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OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Boards of Appeal

Structure, organisation and proceedings

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Moscow, 4 December 2015



Alicante

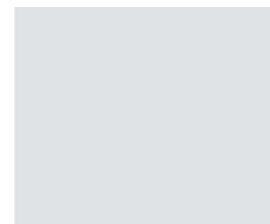
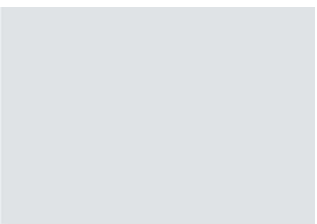
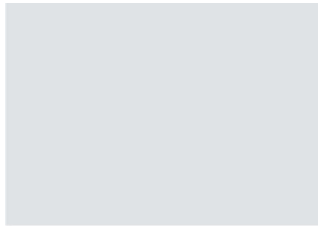


BEAUTIFUL, MEDITERRANEAN, UNIQUE



City of OHIM

OHIM – Agency of the EU / 120 000 CTMs and 80 000 RCDs/year / The EU Observatory on Infringements of IP rights
Employees from 28 EU Members States / 1500 IP Professionals working ... **For you**



- ☐ **Mission**
- ☐ **Structure – Organisation**
- ☐ **Appeal procedure**
 - **Main stages**
 - **ISO certification**
 - **Language of proceedings**
 - **Fundamental procedural principles**
 - **Scope of the proceedings**
- ☐ **Legality control**
- ☐ **Place of the Boards in the jurisdictional system of protection of CTM/CDR**
- ☐ **Mediation**



Mission

**hear and adjudicate appeals filed before the Boards of Appeal
as authorized by the Community Trade Mark and Community
Design Regulations and EU Law**

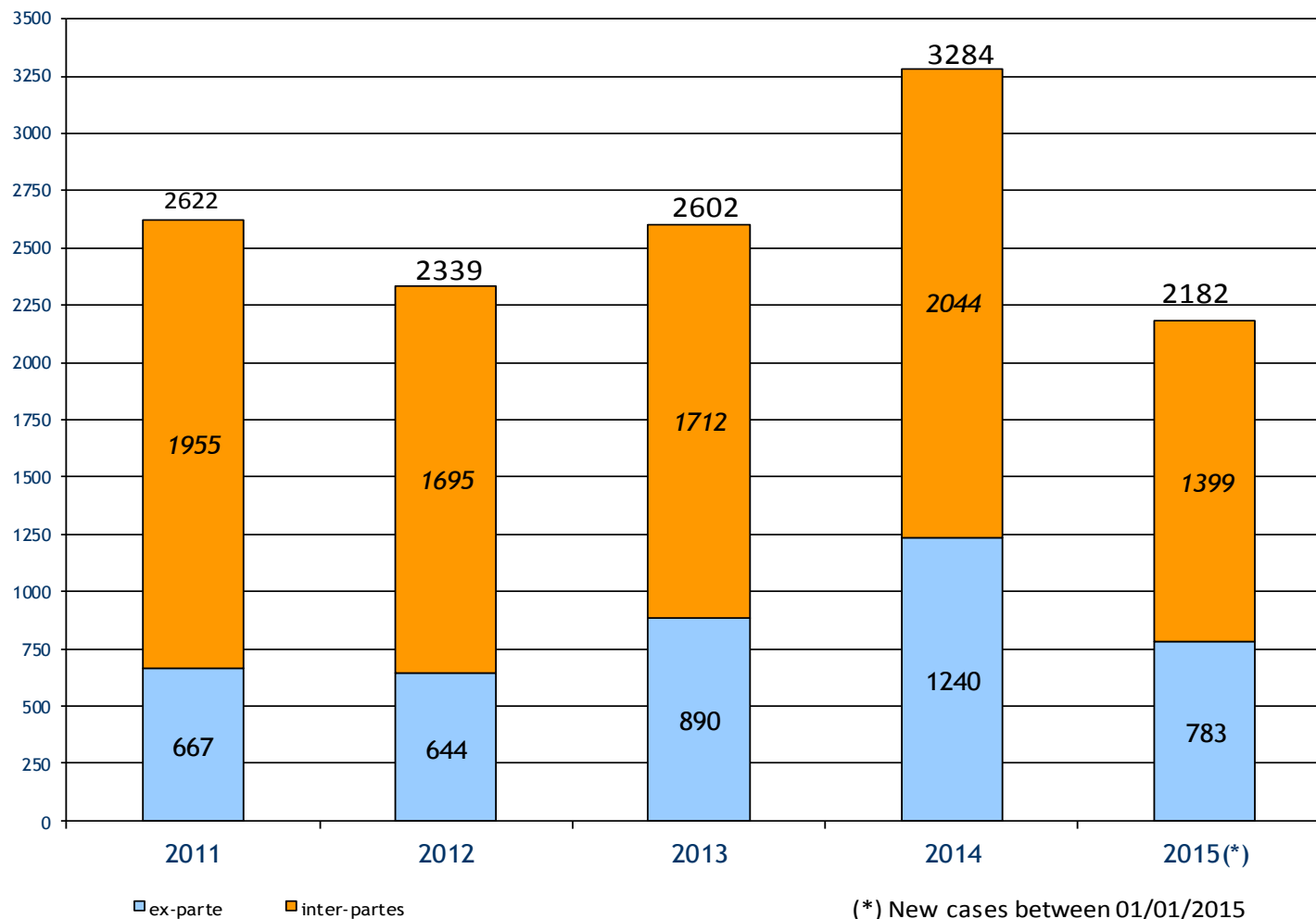
Appealable decisions:

- **Of examiners on absolute grounds**
- **Of examiners on formalities**
- **Opposition decisions**
- **Decisions on cancellation requests (invalidity on absolute or relative grounds, revocation for non-use)**
- **Of the Register Service (transfers, renewals, etc.)**

Appeal filed:

