

COURT OF JUSTICE
OF THE EUROPEAN UNION

STATEMENT IN INTERVENTION

in case C-337/22 P

Pursuant to Article 40 of the Statute of the Court of Justice filed in the name of

International Trademark Association (“INTA”)

Established at 675 Third Avenue, 3rd Floor,
New York, NY 10017-5646, United States of America

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- **Intervener** -

We are authorized to practice before the courts of a Member State. Pursuant to Article 44(1)(b) of the Rules of Procedure of the Court of Justice (hereinafter the “**Rules of Procedure**”), we have produced certificates attesting to this fact along with our application for leave to intervene. We hereby declare that we represent and are acting on behalf of INTA, pursuant to a valid power of attorney, also filed application for leave to intervene. **We confirm that the registry may serve documents on us via e-Curia.**

* * *

The main parties being:

European Union Intellectual Property Office (“EUIPO”), 4 Avenida de Europa, E – 03008
Alicante, Spain, represented by D. Gája, D. Hanf, E. Markakis and V. Ruzek, acting as Agents

- **Appellant** -

supported by

Federal Republic of Germany, represented by J. Möller, J. Heitz and M. Hellmann, acting as Agents

- **Intervener in the Appeal** -

the other party to the proceedings being

Nowhere Co. Ltd (“**Nowhere**”), established in Tokyo (Japan), represented by R. Kunze, *Rechtsanwalt*

- **Applicant at first Instance** -

In the appeal against the judgment of the General Court of the European Union (hereinafter “General Court”) of 16 March 2022, *Nowhere v EUIPO - Ye (APE TEES)* (T-281/21, EU:T:2022:139) (hereinafter the “contested decision”).

* * *

This statement is filed by the deadline set forth in Articles 132 and 51 of the Rules of Procedure, since the Court of Justice of the European Union (hereinafter referred to as either the “**Court**” or the “**CJEU**”)’s order of 27 April 2023 authorizing INTA’s intervention (the “**Order**”) was **served upon the Intervener on 28 April 2023**.

* * *

1. **RELIEF SOUGHT**

1. In support of the EUIPO’s single ground of appeal, INTA requests that this honorable Court:
 - set aside the decision rendered by the General Court of 16 March 2022, Case T-281/21; and
 - order INTA to bear its own costs.

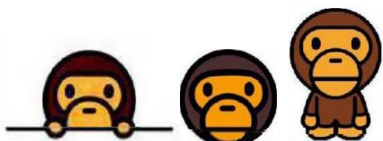
2. **SUMMARY OF THE DISPUTE**

2. For the sake of concision, INTA refers to the detailed description of the facts contained in the appeal filed by EUIPO. INTA however wishes to recall the following points.
3. The case at issue involves opposition No. B2669375 (the “**Opposition**”) filed by Nowhere (also referred to as the “**Opponent**”), a UK company, against European Union trade mark (“**EUTM**”) application No. 014319578 (the “**Application**”) in the name of Junguo Ye (the

“Applicant”) filed on 30 June 2015 in classes 3, 9, 14, 18, 25 and 35 for the following mark:



4. The Opponent filed the Opposition on 8 March 2016 and opposed all of the goods and services applied for. The Opponent relied on, *inter alia*, the following three earlier non-registered marks, used in the course of trade in, *inter alia*, the United Kingdom:



5. The ground relied on by the Opponent was Article 8(4) of Regulation No. 207/2009 [now Article 8(4) of Regulation 2017/1001 (hereafter referred to as the “EUTMR”)].
6. By a decision of 20 September 2017, the EUIPO Opposition Division rejected the Opposition.
7. The Opponent appealed the decision before the Board of Appeal of the EUIPO (the “BoA”) on 17 November 2017.
8. By a decision of 8 October 2018, the Second BoA dismissed the appeal (the “BoA 2018 Decision”).
9. On 7 January 2019, the Opponent brought an action at the General Court seeking annulment of the BoA 2018 Decision.
10. On 29 April 2019, the rapporteur of the BoA informed the parties that it intended to revoke the BoA 2018 Decision.
11. By a decision of 17 July 2019, the Second BoA revoked the BoA 2018 Decision on account of an obvious error attributable to the EUIPO.
12. By order of 18 December 2019, the General Court held there was no need to adjudicate on the action against the BoA 2018 Decision.
13. By a decision of 10 February 2021 (Case R2474/2017-2) (the “BoA 2021 Decision”), the Second BoA dismissed the appeal. In particular, as regards the Opposition based on the earlier non-registered trademarks, it found that, after the withdrawal of the United Kingdom from the European Union and after the expiry of the transitional period on 31 December 2020, the Opponent could no longer rely on the rules governing common law actions for

