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**Council for Trade-Related Aspects
of Intellectual Property Rights**

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REVIEW OF LEGISLATION ON TRADEMARKS, GEOGRAPHICAL INDICATIONS AND INDUSTRIAL DESIGNS

Belgium¹

The present document reproduces the questions put to the delegation of Belgium and the responses given in the review of legislation on trademarks, geographical indications and industrial designs at the Council's meeting of 11-15 November 1996.²

I. REPLY TO THE GENERAL QUESTION CONCERNING PRIORITY RIGHTS³

Does your country recognize a right of priority on the basis of an earlier trademark application filed in any other WTO Member by a national of a WTO Member?

Article 3.1 of the Uniform Benelux Trademark Law (UBTL) specifies: "Without prejudice to the priority rights set forth in the Paris Convention for the Protection of Industrial Property or the Madrid Agreement concerning the International Registration of Marks, the exclusive right to a mark is acquired by the first registration ...".

If the country whose national wishes to benefit from priority is a member of the Paris Convention for the Protection of Industrial Property or the Madrid Agreement, then the answer to the question is: Yes, Belgium does recognize a right of priority for such nationals.

As to the UBTL, changes have been proposed by the three Governments (Protocol of 7 August 1996). Approval of these proposals is pending. After approval, nationals of all WTO Members can invoke priority rights when they apply for a "Benelux mark".

¹As regards laws and regulations in the areas under review as notified by Belgium under Article 63.2 of the Agreement, reference is made to documents IP/N/1/BEL/1, IP/N/1/BEL/T/1-2, IP/N/1/BEL/G/1-4 and Revisions, IP/N/1/BEL/O/1, IP/N/1/BEL/D/1-2 and IP/N/1/BEL/I/1-2.

²The minutes of this meeting are contained in document IP/C/M/11.

³At the meeting of the TRIPS Council of 11-15 November 1996, Members agreed to respond to this question in the context of the present review (document IP/C/M/11, paragraph 43).

II. REPLIES TO QUESTIONS POSED BY THE UNITED STATES

1. *Article 1 of the uniform law governing marks in the Benelux countries sets forth the types of signs that are capable of being protected as a trademark. This list of signs does not include colour marks. Please indicate whether colour marks are capable of constituting a trademark under the uniform law governing marks in the Benelux countries, and if so, under what authority.*

The list of signs capable of being protected as a trademark in Article 1 of the Uniform Benelux Trademark Law is not an exhaustive list. It is possible under the UBTL that a colour can constitute a trademark if it does fulfil the requirements for protection. In short, this means that a colour is able to distinguish the products or services of a certain company. The Benelux Trademark Office in The Hague, Netherlands can refuse registration of a colour as a trademark when it does not meet the requirement of distinctiveness. At the end, it is up to the judge in an infringement case to decide whether or not a colour does fulfil the requirements for protection, including the distinctiveness.

2. *Please explain whether the nature of goods or services to which a trademark is to be applied can serve as an obstacle to the registration of the mark under Belgian or Benelux trademark law. If so, please identify and explain the subject matter excluded under the authority, and the relative provisions of such law that serve as a basis for these exclusions.*

There are no special Belgian, Luxembourg or Dutch laws existing on the protection of trademarks. The UBTL is a common law of the Benelux countries which is applicable in Belgium, Luxembourg and the Netherlands.

The Benelux Trademark Office has the authority to refuse registration of trademarks when the nature of products or services is an obstacle to registration in only one case. A sign has to be refused as a trademark when the shape of a product is dictated by the nature of that product, and the shape affects the essential worth of the product (Article 1 UBTL). This exclusion of protection is meant to avoid conjunction of trademark protection and copyright and design protection.

3. *Please explain whether the uniform law governing marks in the Benelux countries provides for the acceptance of applications to register a trademark based on an intent to use the mark pursuant to TRIPS Article 15.3. Please explain the requirements and conditions that are placed on parties wishing to register and maintain applications of a mark based on an intent to use the mark.*

There are no requirements for the application of a trademark in the UBTL relating to the intention to use a trademark.

