

# COMMUNITY DESIGN PROTECTION: PARTICULAR ASPECTS OF THE PROCEDURE BEFORE THE COURT OF JUSTICE OF THE EUROPEAN UNION

ALINA MIHAELA CONEA\*

## Abstract

*The Court of Justice of the European Union (CJEU) has the opportunity to decide on the Community design and interpretation of the rules governing this matter in actions that can follow two different procedural paths. In the first case we refer to the action brought before the Court against a decision of the Office for Harmonization in the Internal Market (OHIM). In this situation we must distinguish between actions that may or may not be led by a proceeding before the Board of Appeal of the Office. In a second case, we are in the presence of the preliminary procedure raised by national courts. Regarding action against the decision of OHIM the approach will be different, taking into account several reasons. First, we have to identify the nature of the action: are we in the presence of an action for annulment in the ordinary sense? The second reason is imposed by the existence of specific differences related to intellectual property rights litigation, compared to other European court procedures. This paper is considering CJEU case law and implications of the new Rules of Procedure of the Court of Justice.*

**Keywords:** *community design, new rules of procedure, action in annulment, Court of Justice of the European Union.*

## Introduction

Invalidity proceedings against registered Community designs (CDR) are at utmost importance, as CDR are not examined for novelty and individual character prior to registration. A CDR can be declared invalid by means of two different procedures: directly, by bringing an invalidity action before OHIM or by a Community design court on the basis of a counterclaim in infringement proceedings. The appeal proceedings against an OHIM decision can imply three stages: the proceeding in front of the Boards of Appeal of OHIM, of The General Court and of the Court of Justice.

The present paper analyse the specific characteristics implied by the proceedings in front of the Court of Justice of the European Union.

The importance of this studied matter is based on the complexity of systematization of the procedural framework of the Community design protection. The reason is the institutional interference of protection afforded at the Union and national level. The analysis of specific questions regarding the enforcement of intellectual property rights is thus a contribution to clarifying Community design protection.

Thus, we have considered in the content of this material the specificity of the subject matter regarding the action before the Court of Justice against decisions of OHIM, the parties, the proceedings, terms and effects of the action.

Given that, seemingly, European primary law does not confer to the European level legislative competence of in the field of intellectual property law, the Court of Justice jurisprudence maintains its central importance as the foundation of Community intellectual property law. The specifics of the relationship between the Court and the field of intellectual property were outlined by legal literature from different perspectives. We are considering approaches centred on the interaction

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\* Assistant Lecturer, PhD, Faculty of Law, "Nicolae Titulescu" University of Bucharest (e-mail:alinaconea@gmail.com).

of intellectual property rights with EU primary law (David Keeling, 2003<sup>1</sup>), with the internal market and competition rules (Inge Govaere<sup>2</sup>; Valentine Korah, 2006<sup>3</sup>; Catherine Barnard, 2007<sup>4</sup>), issue of "judicial activism" (Vlad Constantinesco, 2000<sup>5</sup>) and normative significance of "case law" (Anthony Arnall, 2006<sup>6</sup>). Thus, it was shown the need to develop a coherent jurisprudence of intellectual property in the interest of the Union legal unity and its independent intellectual property policy (Hanns Ullrich, 2010<sup>7</sup>). It has also been stressed the coherence of EU judicial system that does not rely solely on the courts of the Union, but rather, on the articulated system of jurisdiction between the EU Court and national courts (Koen Lenaerts, 2007<sup>8</sup>).

### Preliminary Issues

The Court of Justice of the European Union is able to rule on the Community design and the interpretation of rules governing the matter in actions that come on two different procedural paths.

In the first case we refer to the action brought before the Court against a decision of the Office. And, in this case, it must be distinguished from actions that may or may not be preceded by a proceeding before a Board of Appeal of the Office. In a second case, we are in the presence of the preliminary procedure raised by national courts.

*Preliminary procedure* has no special features regarding intellectual property rights. Is the same, irrespective of the subject matter. In this respect, we believe that an analysis of the preliminary procedure it would go beyond the selected object of our study. However, the issue is of particular interest in the dynamics of the relationship between national courts and the Court of Justice. As far as procedural aspects are relevant, they will be the subject our presentation.

Regarding *action against the decision of OHIM* approach will be different, taking into account several reasons. First, we must establish the nature of the action: are we in the presence of an action for annulment in the ordinary sense? Or the action has a different nature?

