

Functional continuity

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Legal basis

Article 64(1) EUTMR – Decisions in respect of appeals

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.

Legal basis

Article 76 EUTMR – Examination of the facts by the Office of its own motion

- (1) 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.
- (2) The Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

Case law

8.07.1999, T-163/98, Baby-Dry, §§ 38, 39, 43

There is continuity in terms of their functions between the examiner and the Boards of Appeal.

There is a close interconnection between their duties (appeal to be filed 'at the Office', interlocutory revision, automatic remittal to the Board if not rectified).

The Board enjoys the same powers in determining the appeal as the examiner and [...] should have either ruled on the substance of that issue or remitted the matter to the examiner.

Case law

12.12.2002, T-63/01, Soap bar shape, §§ 21 - 23

There is continuity in terms of their functions between the various departments of the Office and the Boards of Appeal.

An action before the Board of Appeal forms part of the administrative registration procedure following an interlocutory revision.

The Board of Appeals cannot be classified as tribunals. The applicant cannot rely on a right to a fair hearing before the Boards of Appeal.

Case law

23.09.2003, T-308/01, Kleencare, §§ 25 – 31

The outcome of the appeal depends on whether or not a new decision with the same operative part as the decision under appeal may be lawfully adopted at the time of the appeal ruling.

The Board of Appeal is required to base its decision on all the matters of fact and law which the party concerned introduced in the first-instance proceedings or, subject to Article 76(2), in the appeal.

Consequences

Ex-parte proceedings

- A new, comprehensive examination of the merits of the case, in terms of both law and fact
- New facts, evidence, arguments on appeal to be taken into account

Extent of the examination limited by

- The absolute grounds of refusal relied upon by the examiner
- The scope of the appeal

Consequences

Inter-partes proceedings

- A new, comprehensive examination of the merits of the case, in terms of both law and fact
- New facts, evidence, arguments subject to Article 76(2) EUTMR

Extent of the examination of the appeal is limited by

- The grounds of opposition/cancellation relied upon by the party concerned
- The scope of the appeal

Conclusions

- Functional continuity follows directly from the provisions of the EUTMR
- Functional continuity only refers to the scope of the re-examination to be performed by the Boards
- Functional continuity is not a criterion to qualify the type of activity performed by the Boards of Appeal as administrative or judicial