

**Notification de refus provisoire de protection fondée sur une opposition
conformément à l'article 5 du protocole de Madrid, à la règle 17, paragraphes 1
et 2, du règlement d'exécution commun à l'arrangement et au protocole de
Madrid, et à la règle 115 du REMUE**

Alicante, 22/09/2016

<i>N° de demande internationale:</i>	1251407
<i>Date de notification:</i>	21-04-2016
<i>Marque:</i>	TESLA
<i>Titulaire:</i>	Internet group d.o.o. Savski nasip 7 11070 Beograd
<i>Numéro d'opposition:</i>	B2758574

La protection de la marque susmentionnée est provisoirement refusée pour l'Union européenne.

Le refus provisoire est fondé sur le fait qu'une opposition a été déposée contre l'enregistrement international.

I. Les motifs de la présente opposition sont les suivants:

conflit avec une marque antérieure en raison de la similitude des produits ou des services, ou de la similitude des marques concernées, et risque de confusion (article 8, paragraphe 2, du RMUE);

conflit avec une marque antérieure identique ou similaire enregistrée pour des produits et des services qui ne sont pas similaires à ceux pour lesquels l'enregistrement international est enregistré, dès lors que la marque antérieure jouit d'une renommée et que l'usage sans juste motif de l'enregistrement international tirerait indûment profit du caractère distinctif ou de la renommée de la marque antérieure ou qu'il leur porterait préjudice (article 8, paragraphe 5, du RMUE);

II. Nom et adresse de l'opposante:

**Tesla Engineering Limited
Water Lane
Storrington, Sussex RH20 3EA
REINO UNIDO**

III. L'opposition est fondée sur une marque qui a fait l'objet d'une demande ou d'un enregistrement.

- type de marque: **MUE**
- date de dépôt, date d'enregistrement et, le cas échéant, date de priorité:

Date de dépôt: 25/05/2005

Date d'enregistrement: 20/06/2006

- numéro de dépôt et, si différent, numéro d'enregistrement:

Numéro de dépôt: 004455267

Numéro d'enregistrement: 004455267

- représentation de la marque: (voir annexe)
- liste des produits et services sur lesquels se fonde l'opposition: (voir annexe)

IV. Le refus provisoire concerne

uniquement les produits et services suivants couverts par la désignation de l'Union européenne:

Classe 9 Accumulateurs électriques; accumulateurs électriques pour véhicules; batteries d'allumage; piles électriques; caisses d'accumulateurs; chargeurs de piles et batteries; bêtatrons; boîtes de dérivation [électricité]; réducteurs [électricité]; appareils pour la recharge des accumulateurs électriques; disjoncteurs; joncteurs; conducteurs électriques; tableaux de commande [électricité]; convertisseurs électriques; raccordements électriques; redresseurs de courant; cyclotrons; détecteurs; détecteurs d'objets métalliques à usage industriel ou militaire; tableaux de distribution [électricité]; armoires de distribution [électricité]; pupitres de distribution [électricité]; canalisations électriques; éléments galvaniques; piles galvaniques; inducteurs [électricité]; appareils d'ionisation non pour le traitement d'air ou d'eau; encodeurs magnétiques; fils magnétiques; aimants; appareils électriques de surveillance; prises de courant; piles solaires; survolteurs; boîtes à clapets [électricité]; bornes [électricité]; régulateurs contre les surtensions ; serre-fils [électricité]; fils électriques.

- V. L'EUIPO notifiera l'opposition à la titulaire de l'enregistrement international séparément, y compris toute preuve sur laquelle elle est fondée, conformément à la règle 18, paragraphe 1, du REMUE. L'EUIPO fixera des délais à la titulaire. Cette notification ouvrira une période de deux mois (prorogeable) – « cooling off », ainsi qu'une nouvelle période de deux mois pour permettre à l'opposante d'étayer son opposition. La notification fixera un délai de six mois – en principe – à la titulaire de l'enregistrement international pour qu'elle fasse part de ses observations.

L'EUIPO fixera également un délai de deux mois à la titulaire de l'enregistrement international pour désigner un représentant conformément à l'article 93, paragraphe 1, du RMUE. La protection de l'enregistrement international pour l'Union européenne sera refusée en totalité si un représentant n'est pas désigné dans le délai prescrit.

