

International Comparative Legal Guides



Trade Marks 2020

A practical cross-border insight into trade mark work

Ninth Edition

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This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.

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From the Publisher

Dear Reader,

Welcome to the ninth edition of *The International Comparative Legal Guide to: Trade Marks*, published by Global Legal Group.

This publication provides corporate counsel and international practitioners with comprehensive jurisdiction-by-jurisdiction guidance to trade mark laws and regulations around the world, and is also available at www.iclg.com.

This year, there are two expert chapters which provide an overview of online intermediary liability and trade mark infringement and the overlap between trade mark and design rights from an Indian perspective.

The question and answer chapters, which in this edition cover 48 jurisdictions, provide detailed answers to common questions raised by professionals dealing with trade mark laws and regulations.

As always, this publication has been written by leading trade mark lawyers and industry specialists, for whose invaluable contributions the editors and publishers are extremely grateful.

Global Legal Group would also like to extend special thanks to contributing editor Nick Aries of Bird & Bird LLP for his leadership, support and expertise in bringing this project to fruition.

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1 Relevant Authorities and Legislation

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

The relevant trade mark authority for Belgium is the Benelux Office for Intellectual Property (“**BOIP**”), which acts as the official body for trade mark and design registrations in the Benelux Union.

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

The relevant trade mark legislation is the Benelux Convention on Intellectual Property (trade marks and designs) of 25 February 2005 (“**BCIP**”), as last amended by the Protocol of 11 December 2017, which entered into force on 1 March 2019.

The BCIP must be read in combination with the Implementing Regulations under the Benelux Convention on Intellectual Property (trade marks and designs) (“**IRBCIP**”), whose amended version also entered into force on 1 March 2019.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

According to Article 2.1 BCIP, a trade mark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings, and being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection.

2.2 What cannot be registered as a trade mark?

The BCIP does not provide a list of signs that cannot be registered as trade marks. Therefore, if a sign meets the conditions of Article 2.1 BCIP, it can be registered as a trade mark. However, the registration as a trade mark may be refused on the basis of absolute and relative grounds of refusal (on that point, see *infra* – sections 3 and 4).

2.3 What information is needed to register a trade mark?

According to Rules 1.1 to 1.4 IRBCIP, the application document must contain, *inter alia*, the applicant’s name and address, the representation of the trade mark, a list of the goods and services for which the trade mark is intended, a specification of the trade mark and the applicant’s signature.

2.4 What is the general procedure for trade mark registration?

Upon filing of the application, the BOIP will first examine whether the formalities have been fulfilled. In that case, it will publish the trade mark application. The BOIP will then check the existence of absolute grounds of refusal pursuant to Article 2.11 BCIP.

2.5 How is a trade mark adequately represented?

Pursuant to Rule 2.1 BCIP and 1.1 IRBCIP, the representation of a trade mark must enable the competent authorities and the public to determine the clear and precise subject matter of the protection granted to the owner. A 50 word description of the distinctive elements of the trade mark may be provided.

2.6 How are goods and services described?

Pursuant to Article 2.5*bis* BCIP, the goods and services must be identified in conformity with the Nice Classification, with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the exact scope of the protection.

2.7 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Exotic trade marks may be registered at the BOIP provided they fulfil the aforementioned conditions. In the case of colour marks, the colour code should be indicated in the application.

2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Under the BCIP, proof of use is not required for the registration and renewal of trade marks.

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

A registered Benelux trade mark has a unitary character in the Benelux Union (Belgium, the Netherlands and Luxembourg).

2.10 Who can own a trade mark in your jurisdiction?

A Benelux trade mark may be owned by a natural person or a legal entity, regardless of its place of residence.

2.11 Can a trade mark acquire distinctive character through use?

Pursuant to Article 2.2*bis*, §3, BCIP, a trade mark that lacks inherent distinctive character may be registered if, before the date of application for registration, it has acquired distinctive character through use. In that case, proof of acquired distinctiveness must be provided by the applicant. For the same reason, a trade mark shall not be declared invalid if, before the date of application for a declaration of invalidity, it has acquired a distinctive character through use.

