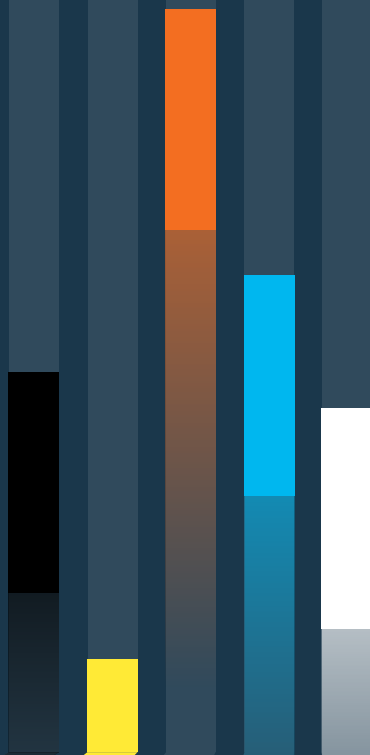
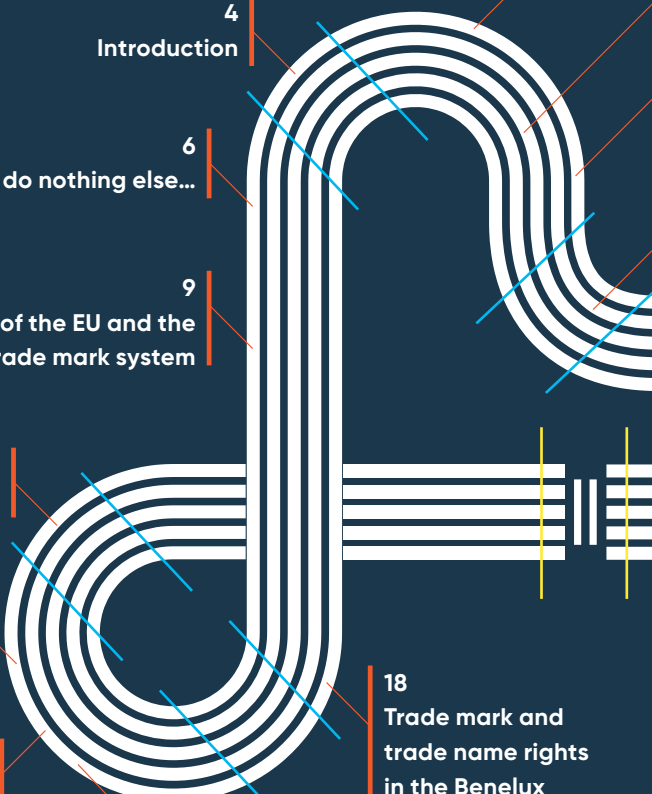


On your marks,
get set...
Benelux!



Contents



Introduction	4
If you do nothing else...	6
Overview of the EU and the Benelux trade mark system	9
The EUTM system	10
National trade mark systems	11
Examples of points for applicants with particular interest	12
The Madrid International System	13
Trade mark and trade name rights in the Benelux	18

22

What can constitute a Benelux trade mark?

27

Distinctiveness

34

Availability, search and clearance

42

Registering your trade mark

44

Registering an International trade mark

48

Registering an EU trade mark

52

Registering a
Benelux trade mark

56

Differences between
an EUTM and a
Benelux mark

58

Third party
objections

70

Team

71

About us

67

Monetising your
trade mark

65

Well-known
Benelux marks

61

Using your trade mark

63

Enforce your trade mark

| Introduction

This guide will help you navigate the trade mark systems of the Benelux (Belgium, the Netherlands, and Luxembourg) to ensure you can protect and enhance the value of your brand and business.

The Benelux is an important market in Europe, and often used as a gateway to the EU through the ports of Rotterdam and Antwerp, and the major airports in Brussels and Amsterdam.

Your brand is one of your most valuable assets, and by highlighting the risks and opportunities that expansion into the Benelux can have for your brand, this guide will help you to avoid any bet-the-company disputes and to secure your competitive advantage in the Benelux and the EU.

Despite the availability of a pan-EU trade mark registration (and its harmonised laws), taking your brand into the EU is not like entering a single market. The plethora of legal systems, processes, languages and cultures presents a unique challenge. Successfully navigating these differences will require a different approach to brand protection than you would take elsewhere in the world, and local expertise can be key to avoiding expensive mistakes and missed opportunities.

Throughout the chapters, we'll explain:

- How the Benelux and EU systems work.
- How they differ from each other, and other systems, and the benefits and threats this can pose.
- The risks you can face, and how to mitigate them, when protecting or rolling out your brand in the Benelux.
- The best ways to deal with threats to your brand and your reputation.
- What to do in the face of opposition proceedings and injunctions.

If you do nothing else...

As mentioned in Part 1, protecting your brand in the Benelux can be a complicated business. If you do nothing else, here's 10 key points to take on board right away:

- 1.** Register now. Don't wait until your plans are more concrete. You don't need to use your mark or have proof of your intention to do so before protecting it. This will help provide you with a defence, should a dispute arise in the future.
- 2.** Check for prior rights, and not just on the Benelux trade mark register. If budgets allow, conduct proper clearance searches. This allows you to better align your protection to your needs and risks.

3. If there appears to be a prior right blocking you, get local advice. With time and a careful strategy, solutions that allow your mark to proceed can be found.
4. Get local advice on language issues in the Benelux when choosing a mark or when there appears to be a prior right blocking you.
5. Make an informed choice about protection. Don't assume registering a Benelux trade mark or an EU trade mark is right for you. There can be good reasons to seek other, or parallel, protection (eg. using registered designs, or relying on unregistered rights).
6. Take account of industry-specific issues, eg. the requirement for a single pan-EU brand for pharmaceuticals, regulations to stop co-branding with tobacco products, geographical indicators for regional wines, and the labelling of non-EU packaged goods differently from those destined for the EU.
7. Take a European view of the scope of goods and services for which you protect your brand. Don't automatically align it with the protection you have elsewhere, eg. in the US.
8. Record your rights with customs either in the Benelux countries or using the centralised EU system (if you have EU marks as well). Put the infrastructure in place, either in-house or with outside counsel, to support local interceptions of infringing goods where you trade.
9. Enforce your rights strategically by carefully choosing your forum (in court or a registry).
10. Keep good evidence relating to the use and reputation of your brand on a country-by-country basis.



Overview of the EU and the Benelux trade mark system

Two trade mark systems operate in parallel in the Benelux: the uniform EU trade mark (EUTM) system and the (national) Benelux trade mark laws. Overlaid on these is the Madrid international system.

1 A national/
Benelux
registered
trade mark.

2 An EUTM.

3 An International
Registration
designating the
relevant country.

4 An International
Registration
designating the
EUTM system.

In addition, there are options for registering designs on a national or pan-EU basis and various unregistered rights can arise. Each system has advantages and disadvantages.