[Follow-up question from the US]

Please explain whether the uniform law governing marks in the Benelux countries provides for the acceptance of applications to register a trademark based on an intent to use the mark pursuant to TRIPS Article 15.3. If it does, please identify the relevant section of this law.

The acceptance of an application for a Benelux trademark is not dependant on the intention to use the mark. There are no such requirements in the UBTL and in that respect the law fully complies with Article 15.3 of the TRIPS Agreement.

4. *Article 5.2(a) of the uniform law governing marks in the Benelux countries allows the proprietor of a trademark to present "valid reasons" to justify continued registration despite non-use of a trademark. Please explain the types of circumstances that would be sufficient to satisfy this provision, including, where relevant, results of administrative or judicial decisions addressing the issue.*

In two cases, the Supreme Court of the Benelux for Benelux trademarks and designs (the Benelux Gerechtshof) has given an interpretation of what is meant by "valid reasons" in Article 5.2(a) UBTL. The Court ruled that any risk that is normal for running an enterprise cannot constitute a valid reason for non-use (*Winston decision*, 27 January 1981, NJ 1981, 333; *Kim decision*, 18 November 1988, NJ 1988, 299).⁴

5. *Please explain how unregistered well-known marks are protected in the Benelux countries, as required by TRIPS Articles 16.2 and 16.3.*

Well-known marks are protected through Article 4.5 UBTL. It is not possible to obtain a registration for a mark that can cause confusion with a well-known mark in the meaning of Article 6bis of the Paris Convention. The protection is also applicable when the conflicting marks are connected with dissimilar products or services. This protection applies as well to marks for products as to marks for services (Article 39 UBTL).

[Follow-up question from the US]

Does the Benelux trademark law place any requirements or conditions on owners of unregistered well-known marks who have brought an action against a third party's use of the unregistered well-known mark before that action can proceed?

The UBTL states that the proprietor of a well-known mark can only get a court ruling forcing a third party to stop its use of this well-known mark if this mark has been registered in the Benelux countries (Article 12.A.1). In the event that the proprietor of an unregistered well-known mark starts legal proceedings against a third party's use of this mark, the proprietor of the well-known mark always has the option of registering his mark during the proceedings, on the basis of Article 12.A.3, and thus fulfilling this specific requirement of the above-mentioned Article 12.A.1.

6. *Please explain whether a presumption of likelihood of confusion is provided under either the uniform law governing marks in the Benelux countries or Belgian laws or regulations in the determination of confusing similarity involving identical marks that are used on identical goods, as required by TRIPS Article 16.1. If so, please provide an indication of the basis for this presumption.*

Article 13.A.1(a) UBTL provides the right holder the opportunity to prevent third persons any use of the mark in the course of trade for products or services the mark has been registered for. Under these circumstances, likelihood of confusion is not required. Article 13.A.1(b) sets out that the right holder can take action against any use of the mark or a similar sign in the course of trade for products or services the mark has been registered for, or for similar products or services, when there is likelihood of association to the public between the mark and the sign.

7. *Please explain whether the uniform law governing marks in the Benelux countries imposes time limits on actions to cancel trademark registrations that have been obtained by means of fraud or bad faith.*

In case a mark has been registered in bad faith (Article 4.6 UBTL), the registration can be declared invalid when an action is brought to court within five years from the date of deposit.

⁴Subsequent to request from the United States following this answer, copies of these decisions were provided (see Annex I and II to the present document).

[Follow-up question from the US]

According to this response, marks registered in bad faith can only be cancelled if an action is brought to court within five years from the date of deposit. Please explain how the Benelux countries implement Article 6bis(3) of the Paris Convention, which states that no time limit shall be fixed for requesting the cancellation of a mark registered in bad faith.

