

EU: Delay of opposition proceedings.

In its *Capella vs EUIPO* decision of 16 March 2017 (case no. T-473/15), the Court of Justice of the EU (CJEU) that in case of an improper limitation of the contested trademark application the Opposition Division of the EUIPO must not decide upon the opposition unless it has informed the applicant of the impropriety of the limitation and has given the opportunity to rectify the mistake.

In the underlying case, the owner of trademark ABUS had opposed an EU trademark application for ABUS that initially covered “vehicles and parts and accessories thereof”.

During the appeal proceedings, the applicant restricted the application two times. Each time, the Board of Appeal advised the applicant that it would decide on the restriction within its decision on the appeal. The decision was then made on the basis of the first restriction as it considered the second restriction inadmissible. The applicant filed an action to the General court of the EU, arguing that the BoA had violated the applicant’s right to be heard.

The General Court decided in favor of the applicant and lifted the BoA’s decision. The BoA should have advised the applicant of the inadmissibility of the second restriction to allow the applicant to comment on the BoA’s view and possibly cure the mistake.

While this decision safeguards the position of the applicant and avoids unfavorable surprises, it can easily be abused to delay opposition proceedings. An applicant who is interested in a delay of the proceeding e.g. because he is expecting a negative decision can apply for a improper restriction of the trademark application to get a notice of inadmissibility and a period of several months to cure the mistake. As a trademark application can be restricted any time, this can be done in any stage of the proceedings and repeatedly.

As this decision will apply not only to opposition proceedings but also to invalidation proceedings, it will be possible to substantially delay the invalidation of an EU trademark.

If you have any questions or if you require more detailed information, please do not hesitate to contact us.

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