passing off under the law of the United Kingdom for the purposes of Article 8(4) of EUTMR. The BoA confirmed rejection of the Opposition for that reason alone.

14. In its application to the General Court, the Opponent challenged the BoA 2021 Decision only to the extent that, by that decision, the Second BoA confirmed the rejection of the Opposition in so far as it was based on the earlier non-registered trademarks, and only in so far as those marks were used in the course of trade in the United Kingdom. The Opponent submitted that the relevant date with regard to establishing the existence of an earlier right which has been relied on in opposition to the registration of an EUTM is the date on which the application for registration was filed. The EUIPO's position was that such an earlier right must exist not only on that date, but also on the date on which the EUIPO takes its final decision on the opposition.
15. In its judgment of 16 March 2022 (Case T-281/21), the General Court noted that the Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (the "**Withdrawal Agreement**") entered into force on 1 February 2020. Unless otherwise stated in the Withdrawal Agreement, EU law continued to apply in the United Kingdom during a transition period which ended on 31 December 2020 (the "**Transition Period**"). The provisions of the Withdrawal Agreement regarding intellectual property are silent as regards the treatment of an opposition which was brought before the entry into force of the Withdrawal Agreement, on the basis of an earlier right which was protected in the United Kingdom, against the registration of an EU trade mark which had also been applied for before the entry into force of the Withdrawal Agreement.
16. The General Court also noted that, in the present case, the filing of the Application, the filing of the Opposition, the EUIPO Opposition Division's rejection of the Opposition, the BoA 2018 Decision, the decision revoking the BoA 2018 Decision and the order holding that there was no need to adjudicate on the Opponent's action against the BoA 2018 Decision all took place before the entry into force of the Withdrawal Agreement. The only relevant document that postdates the entry into force of the Withdrawal Agreement and the end of the Transition Period is the BoA 2021 decision.

3. INTA SUPPORTS EUIPO'S APPEAL

17. By its appeal, the EUIPO seeks to have this honorable Court set aside the contested decision.
18. In its order of 16 November 2022 allowing the appeal to proceed pursuant to Article 58(a) of the Statute, the Court references the EUIPO's single ground of appeal and the six parts of which it is composed. In particular, by its single ground of appeal, the EUIPO submits *inter alia* that the General Court infringed Article 8(4) EUTMR.
19. In particular, according to the EUIPO, the General Court wrongly held, in paragraphs 28 to 31 of the contested decision, that, since the substantive law applicable *ratione temporis* was determined by the filing date of the application for registration and the Application was filed before the expiry of the Transition Period, the Board of Appeal should have taken into account the earlier non-registered UK trade marks relied on by the Opponent. Moreover, the EUIPO argues that the General Court wrongly rejected the argument that the relevant date with regard to the outcome of Opposition is the date on which the decision at issue was adopted.
20. INTA submits that indeed, as the EUIPO contends, the consequence of Withdrawal of the UK from the EU can be equated with other instances of "disappearance" of earlier rights in invalidity/opposition proceedings based on relative grounds for the following reasons.

A. ON THE CASE LAW CITED

21. The General Court annulled the BoA 2021 Decision allegedly:
"...in line with the case-law of the Court of Justice from which it is apparent, in essence, that it is the filing date of the application for registration of the mark against which an opposition has been brought which is decisive for the purposes of identifying the applicable substantive law..., it is clear from now settled case-law that the existence of a relative ground for refusal must be assessed as at the time of filing of the application for registration of an EU trade mark against which an opposition has been brought..." (paragraph 28 of the contested decision).
22. INTA submits that such earlier CJEU case law in fact concerns the **substantive law** applicable to a dispute and finds that for this to be determined the relevant date is the filing date of the later mark. However, determining the substantive law is an issue different to the one at hand in the present case.

