

Recent updates from the EUIPO's Boards of Appeal

Session with IP Practitioners

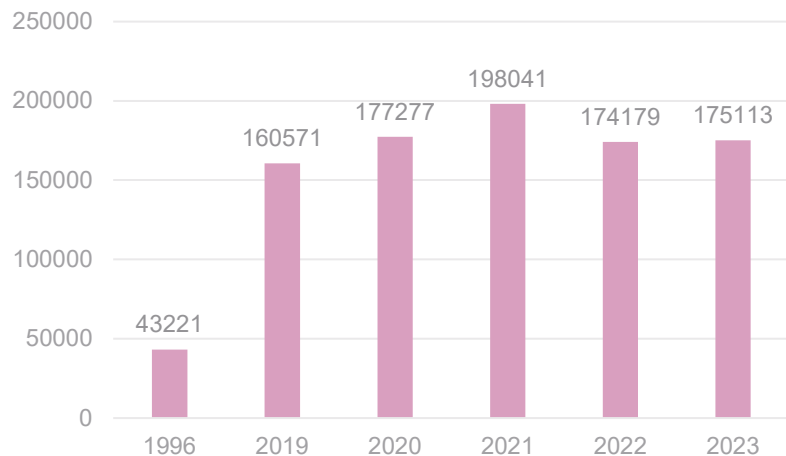
Gordon HUMPHREYS
President of the Boards of Appeal of EUIPO ad interim
11 June 2024, Athens



