

# Impact of the legislative reform on appeal proceedings

---

Scott Stanley  
28/11/2017

1. Overview
2. Trade mark cases

# LEGAL REFORM OVERVIEW

## Purpose

“an effective, efficient and complete review... by means of a transparent, thorough, fair and equitable procedure”

*Recital 42, EUTMR*

## Purpose

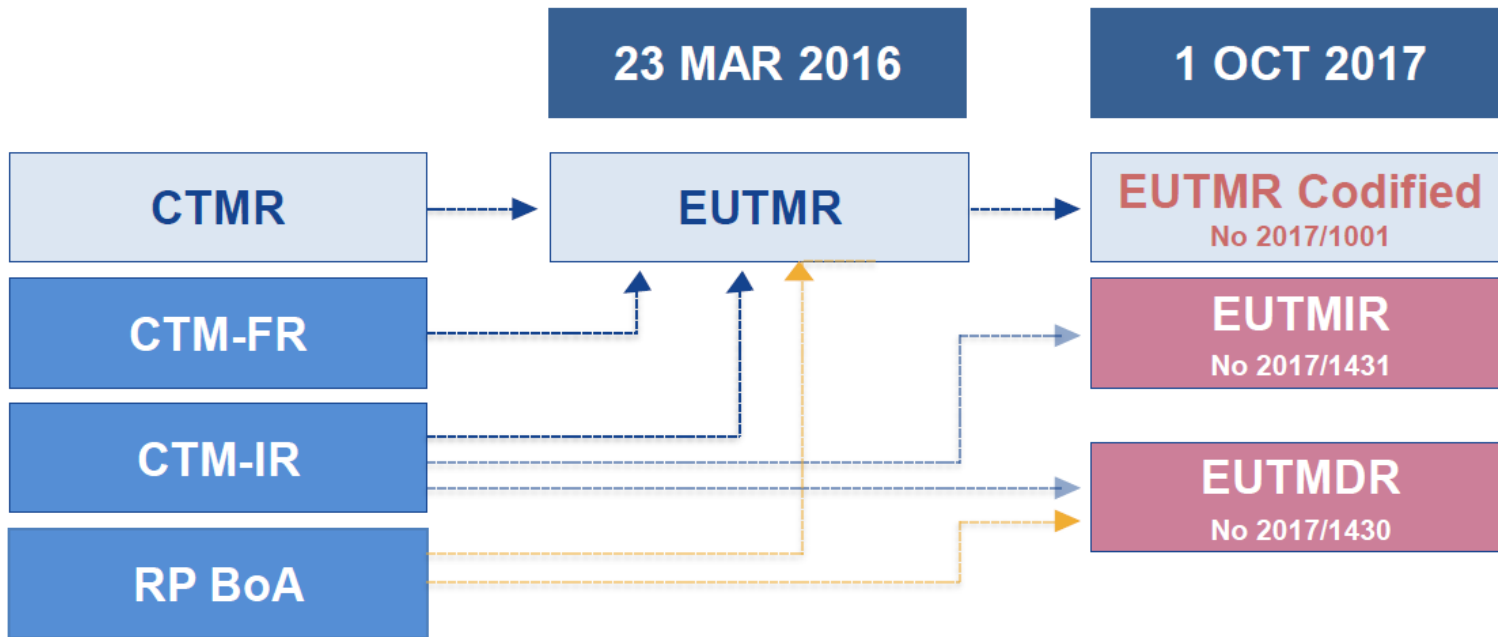
“a transparent, thorough, fair and impartial appeal procedure suited to the specific nature of intellectual property law”

“it is appropriate to reinforce legal certainty and predictability by clarifying... the procedural rules”.

*Recital 8, EUTMDR*

“high quality and consistency of the decisions... as well as the efficiency of the appeal proceedings.”

*Recital 9, EUTMDR*



## Which law applies?

### Substantive law

- Determinative date = EUTM filing date.
- C-591/12 P, Bimbo Doughnuts § 12
- New AG grounds only applied to EUTMs filed after entry into force of EUTMR.
- No retroactive cancellations.

## Which law applies?

“Given that the application ... at issue was filed on 25 May 2006 and that **that date is determinative for the purposes of identifying the applicable substantive law...** the present dispute is governed by... the substantive provisions of Regulation No 40/94.”

