



Protecting trademarks in the Benelux region

Information for entrepreneurs



BENELUX
OFFICE FOR
INTELLECTUAL
PROPERTY

Registration: the first step
towards a successful business



Have a powerful trademark from the word go

'When I went into business as an entrepreneur, I did hesitate before registering my brandname. Was it too early to register my new trademark? After all, as a sole trader, you've got to spend your capital carefully. Well, all I can say is that it's a relatively small investment that is definitely worth it. Why? Because you have to assume that your business is going to be a success and that your trademark will represent a lot of money and goodwill. That's what being an entrepreneur is all about.'

I know plenty of people who started small and who now own a global trademark. Just think of those DJs who had their names registered six or seven years ago: at that time, no-one thought that one day the names of well-known DJs would be worth so much money. These days, their interests are protected all over the world.'

The Benelux Office for Intellectual Property is the official agency for the registration of trademarks and designs in the Benelux region. The Office's register already contains almost one million trademarks.

Your business and your products and/or services have a name or a logo or a combination of the two. These are your trademarks. They point consumers and other customers in the direction of your products and services, symbolise and represent your company and are a financial asset.

In order to protect your trademark and prevent others from misusing it, you will need to register your trademark. For the Benelux region, this means getting in touch with the Benelux Office for Intellectual Property.

Why register a trademark?

A trademark is a company's calling card. This is true just as much for major companies such as Philips, InBev or Villeroy & Boch as it is for smaller businesses. People recognise your products and services by the (brand) name you give them. This sets you apart not only from completely different companies but also from companies that offer similar products or services.

If you don't register your trademark with the Benelux Office for Intellectual Property, then you will not be able to take action against those who use your trademark without your permission and benefit from all your marketing work. They will exploit the brand awareness that you have built up to make it easier to sell their products and services, possibly at lower prices, as you have paid all the start-up costs.

No rights without registration

A powerful trademark is a major asset in the marketplace. Everybody is familiar with McDonald's, Sony and Mercedes-Benz, but there are also trademarks that are extremely well-known in a particular region or city. It sometimes seems as if the brandname itself is enough to make people buy it. This is why it is important to prevent your trademark from being copied. It's also important to ensure that customers do not get confused by a trademark that looks very similar to yours.

You may also lose out if a producer sells different products and services but uses a trademark that is similar to yours. Example: suppose that you have a well-known trademark that you use to sell luxury chocolates, and someone then launches a brand of cat food onto the market whose trademark is similar to yours. This could tarnish your trademark by association. However, should this happen to you when you have registered your trademark, then under certain circumstances you may be able to lodge an objection in court.

A trademark is a saleable, transferable right. If you develop a powerful trademark, this will have a financial value that you can capitalise on.

Start-up entrepreneurs may feel that it is still too early to register their trademark, but if you do register it straight away you will be ensuring that you can take action against anybody who may have used your name or logo, possibly inadvertently. On the other hand, if you wait before registering, you may find you are too late to take action against the use of your trademark by third parties.

Many entrepreneurs think that in the Netherlands it is enough to register with the Chamber of Commerce, and in Belgium through a small business office at the Kruispuntbank. However, they're wrong, as registering there only grants the right of protection for the company name or trade name and does not protect your logo. Another point is that in many cases a trade name can only be granted regional protection.

Protection throughout the entire Benelux region is not automatic.

This is why you may need to register your trade name as a trademark. It may also be that the names of some of your products or services differ from your trade name, which would mean that they would not be protected by your trade name registration. The only way to get trademark protection is to register it with the Benelux Office for Intellectual Property.

The quality behind a registered trademark

'Pigs are my passion. When the swine fever epidemic broke out and my animals had to be destroyed, it almost broke my heart. In the end I decided to move to England to raise pigs but this time on a small scale. There, I discovered a rare breed of pig that produces pork with a really special taste. I was able to buy a pair of these animals in France. Crossing them with ordinary pigs produced the first piglets.

I took this meat to butchers and had it tasted by chefs at gourmet restaurants. They said they loved the taste: the meat tastes sweeter and its texture is more interesting than that of normal pork. It was then that I realised that I had my hands on a quality product, and one that needed a distinctive brand name. This meat, using this name, can now be found on the menu of top restaurants both here and abroad, whereas it used to be thought inconceivable that pork would be eaten in those sorts of places.

My trademark stands for a high-quality product that is produced under 'free range' conditions. People know this and are prepared to pay accordingly. A trademark like this has to be nurtured and protected, which is why I had it registered for the Benelux region with the Benelux Office for Intellectual Property.'