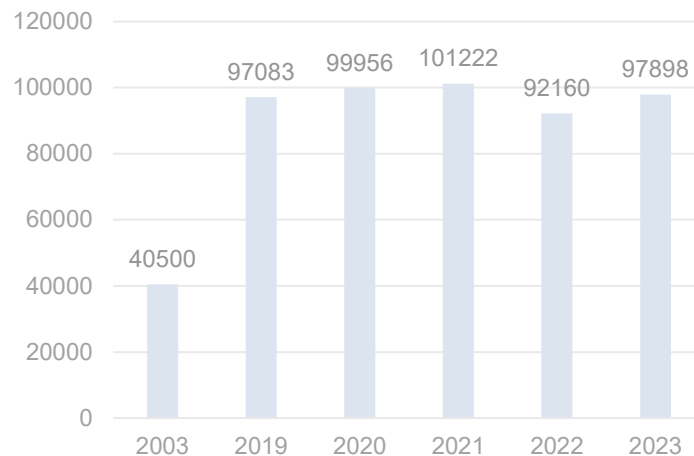


Trademark and Design Systems

EUTM Applications



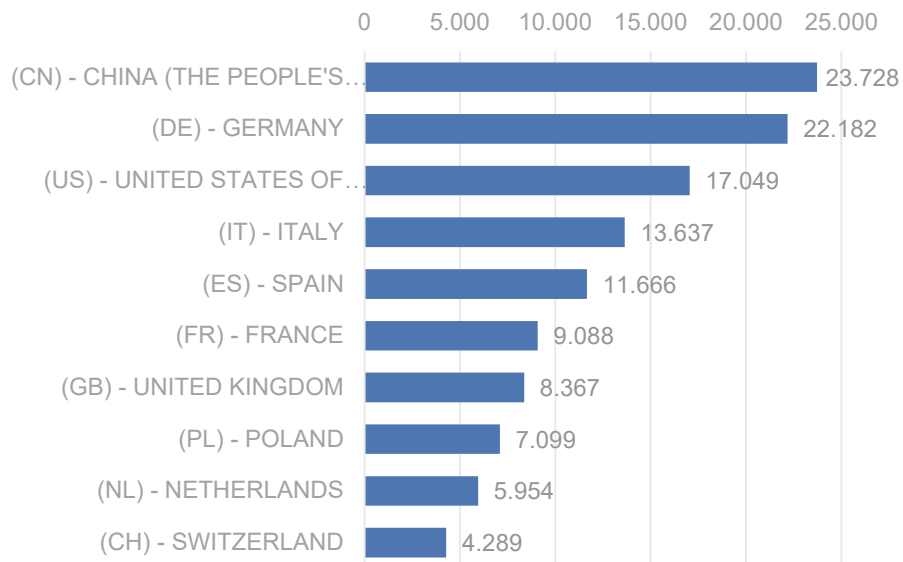
RCD Received



EUTM Applications and Designs - Countries

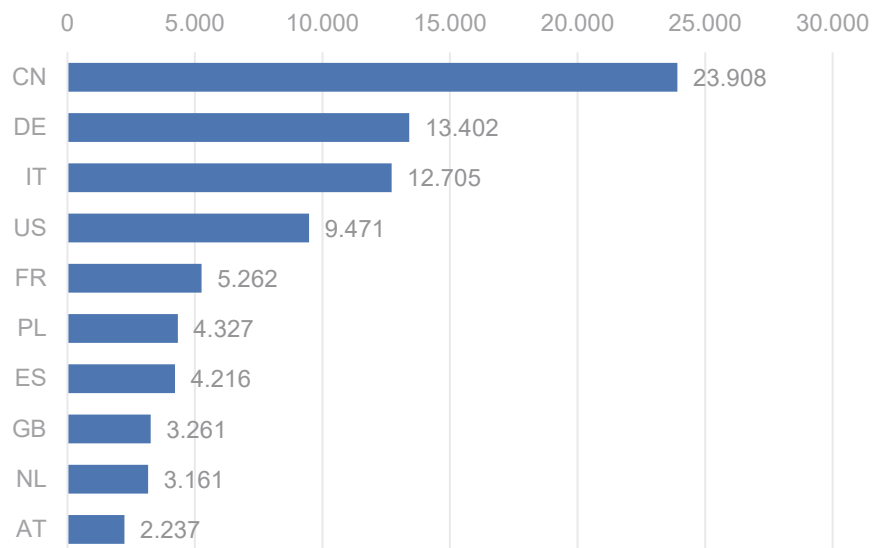
EUTM applications

TOP 10 EUTM 2023

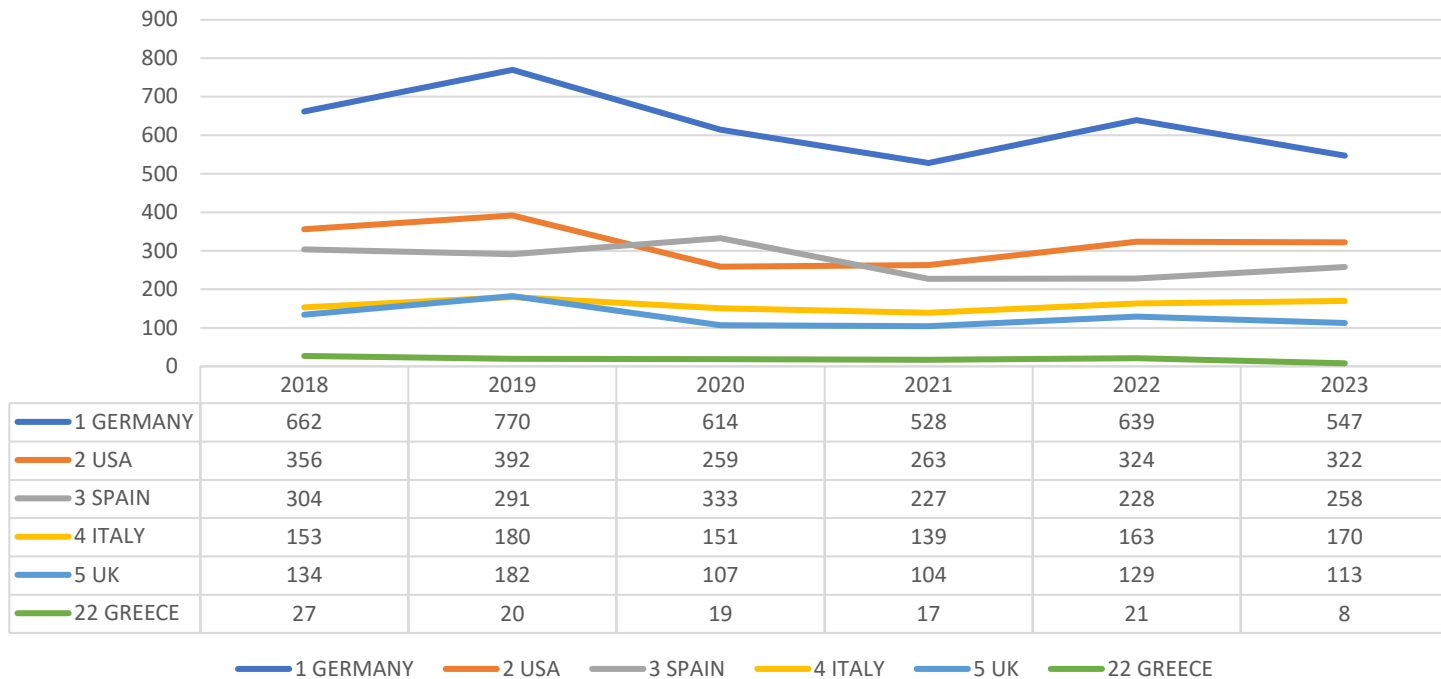


Design Applications

TOP 10 RCD COUNTRY 2023



EUTM appeals by top 5 countries + Greece



WORKLOAD - APPEALS FILED 2023

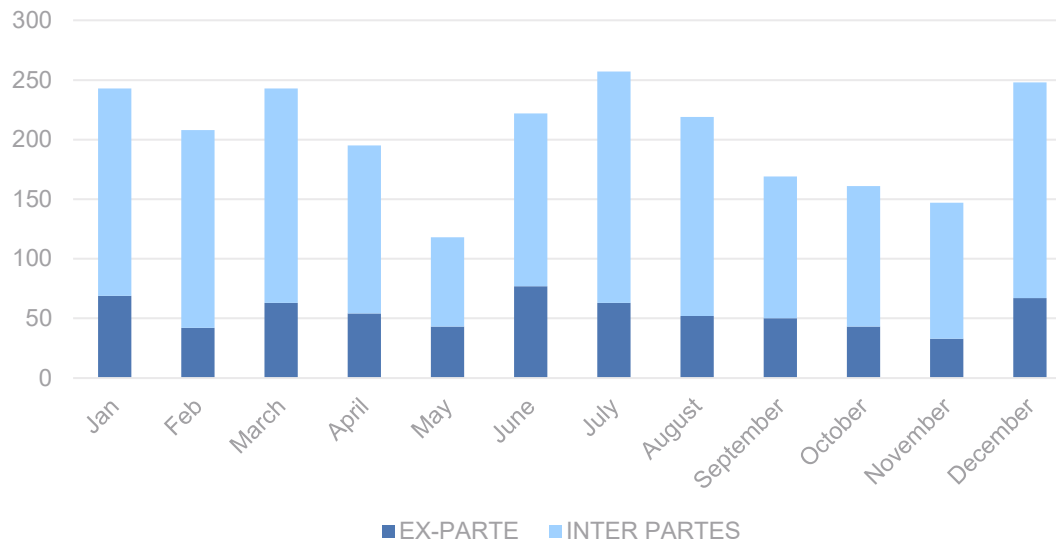
TOTAL FILED: 2535

EX PARTE : 680 (26.82%)