23. The contested decision states:

“The fact that the earlier trade mark could lose the status of a trade mark registered in a Member State at a time after that of the filing of the application for registration of the EU trade mark, in particular following the possible withdrawal of the Member State concerned from the European Union, is in principle irrelevant to the outcome of the opposition...” (paragraph 29 of the contested decision)

“Consequently, the fact that an opposition under Article 8(4) of Regulation No 207/2009 is based on non-registered trade marks used in the course of trade in the United Kingdom and on the law of passing off laid down in the law of the United Kingdom is irrelevant as regards an opposition brought against an application for registration of an EU trade mark which was filed before the entry into force of the withdrawal agreement and the expiry of the transition period...” (paragraph 30 of the contested decision)

“Since the application for registration of the mark applied for was filed before the expiry of the transition period, indeed before the entry into force of the withdrawal agreement..., it must be held that the earlier non-registered trade marks were, in so far as they had been used in the course of trade in the United Kingdom, in principle, indeed capable of forming the basis of the opposition in the present case. As the [Opponent] correctly submits, the Board of Appeal should therefore have taken them into account in its assessment, which it, however, refused to do for the sole reason that the transition period had expired at the time when the contested decision was adopted...” (paragraph 31 of the contested decision).

24. The General Court draws the above from the argument that to assess whether there exists a genuine relative ground for opposition, it is appropriate to look at the time of filing of the opposed application citing respective General Court case law¹. It then finds, similarly to such prior General Court case law, that Brexit is irrelevant if it occurred after the filing date

¹ E.g. Judgment of 30 January 2020, *Grupo Textil Brownie v EUIPO – The Guide Association (BROWNIE)* T-598/18, EU:T:2020:22, paragraph 19 *“Furthermore, it has previously been held that, in order to assess whether there exists a genuine relative ground for opposition, it is appropriate to look at the time of filing of the application for an EU trade mark against which a notice of opposition has been filed on the basis of an earlier trade mark. It is therefore necessary to examine the various aspects of the earlier mark as they were at the time of filing of the application for an EU trade mark which is opposed by the earlier mark (judgment of 17 October 2018, Golden Balls v EUIPO – Les Éditions P. Amaury (GOLDEN BALLS), T-8/17, not published, EU:T:2018:692, paragraph 76)”*.

of the later mark. However, it appears that the General Court in T-598/18 and all subsequent rulings quoting it, misconstrued prior case law and in particular T-342/12², which it applied “by analogy”.

25. In particular, the ruling in Case T-342/12 concerned the revocation of an earlier mark and confirmed that at a time when the revocation decision had not yet become final, there was still interest in bringing proceedings. T-342/12 at another point appears to support the view that there is always interest in the proceedings, because the opposition process stalls the registration of the mark and for this reason it justifies an interest *per se*³. However, this rationale is questionable, especially if the right on which the action is based ceases to exist, thereby defeating the purpose of the opposition/cancellation action.
26. In the above decision the General Court discusses extensively the only issue that is, in the view of INTA, relevant to the case at issue, namely the issue of **interest to bring the proceedings**. According to established CJEU case-law, there must be an interest in bringing proceedings not only at the time of bringing them but also at any later time until the final ruling is issued (see order of 9 February 2007 in *Wilfer v OHIM*, C-301/05 P, ECR, EU:C:2007:91, paragraph 19, and judgment of 7 June 2007 in *Wunenburger v Commission*, C-362/05 P, ECR, EU:C:2007:322, paragraph 42, also T-598/18 above).
27. In the subject matter, the interest in bringing proceedings is affected by Brexit, per INTA’s view.

² Judgment of 8 October 2014, *Fuchs v OHIM – Les Complices* (Star within a circle), T-342/12, EU:T:2014:858.

³ Par. 28, 29: “Finally, the mere fact that appeals against the decisions of the Opposition Division and of the Board of Appeal have a suspensory effect under the second sentence of Article 58(1) and of Article 64(3) of Regulation No 207/2009, cannot suffice to call into question the applicant’s interest in pursuing the action. It must be recalled that, according to Article 45 of Regulation No 207/2009, it is only once an opposition has been rejected by a definitive decision that the mark is to be registered as a Community trade mark. Accordingly, when the Opposition Division or the Board of Appeal allows an opposition, such a decision will result in the mark not being registered, for so long as there has been no ruling on an appeal brought against that decision.

