



# PROCEDURES BEFORE THE COURT OF FIRST INSTANCE & THE COURT OF JUSTICE

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EC-ASEAN Intellectual Property Rights Co-operation Programme (ECAP II)  
Phnom Penh, 17 December 2007



## I. The system of judicial review

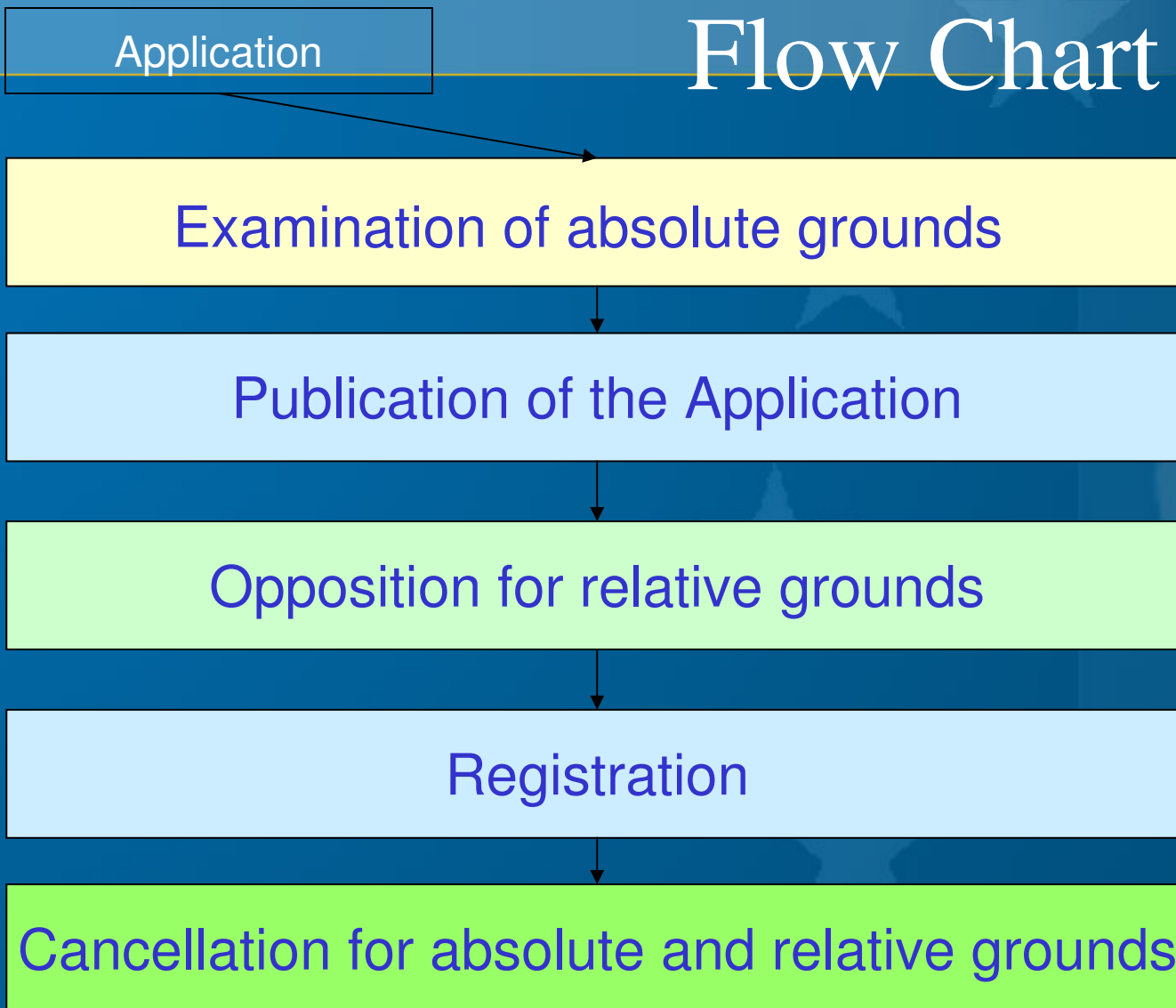
## II. Specific problems of procedural law