*C-591/12 P, Bimbo Doughnuts, § 12*



## Temporal applicability

### Procedural law

“It is established case-law that procedural rules are generally held to apply from the date on which they enter into force”

*C-201/09 P, Arcelor Mittal Luxembourg v Commission , § 36*

## Transitional provisions

EUTMDR and EUTMIR contain transitional rules

Although CTMIR and BoA-RoP repealed, they may still apply

Article 38(2) EUTMIR; Article 81(2) EUTMDR

## Transitional provisions

### Article 82(2)(j) EUTMDR

title V shall not apply to appeals entered before the abovementioned date;

# TRADE MARK APPEALS

- i. Appeal provisions
- ii. Horizontal provisions
- iii. First-instance provisions

i. Appeal provisions

## Notice of Appeal

### Requirements:

- Name and address of the appellant and representative
- Clear and unambiguous identification of the decision subject to appeal
  - the date on which it has been issued
  - the file number of the proceedings to which it relates
- If a partial appeal, a clear and unambiguous identification of the relevant goods and services.
- In the language of proceedings.
  - Change of language procedure

## Notice of Appeal

### Deficiencies & remedies:

- Name and address of the appellant and representative
  - Time limit set by registry (1 month)
- Clear and unambiguous identification of the decision subject to appeal
  - Within the four months to file the statement of grounds
- If a partial appeal, a clear and unambiguous identification of the relevant goods and services.
  - Time limit set by registry (1 month)
- In the language of proceedings.
  - Within the four months to file the statement of grounds

## Notice of Appeal

### Inadmissibility

- Failure to remedy any of the deficiencies listed will render the appeal inadmissible.



## Statement of Grounds

### Requirements:

- Indication of the appeal proceedings
  - Either the appeal number, or the decision subject to appeal (date & file number)
- The grounds of appeal
- The facts, evidence and arguments in support
- Filed within four months of notification of the contested decision
- In the language of proceedings

## Statement of Grounds

### Deficiencies and remedies:

#### Indication of the appeal proceedings

- Either the appeal number, or the decision subject to appeal (date & file number)
- **Time limit set by registry (1 month)**

#### The grounds of appeal

- **Time limit set by registry (1 month)**

#### The facts, evidence and arguments in support

- **Time limit set by registry (1 month)**

#### Filed within four months of notification of the contested decision

- **Translation within one month of submitting the original**

## Statement of Grounds

### Inadmissibility:

- Indication of the appeal proceedings
- The grounds of appeal
- The facts, evidence and arguments in support
- Languages of proceedings
- Time limit

## Defendant's observations

### Requirements:

- Within two months of notification of the statement of grounds
  - Extension of filing period is possible (exceptional).
  
- Name and address of defendant and their representative
  
- Mutatis mutandis
  - Identification of the contested decision
  - Identification of the appeal proceedings
  - Facts, arguments and grounds
  
- Deficiencies may be remedied within one month.

## Cross Appeal

### Requirements:

- Within two months of notification of the statement of grounds
- In a separate document
- Identification of the decision subject to appeal incl. date and file number
- Identify the appellant and their representative
- Language of proceedings

## Cross Appeal

### Inadmissibility:

- Not submitted within two months of notification of the statement of grounds
- Not in a separate document
- Failure to remedy a deficiency in other requirements:
  - Identification of the decision subject to appeal incl. date and file number
    - Within period for filing the cross appeal
  - Identify the appellant and their representative
    - Mutatis mutandis
  - Language of proceedings
    - Translation within one month of the original

## Request to file a reply

### Requirements:

- Two week deadline
- Request must be reasoned
- Only appellant may request a second round of submissions
- Respondent has the right to file a rejoinder if a reply is granted
- Board retains power to invite parties to file observations as often as necessary

## Reply and rejoinder

### Requirements:

- Language of proceedings
  - One month to file translation
- Filed within the time limit set by the rapporteur
- If a reply is granted, the rejoinder is a right.
- Essentially a codification of the old BoA-RoP with some minor changes.



