

MADRID PROTOCOL

Model Form 3A: Total Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)

I.	Office making the notification: Antigua and Barbuda
II.	Number of the international registration: 1 269 362
III.	Name of the holder: VINPROM PESTERA S.A.
IV.	<p>Information concerning the type of provisional refusal:</p> <p><i>Please indicate the type of refusal by checking only one of the following options:</i></p> <p><input type="checkbox"/> Total provisional refusal based on an <i>ex officio</i> examination</p> <p><input checked="" type="checkbox"/> Total provisional refusal based on an opposition</p> <p><input type="checkbox"/> Total provisional refusal based on both an <i>ex officio</i> examination and an opposition</p> <p><i>Where the refusal is based on an opposition, please indicate the name and address of the opponent:</i></p> <p>(i) Name of the opponent: SENSI VIGNE & VINI S.R.I</p> <p>(ii) Address of the opponent: Via Cerbaia, 107 –Fraz. Cerbaia, 1-51035 Lamporecchio (PT), Italy</p>
V.	<p>Information concerning the scope of the provisional refusal:</p> <p>Total provisional refusal affects all the goods and/or services. YES</p>
VI.	<p>Grounds for refusal [(where applicable, see item VII)]:</p> <p>Section 3(2)(v) of the Trade marks Act states that a mark cannot be validly registered if it is identical with or confusingly similar to ... a mark or trade name which is well known in Antigua and Barbuda for identical or similar goods.</p>

Model Form 3A

VII. Information relating to an earlier mark:

- (i) Filing date and number, and, if any, priority date:
- (ii) Registration date and number (if available):
- (iii) Name and address of the owner:
- (iv) Reproduction of the mark:
- (v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):

VIII. Corresponding essential provisions of the applicable law:

Section 3(2)(i) of Antigua and Barbuda Trademark Act

IX. Information relating to the possibility to request a review or file an appeal:

- (i) Time limit for requesting review or appeal: **Two months from the date of notification sent to the IB.**
- (ii) Authority to which such request for review or appeal should be made: **Antigua and Barbuda Intellectual Property & Commerce Office.**
- (iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:
- (iv) Other requirements, if any: **The Trademark Act at section 18 of the Antigua and Barbuda Trademark Act states that where an applicant's ordinary residence or principle of business is outside of Antigua, he shall be represented by a registered agent practicing in Antigua & Barbuda before the Registrar of Intellectual Property Office. The procedure for registration of agent shall prescribed in the regulations.**

Section 31 of the Antigua and Barbuda Trademark Regulations states that a local attorney at law or agent admitted to represent clients before the Intellectual Property & Commerce Office may be appointed.

X. Signature or official seal of the Office making the notification:

 . KJG LTR

XI. Date of the notification to the International Bureau:

September 12th, 2016

[End of Model Form 3A]

ROBERTS & CO

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Our Ref: 6035.000

2016-09-07

Registrar of Trademarks
Intellectual Property & Commerce Office
Hewlett House, St. John's Street
St. John's
Antigua

SEP 08 2016
J.S

Dear Madam Registrar

**Re: International Trademark Registration No. 1269362 "SENSE" in the Name of Vinprom
Peshtera S.A. and Opposition by Sensi Vigne & Vini S.R. L.**

We refer to the above captioned matter and act for and on behalf of Sensi Vigne & Vini S.R. L.

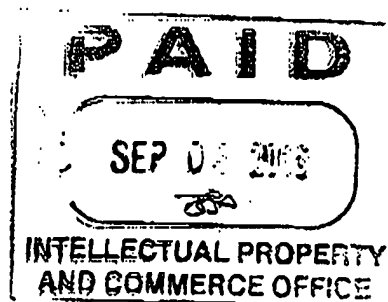
We have been instructed to oppose the registration of the above captioned mark on behalf of our client. In connection therewith, please find enclosed the following:-

1. Authorization of Agent (original)
2. Notice of Opposition and Statement of Grounds – Form 3
3. Filing fees in the amount of \$100.00.

Yours sincerely,
ROBERTS & CO
Attorneys at Law


Safiya L. Roberts

Enc.