INTER PARTES : 1855 (73.17%)

EUTM : 2423

RCD : 112



WORKLOAD - APPEALS FILED CURRENT YEAR UNTIL MAY 2024

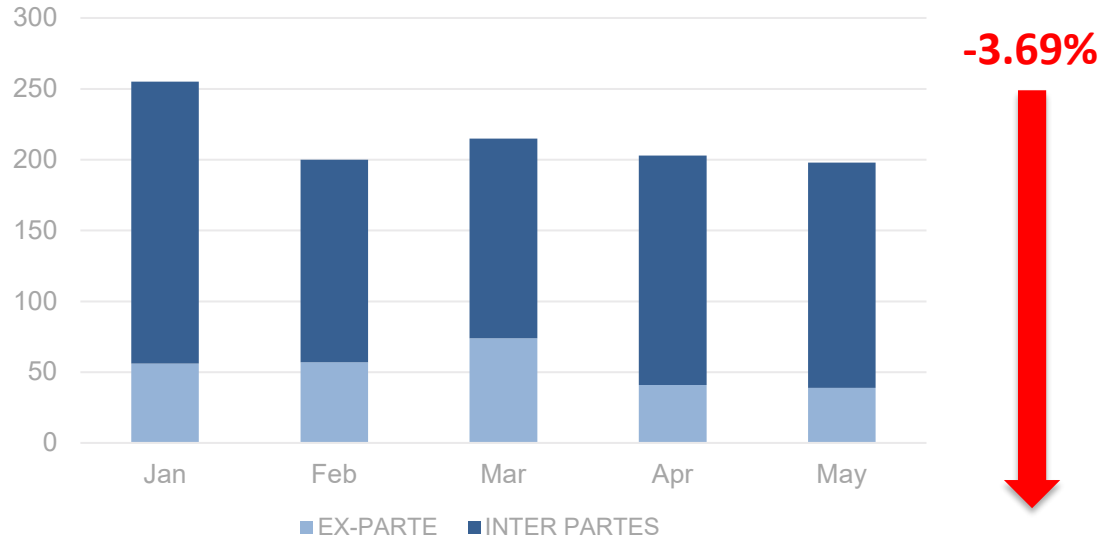
TOTAL FILED: 1.071

EX PARTE : 267 (25%)

INTER PARTES : 804 (75%)

