



European Communities Trade Mark Association

ECTA comments on OHIM's note of February 2010 on suspensions and extensions of time in opposition proceedings

As a preliminary observation, ECTA praises OHIM's initiative: clarity and predictability are certainly important aspects of the CTM system, all the more so in relation to important practical aspects of opposition proceedings such as suspensions and extensions of time.

Our comments regarding the OHIM's note of February 2010 (presented at the OAMI Users Group Meeting of 15 March 2010) on suspensions and extensions of time in opposition proceedings are as follows:

- ***Suspensions***

The change of practice suggested for suspension is a sensible one and ECTA sees no objection to its implementation.

- ***Extensions of time***

ECTA disagrees with the solution proposed in relation to extensions, i.e. first request automatically granted, the second one granted only exceptional cases of force majeure and ECTA would not like to see it implemented.

First of all, the proposal might not be compatible with Rule 71 CTMIR. The "ratio legis" of establishing time limits in this kind of proceedings is to avoid the undue prolongation of proceedings. The proposal of the Office unduly permits this prolongation and abuse by one of the parties in detriment to the other. Rule 71.2 purposely establishes that those extensions "may" be given by OHIM "subject" to the agreement of the other parties.

Thus, ECTA feels that OHIM should diligently apply the rule (which does not currently always seem to be properly applied in all cases) and only grant the extensions when the circumstances justify it. The proposal of the Office may simplify things at its end but does not really seem to add any benefit to users.

Furthermore ECTA notes that the concept of force majeure may be impossible or very difficult to meet and also deviates from Rule 71. It would seem to be too strict of a standard, bringing unwelcomed uncertainties, the elimination of which was precisely the reason behind the proposed change of practice. If OHIM wants to adopt such a concept it would first need to be defined more in detail.

However, ECTA looked, albeit briefly and not exhaustively, into OHIM case law to get at least an approximate idea of how this concept has been interpreted by the Office. In the Decision of 13 September 2006 in Case R 628/2006-2 [SIDESCAN] the Second Board of Appeal pointed out: "*As to the concept of force majeure, this covers unusual circumstances which make it impossible for the relevant act to be carried out. Even though it does not require absolute impossibility, it does require abnormal difficulties which are independent of the will of the person concerned and which are apparently inevitable even if all due care is taken* [Emphasis added] (see judgment of the Court of Justice of 9 February 1984 in Case C-284/82 *Busseni S.p.A. v Commission* [1984] ECR 557, the paragraph 11).

The concepts of force majeure and unforeseeable circumstances contain an objective element relating to abnormal circumstances unconnected with the individual in question and a subjective element involving the obligation on his or her part to guard against the consequences of the abnormal event by taking appropriate steps without making unreasonable sacrifices. In particular, the individual must pay close attention to the course of the procedure set in motion and, in particular, demonstrate diligence in order to comply with the prescribed time limits (see judgment of the Court of Justice of 15 December 1994 in Case C-195/91 Bayer v Commission [1994] ECR I-5619, paragraph 32). At §§16-17

Likewise, in Decision of the Cancellation Division of 4 April 2007 regarding CTM No. 1 160 183 [CHINAWHITE], the Office remarked: *A further justifiable reason for non-use is cases of force majeure (that is: an unavoidable cause of delay or of failure to perform an obligation in time due to an unpreventable, overwhelming and irresistible force. Relevant events might be earthquakes, epidemics, blockades, wars, acts of sabotage [Emphasis added]) which hinder the normal functioning of the owner's enterprise. (at §37)*

In the light of the above, and assuming those concepts become the test, it seems that a second extension would only be granted in a limited number of cases. However, as said before, this appears a too restricted approach and ECTA believes instead that a second request for extension, if properly justified and grounded could be allowed.

In light of the above considerations and taking into account the uncertainties of the present situation, ECTA suggests as preferable to the proposal as stated, a different approach which may ensure a proper degree of flexibility and where OHIM can evaluate the specific circumstances surrounding the request for (further) extension and decide on the same on a case-by-case basis.

ECTA thus suggests therefore reformulating the proposal as follows:

"Any first request for an extension which is received in time will always be granted independently of the explanation given by the party requesting it.

A second request will need to be properly grounded and the applicant has to convincingly explain why the additional time granted was insufficient to meet the deadline. The Office reserves the right of denying it when it prima facie appears without foundation or it does not seem appropriate under the circumstances.

Further request after the second one will be granted only in exceptional circumstances".

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