designs
- III: Common provisions
- IV: Charges and fees

Trademarks and drawings/designs are each given their own Part. The provisions that apply to both are set out in Part III. All matters relating to the charges and fees payable are set out in Part IV. In line with international practice, it has been decided to designate the provisions in the Implementing Regulations as 'Rules' ('regels') and no longer as 'Articles' ('artikelen').

Each Part is subdivided into chapters and the chapters themselves are subdivided into Rules. Each rule has a number that consists of two elements, the first element being the number of the Part in which the Rule is found. In this way, all Rules numbered '1.x' relate to trademarks and all those numbered '2.x' relate to drawings or designs. Each Rule is given a heading that summarises the content of that Rule.

THE IMPLEMENTING REGULATIONS: AMENDMENTS

In contrast to the new Convention, the Implementing Regulations have indeed seen a large number of amendments to ensure that our processes and procedures dovetail with current market practices. All amendments were arrived at after discussing them with the relevant stakeholders.

It has been decided to abolish the requirement to provide a power of attorney, as in practice the power of attorney offered us little of benefit and was basically viewed by the agents as an administrative chore. However, in the event of any uncertainty we will continue to ask for a power of attorney, in which case we shall require a recent original (i.e. not a copy). The power of attorney will continue to be required for the cancellation of any registration.

In the case of modifications, it will be sufficient from now on to provide copies of documentary evidence. Here too, we can ask for additional information if there is anything that needs clarification. This move puts us in line with current international practice. This change has been made possible by the improved quality of copies.

These days, people rarely come to our offices to file trademarks, even though our practice of antedating was based on this. The idea behind it was that everybody, wherever they filed, should have the same chance of being given a filing date. However, these days most filing is done via the Internet or by fax. These filing channels are available 24 hours a day and 7 days a week, which means that from now on the moment when these documents were actually received will be the official date of receipt. With digital submission, there are no such things as closing times or 'Office closed today'. Naturally, applicants can still come along in person and file a trademark at our offices, in which case the opening times for the Office and the national offices will apply.

In contrast, there is no change to procedure in respect of the deadlines by which documents have to be submitted: where deadlines expire on a day on which the Office is closed, we will extend the deadline until the next working day, as before.

From now on, we will deem renewals of trademark registrations to have been received when we have either received the appropriate petition or collected the renewal charges payment. Unfortunately, we cannot use the same system for trademark registrations that we use for the renewal of designs (i.e. renewal by payment alone). This is because both the above conditions ensue directly from the BCIP. However, the systems has been simplified as regards the allowability of the petition and the associated date.

The Implementing Regulations are also introducing an open category for trademarks that we are calling 'Other types of trademark'. Here, applicants can file something other than a word mark, logo, word/logo or shape trademark. We will naturally monitor the development of this category closely.

From now on, WIPO, the World Intellectual Property Organization, will publish the registration date of any international application that also applies to the Benelux region. If the opposition period has lapsed unutilised and the trademark has been accepted on absolute grounds, we will notify WIPO that protection has been granted.

After more than two years' experience in the handling of oppositions, we have made a number of improvements that simplify the opposition handling procedure. The Implementing Regulations now dovetail properly with market practice. The most obvious changes are the implicit petitions, the listing of the goods and services in question when submitting your opposition, and the option of paying the fees in two instalments.

There are two cases where an opposition will be deemed to be an implicit petition for renewal or for notice of modification, namely when the opposition is based on a trademark that still has to be renewed or when it is based on a trademark that is not registered in the opponent's name.

From now on, opponents will have the option of already stating in their submission the goods or services they are basing their claim on and what their opposition relates to.

It is now possible to pay the opposition fees in two instalments: you can pay the first 400 euros when submitting an opposition, and pay the remaining 600 euros if you decide to continue with the opposition once the legal procedure commences (i.e. after the end of the cooling-off period). You will naturally still be able to pay the entire opposition charge of 1,000 euros in one go should you so desire.



ALL THE CHANGES IN A NUTSHELL



- Abolition of the obligatory preliminary search for trademarks
- Abolition of the requirement to send a request for maintaining the application
- Abolition of the power of attorney requirement
- Abolition of the practice of antedating until the final moment that the Office or national offices were open
- Abolition of the requirement to submit original documents when submitting modifications
- A renewal petition for trademarks is now allowable as soon as one of the two conditions has been fulfilled
- Introduction of new 'Other types of trademark' category
- Introduction of implicit petitions for renewal or modification when submitting an opposition
- Option to pay the opposition fees in two instalments
- Option when submitting an opposition to state which goods or services are involved
- WIPO will be notified about the granting of protection for international registrations.

MORE INFORMATION

The website of the Benelux Office for Intellectual Property (BOIP) will be our most important communications channel. As befits a new organisation, we will also be launching a new website at www.boip.int, where you will also be able to obtain all the other information you need and download the new Convention and the Implementing Regulations. If you require paper versions of these texts, they can be ordered from us.

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WORK IN PROGRESS



On 1 September 2006 our name will change into

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