

Advocate General Sharpston (AG) has provided further guidance on the interpretation of the provisions of the CTMIR relating to the time limits for the submission of evidence of earlier rights on which an opposition is based.

The opinion concerns three oppositions filed by Mr Rintisch (R) against three CTM applications, on the grounds that was a likelihood of confusion with a number of earlier German trade mark registrations of which he claimed to be owner. R did not fully substantiate the grounds of opposition with the necessary documentary evidence of the existence of German trade mark registrations, such as evidence that the registrations over ten years old had been renewed, or translations of the documentary evidence within the time limit set by OHIM. The opposition was therefore dismissed. R appealed this decision, filing the necessary further documents and translations, which OHIM's Board of Appeal (BoA), and the General Court (GC) refused to take into account, on the grounds that it had no discretion to do so.

Advocate General Sharpston has discussed whether the GC was wrong to find that the BoA had no discretion to take into account evidence relating to the validity of earlier marks after the expiry of the time limits set by OHIM. R appealed the decision of the GC on the grounds that it had infringed Art 74(2) of Regulation 40/94 on the basis that it had wrongly found that the BoA has no discretion when deciding that an opposing party has not substantiated its earlier marks.

The argument centred on the interpretation of Art 74(2) which provides that OHIM *"may disregard facts or evidence which are not submitted in due time by the parties concerned"*, and whether this should be interpreted to read that OHIM and the BoA had the discretion to take into account the evidence that R had submitted after the relevant deadline, which pertained to the admissibility of the oppositions. The AG considered that the evidence in question, concerning the existence and validity of the marks on which the opposition was based, would have to be submitted prior to OHIM deciding whether the opposition was admissible.

She reviewed this in light of Rule 50(1) of the Implementing Regulation, which states that:

"Where the appeal is directed against a decision of an Opposition Division, the Board shall limit its examination of the appeal to facts and evidence presented within the time limits set in or specified by the Opposition Division in accordance with the Regulation and these Rules, unless the Board considers that additional or supplementary facts and evidence should be taken into account pursuant to Article 74 (2) (now Article 76 (2)) of the Regulation."

The question of whether the BoA had discretion to take into account the evidence submitted after the time limit centred on whether it would be considered to be *"additional or supplementary facts and evidence"*.

The AG considered that where the evidence in question was to demonstrate that a mark had been put to genuine use, there would be greater discretion. Given that the issue of genuine use is so dependent on the particular goods and services in relation to which a mark is used and the particular market, what counts as genuine use can vary wildly. The AG stated that whilst Rules 22(3) and 22(4) of the CTMIR describe what needs to be proved and how this can be done, there is no exhaustive list of indispensable documentary evidence that must be submitted to satisfy the burden of proving genuine use.

In contrast, Rules 19(2) (a) (ii) and 20(1) of the CTMIR clearly prescribe the evidentiary threshold for demonstrating the validity of trade marks that are not Community trade marks, on which a party has based its opposition. Rule 19(2) (a) (ii) of the CTMIR clearly states that for registered trade marks that are not CTMs, the opposing party is required to submit a copy of the relevant registration certificate, and if appropriate, a copy of the latest renewal certificate showing that the term of protection of the trade mark extends beyond the time limit set by the Opposition Division. Additionally Rule 19(3) of the CTMIR clearly requires the evidence to be in the language of the proceedings or accompanied by a translation of such, and for any translations to be submitted within the time limit prescribed by the Opposition Division. In addition Rule 19(4) CTMIR states that *"the office shall not take into account written submissions or documents, or parts thereof, that have not been submitted or that have not been translated into the language of the proceedings, within the time limit set by the Office"*.

In light of these clear and unambiguous terms, the AG considered that the GC was right to hold that the BoA did not have discretion to take into account the evidence of the existence and validity of the earlier marks filed after the expiry of the time-limit. Given that the BoA could not exercise such discretion, the AG believed that there was no scope to consider how the BoA might exercise this discretion.

In light of the above the AG recommended that the appeal was dismissed in its entirety.

In the interests of legal certainty, this is the approach that should be taken. OHIM sets clear and unambiguous deadlines for the submission of documents, including evidence. This case emphasizes the importance of complying with these deadlines, and the ramifications of failure to do so.

Authors

Chris McLeod
Director of Trade Marks
T +44 20 7655 1590
E chris.mcleod@squiresanders.com

Amanda W. McDowall
Trademark Attorney
T +44 20 7655 1344
E amanda.mcdowall@squiresanders.com

This article first appeared on WTR Daily, part of World Trademark Review, in May 2013. For further information, please go to www.worldtrademarkreview.com

The contents of this update are not intended to serve as legal advice related to individual situations or as legal opinions concerning such situations nor should they be considered a substitute for taking legal advice.

© Squire Sanders.