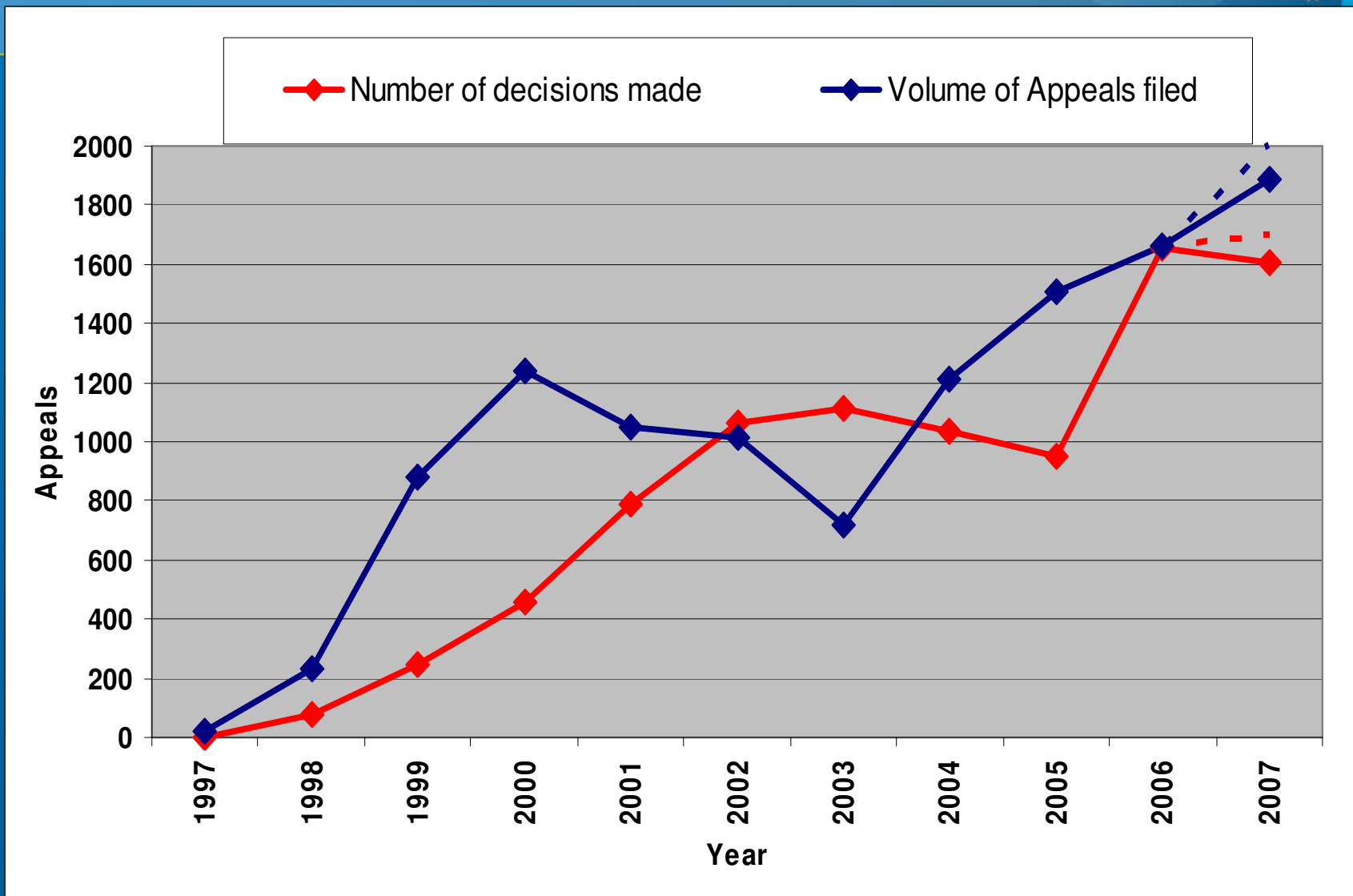
- The parties to the proceedings
- Intervention
- Substance matter of proceedings
- Discontinuance and no need to adjudicate