The EUTM system

This is a uniform trade mark that gives you protection across the EU

Advantages

- Coverage in 27 member states.
- Protection automatically extends to any country joining the EU.
- Pan-EU injunctions/compensation obtained from one court.
- No need to use your mark in all member states (use in one might possibly event suffice).
- Cheaper than national registration if protection sought in more than two countries.
- Can rely on pan-EU customs watch service.

Disadvantages

- Unregistrable if descriptive in any EU language.
- Unclear what protection remains in a country that leaves the EU (eg. the UK).
- At risk from earlier national rights.
- Liable to cancellation from a non-specialist IP court.
- Hard to prove acquired distinctiveness across the EU.
- Registry decisions liable to 3 levels of appeal up to European Court of Justice.

National trade mark systems

Applications are filed at each national IP office.

Advantages

- Avoids blocks posed by prior rights in other member states.
- Overcomes issues of descriptiveness in one EU language.
- Appropriate where use is limited to one or two EU countries.
- Easier to prove acquired distinctiveness.

Disadvantages

- Injunction/compensation for one country only.
- More expensive than EUTM if seeking protection in more than two countries.
- Need to engage local counsel with prosecution in local language.
- Requires use in that country after five years.

Examples of points for applicants with particular interest

Application from the US

Beware of using your US rights as the home application or registration for international filings into the EU. The USPTO's strict approach to specification drafting means your EU rights may be unnecessarily narrower than those actually available to you.

Applicants with a commercial base in the EU

The 'central' attack mechanism (see page 13) makes it risky to use a recently filed EUTM as the base application for an international filing programme. The EUTM could face multiple oppositions including based on unregistered right in the EU that you are unaware of. It may be preferable to use a national mark for the base.

Brands that are currently, or will in future be, only used in the UK or only in the rest of the EU

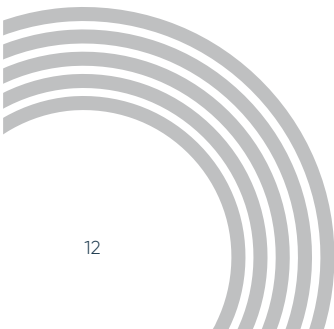
Retain or seek protection bearing in mind the points discussed in the Brexit chapter below.

Brands that only work in the local language (eg. advertising slogans)

An EUTM in one language does not automatically give protection for translations in other EU languages. For such marks, national registrations are preferable.

IP owning entities based in low tax jurisdictions

A number of the countries often used for tax efficient corporate structures are not party to the Madrid system. Companies based in these countries may not be able to own International Registrations. However, they could own directly filed EUTMs and national EU marks.



The Madrid International System

An administrative wrapper that allows for centralised handling of trade mark applications and registrations using either or both of the above systems.

Advantages

- One application form in one language.
- Material cost saving on filing fees.
- Can designate any or all EU member states and/or the EUTM system.
- Can add extra countries in future.
- Renewals and assignments/changes of records done centrally.

Disadvantages

- Need a home application to start with.
- Owner must be national of/ domiciled in or have business in a signatory country.
- A successful attack against the home application can invalidate those based on it covering other countries, known as 'central attack'.
- Goods/services of application can only cover what home application covers.
- Protection in all designated countries cut back if home application cut back.

IP owning entities based in low tax jurisdictions

A number of the countries often used for tax efficient corporate structures are not party to the Madrid system. Companies based in these countries

may not be able to own International Registrations. However, they could own directly filed EUTMs and national EU marks.

| Which to choose?

Some industries (eg. the pharmaceutical industry) require you to use just one brand throughout the EU for the same product. In that case, it's vital to have a clear understanding of the systems you are dealing with and how they can affect uniform trade mark protection.

In most sectors, the system which works best for your brand depends on your circumstances. There are sometimes reasons for using both the EUTM and national systems, and perhaps also an international filing. The examples above identify some of the factors to consider in making your choice.

Relying on a mix of rights can help avoid the disadvantages of using a single system. This can be particularly important when disputes arise in the markets where your main commercial interests lie.

Benelux

The national system of the Benelux is a regionalised system. Belgium, the Netherlands and Luxembourg operate as one territory, with harmonised trade mark law (known as the Benelux Convention on IP, "BCIP") and one IP office issuing a single registration covering all three countries. Think of it as a mini-EUTM for these three countries.

Multiple legal systems

Europe is not one country with one legal system. Some aspects of EU trade mark law are consistent across all 27 member states, but differences remain.

Most of these differences relate to the procedures for enforcing your trade mark rights in the courts, the remedies available if you win, the processes for objecting to new applications (whether pre- or post-registration) and the forum for dealing with cancellation or non-use revocation actions.

There are also key differences in the scope of protection and in the defences available. This is especially so for an interim period, as newly introduced changes are sometimes being implemented at different times in different countries.

Conflicts between the systems

There have been cases where national courts or registries and their EU equivalents reach different conclusions, despite the facts and issues being identical. Certain rules try to avoid this.

These contradictions can create tactical opportunities, but can equally create surprises.

First to file systems

All EU systems, including the Benelux, operate on a first-to-file system. This means priority is not given by default to the first person to use a brand. There are two issues with this:

1. Your ability to use and protect your brand is vulnerable to a competitor who files for a registration before you. Even if you have been using a mark for several years, you risk losing your exclusivity in the EU by delaying to file. You could find yourself unable to use your brand, or at least being prevented from expanding your business into new jurisdictions, or new products and services
2. You, or a competitor, can take advantage of the five-year post-registration 'grace period' to block out brands of potential interest across the EU. Genuine commercial use needs to have started somewhere in the EU by the end of the fifth year after registration.

Timing

Whatever you decide to do, registering your trade mark well before launching in the Benelux market is vital if you are to protect your brand properly and avoid potential costs further down the line. Even if you do not need it to stop use by others, it could provide you with a useful defensive 'shield' against someone threatening to sue you in the future.

Which to choose?



Trade mark and trade name rights in the Benelux

As a company it's possible to register a trade mark containing the name of your company. In addition, the name of a company can also be protected under local trade name laws, which provide a national regime of protection.

Trade name protection is based on the idea that a company is obliged to inform the public truthfully about who is, or who are, the person(s) responsible and behind the company. In the Netherlands, trade names are protected under the Dutch Trade Name Act.

In contrast to trade marks, the Dutch Trade Name Act provides protection without the obligation to register this trade name. Under the Dutch Trade Name Act, a company is not allowed to use a trade name that is identical, or highly similar to, a trade name that is already used by another company if such use results in a likelihood of confusion by the public. Whether there is confusion depends on the type of company, the place this company is located, and all other relevant circumstances of the specific case.

Furthermore, it's necessary that the trade mark has a distinctive character to successfully register a trade mark. Distinctiveness is, however, no requirement for trade name protection in the Netherlands as such. A trade name that is descriptive, which means that it describes the services offered or goods sold, can be valid. However, in determining the scope of protection, the distinctiveness of a trade name does play an important role. Very common descriptive names can in principle be used by another company as (part of) their trade name unless there are additional circumstances which make the use of that descriptive trade name unlawful.

