

## **Decision on how the EU Intellectual Property Office (EUIPO) notified a party in an ‘opposition proceeding’ (case 2241/2021/LDS)**

Decision

**Case 2241/2021/LDS - Opened on 23/06/2022 - Decision on 27/02/2023 - Institution concerned** European Union Intellectual Property Office ( Maladministration found ) |

The complainant filed an ‘opposition proceeding’ against an application for an EU trademark before the EU Intellectual Property Office (EUIPO). Opposition proceedings enable holders of existing EU trademarks to challenge applications for new EU trademarks in order to protect their rights. At the beginning of the opposition proceeding, and in previous proceedings filed by the complainant, the EUIPO communicated with the complainant by post. During the course of the opposition proceeding, the EUIPO changed its communication policy and decided to move to electronic communications. Because of this, the complainant missed a request for evidence.

The Ombudsman found that the EUIPO’s failure to inform the complainant properly about its decision to communicate electronically constitutes maladministration, because it was inconsistent with the EUIPO’s past practices. Since the opposition proceeding had been closed, the Ombudsman closed the case without making a recommendation.

However, she suggested that the EUIPO informs users about changes in its communication policy through the same channel it used to communicate with them in the past.

## **Background to the complaint**

1. In August 2020, the complainant filed an opposition proceeding [1] against a trademark application before the EU Intellectual Property Office (EUIPO). At the beginning of the opposition proceeding, and in previous filings, the EUIPO communicated with the complainant by post, which the complainant had designated as his preferred means of communication.

2. In March 2021, the EUIPO started communicating exclusively through the online portal it has in place for dealing with trademark applications and opposition proceedings (the ‘User Area’). It sent the complainant a message via his User Area, asking the complainant to provide evidence in the context of the opposition proceeding. The complainant was not aware he had received as message, in part, because it did not receive an email notification about the message in the User



Area.

3. In September 2021, the complainant received an email notification informing him that he had received a new message in his User Area. The message notified him that, as he had not provided the requested evidence, the EUIPO had dismissed the opposition proceeding.

4. The complainant wrote to the EUIPO explaining that he had not received the request for evidence. He explained that all his previous communications with the EUIPO had taken place by postal mail. While he had created a user account with the EUIPO on its online portal, he did not expect to receive important communications via that account. He also pointed out that, while he had received an email notification following the dismissal of his opposition procedure, he did not receive any email when the EUIPO requested evidence. He asked the EUIPO to reopen the opposition proceeding and to give him a new deadline to provide evidence.

5. The EUIPO replied that it had first attempted to contact the complainant via postal mail in February 2021 but the letter could not be delivered. It had then sent the message to his User Area, in March 2021, following the decision to move to electronic communications. The EUIPO considered this notification to be valid and thus refused to reopen the opposition proceeding. Lastly, it noted that the complainant had not activated email notifications in his User Area, and explained how he could do so.

6. Dissatisfied with the reply of the EUIPO, the complainant turned to the Ombudsman in December 2021.

#### **The inquiry**

7. The Ombudsman opened an inquiry into how the EUIPO notified the complainant in an opposition proceeding and, in particular, how it provided information about its decision to change its communications policy.

8. In the course of the inquiry, the Ombudsman asked the EUIPO for a written reply on the complaint. The complainant provided comments on the reply.

## **Arguments presented to the Ombudsman**

9. The complainant claimed that the EUIPO should have notified him by post of its decision to switch to communicating exclusively via the online User Area, given he had designated communication by post as his preferred means of communication. Since the complainant did not know that the EUIPO had switched to a system of electronic notifications via the User Area, he missed the request to provide evidence and the proceeding was dismissed.

10. The EUIPO replied that its change of communication policy was based on a decision of the Executive Director of the EUIPO [2], which was adopted in November 2020 and entered into force in March 2021.

11. Article 4 of the Decision states that “ *[t]he User Area is the sole platform through which the*



*Office will issue notifications by electronic means, and account holders may not opt out of this means of receiving electronic communications from the Office as long as the User Area account remains active. This applies equally to new and existing user account holders, including those that may have previously opted out under the former rules.* ”

**12.** The EUIPO explained that it had run a communications campaign to make users aware of these changes. The campaign included publishing ‘banners’ in the User Area, news articles on the EUIPO website, announcements on social media, mentions in the newsletters of user associations and national industrial property offices, messages included in all replies sent by its Information Centre to answer users’ general queries, and webinars.

**13.** Likewise, the EUIPO phoned users that had registered in the User Area but had not provided an email address, sent letters to account holders that had provided a postal address only, and emailed account holders that had provided a valid email address, which included the complainant.