# Flow Chart



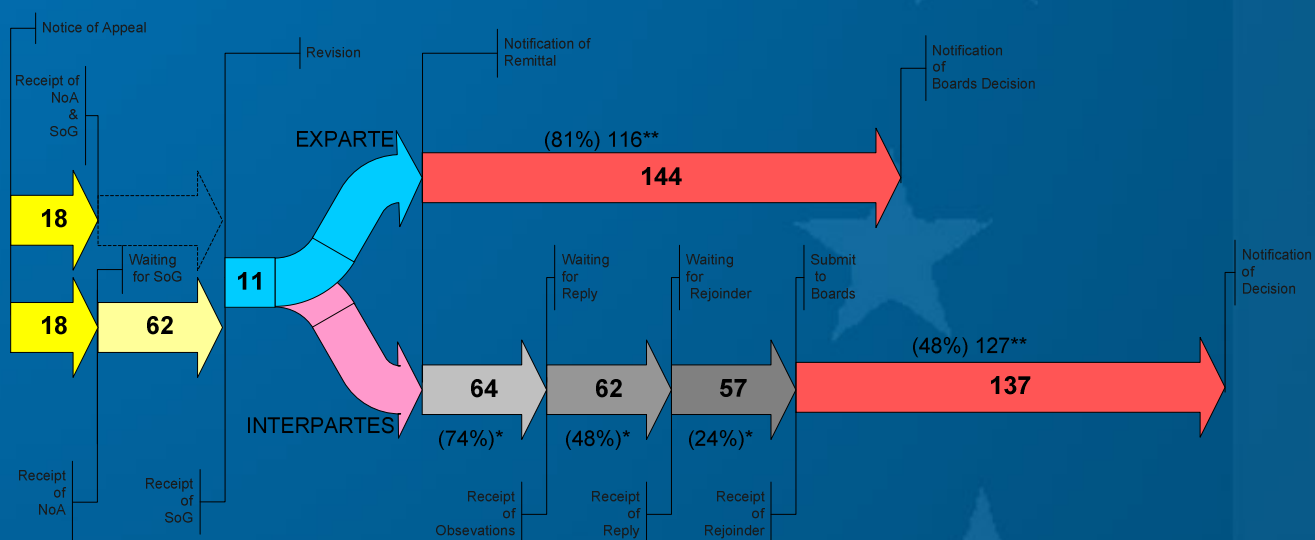


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## AVERAGE TIME FOR BOARDS OF APPEAL PROCEDURE 3 Q 2007 (TIME IN NATURAL DAYS)



(\*) Appeals ratio for which the respective documents were received

(\*\*) Appeals ratio and sample of cases in which no further information requests were issued by rapporteurs



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# OHIM DECISIONS

Décisions from 01/01/2007 to 01/12/2007

		Confirmed By Boards of Appeal	%	Annulled By Boards of Appeal	%
<b>Total décisions<sup>1</sup></b>	<b>1322</b>	<b>975</b>	<b>74%</b>	<b>284</b>	<b>26%</b>
<b>ex-parte</b>	<b>509</b>	<b>430</b>	<b>84%</b>	<b>79</b>	<b>16%</b>
<b>inter-partes</b>	<b>813</b>	<b>545</b>	<b>67%</b>	<b>268</b>	<b>33%</b>

# CONFIRMATION BY CFI

Judgments from 01/01/2007 to 01/12/2007

		Confirmed by CFI	%	Annuled by CFI	%
<b>Total décisions<sup>2</sup></b>	<b>87</b>	<b>72</b>	<b>83%</b>	<b>15</b>	<b>17%</b>
<b>ex-parte</b>	<b>27</b>	<b>25</b>	<b>93%</b>	<b>2</b>	<b>9%</b>
<b>inter-partes</b>	<b>60</b>	<b>47</b>	<b>78%</b>	<b>13</b>	<b>22%</b>



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## Types of Appeals

2006/2007

<b>ex-parte</b>	<b>32%</b>
<b>opposition</b>	<b>58%</b>
<b>invalidity</b>	<b>5%</b>
<b>designs</b>	<b>2%</b>
<b>Madrid Protocol</b>	<b>2%</b>
<b>Recordals</b>	<b>1%</b>



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## Rate of appeals according to the type of OHIM decision

2006/2007

<b>ex-parte</b>	<b>18%</b>
<b>opposition</b>	<b>20%</b>
<b>annulation</b>	<b>44%</b>



