

UKIPO and EUIPO TM Appeal procedures – a practical guide

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Options once decision is issued – Appointed Person

- If you feel the Hearing Officer has made an error on a point of law or made an unreasonable decision, then you can file an appeal to the Appointed Person or High Court.
- Appeals to the Appointed Person must be made within 28 days from the issue of the decision.
- Non-extendable.
- Notice of appeal must include the grounds of appeal and relevant trade mark law and legal authorities relied upon.
- The Appointed Person's decision is final.

Options once decision is issued – High Court

- Appeals to the High Court must be made within 28 days from the issue of the decision.
- Possible to extend where deadline has passed: must provide reason for delay and action taken prior to that date.
- Must be filed in line with the Civil Procedure Rules: must provide appellant's notice and grounds of appeal.
- Decisions by the High Court may be appealed to the Court of Appeal.

Statistics – Oppositions (for 2019 – most recent data)

- 4,117 oppositions filed in 2019 (107,527 applications) – 3.8% of applications opposed
- 2,906 pending at end of 2019
- 2,713 applications or oppositions withdrawn – 65.9% of oppositions filed resolved between the parties
- 419 proceeded to decision – 10.1% of oppositions
- 171 oppositions unsuccessful – 40.8% of decisions
- 248 oppositions successful (in part or in full) – 59.2% of decisions
- 100 hearings on oppositions – 23.9% of decisions

Statistics – Appeals to the Appointed Person (for 2019 – most recent data)

- 70 appeals to the Appointed Person filed in 2019
- 8 appeals withdrawn
- 32 appeals unsuccessful
- 5 appeals successful (in part or in full)
- 2 appeals remitted back to registry



Statistics – Appeals directly to the Court (for 2019 – most recent data)

- 7 appeals to the Court in 2019 (21 in 2018)
- 2 appeals unsuccessful
- 0 appeals withdrawn
- 0 appeals successful (in full or in part)
- 0 appeals referred to ECJ



Introduction (EUIPO procedures)

- In 2019, the EUIPO handled
 - 131,000 EUTM (direct) applications (plus 28,500 through WIPO)
 - 97,000 RCD (direct) filings (plus 15,000 through WIPO)
- Most EUTM and RCD applications came from Germany, followed by China and the USA.
- In total, there are more than 2 million registered EUTMs / 1,3 million RCDs

Refusal rate

- On average, 8-10% of all EUTM applications are refused by the EUIPO based on **absolute grounds**.
- Around 11%–14% of all EUTM applications are subject to **opposition**.
- Registered EUTMs can also be subject to **cancellation** actions (for non-use and/or based on earlier rights) – 375 decisions taken in 2019.

Appeal rate

- On average, 15% of all decisions concerning **absolute grounds** are appealed.
- Around 20% of all decisions in **opposition matters** are appealed.
- Roughly 35% of all decisions concerning **cancellation** matters are appealed.
- In 2019, most appeals were brought from Germany (25%), followed by the USA (13%), Spain (9,7%), UK (5,9%) and Italy (5,8%).

Stages of appeal

- Decisions taken by the EUIPO in first instance can be appealed to the Boards of Appeal (“BoA”).
- The decisions of the BoA are liable to actions before the General Court (“GC”).
- The judgments of the GC are subject to a right to appeal to the Court of Justice of the European Union (“CJEU”) on points of law.



Decision-making bodies of the EUIPO

- There are five Boards of Appeal and one Grand Board of Appeal. A BoA consists of three Members; two of the Members must be legally qualified. The Grand Board consists of nine Members. A Board may refer a case to the Grand Board if it believes that this is justified because of its legal difficulty, importance or special circumstances.
- The BoA are **independent** and, in deciding a case, **not bound** by previous decisions of the EUIPO and/or the EUIPO's own guidelines (see Art. 166 (7) EUTMR and also decision of the General Court of 7 November 2019 in case T-240/19, *Bell*, para. 75).
- In 2019, the BoA took 2,507 decisions = two decisions per day / per Board.

Confirmation rates (BoA) in 2019

- Confirmation rates of first-instance decisions by the BoA:
 - **EUTM refusals:** 79%
 - thus a **21%** chance of successfully overturning an initial negative decision
 - **Oppositions:** 76%
 - thus a **24%** chance of successfully overturning an initial negative decision
 - **Cancellation actions:** 72%
 - thus a **28%** chance of successfully overturning an initial negative decision

Confirmation rates (GC) in 2019

- Confirmation rates of BoA's decisions by the GC:
 - **EUTM refusals:** 90%
 - thus (only) a **10%** chance of successfully overturning a negative decision of the BoA
 - **Oppositions:** 71%
 - thus a **29%** chance of successfully overturning a negative decision of the BoA
 - **Cancellation actions:** 76%
 - thus a **24%** chance of successfully overturning a negative decision of the BoA

Comparison BoA / GC confirmation rates

- Filing an action before the GC appears, statistically speaking, to have only a low success rate (10%) with respect to refusals based on absolute grounds.
- However, with respect to oppositions as well as cancellation matters, the chances of success before the GC appear to be the same as before the BoA, i.e. around 25% up to 29%.
- Considering the confirmation rates before the BoA and the GC together, it seems that there is almost a 50% chances of successfully overturning a negative decision taken by an examiner in first instance.
- Somewhat surprisingly, the ratio of actions brought against BoA decisions before the General Court in 2019 was only at 10.8%.

Appeal proceeding before the BoA

- Deadline: notice of appeal must be filed within **two months** of the date of notification of the decision (grounds of appeal can be filed later, i.e. within **four months** of the date of notification of the decision), see Art. 68 (1) EUTMR.
- Appeal fee: **EUR 720**.
- Duration of the proceedings: on average, the BoA issues a decision within **6-8 months**.
- Costs: BoA can grant cost reimbursement for the winning party up to **EUR 850**.

Appeal proceeding before the GC

- Deadline: Action must be lodged with the General Court Registry via the e-Curia application within **two months** (plus 10 days) from the date of receipt of the BoA's decision.
- There are **no** court fees for filing an action before the GC.
- On average, the GC issues a judgment within **12-18 months**.
- GC will issue a decision on costs upon request.

Conclusion

- Filing an appeal before the BoA as well as the GC appears to involve promising chances of success (with exception of matters concerning absolute grounds for refusal) and overall, it seems worthwhile going the “extra mile”.
- The duration of the proceedings appear to be reasonably fast:
 - BoA: 6-8 months
 - GC: 12-18 months
- The risk in terms of costs appears to be limited
 - BoA: EUR 1,570 (appeal fee + eventual cost reimbursement) plus attorney fees
 - GC: No court fees only the risk of eventual cost reimbursement (attorney fees, travel costs etc.) plus attorney fees

Thank you for your attention!

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