

## PROVISIONAL REFUSAL

according to rule 17(1) of the Common Regulations under the Madrid Agreement and Protocol

### Refusal not based on opposition

“EX OFFICIO”

**I. Office:**

INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL  
DIREÇÃO DE MARCAS E PATENTES  
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**II. International registration number: 1251407 E1**

Trademark elements:

TESLA

**III. Name and address of the holder: INTERNET GROUP D.O.O.**

SAVSKI NASIP 711070 BEOGRAD, SÉRVIA

**IV. Grounds for refusal.**

Relative grounds: Art. 239th, nr 1, a)

**a) Corresponding essential provisions of the applicable law under X.**

**V. Conflicting rights.**

**Application/registration number: EUTM 003411758**

**Filing Date: 24/10/2003**

**Registration date: 01/06/2005**

**Name and address of the owner:**

TESLA Holding a.s.  
Poděbradská 56/186  
CZ-180 66 Praha 9 – Hloubětín  
CZECH REPUBLIC

**Trademark:**

**TESLA**

**List of goods and/or services on which the conflict is based:**

09 – Electrochemical current supplies; passive devices, especially resistors, thermal resistors, potentiometers, condensers, connectors, other connecting devices, small transformers, choke coils and other inductors, telecommunication relays, switches, printed wiring, protection elements, electric current interrupters; printed circuit cards (electric and printed), circuits (electric, integrated and printed); active devices, screens, X-ray tubes, other electron tubes, especially photomultiplier tubes, glow-tubes, microwave electron tubes, diodes, transistors, thyristors including diacs and triacs, other discrete semi-conductor components, crystal units; piezoceramic equipment and devices, radio frequency ceramics; electron valves, camera tubes, transmitting tubes, storage tubes, microwave tubes; microelectronic circuits, especially monolithic integrated circuits (ICs), hybrid ICs, switching ICs, storage ICs; optoelectronic devices and equipment, especially photoelectric devices, displays, electroluminescent panels, microwave components and circuits, magnetic and electromagnetic devices and equipment, ferrite elements, various electronic elements, especially filters, ultramicrotomes and microscopes, including electron microscopes; terrestrial, cable and satellite transmission equipment, local and integrated telecommunication network equipment, remote signalling, control and measuring devices, mobile phones and GSM and GPRS accessories, satellite data transmission antennas, receivers and decoders, radio-communication and TV devices and equipment, especially broadcast and TV transmitters, translators, antennas and antenna arrays, radio-relay links, radio stations, radio link and control devices, CCTV, terrestrial satellite link terminals, TV and radio signal receivers and distribution equipment, public radio and wire broadcasting systems, TV and broadcast studio equipment including sounding and acoustic equipment, TV OB and reporting vans, consoles, public address systems and interpreting equipment, mixing consoles and equipment, localisation equipment, measuring and regulation equipment including wireless systems; radar and navigation devices and aids, radars, data terminal installations; fibre-optic data transmission devices and equipment, lasers and laser telecommunication and measuring equipment, wire-bound communication systems accessories and equipment, especially telephone sets, public exchanges, intercommunication and conference equipment, communication facilities, videophones; magnetic cards, industrial electronics, especially electronic and electric signalling and interlocking systems and monitors as well as road and rail transport, shipping, air carriage and mine haulage equipment including acoustic and optical indication and signalling devices, electronic and electric burglar, fire and other alarm systems, manufacturing automation, regulation and production control machines and equipment including voice-controlled systems, detectors, sensors, actuators, control units, specialist electronic devices for textile industry, especially filament breakage sensors, textile machine control units, electric and electronic vehicle, ship and aircraft equipment and accessories; electronic and electric instruments, oscilloscopes and oscillograph, analyzers, especially electric and electronic recorders, indicating, measuring, monitoring and testing instruments and devices including non-electronic quantity measuring instruments, telecommunication measuring instruments, nuclear technology instruments and equipment, especially particle accelerators, radioactive emission indicator, measuring and monitoring instruments, nuclear resonance spectrometers, meteorological devices, ultrasonic devices, scientific and laboratory apparatus, clock generators, especially electronic metronomes, weighing equipment, vacuum apparatus, especially channel electron multipliers, vacuum interrupters, vacuum condensers, vacuum generation and measurement devices, mass spectrometers, ultravacuum devices, linear accelerators, microwave oscillators, coherent radiation generators; special electrical technology and electronics materials, especially semiconductors, ferromagnetic and highly pure chemicals; consumer electronics devices, especially radio and TV sets including the combination thereof with other equipment, monitors, displays and display devices including advertising display boards and LED display boards; video recorders, tape recorders, memo recorders, record players, magnetic tape recorders, video cameras, audio- and video-players including digital players, tuners and electronic amplifiers, cinematographic equipment, cameras, movie cameras, photo-electronic accessories, TV games and toys, consumer electronics accessories and parts, electromechanical, electromagnetic and electro-acoustic converters, microphones, loudspeakers, earphones and amplifiers, CD and DVD players, all-format sound, video and image recorders and players, cables; data collection, transmission, processing and storage machines and equipment and the combinations thereof, especially computers, servers, PDAs, notebooks, calculators, CPUs, microprocessors, computer components and hardware including sources and peripheries, graphic display units, modems, terminals, printers, copy machines, scanners, faxes and other office equipment, electronic diaries, indicators, interactive set-top boxes for data reception and sending; storage media, especially records, tapes, cassettes, discs, cards, chips; cables including optical cables and accessories; electronic teaching aids for polytechnic teaching and education including microcomputers and electronic kits and games; computer software including interactive multimedia applications and games, trainers and simulators of all types, especially for military and aviation use; irons and gooses of all kinds; components, parts and accessories of all the above mentioned products.

