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#### **Cross Appeals Webinar**

Philipp von Kapff, Member of the First Board of Appeal 24 July 2018



### The winner is ...



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





- 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:**

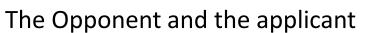
- The applicant's appeal and the opponent's appeal against the same decision are joined (Art. 35(5) EUTMDR).
- ,Multiple appeals'







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



- could live with the partial refusal,
- if the other party does not appeal.
  What if on the last day only <u>one party</u> files an 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?





- 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 <u>not</u> 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



#### 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 <u>opponent</u> 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





- Applicant
- OD decision:
  - pou (+),
  - but loc (-),
  - **Opposition rejected**



- Opponent:
  - proof of use?
  - Likelihood of confusion?
  - May the applicant challenge the proof of use?





- 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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Thank you



Presentation		
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