Benelux: several options for challenging company names

Does a company name provide a ground for challenging a trade mark application?

In the Benelux a company name does not provide a ground for opposing a trade mark application. The opposition procedure in the Benelux is restricted to three grounds. The holder of an earlier trade mark can lodge an opposition against: (a) an identical trade mark application filed for the same goods or services; or (b) an identical or similar trade mark filed for the same or similar goods or services, where there exists a likelihood of confusion on the part of the public; or (c) in the case of a well-known trade mark within the meaning of Article 6b of the Paris Convention: if the younger trade mark can cause confusion with this trade mark. Contrary to the OHIM opposition rules, companies cannot invoke their company names in the opposition procedure before the Benelux Office of Intellectual Property.

Can company names be challenged and if so how?

There exist several actions for the holder of an earlier trade mark who wishes to oppose the use of a younger identical or similar company name. First of all, on the basis of article 2.20(1)(d) of the Benelux Treaty on Intellectual Property (BTIP), the owner of a trade mark can invoke its trade mark rights against a third party that uses an identical or similar sign *not* in relation to goods or services. The article requires that the company name is being used without due cause and the use takes unfair advantage of and is detrimental to the distinctive character or the repute of the trade mark. The provision is an implementation of article 5(5) of the European Trade mark Directive.

Additionally, article 5a Company Name Act stipulates that a company name may not cause confusion with an earlier trade mark. As this provision has a more limited scope and provides a more limited protection than article 2.20 (1)(d) BTIP, the latter is normally used in these situations. For example, article 5a Company Name Act is not the appropriate provision to invoke in the case of a device mark.

Does it make a difference if the company name includes a trade mark?

No, the trade mark owner has the same rights to call upon. But since the decision of the ECJ in the *Céline* case (C-17/06, 11th September 2007), if the company name is used in relation to goods within the meaning of article 5(1) of the European trade mark directive, the ground for opposing such use should be the corresponding article 2.20(1)(a) or (b) BTIP.

According to the judgment, there is use "in relation to goods" when the sign constituting his company name is affixed to the goods which he markets or where a link is established between the sign which constitutes the company name and these goods. Unless the use made by the third party is in accordance with "honest practice", and if one of the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods or services, is affected, the trade mark owner may prevent such use.

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