The second reason is imposed by the existence of specific differences related to intellectual property rights disputes, compared to other European court procedures. It should be mention that the latter does not apply to actions brought directly against Office, without a proceeding before a Board of Appeal of OHIM. In the following, we present the procedural way in which action before the Court is preceded by an action before a Board of Appeal of the Office.

According to Regulation no. 6/2002 on Community designs "actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals"<sup>9</sup>. Under art. 61 of the

<sup>1</sup> David T. Keeling, *Intellectual property rights in EU law. Volume 1, Free movement and competition law*. Oxford: Oxford University Press, 2003.

<sup>2</sup> Inge Govaere, *The Use and Abuse of Intellectual Property Rights in E.C. Law: Including a Case Study of the E.C. Spare Parts Debate*. London ; Toronto, Sweet & Maxwell, 1996.

<sup>3</sup> Valentine Korah, *Intellectual property rights and the EC competition rules*. Oxford: Hart, 2006

<sup>4</sup> Catherine Barnard, *The substantive law of the EU*. 2nd ed. Oxford: Oxford Univ. Press, 2007.

<sup>5</sup> Vlad Constantinesco, "The ECJ as a law-maker: *Praeter aut contra legem?*", p. 73-79 in O'Keefe, David, *Judicial review in European Union law- Liber amicorum in honour of Lord Slynn of Hadley*. The Hague: Kluwer Law International, 2000.

<sup>6</sup> Anthony Arnall, *The European Court of Justice*. Oxford: Oxford University Press, 2006.

<sup>7</sup> Hanns ULLRICH, "The Development of a System of Industrial Property Protection in the European Union: The Role of the Court of Justice (Die Entwicklung Eines Systems Des Gewerblichen Rechtsschutzes in Der Europäischen Union: Die Rolle Des Gerichtshofs)." *Max Planck Institute for Intellectual Property, Competition & Tax Law Research Paper* 10-11 (2010).

<sup>8</sup> Koen Lenaerts, "The rule of law and the coherence of the judicial system of the European Union." *Common Market Law Review* 44 (2007): 1625-59.

<sup>9</sup> Art. 61 (1), Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, *OJ L* 3, 5.1.2002, p. 1-24.

Regulation no. 6/2002, the Court of Justice has jurisdiction *to annul* or *to alter* the contested decision<sup>10</sup>.

From the perspective of the nature of this form of procedure, according to an opinion, which we share, the appeal before the Court of Justice is not a form of appeal, but a judicial review of decisions of the Office<sup>11</sup>. The effect of that new legal remedy is, however, similar to an appeal since, for example, all parties in proceedings before the Office can take part<sup>12</sup>.

Moreover, the right to request review by a judicial procedure is guaranteed by the TRIPs Agreement if the OHIM Boards of Appeal are considered administrative and not judicial bodies. Art. 41 (4) from TRIPs Agreement stated that: "*Parties to a proceeding shall have an opportunity for review by a judicial authority of final administrative decisions and, subject to jurisdictional provisions in a Member's law concerning the importance of a case, of at least the legal aspects of initial judicial decisions on the merits of a case. However, there shall be no obligation to provide an opportunity for review of acquittals in criminal cases*".

In the case of *ex parte* proceedings, the action is similar to review of any other decision of a Community institution. In the case of *inter partes* actions, the Office has the identity of the defendant and, in fact, replace the party in whose favour has decided. To enable all parties in proceedings before the Office to behave independently in the action before the ECJ, it have been operated a number of changes to procedural rules of the court in Luxembourg. Consequently, the part for which the Office has decided can not only intervene alongside the Office but it can present their own arguments, and can introduce their own appeal against the court decision.

#### **Subject of proceedings before the Court of Justice against decisions of OHIM (preceded by a proceeding before a Board of Appeal)**

The subject of proceedings before the Court of Justice is represented by decisions of the Boards of Appeal of the Office through which they adjudicate on an appeal.

Under article 61 of the Regulation no. 6/2002, the Court of Justice has jurisdiction *to annul* or *to alter* the contested decision<sup>13</sup>. Therefore, in addition to its power to annul a decision of the Board of Appeal of the Office, the Court has unlimited jurisdiction *to alter* the Board's decision and replace it with its own<sup>14</sup>. Accordingly, the Court has no jurisdiction to rule on a request presented for the first time before it<sup>15</sup>.