Consequently, notwithstanding the intervention of a definitive decision revoking the earlier Community mark on which the opposition was based, the applicant retains an interest in challenging the contested decision, including to the extent that that decision rules on the opposition based on that mark for the goods in Class 18”.

B. INTEREST IN BRINGING PROCEEDINGS – NATIONAL LAW

28. INTA notes that according to national law and/or case-law of Member States, the interest in bringing proceedings is a requirement, distinct from the legal and factual basis, which must exist both at the time of institution of the action, as well as at the time of the delivery of the decision.
29. For instance, the above rule generally applies to civil proceedings in **Italy**. With specific regard to administrative proceedings pending before the Italian PTO, at both first instance and appeal stage, the Italian Industrial Property Code (hereafter “IPC”) expressly states that the proceedings must terminate, if there is a “*supervening lack of interest in bringing proceedings*” [see to this extent, Article 136-*nonies*, paragraph 7, IPC, with respect to appeal proceedings; Article 181, paragraph 1, letter e-*ter*), IPC, with respect to opposition proceedings; and, similarly, Article 184-*octies*, paragraph 1, letters a) and g), IPC, related to cancellation proceedings].
30. In **France**, Article R-712-18 of the Intellectual Property Code provides that opposition proceedings are closed notably “*when the effects of all the prior rights invoked have ceased*”. Furthermore, the French Trademark Office (INPI) guidelines clarify that this encompasses: a) cancellation of the earlier trademark by an administrative or judicial decision that has become final, b) renunciation by the owner and c) failure to maintain the mark in force. The above is confirmed by case-law including of the Paris Court of Appeal which, for example, has ruled that INPI’s proceedings had been rightly closed due to cancellation, during the proceedings, of the trademark invoked as prior right.
31. In the **Netherlands**, according to Benelux trademark law, the opposition procedure is terminated when the older mark (or right) is no longer valid. It provides under Article 16 (Course of the [opposition proceedings] that: “(...) 3. *The opposition proceedings shall be closed: (...) d. where the earlier trademark or earlier right is no longer valid*”). Therefore, the earlier right (trademark) on which the opposition is based has to be valid at the moment when the trademark office or the appeal institutions decide on the opposition. If the trademark is no longer valid at a later hearing, this right cannot be any more relied upon in an opposition procedure and the procedure will be closed.
32. In **Spain**, according to procedural rules and case-law, the interest in bringing proceedings must exist both at the time of institution of the action, as well as at the time of the delivery

of the decision. This applies both to administrative proceedings before the Spanish trademark courts and to proceedings before the courts based on civil jurisdiction.

33. In **Portugal**, the interest in bringing proceedings must exist both at the time of institution of the legal action, as well as at the time of the delivery of the decision. The interest in bringing proceedings has been considered by the case law and the doctrine as a procedural requirement. In procedural terms, when the plaintiff does not establish through the facts put forward, the existence of a conflict with the defendant, the court may decide that the plaintiff has no interest in bringing the proceedings. It is also possible that the plaintiff's interest in bringing a legal action disappears during the course of a legal action, which has to be shown/argued by the parties.
34. In **Greece**, in administrative proceedings (which are also applicable on oppositions, cancellations and related actions), there must be interest in bringing proceedings, at the time when the junior mark is filed, when the action is heard and up to when the decision is issued⁴ (in the sense that if the right is lost after the hearing and before the issuance of the decision and this is notified to the court the proceedings will end).
35. It follows from the above that, regardless of whether for finding the law and facts relevant to the case the relevant period is the application date of the junior mark, across the European Union **the interest in bringing proceedings must exist both at the time of institution of the action, as well as at the time of the delivery of the decision.**

C. INTA'S POSITION

36. INTA's view is that where the opponent's/cancellation applicant's right relied upon is no longer valid at the time a decision is taken, then it should follow that the opponent no longer has an interest in bringing proceedings and the opposition should fail.
37. The interest in bringing proceedings is recognized by CJEU case-law as a condition of admissibility of an action, which – as mentioned above – must persist until the delivery of the decision, and it is an issue examined by the court on its own motion (see orders of 7 October 1987, in *d. M. v Council and ESC*, 108/86, ECR, EU:C:1987:426, paragraph 10, and of 10 March 2005, in *Gruppo ormezzatori del porto di Venezia and Others v Commission*, T-228/00, T-229/00, T-242/00, T-243/00, T-245/00 to T-248/00, T-250/00,

⁴ E.g. Administrative Supreme Court Plenary 280/1996, Administrative Supreme Court 324/2001.