Jesús MARTINEZ MARTINEZ

Annexes: acte d'opposition.

FRY HEATH SPENCE *BY FAX ONLY*

EUIPO
Avenida de Europa, 4
E-03008 Alicante
Spain

22 August 2016

Dear Sirs

International Registration (Designating the EU) No: 1251407
TESLA in Classes 7, 9, 11
In the name of Internet group d.o.o.
-And-
Opposition thereto by Tesla Engineering Limited
Our Reference: M105068M/MB/TR

We refer to the above-referenced application, and enclose herewith the following:

1. Notice of Opposition;
2. Copy case details of Community Trade Mark Registration No: 004455267 for TESLA; and
3. Grounds in Support of Opposition.

Please inform us of any perceived errors, omissions or deficiencies in the attached, and set a date within which this should be made good.

We confirm that the Opposition fee can be deducted from our Account No: 000206.

Yours faithfully
FRY HEATH SPENCE



Michael Barrett
Professional Representative ID No: 59846

Enc.

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Last updated: 03/2016



NOTICE OF OPPOSITION

Number of pages (including this one) 7	Opponent/representative reference (not more than 20 characters) ☐ Opposition against EUTM application ☒ Opposition against IR	Mod.007
Opponent ID number 225590 ☐ multiple opponents		
Name of legal entity or first name and surname Legal form of the entity Tel, fax, email Address Street and number City and postal code Country Postal address (if different) Nationality		
Tesla Engineering Limited Private Limited Company Water Lane Storrington, Sussex, RH20 3EA United Kingdom		
Representative ID number 10618 ☐ multiple representatives		
Name Tel, fax, email Address Street and number City and postal code Country Postal address (if different)		
Fry Heath & Spence LLP 00441293776880 00441293776837 mail@fhs.co.uk The Gables 17 Massetts Road Horley, Surrey, RH6 7DQ United Kingdom		
Type of representative ☐ legal practitioner ☒ professional representative ☐ association of representatives ☐ employee		
Challenged application EUTM application/IR No 1251407 Date of publication (DD/MM/YYYY)		
Name of EUTM applicant or IR holder Internet group d.o.o. / /		
Extent of the opposition ☐ against all the goods and services in the application ☒ against part of the goods and services in the application, namely:		
Language of the opposition ES DE EN FR IT		
Electric accumulators; electric accumulators for vehicles; batteries for lighting; electric cell batteries; accumulator boxes; battery chargers; betatrons; branch boxes [electricity]; cell switches [electricity]; apparatus for charging electric accumulators; breakers (circuit breakers); circuit closers; electric conductors; control panels [electricity]; electric converters; electric couplings; current rectifiers; cyclotrons; detectors; metal detectors for industrial or military use; distribution boards [electricity]; distribution boxes [electricity]; distribution consoles [electricity]; electric ducts; galvanic cells; galvanic batteries; inductors [electricity]; ionization apparatus not for the treatment of air or water; magnetic encoders; magnetic wires; magnets; electric monitoring apparatus; sockets, plugs and other contacts [electric connections]; solar batteries; step up transformers; switchboxes [electricity]; terminals [electricity]; surge protectors; wire connectors [electricity]; electric wires.		
☐ continuation sheet(s)		
Payment of fee Total € 320		
Current account with EUIPO ☒ Account No 000206 ☐ Do not use my current account with EUIPO		
Transfer to EUIPO account ☐ Banco Bilbao Vizcaya Argentaria ☐ La Caixa		
Date of transfer (DD/MM/YYYY) / /		
Signature Name Michael Barrett, Fry Heath & Spence LLP Signature		

page number

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NOTICE OF OPPOSITION

BASIS OF OPPOSITION: TRADE MARK REGISTRATION/APPLICATION

Identification of the earlier mark

☒ Trade mark registration☐ Trade mark application☒ EU trade mark☐ National trade mark☐ International registration with effect in one or more Member State(s)

Member State(s)

EM	BG	BX	CZ	DK	DE	EE	IE	EL	ES	FR	HR	IT	CY	LV	LT	HU	MT	AT	PL	PT	RO	SI	SK	FI	SE	UK
☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐

Filing date (DD/MM/YYYY)

25 / 05 / 2005

Filing number

004455267

Registration date (DD/MM/YYYY)

20 / 06 / 2006

Registration number

004455267

Representation of the mark (in colour if applicable)

☐ attached

Type of mark

☒ Word mark

TESLA

☐ Figurative mark☐ Other (specify)

Goods and services on which the opposition is based:

☒ all the goods and services covered by the registration/application☐ part of the goods and services, namely:

☐ continuation sheet(s)

Entitlement of opponent

☒ Owner

Copy of registration/application

☒ attached☐ to follow☐ Authorised licensee

Translation

☐ attached

Grounds for opposition

☐ Article 8(1)(a) EUTMR

- the EUTM application/IR is identical to the earlier mark and covers identical goods and/or services

☒ Article 8(1)(b) EUTMR

- there is a likelihood of confusion on the part of the public

☒ Article 8(5) EUTMR

- use without due cause of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark

Explanation of grounds and other remarks:

Please see Attachment 1.

☐ continuation sheet(s)

Territory where the earlier mark has a reputation:

EM	BG	BX	CZ	DK	DE	EE	IE	EL	ES	FR	HR	IT	CY	LV	LT	HU	MT	AT	PL	PT	RO	SI	SK	FI	SE	UK
☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☐	☒

Goods and services for which the trade mark has a reputation

☒ all the goods and services covered by the registration/application☐ part of the goods and services covered by the registration/application, namely:

☐ continuation sheet(s)

Evidence of reputation

☐ attached☒ to follow

translation

☐ attached

page number

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Council Regulation (EC) No. 207/2009

IN THE MATTER of
EU Designation of International Registration No: 1251407

7 E S L A

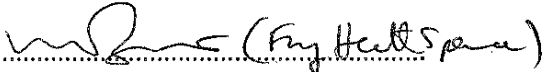
-And-

Opposition thereto by
Tesla Engineering Limited

GROUND IN SUPPORT OF OPPOSITION

1. The Opponent is the registered proprietor of Community Trade Mark Registration No: 004455267 TESLA.
2. The Opponent contends that the application in suit is for the Trade Mark 7 E S L A, a confusingly similar mark, and is made in relation to goods, identified in the Notice of Opposition, which are in conflict with the earlier goods and services protected by the Opponent's earlier registrations, in particular, "electric accumulators; electric accumulators for vehicles; batteries for lighting; electric cell batteries; accumulator boxes; battery chargers; betatrons; branch boxes [electricity]; cell switches [electricity]; apparatus for charging electric accumulators; breakers (circuit breakers); circuit closers; electric conductors; control panels [electricity]; electric convertors; electric couplings; current rectifiers; cyclotrons; detectors; metal detectors for industrial or military use; distribution boards [electricity]; distribution boxes [electricity]; distribution consoles [electricity]; electric ducts; galvanic cells; galvanic batteries; inductors [electricity]; ionization apparatus not for the treatment of air or water; magnetic encoders; magnetic wires; magnets; electric monitoring apparatus; sockets, plugs and other contacts [electric connections]; solar batteries; step up transformers; switchboxes [electricity]; terminals [electricity]; surge protectors; wire connectors [electricity]; electric wires". Consequently, the Opponent contends that the application in suit offends Article 8(1)(b) of the CTMR.
3. The Opponent further contends that the use of the mark applied for without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier registrations. The Opponent has reputation in the TESLA mark by virtue of use. By reason of the premises, the registration of the mark applied for will offend against Article 8(5) of the CTMR.
4. The Opponent therefore requests that the application in suit be refused for all goods claimed under the application.

5. The Opponent requests that it be awarded its costs.

Signed:  (Fry Heath Spence)

Michael Barrett (Fry Heath & Spence LLP) (for and on behalf of Tesla Engineering Limited)

Authorised representatives for the Opponent

Date: 22 August 2016

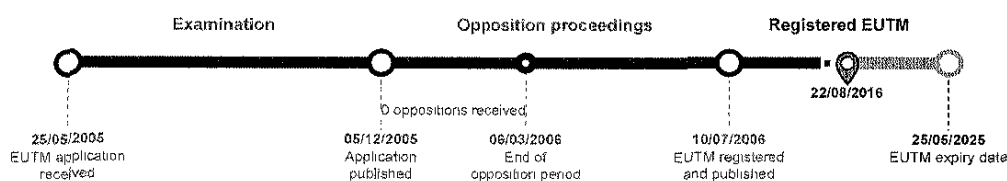


Protect your intellectual property in the European Union

EUTM file information

TESLA
004455267

Timeline



Trade mark information

Name	TESLA	Filing date	25/05/2005
Filing number	004455267	Registration date	20/06/2006
Basis	EUTM	Expiry date	25/05/2025
Date of receipt	25/05/2005	Designation date	
Type	Word	Filing language	English
Nature	Individual	Second language	French
Nice classes	9, 42 (Nice Classification)	Application reference	T35727F-CT
Vienna Classification		Trade mark status	Registered
		Acquired distinctiveness	No

Goods and services

English (en) ☒

9 Electrical coil windings; electromagnets; superconductor magnets.

42 Designing, building and testing magnets for scientific, medical and industrial applications and consultancy services relating thereto.

Description

No entry

Owners

Tesla Engineering Limited

ID	225590	Country	GB - United Kingdom	Correspondence address	Can be accessed and changed by authorised user via the User Area
Organisation	Tesla Engineering Limited	State/county	Sussex	Tesla Engineering Limited	
		Town	Storrington,	Water Lane	
Legal status	Legal entity	Post code	RH20 3EA	Storrington, Sussex RH20 3EA	
				REINO UNIDO	

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Address

Water LaneCan be accessed and
changed by authorised user
via the User AreaCan be accessed and
changed by authorised user
via the User Area

Representatives

FRY HEATH & SPENCE LLP

ID	10618	Country	GB - United Kingdom	Correspondence address	00 44-1293776880
Organisation	n/a	State/country	Surrey	FRY HEATH & SPENCE LLP	
Legal status	Legal person	Town	Horley,	The Gables, 17 Massetts Road	00 44-1293776837
Type	Association	Post code	RH6 7DQ	Horley, Surrey RH6 7DQ	
		Address	The Gables, 17 Massetts Road	REINO UNIDO	mail@fhs.co.uk

Correspondence

	From	Procedure	Filing number	Subject	Date	Actions
		EUTM	004455267	Surveillance letter	09/06/2016	
		EUTM	004455267	Surveillance letter	02/06/2016	
		EUTM	004455267	Surveillance letter	29/04/2016	
		Recordal	010656695	T722M - Registration of recordal C.1.3 / B.2.2	02/03/2016	
		Recordal	010656695	Letter to the EUIPO	29/02/2016	
		EUTM	004455267	Surveillance letter	04/02/2016	
		EUTM	004455267	Surveillance letter	18/12/2015	
		Recordal	008924790	L607 \: Notification of the total renewal of the EUTM	28/04/2015	
		Recordal	008924790	Application form and attachment	21/04/2015	
		Recordal	008924790	L601A \: Notification of the need to renew an EUTM registration	27/10/2014	
Showing 1 to 10 of 28 entries						

IR transformation

No entry

Seniority

No entry

Exhibition priority

No entry

Priority

No entry

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Publications

Bulletin number	Date	Section	Description
2005/049	05/12/2005	A.1	Applications published under article 40 EUTMR
2006/028	10/07/2006	B.1	Registrations with no amendments since the application was published
2015/079	29/04/2015	D.1	Renewals
2016/044	04/03/2016	C.1.3	Proprietor - Change of name and address
Showing 1 to 4 of 4 entries			

Cancellation

No entry

Recordals

Bulletin number	Date	Section	Filing number	Title	Subtitle
2015/079	29/04/2015	D.1	008924790	Renewal	Total Renewal
2016/044	04/03/2016	C.1.3	010656695	Proprietor	Change of name and address
Showing 1 to 2 of 2 entries					

Oppositions

No entry

Appeals

No entry

Decisions

No entry

Renewals

Title	Filing number	Status	Status date
Renewal	008924790	Trade mark renewed	29/04/2015
Showing 1 to 1 of 1 entries			

Trade mark relations

No entry

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