EUTM : 1,032

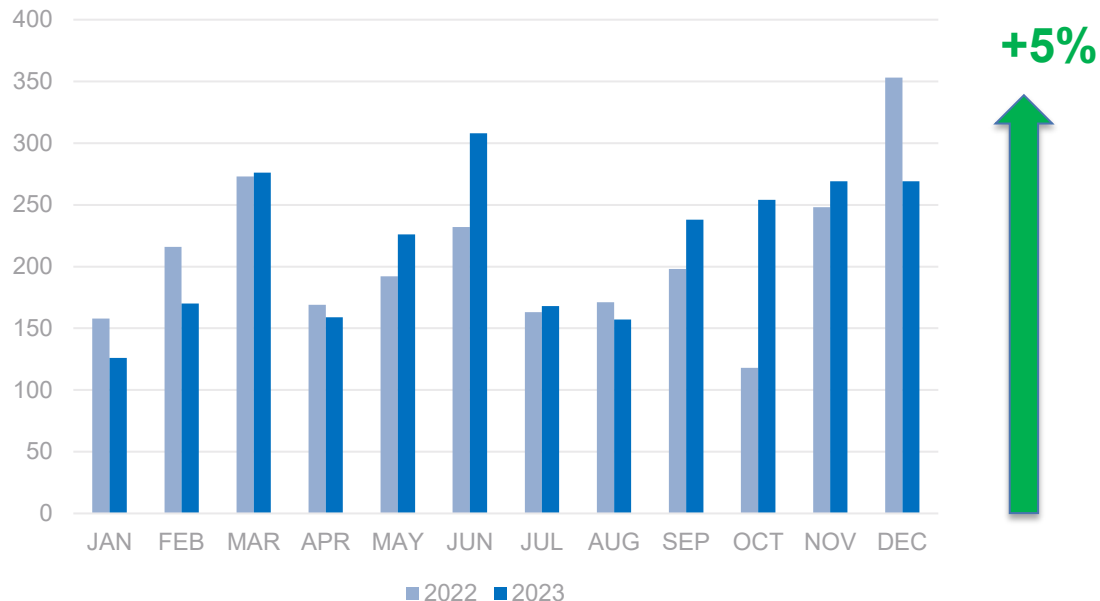
RCD : 39



WORKLOAD – DECISIONS NOTIFIED IN 2023

TOTAL DECISIONS: 2621

- EUTM: **2515**
- RCD: **106**
- EX PARTE: **(746) 28.46%**
- INTER PARTES: **(1875) 71.53%**



WORKLOAD – DECISIONS NOTIFIED IN 2024

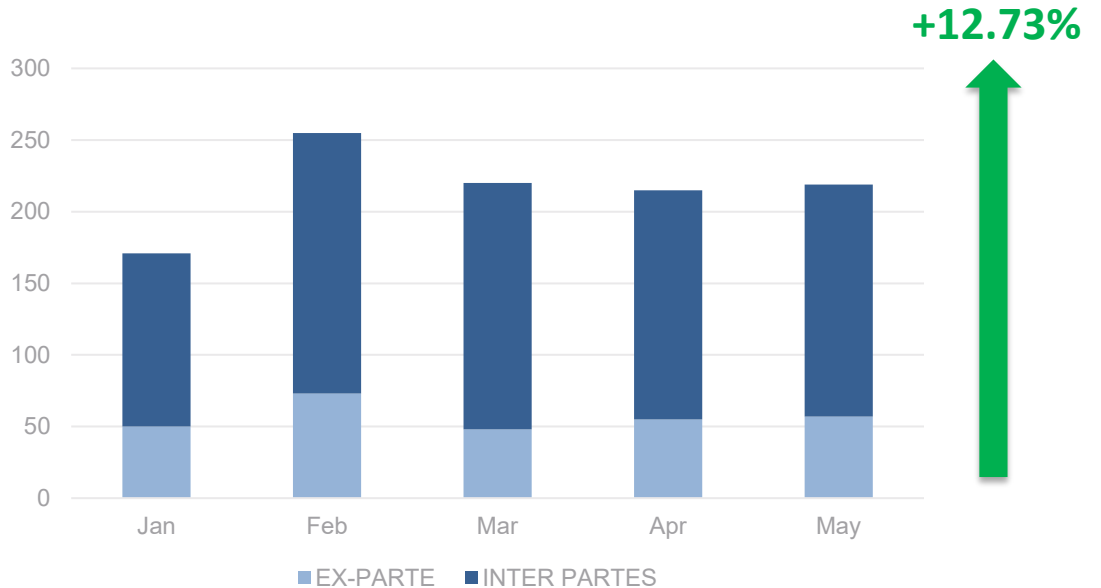
TOTAL DECISIONS: 1080

EX PARTE : 283 (26%)

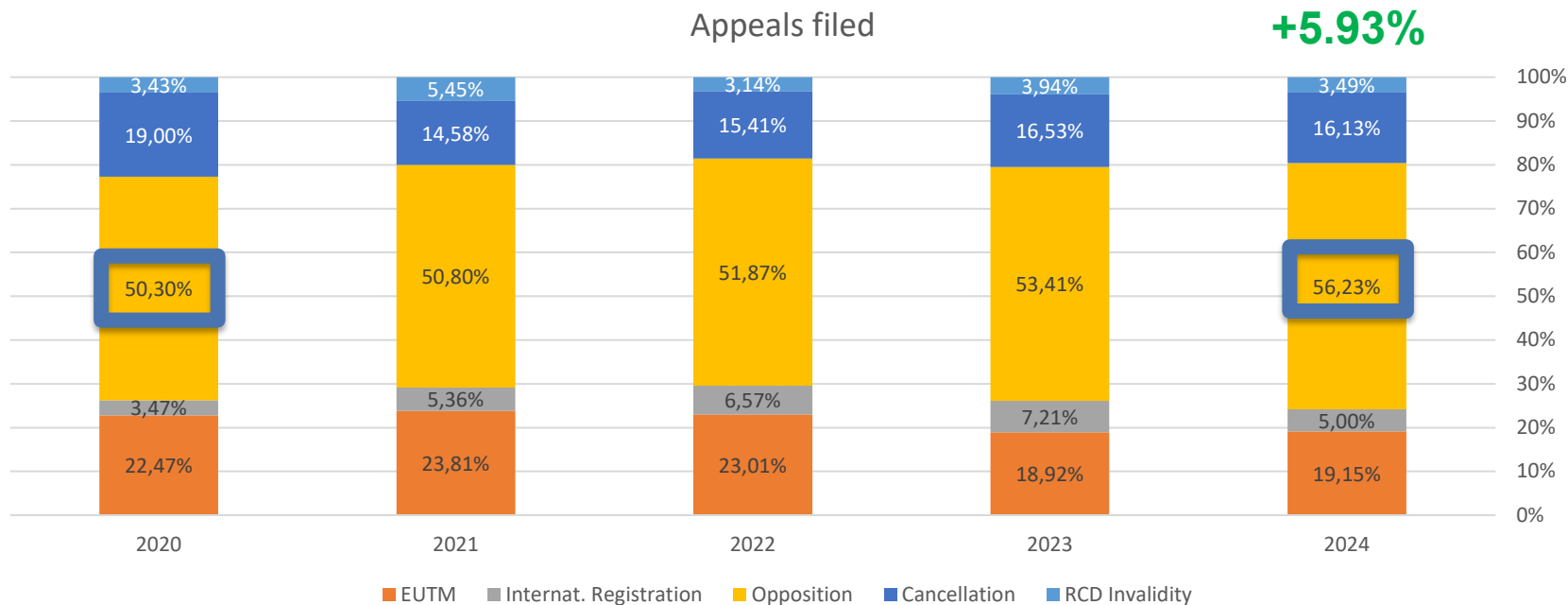
INTER PARTES : 797 (74%)

