

**COMMISSION REGULATION (EC) No 216/96**

**of 5 February 1996**

**laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market**

**(Trade Marks and Designs)**

**(OJ EC No L 28 of 6.2.1996, p. 11)**

**amended by Commission Regulation (EC) No 2082/2004**

**of 6 December 2004**

**(OJ EC No L 360 of 7.12.2004, p. 8)**

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Community,

Having regard to Council Regulation (EC) No 40/94 of 20 December 1994 on the Community trade mark<sup>1</sup>, as amended by Regulation (EC) No 3288/94<sup>2</sup>, and in particular Article 140 (3) thereof,

Whereas Regulation (EC) No 40/94 (hereinafter 'the Regulation') creates a new trade mark system allowing a trade mark having effect throughout the Community to be obtained on the basis of an application to the Office for Harmonization in the Internal Market (Trade Marks and Designs) ('the Office');

Whereas for this purpose the Regulation contains in particular the necessary provisions for a procedure leading to the registration of a Community trade marks, as well as for the administration of Community trade marks, for appeals against decisions of the Office and for proceedings in relation to revocation or invalidity of a Community trade mark;

Whereas under Article 130 of the Regulation, the Boards of Appeal are to be responsible for deciding on appeals from decisions of the examiners, the Opposition Divisions, the Administration of Trade Marks and Legal Division and the Cancellation Divisions;

Whereas Title VII of the Regulation contains basic principles regarding appeals against decisions of examiners, the Opposition Divisions, the Administration of Trade Marks and Legal Division and the Cancellation Divisions;

Whereas Title X of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation No 40/94 on the Community Trade Mark<sup>3</sup> contains implementing rules to Title VII of the Regulation;

Whereas this Regulation supplements those other rules, in particular as regards the organization of the Boards and the oral procedure;

Whereas before the beginning of each working year a scheme should be established for the distribution of business between the Boards of Appeal by an Authority established for that purpose; whereas to this end the said Authority should apply objective criteria such as classes of products and services or initial letters of the names of applicants;

Whereas to facilitate the handling and disposal of appeals, a rapporteur should be designated for each case, who should be responsible *inter alia* for preparing communications with the parties and drafting decisions;

Whereas the parties to proceedings before the Boards of Appeal may not be in a position or may not be willing to bring questions of general relevance to a pending case to the attention of the Boards of Appeal; whereas, therefore, the Boards of Appeal should have the power, of their own motion or pursuant to a request by the President, to invite the President of the Office, to submit comments on questions of general interest in relation to a case pending before the Boards of Appeal;

Whereas the measures provides for in this Regulation are in accordance with the opinion of the Committee established under Article 141 of the Regulation,

HAS ADOPTED THIS REGULATION:

**Article 1**

**Presidium of the Boards of Appeal<sup>4</sup>**

1. The authority referred to in Articles 130 and 131 of the Regulation shall be the Presidium of the Boards of Appeal (referred to hereinafter as 'the Presidium').

2. The Presidium shall comprise the President of the Boards of Appeal, who shall chair it, the chairmen of the Boards and Board members elected for each calendar year by and from among all the members of the Boards other than the President of the Boards of Appeal and the chairmen of the Boards. The number of Board members so elected shall be a quarter of the number of Board members, other than the President of the Boards of Appeal and the chairmen of the Boards, rounded up if necessary.

3. If the President of the Boards of Appeal is unable to act or if the post of President is vacant, the Presidium shall be chaired by:

(a) the chairman of the Board having the longest service on the Boards of Appeal; or

(b) where chairmen have the same length of service, by the eldest of those qualifying under the preceding subparagraph.

4. The Presidium may validly deliberate only if at least two-thirds of its members are present, including its chairman and two Board chairmen. Decisions of the Presidium shall be taken by a majority vote. In the event of a tie, the vote of the chairman shall be decisive.

<sup>1</sup> OJ No L 11, 14.1.1994, p. 1

<sup>2</sup> OJ No L 349, 31.12.1994, p. 83

<sup>3</sup> OJ No L 303, 15.12.1995, p. 1

<sup>4</sup> Amended by Commission Regulation (EC) No 2082/2004 of 6.12.2004

5. Before the beginning of each calendar year, and without prejudice to Article 1(b), the Presidium shall decide on objective criteria for allocating cases among the Boards for the calendar year in question and shall designate the full and alternate members of each of the Boards for that year. Each member of the Boards of Appeal may be assigned to several Boards as a full or alternate member. These measures may be modified, as necessary, in the course of the calendar year in question. Decisions adopted by the Presidium pursuant to this paragraph shall be published in the Official Journal of the Office.

