

BOIP



Benelux Office for
**Intellectual
Property**

www.boip.int



Annual overview case law 2024

Indescribably distinctive

3 December 2024
Camille Janssen & Eline Schiebroek



What are we discussing?



Numbers & Statistics



Useful information on procedural aspects



Highlights we are skipping (read up on it afterwards)



Case law



Questions



Know How webpage, announcements & final remarks





Which subjects and cases?

Position trademarks

- Dr Martens

Colour trademarks

- Magenta & Chocomel

Reputation

- Martini, Max & Mac

Acquired distinctiveness

- Cruisereizen.nl & Zeetours

Descriptive character

- The Bank, Neoflavon & Desktop

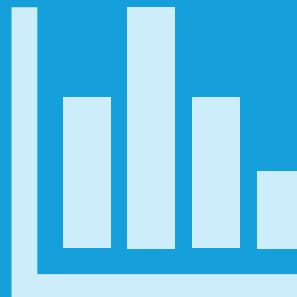


BOIP



Benelux Office for
**Intellectual
Property**

Numbers & Statistics





Question

1



How many inter partes decisions has BOIP taken since the BenCJ became competent for appeals? 6,5 years to date

- A. 500 – 750
- B. 750 – 1000
- C. > 1000





Numbers & Statistics



845 opposition decisions

88 Appeals

71 Decisions

205 cancellation decisions

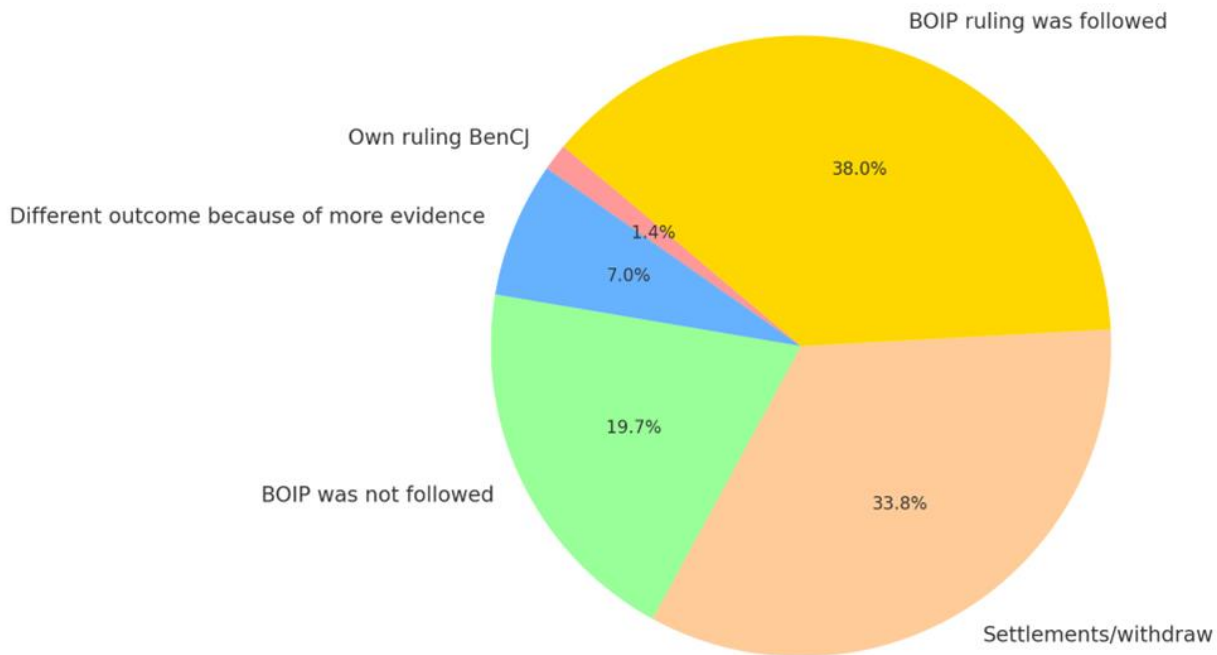
54 Appeals

31 Decisions



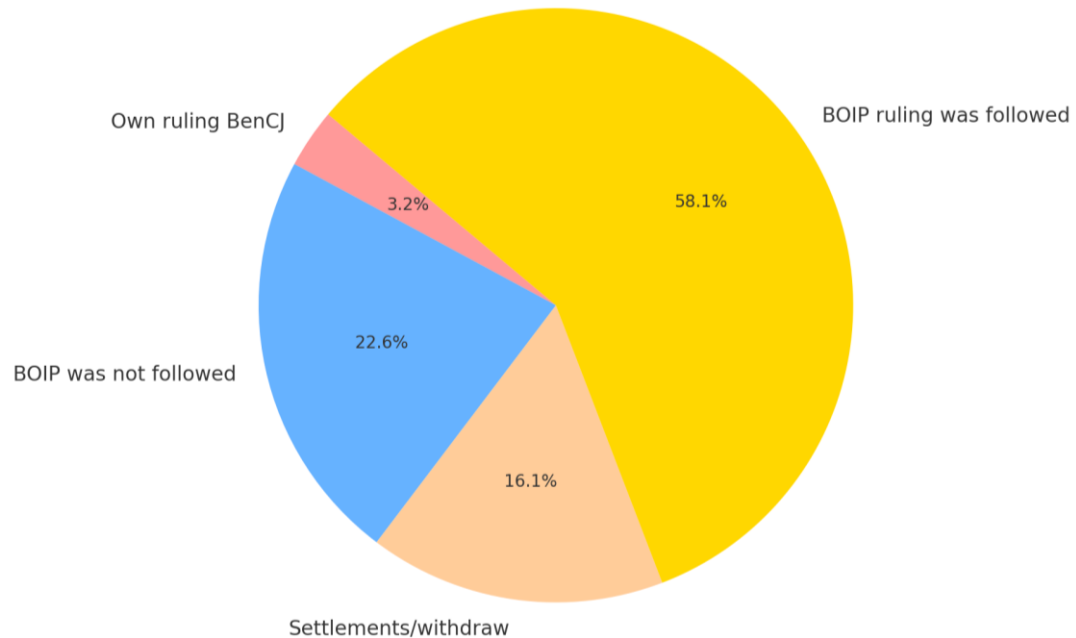


Appeal decisions opposition





Appeal decisions cancellation





Waiting time for BOIP decisions



Oppositions

Cases ready since **July 2024** are now picked up by rapporteurs

38 cases



Cancellations

Cases ready since **September 2024** are now picked up by rapporteurs

18 cases

Objections AG

Average response time **22 working days**

69 letters



BOIP



Benelux Office for
**Intellectual
Property**



Useful information on procedural facts



Counterclaim in appeal (Cross appeal)

An appeal against decisions of BOIP must be done within two months

This two-month period is a hard deadline for both parties

So a cross-appeal must also be done within 2 months

BenCJ 6 februari 2024, C 2022/19
(Ariane Consulting)



