

OPTIMIZATION of *IP* PROCEEDINGS before the GC: EFFECTIVENESS by means of PROCEDURAL GUARANTEES



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I. NEW RULES OF PROCEDURE

- Extension of provisions relating to a **single Judge** (Art. 29.1 a) RP).
 - lack of difficulty of the questions of law or facts
 - limited importance of the case
 - absence of other special circumstances
- Simplification of the rules determining the **language** (Art. 45.4 RP).
 - If disagreement: language of *BA* Decision
 - No possibility.
- **Intervener status** (Art. 173.2 RP).
 - Provisional status (presenting a document) turns definitive-compulsory (C-35/14 *Enercon v Gamesa Eólica*) when the response is lodged.
 - Observations on 'stay at proceedings', 'discontinuance' or 'no need to adjudicate' (T-49/10 *Footwear v OHIM – Reno Schuhcentrum*)
 - Cost clarification

- Possibility of **replacement of the party** (Arts. 174-176 RP).

[T-310/04, Ferrero Deutschland v OHMI – Cornu (*FERRO*);

T-369/10 You-Q v OHMI – Apple Corps (*BEATLE*);

T-94/02 Boss v OHMI – Delta Biomichania Pagatou (*Boss*)]

- **One single round of pleadings** (Art. 181 RP) but remaining the possibility of **requesting a hearing** (Title II RP).

- The **cross-claim** must be by **separate document** for (Art. 182 RP)

II. PROCEDURAL GUARANTEES

■ **Obligation to state reasons (Art. 75.1 CTMR 2015/2424).**

1. «Obligation to state reasons (art. 296 TFUE) clearly and unequivocally (... *to ascertain & to allow review*)». «The BA is not obliged to take a view on every argument» (T-778/14, Ugly v OHIM – Group Lottuss (*COYOTE UGLY*), 3-3-2016; p. 66-67).
2. «State reasons is a matter of public policy that could be stated by Court at its own motion» (T-62/14 BR IP Holder v OHIM – Greyleg Investments (*HOKEY POKEY*), 21-1-2016; pp.31-40).
3. «Reasons include its wording, its context and the whole legal rules governing the matter». «Need to indicate the grounds for refusal (absolute-relative) and provisions and facts from which this is drawn» (T-68/13 Novartis v OHIM (*CARE TO CARE*) 23-1-2014; pp. 27-28).
4. «When validating a previous decision, this judgement and its motivation, constitute the ‘context of the BA’ decision’ known by parties». «The reasoning is sufficient if it refers expressly to another sent document» . «If trade-mark devoid of ‘intrinsic distinctive character’ (drawn from analysis of facts arising from practical experience) the BA is not obliged to give examples» (T-109/08 Freixenet v OHIM (*Shape of a white émerisée bottle*) 27-4-2010; p. 47-48 & 17).
5. «To state reasons [*procedural*] is different from the well-founded of the reasoning [*substantive*]» (T-816/14 Tayto Group v OHIM – MIP Metro (*REAL HAND COOKED*), 24-2-2016; p. 91).
6. «Non-compliance cannot be regularized if the party becomes aware during the proceedings». «The possibility of supplementary grounds to complete reasoning, undermine the rights of defence, effective remedy and equality» (T-235/12 CEDC International v OHIM – Underberg (*Shape of a blade of grass in a bottle*) 11-12-2014; pp.71-72).

■ Enforcement: Recent case-law.

A) Not complied:

1. T-382/14, Rintisch v OHIM – Compagnie laitière européenne (*PROTICURD*), 24-9-2015; pp.57 & 60.
2. T-62/14 BR IP Holder v OHIM – Greyleg Investments (*HOKEY POKEY*), 21-1-2016; pp. 31-40.
3. T-674/13, Gugler France v OHIM – Gugler (*GUGLER*), 28-1-2016; pp. 52-72.
4. T- 501/13 Karl-May-Verlag GmbH v OHMI-Constantin Film Production GmbH of 18-3-2016.

A) Complied:

1. T-687/14 Novomatic v OHIM – Simba Toys (*African SIMBA*); 28-1-2016; p. 24.
2. T-816/14 Tayto Group v OHIM – MIP Metro (*REAL HAND COOKED*); 24-2-2016; 93.
3. Other recent Case-Law
 - T-778/14 Ugly v OHIM – Group Lottuss (*COYOTE UGLY*) of 3-3-2016 pp. 66-72.
 - T-846/14 Spokey v OHIM – Leder Jaeger (*SPOKeY*) of 21-1-2016, pp. 17-22.
 - T-763/14 Soprema v OHIM – Sopro Bauchemie (*SOPRAPUR*) of 25-11-2015, pp.20-25

■ «*Audi et alteram partem*» rule:

1. «The principle that the parties should be heard (part of the right to a fair trial of art. 47 EUFRCh) applies to any procedure which may result in a decision ... affecting a person's interests». «It comprises the right to be apprised of the documents produced and observations made to the Court by the other party, or matters raised by those courts of their own motion and to discuss them; ...the right to a fair hearing; ...the right to be apprised of, and to be able to debate and be heard on the matters of fact and of law which will determine the outcome» (C-530/12 P, OHIM v National Lottery Commission of 27-3-2014, pp. 52-53-54).
2. «EU judicature could raise of its own motion a ground involving a question of public policy...in the light of the rule that the parties should be heard... inviting the parties to submit their observations on that ground» (T-674/13 Gugler France v OHIM – Gugler (GUGLER), of 28-1-2016; p. 54).
3. «An applicant for a trade mark against whom OHIM relies on such well-known facts may challenge their accuracy before GC and there is therefore no infringement of the rights of defense» (T-618/14 Grupo Bimbo v OHIM (Shape of a mexican'tortilla) of 29-6-2015; p. 28).
4. «The opinion surveys do not constitute facts which are well known...able of being taken into account by OHIM of its own motion» (T-85/08 Exalation v OHIM (Vektor-Lycopin) of 9-7-2010, p.29).
«The results of internet research...are not ...that well-known facts» (T-222/09 Ineos Healthcare v OHIM Teva Pharmaceutical Industries (ALPHAREN) of 9-2-2011, pp.30-32).