2.12 How long on average does registration take?

On average, the registration procedure may take three to six months. However, if an opposition is filed after the application was published, the registration procedure may take much longer, and the trade mark might not be registered at all as a consequence of the opposition.

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

The basic fee for an individual trade mark is €244 for one class and an additional fee will be added per class of goods or services (€27 for the second class and €81 per class from the third on). The basic fee for a collective or certification mark is €379 for one class and an additional fee will be added per class of goods or services (€42 for the second class and €126 per class from the third on).

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

A Benelux trade mark may be registered at the BOIP based on the BCIP or through another national office based on the Madrid Protocol. A European trade mark (covering the Benelux territory, which is entirely part of the European Union) may also be registered at the EUIPO on the basis of Trade Mark Regulation n°2017/1001.

2.15 Is a Power of Attorney needed?

Pursuant to Rule 3.7 IRBCIP, a Power of Attorney is not needed,

since any party claiming to act as the representative of an interested party is presumed to have been authorised by the interested party. However, if the BOIP has doubts on the representative's authorisation, it may request the submission of a Power of Attorney.

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

This is not applicable.

2.17 How is priority claimed?

Pursuant to Article 2.6 BCIP and Rule 1.4 IRBCIP, a right of priority may be claimed:

- at the time of the filing, by stating the application, the country, the date, the number and the holder of the application that serves as the basis for the right of priority; or
- during the month following the filing, by stating the same information and by means of a special declaration submitted to the BOIP.

2.18 Does your jurisdiction recognise Collective or Certification marks?

In the Benelux, collective marks may be registered pursuant to Chapter 8 of the BCIP, whereas certification marks may be registered pursuant to Chapter 8*bis* of the BCIP.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

Pursuant to Article 2.2*bis* BCIP, the absolute grounds of refusal may be presented as follows:

- signs which cannot constitute a trade mark;
- trade marks which are devoid of any distinctive character;
- trade marks which consist exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services;
- trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;
- signs which consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves, which is necessary to obtain a technical result, or which gives substantial value to the goods;
- trade marks which are contrary to public policy or to accepted principles of morality;
- trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or services;
- trade marks which have not been authorised by the competent authorities and are to be refused or invalidated pursuant to Article 6*ter* of the Paris Convention;
- trade marks which are excluded from registration pursuant to relevant legislation providing for protection of designations of origin and geographical indications, traditional terms for wine, traditional specialities guaranteed or plant variety rights; and
- signs for which the application is made in bad faith.

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

If the BOIP objects the registration on the basis of absolute grounds, the applicant is notified in writing of the reason of its provisional refusal, pursuant to Article 2.11 BCIP. The applicant may file an objection, stating the reasons why the registration should be accepted, within a period of one month that can be extended to a maximum period of six months, pursuant to Rule 1.12 IRBCIP. If the BOIP maintains its decision in whole or in part, the applicant is notified of its final decision and of the legal remedies.

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

The final decision of the BOIP to refuse the registration of the trade mark is subject to appeal by the applicant to the Benelux Court of Justice (“**BCJ**”), in order to have that decision annulled or reviewed, pursuant to Article 1.15*bis* BCIP.

3.4 What is the route of appeal?

The appeal to the BCJ must be filed within two months from the notification of the final decision, pursuant to Article 1.15*bis* BCIP. In the proceedings before the BCJ, the BOIP may be represented by a member of staff appointed for this purpose. The applicant may be represented by an attorney. The BCJ may refer questions of interpretation of EU law to the Court of Justice of the European Union (“**CJEU**”).

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

Relative grounds for refusal are only examined by the BOIP upon request in the frame of opposition proceedings. Pursuant to Article 2.2*ter* BCIP, these grounds refer to the existence of earlier rights, namely:

- An earlier identical trade mark filed for identical goods or services.
- An earlier identical or similar trade mark filed for identical or similar goods or services, if there exists a likelihood of confusion on the part of the public.
- An earlier identical or similar reputed trade mark, irrespective of the similarity of the goods or services, when the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character of the reputed earlier trade mark.
- An earlier application for a designation of origin or geographical indication.