It's common for a conflict to occur between a trade name and a trade mark. The trade mark holder can only act against the user of a similar trade name if the trade mark is registered and if the trade mark is older than the trade name. This means that an older trade name will not be affected by a younger trade mark. Similarly, a younger trade name cannot act against an older trade mark. The holder of a trade name that is older than a trade mark can prohibit the use of this trade mark under Dutch law, provided that the infringement requirements are met.

The registration of a trade name at the Dutch Chamber of Commerce does not give any protection whatsoever. The right to a trade name under the Dutch Trade Name Act arises when a company uses that name to conduct a business. Registration of a trade name at the Dutch Chamber of Commerce is not sufficient to gain this right.

However, the registration of a name as a trade mark is sufficient to gain trade mark protection at least for the first five years after registration, after which it has to be genuinely used to avoid revocation.

In Belgium, trade names are protected in a similar way, but there is no specific law that provides this protection. The right to a trade name constitutes, according to legal doctrine, a separate industrial property right. The holder of a trade name has an exclusive right to oppose any use of an identical or highly similar sign by a third party that can cause damage to the holder of the trade name.

The right to a trade name is not an intellectual right, ie. like copyrights, but a right of occupancy. The right of protection arises from the first public use of the trade name, without any obligation of registration nor any other administrative formality. In other words: a registration in the Belgian Crossroads Bank for Enterprises is not required in order to enjoy protection of a trade name. The mere use of the trade name is sufficient, as long as the use is visual, public and continuous.

In contrast to trade marks, the originality or descriptiveness of a trade name does not have any influence on the degree of protection. A trade name can't, however, be used to monopolise common descriptive names.

Other than in the Netherlands, distinctiveness is a requirement for trade names. Where a trade mark is used to identify the origin (ie. a person or company) of the goods and services, the trade name is used to identify the company itself. The distinctiveness is, next to the purpose of publicity, the essential function of a trade name.

This distinction is important when there is a conflict between a trade name and a trade mark. The legal grounds of trade mark infringement can only be invoked when the trade name is used to identify the source of the goods and services. If the trade name is used to identify the company itself, the trade mark owner will have to demonstrate that unfair advantage has been taken, or detriment to the distinctive character and/or reputation of the trade mark has been caused.

Trade names are protected in Luxembourg in a similar way. The right to protection of a trade name arises from the first use. There is no obligation for registration.

What can constitute a Benelux trade mark?

Before registering a trade mark, you must make sure that the sign you intend to register may constitute a trade mark.

Even though a wide range of signs can be registered as such, not any sign can be, and some signs are likely to raise more questions than others. You can save on time and costs, and significantly improve your chances of success, by being aware of what difficulties each type of trade mark faces and being ready with the appropriate arguments or evidence.

Different types of trade marks

You can basically register any sign, provided that:

- it can be represented in a clear and precise manner, and
- it allows you to distinguish the goods and services of your undertaking from those of another.

This includes names, drawings, imprints, stamps, letters, numerals, shapes of goods or packaging.

However, excluded from trade mark protection are shapes or other characteristics of a product (such as a colour or a smell) that:

- result from the nature of the goods, or
- give substantial value to the goods, or
- are necessary to obtain a technical result.

In addition, abstract ideas or concepts can't be registered as Benelux trade marks (eg. all conceivable shapes of a transparent bin of a vacuum cleaner).

The condition of precise and concrete representation, which replaces the former requirement of graphical representation, is not limited to visual representation, but includes any technical means of representation which offers sufficient guarantees as to its capacity to allow a sign to be identified by the public (eg. computer files).

Traditional trade marks

Traditional trade marks are generally divided into three categories:

Word marks	any word, combination of words, fictional word, name, combination of letters or numbers, onomatopoeia, slogans, etc.
Figurative marks	portraits, logos, pictures, as well as words written in a particular font.
Complex and compound marks	combination of elements, most commonly words and images.

Non-traditional and special trade marks

Besides the traditional marks, you can also register non-traditional or special marks such as:

Colour marks	A specific colour, or a specific combination of colours, as a trade mark. Excluded from trade mark protection are the natural, standard, or functional colours of the products to which the registration relates (eg. the colours on electric wiring, red for a fire extinguisher, or bright yellow and orange for dangerous parts). The description and representation of colours is likely to raise issues. It's important to make sure that the colour is represented in a way that allows it to be identified with certainty. To this end, colour marks are usually identified by reference to a colour code, such as the Pantone codes.
Shapes and 3D marks	Shapes of a product or packaging, including shapes that contain word or figurative elements such as logos or labels, which allows the public to identify its commercial and industrial origin.
Smell and taste mark	Trade marks consisting of a smell or a taste. Such trade marks may in principle be registered. The representation of such sign however raises major issues. For example, the representation of an olfactory sign by a description in written words, a chemical formula, or the deposit of an odour sample has been considered insufficiently clear and precise. The replacement of the graphical representation requirement by the requirement of clear and precise representation might lead to more attempts to register smells and tastes in the future. However, it seems probable only a few will succeed. Further case law will be needed to help clarify the scope of their protection.

Position marks	Trade marks consisting of the specific way in which the mark is placed or affixed on the product. Such trade marks can be registered provided that the sign is likely to be perceived as having a distinctive character (meaning as an indication of commercial origin), and as different from the normal appearance of the product to which it relates. However, even if the relevant public is attentive to the different aesthetic details of a product, this does not automatically imply that they will perceive it as a trade mark (as opposed to only an ornamental element).
Sound, multimedia and hologram marks	Trade marks consisting exclusively of sounds or a combination of sounds; trade marks consisting of, or extending to, a movement or a change in the position of the elements of the mark; and trade marks consisting of elements with holographic characteristics. The removal of the requirement for graphical representation has facilitated the registration of such signs. Computer files, as well as musical recordings, representing the trade mark in a clear and precise manner, can now be submitted to accompany descriptions. As a result, we expect more such marks to be registered in the future.



Excluded signs

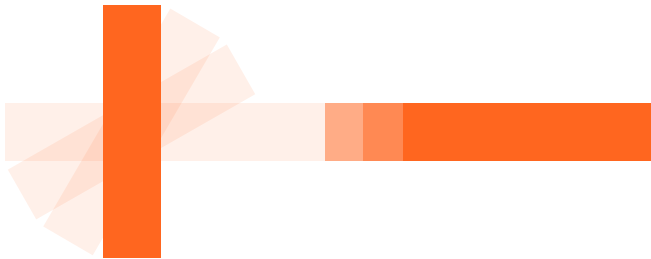
Prohibited signs	Certain signs may never be registered as a trade mark, namely those signs that: ■ are contrary to public order or the accepted principles of morality, or ■ contain an emblem, flag, or any another official sign of a State. It is sufficient that the sign is deemed unlawful in one of the Benelux countries for it to be excluded from trade mark protection.
Deceptive signs	Signs which are likely to deceive the public (eg. with regard to the nature, quality, or geographical origin of the goods or services), are also excluded from protection. An example of this is the registration of a geographical name for a product from a different origin. This exclusion applies to signs that are deceptive by essence, independently from the use that is made of the trade marks.
Geographical indications, protected traditional term for wine or specialties	Signs that are the same as protected geographical indications, a protected traditional term for wine or a traditional speciality guaranteed, are excluded from protection.
Plant varieties	Signs that consist in or are very similar to an older protected denomination for a plant variety, are excluded from protection.