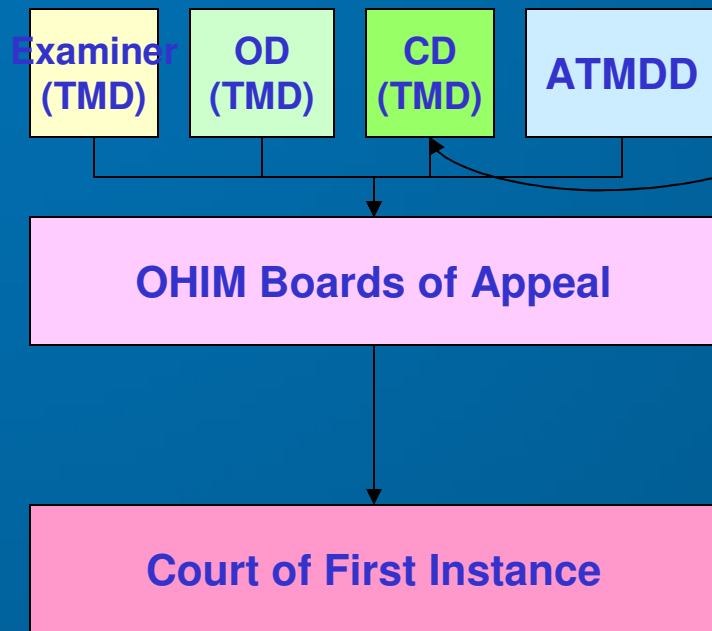
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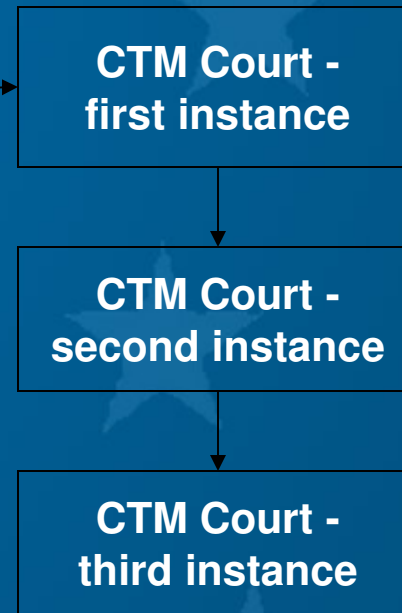
# Successive appeals for CTMs



## OHIM



## Infringement Proceedings



Preliminary ruling



# **Actions before the Court of First Instance (and subsequent appeals before the Court of Justice)**



Specific form of action for annulment provided for by Article 63 of the Community Trade Mark Regulation (CTMR) and governed by special provisions in the Rules of Procedure of the Court of First Instance (RPCFI).

Action should be brought before the Court of First Instance (CFI) and appeals against CFI judgments should be brought before the Court of Justice.

Similarities with ordinary actions for annulment [system provided for by Art. 229 (ex 172) and Art. 230 (ex 173) of the EC treaty]:



# Similarities with ordinary actions for annulment



- grounds of action:
  - lack of competence;
  - infringement of an essential procedural requirement;
  - infringement of the Treaty, of the CTMR or of any rule of law relating to their application;
  - misuse of power;
- time limit for bringing the action (within two months of the date of notification of the decision of the Board of Appeal);
- the Office is required to take the necessary measures to comply with the judgment of the Court of Justice.



# Similarities with ordinary actions for annulment



- Representation:

A lawyer-member of the bar of a Member State.  
What about patent attorneys?

- Oral procedure:

- Court of First Instance:
- Court of Justice (appeal):

will always hold an hearing;  
may decide not to hold an hearing,  
unless one of the parties sets out the reasons for which he wishes to be heard.



## Differences with ordinary actions for annulment



- The action is brought against decisions of the OHIM Boards of Appeal.
- The contested decision of the Boards of Appeal does not take effect as long as the CFI has not rejected the action (Article 62 (5) CTMR).
- The action is brought by parties before the Boards of Appeal, in so far as they are adversely affected by the decision.

The Office cannot bring an action in front of the CFI since the Boards of Appeal's decision is the 'last word' of the Office in a specific case; it may, where appropriate, bring an appeal against CFI judgments before the Court of Justice.



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## Differences with ordinary actions for annulment



- *Inter partes* cases: the position of interveners is improved (Article 134 of the Rules of Procedure of the CFI).
- The CFI has the power to annul or to alter the contested decision but it will only consider claims examined by the Office
- The parties' pleadings may not change the subject-matter of the proceeding before the Board of Appeal [Article 135 (4) of the Rules of Procedure of the CFI];
- A shorter written procedure, normally limited to the application and the response: replies and rejoinders are only exceptionally authorised [Article 135 (2) of the Rules of Procedure of the CFI];



## Appeal before the Boards of Appeal

Preliminary administrative action: last word of the Office.

Composition: Chairman of the Boards + 4 Boards  
Each Board: 1 Chairman + 2 members;  
2 additional members;  
Appointed by the Council for a term of 5 years

OHIM (Board of Appeal) decides.