R# 67106T
\$100.00

Form No. 2

ANTIGUA AND BARBUDA

THE TRADE MARKS ACT, 2003

AUTHORIZATION OF AGENT

WIPO - ROMARIN - International Registration Details

1242767

10.12.2015

151 Date of the registration
10.02.2015

180 Expected expiration date of the registration/renewal
10.02.2025

270 Language of the application
French

Current Status

732 Name and address of the holder of the registration
SENSI VIGNE & VINI SRL Via Cerbaia, 107, Frazione Cerbaia I-51035 LAMPORECCHIO (PT)
Italy

812 Contracting State or Contracting Organization in the territory of which the holder has a real and
effective industrial or commercial establishment
IT (Italy)

740 Name and address of the representative
Dott. Franco Cicogna & C. Srl - 01077 Dott. Alessandro Turato Via Visconti di Modrone, 14/A I-
20122 MILANO Italy

540 Mark

SENSIWINE

541 Reproduction of the mark where the mark is represented in standard characters

511 International Classification of Goods and Services for the Purposes of the Registration of Marks
(Nice Classification) - NCL(10-2015)

33 Wines; alcoholic aperitifs, sparkling wines, liqueurs and alcoholic beverages excluding beer.

821 Basic application
IT (Italy), 27.01.2015, MI2015C000719

300 Data relating to priority under the Paris Convention and other data relating to registration of the
mark in the country of origin
IT (Italy), 27.01.2015, MI2015C000719

832 Designation(s) under the Madrid Protocol
AU (Australia), GB (United Kingdom), US (United States of America)

834 Designation(s) under the Madrid Protocol by virtue of Article 9sexies
CN (China), DE (Germany), ES (Spain), FR (France)

527 Indications regarding use requirements
GB (United Kingdom), US (United States of America)

Registration

450 Publication number and date
2015/14 Gaz, 16.04.2015

832 Designation(s) under the Madrid Protocol
AU (Australia), GB (United Kingdom), US (United States of America)

834 Designation(s) under the Madrid Protocol by virtue of Article 9sexies
CN (China), DE (Germany), ES (Spain), FR (France)

WIPO - ROMARIN - International Registration Details

1138832

10.12.2015

- 151 Date of the registration
22.10.2012
- 180 Expected expiration date of the registration/renewal
22.10.2022
- 270 Language of the application
French

Current Status

- 732 Name and address of the holder of the registration
SENSI VIGNE & VINI S.R.L. Via Cerbaia, 107, Frazione Cerbaia I-51035 Lamporecchio (PT)
Italy
- 812 Contracting State or Contracting Organization in the territory of which the holder has a real and effective industrial or commercial establishment
IT (Italy)
- 740 Name and address of the representative
Dott. Franco Cicogna & C. Srl - 01077 Dott. Alessandro Turato Via Visconti di Modrone, 14/A I-20122 MILANO Italy
- 540 Mark
MEMORIE DEI SENSI
- 541 Reproduction of the mark where the mark is represented in standard characters
- 511 International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) - NCL(10)
33 Wines; aperitifs, spirits [beverages] and liqueurs; except beer.
- 821 Basic application
IT (Italy), 16.10.2012, MI2012C009778
- 300 Data relating to priority under the Paris Convention and other data relating to registration of the mark in the country of origin
IT (Italy), 16.10.2012, MI2012C 009778
- 832 Designation(s) under the Madrid Protocol
JP (Japan)

Registration

- 450 Publication number and date
2012/48 Gaz, 20.12.2012
- 832 Designation(s) under the Madrid Protocol
JP (Japan)
- 580 Date of recording (date of notification from which the time limit to notify the refusal starts)
13.12.2012

Statement of grant of protection made under Rule 18ter(1)

- JP (Japan)
- 450 Publication number and date
2013/19 Gaz, 30.05.2013

Rule 18ter(2)(i)

DE (Germany)

450 Publication number and date

2014/11 Gaz, 27.03.2014

580 Date of notification

13.03.2014

Date of receipt by the International Bureau

05.03.2014

Rule 18ter(2)(i)

US (United States of America)

450 **Publication number and date**

2014/47 Gaz, 04.12.2014

580 **Date of notification**

04.12.2014

Date of receipt by the International Bureau

18.11.2014

WIPO - ROMARIN - International Registration Details

1127549

10.12.2015

- 151 Date of the registration
 18.05.2012
- 180 Expected expiration date of the registration/renewal
 18.05.2022
- 270 Language of the application
 French

