

COMMISSION OF THE EUROPEAN COMMUNITIES

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Brussels, 23 December 1986

Proposal for a
COUNCIL REGULATION (EEC)
on the rules of procedure of the Boards of Appeal instituted
by Regulation (EEC) on the Community trade mark

(submitted to the Council by the Commission)

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EXPLANATORY MEMORANDUM

I. Introduction

The purpose of this proposal for a Regulation is to lay down the rules of procedure of the Boards of Appeal to be set up within the Community Trade Mark Office under Articles 112 et seq. of the proposal for a Regulation on the Community Trade Mark.

Like certain provisions of the proposal for a Regulation on the Community Trade Mark, for example those concerning appeals, procedural rules and the arrangement of divisions of the Office (in particular Articles 48 to 53, 62, 64, 105, 112, 117 to 119) and certain provisions of the proposal for an Implementing Regulation (in particular Articles 36 to 40 and 76), the present proposal corresponds to provisions of the Munich Convention on the European Patent. These are the provisions laying down the rules of procedure of the Boards of Appeal of the European Patent Office, reproduced in their December 1982 version in the official Journal of the European Patent office for 1983, pages 7 et seq.

These provisions satisfy the requirements for a proper organization of the Boards of Appeal and provide legal certainty for the parties affected by the decisions of the Office.

II. Essential points

1. Rule on the distribution of business among the Boards of Appeal

Effect must be given to the principle of the independence of members of Boards of Appeal expressed in Article 118 of the proposal for a Regulation on the Community Trade Mark. For this reason, for every possible type of appeal, the competent Boards of Appeal and the competent members must be designated in advance. Article 1(2) creates an authority on which the majority of members are members of the Boards of Appeal. The task of this authority is, before the beginning of each working year, to distribute the business among the various Boards of Appeal and at the same time to designate all the permanent members of the Boards and their alternates.

The assignment of duties to each Board of Appeal must be done on the basis of abstract criteria such as classes of products and services, initial letters of the names of appellants, etc. This method makes it possible to avoid any risk of arbitrariness and thus to protect the independence of the members of the Boards of Appeal, and finally to increase the confidence of the parties in the neutrality and objectivity of the decisions of the Community Trade Marks Office on appeals.

2. Organization of the procedure within the Boards of Appeal

According to Article 117 of the proposal for a Regulation on the Community Trade Mark, each Board of Appeal shall be composed of three members who are qualified in law. A provision is needed to determine which of these three members is responsible for preparing the oral hearings and drawing up the draft decision. This is the purpose of Article 4. It is also necessary to lay down the rules on deliberation and the order of voting to be followed by the Boards. This is the purpose of Articles 9 and 10 respectively.

3. Information for the parties

With a view to organizing the procedure in a rational manner it is desirable that, at as early a stage as possible, a rapporteur - and not the three members of the Board - should give the parties a summary of the factual and legal problems arising and give them the provisional opinion of the Board. Such information for the parties is provided for by Articles 4(2). It should often lead to a withdrawal of the application, opposition, etc. and thus relieve the Board of the need to make a decision.

For the oral hearings, provision is made for the Board, the Chairman or the rapporteur, to request the parties to submit any outstanding documents and make any observations necessary to enable the oral hearings to concentrate on essentials (Article 8).

Thus as a general rule a single oral hearing should make it possible to conclude the proceedings.

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THE COUNCIL OF THE EUROPEAN COMMUNITIES,

Having regard to the Treaty establishing the European Economic Community,

Having regard to Council Regulation (EEC) No of
on the Community trade mark, and in particular Article 125 thereof,

Having regard to the proposal from the Commission,

Whereas, under the terms of Article 125 of Regulation (EEC) No
the Council must adopt the rules of procedure of the Boards of Appeal
to be instituted within the Community Trade Marks Office, competent to
examine from the point of view of both fact of of law the decisions of
the Examining Division, Opposition Division, Administration of Trade
Marks Division and Cancellation Division;

Whereas, before the beginning of each working year, a scheme should be
established for the distribution of business between the Boards of Appeal
by the authority competent to do so; whereas to this end the said authority
should apply objective criteria such as classes of products and services,
initial letters of the names of applicants, etc.....;

Whereas to allow the Boards to conduct their business in an orderly manner,
a rapporteur designated for each appeal should indicate to the parties
concerned the decision which may emerge from the proceedings as to law
or to fact; whereas the report, signed by the rapporteur on behalf of the
Board and communicated to the parties, should not be interpreted as being
binding upon the Board,

HAS ADOPTED THIS REGULATION :

Article 1

Scheme for distributing business and authority competent to do so.