Article 61 (2) of the regulation provides that an action against a decision of the Board of Appeal of the Office may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of the Regulation or of any rule of law relating to their application or misuse of power. It follows that the General Court has jurisdiction to conduct a

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<sup>10</sup> Art. 61 (3), Regulation No 6/2002.

<sup>11</sup> Koen LENAERTS, *Procedural law of the European Union*, London: Sweet & Maxwell, 2006, p. 494.

<sup>12</sup> David MUSKER, *Community Design Law: Principles and Practice*. London: Sweet & Maxwell, 2002, p. 206.

<sup>13</sup> Judgment of the Court of First Instance (Fourth Chamber) of 12 December 2002, eCopy, Inc. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-247/01, *European Court reports 2002 Page II-05301*; Judgment of the Court of First Instance (Fifth Chamber) of 23 November 2004, Frischpack GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-360/03, *European Court reports 2004 Page II-04097*.

<sup>14</sup> Judgment of the Court (Fifth Chamber) of 18 September 2003, Albacom SpA (C-292/01) and Infostrada SpA (C-293/01) v Ministero del Tesoro, del Bilancio e della Programmazione Economica and Ministero delle Comunicazioni, Joined cases C-292/01 and C-293/01, *European Court reports 2003 Page I-09449* reported by Koen LENAERTS, *Procedural law of the European Union*, London: Sweet & Maxwell, 2006, p. 495.

<sup>15</sup> **Judgment of the Court of First Instance (Second Chamber) of 2 July 2002, SAT.1 SatellitenFernsehen GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-323/00, *European Court reports 2002 Page II-02839*, para. 18.**

full review of the legality of OHIM's assessment of the particulars submitted by an applicant<sup>16</sup>. The General Court is called upon to assess the legality of the decisions of the Boards of Appeal of OHIM by reviewing their application of Community law, having regarded, in particular, to the facts which were submitted to them. Thus, the Court can carry out a full review of the legality of the decisions of OHIM's Boards of Appeal, if necessary examining whether those boards have made a correct legal classification of the facts of the dispute or whether their assessment of the facts submitted to them was flawed<sup>17</sup>.

Admittedly, the General Court may afford OHIM some latitude, in particular where OHIM is called upon to perform highly technical assessments, and restrict itself, in terms of the scope of its review of the Board of Appeal's decisions in design matters, to an examination of manifest errors of assessment<sup>18</sup>.

Those documents, produced for the first time before the Court, cannot be taken into consideration. The purpose of actions before the General Court is to review the legality of decisions of the Boards of Appeal of OHIM as referred to in Article 61 of Regulation No 6/2002, so it is not the Court's function to review the facts in the light of documents produced for the first time before it. Accordingly, the abovementioned documents must be excluded, without it being necessary to assess their probative value<sup>19</sup>.

## Parties

### The defendant

In the case of *inter partes* actions, the Office has the identity of the defendant and, in fact, replace the party in whose favour has decided.

### The applicant

The action shall be open to any party to proceedings before the Board of Appeal adversely affected by its decision<sup>20</sup>. The parties to the proceedings before the Board of Appeal other than the applicant may participate, as interveners.

For the purposes of determining whether an applicant is entitled to challenge a decision of the Board of Appeal before the Court, the view must be taken that a decision of a Board of Appeal of OHIM does not uphold the claims of a party when it rules on an application filed before OHIM by that party in a manner unfavourable to it. This case must be regarded as including the situation where the Board of Appeal, after having rejected an application the admission of which would have ended the proceedings before OHIM in a manner favourable to the party which made it, remits the case to the lower department for further prosecution, irrespective of the fact that that re-examination could give rise to a decision favourable to that party<sup>21</sup>.

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<sup>16</sup> Judgment of the Court (Grand Chamber) of 5 July 2011, *Edwin Co. Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case C-263/09 P., *European Court reports 2011*, para. 52.

<sup>17</sup> Judgment of the Court (First Chamber) of 18 December 2008, *Les Éditions Albert René Sàrl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) and Orange A/S*, Case C-16/06 P, *European Court reports 2008 Page I-10053*, p. 38 and 39.

<sup>18</sup> Judgment of the Court (Fourth Chamber) of 20 October 2011, *PepsiCo, Inc. v Grupo Promer Mon Graphic SA*, Case C-281/10 P., *European Court reports 2011*, p. 67.