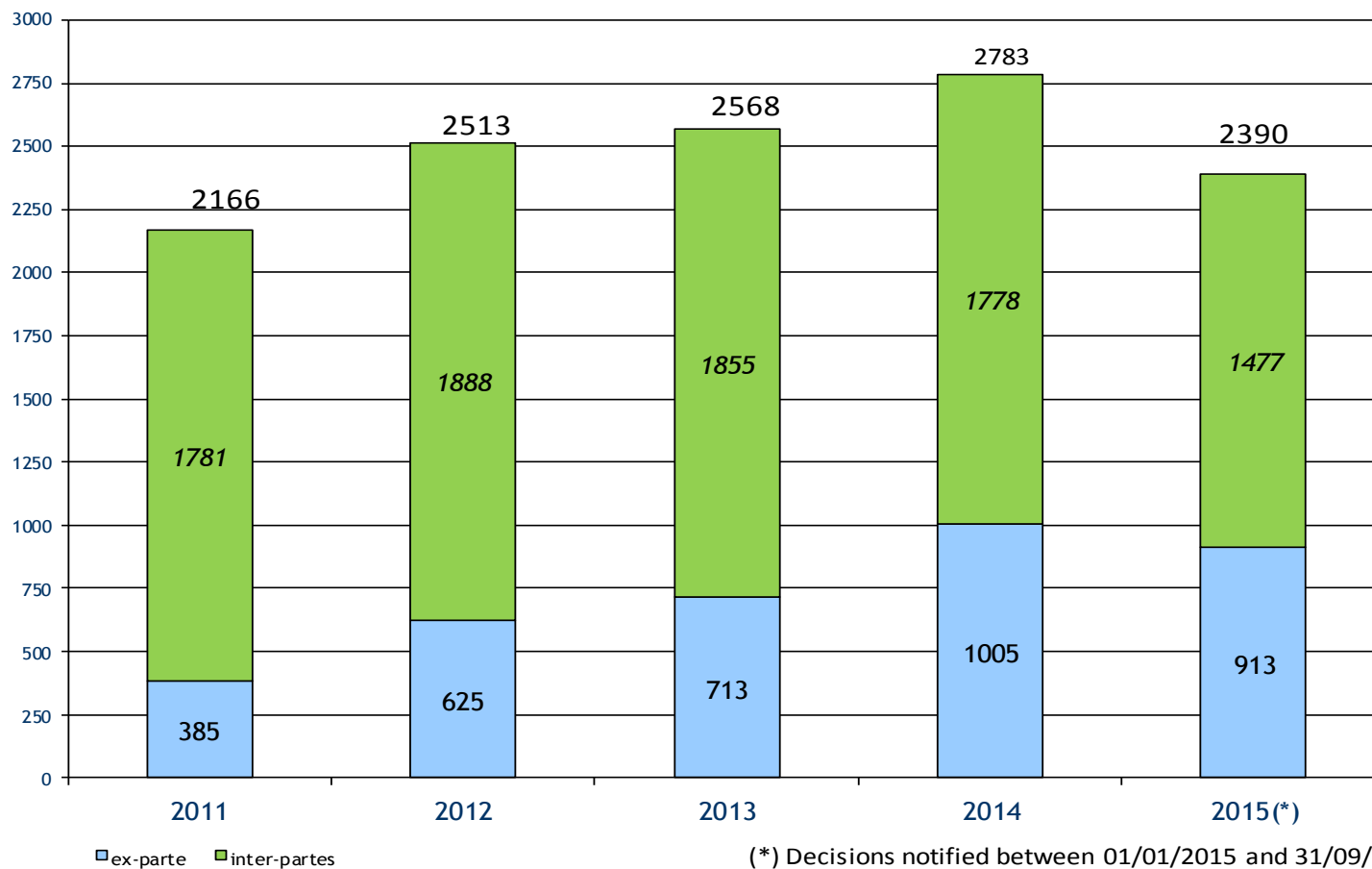
- **OHIM / BoA**
- **Mails go to Registry**
- **Appeal file is created, file is blocked for examiner**
- **e-Appeal : future (project in progress)**