Appeal: two steps process (notice of appeal: 2 months and written statement: 4 months); fee (800 €).

Interlocutory revision.

Decision: dismisses, exercises the power of the first instance department or remits the case to it.

Representation: lawyer not mandatory.

Written procedure: oral hearing exceptional.

Language: the same as that used in the previous proceedings.



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## Action before the Court of First Instance

Jurisdictional review of the decision of the Office.

Composition: 25 judges (incl. one president)

Cases heard by 5 Chambers (3 judges)

Appointed by the Member States for a term of 6 years.

(Court of Justice: 25 judges + 8 advocates general)

OHIM is a party to the case (defendant: may not attack its own decision).

Action: 2 months to lodge the application; no fee.

No.

Judgment: dismisses, annuls or alters.

Representation: lawyer mandatory (or agents).

Written and oral procedure: always an oral hearing.

Language: specific rules (ex parte / inter partes).



# Preliminary references to the Court of Justice



**CONFLICTS BETWEEN NATIONAL  
TRADE MARKS  
BEFORE A NATIONAL JUDGE**

**PRELIMINARY REFERENCE**

**LUXEMBOURG  
COURT OF JUSTICE**

**First Trade Mark Directive 89/104 to  
approximate the laws of the Member  
States relating to trade marks**



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# Preliminary references to the Court of Justice



In application of art. 234 (ex 177) of the EC Treaty, any court or tribunal of a Member State **may**, if it considers that a decision is **necessary** to enable it to give judgment, request a preliminary ruling:

- on the interpretation of the Treaty;
- on the validity and interpretation of acts of the institution.

Where there is no judicial remedy under national law against the decisions of that national court or tribunal, it has the **obligation** to bring the matter before the Court of Justice.



# The future of the EU jurisdictional system for trade mark cases



*(Art. 220, 225 and 225a of the EC Treaty as modified by the Treaty of Nice)*

- The statute of the Court may entrust to the Court of First Instance the jurisdiction to hear preliminary rulings in certain specific matters.
- The Council may create judicial panels ‘attached to the Court of First Instance’ to hear at first instance certain categories of actions in specific matters (e.g. in the area of intellectual property).

Decision of the judicial panels may be appealed before the Court of First Instance (on points of law only or, when provided for in the decision establishing the panel, also on matters of fact).



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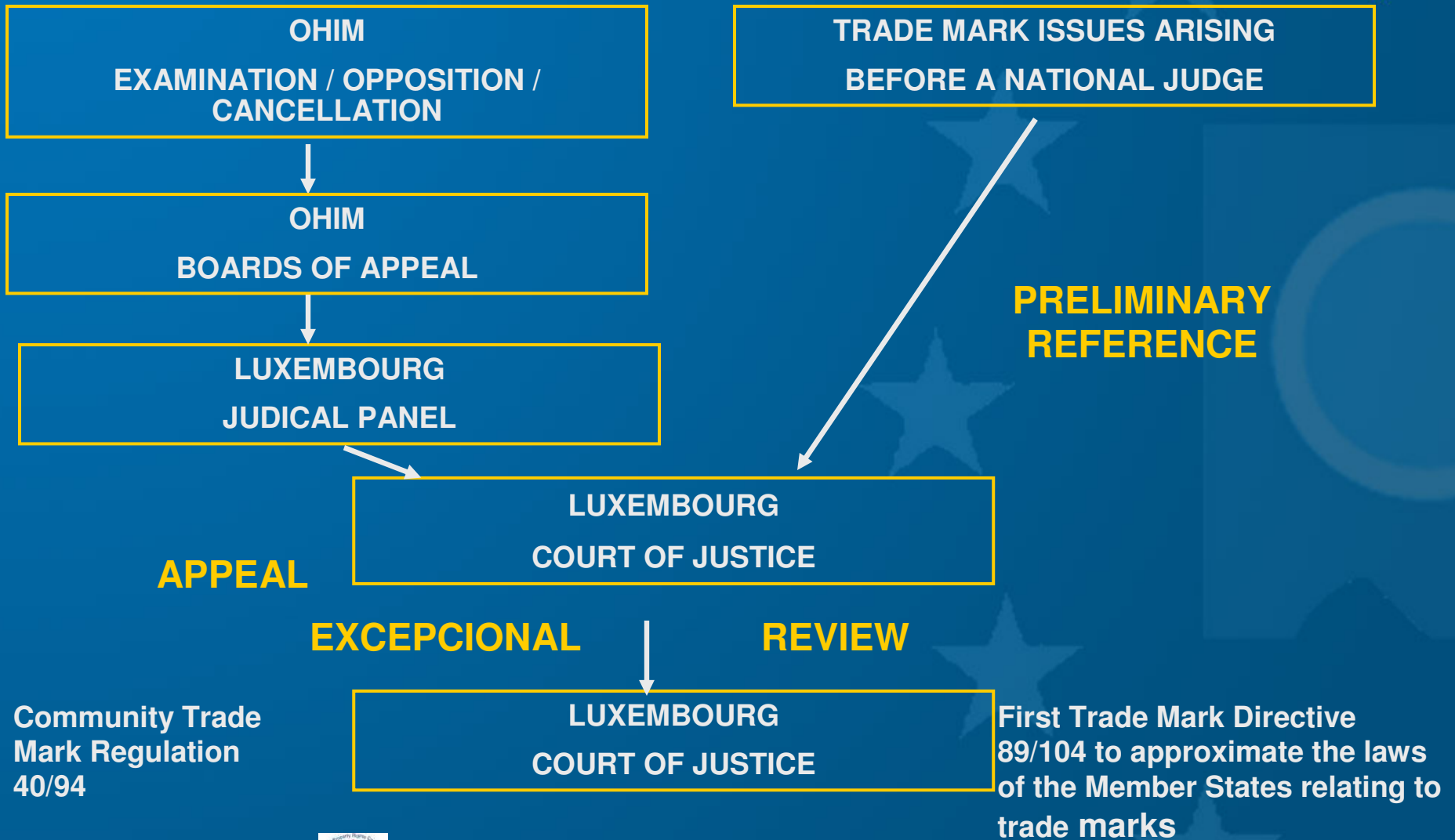