<sup>19</sup> Judgment of the General Court (Fifth Chamber) of 18 March 2010, *Grupo Promer Mon Graphic, SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-9/07, *European Court reports 2010 Page II-00981*, p. 24; Judgment of the General Court (Second Chamber) of 13 November 2012, *Antrax It Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined cases T-83/11 and T-84/11, *European Court Reports 2012*, p. 28.

<sup>20</sup> Art. 61 (4), Regulation No 6/2002.

<sup>21</sup> Judgment of the General Court (Third Chamber) of 14 December 2011, *Völkl GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-504/09, *European Court reports 2011*, p. 27-28.

## Interveners

### *Privileged interveners in the matter of intellectual property rights*

The Rules of procedure of the Court of First Instance admits that the parties to the proceedings before the Board of Appeal other than the applicant may participate, *as interveners*, in the proceedings before the General Court by responding to the application in the manner and within the period prescribed<sup>22</sup>.

The interveners have *the same procedural rights* as the main parties. They may support the form of order sought by a main party and they may apply for a form of order and put forward pleas in law independently of those applied for and put forward by the main parties.

Thus, an intervener may seek an order *annulling* or *altering* the decision of the Board of Appeal *on a point not raised* in the application and put forward *pleas in law not raised* in the application.<sup>23</sup> However, such submissions seeking orders or putting forward pleas in law in the intervener's response shall cease to have effect should the applicant discontinue the proceedings.

The role granted to intervener is reemphasized in case of impossibility of applying the proceedings by default under certain conditions. Therefore, in derogation from Article 122 of the Rules of procedure of the Court of First Instance<sup>24</sup>, the default procedure shall not apply where an intervener has responded to the application in the manner and within the period prescribed.

### *Ordinary interveners*

According to the Statute of the Court of Justice of the European Union, "Member States and institutions of the Union may intervene in cases before the Court of Justice"<sup>25</sup>. Member States and institutions of the Union are, according to the general rules of procedure before the Court of Justice, *privileged* interveners in the sense that they do not have to establish an interest in the outcome of the case<sup>26</sup>. An application to intervene shall be limited to supporting the form of order sought by one of the parties. This category of interveners is not able to put forward pleas in law independently of those applied for and put forward by the main parties.

The special provisions, as shown above, in the contentious intellectual property rights constitute an *exception* to this general rule. For this reason and in this context, we call *ordinary* the interveners that are generally *privileged*.

## The proceedings

### The competent court

Regarding the jurisdiction between the instances of the Court of Justice of the European Union, art. 256 (1) TFEU<sup>27</sup> and art. 51 of the Statute of the Court of Justice of the European Union confer this jurisdiction to the General Court. *An appeal* to the General Court decision may be brought before the Court of Justice. As provided by the Statute of the Court, an appeal to the Court of Justice shall be *limited to points of law*. The appeal shall lie on the grounds of lack of competence of the

<sup>22</sup> Art. 134 (1) Rules of procedure of the Court of First Instance of the European Communities of 2 May 1991 OJ L 136, 30.5.1991, p. 1–23, as amended until 22.6.2011.

<sup>23</sup> Art. 134 (3) Rules of procedure of the Court of First Instance.

<sup>24</sup> „If a defendant on whom an application initiating proceedings has been duly served fails to lodge a defence to the application in the proper form within the time prescribed, the applicant may apply to the General Court for judgment by default.” Art. 122 (1), Rules of procedure of the Court of First Instance.

<sup>25</sup> Art. 40, Protocol (No 3) on the Statute of the Court of Justice of the European Union, annexed to the Treaties, as amended by Regulation (EU, Euratom) No 741/2012 of the European Parliament and of the Council of 11 August 2012 (OJ L 228, 23.8.2012, p. 1).

<sup>26</sup> Koen LENAERTS, *Procedural Law of the European Union*. London: Sweet & Maxwell, 2006, p.569 .

<sup>27</sup> Treaty on the Functioning of the European Union, (Consolidated version 2012), OJ C 326, 26.10.2012, p. 47-199

General Court, a breach of procedure before it which adversely affects the interests of the appellant as well as the infringement of Union law by the General Court<sup>28</sup>.