Current Status

- 732 Name and address of the holder of the registration
 SENSI VIGNE & VINI S.R.L. Via Cerbaia, 107, Frazione Cerbaia I-51035 Lamporecchio (PT)
 Italy
- 812 Contracting State or Contracting Organization in the territory of which the holder has a real and effective industrial or commercial establishment
 IT (Italy)
- 740 Name and address of the representative
 Dott. Franco Cicogna & C. Srl - 01077 Dott. Alessandro Turato Via Visconti di Modrone, 14/A I-20122 MILANO Italy
- 540 Mark



- 531 International Classification of the Figurative Elements of Marks (Vienna Classification) - VCL(6)
 05.05.20 ; 25.01.15 ; 27.05.01

- 571 Description of the mark

The composite mark comprises graphic and verbal elements. The word "Dolcevita" in special characters can be read inside an imaginary impression above "SPARKLING SWEET WINE dei" and further down "SENSI" The above words are surrounded by three stylized flowers. "1890" is written at the bottom.

La marque présente une structure complexe car elle est constituée d'éléments graphiques et littéraires. On lit, notamment le libellé "Dolcevita" en caractères spéciaux à l'intérieur d'une empreinte imaginaire et dessous "SPARKLING SWEET WINE dei" et dessous encore "SENSI". Ces libellés sont entourés de trois fleurs stylisées. On y lit dessous le libellé "1890".

La marca presenta una estructura compuesta, formada por elementos denominativos y elementos figurativos. La etiqueta "Dolcevita" en caracteres especiales en el interior de un

851 **Limitation of the list of goods and services**
RU (Russian Federation)
The subsequent designation concerns only classes 29 and 33.
580 **Date of recording (date of notification from which the time limit to notify the refusal starts)**
08.08.2013
891 **Date of subsequent designation (Rule 24(6) of the Common Regulations)**
13.03.2013

861 **Total provisional refusal of protection**
US (United States of America)
450 **Publication number and date**
2013/33 Gaz, 05.09.2013
580 **Date of notification**
29.08.2013
Date of receipt by the International Bureau
14.08.2013

Ex Officio examination completed but opposition or observations by third parties still possible, under Rule 18bis(1)

AU (Australia)
450 **Publication number and date**
2013/35 Gaz, 19.09.2013
Opposition end date
05.12.2013

Ex Officio examination completed but opposition or observations by third parties still possible, under Rule 18bis(1)

NZ (New Zealand)
450 **Publication number and date**
2013/35 Gaz, 19.09.2013
Opposition end date
02.12.2013

Statement of grant of protection made under Rule 18ter(1)

AU (Australia)
450 **Publication number and date**
2013/46 Gaz, 05.12.2013

Statement of grant of protection made under Rule 18ter(1)

NZ (New Zealand)
450 **Publication number and date**
2013/49 Gaz, 26.12.2013

861 **Total provisional refusal of protection**
MX (Mexico)

450 **Publication number and date**

From	Procedure	Filing number	Subject	Date	Actions
	CTM	013409719	Application form and attachment	28/10/2014	

Showing 1 to 5 of 5 entries

IR transformation

No entry

Seniority

No entry

Exhibition priority

No entry

Priority

No entry

Publications

Bulletin number	Date	Section	Description
2014/227	02/12/2014	A.1	Applications published under article 40 CTMR
2015/031	16/02/2015	C.2.1	Representative - Change of name and professional address
2015/050	13/03/2015	B.2	Registrations with amendments since the application was published

Showing 1 to 3 of 3 entries

No entry

Renewals

No entry

Trade mark relations

No entry

Trade mark information

Name	18 K SENSI	Filing date	24/09/2013
Filing number	012167409	Registration date	18/02/2014
Basis	CTM	Expiry date	24/09/2023
Date of receipt	24/09/2013	Designation date	
Type	Word	Filing language	Italian
Nature	Individual	Second language	French
Nice classes	33 (Nice Classification)	Application reference	DOTT.AT2013/102/1
Vienna Classification		Trade mark status	Registered
		Acquired distinctiveness	No

Goods and services

English (en)

33 Wine; Alcoholic aperitifs; Sparkling wine; Liqueurs and alcoholic beverages (except beers).

Description

No entry

Owners

SENSI VIGNE & VINI S.R.L.