6. The Presidium shall also be competent to:

- (a) lay down such rules of a procedural nature as are necessary for the processing of cases brought before the Boards and such rules as are necessary on the organisation of the Boards' work;
- (b) rule on any conflict concerning the allocation of cases among the Boards of Appeal;
- (c) lay down its internal rules;
- (d) lay down practical instructions of a procedural nature for parties involved in proceedings before the Boards of Appeal, for example, with regard to the submission of written statements and to oral proceedings;
- (e) exercise any other powers as are conferred to it by the present Regulation.

7. The President of the Boards of Appeal shall consult the Presidium on the expenditure requirements of the Boards, which he shall communicate to the President of the Office with a view to drawing up the expenditure estimates and where he considers it appropriate, on any other question relating to the management of the Boards of Appeal.

#### **Article 1(a) Grand Board<sup>5</sup>**

1. The enlarged Board set up by Article 130(3) of the Regulation shall be the Grand Board.

2. The Grand Board shall comprise nine members, including the President of the Boards of Appeal, who shall chair it, the chairmen of the Boards, the rapporteur designated prior to referral to the Grand Board, if applicable, and members drawn in rotation from a list comprising the names of all members of the Boards of Appeal other than the President of the Boards of Appeal and the chairmen of the Boards.

The Presidium shall draw up the list referred to in the first paragraph and establish the rules according to which members are drawn from that list on the basis of objective criteria. The list and such rules shall be published in the Official Journal of the Office. If a rapporteur has not been designated prior to referral to the Grand Board, the chairman of the Grand Board shall designate a rapporteur from among the members of the Grand Board.

3. If the President of the Boards of Appeal is unable to act or if the post of President is vacant, or in the event of exclusion or objection within the meaning of Article 132 of the Regulation, the Grand Board shall be chaired by:

- (a) the chairman having the longest service on the Boards of Appeal; or
- (b) where chairmen have the same length of service, by the eldest of those qualifying under the preceding subparagraph 4.

4. If another member of the Grand Board is unable to act or in the event of exclusion or objection within the meaning of Article 132 of the Regulation, he or she shall be replaced by the person highest on the list referred to in paragraph 2 of this Article.

5. The Grand Board may not hear cases and oral proceedings may not take place before it unless seven of its members are present, including its chairman and the rapporteur.

If the Grand Board hears a case in the presence of only eight of its members, the member with the least seniority in the Boards of Appeal shall not take part in the vote, unless that member is the chairman or the rapporteur, in which case the member with the next highest seniority to that of the chairman or rapporteur shall not vote.

#### **Article 1(b) Referral to the Grand Board<sup>6</sup>**

1. A Board may refer a case allocated to it to the Grand Board if it believes that this is justified by the legal difficulty or importance of the case or by special circumstances, for example, if Boards of Appeal have issued diverging decisions on a point of law raised by that case.

2. A Board shall refer a case allocated to it to the Grand Board if it believes that it must deviate from an interpretation of the relevant legislation given in an earlier decision of the Grand Board.

3. The Presidium may, on a proposal made by the President of the Boards of Appeal on his or her own initiative or at the request of a member of the Presidium, refer to the Grand Board a case allocated to a Board if it believes that this is justified by the legal difficulty or importance of the case or by special circumstances, for example, if Boards of Appeal have issued diverging decisions on a point of law raised by that case.

4. The Grand Board shall, without delay, refer the case back to the Board to which it was originally allocated if it believes that the conditions for the original referral are not met.

5. All decisions relating to referral to the Grand Board shall be reasoned and shall be communicated to the parties to the case.

#### **Article 1(c) Decisions by a single member<sup>7</sup>**

1. The Presidium shall draw up an indicative list of the types of cases which the Boards may, unless special circumstances apply, devolve to a single member, such as decisions closing the proceedings following agreement between the parties, and decisions on the award of costs and the admissibility of the appeal.

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<sup>5</sup> Inserted by Commission Regulation (EC) No 2082/2004 of 6.12.2004

<sup>6</sup> Inserted by Commission Regulation (EC) No 2082/2004 of 6.12.2004

<sup>7</sup> Inserted by Commission Regulation (EC) No 2082/2004 of 6.12.2004

The Presidium may also draw up a list of the types of cases which may not be devolved to a single member.