Article 14.B.2 in conjunction with Articles 4.5 and 4.6 of the UBTL states that a registration for a mark that causes confusion with a well-known mark (Article 4.5), or for a mark that has been registered in bad faith (Article 4.6), can be declared invalid if a case is brought to court within five years of the date of deposit. The Supreme Court of the Benelux, however, ruled in the *Adidas case* (BenGH 23 December 1985)⁵ that the time limit of five years in Article 14.B.2 does not apply when a mark is registered in bad faith and the infringed mark is a well-known mark as mentioned in Article 6bis of the Paris Convention. This means that, in these cases, no time limit applies for invoking invalidation of a mark registered in bad faith.

8. *Please explain how geographical indications are protected under Belgian law, as required by TRIPS Articles 22 and 23.*

Geographical indications are protectable under Articles 16 to 21 of the law of 14 July 1991 on the trade practices, information and protection of the consumer. A judicial procedure can be introduced under Articles 95 to 100 of the same law.

Such indications can also be protected through the general action against unlawful acts (Article 1382, Civil Code). When registered geographical indications are protected through EC Regulation 2081/92 of 14 July 1992 of the European Council, and the Regulations 1107/96 of 12 June 1996 and 1263/96 of 1 July 1996 of the European Commission.

9. *Please describe the methods by which industrial designs are protected in Belgium, in particular:*

- (a) *the form or forms of intellectual property used to protect the design (e.g., patent, copyright, sui generis);*
 - (b) *the conditions that must be satisfied to obtain the grant of such protection (e.g., whether designs must be new or original and the parameters of these concepts), and a brief description of the registration or granting procedure;*
 - (c) *the nature of the rights granted and the term of protection provided;*
 - (d) *the nature of remedies available to the owner of each type of protection, including a description of the conditions that may be imposed (e.g., whether commercial use is required); and*
 - (e) *whether any exceptions to protection or rights exist for each type of intellectual property involved.*
- (a) The uniform law governing the protection of designs in the Benelux (UBDL) and the Belgian Copyright Law of 30 June 1994 are used to protect designs in Belgium.

⁵See Annex III to the present document.

- (b) A design can be protected through the UBDL if it meets the requirements set out in Article 1 UBDL. The design has to fulfil the requirement of novelty and the object of protection has to be a utility product. The first deposit of a design causes the design right (Article 3 UBDL). Designs are not examined by the Benelux Design Office except for conflict with public order or morality, and there is not foreseen in an opposition procedure (Article 9 UBDL). A deposit can take place with the national services of the Benelux countries or the Benelux Design Office in the Hague, Netherlands. The deposit has to contain a (photo)graphical representation of the appearance of the object and a payment of the prescribed taxes (Article 8 UBDL).

Under the Belgian Copyright Law the holder of a design obtains a copyright as soon as he has completed the design and if the design has its own original character and a personal mark of the maker. There is no official and specific registration procedure. Both for design and copyright protection in cases before court will be judged whether a design fulfils the requirements of protection for design or copyright.

- (c) Once a design is filed in the Benelux Design Office, the depositor obtains an exclusive right to prevent others to produce, import, export, sell, offer for sale, rent, offer for rental, exhibit, deliver, use or keep in stock for industrial or commercial purposes a design with the same or similar appearance (Article 14.1 UBDL). The maximum term of protection in the UBDL is 15 years from the date of deposit (Article 12 UBDL).

A copyright gives the right holder the exclusive right to prevent others to copy his design or to make it public (Article 1 Belgian Copyright Law). The term of protection ends 70 years after the death of the maker (Article 2 Belgian Copyright Law).

- (d) The holder of a right based on the UBDL can bring an infringement case before court and ask for declaratory judgements, a claim for damages, an order to abstain from certain activities or to act, such as recalling infringing products, and providing information about suppliers. When court has stated the infringement was on purpose, the right holder can claim destruction of the infringing products and productive machinery, a property claim on these goods and a claim on money obtained from infringing activities. No further conditions than those mentioned in Article 14.1 UBDL are required.

