



POSSIBLE ROLE OF FUTURE UPOV GUIDANCE IN CASES BEFORE THE COURT

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Topics

General theme: Crystal ball gazing through the prism of OHIM

- 1) Specific context of OHIM and the historical need for guidelines
- 2) Trends and developments in the treatment of OHIM guidelines by the Courts
- 3) Current elaboration process of OHIM guidelines
- 4) Conclusions



Specific context of OHIM and historical need for guidelines

- OHIM (Office for Harmonization in the Internal Market) grants registration protection for Community trade marks and designs at EU level.
- Since 1 April 1996 OHIM issues *ex parte* and *inter partes* decisions at first instance, that are appealable to the Boards of Appeal.
- Board of Appeal decisions are then appealable to the General Court of the EU and, on a point of law, to the Court of Justice of the EU.
- The mix of nationalities and legal cultures of OHIM examiners made it imperative to draw up *sui generis* guidelines before operations commenced.
- The EU judges in Luxembourg were experienced in competition and EU institutional law but were on a 'learning curve' with EU trade mark and design law.
- OHIM written pleadings before the EU judges sought to guide them.



Trends and developments in the treatment of OHIM guidelines by the Courts

- National decisions or judgments do not bind the Boards, and the same applies to OHIM guidelines and to decisions by the Office or the Boards themselves.
- OHIM guidelines bind examiners but not the Boards of Appeal. The Board views them as general instructions – not of a legislative nature and not exhaustive – but in constant evolution.
- However, guidelines are sometimes cited with approval as additional support for a particular finding (e.g. the guideline definitions of 'nature' and 'purpose' of goods in an *inter partes* context (R-1730/2008-4, JIMI HENDRIX / EXPERIENCE HENDRIX II, para. 28)
- The General Court and the Court of Justice reflect the Boards' approach: cases should be decided under the 'Community trade mark regulations, as interpreted by the Community judicature, and not on the basis of a previous practice of the Office (judgement of 12 January 2006, C-173/04, para. 48.)



Trends and developments in the treatment of OHIM guidelines by the Courts (continued)

- ‘Th[e] guidelines are merely a set of rules setting out the line of conduct which OHIM proposes to adopt’ (Case T-124/09, para. 20) and are ‘not binding legal acts for the purposes of interpreting provisions of European Union law’ (Case C-149/11, para. 48)
- The Courts admit the theoretical possibility of the guidelines creating legitimate expectations but find, on the facts of the case, that it was something else (e.g. the appellant’s own unilateral act rather than the guidelines) creating the expectations.
- But sometimes the Courts cite OHIM guidelines with approval – e.g. Case T-267-11, para. 20, on the interpretation of ‘all due care in circumstances’ given in OHIM guidelines on *restitutio in integrum*.
- The guidelines of the Standing Committee on the law of Trade Marks of WIPO on well-known marks, September 1999, are applied by OHIM and the UK Courts and are contained in the legislation of the Ukraine and the Baltic States.



Current elaboration process of OHIM guidelines

Knowledge circles (with Board of Appeal representatives)



Incorporation of trade mark and design Board of Appeal decisions and EU judgments



Incorporation of comments of EU Member State industrial property offices



Incorporation of comments of user groups (owners and legal practitioners)



Final guidelines

= Broadening stakeholders and converging practices with a view to strengthening the guidelines



Conclusions

- The Courts are generally not well disposed to OHIM guidelines but they may sometimes see them as an additional reason for reaching a finding.
- UPOV is not OHIM. The matters UPOV deals with are more technical and will concern infringement as well as registration issues. Courts may feel less comfortable with the subject matter and thus be more ready to refer to guidelines. The international standing of UPOV may help in the same way as WIPO guidance on well known marks.
- Guidelines that embrace a broad spectrum of stakeholders and interests may be more credible and persuasive for the Courts.



THE END

THANK YOU FOR YOUR ATTENTION!