ID	587494	Country	IT - Italy	Correspondence address	
Organisati...	SENSI VIGNE & VINI S.R.L.	State/coun...	n/a		Can be accessed and changed by authorised user via the User Area
		Town	LAMPOR (PT)	SENSI VIGNE & VINI S.R.L. VIA CERBAIA, 107 -	
Legal status	Legal entity	Post code	51035	FRAZ. CERBAIA I-51035	
		Address	VIA CERBAIA, 107 -	LAMPORECCHIO (PT) ITALIA	Can be accessed and changed by authorised user via the User Area

Exhibition priority

No entry

Priority

No entry

Publications

Bulletin number	Date	Section	Description
2006/004	23/01/2006	A.1	Applications published under article 40 CTMR
2006/033	14/08/2006	B.1	Registrations with no amendments since the application was published
2007/066	10/12/2007	C.2.1	Representative - Change of name and professional address
2012/201	22/10/2012	C.2.2	Representative - Replacement of a representative
2013/052	14/03/2013	C.1.3	Proprietor - Change of name and address
2015/031	16/02/2015	C.2.1	Representative - Change of name and professional address
2015/079	29/04/2015	D.1	Renewals

Showing 1 to 7 of 7 entries

Cancellation

No entry

Recordals

Bulletin number	Date	Section	Filing number	Title	Subtitle
2007/066	10/12/2007	C.2.1	002894411	Representative	Change of name and professional address

LUNGARNO

Toscana

Leaf

SENSI

Trade mark information

Name

LUNGARNO
Cabernet Toscana

Filing date

03/05/2005

Registration date

From	Procedure	Filing number	Subject	Date	Actions
	Opposition	002222928	Suspension of proceedings - to the opponent.	06/02/2014	
	Opposition	002222928	Suspension of proceedings - to the applicant.	06/02/2014	

Showing 1 to 10 of 27 entries

IR transformation

No entry

Seniority

No entry

Exhibition priority

No entry

Priority

No entry

Publications

Bulletin number	Date	Section	Description
2013/076	23/04/2013	A.1	Applications published under article 40 CTMR
2014/079	29/04/2014	B.2	Registrations with amendments since the application was published
2015/031	16/02/2015	C.2.1	Representative - Change of name and professional address

Showing 1 to 3 of 3 entries



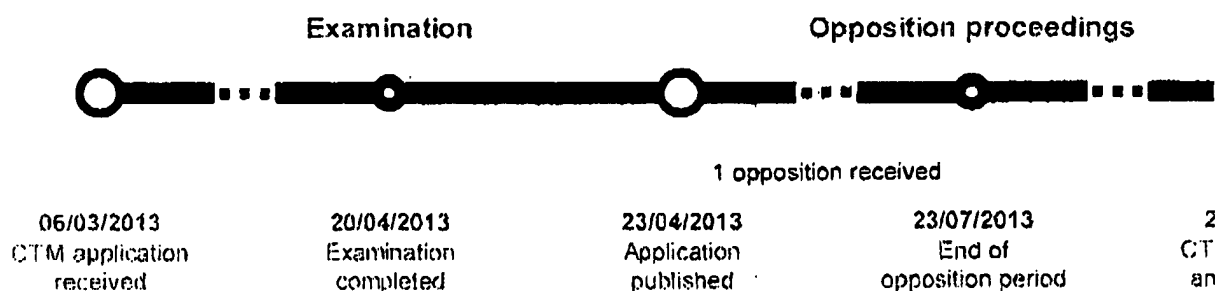
**OFFICE FOR HARMONIZATION
IN THE INTERNAL MARKET**
(TRADE MARKS AND DESIGNS)

Protect your intellectual property in the European Union

CTM file information

SENSI
011631983

Timeline



Graphic representation

Identical and/or Similar Goods and Services

The Applicant is claiming goods in Class 33 identical to that which is used by the Opponent in respect to the Opponent's Mark. The products belong to the same, identical market sector as the products claimed by the Opponent.

