

**Decision 2009-3 of 10 December 2009 of the Presidium of the Boards of Appeal  
CONCERNING INSTRUCTIONS TO THE REGISTRY OF THE BOARDS OF APPEAL**

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**THE PRESIDIUM OF THE BOARDS OF APPEAL**

Having regard to Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community Trade Mark<sup>1</sup> (hereinafter referred to as 'CTMR'), in particular Article 136(1) thereof,

Having regard to Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs<sup>2</sup> (hereinafter referred to as 'CDR'), and in particular Articles 97 and 108 thereof,

Having regard to 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)<sup>3</sup> (hereinafter referred to as 'RP'), and in particular Articles 1(6) and 5(5) thereof,

Having regard to Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark<sup>4</sup> (hereinafter referred to as 'CTMIR'),

Having regard to Commission Regulation (EC) No 2869/95 of 13 December 1995 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs)<sup>5</sup> (hereinafter referred to as 'CTMFR'),

Having regard to Commission Regulation (EC) No 2245/02 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs<sup>6</sup> (hereinafter referred to as 'CDIR'),

Having regard to Commission Regulation (EC) No 2246/2002 of 16 December 2002 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) in respect of the registration of Community designs<sup>7</sup> (hereinafter referred to as 'CDFR'),

Whereas:

(1) The Presidium of the Boards is competent to lay down the rules and organise the work of the Boards.

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<sup>1</sup> OJ EC L 78, 26.2.2009, p. 1. This Regulation replaces Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.

<sup>2</sup> OJ EC L 3, 5.1.2002, p. 1. Regulation as amended by Annex II to the Act of Accession which inserted Article 110a in the Regulation ( OJ EU L 236, 23.09.2003, p. 344).

<sup>3</sup> OJ EC L 28, 6.2.1996, p. 11. Regulation as last amended by Regulation (EC) No 2082/2004 (OJ EU L 360, 7.12.2004, p. 8).

<sup>4</sup> OJ EC L 303, 15.12.1995, p. 1. Regulation as last amended by Regulation (EC) No 1041/2005 (OJ EU L 172, 5.7.2005, p. 4).

<sup>5</sup> OJ EC L 303, 15.12.1995, p. 33. Regulation as last amended by Regulation (EC) No 1687/2005 (OJ EU L 271, 15.10.2005, p. 14-16).

<sup>6</sup> OJ EC L 341, 17.12.2002, p. 28-53.

<sup>7</sup> OJ EC L 341, 17.12.2002, p. 54-59.

- (2) The Presidium may upon proposal by the President of the Boards of Appeal entrust to the Registry tasks relating to the conduct of proceedings before the Boards,

HAS ADOPTED THE FOLLOWING DECISION:

*ARTICLE 1*

*THE TASKS OF THE REGISTRY*

The Registry shall, inter alia,<sup>8</sup> be responsible, for the receipt, dispatch, safekeeping and notification of all documents relating to the proceedings before the Boards of Appeal and for the compilation of the relevant files.

The Registry 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 including the payment of the appeal fee<sup>9</sup>.

The Registry shall allocate the cases to the Boards of Appeal, in accordance with allocation criteria laid down by the Presidium<sup>10</sup>.

It shall perform any other tasks that are entrusted to it by the applicable legislation and by the present instructions.

*ARTICLE 2*

*ENTRUSTED TASKS*

1. The transfer to the Registry of the execution of a task falling on a Board of Appeal shall not prejudice the competence of the Board to take decisions itself.
  