Distinctiveness

To be registrable, a Benelux trade mark must be distinctive. This means that a trade mark has acquired such distinctiveness that it is capable of distinguishing the goods or services of one undertaking from those of another undertaking.

A Benelux trade mark which simply describes the goods or services it refers to, or its characteristics, will lack such individuality and be devoid of distinctive character.

It follows logically that a trade mark may not consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or time of production of the goods or performance of the service, or other characteristics of the goods or services, or have become customary in the current language.



The distinctive character of traditional trade marks

Word marks	■ A single (common or fantasy) word must have nothing to do with the product or service for which it is registered. Existing words can be used but must have nothing to do with the characteristics of the product. In addition, if a word is so frequently used that it has lost any capacity to distinguish goods and services (such as 'eco', 'green', or "multi"), it will be devoid of distinctive character. ■ Names of individuals can be registered as a trade mark. Names are considered distinctive, irrespective of the frequency of the name, and even in the case of the most common surnames, except where the name can also be perceived as a non-distinctive term.
Slogans	■ A slogan must be perceived by the public as more than a promotional formula. This will be the case if the slogan: ▪ constitutes a play on words; and/or ▪ introduces elements of conceptual intrigue or surprise, so that it may be perceived as imaginative, surprising or unexpected; and/or ▪ has some particular originality or resonance; and/or ▪ triggers in the minds of the relevant public a cognitive process or requires an interpretative effort. ■ The following character may contribute to finding distinctiveness: ▪ unusual syntactic structures, and ▪ the use of linguistic and stylistic devices, such as alliteration, metaphors, rhyme, paradox, etc. ■ If the slogan immediately conveys information about the kind, quality, intended purpose, or other characteristics of the goods or service it will be devoid of distinctive character.

Figurative marks

- Images, whether realistic or not, will be distinctive as long as they are not descriptive of the goods or services.
- A descriptive image could be distinctive if it is non-realistic or stylised, meaning that it departs from the simple presentation of the product, or its characteristics. However, this would not prevent a third party from registering the same image in another (not alike) style.

Strengthening the distinctive character of traditional marks: compound/complex trade marks

- A way to limit the risk of refusal for lack of distinctive character is to combine words and images. A common word coupled with an image can be considered as distinctive.
- In the case of complex trade marks, the distinctive character will be assessed based on the overall impression taking into account which elements are most distinctive and dominant. When assessing the overall impression, word elements will, in general, have more weight than images because the consumer will be more likely to refer to the product by name.



The distinctive character of non-traditional and special marks

Whereas consumers are used to identifying traditional trade marks as an indication of the commercial origin of goods and services, the same does not apply to non-traditional and special marks.

The requirement of a significant gap	In some cases, the sign will have to significantly depart from the norm or customs of the sector. This is true for: ■ Two and three dimensional shapes. ■ Sounds. ■ Position marks.
The requirement of acquired distinctiveness	For other signs, evidence of acquired distinctiveness will have to be brought. This is true for: ■ Colours. ■ Geographical names.

Impact of the language

The way the relevant public will perceive a sign will be influenced by the languages spoken. This is an essential factor to be taken into consideration when assessing the distinctive character of a trade mark.

As a Benelux trade mark grants protection throughout the Benelux, a registration must be refused if it lacks distinctive character or is descriptive in only one country. Consequently, the assessment of the distinctive character must take into account the cultural and linguistic diversity within the Benelux.

A word can be considered more or less distinctive depending on the language spoken by the relevant public. In this regard, the word to be registered must be distinctive in all official languages of the Benelux, ie. Dutch, French, German and Luxembourgish. Languages that are the main language, or the one commonly used in relation to the goods or services concerned, must also be taken into account. As a result, the English language will often have to be taken into consideration.

Dynamic nature of distinctiveness

The level of distinctiveness of a trade mark is not fixed. A sign can acquire and lose distinctive character over time. Many factors can influence the distinctive character of a trade mark, including the increase or decrease of the reputation of a trade mark, or the change in the meaning of the trade mark.



Acquired distinctiveness

Acquired distinctiveness in the Benelux can be relevant before and after registration:

Before registration	After registration
■ Some types of trade marks will require acquired distinctiveness to be registered. ■ Distinctiveness acquired between the filing and the decision on the registration of the trade mark will not necessarily be taken into account by the Benelux Office. ■ Excluded signs cannot be registered even if evidence of acquired distinctiveness is brought.	■ A trade mark may acquire distinctive character after registration. For example, a weak trade mark can become much stronger if it's intensively used and advertised. ■ A trade mark that would have been registered despite the lack of distinctive character at the time of its registration may no longer be cancelled if it has acquired distinctiveness before the filing of the cancellation claim.

Loss of distinctive character

The registration of a Benelux trade mark does not guarantee that its distinctive character will be maintained. It is therefore important that even after a trade mark is registered, care is given to how the trade mark is used, since the extent of the protection of a trade mark will be determined not at the time of the registration of the trade mark, but at the time when the use of the similar trade mark or sign allegedly infringing the trade mark began.

A trade mark will lose its distinctive character if the signs composing it (a word in most cases) become generic. For example, if the word has become the only way to designate the product. As a result, the holder could lose the protection of his trade mark, provided that such loss is attributable to his acts or lack thereof, namely if he has not taken the necessary measures to prevent it from happening.

Availability, search and clearance

Besides being distinctive, a sign must be available. This means that it must not conflict with a prior trade mark or another distinctive sign used in the relevant sector. It is therefore highly recommended to conduct a search and clearance investigation before filing a Benelux trade mark.



The relevant prior rights

When assessing the availability of a sign, several prior rights must be taken into consideration.

Earlier registered trade marks and trade mark applications enjoying trade mark protection on the relevant territory (ie. for a Benelux trade mark: Benelux and EU trade marks)

As trade marks grant exclusive rights on the signs registered, it follows naturally that the holder of an earlier trade mark may oppose the registration of an identical or similar sign.

A sign to be registered as a Benelux trade mark will be subject to:

- not yet expired earlier applications in the Benelux,
- not yet expired applications for Benelux through an international registration,
- older EU trade mark applications,
- younger EU trade marks applications which can rely on the seniority of an earlier national application.

Other signs:

- Trade names.
- Other prior rights, such as moral rights and rights on a work protected by copyright or on a design. Those rights are not grounds for refusal or cancellation in the Benelux. However, even though the holder of such rights will not be able to oppose the application of the trade mark, it may be able to prevent its use.