BOIP

Benelux Office for
Intellectual
Property

Topic:
**Cross appeal to the
Benelux Court of Justice**

**BenCJ 6 februari 2024,
C 2022/19 (Ariane Consulting)**

C 2022/19

Download this explainer (PDF)

Curious?
Find out
more!

17



Settlements

During BOIP procedure, even after a decision (but before appeal): Claimant may withdraw

During appeal: Parties should ask the BenCJ to drop the case and ask BOIP not to execute

After an appeal decision: Parties should ask BOIP not to execute. Which we will not do automatically anyway

Please let us know! Happy to take your call and keep an eye on the file



BOIP
Benelux Office for
Intellectual
Property

**SETTLEMENTS
IN OPPOSITIONS
AND CANCELLATIONS**

What should you do next?

The answer depends on the status of the BOIP procedure.
We discuss 3 situations:

115



Executing a decision

We wait until the end of the delay for appeal has lapsed unused:

2 months + 1 month contingency

After a decision in appeal:

3 months delay for cassation + 1 month

BOIP is not notified of appeal decisions!

Execution is done in monthly badges



What happens... with Inter Partes decisions?

Unlock the Mysteries of
Intellectual Property!

Find out (in 3 pages) *Swipe*

Whoosh! This is
where most
LinkedIn users
swipe left



BOIP



Benelux Office for
**Intellectual
Property**

Highlights we are skipping
(read up on it afterwards)





Cases concerning bad faith & misleading TMs



Nielson

BenCJ, 23 April 2024, C 2021/18 – Bad faith



Gimeau (no appeal)

BOIP, 25 April 2024, 3000564 – Bad faith



Van Wonderen

BenCJ, 6 February 2024, C2022/23 - Bad faith



Baidu (no appeal)

BOIP, 2 February 2024, 3000314 – Bad faith



Hollander & It must be a Hollander (no appeal)

BOIP, 11 January 2024, 3000489 & 300490 – No misleading use





Question

2

Should BOIP in bad faith cancellation cases, always grant a 2nd round to exchange arguments?