11 – Electric light sources, especially bulbs, discharge lamps, fluorescent lamps, lighting installations, lighting fittings and their parts; all types of heat consumers based on both direct and indirect heating systems, especially electric and gas cookers, kitchen ranges, water heaters, kettles, heat guns, infra-red heaters, grills, sandwich-makers, toasters, welders, deep fryers, roast ovens, ovens, air heaters, electric fire, heater fans, air conditioners, water heat radiators for baths, curling irons, hair driers, microwave ovens, perm rods, washing machines; bubble baths, vibration massage machines; cooling systems, refrigerators, freezers, ice-cream makers, steam generators, drying, and ventilation systems, water distribution systems and sanitary facilities including but not only air-conditioning units, driers, dehumidifiers, humidifiers, range hoods and ventilation

systems including accessories and components of all the previous products.

**Application/registration number:** EUTM 007050024

**Filing Date:** 09/07/2008

**Registration date:** 22/03/2011

**Name and address of the owner:**

TESLA Holding a.s.  
Poděbradská 56/186  
CZ-180 66 Praha 9 – Hloubětín  
CZECH REPUBLIC

**Trademark:**



**List of goods and/or services on which the conflict is based:**

07 - Alternators, fittings for engine boilers, packing machines, pumps (machines), pump diaphragms, high pressure washers, feeders (parts of machines), conveyers (machines), belt conveyors, ejectors, gas-operated soldering irons, labellers (machines), filters (parts of machines, motors or engines), milling machines, generators of electricity, drive motors, other than for land vehicles, engines, other than for land vehicles, gas-operated soldering blow pipes, filter presses, carburettors, hammers (parts of machines), universal joints (cardan joints), compressors (machines), condensing installations, boiler tubes (parts of machines), metalworking machines, bread cutting machines, food processors (electric), kitchen machines, electric, included in this class, cultivators (machines), glue guns, electric, moulds (parts of machines), moulding machines, presses (machines for industrial purposes), fruit presses, electric, for household purposes, bearings (parts of machines), handling machines, automatic (manipulators), hand-held tools, mechanically operated, blowing engines, agitators, blenders, electric, for household purposes, grinders/crushers, electric, for household purposes, roller bridges, injectors for engines, washing apparatus, bottle washing machines, dishwashers, expansion tanks (parts of machines), de-aerators for feedwater, electromechanical apparatus for preparing beverages, instruments (parts of machines), sharpening machines, knives (parts of machines), electric knives, trimming machines, water separators, degreasing preparations for use in manufacturing processes, air suction machines, bending machines, rinsing machines, tin openers, electric, control cables for machines, engines or motors, control mechanisms for machines, engines or motors, steam engine boilers, bottle sealing machines, filling machines, bottle filling machines, propulsion mechanisms other than for land vehicles, washing machines (laundry), aerators, racket stringing machines, regulators (parts of machines), sewage pulverisers, cutting machines, blades (parts of machines), piston segments, separators, sieves (machines or parts of machines), lathes (machine tools), starters for motors and engines, bottle capping machines, shears, electric, drying machines, welding machines, electric, sparking plugs for internal combustion engines, glow plugs for diesel engines, electric whisks, electric blenders and whisks for household purposes, sifting machines, pistons for cylinders, valves (parts of machines), cartridges for filtering machines, boring heads (parts of machines), drilling machines, heat exchanger units (parts of machines), dusting apparatus, vacuum pumps (machines), air condensers, igniting magnetos, aerated water making apparatus, bottle stoppering machines, watering machines for agricultural purposes, ironing machines.