The stepping stone that helps you to expand

'I arrived in the Netherlands about fifteen years ago but I continue to have ties with my homeland, where they produce a special brandy that is still completely unknown here. I bought the exclusive distribution rights and am now launching this liqueur onto the market in these parts. I've given it its own brand name, logo and label, which of course I've registered with the Benelux Office for Intellectual Property.

For me, this company is the stepping stone that will help me to achieve my dream, which is to have a store selling furniture and fabrics from my homeland. These are wonderful products rich in mystical symbolism for which I know there is a market. I want you to be able to get this little piece of my homeland. It will also mean that I am giving something back to the country of my birth, a country to which I owe so much.'

What is a trademark?

When you register a trademark, you are registering the names that you use to market your products or services. In the case of a small company, the name of a product or service is often the same as the company's trade name. This is the name under which the company is registered in the Netherlands with the Chamber of Commerce or in Belgium with the Kruispuntbank. However, larger companies usually have a range of different products and services, each of which has its own name.

Your trademark can also be something other than the name of your product or service. You may use a logo to set your product or service apart from those of your competitor and give it a competitive edge. A famous example is Shell's red and yellow shell; another is the shape of your product or the packaging used, such as the Coca-Cola bottle.

There are other possibilities, too. Very generally, a trademark is a mark or symbol that you use to distinguish your products or services from those of your competitors. This also includes combinations of figures such as 4711 and abbreviations such as IBM. In theory, a sound can be a trademark too - just think of any well-known advertising jingle - or a specific colour such as the blue of Campingaz.

What is not a trademark?

A brand name has to set your products and services apart from those of a competitor. This can't be done if your brand name is very general. The word 'biomild' for yoghurt is an example of a designation that is not distinctive enough. This is because 'bio' simply indicates that the yoghurt has been produced biologically (i.e. organically / macrobiotically), and 'mild' merely says something about the taste. In other words, the two together ('bio' + 'mild') do not constitute - in the words of the European Court of Justice - the 'unusual variation as to syntax or meaning' that makes the whole sufficiently distinctive to serve as a trademark.

The BOIP has to refuse brand names that are not distinctive.

The BOIP also has to reject trademarks that are misleading. For instance, you cannot register an image that clearly shows coffee as a trademark for a tea product.

The BOIP also has to refuse trademarks that consist of national symbols such as flags. Incidentally, the most common reason for refusing a trademark on these grounds is the use of the flag of the European Union.

Is the trademark available?

Others want to prevent their trademarks from being misused, just as you do with yours. This is why they have already registered their trademark. In order to prevent them from challenging your trademark, you can check whether an identical or similar trademark has already been filed. You can do this for free by consulting the online trademarks register at www.boip.int. When registering a trademark, the Benelux Office for Intellectual Property will not check whether your trademark violates any previously registered trademarks.

If you don't have time to do this yourself then you can ask us to carry out an informative search of the trademarks register for you. After two weeks, you will receive a list of any trademarks that may conflict with yours.

If you want to carry out a full search into the availability of your trademark, this to include the issuing of an advice, then you can contact a trademarks agent or a lawyer who specialises in intellectual property. For more information on these experts in trademarks, see later in this brochure.

For how long, and where, is the registration of a trademark valid?

A registration at the Benelux Office for Intellectual Property is valid for the Netherlands, Belgium and Luxembourg. In other words, such a registration will not permit you to take action against use of your brandname or logo outside the Benelux region. Your registration is valid for ten years. Six months before this period expires, you will be notified accordingly and can extend the registration for another ten years.

Protection outside the Benelux region can be obtained too. In fact, you better do this if you are going to sell your products and services outside the Benelux region. A registration in other countries can be assigned the same date as that assigned to the basic registration in the Benelux region, provided that you apply not later than six months after the date of your Benelux region application.

You can decide whether to just protect your trademark within the European Union or to also protect it in over 75 countries that are signatories to an international agreement.

If you want to register your trademark in all European Union countries simultaneously, you should register your trademark with OHIM, the Office for Harmonization in the Internal Market, which is located in Alicante, Spain. Its website: oami.europa.eu.

We will be happy to provide you with details of OHIM procedures.

If you wish to register your trademark for a number of countries within the European Union, or for countries outside it, you can register your trademark with WIPO, the World Intellectual Property Organisation, in Geneva, Switzerland, which organisation is also known as 'OMPI'. Its website address: www.OMPI.int. A registration with WIPO is made via the Benelux Office for Intellectual Property.



'Together with a friend of mine I developed naturally produced cosmetics that are safe for people, animals and the environment. We started up as a small company, and our products are tremendously popular. Our company now has offices in a number of countries and the trademark has become a household name.'

How is a registered trademark protected?