4.2 Are there ways to overcome a relative grounds objection?

See section 5.

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?

In the Benelux, a trade mark can be opposed on the basis of the relative grounds listed in Article 2.2*ter* BCIP (see question 4.1).

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

When the opposition is based on an earlier trade mark, the opponent can be the trade mark owner and the duly authorised licensee.

5.3 What is the procedure for opposition?

Pursuant to Article 2.14 BCIP, an opposition may be filed in writing at the BOIP within two months following publication of the application. The BOIP decides whether the opposition is admissible. At the end of a period of two months (known as the “cooling-off period”, which can be extended by mutual request), the BOIP notifies the parties of the commencement of the procedure, if no amicable settlement has been reached. After that notification, the opponent has two months to provide arguments. The BOIP then sends the opponent’s arguments to the defendant, who has two months to respond and request the proof of use of the earlier trade mark. The BOIP may request one or more parties to submit additional arguments or documents. An oral hearing may take place. Finally, the BOIP will take its decision on the opposition. On the conditions of appeal, see questions 3.3 and 3.4.

6 Registration

6.1 What happens when a trade mark is granted registration?

Pursuant to Rule 1.6 IRBCIP, the BOIP publishes the application in the register, stating the registration number, the indications contained in the trade mark application, the date on which the period of validity of the registration expires and the registration number. Pursuant to Article 2.8 BCIP, the BOIP will confirm the registration to the trade mark owner.

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

The applicant’s trade mark rights commence once the BOIP has registered the application. From the registration onwards, the trade mark owner has an exclusive right that he can invoke against third parties.

6.3 What is the term of a trade mark?

The registration of a Benelux trade mark is valid for a period of 10 years from the filing date, which can be renewed.

6.4 How is a trade mark renewed?

Pursuant to Article 2.9 BCIP, the BOIP reminds the trade mark owner that the registration needs to be renewed. Renewal takes place upon payment of the renewal fees. The fees should be paid within a period of six months preceding the expiry of the registration (or within a further period of six months, if an additional fee is paid). The renewal is recorded by the BOIP, and takes effect from the day following the expiration date of the existing registration.

7 Registrable Transactions

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

An individual may register the assignment of a trade mark. Registration is not mandatory for the assignment to be effective between the parties, but it is needed to be enforceable against third parties.

7.2 Are there different types of assignment?

Pursuant to Article 2.31 BCIP, the transfer of a trade mark may take place, with or without the transfer of the undertaking of the trade mark owner, in respect of some or all the goods or services for which it is registered, provided it is laid down in writing and covers the entire Benelux territory.

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

An individual may register the licensing of a trade mark. Registration is not mandatory for the licence to be effective between the parties, but it is needed to be enforceable against third parties.

7.4 Are there different types of licence?

Pursuant to Article 2.32 BCIP, a trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Benelux territory. It may be exclusive or non-exclusive.

7.5 Can a trade mark licensee sue for infringement?

The licensee may bring infringement proceedings only if the trade mark owner has consented thereto. However, the exclusive licensee may bring such proceedings after a formal notice to the trade mark owner if the latter does not himself bring such proceedings within an appropriate period.

Furthermore, the licensee may intervene in an action brought by the trade mark owner to obtain compensation for his damages or to be allocated a proportion of the profit made by the defendant. He may also bring independent action for that purpose if the trade mark owner has consented thereto.

7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not mandatory, but are nevertheless advisable.

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

Pursuant to Article 2.32*bis* BCIP, a trade mark may indeed be given as a security interest or be subject of rights *in rem*.

7.8 Are there different types of security interest?

No, although a Benelux trade mark may be given as a security interest with or without the undertaking of the party that gives the security interest.

8 Revocation

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

Pursuant to Article 2.27 BCIP, a trade mark shall be liable to revocation if no genuine use has been made of it in the Benelux territory within a period of five years, it has become a common name in the trade for a product or service in respect of which it is registered or it is liable to mislead the public as a result of the use made of it.

