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Cross Appeals Webinar

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The winner is …

Suspense of two months –
what if the defeated wants to fight the result …

1. To appeal or not to appeal?

- OD decision: partial refusal
  - Application (-) for goods A
  - Opposition (-) for goods O

The Opponent and the applicant

- could live with the partial refusal,
- if the other party does not appeal.

What if on the last day …

What if on the last day …

Nobody appeals:

- If nobody files an appeal, the contested decision takes effect after two months (Art. 66(1) EUTMR).

Both parties appeal:

- The applicant‘s appeal and the opponent‘s appeal against the same decision are joined (Art. 35(5) EUTMDR).
- **‚Multiple appeals‘**

2. To appeal or not to appeal?

- OD decision: partial refusal
  - Application (-) for goods A
  - Opposition (-) for goods O

The Opponent and the applicant

- could live with the partial refusal,
- if the other party does not appeal.

What if on the last day only **one party** files an appeal?

3. To appeal or not to appeal?

OD decision:

- Opposition (-) for goods A, opponent may appeal
- Application (-) for goods B, applicant may appeal

- Appellant: ‚Defensive' partial appeal is admissible,
  - Notice of appeal 2 months,
  - Statements of grounds 4 months,
  - 720€
  - To the extent he is adversely affected.
- Defendant: what about the defence?

3. To appeal or not to appeal?

- Defendant: may file a cross appeal
  - Which remains dependent on the first appeal.

- Appellant
  - may be worse of (reformation in peius), but
  - May withdraw the own appeal, to frustrate the cross appeal.

The defence appeal (‚cross appeal‘)

- Art. 68(2) EUTMR (since 2017)

‚In inter partes proceedings, the defendant may, in his response, seek a decision annulling or altering the contested decision on a point not raised in the appeal.

Such submission shall cease to have effect should the appellant discontinue the proceedings.’

Before: Art. 8(3) RP-BoA ‚ancillary appeal‘

Cf. Cross claims in Art. 182-187 RP-General Court

Cross Appeal formalities (Art. 25 EUTMDR)

- On a document separate from the response,
- within the time to file a response to the statement of grounds,
- Parallel to an appeal (Identifying the decision, the defendant / cross appellant, the extent of appeal etc.)

More legal security

- In a separate document, not simply in the response,
  - No ‚e-cross-appeal' yet, do **not** use the e-appeal,
  - The case will have no separate appeal number or fee,

- Own legal basis in the EUTMR,
- The appellant is invited to file observations in reply.

Decision on costs

Multiple appeals

- Joined appeals,
- Decision on costs for each appeal.

Cross appeal

- One appeal,
- Decision on costs depending on outcome
- Equity

4. To appeal or not to appeal?

Applicant

OD Decision: application rejected

- Austria, Greece, UK, EUTM not substantiated
- LOC with the Danish mark for all g+s

Opponent

- MGM
- Trade marks in Denmark, Austria, Greece, UK, EUTM application …

- **Can the <u>opponent</u> appeal in order to avoid conversion?**

4. Appeal is inadmissible

Applicant

OD Decision: **application rejected**

- Austria, Greece, UK not substantiated, EUTM not registered,
- **LOC with the Danish mark for all g+s**

Opponent

- MGM
- Trade marks in **Denmark**, Austria, Greece, UK, EUTM application …

- **The opponent is not adversely affected (Art. 67 EUTMR,** T-342/02)
- **But may contest the findings on the substantiation in its defence to the applicant‘s appeal just in case**

5. To appeal or not to appeal?

- Applicant

- OD decision:
  - pou (+),
  - but loc (-),

  Opposition rejected

- Opponent:
  - proof of use?
  - Likelihood of confusion?

  - May the applicant challenge the proof of use?

5. To appeal or not to appeal?

- Applicant

- OD decision:
  - pou (+),
  - but loc (-),

  Opposition rejected

- Opponent:
  - proof of use?
  - Likelihood of confusion?

  - The applicant‘s appeal would be inadmissable.
  - But he may (must) challenge the proof of use in the response to the opponent‘s appeal just in case.

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