1. Before the beginning of each working year, objective criteria shall be applied for the distribution of business among the Boards of Appeal and the members of each of the Boards and their alternates shall be designated. Any member of a Board of Appeal may be designated for several Boards of Appeal as a member or an alternate. This scheme may be amended as necessary during working year.
2. The scheme referred to in paragraph 1 shall be drawn up by an authority composed of the President of the Office as Chairman, a Vice-President, the Chairmen of the Boards of Appeal and three other members of the Boards of Appeal elected by all the members of those Boards for four years. This authority may validly deliberate only if at least five of its members are present, including the President and two Chairmen of Boards of Appeal. Decisions shall be taken by majority vote; in case of tied voting the Chairman shall have a casting vote.
3. The authority provided for in paragraph 2 shall decide on any dispute over assignment of duties among different Boards of Appeal.

Article 2

Replacement of members.

1. Reasons for replacement by alternates shall include leave, sickness, commitments which cannot be avoided and the grounds of exclusion mentioned in Article 119 of Regulation (EEC) No
2. Any member requesting to be replaced by an alternate shall inform the Chairman of the Board concerned of his unavailability without delay.

Article 3

Exclusion and objection.

1. If it is alleged that there is reason for exclusion or objection under Article 119(3) of Regulation (EEC) No, the member concerned shall be invited to present his comments.
2. There shall be no further proceedings in the case until a decision is taken on the exclusion of the member.

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 and may prepare a report subject to the direction of the Chairman of the Board, indicating the decision which may emerge from the proceedings as to law or to fact. This report shall be signed by the rapporteur on behalf of the Board and communicated to the parties. The report may not be interpreted as binding upon the Board.
3. The rapporteur shall prepare internal meetings of the Board and the oral proceedings.
4. The rapporteur shall draft decisions.

Article 5

Registries

1. A registry shall be established for each Board of Appeal. Registrars shall be responsible for the discharge of the functions of the Registries. One of the Registrars shall be designated Senior Registrar.
2. The authority provided for in Article 1(2) may be entrusted to the Registrars the execution of functions which involve no technical or legal difficulties, particularly with regard to fixing the amount of costs, representation, the submission of translations, opening of files to public inspection, notifications or decisions in relation to time limits.
3. The Registrar shall submit to the Chairman of the Board concerned a report on the admissibility of each newly filed appeal.
4. Minutes of oral proceedings and of the taking of evidence shall be drawn up by the Registrar or such other officer of the Office as the Chairman of the Board may designate.

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 will 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, the member of the Board concerned having the longest service on the Board, or in the case where members have the same length of service, the eldest 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 in the same composition, that Board may deal with those appeals in consolidated proceedings with the consent of the parties.

Article 8

Oral proceedings

1. If in accordance with Article 58 of Regulation (EEC) No, the Board has recourse to oral proceedings, it shall endeavour to ensure that the parties have provided all relevant information and documents before the hearing.
2. The Board may send with the summons to oral proceedings 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 the oral proceedings on essentials.
3. The Board shall endeavour to ensure that the case is ready for decision at the conclusion of the oral proceedings.

Article 9

Deliberations preceding decisions.

The members of a Board shall meet to deliberate. Only members of the Board shall participate in the deliberations; the Chairman may however authorize other officers to attend. Deliberations shall be secret.

Article 10

Order of voting.

1. During the deliberations, the opinion of the rapporteur shall be heard first and, if the rapporteur is not the Chairman, the Chairman's last.
2. If voting is necessary, votes shall be taken in the same sequence, save that if the Chairman is also the rapporteur, he shall vote last. Abstentions shall not be permitted.

Article 11

Remission to the division whose decision
was the subject of an appeal.

Where the procedure followed by the division whose decision is the subject of an appeal was vitiated by fundamental errors, the Board shall set aside the decision and remit the case to the division, unless there are special reasons for doing otherwise.

Article 12

Entry into force

This Regulation shall enter into force twelve months after its publication in the Official Journal of the European Communities.

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

Done at,

For the Council
The President