- Decisions of the Court of First Instance
  - on questions referred for a preliminary ruling;
  - on actions brought against decisions of the judicial panels;

may exceptionally be subject to review by the Court of Justice where there is a serious risk of the unity or consistency of Community law being affected.
- In a unilateral declaration annexed to the Treaty of Nice, Luxembourg accepted “that the Boards of Appeal will remain in Alicante even if they become judicial panels”.



# The future system



# Particularities of the procedure before the Court of First Instance - Origin



## **Article 131 CTMR: Independence of the members of the Boards of Appeal:**

- Members of BoA are not bound by any instructions
- Members of BoA may not be part of ED, OD, ATM, LD or CD

## **Article 133 (2) Rules of Procedure CFI**

The application shall be served on the Office, as defendant, and on the parties to the proceedings before the BoA other than the applicant.



# The Role of the Parties



- Office is respondent and not defendant; amicus curiae?
- Party before the BoA may lose its status as a party to the proceedings
- Can the Office reach a friendly settlement?
- Is the Office obliged to defend the decision of the BoA?



# Intervention - Article 134 Rules of Procedure



- The parties to the proceedings before the BoA other than the applicant may participate as interveners.
- The interveners have the same procedural rights as the main parties  
(Article 134 versus Article 115 of the Rules of Procedure)
- Does this principle also apply to successors in title?
- Rights of the other party in appeal proceedings before the ECJ?
- Costs of the proceedings?



# Subject matter of the proceedings



- Article 135 (4) of the Rules of Proceedings:  
The parties' pleadings may not change the subject-matter of the proceedings before the BoA.
- Principle of separation of powers
- Limitation of the list of goods and services
- Partial withdrawal of the application



# Discontinuance and “no need to adjudicate”



- Withdrawal of the application/opposition following a friendly settlement during the Court proceedings
- Two procedural options:
  - Withdrawal of the application (discontinuance Article 99 Rules of Procedure) or
  - Declaration that the Action has become devoid of purpose (Article 113 Rules of Procedure).
- Consequences for decision on costs
- Impact on the Board of Appeal decision



# Procedural bonus issue: Applicability of Article 111 of the Rules of Procedure



**Action manifestly lacks any foundation in law**

**Decision of the Court by reasoned order; no hearing**

**Can the Office formally request a Article 111 declaration?**





**Thank you for your attention!**

Further question can be addressed to: [arnaud.folliard@oami.europa.eu](mailto:arnaud.folliard@oami.europa.eu).



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