

ONEL ruling plunges Europe into confusion

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The ruling of the Benelux Office of Intellectual Property (BOIP) in *Onel* has created uncertainty over what constitutes genuine use of a mark in the European Union.

Leno Merken, a Dutch firm of trademark attorneys that owns a Community trademark (CTM) registration for ONEL, had opposed Hagelkruis Beheer's application to register OMEL in the Benelux. The BOIP subsequently ruled that use of a CTM in a single EU member state is insufficient to constitute genuine use of the mark in the European Union. This means that the BOIP will demand proof that a mark owner has genuinely used the CTM in more than one country, a notion that is contrary to the supposedly unified nature of Benelux and EU law.

"In my opinion, the BOIP ruling is wrong," argued Paul Steinhauser of [Arnold + Siedsma](#). "The opinion is contrary to the very reason behind both the Benelux trademark law and the CTM law, namely avoiding the free trade of goods within the Benelux and the European Union. But as long as it is not overruled in appeal, we must fear that the BOIP will follow it."

Alternatively, if use in one country does suffice, the CTM register could become swamped with marks that are used in one member state only. This poses the question of whether the legislator should intervene. "One could imagine, for example, the introduction of an obligatory annual affidavit, proving use of a CTM per country," suggests [Paul Maeyaert](#), head of the IP and unfair competition team at ALTIUS. "On the other hand, such legal intervention would constitute the end of the unitary character of the CTM."

Experts are predicting that this now infamous case could go to the ECJ, where the BOIP's ruling will probably be overruled. "An indication in that direction is the ECJ's decision in *Pago*, which shows that a consequence of use such as notoriety within just one member state has effect outside of that country," notes Steinhauser (see "[Austria is a substantial part of the European Union, says ECJ](#)").

However, as news of the ruling has settled, some experts argue that, in contrast to *Pago*, the ONEL ruling actually makes more sense. "From a common sense perspective," notes [Fry Heath Spence](#) partner Ben Mooneapillay on the IPKat blog, "if a CTM proprietor has used his mark in only one member state in five years, then protection in one member state is all that is required."

Indeed, while the ECJ ruling favours the trademark owner, the BOIP looks at the matter from a different perspective. "By saying that reputation in Austria [as in *Pago*] is sufficient to claim reputation all over the community, the ECJ wants to take away any hurdles for the trademark owner to the rest of the community," explained [Paul Reeskamp](#), an IP litigator at Allen & Overy. "The BOIP takes the opposite approach: it does not take the perspective of the trademark owner but that of third parties that might be hindered by granting community-wide protection for a trademark only locally used." Local users will always have the fallback of their national registration for the jurisdiction in which they operate. "Personally my sympathy is with the Benelux approach," added Reeskamp.