EUTM : 1042

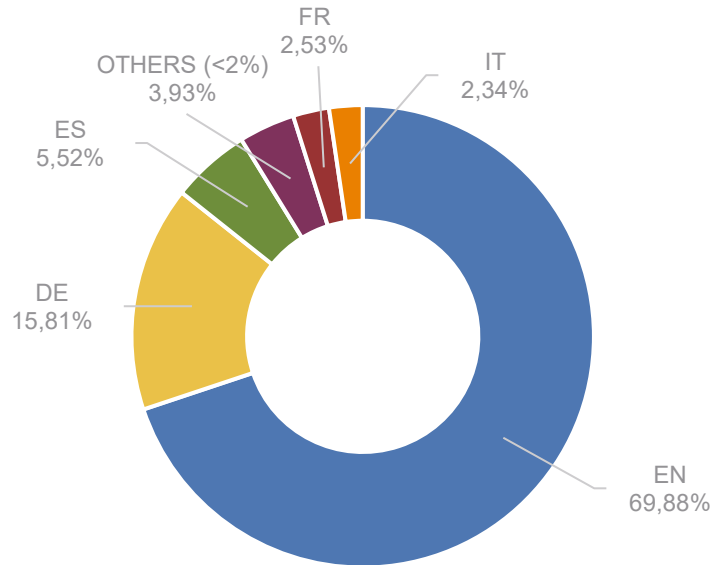
RCD : 38



WORKLOAD – COMPLEXITY OF FILES/TYPE OF PROCEEDINGS



WORKLOAD – APPEALS FILED BY LANGUAGE



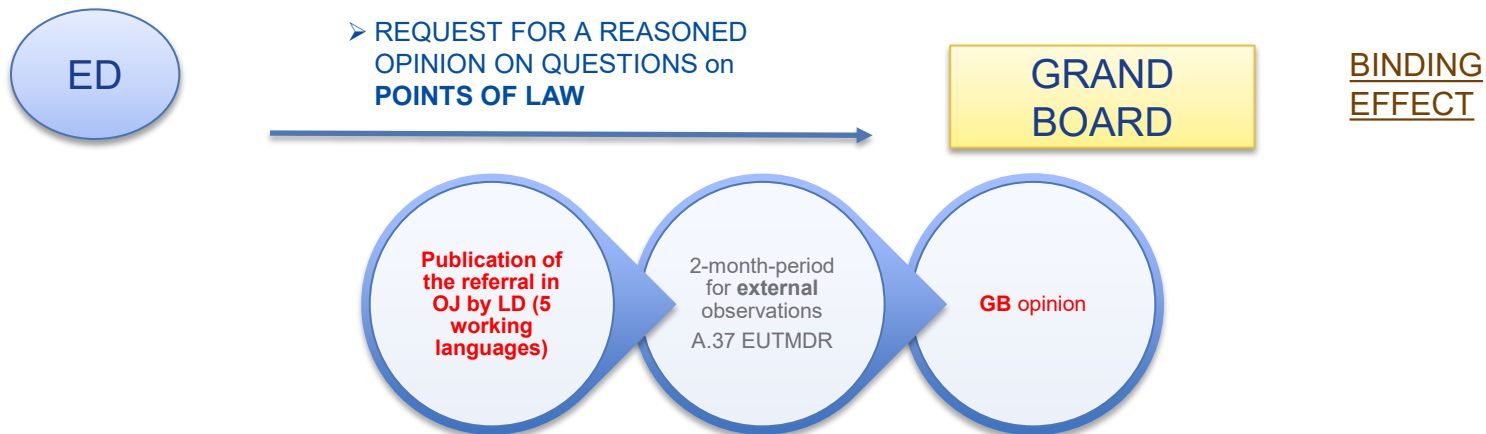
GRAND BOARD OF APPEAL

- 49** Total cases decided
- 5** Decisions in past 12 months
- 6** Cases currently pending

Some topics addressed by recent cases:

- Similarity of non-alcoholic and alcoholic beverages (*Zoraya* [R0964/2020-G](#))
- Admissibility of a conversion request following revocation of the EUTM for non-use (*Zara* [R1508/2019-G](#))
- Freedom of expression in public policy and morality objections (*Covidiot* [R0260/2021-G](#))

ARTICLE 157(4)(I) EUTMR



R 1241/2020-4, 'Nightwatch - First referral of questions by the Executive Director to the 'Grand Board' of Appeal

- Questions referred to the Grand Board by the Executive Director
- Consistency between R331/2006-G, Optima and R1241/2020-4, Nightwatch
- Is conversion possible despite a not-yet-final decision refusing the mark?
- Submissions from national offices and user associations

R 1508/2019-G, ZARA

What is the relationship between revocation for non-use and conversion?

Art 139(2)(a) EUTMR: No conversion where the rights of the proprietor of the EU trade mark have been revoked on the grounds of non-use, unless in the Member State for which conversion is requested the EU trade mark has been put to use which would be considered to be genuine use under the laws of that Member State.

Follows the GC line in T-337/20, Bittorrent, EU:T:2022:406,

R 1508/2019-G, ZARA

Conversion request and revocation are different administrative proceedings.

No Res Judicata because “the applicable legal standards are different”

New evidence can be filed during conversion proceeding.

Not limited to national decisions or national judgments only.

Assessed under the national law on genuine use of the particular Member State for which conversion is requested.

R 0260/2021 G COVIDIOT (fig.)