2. A Board may delegate to its chairman the decision to allocate to a single member cases falling within the types of cases defined by the Presidium in accordance with paragraph 1.

3. The decision to devolve the case upon a single member shall be communicated to the parties.

The member to whom the case has been devolved shall refer it to the Board if he finds that the conditions for devolution are no longer met.

#### **Article 1(d)**

##### **Referral of a case following a ruling of the Court of Justice<sup>8</sup>**

1. If, pursuant to Article 63(6) of the Regulation, the measures necessary to comply with a judgment of the Court of Justice annulling all or part of a decision of a Board of Appeal or of the Grand Board include re-examination by the Boards of Appeal of the case which was the subject of that decision, the Presidium shall decide if the case shall be referred to the Board which adopted that decision, or to another Board, or to the Grand Board.

2. If the case is referred to another Board, that Board shall not comprise members who were party to the contested decision. This provision shall not apply if the case is referred to the Grand Board.

#### **Article 2**

##### **Replacement of members**

1. Reasons for replacement by alternates shall in particular include leave, sickness, inescapable commitments and the grounds of exclusion set out in Article 132 of the Regulation.

2. Any member asking to be replaced by an alternate shall without delay inform the Chairman of the Board concerned of his unavailability.

#### **Article 3**

##### **Exclusion and objection**

1. If a Board has knowledge of a possible reason for exclusion or objection under Article 132 (3) of the Regulation which does not originate from a member himself or from any party to the proceedings, the procedure of Article 132 (4) of the Regulation shall be applied.

2. The member concerned shall be invited to present his comments as to whether there is a reason for exclusion or objection.

3. Before a decision is taken on the action to be taken pursuant to Article 132 (4) of the Regulation, there shall be no further proceedings in the case.

#### **Article 4**

##### **Rapporteurs**

1. The Chairman of each Board shall for each appeal designate a member of his Board, or himself, as rapporteur.

2. The rapporteur shall carry out a preliminary study of the appeal. He may prepare communications to the parties subject to the direction of the Chairman of the Board. Communications shall be signed by the rapporteur on behalf of the Board.

3. [deleted]<sup>9</sup>

3.<sup>10</sup> The rapporteur shall draft decisions.

#### **Article 5**

##### **Registry<sup>11</sup>**

1. A Registry shall be set up at the Boards of Appeal, and shall, inter alia, be responsible, under the authority of the President of the Boards of Appeal, for the receipt, dispatch, safekeeping and notification of all documents relating to the proceedings before the Boards of Appeal, and for compilation of the relevant files.

2. The Registry shall be headed by a Registrar. The President of the Boards of Appeal shall appoint a Registry agent who shall perform the tasks of the Registrar when the latter is absent or unable to act or if the post of Registrar is vacant.

3. The Registrar shall, in particular, ensure that the deadlines and other formal conditions relating to the presentation of the appeal and of the statement of grounds are respected.

If an irregularity is detected which is liable to make the appeal inadmissible, the Registrar shall, without delay, send a reasoned opinion to the chairman of the Board concerned.

4. The minutes of oral proceedings and of the taking of evidence shall be drawn up by the Registrar or, if the President of the Boards of Appeal agrees, by such agent of the Boards of Appeal as the chairman of the Board concerned may designate.

5. The President of the Boards of Appeal may delegate to the Registrar the task of allocating cases to the Boards of Appeal in accordance with allocation criteria laid down by the Presidium.

The Presidium may, upon a proposal by the President of the Boards of Appeal, delegate to the Registry other tasks relating to the conduct of proceedings before the Boards of Appeal.

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<sup>8</sup> Inserted by Commission Regulation (EC) No 2082/2004 of 6.12.2004

<sup>9</sup> Deleted by Commission Regulation (EC) No 2082/2004 of 6.12.2004

<sup>10</sup> Numbering of the paragraph amended by Commission Regulation (EC) No 2082/2004 of 6.12.2004

<sup>11</sup> Amended by Commission Regulation (EC) No 2082/2004 of 6.12.2004

## **Article 6**

### **Change in the composition of a Board**

1. If the composition of a Board is changed after oral proceedings, the parties to the proceedings shall be informed that, at the request of any party, fresh oral proceedings shall be held before the Board in its new composition. Fresh oral proceedings shall also be held if so requested by the new member and if the other members of the Board have given their agreement.
2. The new member shall be bound to the same extent as the other members by an interim decision which has already been taken.
3. If, when a Board has already reached a final decision, a member is unable to act, he shall not be replaced by an alternate. If the Chairman is unable to act, then the member of the Board concerned having the longer service on the Board, or where members have the same length of service, the older member, shall sign the decision on behalf of the Chairman.