### Particular aspects of the written procedure

#### *The application*

According to article 132(3) of the Rules of procedure of the General Court, the application shall contain<sup>29</sup> *the names of all the parties* to the proceedings before the Board of Appeal and the addresses which they had given for the purposes of the notifications to be effected in the course of those proceedings. Consequently, the contested decision of the Board of Appeal shall be appended to the application. It also must be indicated the date on which the applicant was notified of that decision.

If the application does not comply with these aspects, article 44(6) of the Rules of procedure of the General Court shall apply<sup>30</sup>.

The Registrar will *inform* the Office and all the parties to the proceedings before the Board of Appeal of the lodging of the application. He will arrange for service of the application after determining *the language of the case*<sup>31</sup>.

The application shall be served on the Office, as defendant, and on the parties to the proceedings before the Board of Appeal other than the applicant. Service shall be effected in the language of the case.

With regard to the communication of the application, the Rules of procedure stated that it will be served on *the Office, as defendant*, and on *the parties to the proceedings before the Board of Appeal* other than the applicant. Service shall be effected in the language of the case<sup>32</sup>. Once the application has been served, the Office shall forward to the General Court *the file relating to the proceedings before the Board of Appeal*.

<sup>28</sup> Art. 58, Statute of the Court of Justice of the European Union.

<sup>29</sup> Without prejudice to Article 44 Rules of procedure of the Court of First Instance of the European Communities of 2 May 1991 *OJL 136, 30.5.1991, p. 1–23*, as amended to 22.6.2011.

<sup>30</sup> „ (...) the Registrar shall prescribe a reasonable period within which the applicant is to comply with them whether by putting the application itself in order or by producing any of the above-mentioned documents. If the applicant fails to put the application in order or to produce the required documents within the time prescribed, the General Court shall decide whether the non-compliance with these conditions renders the application formally inadmissible”.

<sup>31</sup> „ The language in which the as application is drafted shall become the language of the case if the applicant was the only party to the proceedings before the Board of Appeal or if another party to those proceedings does not object to this within a period laid down for that purpose by the Registrar after the application has been lodged. If, within that period, the parties to the proceedings before the Board of Appeal inform the Registrar of their agreement on the choice, the language of the case, of one of the languages referred to in Article 35(1) that language shall become the language of the case before the General Court. In the event of an objection to the choice of the language of the case made by the applicant within the period referred to above and in the absence of an agreement on the matter between the parties to the proceedings before the Board of Appeal, the language in which the application for registration in question was filed at the Office shall become the language of the case. If, however, on a reasoned request by any party and after hearing the other parties, the President finds that the use of that language would not enable all parties to the proceedings before the Board of Appeal to follow the proceedings and defend their interests and that only the use of another language from among those mentioned in Article 35(1) makes it possible to remedy that situation, he may designate that other language as the language of the case; the President may refer the matter to the General Court.”, Art.131 (2) Rules of procedure of the Court of First Instance of the European Communities of 2 May 1991 *OJL 136, 30.5.1991, p. 1–23*, as amended to 22.6.2011.

<sup>32</sup> „Service of the application on a party to the proceedings before the Board of Appeal shall be effected by registered post with a form of acknowledgment of receipt at the address given by the party concerned for the purposes of the notifications to be effected in the course of the proceedings before the Board of Appeal.”, Art.133 (2), Rules of procedure of the Court of First Instance of the European Communities of 2 May 1991 *OJL 136, 30.5.1991, p. 1–23*, as amended to 22.6.2011.

### *Acts of procedure*

The Rules of procedure of the General Court provides the possibility of the lodging of pleadings not only on behalf of the plaintiff and the defendant.

Therefore, the other parties may, within a period of two months of service upon them of the response<sup>33</sup>, submit a pleading confined to responding to the form of order sought and the pleas in law submitted for the first time in the response of an intervener. That period may be extended by the President on a reasoned application from the party concerned.

The application and the responses may be supplemented by replies and rejoinders by the parties, including the interveners, where the President, on a reasoned application made within two weeks of service of the responses or replies, considers such further pleading necessary and allows it in order to enable the party concerned to put forward its point of view. The President shall prescribe the period within which such pleadings are to be submitted<sup>34</sup>.

The Court clarified, in its judgment of 9 February 2011, Case T-222/09 Ineos Healthcare v OHIM - Teva Pharmaceutical Industries<sup>35</sup>, the Court its case-law on the examination by the Board of Appeal of *facts which are well known*.

