

World Trademark Review Daily

ECJ: OHIM has discretion to take into account evidence filed after deadline

European Union - Burges Salmon LLP

**Examination/opposition
International procedures**

July 29 2013

In *New Yorker SHK Jeans v Office for Harmonisation in the Internal Market* (OHIM) (Case C-621/11 P, July 18 2013), the Court of Justice of the European Union (ECJ) has dismissed an appeal brought by *New Yorker SHK Jeans GmbH & Co KG*, deciding that OHIM was entitled to take into account additional evidence of use that had been filed by the opponent after the original deadline for filing proof of use had passed. In doing so, the ECJ has followed its earlier decision in *OHIM v Kaul* (Case C-29/05).

During the course of opposition proceedings concerning its application for the word mark FISHBONE, New Yorker Jeans requested that the opponent provide proof of use of the earlier national mark relied upon for the purposes of the opposition, pursuant to Article 43 of the [Community Trademark Regulation](#) (40/94) (now Article 42 of the [Community Trademark Regulation](#) (207/2009)).

The opponent proceeded to file evidence of use within the deadline given by OHIM, but New Yorker Jeans claimed that such evidence was insufficient to prove genuine use. OHIM gave the opponent a further period within which to submit observations in response. When filing its response, the opponent submitted a number of catalogues as further evidence of use.

When reaching its decision to uphold the opposition, OHIM took the catalogues into account in finding that there was a likelihood of confusion.

The Board of Appeal dismissed an appeal by New Yorker Jeans, deciding that the Opposition Division had been right to take the additional evidence filed by the opponent into account and that there was sufficient evidence of use of the earlier mark. The General Court reached the same conclusion.

On appeal to the ECJ, New Yorker Jeans argued that the General Court had breached Article 42(2) and (3) and Article 76(2) of the Community Trademark Regulation and Article 22(2) of the [Community Trademark Implementation Regulation](#) (2868/95) by finding that OHIM was correct to take into account the additional evidence of use.

Article 76(2) provides that OHIM may disregard facts or evidence that are not submitted within due time. In *OHIM v Kaul*, the ECJ had held that this provision gives OHIM discretion to decide whether or not to take into account evidence that had been submitted late and that doing so is likely to be justified where the material is likely to be relevant to the outcome of the opposition; the circumstances and stage of the proceedings do not preclude such evidence being taken into account. Article 22(2) states that, if proof of use is not provided within the time limit set by OHIM, the opposition will be rejected.

New Yorker Jeans argued that OHIM was obliged to reject the opposition under Article 22(2) when the opponent failed to file evidence sufficient to prove genuine use within the period allowed. However, the ECJ held that Article 22(2) was purely procedural in effect; although the provision required the rejection of an opposition where no proof of use was filed, where proof of use *had* been filed within the period allowed (as in this opposition) the opposition should be allowed to run its course, unless it appears that the evidence is irrelevant for the purposes of establishing genuine use of the mark. Oppositions rejected for lack of sufficient evidence were instead rejected pursuant to Article 42(2). In these circumstances, OHIM had been entitled to exercise its discretion pursuant to Article 76(2) to take into account the additional evidence of use filed after the deadline.

The ECJ's judgment clarifies that OHIM should only reject an opposition pursuant to Article 22(2) either where no evidence of use is filed by an opponent, or where only irrelevant evidence of use is filed. It also underlines the ECJ's previous decision in *OHIM v Kaul* that OHIM has discretion to take into account evidence filed after the deadline set by OHIM. Applicants in opposition proceedings consequently face a difficult decision as to whether or not to challenge perceived insufficient evidence of use, in circumstances where doing so might provide the opponent with an opportunity to improve its position with additional evidence in reply.

Jeremy Dickerson and Jennifer Gibson, Burges Salmon LLP, Bristol

World Trademark Review *Daily*

World Trademark Review (www.worldtrademarkreview.com) is a subscription-based, practitioner-led, bi-monthly publication and daily email service which focuses on the issues that matter to trademark professionals the world over. Each issue of the magazine provides in-depth coverage of emerging national and regional trends, analysis of important markets and interviews with high-profile trademark personalities, as well as columns on trademark management, online issues and counterfeiting.