

COMMISSION REGULATION (EC) No 2082/2004

of 6 December 2004

amending Regulation (EC) No 216/96 laying down the rules of procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs)

THE COMMISSION OF THE EUROPEAN COMMUNITIES,

HAS ADOPTED THIS REGULATION:

Having regard to the Treaty establishing the European Community,

Article 1

Regulation (EC) No 216/96 is amended as follows:

Having regard to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark⁽¹⁾, and in particular Article 157(3) thereof,

1. Article 1 is replaced by the following:

Whereas:

*'Article 1***Presidium of the Boards of Appeal**

(1) Regulation (EC) No 422/2004 amended Regulation (EC) No 40/94 with regard, *inter alia*, to the organisation and procedures of the Boards of Appeal provided for in Articles 130 and 131.

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) Regulation (EC) No 422/2004 introduced, *inter alia*, the new post of President of the Boards of Appeal, created an enlarged Board of Appeal and laid down that, under certain conditions, decisions of the Boards of Appeal may be taken by a single member. It is therefore necessary to set out in detail the powers of the President of the Boards of Appeal, the composition and powers of the Boards of Appeal, the allocation of cases to the Boards of Appeal and the composition of the enlarged Board, cases to be referred to the enlarged Board and cases to be decided by a single member.

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) The practical operation of the Boards of Appeal has shown the need to make certain changes to their organisation and procedures, including changes to the role of the Registry and certain procedural aspects. Centralisation of the Registry and revision of its powers, and rules on exchanges of submissions between parties, are designed to ensure greater efficiency in the handling of cases by the Boards of Appeal. In order not to interfere with proceedings already pending when this Regulation enters into force, a transitional period must be provided for with respect to the exchange of submissions by the parties.

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

(4) The measures provided for in this Regulation are in accordance with the opinion of the Committee on fees, Implementation Rules and the Procedure of the Boards of Appeal of the Office for Harmonization in the Internal Market (trade mark and designs),

(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.

⁽¹⁾ OJ L 11, 14.1.1994, p. 1. Regulation as last amended by Regulation (EC) No 422/2004 (OJ L 70, 9.3.2004, p. 1).

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.'

2. Articles 1(a) to (d) are inserted as follows:

'Article 1(a)

Grand Board

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

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

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.

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

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.'

3. Article 4(3) is deleted and Article 4(4) is renumbered as Article 4(3).

4. Article 5 is replaced by the following:

'Article 5

Registry

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.'

5. Article 8 is replaced by the following:

'Article 8

Procedure

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 2

This Regulation shall enter into force on the twentieth day following its publication in the *Official Journal of the European Union*.

The provisions of Article 8(2) and (3) of Regulation (EC) No 216/96, as amended by Article 1(5) of this Regulation, shall apply only to proceedings in respect of which the appeal was lodged after the entry into force of this Regulation.

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

Done at Brussels, 6 December 2004.

For the Commission

Charlie McCREEVY

Member of the Commission