**14.** The subject of the email allegedly sent to the complainant in February 2021 was “Electronic communications substitute the fax”, and its text included the statement “ *postal mail will continue to be an accepted means of communication with the Office* ”. The complainant stated that he never received this email.

## The Ombudsman's assessment

**15.** On its website, the EUIPO presents its online portal, by which users create an account and complete an application form, as the default procedure for the registration of a trademark. [3] The Ombudsman understands that, in the past, it was possible for users to choose their preferred means of communication with the EUIPO, which could be electronic or non-electronic (such as postal mail, or fax), even if they had an account in the User Area. After the decision to change the communication policy, EUIPO has moved to a system where it communicates with account holders only electronically. [4]

**16.** This decision essentially compelled users that had created an account with the EUIPO to move to electronic notifications through their User Area, regardless of how they had received communications in the past, and without the possibility to opt out.

**17.** Notifications sent by the EUIPO through the User Area can concern important steps in an application or opposition proceeding. This can include decisions on EU trademark applications, information to the proprietors of earlier EU trademarks that may want to oppose the registration of a new EU trademark, decisions on opposition proceedings, requests for observations, and summons to persons concerned to appear before the EUIPO. [5] These notifications enable individuals to know the state of play of their proceedings with the EUIPO, and act accordingly to defend their trademarks.

**18.** Given the importance of the EUIPO’s notifications, changing how these notifications are



sent clearly had potentially significant implications. Against this background, the Ombudsman takes the view that the EUIPO should have done more to inform its users about its decision to move to electronic communications. Generic communication campaigns like announcements on websites and social media are certainly useful reminders, but they are not a suitable method officially to inform users about the EUIPO's new communication policy, as they may go unnoticed to some users, especially if they were not using electronic communications before.

19. In addition, the text of the email that the EUIPO sent to users about the matter, but that the complainant claims he did not receive, was imprecise. Since the email's subject was "*Electronic communications substitute the fax*", non-fax users like the complainant may have believed that the content of the email did not concern them. Additionally, the email's statement that "*postal mail will continue to be an accepted means of communication with the Office*" appears at odds with the decision, which stated that all notifications would henceforth be sent through the User Area . [6]

20. In any event, the Ombudsman believes that, since the EUIPO had previously given the complainant the possibility to designate postal mail as his preferred means of communication, and consistently used this channel in the past, it should have notified the complainant by postal mail of the decision to change its communication policy. As the complainant had received communications by postal mail in the past, he had a 'legitimate and reasonable expectation' that any change to such a policy should be communicated to him by this medium. [7]

21. The situation that occurred meant the complainant did not have the opportunity to properly express his views in the context of the opposition proceeding, as he failed to see the request to provide evidence. This ultimately negatively impacted his ability to protect his trademark.

22. The Ombudsman takes the view that this amounted to maladministration by the EUIPO. However, given that the opposition proceeding filed by the complainant is now closed, and in light of the necessity to preserve legal certainty, the Ombudsman considers that there is no concrete recommendation that could properly address the matter.

23. To prevent similar issues from happening again in the future, the Ombudsman suggests that the EUIPO inform users about future changes in its communications policy through the same means it used to communicate with them in the past. Additionally, the information provided must be sufficiently clear for users to understand how the new communications policy will affect them in practice and whether other channels of communication will remain available.

## Conclusion

Based on the inquiry, the Ombudsman closes this case with the following conclusion:

**The EUIPO's failure to inform the complainant properly about its decision to communicate electronically constitutes maladministration .**



The complainant and the EUIPO will be informed of this decision .

### **Suggestion for improvement**

**The EUIPO should inform users about changes in its communications policy through the same means it used to communicate with these users in the past. The information provided must be sufficiently precise so that users can understand the practical implications of the new policy.**

Emily O'Reilly European Ombudsman

Strasbourg, 27/02/2023

[1] . 'Opposition' is a procedure that takes place before the EUIPO and allows individuals to protect their earlier trademark or other rights against a new EU trademark application. See <https://euipo.europa.eu/ohimportal/en/opposition> [Link].

[2] Decision EX-20-9 on Communications by electronic means.

[3] <https://euipo.europa.eu/ohimportal/en/web/guest/apply-now> [Link].

[4] Article 4 of Decision n EX-20-09.

[5] See the Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R1001> [Link].

[6] Article 4 of Decision n EX-20-09.

[7] European Code of Good Administrative Behaviour, Article 10, <https://www.ombudsman.europa.eu/en/publication/en/3510> [Link].