- A. Yes
- B. No
- C. No opinion/ Don't know





Cases concerning bad faith & misleading TMs



Nielson

BenCJ, 23 April 2024, C 2021/18 – Bad faith



Gimeau (no appeal)

BOIP, 25 April 2024, 3000564 – Bad faith



Van Wonderen

BenCJ, 6 February 2024, C2022/23 - Bad faith



Baidu (no appeal)

BOIP, 2 February 2024, 3000314 – Bad faith



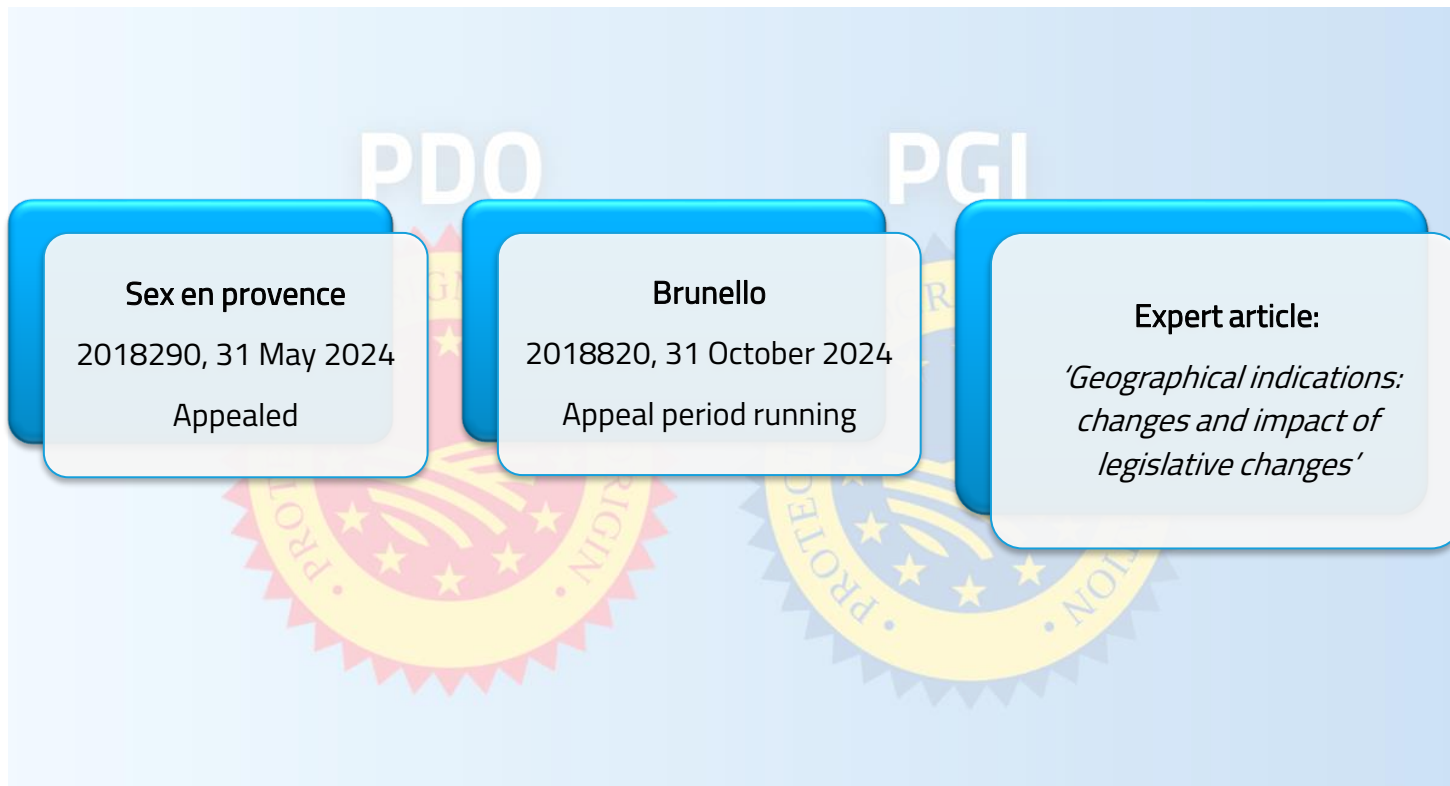
Hollander & It must be a Hollander (no appeal)

BOIP, 11 January 2024, 3000489 & 300490 – No misleading use





GI cases – 2 oppositions this year





Case law





What stood out this year?



