



**Observations submitted by the Association of Trademark and Design Law Practitioners ('APRAM')
regarding the referral to the Grand Board of Appeal of the European Union Intellectual Property Office of questions on a point of law by the Executive Director of the European Union Intellectual Property Office**

Paris, May 30th, 2024

APRAM is respectfully submitting its observations regarding the referral to the Grand Board of Appeal of the European Union Intellectual Property Office of questions on a point of law by the Executive Director of the European Union Intellectual Property Office, dated 22 February 2024¹ and published on 2 April 2024 in the Official Journal of the European Union Intellectual Property Office², appeal number R0497/2024-G.

This referral pertains to the Fourth Board of Appeal's decision dated 26 September 2022, R 1241-2020-4 'Nightwatch', versus the practice in the Office's Guidelines concerning the conversion of a European Union Trademark ('EUTM') into one of several national trademark applications under Article 139 and 140 of the European Union Trademark Regulation ('EUTMR').

1. Presentation of APRAM

APRAM ('Association des Praticiens du Droit des Marques et des Modèles') is an international Francophile association established under French law dated July 1st, 1901. APRAM was founded in 1978 and is registered before the French SIREN under n°490 770 997. Its creation was registered and duly published in the Official Journal of the French Republic in 1978.

One of APRAM's main characteristics is to gather, in equality, the three following families/colleges with complementary experiences, which represent the full spectrum of the professionals specialized in intellectual property, namely: (i) in-house counsels ('industrie' trademark and design owners), (ii) European trademark and design attorneys ('conseils en propriété industrielle'; trademark and design practitioners) and (iii) lawyers ('avocats'; trademark and design practitioners).

¹ https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/official_journal/2024/April/NIGHTWATCH_Referral_of_questions_on_a%20point_of_law_en.pdf

² <https://www.euipo.europa.eu/en/protect-ip/law/communications-and-decisions-ed/official-journal>

With more than 1.100 members, APRAM is amongst the most active Francophile associations specialized in intellectual property matters, specifically trademark and design issues. APRAM's members in all three colleges widely cover all economic sectors, including Cosmetics and personal care, Clothing, footwear and accessories, Sports goods, Food, Chemicals, Energy, Toys and games, Jewellery and watches, Handbags and luggage, Recorded music industry, Spirits and wine, Pharmaceutical, Hotels, Smartphone and Tyres and batteries.

An important objective for APRAM is to protect, assist and promote the common interests of its members amongst all three colleges. In this regard APRAM strives to contribute to the development of trademark and design laws and regulations, in particular in France and within the European Union.

For more than a decade, APRAM has regularly and actively taken official positions on intellectual property issues, on its own or in cooperation with other intellectual property association and on its own initiative or at the request of national or European public institutions. Such public positions can be consulted on APRAM's website³.

APRAM is notably participating in the EUIPO's Liaison Meetings, Observatory Meetings, TM5 / ID5 Meetings, User Group Meetings, SQAP Meetings, European Cooperation Projects on the Convergence of practices on trademarks and Customer Panels, and is also a non-permanent observer since 2020 for the Management Board and Budget Committee Meetings.

APRAM is also well armed and accustomed to provide expertise on trademark and other IP-related laws and regulations to Courts and intellectual property offices, in particular in France and within the European Union. APRAM also strives to provide relevant analysis and opinion in administrative and legal proceedings before national or European institutions as an 'amicus curiae', thanks to its Amicus Curiae Committee launched in early 2024 – which provided the observations below.

2. APRAM's observations

APRAM's Amicus Curiae Committee has carefully considered the questions put forward by the Executive Director of the EUIPO regarding the EUIPO's practice applied to the conversion of EUTMs.

It is important to stress that the spirit of the EUTM is to be unitary. However, this makes it somewhat fragile regarding the multiplicity of validity criteria, both absolute and relative, with which it is confronted. To maintain its attractiveness, we believe that it must be possible for national applications to take over easily and without losing their seniority.

³ www.apram.com

After thorough analysis of the situation, the Amicus Curiae Committee feels it is important to keep a case-by-case approach, depending on the type of grounds for refusal (absolute or relative) and the particular circumstances of each case.

Thus the Committee suggests that the EUIPO guidelines should be nuanced, and that rigid implementation should be avoided.


Nevertheless, the Committee has noted the advantages of the Nightwatch decision, including the possibility of withdrawal without having a permanent entry in the register, the opportunity for a second examination in the conversion offices, increased flexibility for applicants, and rationalization of actions in major markets for holders.

Conversely, the application of the Optima decision has several disadvantages, including failure to consider the different practices of national offices, limiting the number of ways to obtain registration, and prohibiting the applicant of a protection in territories that may not be of interest to the holder of the prior right.

In light of these considerations and of the limited number of conversion requests, the Committee supports the application of the Nightwatch decision, which affords greater flexibility for applicants.

APRAM's Amicus Curiae Committee is grateful for the opportunity to provide an opinion and for the consideration of these observations.

Sincerely,



Romain Mallet
Chair of APRAM's Amicus Curiae Committee