2. The Registry shall prepare the appeal file for the Boards of Appeal and shall process the communications related to the appeal. In particular, the execution of the following tasks shall be entrusted to the Registry:
  - (a) Notification to the appellant that the appeal does not comply with the provisions of Rules 48 and 49 CTMIR and invitation to remedy the deficiencies noted in a time limit set by the Registry;
  - (b) Notification to the appellant that the appeal is likely to be rejected as inadmissible or to be deemed not to have been filed;
  - (c) Communication of information contained in the files, under Rule 90 CTMIR;
  - (d) Summoning to oral proceedings under Rule 56 CTMIR when directed by the Chairperson of the relevant Board;
  - (e) Summoning to give evidence under Rule 57 CTMIR when directed by the Chairperson of the relevant Board;
  - (f) Notification of loss of rights;
  - (g) Setting the time limit for filing the observations to the statement of the grounds of appeal, the reply and the rejoinder;
  - (h) Granting the continuation of the proceedings as provided for by Article 82 CTMIR and Rule 50(2) CTMIR, pursuant to Article 10 of this Decision;
  - (i) Notification that the Board has decided to extend a time limit under Rule 71 CTMIR;
  - (j) Communication to the other party(ies), for comments, of any act terminating the proceedings within the meaning of Article 85(3) CTMIR;
  - (k) Requesting, where a translation must be filed, a certification of translation under Rule 98(1) CTMIR, when directed by the Chairperson of the competent Board;
  - (l) Requesting parties to file a sufficient number of copies of documents or items of evidence that have to be communicated to other parties in accordance with Rules 69 and 79(a) CTMIR;
  - (m) Communication of documents or items of evidence to the other parties to the proceedings;
  - (n) Inviting parties to sign unsigned documents and laying down a time limit for doing so;

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<sup>8</sup> Article 5(1) RP

<sup>9</sup> Article 5(3) RP

<sup>10</sup> Article 5(5) RP

- (o) Fixing the amount of costs to be paid according to Article 85(6), second and third sentence, CTMR.
- (p) Forwarding to the department whose decision is contested, appeals for revision under Articles 61 and 62 CTMR;
- (q) Communication of experts' written reports to the parties under Rule 58(3) CTMR;
- (r) Where appropriate, communication for agreement to the other party(ies) of the request for extension of a time limit submitted by a party;
- (s) Verifying renewals of the earlier trade marks invoked in the cases.

### ARTICLE 3

#### THE SAFEKEEPING OF DOCUMENTS

The Registry shall ensure that all the documents relating to the appeal procedure are kept by electronic means, or by any other means when appropriate.

### ARTICLE 4

#### THE NUMBERING OF THE CASES

1. When an application initiating proceedings is registered, the case shall be allocated by the Registry<sup>11</sup> to the Boards of Appeal according to the criteria set out by the Presidium which are in force at the moment of the allocation. The cases shall be given a serial number preceded by 'R-' and followed by an indication of the year and the Board to which the case is allocated.
2. Applications for *restitutio in integrum*, applications for continuation of proceedings, applications for rectification of decisions, applications for revocation of decisions and applications related to the fixation of costs relating to an appeal case shall be processed under the same serial number as the original appeal.
3. Where, following a judgment of the Court of Justice or the Court of First Instance, the Boards have to re-examine the case, that case shall keep the number previously given to it when it was before the Boards. Should the Presidium decide to refer that case to a Board different from the one which rendered the annulled decision, the indication of the Board shall be changed accordingly.
4. Where an appeal is reallocated following an agreement between the Chairpersons concerned or the decision of the Presidium and where a case is referred to the Grand Board, the indication of the Board shall be changed accordingly. The number of the Board shall be replaced by the indication 'G' when the case is referred to the Grand Board.
5. The serial number of the case together with the names of the parties, as well as the reference number used by the parties, if any, shall be indicated on the procedural documents and in correspondence relating to the case.

### ARTICLE 5

#### THE MANAGEMENT OF FILES

1. For each appeal the Registry shall prepare a case-file in paper form. The file shall contain all the procedural documents, including their annexes, all evidence in whatever form, produced by the parties, including those whose acceptance is refused, the decisions taken in the case, including any decisions relating to refusal to accept documents, reports for the hearing, minutes of the hearing, notices served by the Registry and any other documents or correspondence to be taken into consideration in deciding the case. Each page of the case-file shall be numbered consecutively, excluding non-standard documents.
2. The case-file shall contain a list of the documents on the file. The list of documents shall mention the date of the relevant documents and a brief description of the nature of the document so that it can easily be located in the case-file. The list of documents shall indicate the page numbers attributed to the said documents in accordance with the last sentence of Article 5(1) of this Decision. The case-file shall also contain a cover page showing the serial number of the case, the parties, their representatives, and the nickname of the case, if any.
3. If in doubt, the Registry shall refer the question of whether a document is to be placed on the case-file to the Rapporteur or the Chairperson of the Board if a Rapporteur is not yet appointed, in order for a decision to be taken.