Mission - Appeals filed



(*) New cases between 01/01/2015
and 31/10/2015

Mission - Appeals decisions



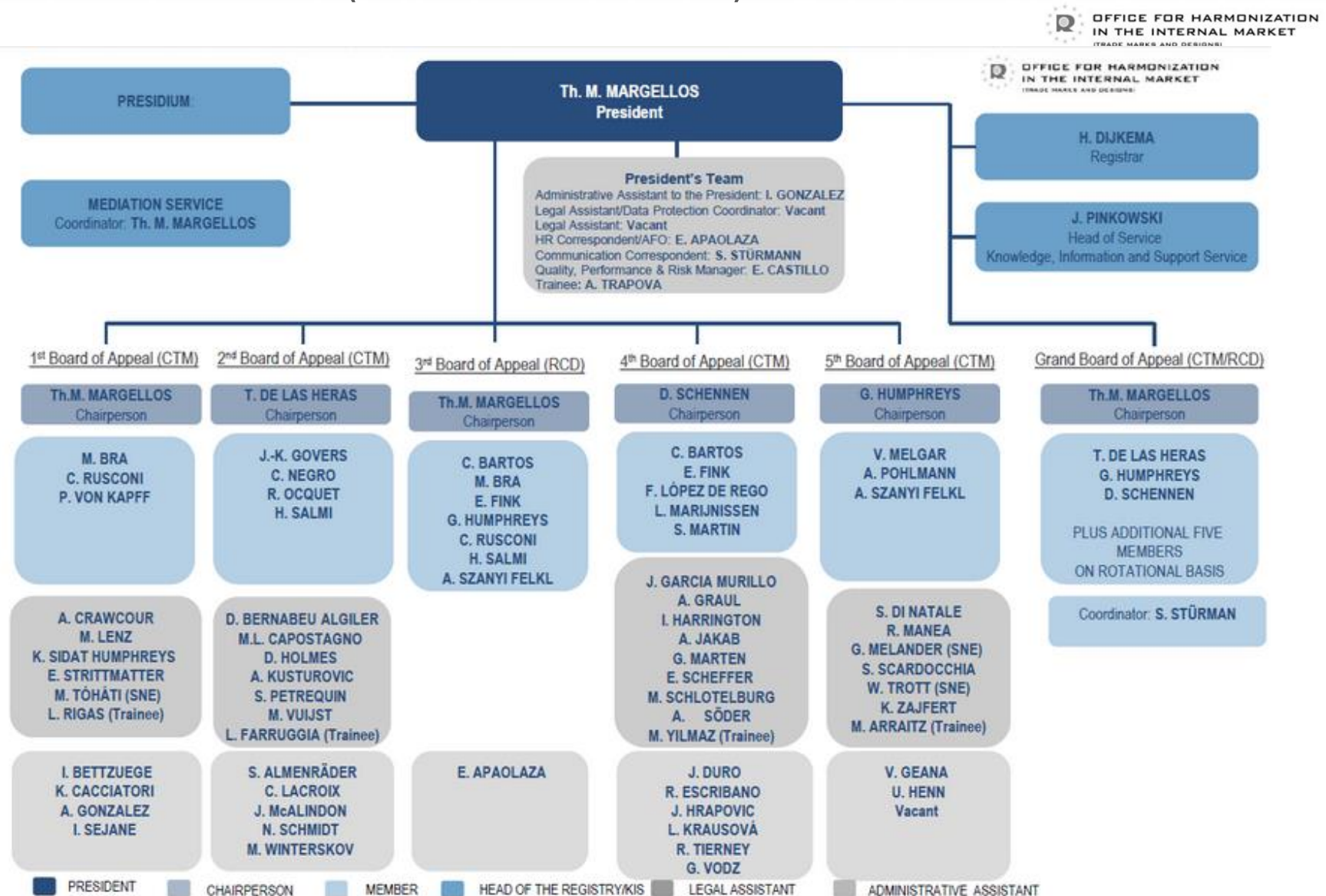
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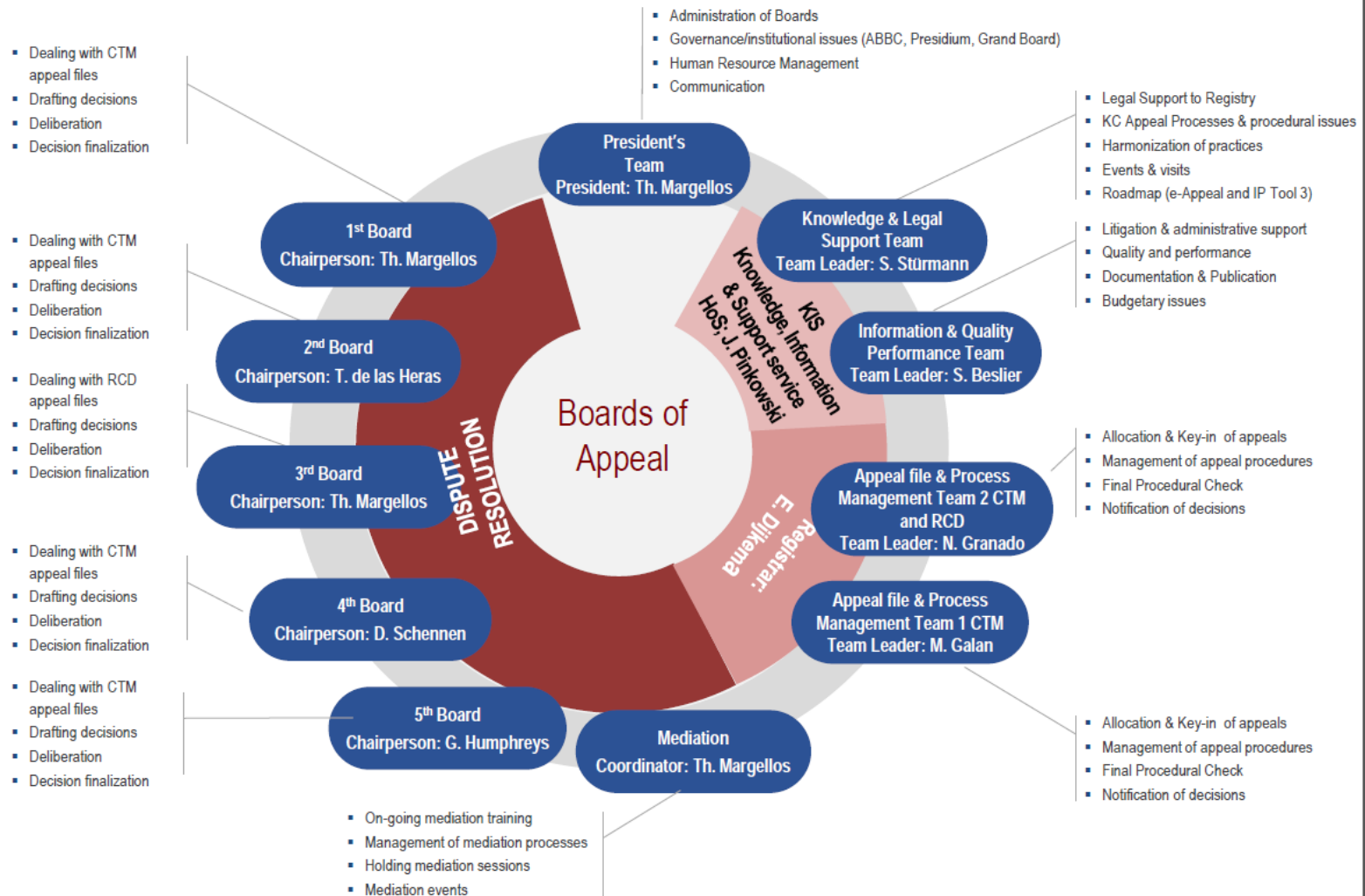
Structure – Organisation

Structure – Organization

Chart of the Boards (18 Chairs and Members)



Structure and Organization - Boards of Appeal



President of the Boards

Chairpersons

Presidium

Structure – Organization

Role of the President of the Boards



- **Management role**
- **Chair Presidium**
- **Chair Grand Board**

Structure – Organization

Role of the Chairpersons



- **Decision-making tasks**
- **Managerial tasks**

Decision-making tasks

- Organise the decision-making procedure
- Harmonise BoA's decisional practice
- Preside over deliberation meetings
- Set the dates on which deliberation meetings will take place
- Designate ad hoc BoA -Rapporteur and 3rd Member-
- Instruct the Registry
- Decide on procedural steps
- Member of the GB
- Act as Rapporteur

Managerial tasks

- **Instruct and supervise the work of assistants and secretaries**
- **Select the staff of the Board**
- **Evaluate the staff**
- **Member of the Presidium**
- **Collaborate with the President of the BoAs**
- **All sorts of other administrative issues**

- **Composition**
(as of 12th July 2013)
- (Art. 136 CTMR, Art. 1 RP BoA)
 - **President**
 - **Chairpersons**
 - **Members (elected)**
 - **Total**
 - **(+2 alternate elected Members)**

1



3



4



8



- **Responsible for organizational matters:**
 - **Decision on abstract criteria for allocation of cases**
 - **Internal rules of organizational nature**
 - **Practical instructions for the parties**
 - **Reallocation of cases if annulment by General Court**

Structure – Organization

Grand Board



- **Composition**
- **(Art. 1a RP BoA, Art. 8 Rules concerning the Organization of the Boards)**

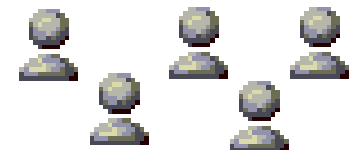
– **President** **1**



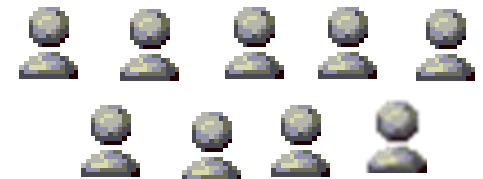
– **Chairpersons** **3**



– **Members (rotating)** **5**



– **Total** **9**



Structure – Organization

Referral to the Grand Board - Art. 1(b) RP BoA



- **By the competent Board or**
- **By the Presidium on proposal**
 - **of the President of the BoA**
 - **of a member of the Presidium**
- **Not by the parties, the President of the Office, or another Board**