The principle of speciality

As the scope of protection of a trade mark is limited to the goods and services to which it relates, the availability of a sign must in most cases be assessed by reference to those goods and services.

As a result, only the following trade marks will be relevant:

- identical signs registered or used for identical goods or services, and
- identical or similar signs registered or used for identical or similar goods and services, provided there is a risk that the public will be misled as to the commercial origin of the products (either because the similarity will lead the public to believe that the products come from the same undertaking or from related undertakings).

The principle of speciality does not apply in the presence of registered trade marks with a reputation. The holder of a trade mark with reputation may oppose the registration of a similar sign, whether the goods and services to which it relates are similar or not, if the use of the sign would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the trade mark.

Search and clearance

Even if you have used your trade mark outside the Benelux, before using or applying to register it in the Benelux, it is advisable to carry out a thorough search.

Earlier trade marks can block you, and the consequences, both financially and for your brand's health, can be serious if you enter a market and later discover that someone else has pre-existing rights.

What trade marks can block you?

- Prior Benelux trade marks.
- Prior EUTMs.
- Prior international marks designating the Benelux or EUTMs.

When is a prior mark relevant?

An earlier registered mark can block your registration or give rise to an infringement claim against you. It does not have to be identical to the one you want to use. Nor does it need to be registered or used for identical goods or services.

A prior mark is relevant if it is:

- identical or similar to your mark and has been registered or used for similar goods or services such that there is a risk of confusion, and/or
- a mark with an established reputation for different goods or services, if people are likely to link your mark with it, and your use would take unfair advantage or be detrimental.

Marks can be considered similar even if words are not similar, but have the same or similar conceptual meaning in another Benelux language (eg. VADER and PÈRE, which means 'father'). It depends on how likely it is that the relevant public (as determined by the type of prior right) would know both meanings and make the association.

Stages of clearance

Two stages of search are advisable:

Stage 1

An identical-only (knockout) or 'screening' search:

a quick, basic (and low cost) check for identical earlier trade mark registrations or applications and trade names. Combine this with a basic online search (ie. on Google) for identical names. This identifies clear-cut blocks, but is unlikely to be sufficient without the second stage search. Such searches can help produce a shortlist from a longer list of proposed names or logos.

Stage 2

A full availability search:

a full search for all relevant earlier trade mark registrations or applications and trade names, including those that are similar.

Managing or resolving risks in the Benelux

As with searches outside the Benelux, finding earlier marks does not necessarily mean that you need to abandon your original plan and choose a different trade mark. Searches usually disclose potential risks – it is a case of assessing their severity in light of the special circumstances that can apply in the Benelux.

Some approaches will be applicable anywhere in the world, eg. adding distinguishing features to your mark, limiting your range of goods/services, and exploring co-existence or consent options. But there are some approaches that are peculiar to the Benelux, including the following:

- Benelux trade marks which are more than five years old can be vulnerable to at least partial revocation. This is partly due to the wide specifications that are permitted in the Benelux. It's also because, until January 2019, it cost the same to file in three classes as it did in one, so applicants filed in three even when only planning use in one class. A full availability search should include some investigation (usually online) into how the earlier mark is being used and may reveal potential vulnerabilities.

- Threatening to file or filing a revocation action against the prior right owner's Benelux registrations. The costs for this are quite low and it immediately puts the owner on the back foot.
- You can acquire an earlier right to trump the blocking right. This approach can work but is fraught with risks, especially if the earlier right is itself unused.

The decision depends on factors such as the level of risk you are prepared to take, the budget available, and the time remaining before launch.

The limitations of searches

Searches generally reveal the most significant potential risks, but even full availability searches do not always give you the entire picture. Within the Benelux the position is as follows:

- The time between filing an application and being able to find it online is approximately a few days, so the risk of missing a recently-filed conflicting application is low.
- Some applications can be backdated (by means of a Convention priority claim) to a date before your search date.
- The specification of an earlier Benelux trade mark may tell you little about the commercial interests of its owner. This is the consequence of the old system, where you were able to register Benelux trade marks in three classes for the same price as a one-class application. More can be learned from the specification of any USA registration that the owner may have for the same mark, due to the stricter use requirements there.

Registering your trade mark

Registering a trade mark is relatively straightforward (no power of attorney is required), but before you get started it's worth knowing what it involves and the potential pitfalls. Filing early is a key strategy; if others are infringing your rights, you want your registration granted as soon as possible.

To register, you need to file a Benelux trade mark application. However, there may be strategic reasons to apply elsewhere. For example, for a descriptive Dutch word that could not be registered as a Benelux trade mark, you might want to secure an EU registration since the EU is mainly a non-Dutch speaking jurisdiction. This could also be useful for blocking applications for similar EU trade marks filed by third parties.

Territory	Application	Authority	Location
The Netherlands, Belgium and Luxembourg	Benelux trade mark application	Benelux Office for Intellectual Property (BOIP)	The Hague, The Netherlands
EU territory	EU trade mark application	European Union Intellectual Property Office (EUIPO)	Alicante, Spain
Internationally	International trade mark application	World Intellectual Property Organization (WIPO)	Geneva, Switzerland
National countries (other than those covered by a Benelux mark)	National trade mark application	National trade mark authority	National country

Registering an International trade mark

The following points are worth bearing in mind when filing an international trade mark application:

- There are two options to seek international trade mark protection: either you can file a trade mark application with the trade mark office of each country in which you are seeking protection, or you can use the so-called Madrid System via the World Intellectual Property Organization (WIPO).
- For the filing (and maintaining) of a trade mark application in a specific (non-EU) country you will probably have to call in the services of a local agent. This trade mark registration will provide protection in one specific country.
- Via WIPO's Madrid System, a single procedure (one application, one language and one (CHF) currency) can provide trade mark protection in several territories (currently approximately 92 countries).

- To be entitled to use the Madrid System, you must have either applied for or obtained an identical Benelux trade mark with the Benelux Office for Intellectual Property (BOIP), or an EU trade mark with the European Union Intellectual Property Office (EUIPO). This so-called basic mark is required before you can file an international application through either BOIP or EUIPO (depending on the nature of the basic registration).
 - If you file the (inter)national trade mark application within six months from the basic application date, you can claim this application date for the (inter)national trade mark application. This is called a 'priority claim'.
 - For a period of five years from the date of its registration, the international registration remains dependent on the basic mark. If the basic mark should become invalid within this five-year period, the international registration will be no longer protected.
 - Via the Madrid System, you can file the application yourself. However, if the application meets an Office Action or an objection, you will probably have to appoint a representative within that country.
- 

The post-registration process via WIPO

- A WIPO registration is a provisional registration. After its registration, the national trade mark offices of the designated countries will have a time limit to start their registrability examination.
- Subsequently, the examiner either raises no objections and the application is published for opposition purposes or raises objections by correspondence. If the examiner raises objections, the applicant can argue the provisional refusal in writing by submitting supporting arguments. However, in that case, the appointment of a local representative might be required.
- Final registration follows once all local registry objections and third party oppositions are concluded. Depending on the number of designated countries, it's not unusual for a final registration to take one to two years. Protection will be obtained with retroactive effect from WIPO application date!