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<sup>11</sup> Article 5(5) RP

4. At the close of the proceedings, the case-file shall be closed and sent to the archives and the appeal file released four months after the decision has been served. Where an appeal before the Court of First Instance has been filed, the case-file shall be sent to the Industrial Property Litigation Unit as soon as the Registry is informed of the lodging of the appeal.
5. Both in ex parte and in inter partes appeal cases, original items such as catalogues or invoices filed by the parties become part of the files of the respective Community trade mark or design application or registration, in the same way as any other document, and shall be kept in accordance with Rule 91(3) CTMIR.
6. Confidential documents shall be marked as such.

*ARTICLE 6  
REGULARISATION*

1. The Registry shall ensure that documents placed on the file are in conformity with the provisions of the CTMR, CTMIR, RP, CTMFR with these instructions and with any practice directions adopted by the Presidium and the President of the Boards. If necessary, and if the irregularity may be remedied according to the CTMR and CTMIR, it shall allow the parties a period of one month for making good any formal irregularities in the documents lodged or of two months when the party concerned does not have its domicile or its principal place of business or an establishment within the Community.
2. When the empowerment of a representative is at issue, the Registry may undertake all necessary steps, in order to enable it to verify that the provisions of Article 92 CTMR, and Rules 75 and 76 CTMIR have been complied with.
3. Where documents annexed to a pleading or procedural document are not accompanied by a translation into the language of the case, the Registry, on its own motion or instructed by the Rapporteur or the Chairperson if a Rapporteur has not been appointed yet, shall require the party concerned to make good the omission in so far as the translation appears necessary for the efficient conduct of the proceedings.
4. Where a document is refused due to an irregularity which cannot be remedied, the Registry shall inform the party accordingly and allow it a period of one month for comments or of two months when the party concerned does not have its domicile or its principal place of business or an establishment within the Community.

*ARTICLE 7  
ADMISSIBILITY OF APPEALS*

Where the Registry considers that an appeal is vitiated by an irregularity which is liable to render the appeal inadmissible or deemed not to have been filed, it shall, without delay, send a reasoned opinion to the Chairperson of the Board concerned. It shall at the same time inform the appellant of the irregularity and invite the appellant to comment within a prescribed period. The written procedure shall be suspended until the Board decides whether to rule on the admissibility of the appeal under Article 8(1) RP.

*ARTICLE 8  
SERVICE*

1. Service shall be done by telefax.
2. If service in accordance with paragraph 1 is not possible service shall be done by courier service.
3. Service shall be done by courier service if the Rapporteur so requests.
4. The form for acknowledgment of receipt, the receipt, the proof of posting of the registered letter or a document establishing the dispatch by telefax or other technical means of communication shall be kept in the case-file together with the copy of the letter addressed to the person upon whom service was to be effected.

*ARTICLE 9  
SETTING AND EXTENSION OF TIME LIMITS*

1. The parties shall be allowed a period of two months, or of one month where all the parties to which the time limit is granted have their domicile or principal place of business or an establishment within the Community :

- (a) for making good any formal irregularities in the documents lodged, if the irregularity may be remedied according to the CTMR and CTMIR;
- (b) for making good the omission of the translation of documents annexed to pleadings or procedural documents which are not accompanied by a translation into the language of the case;
- (c) for submitting comments to the refusal by the Registry of a document due to an irregularity which cannot be remedied;
- (d) for submitting comments on the apportionment of costs in case of a withdrawal leading to the end of the appeal proceedings.

2. The Registry is entitled to grant extensions of time limits for the submission of the respondent's observations to the appeal where:

- (a) the request for extension is the first such request in the proceedings,
- (b) the extension requested does not exceed two months,
- (c) all parties have agreed to the extension, and
- (d) the request is submitted before the expiry of the period prescribed.

In cases other than this, the Registry shall inform the Chairperson or, if appointed, the Rapporteur of the requested extension and, when necessary, submit to the Chairperson or, if appointed, the Rapporteur, proposals for the extension of time limits.

**ARTICLE 10**  
**CONTINUATION OF PROCEEDINGS**

The Registry shall, after consultation of the Board, grant continuation of the proceedings if all the conditions laid down in Article 82 CTMR are fulfilled.

**ARTICLE 11**  
**HEARINGS AND MINUTES OF HEARINGS**

1. The Registrar shall draw up in the language of the case the minutes of every hearing in accordance with Rule 60 CTMIR. Those minutes shall contain an indication of the case, the date, hour and place of the hearing, an indication of whether the hearing was in public or in camera, the names of the Members and the Registrar present, the name of the parties, the names and capacities of the agents, lawyers or advisers of the parties present, the surnames, forenames, status and permanent addresses of the witnesses or experts examined and an indication of the evidence or documents produced at the hearing and the applications and requests made by the parties.