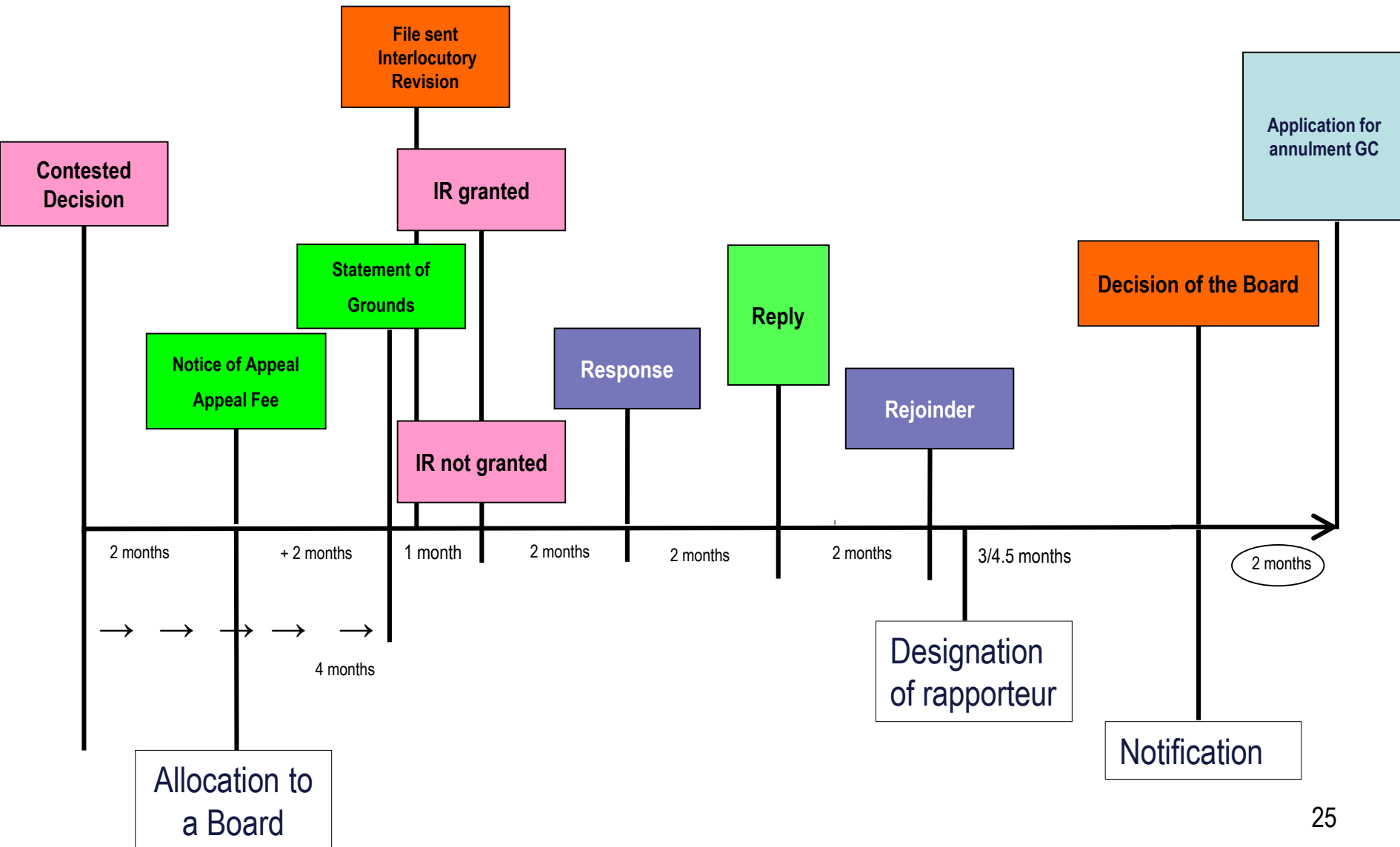
Appeal Procedure



Main stages

Appeal Procedure

The Appeal Process in a Nutshell



ISO certification

- ☐ ISO 9001 Quality
- ☐ ISO 27001 Information Security
(confidentiality of data)

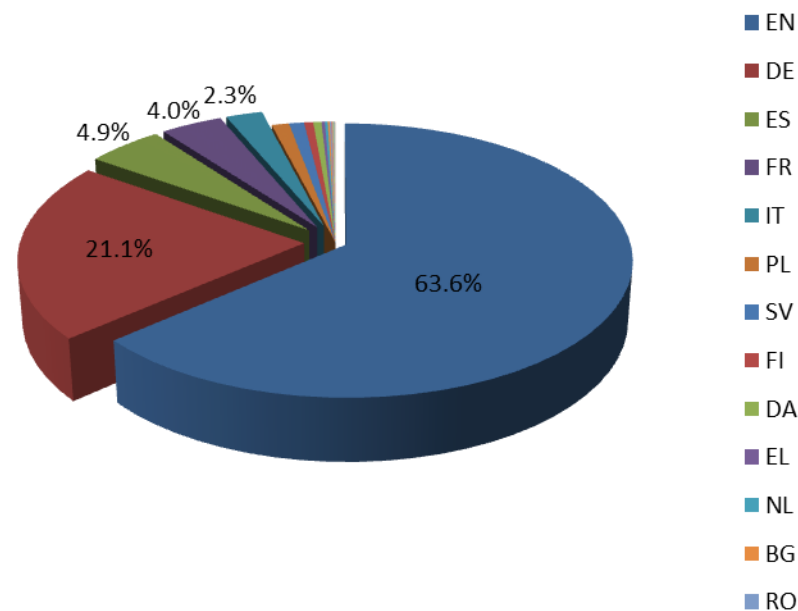


Language of proceedings

Language of proceedings before the Boards is the language of the proceedings before the first instance

	2010	2011	2012	2013	2014	2014%
EN	1776	1705	1505	1745	2090	63.6%
DE	373	520	520	456	694	21.1%
ES	213	138	135	136	161	4.9%
FR	124	149	81	138	130	4.0%
IT	58	62	55	53	77	2.3%
PL	0	8	3	8	36	1.1%
SV	9	9	21	22	31	0.9%
FI	8	11	9	20	19	0.6%
DA	3	8	1	4	17	0.5%
EL	0	0	0	2	7	0.2%
NL	2	9	4	4	6	0.2%
BG	0	0	0	1	4	0.1%
RO	0	0	0	2	3	0.1%
CS	1	2	4	2	3	0.1%
HU	0	0	0	0	3	0.1%
PT	2	1	0	3	1	0.0%
SL	0	0	0	1	1	0.0%
ET	0	0	0	0	1	0.0%
LT	1	0	1	5	0	0.0%
Total	2570	2622	2339	2602	3284	100%

Appeal Language Ratio in 2014





Fundamental procedural principles

Adversarial principle: Art. 63(2) CTMR, Art. 76(1) CTMR, Art. 59(2) CDR and Art. 63(1) CDR

Art. 63(2) CTMR: In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.