Maintaining your trade marks

Maintaining your international trade marks is easy. WIPO trade mark registrations fall due for renewal every ten years. Renewal is generally done within the three-month period before protection ends. It can be done within a six-month grace period afterwards – for a small extra fee.

How do you renew?

International trade marks are renewed online at WIPO by you or your representative. An appropriate fee will be paid to WIPO.

Registering an EU trade mark

The following points are worth bearing in mind when filing an EU trade mark application:

- There are two options to seek trade mark protection within the European Union: either you can file a trade mark application with the trade mark office of an EU country in which you are seeking protection, or you can file an application via the European Office of Intellectual Property (EUIPO).
- For the filing (and maintaining) of a trade mark application in a specific EU country you will probably have to call in the services of a local agent. This trade mark registration will provide protection in one specific country.
- Via EUIPO, one application can provide trade mark protection in 27 countries.
- In European countries that are not part of the EU, you do not get protection by an EU trade mark registration via EUIPO.
- Who can file? If you use the fast track system, you can file the application yourself. You do not have to use an attorney or lawyer. However, if you are not seated in the European Union and the application meets an objection, then you must appoint someone from within the European Union to represent you. Having an EU-based contact or representative on the record also helps local customs and law enforcement officers. There is no need for powers of attorney or notarisation or legalisation of any documentation. If you wish to provide a non-standard description for the goods and services applied for, you will need an EUIPO account.

- How do you file? Applications can be submitted electronically only. If you have an EUIPO account, you will have a personal and secure online environment (User Area) in which you can manage your trade mark applications and registrations.
- What are the specifications? You need to list the goods and services in detail. A fee per class will be payable for an EU trade mark application. Avoid using the international class headings alone as their interpretation can be considered too vague. EU specifications can be much broader than elsewhere (the USA in particular).

Which languages?

You can file an EU trade mark application in any of the 23 languages available.

The EU post-application process

- A filing receipt, with the application number, is issued. This happens immediately online.
- After receipt of the application, the examiner at the EUIPO either raises no objections, and the application is published for opposition purposes, or raises objections by correspondence. If the EUIPO raises objections, the applicant can argue the provisional refusal in writing by submitting supporting arguments.
- The EUIPO does not examine on relative grounds ie. they will provide a list that may contain similar trade marks. However, the application will not be blocked due to these prior rights.
- An EU trade mark application may be subject to opposition filed by a third party within three months of it being published.
- Registration follows once all registry objections and third party oppositions are concluded. An EU trade mark application facing no objections could be registered within five months.

Facing third party oppositions

- A third party may oppose your application based on prior trade mark rights in the European Union (EUIPO), a national trade mark right (within the European Union) or an international trade mark (WIPO) designating the Benelux, EU, or a national EU country.
- The EUIPO opposition process is similar to elsewhere. Exchanges of legal arguments take place, supporting evidence is provided in writing, decisions are put in writing, published, and are subject to appeal.

Maintaining your trade marks

As with international trade marks, maintaining your trade marks in the European Union is easy. EU trade mark registrations fall due for renewal every ten years. Renewal is generally done within the six-month period before protection ends. It can be done within a six-month grace period afterwards – for a small extra fee.

How do you renew?

EU trade marks are renewed online at the EUIPO by you or your representative. A renewal fee will have to be paid to the EUIPO.

Use it or lose it?

- Unlike in some other jurisdictions, eg. the USA, there is no requirement to prove use of a registration in the European Union in order to renew it.
- If an EU trade mark has not been put to use in the European Union within a period of five years since its registration (in connection with the goods or services in respect of which it was registered) a third party may start cancellation proceedings based on non-use.

Registering a Benelux trade mark

The following points are worth bearing in mind when filing a Benelux trade mark application:

- Who can file? You can file the application yourself. You do not have to use an attorney or lawyer based in Belgium, The Netherlands or Luxembourg. However, if you are not seated in the Benelux and the application meets an objection, then you must appoint someone from within the Benelux to represent you. Having a Benelux-based contact or representative on the record also helps local customs and law enforcement officers. There is no need for powers of attorney or notarisation or legalisation of any documentation.
- How do you file? Since applications are submitted electronically only, you will need a MY BOIP account. MY BOIP is a personal and secure online environment in which you can manage your trade mark applications and registrations. You can easily apply for a MY BOIP account on the BOIP's website.
- What are the specifications? You need to list the goods and services in detail. As from January 2019, a fee per class is payable for a Benelux trade mark application (no longer one fee for up to three classes). Avoid using the international class headings alone as their interpretation can be considered too vague. Benelux specifications can be much broader than elsewhere (the USA in particular).
- Which languages? You can file a Benelux trade mark application in Dutch, English or French.
- Is it urgent? You can also opt for the accelerated registration paying an additional registration fee. If the application meets all formal requirements it will be registered in the trademark register immediately. Examination and possible opposition will take place afterwards.

The post-application process in the Benelux

- A filing receipt, with the application number, is issued. This happens immediately online and is confirmed via email.
- After receipt of the application, the examiner at the BOIP either raises no objections, and the application is published for opposition purposes, or raises objections by correspondence. If the BOIP raises objections, the applicant can argue the provisional refusal in writing by submitting supporting arguments.
- The BOIP does not examine on relative grounds, ie. they will not check for and cite prior conflicting rights as a reason to block the application.
- A Benelux application may be subject to opposition filed by a third party within two months of it being published.
- Registration follows once all registry objections and third party oppositions are concluded. A Benelux application facing no objections could be registered within three months.



Facing third party oppositions

- A third party may oppose your application, based on prior Benelux or EU trade mark rights (but not on the basis of national trade mark rights regarding other EU Member States).
- The opposition process in the Benelux is similar to elsewhere. Exchanges of legal arguments take place, supporting evidence is provided in writing, decisions are put in writing, published, and are subject to appeal.

Maintaining your trade marks

As with international and EU trade marks, maintaining your trade marks in the Benelux is easy. Benelux trade mark registrations fall due for renewal every ten years. Renewal is generally done within the six-month period before protection ends. It can be done within a six-month grace period afterwards – for a small extra fee.

How do you renew?

Benelux trade marks are renewed online at the BOIP by you or your representative. A renewal fee will be paid to the BOIP.

Use it or lose it?

Unlike in some other jurisdictions, eg. the USA, there is no requirement to prove use of a registration in the Benelux in order to renew it.

If a Benelux trade mark has not been put to use in the Benelux within a period of five years since its registration (in connection with the goods or services in respect of which it was registered) a third party may start cancellation proceedings based on non-use.

