

**Appealing from OHIM  
to the General Court & Court of Justice**

**Michael Edenborough QC  
Thursday, 2 October 2014  
HGF**

serie court

# The Contested Decision

- first instance decision, *e.g.* examination, opposition or cancellation division of OHIM
- second instance decision of the BoA
- since July 2006, a decision of the Grand Board of Appeal
- the appeal is from the (G)BoA's decision (the "Contested Decision"), not the first instance decision

# Period in which to make the application

- the Contested Decision is now notified to the parties by fax only (Decision of the Presidium, 10<sup>th</sup> May 2006).
- 2 months from notification, plus 10 days due to distance (GC Rules a102(2)), plus “closed days”, for example:
  - decision dated the 24<sup>th</sup> Jul 06
  - decision faxed (only) 28<sup>th</sup> Jul 06 (and so notified on this day)
  - two months expire 28<sup>th</sup> Sep 06 (29<sup>th</sup> Jul to 28<sup>th</sup> Sept)
  - 10 days until 8<sup>th</sup> Oct 06 (Sunday) (29<sup>th</sup> Sep to 8<sup>th</sup> Oct, incl.)
  - and so, last day to file is Monday, 9<sup>th</sup> Oct 06 (2359 hrs Lux. time)
- time limits strictly enforced (*Bell & Ross* Case C-426/10 P).
- [*cf* EPO’s practice: T-2056/08: 10 days + 2 months]

# Application Notice

- the Parties
- summary of Pleas in Law and Main Arguments
- history of the Application (Background)
- the Order sought (include costs if sought)
- Summary of Grounds
- Submissions

# Formalities

- General Court Rules of Procedure, and Practice Direction
- various Notes for the Guidance of Counsel
- Instructions to the Registrar
- signature (at the end), by a “lawyer”
  - not a TM attorney (T-14/04)
  - nor PA Litigator (T-487/07)
  - *sed quaere* a TM&D litigator (C-59/09)
- certified copies (by the lawyer) within 10 days

# e-Curia

- since 11<sup>th</sup> October 2011, an electronic filing system has operated
- need to register
- avoids the need to sign the document, to send the originals or to file certified copies
- more convenient and cheaper
- issues with access / interface

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# Procedural Documents

- Language of the proceedings
- Certificate that the representative is authorised to practise before a Court of the Member State
- Proof of the existence in law of the applicant
- Power of Attorney
- Proof that the PoA has been properly conferred

# Response(s)

- OHIM is the Respondent, even in *inter partes* cases
- Response from OHIM and (optionally) from the intervener
- the response time period is 2 months: it can be extended, but the application has to be made before the time period expires and supported by reasons/evidence

# Further Interim Matters

- normally, only one round of submissions for each party
- exceptionally
  - allowed a reply and rejoinder
  - in response to question(s) from the court, further submissions (and evidence)
- Rapporteur's report sent out for information (not comment now) a few weeks before the hearing

# Oral Hearing

- no need to attend
- but good opportunity to elaborate one's case and to deal with queries from the court
- needs an application for a hearing
- v. short opening speeches (10 or 15 minutes)
- questions from the court (often difficult and many)
- Intervener sits with OHIM (even if OHIM is not supporting the (G)BoA's decision)

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# Afterwards

- judgment (notified in advance, no need to attend)
- appeal to the CJEU, but only on a point of law (strictly enforced – summary dismissal (*Tresplain* Case C-76/11 P)
  - Article 60 SoCJ – no automatic stay
  - Articles 64 and 65 of the CTMR
  - settlement issues – devoid of purpose
- costs

# Michael Edenborough QC

## ■ Contact Details:

- Serle Court, 6 New Square, Lincoln's Inn, WC2A 3QS
- (t) 020 7242 6105
- (e) MEdenborough@SerleCourt.co.uk

## ■ MA (Natural Sciences) (Cantab), DPhil (Biophysics) (Oxon)

- All areas of IP law and practice, in particular trade marks, patents, copyright and designs. Over a 100 reported cases since 2000, of which two thirds were appeals or judicial reviews.
- Appeared often before the General Court and Court of Justice (Luxembourg) in appeals from OHIM and Article 267 references (over 40 cases in all), and in the European Patent Office (Legal and Technical BoA and Opposition Division). Appeared in over 275 matters before the Registry, and over 60 appeals before the Appointed Person.
- Acted for the Comptroller-General of Patents, the Registrar of Trade Marks, the UK government, ITMA, CIPA and AIPPI UK Group.

# IP Juniors at Serle Court



Dan McCourt Fritz (2007)



Gareth Tilley (2007)



Thomas Elias (2008)



Sophie Holcombe (2009)



Adil Mohamedbhai (2010)



Adrian de Froment (2013)