Art. 76(1) CTMR: In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

Art. 59(2) CDR: In the examination of the appeal, the Board of Appeal shall invite the parties, as often as necessary, to file observations, within a period to be fixed by the Board of Appeal, on communications from the other parties or issued by itself.

Art. 63(1) CDR: In proceedings before it the Office shall examine the facts of its own motion. However, in proceedings relating to a declaration of invalidity, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

- **Adversarial principle: Art. 78 (1) and Art. 65(1) CDR**

In any proceedings before the Office the means of giving or obtaining evidence shall include the following:

- (a) hearing the parties;
- (b) requests for information;
- (c) the production of documents and items of evidence;
- (d) hearing witnesses;
- (e) opinions by experts;
- (f) statements in writing, sworn or affirmed or having a similar effect under the law of the State in which the statement is drawn up.

- **Right of defence – right to be heard**

➡ The equality of arms and the right to a fair hearing are general principles of European law which apply in all proceedings leading to the adoption of an act of individual application.

The decisions of OHIM may be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments. The general principle of protection of the right to defend oneself is enshrined in the law of Community trade marks by [Art. 75 CTMR]. (...)

➡ A person whose interests are adversely affected by a decision taken by a public authority must be given the opportunity to make his point of view known.

The right to be heard extends to all the matters of fact or of law which form the basis of the decision, but not to the final position which the authority intends to adopt (see Case T-317/05 Kustom Musical Amplification v OHIM(Shape of a guitar) paragraphs 24, 26 and 27 and the case-law cited).



Scope of the proceedings

- **Review first decision**, get the case heard in substance another time by
- carrying out a **new full** examination of the merits of the case, in terms of both, **facts** and **law**

Definition in case law:

‘Whether based on the facts and evidence now before the Boards a decision with the same outcome can lawfully be taken’.

Yes but Not

- On what is not requested
- On what is not appealed
- And not on new/belated facts or evidence

But also

- On what was not considered by examiner but should have been considered
- On additional or supplementary facts and evidence

**Continuity in terms of their functions
between the
1st Instance Departments and the Boards of Appeal**

Based on:

- **Close interconnection between their duties**, as laid down by the rules governing the lodging and preliminary examination of applications.
- **Article 64(1) CTMR:** *‘Following the examination as to the allowability of the appeal, the Board of Appeal shall decide on the appeal. The Board of Appeal may either exercise any power within the competence of the department which was responsible for the decision appealed or remit the case to that department for further prosecution.’*

New facts and evidence before the Boards

CJ Judgment in 'Arcol / Capol' Case (C-29/05 P)

- Where facts and evidence have not been submitted and produced by the party concerned within the time-limit set to that end under the provisions of Regulation No 207/09, and thus not 'in due time' within the meaning of Article 76(2) of that regulation, that party does not enjoy an unconditional right to have such information taken into account by the Board of Appeal.
- On the contrary, that Board has a discretion as to whether or not to take such information into account when making the decision which it is called upon to give.

New facts and evidence before the Boards

CJ Judgment in 'Arcol / Capol' Case (C-29/05 P)  Reasoning

- If OHIM were compelled to take into consideration, in all circumstances, the facts and evidence produced by the parties to opposition proceedings outside of the time-limits set to that end under the CTMR provisions, those would be rendered redundant.
- It is consistent with the principle of sound administration and the need to ensure the proper conduct and effectiveness of proceedings that the parties have an incentive to respect the time-limits imposed on them by OHIM when hearing a case. The fact that the latter may, if necessary, decide to disregard facts and evidence produced by the parties outside the time-limits prescribed should, in itself, have such an incentive effect.

New facts and evidence before the Boards

CJ Judgment in 'Arcol / Capol' Case (C-29/05 P)  Reasoning:

- It is apparent from Article 41(3) CTMR, that a person who brings an opposition against the registration of a mark on the ground that that mark should be rejected on the basis of the Regulation may submit facts, evidence and arguments in support of that opposition within the time-limit set to that end by OHIM.
- Unlike Article 41(3), Article 60 CTMR , which lays down the conditions for bringing an appeal before the Board of Appeal , does not refer to the submission of facts or evidence, but only to the filing, within a time-limit of four months, of a written statement setting out the grounds of appeal.
- It follows that, contrary to the finding of the General Court, Article 60 CTMR cannot be interpreted as starting a new time-limit for the person bringing such an appeal in which to submit facts en evidence in support of this opposition.

New facts and evidence before the Boards

Rule 50(1) CTMIR:

‘Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 76 (2) of the Regulation.’

Legality control

Review of the legality of the decisions taken by the Boards

Pleas In Law

Actions may be brought based on grounds of:

- lack of competence
- infringement of an essential procedural requirement
- infringement of the Treaty
- infringement of the relevant regulation or of any rule of law relating to their application
- misuse of power

Time-limits

Actions shall be brought before the GC within two months of the date of notification of the decision of the BoA

CJEU judgment of 18 October 2012

Cases C-101/11 P & C-102/11 P

Appeal – Scope of judicial review –

‘Personnage assis’ (Sitting figure)

CD No 000426895-0002



Filed on 7 November 2005

Registered on 27 December 2005

For ‘T-shirts (ornamentation for –),
caps (vizored –) (ornamentation for –),
stickers (ornamentation for –),
printed matter, including advertising
materials (ornamentation for –)’

Application for declaration of invalidity

(18 February 2008)

CD No 1312651



Registered on 7 November 2000

For distinguish ‘clothing’ and other goods
in classes 25, 28 and 32

Under Article 61(2) CDR, an action may be brought before the General Court against decisions of the Board of Appeal for infringement of the Treaty, of the Regulation or of any rule of law relating to their application.

- It follows that the General Court has jurisdiction to conduct a full review of the legality of OHIM's assessment of the particulars submitted by an applicant (see judgment of 5 July 2011, C-263/09 P, *Edwin v OHIM* [2011] ECR I-10053, paragraph 52, and Case , C-281/10 P *PepsiCo V Grupo Promer Mon Graphic* [2011] ECR I-0000, paragraph 66)

Accordingly, the General Court is called upon to assess the legality of the decision of the Board of Appeal by reviewing its application of European Union law, having regard, in particular, to the facts which were submitted to them (paragraph 38).