T-252/00, T-256/00 to T-259/00, T-265/00, T-267/00, T-268/00, T-271/00, T-274/00 to T-276/00, T-281/00, T-287/00 and T-296/00, ECR, EU:T:2005:90, paragraph 22), see also T-342/12 (quoted above), paragraph 22.

38. Furthermore, it is settled case-law that “*the applicant’s interest in bringing proceedings must, [...], exist at the stage of lodging the action, failing which it will be inadmissible. That purpose must continue, like the interest in bringing proceedings, until the final decision, failing which there will be no need to adjudicate, which presupposes that the action must be liable, if successful, to procure an advantage to the party bringing it. If the applicant’s interest in bringing proceedings disappears in the course of proceedings, a decision of the Court on the merits cannot bring him any benefit (judgment in Wunenburger v Commission, EU:C:2007:322, paragraph 43, order of 9 February 2007 in Wilfer v OHIM, C-301/05 P, ECR, EU:C:2007:91, paragraph 19)*”, see T-342/12, paragraph 23.
39. Further, in respect of any perceived ‘unfairness’ to the Opponent in the Opposition, INTA notes that the impact of Brexit means that the Opponent has, in effect, achieved what it ultimately may have achieved had the Opposition been successful based only on the Opponent’s three earlier non-registered marks used in the course of trade in the United Kingdom – or similarly if this were a national UK mark.
40. In the above circumstances, the Applicant could have converted the Application into national trade mark applications in all other Member States *i.e.* the 27 current Member States of the EU. The Opponent’s three earlier non-registered marks used in the course of trade in the United Kingdom would have provided the Opponent with no basis on which to oppose those national trade mark applications and, absent the Opponent having any other relevant rights to rely on, such applications in the 27 current EU Member States would have proceeded to registration.
41. The Applicant will also have protection in the 27 current EU Member States if the Opposition fails and the Application is allowed to proceed to registration. The date of registration would be well after the end of the Transition Period, such that the United Kingdom Intellectual Property Office (“UKIPO”) would not create a comparable right on the UKIPO register. The Applicant had the opportunity to apply to register the same mark as a UK right within nine months after the end of the Transition Period (*i.e.* up to and

including 30 September 2021) and retain the earlier filing date of the Application. It appears from a search of the UKIPO register that the Applicant did not file such an application.⁵

42. The above circumstances further confirm that **the Opponent no longer has an interest in bringing proceedings here.**

43. INTA believes that, as confirmed by the Order, the outcome of the case at issue might have an impact on any situation of “disappearance” of an earlier right during administrative proceedings based on relative grounds. Therefore, we deem it is very important that this honorable Court provides clear guidelines in this respect.

4. COSTS

44. INTA does not request that a party be ordered to pay costs. INTA agrees to bear its own legal expenses.

With all rights reserved and without prejudice,

FOR THESE REASONS,

MAY IT PLEASE THE COURT OF JUSTICE OF THE EUROPEAN UNION TO:

1. Set aside the decision of the General Court of the European Union of 16 March 2022, Case T-281/21; and
2. order INTA to bear its own costs.

Florence, 7 June 2023

For the Intervener

Its counsels,

Noemi Parrotta, Esq.

Marina Perraki, Esq.

Andreas Lubberger, Esq.

Angela Wenninger-Lenz, Esq.

⁵ If the Applicant had applied to register the mark in the UK, we note that the Opponent’s continuing UK rights would have provided a basis to oppose such a registration, again allowing the Opponent to achieve what it ultimately may have achieved based only on the Opponent’s three earlier non-registered marks used in the course of trade in the United Kingdom.