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

Revocation proceedings may be conducted before the BOIP or before the competent Belgian national courts. Before the BOIP, revocation proceedings will closely follow the procedure of opposition proceedings, except that there is no “cooling-off” period. Before national courts, the usual judicial procedure will be followed.

8.3 Who can commence revocation proceedings?

Before national courts, revocation proceedings can be conducted by any natural or legal person with an interest in claiming revocation. Before the BOIP, in the administrative revocation proceedings, no personal interest is required.

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

The trade mark owner can raise several grounds of defence. Depending on the grounds for revocation, he will have to prove that the trade mark has been genuinely used or that the lack of genuine use is justified, that the trade mark still has a distinctive character, or that the trade mark is not misleading.

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

BOIP’s decisions of revocation may be appealed to the BJC within two months after the notification of the decision. Belgian national court’s decisions of revocation may be appealed to the competent Court of Appeal within one month of the date of service of the judgment to the other party, which must be extended in the case of a foreign company pursuant to Article 1051 of the Belgian Judicial Code (“BJC”).

9 Invalidity

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

A trade mark may be invalidated on the basis of absolute and relative grounds (see question 2.4 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?

Before national courts, invalidity proceedings can be conducted by any natural or legal person with an interest in claiming nullity. In addition, the Public Prosecutor can bring an action on the basis of absolute grounds to the courts of Brussels, The Hague and Luxembourg. In that case, any other action brought on the same grounds will be stayed. Before the BOIP, in the administrative proceedings in nullity, no personal interest is required.

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

The trade mark owner can raise several grounds of defence. Depending on the grounds for invalidation, he might have to prove, *inter alia*, that the trade mark has a distinctive character, that the application was not made in bad faith, or that the prior rights invoked are invalid. Pursuant to Article 2.30 *quinquies* BCIP, the trade mark owner can also invoke the non-use of the earlier trade mark as a defence if the earlier trade mark is under the obligation of genuine use. He may also contest the existence of a likelihood of confusion or the existence of a damage to the reputation or the distinctive character of the earlier trade mark. He may finally invoke the consent of the earlier trade mark owner or the existence of a due cause.

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

BOIP's decisions of invalidation may be appealed to the BCJ within two months after the notification of the decision. Belgian national court's decisions of invalidation may be appealed to the competent Court of Appeal within one month of the date of serving of the judgment to the other party, which must be extended in the case of a foreign company pursuant to Article 1051 BJC.

10 Trade Mark Enforcement

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

Benelux trade mark infringement proceedings may be brought (1) to the Presidents of Belgian Business Courts established at the seat of a Court of Appeal (i.e. Brussels, Antwerp, Ghent, Mons and Liège) in order to claim an injunction, and/or (2) to the Belgian Criminal Courts in order to obtain a criminal conviction of the infringer. Territorial jurisdiction will be mainly determined on the basis of the place of the infringement, the place of the execution of the obligation, the address of the defendant or a valid contractual clause designating the Belgian Courts. Regarding EU trade marks, only the Brussels Business Courts are competent.

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

Key pre-trial procedural stages may involve, *inter alia*, a cease-and-desist letter, a description seizure, the designation of an expert, negotiations and/or a mediation. The length of the pre-trial procedural stages will depend on the measures taken by the trade mark owner. Pre-trial procedural stages are not compulsory.

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

Provided that the plaintiff establishes the urgency and the obvious character of the infringement, the Presidents of Belgian Business Courts can grant preliminary injunctions and interim measures pursuant to Article 19 BJC, in order to prevent imminent infringement or forbid the continuation of the infringement, subject to penalty payments. In the case of a risk of irreparable harm, it is possible to request *ex parte* proceedings in order to obtain descriptive measures or the seizure of the infringing goods and the materials used to manufacture them. Prohibitory injunctions are available in proceedings on the merits. A specific "fast track" action allows the president of the competent Business Court to grant a final injunction for prohibitory injunctive relief ("*action en cessation*"). For more information concerning final injunctions, see question 12.1.