The GC can carry out a full review of the legality of the decisions of the Board of Appeal, if necessary examining

- whether these boards have made a correct legal classification of the facts of the dispute or
- whether their assessment of the facts submitted to them was flawed (paragraph 39)

Review of the legality of the decisions taken by the Boards

Scope of the legality review

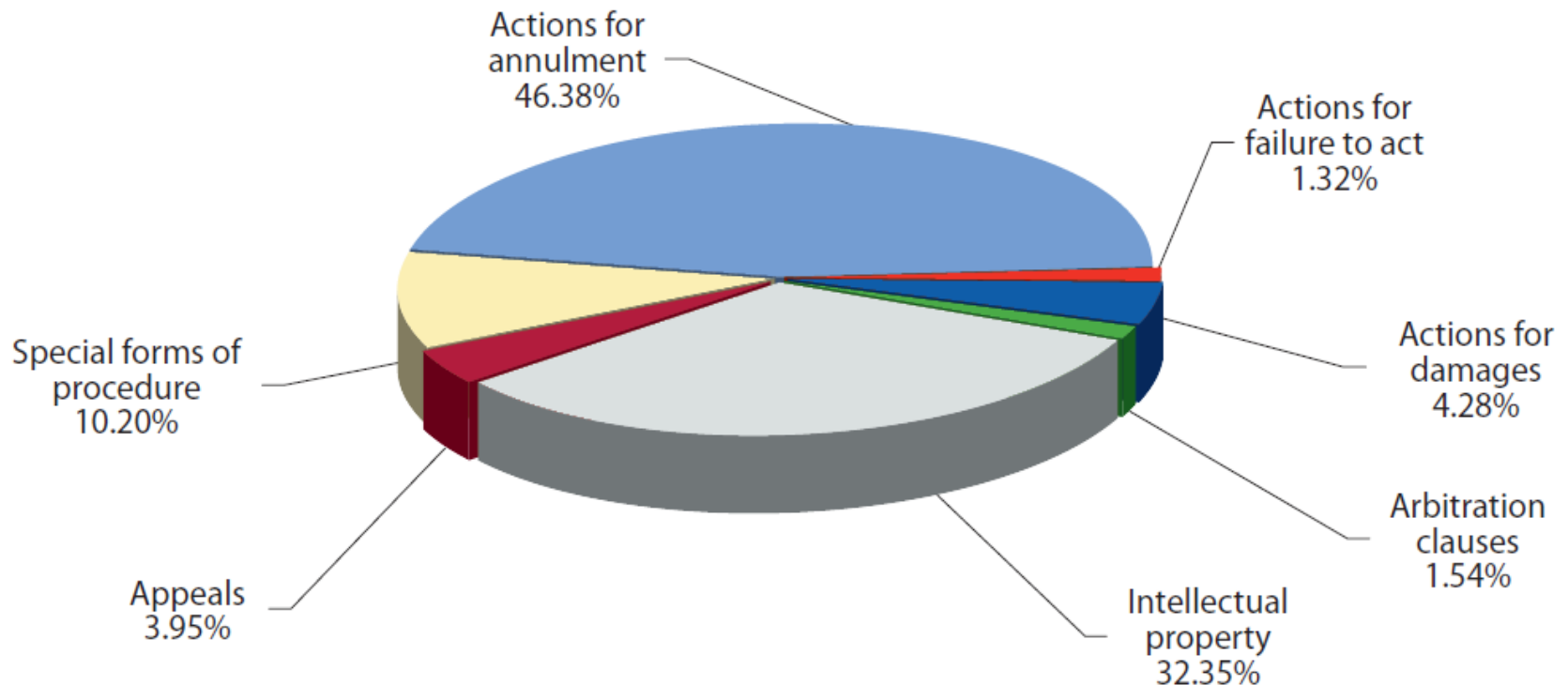


Where it is called upon to assess the legality of a decision of the Board of Appeal, the GC cannot be bound by

- an incorrect assessment of the facts by that board, since that assessment is part of the finding whose legality is being disputed before the GC (paragraph 40).

- New cases 2014: 912 (total) – 295 (IP) = 32,34%

Distribution in 2014



- New cases 2013: 790 (total) – 293 (IP) = 36,96%



Applications for annulment

Consequences

Suspensive effect of action to GC

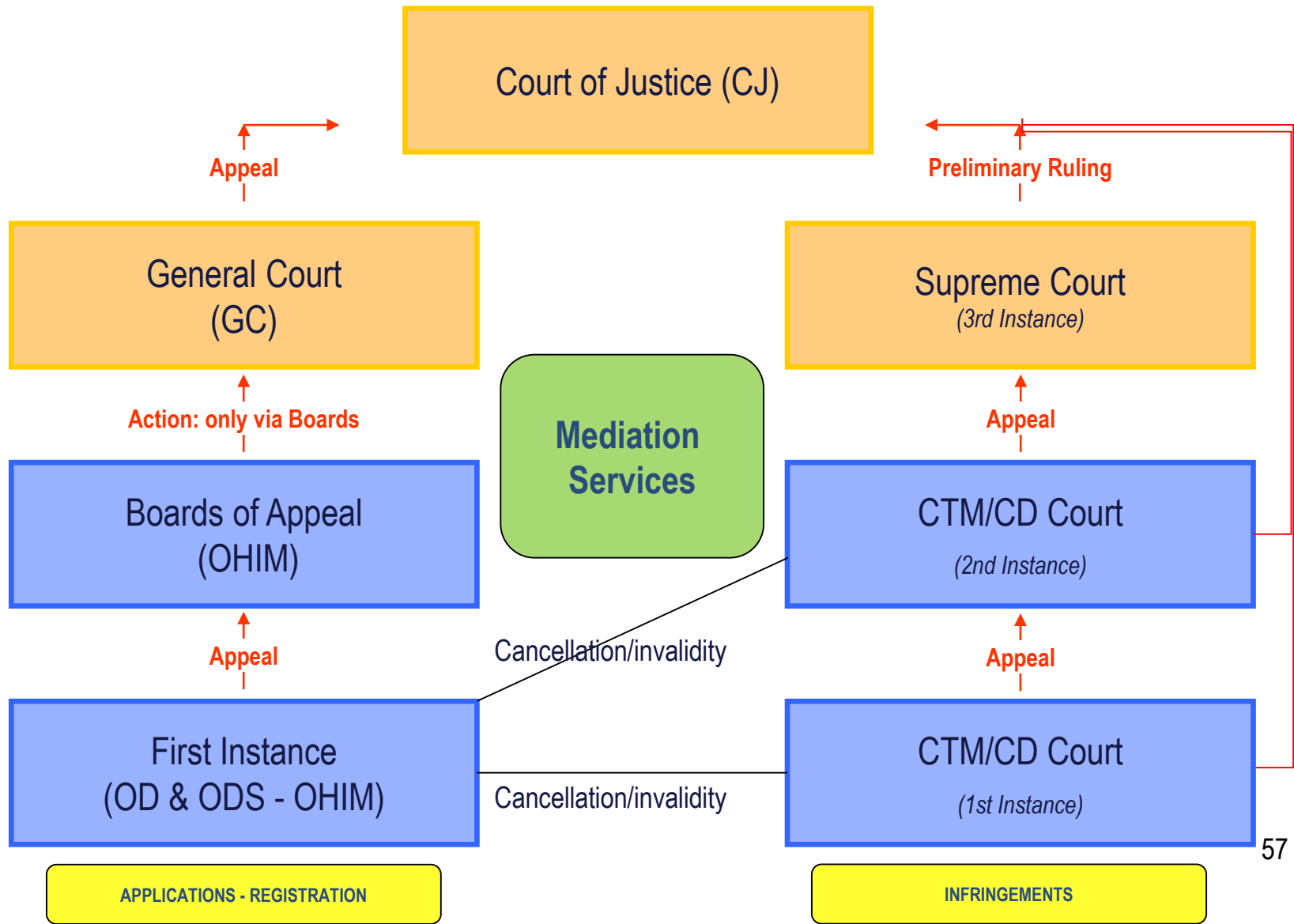
Article 64(3) CTMR:

The decisions of the Boards of Appeal shall take effect only as from the date of expiration of the period referred to in Article 65(5) or, if an action has been brought before the Court of Justice within that period, as from the date of dismissal of such action.



Place of the Boards in the jurisdictional system of protection of CTM/CDR

Place of the Boards in the jurisdictional system of protection of CTM/CDR





OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

OHIM's Boards of Appeal Mediation Service

OHIM's Mediation - Goals

Effective dispute resolution;

Accelerate dispute resolution;

Cut litigation costs;

Take into account of business interests;

Heighten user satisfaction (win-win).

Why ?



Low risk, cost effective and quick extrajudicial
resolution of disputes
‘Personnage assis’ (Sitting figure)



Cancellation Division	Decision 15 July 2008	Action upheld/design invalidated
Notice of Appeal	16 September 2008	By holder of the CD
Board of Appeal	Decision 14 October 2009	Invalidity confirmed
Action of Annulment	22 December 2009	By holder of the CD
General Court EU	Judgment 16 December 2010	Decision annulled
Appeals	28 February 2011	By invalidity applicant/OHIM
Court of Justice EU	Judgment of 18 October 2012	Appeals dismissed -> Remitted to the BoA
Board of Appeal	Decision 30 October 2013	Appeal partly dismissed
Appeal to General Court		
TOTAL	+5 YEARS	

Why?

Low risk, cost effective and quick extrajudicial
resolution of disputes
Arcol / Capol

3 April 1996	CTM Application ARCOL
20 October 1998	Notice of opposition, CAPOL
30 June 2000	Opposition decision
24 July 2000	Notice of appeal
4 March 2002	BoA decision in Case R 782/2000-3
24 May 2002	Application before the General Court (GC)
10 November 2004	Judgment of the GC in Case T-164/02
25 January 2005	OHIM appeal against GC Judgment before the Court of Justice (CJEU)
13 March 2007	CJEU Judgment, C-29/05 P
1 August 2007	BoA decision in Case R 782/2000-2
16 November 2007	Application before the GC, Case T-402/07
25 March 2009	Judgment of the GC in Case T-402/07
4 March 2010	Order of the CJEU in Case C-193/09
TOTAL	14 YEARS

Why?

ALPHA D3 vs ALPHAREN

CTM Application	No 004320297, 3 March 2005	
Notice of Opposition	6 March 2006	Article 8(1)(b) CTMR
Opposition Division	Decision 9 October 2007	Opposition upheld
Notice of Appeal	29 November 2007	APPLICANT
2nd BoA	Decision R 1897/2007-2, 24 March 2009	Decision confirmed
Application for annulment	1 June 2009	APPLICANT
General Court	Judgment T-222/09, 9 February 2011	Decision partially annulled: breach of Art.76 CTMR Internet search results do not constitute well-known fact (within assessment of similarity of goods)
1st BoA	Decision R1235/2011-1, 2 November 2011	Opposition entirely upheld (similarity of goods based on proof submitted by the parties)
Application for annulment	3 July 2013	APPLICANT
General Court	Judgment T-106/12, 3 July 2013	Decision annulled based on Art.1(d)(2). Regulation 216/96: same Member was Rapporteur in both BoA decisions
Application for annulment before ECJ	C-490/13 P, 12 September 2013	Pending
TOTAL	7 1/2 YEARS	

Why?

R10 / R10 (Nike International Ltd. vs Aurelio Muñoz Molina)

CTM Application	No 4 813 713, 2 January 2006	<p>Application to register the word mark “R10” as a CTM for the following G&S:</p> <p>(18) Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.</p> <p>(25) Clothing, footwear, headgear.</p> <p>(35) Retailing of clothing of all kinds and footwear and accessories.</p>
Notice of Opposition	B 1 054 123, 24 October 2006	Opposition based on the earlier non-registered mark “ R10 ”, Article 8(4) CTMR
Opposition Division	Decision B 1 054 123, 19 February 2008	Opposition rejected
Notice of Appeal by Nike	R 551/2008-1, 28 March 2008	Pursuant to Art. 57 to 62 CTMR
1st BoA	Decision R 551/2008-1, 21 January 2009	Appeal dismissed as inadmissible
Action brought before the GC	T-137/09, 6 April 2009	Appeal admissible, procedural violations by BoA
General Court	Judgment T-137/09, 24 November 2010	BoA decision annulled
Appeal brought before CJ by OHIM	C-53/11 P, 7 February 2011	Two pleas raised by OHIM: infringement of Rule 49 of Regulation No 2868/95, and Article 58 of Regulation No 40/94
CJ judgment	C-53/11 P, 19 January 2012	GC judgment annulled
General Court	T-137/09	Pending
TOTAL	7 1/2 YEARS	63

OHIM's Mediation – Effective dispute resolution

Advantages of mediation:

A low risk;

Cost-effective;

Quick extrajudicial resolution of trade mark and design disputes;

Process tailored to the needs of the parties;

Agreements resulting from mediation are more likely to be complied with voluntarily and are more likely to preserve an amicable and sustainable relationship between the parties.