2. The hearing shall be audio or video recorded, according to the instructions of the Chairperson.
3. The parties shall be provided with a copy of the minutes.

**ARTICLE 12**  
**WITNESSES AND EXPERTS**

1. The Registry shall take the measures necessary for giving effect to orders requiring the taking of an expert opinion or the examination of witnesses.
2. The Registry shall obtain from witnesses evidence of their expenses and loss of earnings and from experts a fee note accounting for their expenses and services.
3. The Registry shall cause sums due to witnesses and experts to be paid.

**ARTICLE 13**  
**REMITTAL OF THE FILE TO THE BOARD**

Where the file is not remitted according to Article 7 of this Decision, the Registry shall remit the file to the Chairperson of the relevant Board as soon as the exchange of submissions between the parties has been completed.

**ARTICLE 14**  
**ORIGINALS OF DECISIONS**

Originals of decisions of the Boards shall be kept in the archives of the Office.

**ARTICLE 15**

**ADVICE FOR PARTIES AND REPRESENTATIVES**

At the request of the parties or their representatives or, if need be, of its own accord, the Registry shall send them a copy of the practice directions adopted by the Presidium and of these Instructions to the Registry or refer them to the website of the Office.

**ARTICLE 16**

**COMMUNICATIONS ON REASSIGNMENTS**

Where a case is reallocated to another Board following the reassignment of the Rapporteur, the decision of the Chairpersons concerned, the decision of the Presidium or the referral to the Grand Board, the Registry shall inform the parties accordingly.

**ARTICLE 17**

**COMMUNICATIONS ON DEVOLUTION TO A SINGLE MEMBER**

The Registry shall inform the parties of the decision to devolve a case to a single Member as soon as it has been taken.

**ARTICLE 18**

**REVISION**

If the department whose decision is contested does not consider the appeal admissible and well founded within the prescribed time limit after the receipt of the statement of grounds, the Registry shall resume the appeal procedure without further delay.

**ARTICLE 19**

**DOCUMENTS WHICH HAVE NOT REACHED THE BOARD**

On its own motion or upon request of the Rapporteur, the Registry shall verify whether any new document or information relating to an appeal has not yet been drawn to the attention of the Board and if so remit it to the Board.

**ARTICLE 20**

**STANDARD LETTERS**

The standard letters sent by the Registry shall be submitted to the Presidium, where the President of the Boards or one of its members considers it appropriate to obtain its approval.

**ARTICLE 21**

**PROCEEDINGS RELATING TO COMMUNITY DESIGNS**

1. The present instructions shall apply, mutatis mutandis, to the proceedings governed by the CDR, CDIR and CDFR.
2. The Registrar shall take all measures necessary to ensure the confidentiality appropriate to the proceedings concerning Community designs and shall ensure that relevant information is accessible only to the persons determined by the President of the Boards. He/she shall inform the President of the Boards of Appeal and the Chairperson of the relevant Board of the measures taken.

**ARTICLE 22**

**OTHER ACTIONS**

When the Registry considers that an action should be taken for which it has not received appropriate delegation or instructions, it shall inform the President of the Boards accordingly.

**ARTICLE 23**

**REPLACEMENT OF THE REGISTRAR**

The Registry shall be headed by a Registrar. The President of the Boards 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.

*ARTICLE 24*  
*DEROGATIONS*

Where the special circumstances of a case and the proper administration of proceedings require, the Presidium or the Boards may derogate from any provision of this decision.

*ARTICLE 25*  
*REPEAL OF PREVIOUS DECISIONS*

This Decision repeals and replaces the decision of the Presidium of the Boards of Appeal of 16 October 2006 concerning Instructions to the Registry and the decision of the Presidium of the Boards of Appeal of 10 May 2006 concerning Change of practice: notification of decisions of the Boards of Appeal and time limits granted at the appeal stage.

*ARTICLE 26*  
*ENTRY INTO FORCE*

This decision shall enter into force on 1 January 2010. It shall be published in the Official JOURNAL OF THE OFFICE.

Done at Alicante, 10 December 2009

*For the Presidium*  
*The Chairperson of the Presidium*  
Paul Maier