More and more non-traditional trademark cases



In comparison with traditional trademarks, there are few applications



But lots of action



Applicants are big players in the market, but that makes sense



Currently pending: dishwasher tablets (1485040 & 1485042)



BOIP



Benelux Office for
**Intellectual
Property**

Position mark



Dr Martens: Position mark

- BX 1417807, registered: 28-05-2020
- CI 25: Lace boots
- Start cancellation by Van Haren: 06-10-2020
- Decision BOIP (3000257): Acquired distinctiveness sufficiently demonstrated



The trade mark consists of the combination of a black welt (Pantone 19-3909 TCX) that runs along the perimeter of a boot's outsole and a yellow stitch (Pantone 3965 XGC) applied to the welt in the manner as shown. The matter shown in dotted lines, being the outline of the boot's upper and outsole, are not part of the trade mark but serve to show the positioning of the trade mark.



Dr Martens – considerations in appeal

Evidence shows long and intensive use of the yellow stitching on a black welt on a lace boot.

However, Van Haren stated that the position mark is only recognisable/distinctive in combination with the dark-coloured boot, so not separately.

Position mark only identifies 2 colours, black and yellow. The Court asks about the colour of the rest of the boot.

According to Airwair, the normal colour of a boot is dark -> #Darferdas





Dr Martens – decision of the Court

The CJEU's criterion in the '#darferdas?' case requires considering all potential uses of the mark in question.

For position marks, this means that dotted parts represent all probable appearances of the designated goods.

Contrary to Airwair's belief, the likely colours for lace-up boot are not restricted to dark colours.



Only acquired distinctiveness for position mark on dark-coloured boots, meaning:

Total cancellation

As a result, the position mark protects the yellow stitching/black welt combination on boots

in any colour.

Appealed to the first chamber



From where turns this blue to
dark?

1

2

3

4

5

BOIP



Benelux Office for
**Intellectual
Property**

Colour marks



Deutsche Telekom Magenta/Pink

- Single colour trademarks from 1995, 2009 and 2021
- Single colours are:
 - In principle non-distinctive
 - Unless 'inburgering', distinctiveness acquired through use
- Inburgering
 - At the time of application, and
 - At the time of the cancellation claim
- Only used in the Netherlands, not active in Belgium and Luxembourg
- Distinctive character may grow and shrink over time
 - Article 2.2bis, par 3 BCIP
- Appeal before the BenCJ





Colour marks: Chocomel



BX 934863



IR 1650099



Chocolate milk

i.a. Coffee, chocolate beverages,
pastries, cookies.

Invoked grounds:

- Likelihood of confusion
- Reputation






Chocomel: decision



VS

Genuine use
sufficiently
demonstrated

No aural and
conceptual
similarity

Certain degree
of visual
similarity,
Cacaolat is
dominant

No risk of
confusion

Colour mark
has a
reputation for
chocolate milk

Link only for
part of the
goods
(chocolate
beverages)

Unfair
advantage and
detriment for
those goods



No appeal





Colour mark - reputation



BOIP





Benelux Office for
**Intellectual
Property**

Reputation



Reputation: Martini



<p>Several EU Marks</p> <p>MARTINI</p>  	<p>BX 1472161</p> <p>Martine</p>
<p>Beer Alcoholic beverage</p>	<p>Biscuits Beer</p>
<p>Invoked grounds:</p> <ul style="list-style-type: none"> ➤ Likelihood of confusion ➤ Reputation 	

No appeal





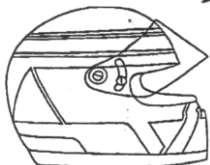
Reputation: Max Verstappen

TM invoked	Opposition	Cancellation
Max Max Verstappen		
CI 18, 24, 25, 35	CI 18, 24, 25, 35	CI 18, 24, 25
		No genuine use for Max
	Vis & Aur low degree Con different No reputation	Vis & Aur low degree Con different No reputation
	Rejected	Rejected