OHIM's Mediation – Effective dispute resolution

Only available in CTM/RCD inter-partes proceedings (oppositions and cancellations based on relative grounds / invalidities);

Only possible before Boards of Appeal;

Need to file notice of appeal, statement of grounds and pay appeal fee;

No mediation fee.

OHIM's Mediation Service – Legal Framework

Legal and normative basis

“The Office may, if it thinks fit, invite the parties to make a friendly settlement” (Article 42(4), 57(4) CTMR).

“The Office may call upon the parties to make a friendly settlement” (Article 31(5) CDIR).

Presidium decision of Board of Appeal No. 2013-3 on Mediation.

President OHIM decision EX-11-04 on administrative charges.

Presidium Rules on Mediation.

Instruction to parties.

OHIM's Mediation Service – Legal Framework

IP Disputes not suitable for mediation:

Mediation should not apply to rights and obligations on which the parties are not free to decide themselves under the relevant applicable law (Recital No 10 of the Mediation Directive 2008/52/EC).

Where trade mark disputes concern the distinctiveness of the mark.

Where the disputes are ex parte in general.

Where invalidation proceedings address absolute grounds.

OHIM's Mediation Service – Excellence of organization

Structured process:

Easily accessible and transparent process;

At every stage of appeal proceedings;

No limits as to the scope of the mediation.

OHIM's Mediation Service – Excellence of organization

Loge an admissible appeal;

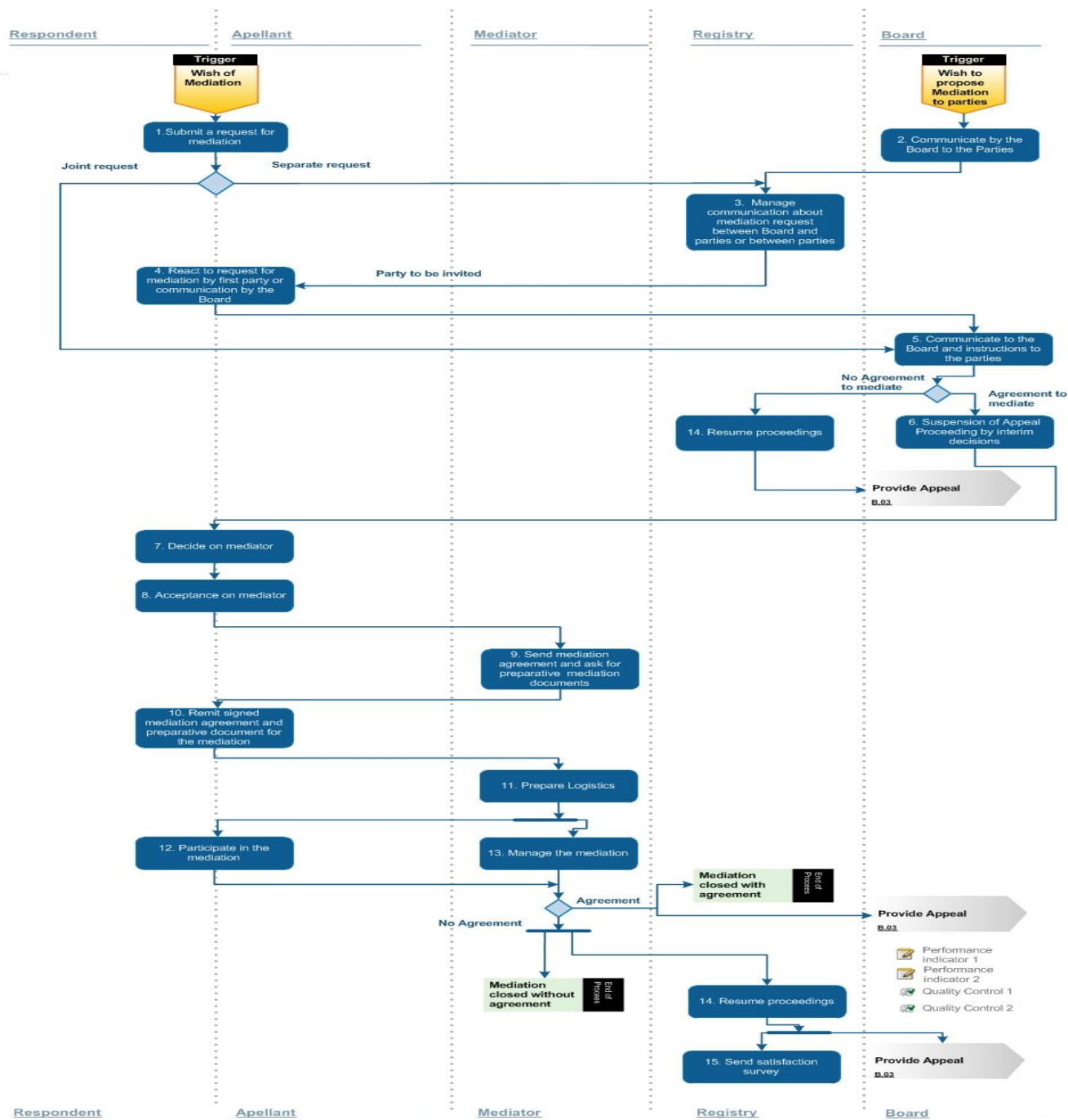
Request mediation in writing;

Identify CTM/RCD, appeal and parties;

Select mediator (CVs on website);

Choose language (if different from appeal language;

OHIM suspends appeal.



OHIM's Mediation Service – Excellence of organization

JOINT REQUEST FORM FOR MEDIATION

N° of pages (including this one):	<input type="text"/>
A. Appellant / Mediation applicant <input type="text"/>	Mediation applicant / Representative reference (not more than 20 characters) <input type="text"/>
Address / ID Number	<input type="text"/>
Representative	<input type="text"/>

OHIM's Mediation Service – Excellence of organization

Alicante (OHIM's premises).

Brussels (OHIM's Office) – subject to EUR 750 administrative charge.

OHIM's Mediation Service – Excellence of organization

Participants to mediation:

The parties to the appeal proceedings;

Professional or employee representatives;

Non-EU counsel;

1 or 2 OHIM Mediators.

OHIM's Mediation Service – Excellence of people

Internationally recognised accreditation (CIArb / CEDR)

20 accredited mediators;

Members of OHIM staff;

Following the European Code of Conduct for mediators;

Linguistic spread;

Continuous education and training;

Easy contact via email: Mediator-XXXX@oami.europa.eu.

Thank you for your attention!

More information on
www.oami.europa.eu

Feedback:

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Sven.sturmann@oami.europa.eu



OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

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