According to the Court, the Board of Appeal, when hearing an appeal against decision terminating opposition proceedings, may base its decision only on the facts and evidence which the parties have presented. However, the restriction of the factual basis of the examination by the Board of Appeal does not preclude it from taking into consideration, in addition to the facts expressly put forward by the parties to the opposition proceedings, facts which are *well known*, that is, which are likely to be known by anyone or which may be learnt from generally accessible sources<sup>36</sup>.

### **Oral part of the procedure**

According to the Rules of Procedure of the *Court of Justice*, on a proposal from the Judge-Rapporteur and after hearing the Advocate General, the Court may decide *not to hold a hearing* if it considers, on reading the written pleadings or observations lodged during the written part of the procedure, that it has sufficient information to give a ruling<sup>37</sup>.

The Rules of Procedure of the *General Court* do not contain a similar provision. In other words, the General Court proceedings will *always* contain the hearing stage.

The contentious matters on intellectual property benefits, however, for an exception to the normal conduct of proceedings before the General Court.

After the submission of pleadings and, if applicable, the General Court, acting upon a report of the Judge-Rapporteur and after hearing the Advocate General and the parties, may decide to rule on the action without an oral procedure. If one of the parties submits an application<sup>38</sup> setting out the reasons for which he wishes to be heard then will take place also the hearing stage.

### **Reasoning of the action**

Article 61 (2) of the Regulation provides that “the action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power.”

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<sup>33</sup> The defence include: the name and address of the defendant; the arguments of fact and law relied on; the form of order sought by the defendant; the nature of any evidence offered by him. Art.46 (1), Rules of procedure of the General Court.

<sup>34</sup> Art.135 (3) **Rules of procedure of the General Court**.

<sup>35</sup> Judgment of the General Court (Fourth Chamber) of 9 February 2011, Ineos Healthcare Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-222/09, *European Court reports 2011 Page II-00183*.

<sup>36</sup> Judgment of the General Court (Fourth Chamber) of 9 February 2011, Ineos Healthcare Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-222/09, *paras 28-29*.

<sup>37</sup> Art. 76 (2), Rules of Procedure of the Court of Justice, *OJ C 337, 6.11.2012, p. 1-42*.

<sup>38</sup> The application shall be submitted within a period of one month from notification to the party of closure of the written procedure.

These reasons are similar to those established for the action for annulment under art. 263 TFEU<sup>39</sup>.

The doctrine distinguishes between the first two grounds of appeal, *lack of competence* and *infringement of essential procedural requirement*, aspects of external legality of the act (“la légalité externe”) and the last two grounds of appeal, *infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of* („la légalité interne”)<sup>40</sup>.

The distinction is relevant from the perspective that the external legality reasons of the contested measure may be raised by the court on its own initiative. The last two reasons must be raised by the parties.

In the judgment of 16 May 2011, case T-145/08 Atlas Transport v OHIM - Atlas Air<sup>41</sup>, the Court was able to clarify, first, the applicable requirements as regards the obligation to set out the grounds of an appeal before the Board of Appeal. The Court concluded from this that an appellant wishing to bring an appeal before the Board of Appeal is required, within the prescribed time-limit, to file with OHIM a written statement setting out the grounds for its appeal, failing which his appeal is to be dismissed as inadmissible, and that those grounds involve more than an indication of the decision appealed and of the fact that the appellant wishes it to be amended or annulled by the Board of Appeal.

#### Special features of the action

It is considered<sup>42</sup> that the particulars of the proceedings before the Court regarding the action that we present come from the following specific issues:

1) Connection with *Article 263* of the Treaty on the Functioning of the European Union regarding the grounds of appeal;

2) *Revision of the contested decision* - The legality of a decision of the Board of Appeal cannot therefore be called into question by pleading new facts before the General Court. So it must be evaluated according to the facts and law existing at the time the decision was taken<sup>43</sup>;

3) *The application must refer to a decision of the Boards of Appeal* - actions may be brought before the Community judicature only against decisions of the Boards of Appeal. Accordingly, in the case of such appeals, it is only pleas directed against the decision of the Board of Appeal itself which are admissible in such an action. In so far as it relates to a decision of a unit of the Office, giving a ruling at first instance, a plea of infringement of a legislative provision must, in consequence, be rejected as being inadmissible<sup>44</sup>.