Given the types of products and services under consideration, it is submitted that the average consumer facing the Applicant's Mark will incur serious phenomena of confusion and association to the detriment of the Opponent

Conclusion

The Applicant's Mark "SENSE" is similar and phonetically identical to the Opponent's Mark "SENSI", and is to be registered for identical and/or similar goods and services offered by our client whose mark is well known in Antigua and Barbuda. According to settled case-law, a likelihood of confusion is the likelihood that the public might believe that the goods or services in question originate from the same undertaking or, as the case may be, economically linked undertakings.⁴ In light of the above, it is clear that there the public will be confused when faced with the Applicant's Mark and the Opponent's Mark in respect to the same goods. The Opponent has also obtained favourable decisions against the Applicant in respect to the opposition of Applicant's Mark in Austria, Croatia, France and Spain.

Similarly, in this case, the Applicant has not met the requirements of section 3 (2) (v) of the Act, and resultantly, SENSI VIGNE & VINI S.R.L. opposes the registration of International Trade Mark Registration No. 1269362 SENSE in Class 33 in Antigua and Barbuda and requests that the Applicant's application for registration be refused.

Dated the 7th of September 2016

ROBERTS & CO
Attorneys-at-Law


Safiya L. Roberts

⁴ Case T-162/01 Laboratorios RTB v OHIM — Giorgio Beverly Hills (GIORGIO BEVERLY HILLS) [2003] ECR II-2821, paragraphs 29 to 33

- The Applicant Mark and the Opponent's Mark covers identical or similar goods.

Identical or Confusingly Similar

It is submitted that the Applicant's Mark is identical or confusingly similar to the Opponent's Mark. The similarity between the Applicant's Mark SENSE and the Opponent's Mark SENSI is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks.

In assessing the similarity of the marks, authority holds that the starting point is the approach laid down in *Sabel v Puma* – 'the 'global appreciation' approach- whereby the marks should be compared as a whole, in the way an average consumer would see them.'¹ In carrying out this approach, 'the marks should be assessed from the point of view of their visual, aural, and conceptual similarities'. However, it is noted that 'the relative importance of each sort of similarity will vary with the circumstances in hand...for instance, wine marks will be perceived 'verbally'; with restaurant services (where word-of-mouth recommendation is highly important), it is likely that phonetic similarity will be a key.'²

The complete identity between the Applicant's Mark SENSE and the Opponent's Mark SENSI is obvious and is the basis of the present opposition. In analysing the Applicant's Mark in its entirety and comparing the Opponent's Mark, one can note that the respective trade marks are confusingly similar. The final letter 'E' in the Applicant's Mark is pronounced as an 'I'. Therefore, the marks are phonetically identical. Furthermore, in analysing the marks as a whole, the letter 'E' in the final part of the Applicant's Mark is not an element that can distinguish or differentiate the Opponent's Mark and company name/trade name.

It is therefore submitted that the two marks are identical or confusingly similar contrary to section 3(2)(v) of the Act and the Applicant's application for registration should be refused.

The Opponent's Mark is Well Known

It is submitted that the Opponent's Mark is well known internationally and in Antigua and Barbuda. The Act does not define 'well-known' and no guidance is given in the Paris Convention as to what this means. However, Arnold J in *Hotel Cipriani*³ laid down the following six criteria which should be taken into account in the assessment of whether a mark is well-known. It is noted that 'the list is neither exhaustive nor mandatory but provides a framework for the assessment:

- 1) The degree of knowledge or recognition of the mark in the relevant sector of the public; the relevant sector of the public for these purposes includes but is not limited to consumers of the goods and services in to which the mark applies, people involved in the

¹ Intellectual Property (Third Edition), Lionel Bently – pg. 863

² Ibid, og. 864

³ *Hotel Cipriani v Ciprinai* (Grosvenor Street) [2009] R.P.C. 9 at paras 235-237

Your name in BLOCK CAPITALS Date – September 7, 2016	
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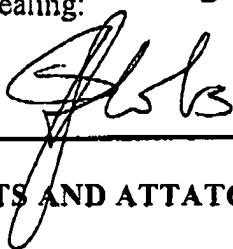
V. SIGNATURE OR SEAL

Name of the natural person who signs or whose seal is used

Safiya L. Roberts
Attorney-at-Law/Notary Public

Date of signature or of sealing: 07/09/16

Signature or seal:



VI. ADDITIONAL SHEETS AND ATTACHMENTS

- ☐ Check this box if additional sheets and/or attachments are endorsed and indicate the total number of such sheets and/or attachments:

