

## Opponent's prior marks must continue to be on the register as of date of decision and even on appeal



In ***Beko plc v EUIPO (T-162/18) ECLI:EU:T:2019:87***, on 6 December 2007, Beko plc applied for an EU trade mark ALTUS in various classes. Acer Inc. opposed this application based on earlier registered marks for or including the word ALTOS. There then following considerable delay arising from a substantial cooling off period and other procedural “wrangling”.

On 2 September 2016, the Opposition Division upheld the opposition based on an earlier Slovak mark for ALTOS. The Slovak mark had been registered on 9 June 2005. Thus, as of the date of application for ALTUS (Dec 2007), the Slovak mark was still within the initial 5 year “grace period” and thus not vulnerable to be revoked.

Beko appealed and in January 2017, Beko asked the Board of Appeal to suspend the proceedings as it intended to begin revocation proceedings to revoke the Slovak mark before the Slovak Industrial Property Office.

In December 2017, the Board of Appeal refused to suspend the proceedings. It said that the revocation of the Slovak mark would make no difference to the opposition proceedings because as of the date of application for ALTUS in 2007, the Slovak mark was still within the first 5 year period. Thus, any effective date of revocation would be later than the date of application. The Board of Appeal said that to suspend the proceedings would render the initial 5 year period of protection “illusory” and in general, incite EU trade mark applicants to delay proceedings until the earlier registered mark matures beyond the 5 year period.

Beko appealed to the General Court. It said that the Board of Appeal was wrong in principle and wrong on the analysis of the facts. Beko argued that the opposition proceedings would be “devoid of purpose” if the earlier mark was in fact revoked. It argued that this overriding principle applied regardless whether the earlier mark was revoked with effect before or after the date of application for the EU trade mark. Beko said that there was a public policy in not allowing “dead” earlier marks to be relied upon to prevent the registration of “live” EU applications. This public policy overrode any “technical” considerations as to whether the earlier mark could only be or had been revoked with effect after the date of application of the later mark.

Beko also denied “gaming” the system. It said that it wanted to issue the revocation proceedings before the Slovak Industrial Property Office for proper reasons and that it had not deliberately delayed doing the same so as to allow the Slovak mark to become vulnerable for non-use.

The General Court agreed with Beko and annulled the decision of the Board of Appeal. It said that the earlier mark must be valid not only as of the date of application for the EUTM but also as of the date that the Opposition Division or if appealed, the date the Board of Appeal gives its decision. Thus, it is not a good ground to refuse an application to suspend proceedings merely because the effective date of revocation of the earlier mark

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would be after the date of application for the earlier mark. In doing so, the General Court has said that the mere fact that an applicant brought revocation proceedings after lodging an appeal was not a ground to refuse a request for suspension. Such did not amount to bad faith by itself.

[Guy Tritton](#) acted for Beko plc instructed by Beck Greener.

**Practice Tips:** Be aware that if there is a substantial lapse of time between the start of opposition proceedings and any decision, prior marks may become vulnerable to revocation during the course of proceedings.

- **Applicant for mark** As applicant, you may wish to “game” the proceedings so as to ensure that the prior marks become vulnerable for lack of genuine use, issue revocation proceedings and seek suspension of the opposition proceedings pending the outcome. Be wary though as such could amount to bad faith conduct.
- **Opponent** As opponent, you should be aware if your client's marks may become vulnerable for lack of genuine use over the course of the opposition proceedings. If so, be aware of this and push for an early decision.

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