The holder of a copyright can also bring an infringement case to court without any further conditions. He can ask for declaratory judgements, a claim for damages, or an order to abstain recalling infringing products or producing materials.

- (e) Excluded from protection under the UBDL are those appearances of objects which are necessary to obtain a technical effect.

The Court of Justice of the European Communities has ruled for design rights based on the UBDL that such rights will be exhausted in the European Economic Area (EEA) and not only in the Benelux countries, when the object of protection has been brought on the market in the EEA by the right holder or by a third person with his consent.

Under the Belgian Copyright Law there are no specific exceptions to protection.

10. *Please explain how textile designs are protected under your law.*

Textile designs are protectable as well under the UBDL as the Belgian Copyright Law. In both laws there is not foreseen in exceptions especially for textile designs.

ANNEX I

Arrêt du 27 janvier 1981

La société à responsabilité limitée
TURMAC TOBACCO COMPANY B.V.
contre

la société de droit américain

R.J. REYNOLDS TOBACCO COMPANY Inc. et
la société à responsabilité limitée
R.J. REYNOLDS TOBACCO B.V.

Affaire A 8Q/1

Président	: M. F. Goerens
Vice-Présidents	: MM. Ch.M.J.A. Moons et le Baron J. Richard
Juges	: MM. R. Legros, R. Thiry, C. Wampach et W.L. Haardt
Juges suppléants	: MM. A. Meeus et S.K. Martens
Avocat général	: M. W.J.M. Berger
Avocats	: Mes. A.G. Maris, E.Ch. Kuhn, L.D. Pels Rijcken, Th.R. Bremer et A. Braun
Langue de la procédure	: le néerlandais

Loi uniforme Benelux sur les marques de produits (L.B.M.).

1. *Extinction du droit à la marque — Article 5-3 de la loi uniforme sur les marques de produits — 'Aucun usage normal' — Notion.*

2. *Extinction du droit à la marque — Article 5-3 de la loi uniforme sur les marques de produits — 'Usage normal' — Notion.*

3. *Extinction du droit à la marque — Article 5-3 de la loi uniforme sur les marques de produits — 'Aucun usage normal' — 'Juste motif' — Notion.*

4. *Frais exposés devant la Cour de Justice Benelux — Interprétation de règles juridiques communes — Attributions juridictionnelles de la Cour — Fixation de ces frais par la Cour — Honoraires des conseils des parties — Notion.*

1. Aux termes de l'article 5-3 de la loi uniforme Benelux sur les marques de produits, le droit à la marque s'éteint dans la mesure où, dans les délais précisés par cette disposition, il n'y a eu, sans juste motif, 'aucun usage normal' de la marque sur le territoire Benelux, ni par le titulaire, ni par un licencié; en utilisant l'expression 'aucun usage normal' et non seulement celle qui est visée par l'article 4 — 6a et 6b — de la même loi, à savoir 'usage normal', ledit article 5-3 dispose qu'il est en principe

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requis que le signe servant à distinguer le produit ait été utilisé dans la vie des affaires hors de l'entreprise et que cet usage se rapporte, sans ambiguïté, à un produit déterminé vendu ou offert en vente et qui, par un tel usage, se distingue des produits d'autrui.

2. Pour déterminer s'il y a, au sens de l'article 5-3 de la loi uniforme Benelux l'"usage normal" de la marque qui évite que le droit à cette marque s'éteigne, il faut prendre en considération dans leurs rapports réciproques tous les faits et circonstances propres à la cause; il est déterminant qu'il se dégage de l'ensemble de ces circonstances, que l'usage a eu pour objet de créer ou de conserver un débouché pour les produits distingués par la marque et non seulement pour sauvegarder le droit à la marque.