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

It is possible to use the *ex parte* procedure for counterfeit seizure in order to inspect premises where an alleged infringement takes place. An expert appointed by the president of the competent Business Court can seize relevant information and goods and provide a report with his findings. However, trade secrets may be invoked as a defence.

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

In Belgium, legal submissions are filed in writing, and the case is pleaded orally at the hearing. The courts may decide to hear witnesses, but there is no system of cross-examination organised in that regard.

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

Infringement may be stayed by Belgian courts in case the validity of a Benelux trade mark is challenged at the BOIP or before another court in the Benelux.

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

Pursuant to Article 2.30 *septies*, §2, BCIP, the trade mark owner is no longer entitled to prohibit an infringing use in the event that he has knowingly tolerated that use for a period of five years and that the disputed sign has been duly registered (rule

of acquiescence). Pursuant to Article 2262*bis*, §1, of the Belgian Civil Code, a trade mark damage claim will be time-barred after five or 10 years, depending on the nature of the infringement (extra-contractual or contractual).

10.8 Are there criminal liabilities for trade mark infringement?

Pursuant to Articles 179 to 192*ter* of the Belgian Criminal Code, the infringement of a trade mark may constitute a criminal offence, punishable by imprisonment and the prohibition to exercise certain rights.

10.9 If so, who can pursue a criminal prosecution?

Under Belgian Criminal law, any party injured by the infringement, including the trade mark owner, the licensee or even a consumer, may file a complaint with the police, the Public Prosecutor or the Economic Inspection Authority.

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

There are no such provisions under Belgian law.

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 alleged infringer may invoke different defence grounds depending on the infringement claim, most notably: absence of likelihood of confusion between the signs; absence of reputation and/or absence of unfair advantage taken from the reputation of the trade mark; or invalidity of the trade mark for lack of genuine use.

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

The alleged infringer may invoke the exhaustion of the trade mark rights or the acquiescence of the trade mark owner with regards to the use of his trade mark. He may raise arguments disputing the validity of the trade mark registration or, in proceedings on the merits, launch a counterclaim for invalidity (revocation).

12 Relief

12.1 What remedies are available for trade mark infringement?

In case of infringement, trade mark owners may invoke remedies including the following:

- Cease and desist order (prohibitory relief).
- Damages and, in relevant cases, surrender of the profits made in bad faith.
- Recall and destruction of the infringing goods.
- Delivery of the materials and tools used to manufacture the infringing goods.
- Publication of the decision or a summary thereof.

- Provision of all information concerning the origin and the channels of distribution of the infringing goods.

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?

Judiciary expenses related to the proceedings are recoverable from the losing party. In Belgium, the losing party has to pay a procedural indemnity to cover the lawyer's fees of the winning party, whose amount is determined on the basis of a Royal Decree providing a statutory cap per instance. Other costs related to the case may be part of a damage claim.

13 Appeal

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

Pursuant to Article 1050 BJC, a first instance judgment may be appealed from the day it is pronounced. Pursuant to Article 1068 BJC, the appeal is referred to the judge of appeal on the merits of the case, and not merely on a point of law.

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

New evidence may be added at the appeal stage.

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 n°608/2013, Belgian custom authorities are entitled to halt imports of infringing goods, either *ex officio* or on the basis of an application by the trade mark owner. In both cases, the authorities can suspend the release of imported goods and notify the trade mark owner. Within a short period, the trade mark owner must establish the infringement and claim the destruction of the goods. In that case, the alleged infringer has to respond. If he stays silent, the goods will be destroyed. If he opposes the destruction of the goods, the trade mark owner will have to initiate legal proceedings.

15 Other Related Rights

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

Pursuant to Article 2.19 BCIP, unregistered trade marks may not be invoked in the Benelux, except if they are well known in the sense of Article 6*bis* of the Paris Convention.