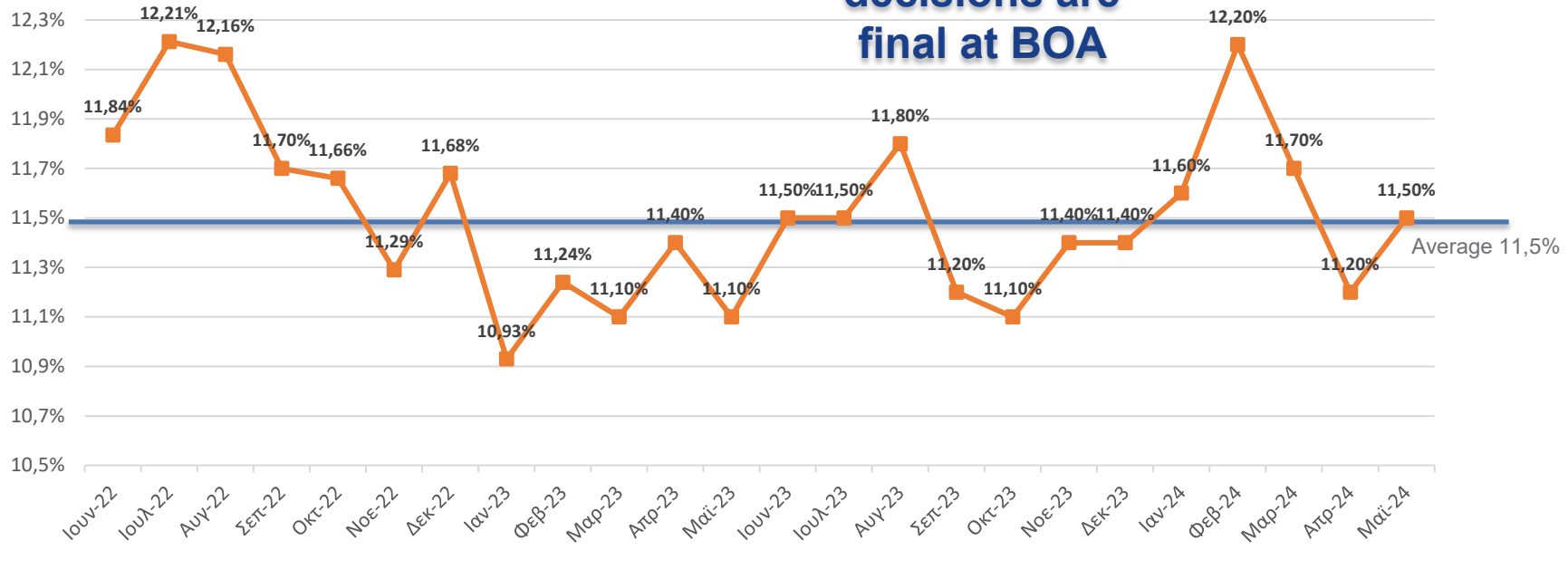
Classes 6, 9 + 28
(metal clamps, game software, mobile apps, board games, toys)
7(1)(f)

Ongoing proceedings

- Questions raised by judgment C-240/18 P, Fack Ju Göhte,
- Right to freedom of expression of the applicant?
- Relevance of commercial nature of trade mark registration?
- Use of a trade mark in political debate?

LITIGATION – APPEAL RATE

**90% of
decisions are
final at BOA**



LITIGATION – ACTIVITIES BEFORE THE EU COURTS LAST 12 MONTHS

2023 LITIGATION ACTIVITIES

GC CASES: **306**

CJEU CASES: **52**

PRELIMINARY RULING: **4**

ORAL HEARINGS: **101**

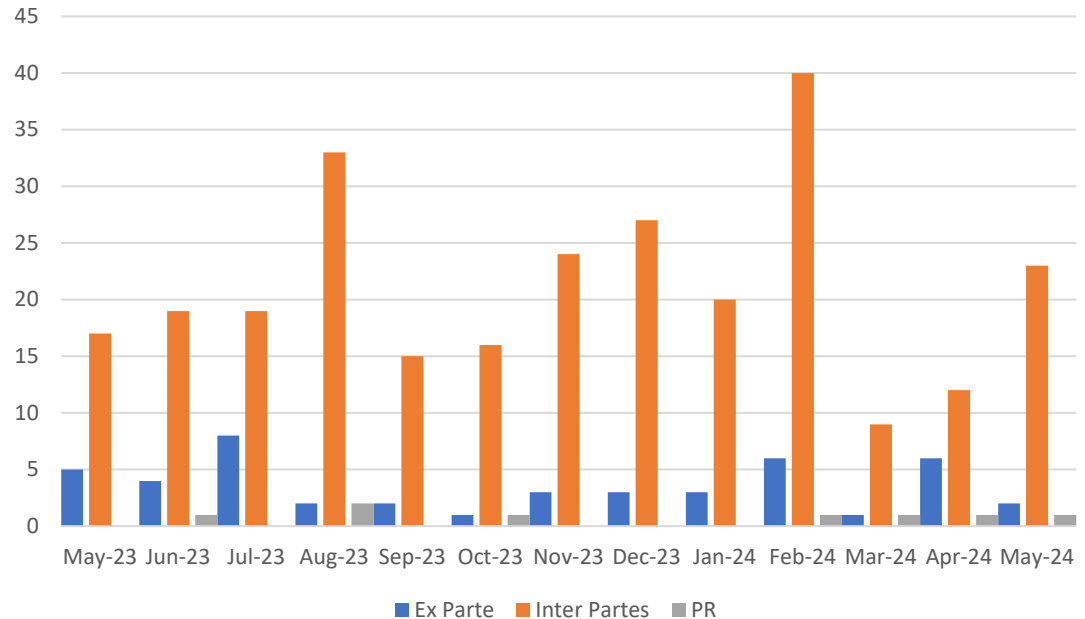
2024 LITIGATION ACTIVITIES

GC CASES: **122**

CJEU CASES: **17**

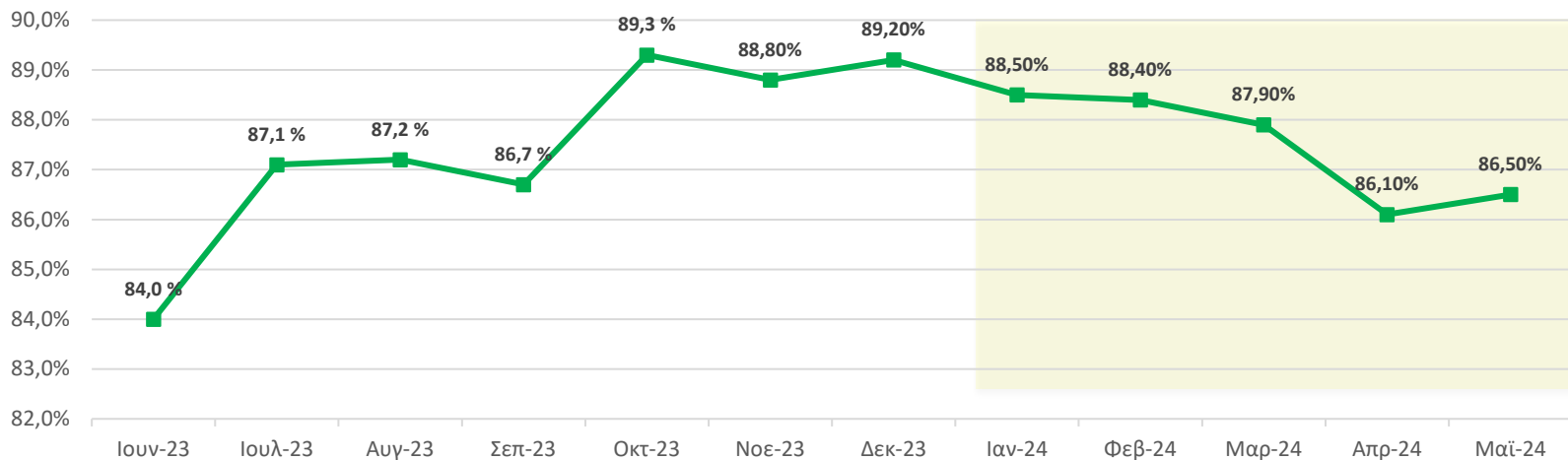
PRELIMINARY RULING: **4**

ORAL HEARINGS: **30**



LITIGATION – CONFIRMATION RATE OF BoA DECISIONS BY GC LAST 12 MONTHS

87.5 % Confirmed



LITIGATION – ACTIVITIES BEFORE THE EU COURTS

Appeals to the Court of Justice admitted to proceed since 2019 = 7

Filed by EUIPO

- 10/12/2021, C-382/21 P, EUIPO v KaiKai: *appeal upheld* (27/02/2024)
- 07/04/2022, C-801/21 P, EUIPO v Indo European Foods (pending)
- 16/11/2022, C-337/22 P, EUIPO v Nowhere (pending)
- 11/07/2023, C 93/23 P, EUIPO v Neoperl (pending)

Filed by parties to EUIPO-proceedings

- 30/01/2023, C-580/22P, bonnanwalt v EUIPO: *appeal upheld* (30/01/2024)
- 18/04/2023, C-751/22 P, Shopify Inc v EUIPO (pending)
- 08/05/2023, C-776/22 P Ughi e Nunziante v EUIPO (pending)

Appeals not admitted to proceed since 2019: > 200



10/12/2021, C-382/21 P, EUIPO v KaiKai: *appeal upheld* (27/02/2024)

- RCD holder filed a claim of priority for the RCD on the basis of an ‘international application’ under the Patent Cooperation Treaty [‘PCT’] pending with the European Patent Office.
- The priority claim was **refused** by the Examiner.
- The **refusal** was confirmed by the Board of Appeal:
 - the priority claim was based on a first application, the PCT-international application, whose date of filing had predated by **more than six (6) months** the date of the subsequent filing of the contested RCD [belated claim].
- The GC **annulled** the decision of the Board of Appeal.
- The Board of Appeal committed an **error in law**, when it found that the contested priority claim, which was based upon a PCT-international **patent** application, was subject to a priority claim period of six (6) months, because the priority claim period should be **twelve (12) months**.
- Single ground of appeal, alleging infringement of Article 41(1) CDR. It consisted of three (3) parts that were interrelated.
 1. The GC infringed Article 41(1) CDR, by finding non-existent gaps in law (lacunae legis) in this provision by a contra legem interpretation.
 2. The GC disapplied Article 41(1) CDR, by substituting its clear and exhaustive provision by a direct effect to Article 4 of the Paris Convention.
 3. The GC infringed Article 41(1) CDR by an erroneous misinterpretation of the Paris Convention and the Patent Cooperation Treaty.

10/12/2021, C-382/21 P, EUIPO v KaiKai: *appeal upheld* (27/02/2024)

- 10.12.2021: the CJEU allows the EUIPO's pourvoi to proceed.
- 13.03.2023: oral hearing before the Grand Chamber.
- 27.02.2024: the CJEU issues the present judgment, which:
 1. **Sets aside the** GC judgment; and
 2. **Dismisses Kai-Kai's action** before the GC.

CJEU Findings:

- Article 4 of the Paris Convention has no direct effect
- Article 41(1) CDR is clear and exhaustive

It follows unequivocally from the clear wording of Article 41(1) CDR that **only two categories** of earlier application – namely (i) **an application for registration of a design** and (ii) an application for registration of a utility model – can form the basis of a right of priority for a subsequent application for registration of a Community design, solely within **a period of six (6) months** as of the date of filing of the earlier application concerned.

30/01/2023, C-580/22P, bonnanwalt v EUIPO: *appeal upheld* (30/01/2024)

- Where the applicant before the GC is a legal person that is formally distinct from the law firm in which its representative works, the fact that the said representative is the only employee of the law firm whose owner and managing director is also the legal representative and managing director of the applicant and therefore they cooperate regarding the applicant's representation before the court, **cannot, in itself**, and in the **absence** of concrete **evidence** demonstrating **the dependence of the lawyer** concerned, constitute a factor capable of calling into question the independence of that lawyer (§ 57-61)