3. Lorsqu'il n'a été fait 'aucun usage normal' de la marque, au sens de l'article 5-3 de la loi uniforme, le droit à la marque ne s'éteint néanmoins pas lorsque des faits ou des circonstances sur lesquels le titulaire de la marque ou le licencié est sans pouvoir et qui ne constituent pas des risques normaux de l'entreprise, ont rendu l'usage normal de la marque impossible ou, à tout le moins, auraient rendu cet usage, compte tenu des critères usuels de la vie des affaires, à ce point difficile ou onéreux qu'il ne peut être raisonnablement exigé de la part du titulaire de la marque ou de celui qui bénéficie d'une licence.

4. Lorsque la Cour de Justice Benelux statue sur une question d'interprétation qui lui a été soumise par une juridiction des Pays-Bas, elle comprend, parmi le montant des frais exposés devant elle, et qu'elle fixe, les honoraires promettés par les conseils des parties qui ont déposé un mémoire recevable au cours de la procédure (Traité du 31 mars 1965, art. 13, et règlement de procédure de la Cour, art. 8).

Traduction

La Cour de Justice Benelux

Dans l'affaire A 80/1

Vu la lettre du Hoge Raad der Nederlanden du 11 janvier 1980 accompagnée d'une copie certifiée conforme de l'arrêt du Hoge Raad du 11 janvier 1980 rendu en cause de société à responsabilité limitée TURMAC TOBACCO COMPANY B.V. à Amsterdam contre 1. société de droit américain R.J. REYNOLDS TOBACCO COMPANY INC. à Winston-Salem, Caroline du Nord, Etats-Unis d'Amérique et 2. société à responsabilité limitée R.J. REYNOLDS TOBACCO B.V. à Hilversum, par lequel sont posées, conformément à l'article 6 du Traité relatif à l'institution et au statut d'un Cour de Justice Benelux, des questions relatives à l'interprétation de l'article 5, 3. de la Loi uniforme Benelux sur les marques de produits;

Quant aux faits:

Attendu que le Hoge Raad a énoncé comme suit les faits auxquels doit s'appliquer l'interprétation à donner par la Cour de Justice Benelux:

'En 1963, Turmac était titulaire aux Pays-Bas de la marque Whiston pour des cigarettes, Reynolds, titulaire dans un certain nombre d'autres pays de la marque Winston pour des cigarettes. L'Arrondissementsrechtbank de La Haye a annulé, par décision du 29 mars 1963 prise à la requête de Turmac, l'enregistrement au nom de Reynolds de la marque Winston aux Pays-Bas, annulation prononcée en raison du caractère ressemblant de cette marque dans ses traits essentiels avec la marque Whiston de Turmac. Le 12 juillet 1963, Turmac a fait enregistrer la marque Winston pour des cigarettes. Reynolds a demandé alors à l'Arrondissementsrechtbank de la Haye d'annuler ce dernier enregistrement de Turmac, mais le Tribunal a rejeté cette requête par décision du 30 mai 1964. Reynolds a interjeté appel de cette décision auprès de la Cour d'appel de La Haye. En outre, Reynolds a engagé, devant l'Arrondissementsrechtbank d'Amsterdam, une action contre Turmac tendant entre autres à ce que tout usage par Turmac de la marque Winston pour des produits de tabac aux Pays-Bas soit déclaré illicite à l'égard de Reynolds.

Le 10 septembre 1965, Turmac et Reynolds ont conclu une convention dont le contenu suit:

Agreement

Agreement made this 10th day of September 1965 between R.J. REYNOLDS TOBACCO COMPANY of Winston-Salem, North Carolina, a corporation organized and existing under the laws of the State New Jersey, United States of America and TURMAC TABAK MAATSCHAPPI (Turmac Tobacco Company) N.V. of Amsterdam, a corporation organized and existing under the laws of the Kingdom of the Netherlands.