4) *The pleading should not change the subject-matter of the proceedings* - Art. 135 (4) of the Rules of procedure of the General Court states that the parties’ pleadings may not change the subject-

<sup>39</sup> Art. 263 (2) TFEU „It shall for this purpose have jurisdiction in actions brought by a Member State, the European Parliament, the Council or the Commission on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaties or of any rule of law relating to their application, or misuse of powers”.

<sup>40</sup> Georges VANDERSANDEN, Ami BARAV, *Contentieux communautaire*. Bruxelles: Bruylant, 1977, cited by Koen Lenaerts, op.cit, p. 289.

<sup>41</sup> Judgment of the General Court (Third Chamber) of 16 May 2011, Atlas Transport GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-145/08, *European Court reports 2011*.

<sup>42</sup> Koen LENAERTS, *Procedural law of the European Union*, London: Sweet & Maxwell, 2006, p.498.

<sup>43</sup> Judgment of the Court of First Instance (Fourth Chamber) of 12 December 2002, eCopy, Inc. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-247/01, *European Court reports 2002*.

<sup>44</sup> Judgment of the Court of First Instance (Fifth Chamber) of 7 June 2005, Lidl Stiftung & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-303/03, *European Court reports 2005 Page II-01917*.

matter of the proceedings before the Board of Appeal<sup>45</sup>. Pleas which have not been raised by the applicant before the departments of OHIM are not admissible before the Court<sup>46</sup>.

### Deadlines

Actions may be brought before the Court of Justice against decisions of the Boards of Appeal on appeals<sup>47</sup>.

### Effects of the action

The General Court has jurisdiction *to annul* or *to alter* the decision of the Board of Appeal of the Office. The annulment of the judgment has the same characteristics as the declaration of invalidity made pursuant to art. 263 TFEU<sup>48</sup>. Consequently, the effects will be retroactive, *ex tunc*, and will apply erga omnes.

According to Regulation no 6/2002, The Office shall be required to take the necessary measures to comply with the judgment of the Court of Justice<sup>49</sup>. Moreover, this provision of the Regulation was correlative to Art. 266 TFEU: “The institution whose act has been declared void or whose failure to act has been declared contrary to the Treaties shall be required to take the necessary measures to comply with the judgment of the Court of Justice of the European Union”.

### Conclusions

Under article 61 of the Regulation no. 6/2002, the Court of Justice has jurisdiction *to annul* or *to alter* a decision of the Board of Appeal of OHIM. From the perspective of the nature of this form of procedure the appeal before the Court of Justice is not a form of appeal, but a judicial review of decisions of the Office. The effect of that new legal remedy is, however, similar to an appeal since, for example, all parties in proceedings before the Office can take part.

In the case of *ex parte* proceedings, the action is similar to review of any other decision of a Community institution. In the case of *inter partes* actions, the Office has the identity of the defendant and, in fact, replace the party in whose favour has decided. To enable all parties in proceedings before the Office to behave independently in the action before the ECJ, it have been operated a number of changes to procedural rules of the court in Luxembourg. Consequently, the part for which the Office has decided can intervene alongside the Office. This category of interveners has *the same procedural rights* as the main parties. They may support the form of order sought by a main party and they may apply for a form of order and put forward pleas in law independently of those applied for and put forward by the main parties.

In addition, the specific features of the proceedings before the Court regarding the intellectual property contentious matters come out from the following: the legality of a decision of the Board of Appeal cannot be called into question by pleading new facts before the General Court, the Court may decide to rule on the action without an oral procedure, the actions may be brought before the Community judicature only against decisions of the Boards of Appeal, the pleading should not change the subject-matter of the proceedings.

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<sup>45</sup> Judgment of the Court of First Instance (Fifth Chamber) of 23 November 2004, Frischpack GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-360/03, *European Court reports 2004 Page II-04097*.

<sup>46</sup> Judgment of the General Court (Eighth Chamber) of 9 December 2010, Tresplain Investments Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-303/08, *European Court reports 2010 Page II-05659*.

<sup>47</sup> Art. 61 Regulation No 6/2002.

<sup>48</sup> Koen LENAERTS, *Procedural law of the European Union*, London: Sweet & Maxwell, 2006, p.500.

<sup>49</sup> Art. 61 (6), Regulation No 6/2002.

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