

GC and CJEU Procedure in IP Matters

EUIPO Webinar, 3 May 2016

Verena v. Bomhard, BomhardIP, Alicante, Spain

General observations

- Action to GC allows judicial review of EUIPO decisions
- Statistical chances of prevailing less than 20%
- Chances better in RG cases than AG cases
- Chances lower where both EUIPO instances ruled the same way
- Bear in mind greater visibility and weight of GC judgment
- Appeals to CJEU – very rarely successful

Action to the General Court

Legal bases

- Article 65 EUTMR
- Rules of Procedure of the General Court (RoP)
http://curia.europa.eu/jcms/upload/docs/application/pdf/2008-09/txt7_2008-09-25_14-08-6_431.pdf
- Statute of the Court of Justice
- Practice Rules
http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=OJ:JOL_2015_152_R_0001

Overview GC proceedings

- Board of Appeal decision notified
 - 2 months + 10 days for bringing action before GC
 - Determination of language
 - Action notified to EUIPO and other party
 - 2 months + 10 days time limit for responses
 - If cross-claim: response of the other party or parties
 - If requested: oral hearing
 - Order or judgment
-
- Overall duration about 12 – 18 months

Who can bring an action?

Art. 65 EUTMR

- Any party **adversely affected** by the decision of the BoA
- NB: EUIPO cannot initiate GC proceedings: it is not a party to proceedings before the BoA

The Office

- always the defendant
- however, not obliged to defend the BoA decision but can also request the annulment of the decision
- In practice, this happens in case of fragrant discrepancies from
 - the Guidelines
 - the case law of the Boards
 - the case law of the European Courts

The other party to the proceedings before the BoA

- Automatically becomes intervener
- Loses this position if it does not file response in due time
- Has all procedural rights the parties have
- Can bring a cross-claim (same time limit as for the response; separate document)

The application: formal matters, language

Time limit

- 65 EUTMR: 2 months; 60 RoP: + 10 days
- **Start:** notification of BoA decision (note rules for EUIPO notifications)
- **End:** If deadline falls on weekend or holiday: next working day (official holidays for the Court of Justice: [http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32015D0704\(01\)&from=EN](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32015D0704(01)&from=EN))

Form of submission

- eCuria (recommended)
- Hard copy: original + 4 or 5 certified copies (73(2) RoP)
- Advance fax sent within time limit OK if hard copy arrives within 10 days (73(3) RoP)

Necessary content for admissibility

- Names and addresses of the parties and of the applicant's representative
- Subject-matter, pleas in law, arguments, summary of pleas
- Representation by an attorney

Additional formal requirements

- Evidence of attorney's bar admission and PoA (specific)
- Evidence of existence of applicant and entitlement of person who signed the PoA
- Contested decision attached
- Maximum of 20 pages written pleadings
- List of Enclosures
- Full pagination

Language

- Application in any EU language (44 RoP)
- Intervener can object (45(4)(c) RoP)
- If so: language of proceedings before BoA; application is translated by the Court (*ergo*: now > 70% English)
- Other parties: must use procedural language

Substantive issues

Pleas in law

- Clear and unequivocal
- 65 EUTMR: action must be based on infringement of the law
- However, not strictly necessary to name the correct provision
- Important: pleas must address the legal basis of the contested decision (e.g. [T-398/14](#))
- Pleas relating to exercise of discretion (e.g. whether to suspend) must be based on manifest errors or misuse of power ([T-566/12](#))

Request for annulment or alteration

- Request for **annulment**; EUIPO must draw the consequences (65(3), (6) EUTMR)
 - Request to declare decision contrary to EUTMR can be interpreted as request for annulment ([T-381/12](#))
- Request for **alteration**: where GC can rule based on facts and law before BoA

Request for alteration

- Alteration must be something the Board could have decided
- Admissible:
 - annulment of first instance decision ([T-183/12](#))
 - Rejection of opposition
- Not admissible:
 - registration of EUTM application (would require instructions to EUIPO) ([T-440/13](#))

New facts or evidence

- Principle: no change of subject matter before BoA (188 RoP)
- Exceptions:
 - Generally known facts
 - Case-law

After the application...

Further proceedings

- Response by Defendant (EUIPO), Intervener: 2 months + 10 days
- Request for oral hearing: three weeks from closure of written proceedings
- Both extendable (exceptionally)

Oral hearing

- Only upon request
- Gowns obligatory
- Pleading notes to interpreters:
interpret@curia.europa.eu
- Pleading time: 15 min main parties, 10 min Intervener
- Q&A can be in language of proceedings or French
- Opportunity for short closing remarks

Suspension

- Discretion of the Court
- Proceedings can be suspended at any time (also after oral hearing)
 - Upon joint request of the parties (69(c) RoP)
 - Where proper administration of justice so requires (69(d) RoP)
- Attack on validity of earlier mark can lead to suspension but may not!

Termination without judgment

- **Discontinuance** of proceedings (Article 125 RoP): equivalent to withdrawal of the action => BoA decision becomes final
- **Withdrawal** of the underlying action (EUTM application, opposition, cancellation action etc.): proceedings lose effect (not provided for in RoP)

Judgment or order

- Order if the application is manifestly inadmissible or unfounded
- Otherwise judgment

Cost decision

- Requires specific request
- Losing party pays
- If party discontinues proceedings, it pays
- If case does not proceed to judgment: discretion of the Court
- Cost order cannot be separately appealed

Dispute on recoverable costs

- If parties disagree as to the amount to be reimbursed
- Application to the GC to determine the cost (170 RoP)
- One submission each
- Necessary costs for the proceedings (normally) excluding costs for Article 170 procedure; equity; only one adviser
- Normally 4k – 8k, only exceptionally more than that

Appeal to the CJEU

Admissibility

- Time limit: 2 month plus 10 days
- Formalities: much like in GC proceedings (but: 15 pages limit)
- Parties to GC proceedings - also EUIPO
- Based on wrong application of the law
- Requests to evaluate the facts are inadmissible unless a distortion of facts has been claimed (very strict)

Thank you!