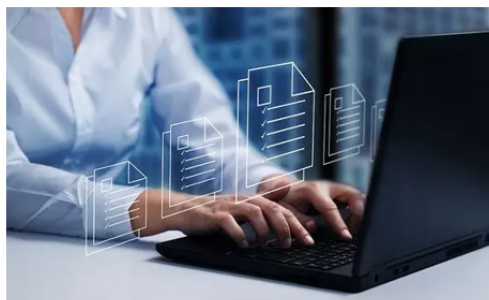
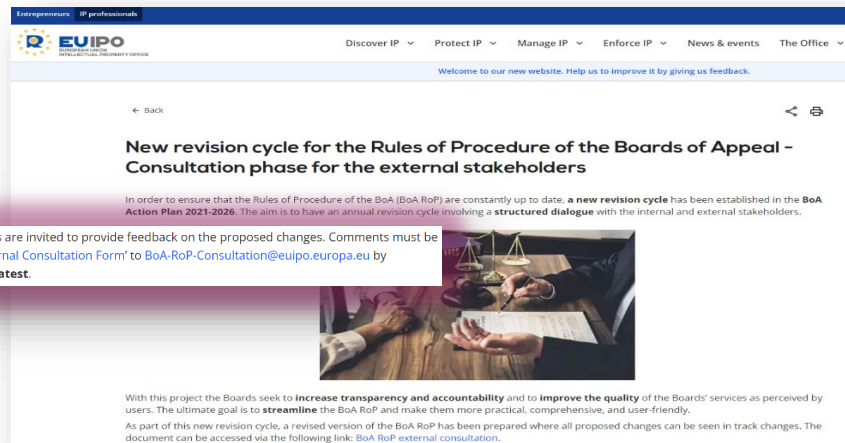
Boards of Appeal Action Plan 2021-2026



<https://euipo.europa.eu/ohimportal/en/web/guest/boards-of-appeal>

RULES OF PROCEDURE

Activity 1	Revision of the RoP
Activity 2	Revise first drafts
Activity 3	BoA internal consultation
Activity 4	Prepare second drafts
Activity 5	External consultation with relevant stakeholders
Activity 6	Prepare final drafts
Activity 7	Adoption
Activity 8	Publication



Revised Rules of Procedure of the Boards of Appeal now available

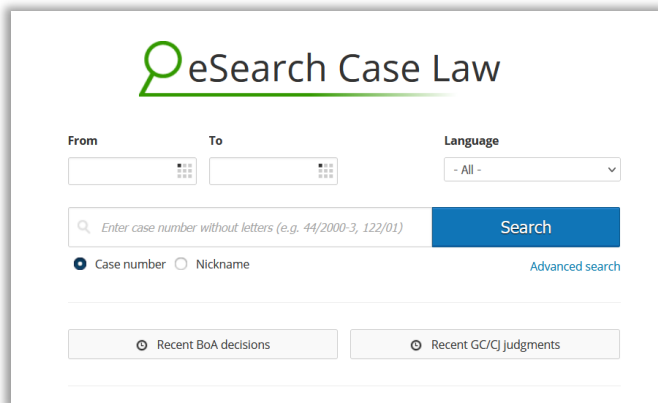
The revised [Rules of Procedure of the Boards of Appeal](#) (BoA RoP) entered into force on 1 March 2024. The amendments primarily aim to ensure an alignment of the terminology used throughout the document, effectively mirroring the current Regulations in force.

[Read more](#)

BoA RoP – last changes entered into force on 1 March 2024

- Alignment of the terminology throughout the document
- Enhance clarity of the competences assigned to different actors within the BoA
- Calculation and extension of time limits (Article 3 BoA RoP)
- Procedures for suspensions (Article 44 BoA RoP)
- Alternative Dispute Resolution (Articles 33 and 34 BoA RoP)

eSEARCH CASE LAW



The screenshot shows the 'eSearch Case Law' search interface. At the top, there is a search icon and the title 'eSearch Case Law'. Below this, there are three input fields: 'From', 'To', and 'Language'. The 'Language' field is a dropdown menu currently set to '- All -'. Below these fields is a search bar with a magnifying glass icon and the placeholder text 'Enter case number without letters (e.g. 44/2000-3, 122/01)'. To the right of the search bar is a blue 'Search' button. Below the search bar, there are two radio buttons: 'Case number' (which is selected) and 'Nickname'. To the right of these radio buttons is a link for 'Advanced search'. At the bottom of the interface, there are two buttons: 'Recent BoA decisions' and 'Recent GC/CJ judgments', both with radio buttons next to them.

- Part of the Boards' Action Plan and EUIPO's Strategic Plan
- Launched in **2022**

Objectives

- New content
 - Judgments from **EU TM and Designs National Courts**
 - Decisions from **IPOs**
 - **Administrative and enforcement proceedings**
- Develop new advanced search functionalities

BOARDS OF APPEAL COOPERATION – User Associations/Stakeholders



Network of Appeal Bodies of EU Intellectual Property Offices

It is a forum of **Appeal Bodies of EU IPOs** for open discussions on trends in EU trade mark and design legal practices and procedures, part of which involves analysing recent Boards of Appeal and national case law

- Network of Appeal Bodies of EU Intellectual Property Offices was established last year
- 1st meeting on **13 September 2023**
- 19 Appeal Bodies (either internal Boards of Appeal or external Courts)
- **One meeting per year**
- Exchange of best practices on procedures and substantive law
- Upcoming 2nd meeting on **12 September 2024**



Judges´ Quality Assurance and Legal Practice Panels

It is a network of **national IP judges from EUTM and RCD national courts** who contribute to a mechanism **to review the quality of legal practice**, essentially focused on analysing decision-making practice of the EUIPO Boards of Appeal and trends in EU IP jurisprudence



- National IP Courts and the Boards of Appeal discuss specific legal topics set out in Case Law Research Reports
- Discussions in Panels
- National judges bring judgments from their respective jurisdictions
- Two meetings per year
- Hybrid format
- Last meeting – **28-29 May 2024**

**THANK YOU FOR YOUR
ATTENTION!**