Facts arising from practical experience generally acquired from the marketing of general consumer goods which are likely to be known by anyone (T-366/03 and T-235/04 Land Oberösterreich v Commission of 5-10-2005).

■ Enforcement: Recent case-law:

A) Not complied:

1. C-530/12 P, OHIM v National Lottery Commission, 27 March 2014, pp. 52-59.

B. Complied:

1. T-377/13 Ultra air v OHIM – Donaldson Filtration Deutschland (*ultra.air ultrafilter*), 9-3-2015, pp.30-38

■ Right to be heard:

1. «Decisions are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments» (**T-715/13** Lidl Stiftung v OHIM – Horno del Espinar (*Castello*) of 5-5-2015, p. 68).
2. «Decision only on matters of fact or of law on which the parties have been able to set out their views...BA assembles of its own motion facts intended to serve as a basis for its decision, ...obligation to notify the parties ... the parties may submit their views thereon» (**C-447/02 P** KWS Saat v OHIM, of 21-10-2004, pp. 42-43).
3. «It extends to all the factual and legal material which forms the basis for the decision, but not to the final position which the authority intends to adopt » (**T-379/13** in Innovation First v OHIM (NANO) of 10-2-2015, p.14)
4. «The fact that the applicant has not put forward arguments on a point which is not consider as an independent reason for the contested decision, but form part of the BA's reasoning, does not imply breach» (**T-106/06** Demp v OHIM – Bau How (BAU HOW) of 23-1-2008, p.17).
5. «The fact that the examiner did not consider an applicant's argument in its decision can not constitute a breach» (**T-588/14** Mechadyne International v OHIM (FlexValve) of 23-9-2015, p.14)
6. «The rights of the defence are infringed by reason of a procedural irregularity only if it has had a concrete effect on the ability of the person concerned to defend himself... the proceedings at issue could have resulted in a different outcome if the person concerned had been better able to defend himself» (**T-816/14** Tayto Group v OHIM – MIP Metro (*REAL HAND COOKED*) of 24-2-2016; p. 33).

■ Enforcement: Recent case-law:

A) Not complied:

1. T-715/13 Lidl Stiftung v OHIM – Horno del Espinar (*Castello*) of 5-5-2015, pp. 68-88.

B. Complied:

1. T-631/14 Roland v OHIM – Louboutin (*Red nuance on top the shoe sole*) of 16-7-2015, p.20.
2. T-137/14 I Castellani v OHIM – Chomarar (Représentation d'un cercle) of 23-10-2015, pp.21-25

■ Evidence submitted out of time:

1. «According to art. 76.2 TMR OHIM may disregard facts or evidence which are not submitted in due time» (p. 42), however, «the submission of facts and evidence by the parties remains possible after the expiry of the time-limits and OHIM has a wide discretion to decide, giving reasons» (p.43) «OHIM could take into account such facts and evidence, 1st) if the material is relevant and 2nd) according to the stage of the proceedings» (p. 44).

Before the *BA* there is no specific rule for the «submisssion of facts and evidence, but only to the filing of the written statement of appeal with-in the time limit of 4 months» (p.60), «art. 59 TMR cannot be interpreted as a new time limit to submitt facts and evidence in support of his opposition» (p.61) [C-29/05 P OHIM v Kaul, of 13-3-2007, p. 42-44]

2. In opposition and revocation proceedings the submission of the proof of use is subject to strict time-limits: «in order to preserve the effectiveness of Rule 22(1) of Regulation N° 2868/95 that establishes a peremptory time-limit, Art. 74(2) TMR 40/94 must be narrowly construed» (p.47), «that submission of proof of use of the earlier mark after the expiry of the period specified for that purpose results, in principle, in the rejection of the opposition without OHIM having a discretion» (p. 49); «OHIM does not have discretion taking into account of the evidence submitted by the applicant after the time limit» (p.51). [T-86/05 K & L Ruppert Stiftung v OHIM–Lopes de Almeida Cunha, Couto Simões, Lima Jatobá (*CORPO livre*) of 12-12-2007, pp-47-51].
3. «It remains possible to submit evidence of use of the mark in addition to the evidence adduced within the time period set by OHIM under Rule 40(5) of Regulation No 2868/95 after expiry of that time limit and that OHIM is in no way prohibited from taking account of additional evidence which is submitted after that time»[C-610/11 P Centrotherm Systemtechnik v OHIM of 26-9-2013, p. 88].

■ Enforcement: Recent case-law:

A) Complied:

1. Opposition: C-621/11 P New Yorker SHK Jeans (*Fishbone*) v OHIM, of 18-7-2013, pp.28-30.
2. Revocation: C-610/11 P Centrotherm Systemtechnik v OHIM, of 26-9-2013, pp. 86-88
3. T-361/13 Menelaus v OHIM – Garcia Mahiques (*VIGOR*) of 18-11-2015, pp.54-60.
4. T-335/14 Davó Lledó v OHIM – Administradora y Franquicias América and Inversiones Ged (*DoggiS*), of 28-1-2016, pp. 28-40.

A) Not-complied:

1. T-354/14 Comercializadora Eloro v OHIM – Zumex Group (*zumex*), 9-12-2015, pp-69-76.
2. T-645/13 Nezi v OHIM – Etam (*E*) of 15-3-2016, pp121-127.

Thank you for your attention!