Differences between an EUTM and a Benelux mark

Belgium, the Netherlands and Luxembourg operate as one territory, with harmonised trade mark laws, with one trade mark office (BOIP) issuing a single registration covering all three countries. Considering the three countries for which you get a trade mark right at once, it is like a mini-EUTM. However, there are notable differences as well:

- Languages: In the three countries of the Benelux multiple languages are spoken (eg. Dutch, French, and German).
- A Benelux trade mark will also be valid in the Benelux territories overseas (eg. the former Dutch Antilles). An EUTM is only valid for member states of the European Union, without the territories overseas.
- Distinctive character of a trade mark: the language diversity means if a trade mark has no distinctive character because it is descriptive in one of the official languages of the Benelux, the sign will not get registered unless the sign has acquired distinctiveness through use in the Benelux. EUTM's need to acquire distinctiveness in all member states separately.

- Non-use: a registered Benelux trade mark should be used within five years after the date of registration. Whether Benelux trade marks are used genuinely depends on circumstances of the case. Just like EUTMs, use of Benelux trade marks in one of the member states, or even local use, could be sufficient to prove genuine use.
- Reputation of a trade mark: a Benelux trade mark has a reputation in the Benelux if the trade mark has a reputation in a substantial part of the Benelux. A reputation in just one of the member states could be sufficient, depending on the circumstances of the case.
- Conversion: unlike the conversion possibilities with EUTMs, there is no such possibility in the Benelux. It's not possible to file a national trade mark application for The Netherlands, Belgium or Luxembourg, so if a Benelux trade mark is refused, for example based on lack of distinctive character, it will not be possible to file a trade mark application for the remaining countries.

Third party objections

If third parties object to a Benelux trade mark application, they initiate opposition proceedings. You can only file opposition at BOIP against a Benelux trade mark or an international trade mark with protection in the Benelux. Oppositions filed against an EU trade mark need to be filed at EUIPO.

Opposition proceedings are a relatively inexpensive procedure to resolve a trade mark dispute without the need to go to court. Opposition can be filed within two months from the date of the publication of the trade mark application. If you want to take action against a conflicting trade mark after it is registered, it's possible to initiate cancellation proceedings at BOIP or challenge it in court.

Grounds of opposition in the Benelux

Opposition can be filed in the following situations:

- An application has been filed for an identical trade mark for the same products or services.
- An application has been filed for an identical or similar trade mark for the same or similar products or services, which may cause confusion on the part of the relevant public.
- An application has been submitted for identical or similar trade marks for other products or services, taking unfair advantage of or infringing the distinctiveness or the reputation of the existing trade mark (which is a new ground for opposition since 2019).
- An application may cause confusion with a well-known mark, as referred to in Article 6bis of the Paris Convention.



Using your trade mark

Proving use

After registering your trade mark, there is no default requirement in EU or Benelux law to file declarations and/or specimens of goods with the trade mark offices in order to maintain your trade mark.

You may be required to prove your use of a registration which is more than five years old in the following circumstances:

- A third party applies to revoke it for non-use.
- You want to rely on it to support an opposition against a later-filed mark.
- You want to rely on it to support a cancellation action against a later-filed mark.
- You want to rely on it in an infringement action against a third party.

If you fail to prove genuine use without proper reasons for non-use, your registration will be vulnerable to someone applying to revoke it. You may also not be able to rely on it to oppose or cancel third party conflicting marks, or to sue third parties for infringing use. It's therefore necessary to prove use of the trade mark in the Benelux territory for the products and services for which it was registered. If you fail to prove use for only part of what your registration covers, then these consequences apply only to that part. You can still rely on and defend the rest of your registration.

The costs of defending your right

Especially for large trade mark portfolios, it can be costly if a third party starts to attack unused trade marks with revocation requests, eg. in the context of another dispute with the trade mark owner. Usually the costs of successful revocation requests are borne by the trade mark owner.

Documenting use of your trade mark

The burden of proof lies with you, the trade mark owner, if a third party can state with good reason that it is of the opinion that the trade mark is not genuinely used.

Proving genuine use is done by providing evidence of real commercial exploitation of the trade mark (eg. use of the trade mark on product packaging). Use of the trade mark solely for the purpose of preserving the rights conferred by the trade mark is not sufficient. Therefore, evidence of public and outward use must be provided.

It is advisable to carefully document the use of the trade mark at the time it is being used. Proving use retrospectively can be difficult. Make sure you collect the documents that are acceptable to the trade mark offices and courts as proof of use. For example, invoices that only contain a reference to a specific product, but do not name the trade mark, may not be sufficient, or can make your case difficult to prove.

It's essential to capture the evidence separately from use elsewhere in the world. For national registrations in the EU, you need to substantiate use of the trade mark in the relevant territory, which is needed on a country-by-country basis. In the Benelux, it is not, however, required to prove genuine use of the trade mark anywhere in the Benelux (so no proof of use over all three Benelux countries is necessary). In general, it can be sufficient to prove use of the trade mark in one of the three countries, or a part of one of the three territories.

For example, the American fast-food chain, Wendy's, made claims for revocation of the Benelux "Wendy's" trade mark against a local Dutch snack restaurant bearing the same name, due to a lack of genuine use. However, according to the Dutch courts, the local snack restaurant was able to prove genuine use in the Benelux by using the trade mark for only one local restaurant in a small town in the Netherlands, because exploiting only one restaurant in that sector was in most cases the standard. So, limited local use of the name can be enough to prove genuine use of the Benelux trade mark, and the American company's claims for revocation were denied.

Enforce your trade mark

Prohibit third parties to use an identical or similar trade mark

The holder of a prior trade mark can oppose the registration of a younger trade mark. The holder of a trade mark can also prohibit third parties from the use of an identical or similar trade mark. This is possible in the following situations.

Identical sign / identical goods

The holder of a trade mark may prohibit third parties from using in the course of trade a sign that is identical to the trade mark for goods or services that are identical to those for which the trade mark is registered. A sign is also identical if it has barely perceptible accents, punctuation marks, or other insignificant differences.

Likelihood of confusion

The holder of a trade mark may prohibit third parties from using in the course of trade a sign that is identical or similar to the trade mark and the goods or services covered by the trade mark, and there exists on the part of the public a likelihood of confusion.



This is the most frequently used legal ground for establishing trade mark infringement. The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case.

The global appreciation relates in particular to:

- the visual, aural or conceptual similarity;
- the perception of the average consumer; and
- the degree of distinctiveness of the trade mark.

Reputation in the Benelux territory

The holder of a trade mark may prohibit third parties from using in the course of trade a sign which is identical or similar to the trade mark for goods or services which are not similar to those for which the trade mark is registered, where the trade mark enjoys a reputation in the Benelux territory. Additionally, the use of the sign should be without due cause and take unfair advantage of or be detrimental to the distinctive character or the repute of the trade mark.

Use not for distinguishing the goods or services

Contrary to holders of EUTMs, the holder of a Benelux trade mark may also prohibit third parties from using a sign for purposes other than those of distinguishing the goods or services, where use of the sign without due cause would take unfair advantage of or be detrimental to the distinctive character or the repute of the trade mark

Well-known Benelux marks

Scope of protection.

Registered marks with a reputation enjoy a broader protection than registered marks without one.