No appeal



J. V. Verstappen



JOS THE BOSS





Reputation: MAC

<p>Several Trademarks Marks</p> <p>McDonald's a.o.</p>	<p>BX 1473777</p> <p>MACBEANS</p>
<p>Restaurants</p>	<p>Candy, gummy, chewing gums, chewing candies, liquorice, lollipops.</p>
<p>Invoked grounds:</p> <ul style="list-style-type: none"> ➤ Likelihood of confusion ➤ Reputation 	

No appeal



BOIP



Benelux Office for
**Intellectual
Property**

Acquired distinctiveness



Acquired distinctiveness

Cruisereizen.nl

1463178 (class 39)

- 20 April 2022
- Registered: acquired distinctiveness
- High threshold, evidence needs to demonstrate the perception of the public
- No market survey, little evidence regarding Belgium
- Cancelled

Zeetours

154974 (class 39)

- 23 November 1987
- Registered without assessment
- High threshold, evidence needs to demonstrate the perception of the public
- No market survey, little evidence regarding Belgium
- Cancelled

No appeal



BOIP



Benelux Office for
**Intellectual
Property**

Descriptive character



Descriptive character: The Bank

- THE BANK indicates a financial institute and/ or its building
- Buildings which used to have a specific destination are being re-used for new and other purposes
- New company uses the indication of the old destination as brand
 - Done a lot in the HORECA branche, normal and commonplace practice



BenCJ did not agree



Question

4

Which of these words are descriptive for restaurant services?

- A. Terrace Yes / No
- B. Tram Yes / No
- C. Mill Yes / No
- D. Warehouse Yes / No





Descriptive character: The Bank

The relevant public will not perceive this as an indication of a characteristics of the services indicated

No association of THE BANK with qualities of the services indicated

HORECA service can be rendered in any building

The old function does not qualify the services rendered in the building

Services indicated are not intrinsically connected with banking

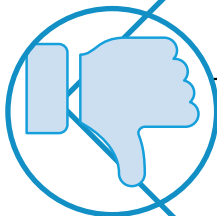
Not a quality which creates a positive feeling

In conclusion, the Sign "THE BANK" is not to be regarded as a sign or designation capable of serving in commerce as an indication of the quality or objective characteristics of the services for which the applicant seeks registration.





Descriptive character: cancellations



Neoflavon (1412768), i.a. medicines, class 5

The Office rejected the cancellation.

The evidence showed the use of the words 'flavones, flavonoids or neoflavonoids'

The Court cancels the trademark: the relevant public would understand the descriptive meaning of the word 'neoflavon'.

**BenCJ, C-2022/22,
15 October 2024**



Desktop Taxatie (1490710), i.a. valuation of real estate, class 36

The Office rejected the cancellation.

The evidence filed did not show that the word 'Desktop Taxatie' was a descriptive indication for a hybrid or remote valuation of real estate.

**BOIP cancellation
3000621 and 622
29 October 2024**

Appeal period running



BOIP



Benelux Office for
**Intellectual
Property**

www.boip.int



Questions?

Discussion, questions, answers...





Know How webpage & Announcements & Final remarks



BOIP



Benelux Office for
Intellectual
Property



IP professionals

ation & Maintenance ▾

Regulations & policy ▾

[Know how](#) ▾

About B



[Home](#) > [IP professionals](#) >

Know how

What do you want to know?

[Go to BOIP guidelines](#) →

[Go to our webinars](#) →

[Go to our explainers](#) →

[Go to our expert articles](#) →



23 January 2025

Location:

not in The Hague



BOIP



Benelux Office for
Intellectual
Property



How do you get the PE Point

Apply through the BMM website

- !!no e-mails to the secretariat!!

Submit:

Confirmation e-mail

Codeword = Colourblind

The screenshot shows a web browser window displaying the BMM website. The page title is 'Aanmelden voor nieuwe opleidingspunten'. The form contains the following fields:

- Opleiding: BOIP Wetleur
- Aantal punten: 1
- Dinschrijving: CODE WORD
- Van opleiding behaald: (empty)
- Opleidingsniveau 1: Choose File (no file chosen)
- Opleidingsniveau 2: Choose File (no file chosen)
- Opleidingsniveau 3: Choose File (no file chosen)

BOIP



Benelux Office for
**Intellectual
Property**

Thank you for watching our webinar!

Please fill in the **survey** and help us improve our services.