## **Article 7**

### **Joinder of appeal proceedings**

1. If several appeals are filed against a decision, those appeals shall be considered in the same proceedings.
2. If appeals are filed against separate decisions and all the appeals are designated to be examined by one Board having the same composition, that Board may deal with those appeals in joined proceedings with the consent of the parties.

## **Article 8**

### **Procedure<sup>12</sup>**

1. If the Registrar sends the chairman of a Board of Appeal an opinion on the admissibility of an appeal in accordance with Article 5(3), second paragraph, the chairman of the Board in question may either suspend the proceedings and request the Board to rule on the admissibility of the appeal, or reserve judgement on the admissibility of the appeal for the decision to end the proceedings before the Board of Appeal.
2. In *inter partes* proceedings, and without prejudice to Article 61(2) of the Regulation, the statement setting out the grounds of appeal and the response to it may be supplemented by a reply from the appellant, lodged within two months of the notification of the response, and a rejoinder by the defendant, lodged within two months of notification of the reply.
3. In *inter partes* proceedings, the defendant may, in his or her response, seek a decision annulling or altering the contested decision on a point not raised in the appeal. Such submissions shall cease to have effect should the appellant discontinue the proceedings.

## **Article 9**

### **Oral proceedings**

1. If oral proceedings are to take place, the Board shall ensure that the parties have provided all relevant information and documents before the hearing.
2. The Board may, when issuing the summons to attend oral proceedings, add a communication drawing attention to matters which seem to be of special significance, or to the fact that certain questions appear no longer to be contentious, or containing other observations that may help to concentrate on essentials during the oral proceedings.
3. The Board shall ensure that the case is ready for decision at the conclusion of the oral proceedings, unless there are special reasons to the contrary.

## **Article 10**

### **Communications to the parties**

If a Board deems it expedient to communicate with the parties regarding a possible appraisal of substantive or legal matters, such communication shall be made in such a way as not to imply that the Board is in any way bound by it.

## **Article 11**

### **Comments on questions of general interest**

The Board may, on its own initiative or at the written, reasoned request of the President of the Office, invite him to comment in writing or orally on questions of general interest which arise in the course of proceedings pending before it. The parties shall be entitled to submit their observations on the President's comments.

## **Article 12**

### **Deliberations preceding decisions**

The rapporteur shall submit to the other members of the Board a draft of the decision to be taken and shall set a reasonable time-limit within which to oppose it or to ask for changes. The Board shall meet to deliberate on the decision to be taken if it appears that the members of a Board are not all of the same opinion. Only members of the Board shall participate in the deliberations; the Chairman of the Board concerned may, however, authorize other officers such as registrars or interpreters to attend. Deliberations shall be secret.

## **Article 13**

### **Order of voting**

1. During the deliberations between members of a Board, the opinion of the rapporteur shall be heard first, and, if the rapporteur is not the Chairman, the Chairman last.

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<sup>12</sup> Amended by Commission Regulation (EC) No 2082/2004 of 6.12.2004. The provisions of Article 8 (2) and (3) of Regulation (EC) No 216/96, as amended by Article 1 (5) of Regulation No 2082/2004 shall apply only to proceedings in respect of which the appeal was lodged after 27.12.2004 (Article 2 of Commission Regulation (EC) No 2082/2004 of 6.12.2004)

2. If voting is necessary, votes shall be taken in the same sequence, save that if the Chairman is also the rapporteur, he<sup>13</sup> shall vote last. Abstentions shall not be permitted.

**Article 14**  
**Entry into force**

This Regulation shall enter into force the third day following its publication in the *Official Journal of the European Communities*.<sup>14</sup>

This Regulation shall be binding in its entirety and directly applicable in all Member States.

Done at Brussels, 5 February 1996.

*For the Commission*

Mario MONTI

*Member of the Commission*

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<sup>13</sup> Read: "he"

<sup>14</sup> Date of entry into force: 9.2.1996. Date of entry into force of the amendments by Commission Regulation (EC) No 2082/2004 of 6.12.2004: 27.12.2004