- For trade marks without a reputation, the trade mark owner can invoke its trade mark against signs that are either identical or similar, and that are used for goods and services that are also identical or similar to the registered mark.
- In cases of trade marks with a reputation, the trade mark owner can also invoke his trade mark against a party using a sign in the course of trade which is identical or similar to the registered well-known trade mark for goods and services which are not similar to those for which the trade mark is registered. The second requirement is that the use of the sign by the third party must take unfair advantage of or be detrimental to the distinctive character or the reputation of the trade mark.

Due to recent legislative developments in the Benelux, it's now possible, both in opposition and in cancellation proceedings, to rely on a trade mark that is well-known in the Benelux against a later mark which takes unfair advantage of, or is detrimental to, the reputation or distinctive character of the invoked trade mark.

Therefore, possible actions for owners of a well-known mark include:

- Opposition proceedings.
- Invalidity proceedings.
- Infringement proceedings.

The party invoking the reputation of a trade mark must provide proof thereof. It's therefore important to keep good evidence relating to the reputation of your brand to enlarge your enforcing possibilities.

Degree of knowledge among the public required.

Well-known marks usually demand a high degree of recognition and renown among the public due to longstanding use, promotional activities and media (for example, coverage). The rule is that the mark has no reputation, unless the mark has a certain degree of knowledge among the public. The required degree of knowledge is met when the trade mark is known by a significant part of the public concerned with the products or services covered by the registered trade mark. Different factors will be taken into account by determining whether a significant part of the public knows the trade mark, such as the market share, the intensity and duration of the use of the trade mark, the geographical extent of the mark and the size of the investments made by promoting the trade mark.

The registration of trade marks liable to create confusion with another trade mark already well known in the Benelux territory is not permitted.



Monetising your trade mark

Once you have registered your Benelux trade mark or your EUTM, you can use it yourself, sell or transfer it to another party, or license it to one or more third parties. However you decide to use or profit from it, there are legal issues which are particularly pertinent to Benelux trade marks and EUTMs.

Benelux Trade Marks

- The proprietary aspects of transferring or licensing a Benelux trade mark are partly included in the BCIP and partly in national laws. According to Dutch law, a right to a trade mark is considered a property right.
- The transfer of a Benelux trade mark needs to be in writing and needs to relate to all countries of the Benelux. It is possible to transfer or grant a license to a Benelux trade mark that relates to all goods and services or to only transfer or license a selection of goods and services.
- The license can be part of a broader contract between the licensor and licensee, for example through a franchise agreement.

EUTMs

- If you wish to sell rights to one country only, you can convert your EUTM into national rights. It is treated like a new application in each country where you want protection, but you keep the original priority date of the EUTM. You pay a new application fee and then you can sell the rights off by country.
- While EUTMs cover the whole EU, you can grant licences for part of the EU, for example the Benelux, without having to convert it.

EU competition/ anti-trust law

- A licence or sale agreement needs careful checking for compliance with EU competition law.
- You can split the countries between licensees, but any attempt to artificially partition the EU market with a licensing regime can fall foul of EU competition law.
- You cannot stop your licensees responding to unsolicited sales enquiries and fulfilling orders placed from an EU country that is outside of their licensed territory. You can stop them actively promoting in that country.
- Care needs to be taken with restrictions on volume of goods traded, setting onward sale prices, non-challenge clauses, exclusivity, choice of suppliers and restrictions on conducting online sales without a 'bricks & mortar' establishment.

Recordal of licences and rights of licensees

European jurisdictions differ on whether licences must, can, or should be recorded. It's important to carefully check the legislation for each market you plan to enter.

- In some countries, it is not possible to record a licence in the trade mark register.
- In others, it is advisable to record the licence when you are the licensee (eg. in the Benelux, failure to do so can result in disadvantages with enforcement activities).
- For EUTMs, it is not mandatory, but can be done on request of one of the parties.

Licensees that are likely to want to enforce rights under the trade marks against third parties should probably record their license. Note that exclusive licensees can have rights of enforcement by default. The position can vary across the EU, including as to whether the licence agreement can remove this entitlement.

Licensing and tax law

Conformity with tax law is important.

- This is especially true when the parties to the agreement are in different jurisdictions which are subject to different tax systems.
- The question can arise as to which party has to pay which kind of tax on the basis of any licence fees.
- Different countries have different tax breaks relating to IP licensing and anti-avoidance regimes, as well as different positions on withholding tax due to differing participation in double-taxation treaties.

Team



Maarten Rijks

Partner

+31 88 02 43 117

m.rijks@taylorwessing.com



Marie Keup

Counsel

+32 2 316 1010

m.keup@taylorwessing.com



Saskia Bullens

Trademark and Design Attorney

+31 88 02 43 109

s.bullens@taylorwessing.com



Diana Nieuwhof

Trademark and Design Attorney

+31 088 0243 114

d.nieuwhof@taylorwessing.com



Margot van Gerwen

Senior associate

+31 88 02 43 112

m.vangerwen@taylorwessing.com



Lucas de Groot

Associate

+31 88 0243 020

l.degroot@taylorwessing.com



Annemijn Schipper

Associate

+31 88 02 43 120

a.schipper@taylorwessing.com

About us

Taylor Wessing is a global law firm that serves the world's most innovative people and businesses.

Deeply embedded within our sectors, we work closely together with our clients to crack complex problems, enabling ideas and aspirations to thrive.

Together we challenge expectation and create extraordinary results.

By shaping the conversation in our sectors, we enable our clients to unlock growth, protect innovation and accelerate ambition.



Technology, Media & Communications



Private Wealth



Real Estate, Infrastructure & Energy



Life Sciences & Healthcare

- Aerospace & Defence
- Business & Professional Services
- Consumer & Retail
- Hotels, Hospitality & Leisure
- Manufacturing & Industrials
- Automotive & Mobility
- Chemicals
- Financial Institutions & Insurance
- Logistics & Transport
- Public Services & Education

2000+ people
1100+ lawyers
300+ partners
29 offices
17 jurisdictions



Austria	Klagenfurt Vienna
Belgium	Brussels
China	Beijing Hong Kong Shanghai
Czech Republic	Brno Prague
France	Paris
Germany	Berlin Düsseldorf Frankfurt Hamburg Munich
Hungary	Budapest
Netherlands	Amsterdam Eindhoven
Poland	Warsaw
Republic of Ireland	Dublin
Slovakia	Bratislava
South Korea	Seoul*
UAE	Dubai
Ukraine	Kyiv
United Kingdom	Cambridge Liverpool London London TechFocus
USA	New York Silicon Valley

* In association with DR & AJU LLC

© Taylor Wessing LLP 2021 | 2010-000168-7

Taylor Wessing statistics published are correct as of 1 September 2021.

This publication is not intended to constitute legal advice. Taylor Wessing entities operate under one brand but are legally distinct, either being or affiliated to a member of Taylor Wessing Verein. Taylor Wessing Verein does not itself provide legal or other services. Further information can be found on our regulatory page at:

taylorwessing.com

TaylorWessing