## Language of appeal proceedings

a) Ex parte cases

- new possibility to choose in rare case

b) Inter partes cases remain as previously

All documents should be filed in the language of appeal proceedings

## Translations overview

Document	Time limit for filing a translation
Notice of appeal	<p>Four months of the date of notification of the decision subject to appeal.</p> <p>Art 21(2) EUTMDR</p> <p>This is codification of the “Elite by Mondariz” (T-386/14).</p>
<p>Statement of grounds</p> <p>Defendant’s observations</p> <p>Appellant’s reply</p> <p>Respondent’s rejoinder</p>	<p>One month from the submission of the original document.</p> <p>Respectively: Art 22(2) EUTMDR; Art 22(2) EUTMDR; Art 146(9) EUTMR; Art 146(9) EUTMR.</p>

## Examination of the appeal

**Certain claims cannot be assessed if raised for 1<sup>st</sup> time at BOA:**

- Distinctiveness acquired through use for AG
- Recognition acquired through use for purposes of Article 8(1)(b) EUTMR
- Requests for proof of use

## Acquired distinctiveness

When to make the claim:

- with the EUTM application, or
- at latest, in reply to a first objection from the Office.

**BoA will not take the claim into account unless it was made first during the 1<sup>st</sup> instance proceedings.**

## Acquired distinctiveness

Primary v. Subsidiary claims:

- Acq dist. may be claimed as a primary or subsidiary claim
- This distinction is made when claiming
- If made as a **principle** claim, OD will assess both inherent and acq. Distinctiveness in the same decision, as will BOA.

## Belated evidence

Mere codification of case law (in particular Arcol Capol, C-193/09 P)

Recital 7 EUTMDR

BoA may exercise discretion to accept evidence filed first before the BOA:

1. likely to be relevant for the outcome of the case; and
2. not produced in due time for valid reasons, in particular: where merely supplementing facts and evidence already submitted in due time or are filed to contest findings for the first time in the contested decision

## Belated evidence and online substantiation

Rules on online substantiation have limited effect currently at BOA

Online evid. acceptable at BOA only if Art 7(3) and 16(2) EUTMDR apply

## Reopening on AG

Article 45(3) EUTMR:

The Office may reopen the examination of absolute grounds of refusal at any time before registration.

Corollary with ability of third parties to file observations on AG.



## Reopening on AG

### Context: AG Appeal

- BoA considers that an AG applies
- G/S not part of the appeal
- BOA informs Examiner
- Examiner may decide to re-open the examination (pursuant to Article 45(3)EUTMR)

## Reopening on AG

### Context: Opposition appeal

- BOA considers an AG applies to G/S claimed in the EUTM application
- Reasoned interim decision suspending the appeal
- Remit the EUTMA to the Examiner,
  - recommendation to re-open the examination

Next steps depend on OD's decision.

## Reimbursement

Three new possibilities:

- 1) where OD revokes the contested decision
- 2) where the BOA sends to re-examine AG and OD refuses the mark.
- 3) Where the appeal is dismissed but reimbursement is equitable due to a substantial procedural violation

## Single member decisions

Lack of difficulty of the legal/factual matters and/or limited importance

- inadmissibility
- Withdrawal of the appeal, opposition, revocation, invalidity action
- Rejection/surrender/cancellation of the contested or earlier mark
- AG appeals which are manifestly unfounded or manifestly well-founded

## Grand Board

9 MEMBERS (BoA Pres. + Chairpersons + Rotational Members)

Decisions and opinions (where referred by ED)

All measures are binding of the office

BOA or Presidium **may** refer to GB :

- legal difficulty
- Importance of the case
- Special circumstances

BOA or Presidium **shall** refer to GB :

- diverging decisions between the Boards
- if the Board proposes to deviate from an interpretation of the legislation by the GB

## Reallocation

Any decision annulled or altered by judgment of the Court shall be reallocated for a new decision to implement the judgment

The new decision shall not be taken by any of the same members of the Boards of Appeal.

## Expedited proceedings

### Requirements

- On application only
- Either party may apply
- Reasoned request (urgency, circumstances of the case) + evidence
- In a separate document
- At any time during proceedings before BoA

## ii. New horizontal provisions



## Applicability to appeal proceedings

LR has maintained the general principle that procedural rules applicable before the other instances of the office are also applicable at the Boards, *mutatis mutandis*, unless otherwise provided in the regulations.

Rule 50 CTMIR is now Article 48 EUTMDR.

## Time limits

- One month, if not set by the regulations.
- EEA and non-EEA treated the same
- All appeals - no transitional provisions as in the basic regulation

## Continuation of proceedings

Some changes which relate to other proceedings rather than appeals

No continuation of proceedings for the time limits the appeal fee, notice of appeal, statement of grounds or action before the courts.

In principle, continuation of proceedings is possible for other appeal related time limits, such as formal deficiencies.

## Extensions

Codification of Boards of Appeal practice that extensions should be reasoned.

Without reasoning, a unilateral request will be rejected.

