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Advocate General Opinion in APE TEES – hopefully no forecast for the CJEU’s judgment

Verena von Bomhard (BomhardIP) · Tuesday, May 13th, 2025



On 10 April 2025, Advocate General (AG) Cápeta delivered her opinion in the matter EUIPO v Nowhere, C-337/22 P, also referred to as APE TEES. The opinion is both surprising and concerning. If the CJEU were to adopt AG Cápeta’s views, this would mean a complete overhaul of EU trademark law as we know it, and not for the better. Formalism would win over commercial logic and needs.

There is reasonable doubt that the CJEU will follow AG Cápeta’s opinion, as this is not only contrary to the SHOPPI decision of the General Court (see [here](#) and [here](#)) and the opinion of AG Szpunar in the BASMATI case (C-801/21 P) but – in this author’s understanding – the BASMATI decision itself, see the previous blog [here](#).

For recollection, the Nowhere case concerns an opposition against an EUTM application (from 2015) for the device shown above. The opponent invoked an earlier unregistered trademark right in the UK. The Board of Appeal decided on 10 February 2021, i.e. after the transition period for Brexit (which ended 31 December 2020). In line with the consistent practice of the Office, the Board rejected the opposition, because, following Brexit, UK rights can no longer be held against EUTM applications.

Much to everyone’s surprise, the GC annulled the Board’s decision. According to the GC, what

mattered was whether the prior right existed at the time of the application for the contested mark. The EUIPO's appeal to the CJEU was allowed to proceed (see report [here](#)).

AG Cápeta suggests that EUIPO's appeal must be dismissed because there was a "significant period of potential conflict", namely, from the date of the EUTM application until 31 December 2020. She emphasizes that trademarks that survive an opposition are registered with effect from the filing date and concludes that, even where the earlier right loses its validity during the proceedings, there would have been a "*potential co-existence*" between the marks during some time.

One is tempted to ask – so what? The purpose of an opposition is to avoid registration. Article 8 EUTMR contains "grounds for refusal" of registration of an application. There is no reason for refusal if, at the time the final decision is taken, there is no earlier right.

The AG appears to confuse the situation on the register with that on the marketplace. In *Cooper International* (C-622/18, judgment of 26 March 2020), the CJEU ruled that the owner of a trademark that has been revoked can still claim damages from users of infringing signs for the time when the mark was valid – even if the earlier mark was never used. Whether one likes that position, which seems to incentivize defensive filings, it is the law as it stands.

However, there is no reason to apply this backward-looking concept to opposition proceedings. Whether the infringing sign is registered as a trademark has no impact on possible retroactive damage claims. As the CJEU has repeatedly stated (for EUTMs: C-561/11 – FCI FEDERATION CYNOLOGIQUE INTERNATIONALE, for national marks: C-491/14 – Rosa dels Vents, for EU designs C-488/10 – Celaya), registration of trademark (or design) rights in the EU provides no affirmative right to use.

Therefore, granting an opposition based on an earlier right that no longer exists serves nobody's interests. Whether there was, at some point, a ground for refusal is irrelevant. What matters is whether there is one when the decision is taken.

BASMATI concerned a case where the Board had decided before the end of the transition period. The same is true for the recent judgment in *Dr. August Wolff v EUIPO* (T-679/20, 30 April 2025). However, where the earlier right loses its effect during the proceedings before the Office, the outcome should be that the opposition or invalidity action based on it is rejected. Why else would one bring non-use cancellation actions if the earlier mark runs into the use requirement during the course of the proceedings, requesting suspension? This is a practice that the GC has endorsed – or even required – on numerous occasions.

So – hold your breath everyone. The last word is yet to be spoken, and there is good reason to hope that the CJEU will get this one right!

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