You protect your trademark by taking action against improper use of your brand name or logo, for instance if someone is infringing them. One of the ways to discover a possible infringement at an early stage, is to constantly monitor new registrations in the trademarks register.

You can do this in three ways:

1. By searching the register yourself.
2. By taking out our subscription for subsequent trademarks, which you can apply for online. You will then receive mail notification if any identical or corresponding trademarks are filed after yours.
3. By mandating a trademarks agent or lawyer who specialises in intellectual property to monitor your interests.

If a conflicting trademark is found, you can initiate an opposition procedure at the Benelux Office for Intellectual Property. If your trademark is being abused, you can institute court proceedings to protect your registration. Your registration is a powerful weapon in this battle.

The opposition procedure is a simple and relatively cheap way of opposing the registration of a more recent trademark and of settling a trademark-related dispute without court intervention. You can lodge an objection not later than two months after the publication of the new application for registration in question. For more information, please go to our website www.boip.int.

Of course the registration of an identical trademark by another party is not the only form of infringement. Most conflicts relate to the use of a brand by another market party.

You can ask the court to ban the use of the trademark that is infringing on your trademark. The court action may include the seizure of goods, a compensation payment and even payment of profits (for a deliberate infringement). The deliberate faking or bringing into circulation of faked trademarks or branded articles is a criminal offence.

Who can register a trademark?

Anybody can register a trademark, either in a private capacity or as an organisation. Naturally, a combination of such parties is possible too, if a single trademark is registered in the name of different people.

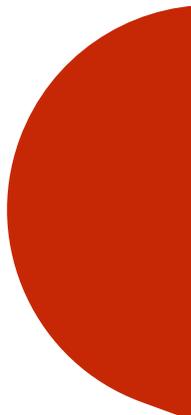
You can register your trademark yourself or leave the formalities to a trademarks agent or to a lawyer who specialises in intellectual property.

What is the procedure for registering a trademark?

You can register your trademark directly on our website. Of course, you can also visit the Benelux Office for Intellectual Property or the National Offices in Belgium and Luxembourg in person and submit your application that way. The procedure is quick and simple.

When we have received your application, we will assign it a date of receipt. Within just a few working days you will be able to view your trademark in our online trademarks register. After completion of all formalities, which on average takes four to six months, your trademark will be officially registered. This means it is now protected too. You can order a copy of your registration from us.

You can also opt for a priority registration. After all, there will be times when you need quick protection for your trademark. A priority registration means that we register the trademark as soon as all formalities have been complied with, in a procedure which may take just a few days. Remember, however, that a refusal on absolute grounds or an opposition can still lead to this type of registration being cancelled. For more information, see the above sections 'What is not a trademark?' and 'How is my registered trademark



protected?'. Note that a priority registration requires the payment of an additional fee.

Remember too that you can amend certain parts of your registration, for example if the name of your company or your address changes. You can also change the name of the owner if the trademark is transferred, for instance if it is sold. Naturally it is important that the information on the trademark in the register is always kept up-to-date.

The Benelux Office for Intellectual Property can provide you with all the information you need on the procedures to be followed, but do remember that the Benelux Office for Intellectual Property is only permitted and able to inform you, not to advise you. Naturally you can arrange all the work you need to do for the trademark yourself but again, remember that trademark law is a specialist field and that most companies do not have this specialist knowledge in-house. This is why it makes sense to seek advice from a trademarks agent or from a lawyer who specialises in intellectual property. They know all the ins and outs of trademark law and of the case law and literature based on it. They can advise you on whether a previously registered trademark could pose a problem for your new trademark. They will also advise you on legal aspects of trademark protection and will arbitrate in the event of disputes.

Trademark specialists have joined forces in the BMM, the Benelux Association of Trade Marks and Design Law. Addresses of their offices can be found on the websites www.bmm.nl and www.bmm.be and www.bmm.lu.



Trademark confusion abroad

'A good brand name and a distinctive logo are your calling card for your company's services. Your trademark is a clear statement of what you stand for. Registering your trademark strengthens your competitive position, as it means you can take action against improper use of your trademark.

If you want to use your trademark to launch your product in international markets, you should always take account of linguistic and cultural differences. There are plenty of examples of companies who didn't, and consequently made a complete mess of their product launches, such as the major car company that launched a car in Finland with a name that translates as 'idiot' in Finnish!

To sum up: if you want to capitalise on your brand name in different countries, you should consider getting advice from the experts...'

Contact

For general information, forms, price lists, and to request services, click to our website:

www.boip.int

You can also phone our Information Centre:

- from the Netherlands: 070 349 12 42
- from Belgium: 070 244 242 (local rates apply)
- from Luxembourg: 8002 5383 (local rates apply)

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