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

In Belgium, the first company that uses a company name has an exclusive right over it within the territorial space where it is known by the public, provided it is genuinely put to use. Modification of the company name, as well as damages, may

be claimed where another company uses a company name or a distinctive sign including a later trade mark identical or similar to an earlier company name, provided that it is likely to cause confusion on the part of the relevant public.

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

Beyond trade mark rights, a sign can also be protected by copyright provided it constitutes an original work and/or by design rights if the conditions of Title III BCIP are met. In Belgium, there is no specific IP protection for book titles and film titles.

16 Domain Names

16.1 Who can own a domain name?

Belgian domain names can be owned by natural persons and legal persons alike.

16.2 How is a domain name registered?

Belgian domain names must be registered through an accredited registrar at DNS Belgium.

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

Pursuant to Article XVII.23 of the Belgian Economic Law Code, Belgian courts are competent to order the termination or the transfer of the registration of a domain name which is identical or confusingly similar to an earlier domain name.

16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

In Belgium, “.be” ccTLDs are available for registration.

16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

In Belgium, alternative dispute resolution procedures are available for “.be” ccTLDs at the Belgian Centre for Arbitration and Mediation (“CEPANI”).

17 Current Developments

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

As of 1 January 2019, the “three classes for the price of one” system was replaced by a “one fee per class” system in the Benelux, which applies to registration and renewal fees alike.

As of 1 March 2019, the “trade mark Package” was implemented in the Benelux, as a result of the transposition of the new trade mark Directive n°2015/2436 in the BCIP. The extension of the administrative invalidity and revocation procedures came as a complement to the previous extension of invalidity and opposition procedures introduced in 2018.

The requirement of “graphic” representation was replaced by the requirement of “clear and precise” representation in Article 2.1 BCIP, making it easier to register signs that are difficult to capture (such as holograms, motion marks and sounds).

Furthermore, a distinction was introduced in the BCIP between “certification marks” (Chapter 8*bis* BCIP), which refer to quality marks, and “collective marks” (Chapter 8 BCIP), which refer to association marks.

Finally, the absolute grounds of refusal of shape marks in Article 2.2*bis*, §1, e) BCIP were extended to “other characteristics of the goods”, so that the refusal of registration of a trade mark may also be based on the fact that it consists exclusively of characteristics other than the mere shape of the goods.

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

By **judgment of 7 August 2019**, the President of the Brussels French-Speaking Business Court has found three companies of the Amazon group guilty of infringing Christian Louboutin’s trade mark rights by advertising on the websites Amazon.fr and Amazon.de reproductions of high-heeled shoes with red soles which were not put on the market with Christian Louboutin’s consent.

By **judgment of 22 February 2019**, the Brussels Court of Appeal has found the existence of a likelihood of indirect confusion on the part of the relevant public between the Benelux trade mark application “Strawberry.com” and the earlier trade mark “Blackberry” in relation to goods and services of classes 9 and 38. In turn, it has partially annulled the BOIP decision of 22 December 2017 on the matter, and refused to register the trade mark application for “Strawberry.com” for the goods and services of classes 9 and 38.

By **judgment of 5 November 2019**, the Court of Appeal of Liège has confirmed that the use of the “TIGERCAT” trade mark by Tigercat International Inc. in relation to goods of classes 7 and 12 infringes Caterpillar Inc.’s rights on its earlier trade mark “CAT” due to a likelihood of confusion between the trade marks at stake. In turn, it has ordered Tigercat to cease any use of the “TIGERCAT” trade mark in the Benelux in relation to goods of classes 7 and 12, including in the forestry sector, under high penalties per single use and per day.

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

No significant developments are expected in the next year in Benelux trade mark law.

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

Since 1 March 2019, the reform of the BCIP has simplified the registration and enforcement of non-traditional trade marks before the BOIP and national courts (such as in the case of the Louboutin red sole trade mark). On the other hand, especially in Belgium, an increasing judicial backlog appears to burden the efficiency of the judicial remedies offered to trade mark owners, by extending the period of time needed to obtain a final decision on the merits of a trade mark infringement case.



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