Extension requests may be made subject to the agreement of the other party.

## Suspensions

Four major changes:

1. The first joint request for a suspension will automatically be granted.
2. The default period is for 6 months
3. time limits that were suspended are restarted in full when the proceedings are resumed.
4. Two year maximum duration.

BOA may also suspend of own motion.

## Suspensions - effects

All time-limits are interrupted

- (except for fee payment)

On resumption the time period **restarts** in full

## Evidence

The following formatting requirements:

- Numbered annexes
- An index containing at least:
  - Number of the annex
  - Short description of the document (and number of pages)
  - Page number in the observations where the document is mentioned

This follows the case law of the General Court in Pelikan (T-136/11) and the Boards in Galileo (R1840/2011) and mirrors the GC rules.

Different transitional rule

## Means of communication

Executive Director has issued a decision regarding acceptable data carriers which implements Article 64(1) EUTMDR

### Acceptable Media:

- CD ROMs, DVDs, other small portable storage devices such as USB flash drives or similar units

### Unacceptable Media:

- External hard drives, memory cards, other optical discs

### Acceptable formats:

- Graphical representations and photos: JPEG and JPG format
- Sound files: MP3
- Video files: MP4
- Other attachment: PDF, JPEG, JPG
- Each attachment may be max 200MB, uncompressed.



## Limitations

- In opposition cases, they must be filed as a separate document
- Otherwise, will may not be taken into account.
- If Registry spots a limitation contained in observations, will inform the party that it needs to be refiled in a separate document
- No separate document requirement for ex parte cases
- BoA will also always ask other party if they wish to withdraw the proceedings where a limitation has been filed
- BOA must decide on the lim. at latest in the decision

## Surrenders

Similar rules as for limitations – at latest in the BoA decision and requirement to use a separate document

### Revocations cases

- Validity of surrender requires either a final decision on the revocation, or consent of the revocation applicant
- Have to ask the other party if they withdraw the cancellation action
- If they agree to withdraw, then the surrender can be processed
- Otherwise, the surrender is on hold till the end of the proceedings

## Representation

It is no longer mandatory for parties from Iceland, Liechtenstein and Norway to have representation

Persons with their commercial establishment in one of those countries may be entered on the register of professional representatives

This practice has already been established in the other departments by means of a [decision of the ED](#).

## General Authorisations

No longer required by law

However, BOA maintains old practice, i.e. all employee representatives will be requested to file a general authorisation.

## Withdrawals

In inter partes proceedings, withdrawals should be filed as a separate document.

### iii. New first-instance provisions

## Revocation of the 1st instance decision

OD receives request for revocation

Appeal is placed on hold pending a clear intention from OD.

If OD intend to revoke the decision

- BoA Registry will suspend the appeal pending the OD decision.
- The appeal becomes devoid of purpose, is dealt with in a single member decision and the appeal fee reimbursed

If OD does not intend to revoke the decision

- resume the proceedings

## Online evidence

The Registry checks whether earlier rights have expired or are still valid

Registry will follow the same guidelines as the OD in terms of checking on earlier rights

Will not ask for a renewal certificate if it is clear from the online source cited

Same requirements as the OD for valid source



# DESIGNS APPEALS

## Legal framework

### Article 106

#### Boards of Appeal

*In addition to the powers conferred upon it by Article 131 of the Regulation on the Community trade mark, the Boards of Appeal instituted by that Regulation shall be responsible for deciding on appeals from decisions of the examiners, the Invalidity Divisions and from the decisions of the Administration of Trade Marks and Designs and Legal Division as regards their decisions concerning Community designs.*

## Legal framework

### Art 108 CDR:

#### Rules of procedure of the Boards of Appeal

*The rules of procedure of the Boards of Appeal shall apply to appeals heard by those Boards under this Regulation, without prejudice to any necessary adjustment or additional provision, adopted in accordance with the procedure laid down in Article 109(2).*

## Potential issues

Article 80 EUTMDR repeals the Regulation on the Rules of Procedure of the Boards of Appeal i.e. Commission Regulation 216/96

- Time limits stay the same – Article 57 CDR
- Cross appeals seem to be possible as there is nothing to the contrary in the CDR
- Suspensions and extensions
- Withdrawals

## **Appeal fee:**

- EUR 720 for trade marks**
- EUR 800 for designs**

**email: [scott.stanley@euipo.europa.eu](mailto:scott.stanley@euipo.europa.eu)**