

BOIP

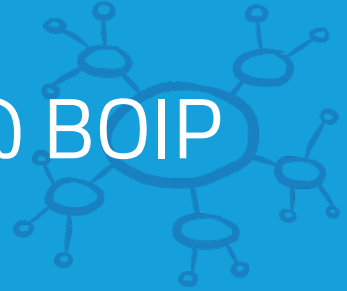


Benelux Office for
**Intellectual
Property**

www.boip.int



Use part III – Reputation @ BOIP



Pieter Veeze

Acquired distinctiveness
26 March 2024



Yvonne Noorlander

Genuine use
13 June 2024



Tineke Van Hoey

Reputation
24 September 2024



Reputation @ BOIP

- Opposition since 1 June 2018 /cancellation since 1 March 2019
- Almost always invoked in combination with risk of confusion
- Issues: reputation – link/risk of injury





Applicable law: Article 2.2ter (3)(a) BCIP - Conditions

- The signs must be either **identical or similar**
- The trademark invoked must have a **reputation**
- The public establishes a **link** between the contested sign and the mark.
- Risk of injury: use of the contested sign would take **unfair advantage** of, or be **detrimental** to, the **distinctive character** or **repute** of the trademark invoked
- There is **no due cause** for the use of the contested sign



+ See BOIP's Opposition Guidelines





Reputation issues

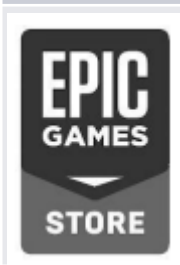

- High threshold
- Relevant point in time
- Together with your arguments (rule 1,14,1c IR)
- Relevant territory
 - Attention to EU TMs
- In relation to goods/services concerned (registration vs what are you really reputed for)





EPIC EVENTS (oppo 2018034, 31 August 2023)






TM invoked	Contested sign
<p data-bbox="274 401 987 481">EPIC GAMES</p>	
	
<p data-bbox="274 748 987 1031">CI 35 online retail services relating to computer software, games software, video games, computer games, games programs.</p>	<p data-bbox="987 748 1829 1031">CI 35: Advertising, marketing, and organizing promotional events and trade shows. CI 43: Event hosting, venue rentals, and booking accommodations and catering for events.</p>





SMART4U (oppo 2018308, 23 September 2024)





TM invoked	Contested sign
<p>SMART</p>  	
G/S related to cars/vehicles	G/S related to electricity/energy





Cacoalat (oppo 2018061, 28 June 2024)



TM invoked	Contested sign
	
CI 30 Chocolate milk	CI 30 <ul style="list-style-type: none"> - coffee, cocoa spreads, chocolate-based foods, sweets, pastries, chocolates, biscuits, cookies, and ice creams - chocolate based beverages or ingredients to make chocolate based beverages





Link/Risk of injury issues

- Reputation alone is not enough
- Risk of injury which is not hypothetical
- Don't just state it, prove it



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