09 - Accumulators, electric, aerials, audiovisual teaching apparatus, distribution machines, automatic, electric batteries, cells, lightning arresters, lightning conductors, buzzers, electric, electric coils, electromagnetic coils, choking coils (impedance), cyclotrons, bar code readers, time switches, automatic, chips (integrated circuits), galvanic cells, grids for batteries, solar batteries, contact lenses, optical lenses, readers (data processing equipment), remote control apparatus, electric installations for the remote control of industrial operations, electric apparatus for remote ignition, detectors, diagnostic apparatus, not for medical purposes, slide projectors, optical lamps, diffraction apparatus (microscopy), dictating machines, magnetic disks, compact discs (audio-video), luminous or mechanical road signs, electric wires, digital video disc players, electric cables, electric connections, welding apparatus, electric, electric devices for attracting and killing insects, hair-curlers, electrically

heated, electrified fences, electronic pens (display units), electronic notice boards, thermionic lamps and tubes, facsimile machines, respirators for filtering air, fluorescent screens, cameras (photography), galvanic cells, galvanizing apparatus, electroplating apparatus, apparatus for changing record player needles, record players, hands-free sets for telephones, voting machines, speaking tubes, chronographs, time recorders, indicators (electricity), inductors (electricity), integrated circuits, intercommunication apparatus, coaxial cables, junction sleeves for electric cables, starter cables, fibre optic cables, cinematographic cameras, batteries for pocket lamps, torches, integrated circuit cards (smart cards), cathodes, containers for microscope slides, collectors, electric, electric apparatus for commutation, terminals (electricity), capacitors, connectors (electricity), contacts, electric, photocopiers (photostatic, electrostatic, thermic), make-up removing appliances, electric, armatures (electricity), covers for electric outlets, darkroom lamps (photography), lasers, not for medical purposes, magnetic data media, magnetic cards (encoded), magnetic encoders, audio cassette recorders, video recorders, beacons, luminous, megaphones, converters, electric, microwave equipment, microprocessors, modems, chargers for electric batteries, furniture especially made for laboratories, signals, luminous or mechanical, navigational instruments, optical data media, notebook computers, objectives (lenses) (optics), screens, branch boxes (electricity), electric resistances, anti-interference devices (electricity), limiters (electricity), optical discs, optical apparatus and instruments, oscillographs, personal stereos, lighting ballasts, ozonators, soldering irons, electric, luminous or mechanical signalling panels, computer peripherals, projection screens, plotters, calculating machines, computers, computer memories, fuses, semiconductors, printed circuits, cases fitted with dissecting instruments (microscopy), processors (central processing units), projection apparatus, cathodic anti-corrosion apparatus, cassette players, compact disc apparatus, portable telephones, voltage surge protectors, circuit breakers, audio and video receivers, sound reproduction apparatus, radars, radios, radiotelephony sets, regulating apparatus, electric, electric light dimmers, rheostats, dimmer switches (electric), heat regulating apparatus, electric relays, rheostats, loudspeakers, vehicle radios, switchboards, control panels (electricity), satellite navigation apparatus, transmitters of electronic signals, sirens, distribution boxes (electricity), image sensors, scanners (data processing), recorded computer software, sonars, circuit closers, connectors for electric lines, masts for wireless aerials, welding electrodes, electric welding apparatus, flashing lights (luminous signals), junction boxes (electricity), telephone wires, telephone apparatus, TV sets, transformers (electricity), transistors (electricity), automatic turnstiles, particle accelerators, scales, electricity conduits, video cameras, videophones, conductors, electric, switches, electric, transmitting sets (telecommunications), transmitters of electronic signals, high-frequency apparatuses, teaching apparatus, data processing equipment, radiotelegraphy sets, sockets and other contacts (electric connections), electric, answering machines, amplifying tubes, amplifiers, flashlights (photography), electric irons, with express exclusion of electronic keys locks; access control devices and alarms.

11 – Globes for lamps, mixer taps for water pipes, searchlights, safety lamps, purification installations for sewage, electric coffee percolators, electric lamps, blankets, electric, not for medical purposes, electrically heated carpets, rugs, filters for air conditioning, filters for drinking water, fountains, deep-fryers, electric, hydrants, cooling apparatus and equipment, ice boxes, ionising apparatus for the treatment of air, electric appliances for making yoghurt, shower booths, stoves, pocket searchlights, coffee machines, electric, air-conditioning apparatus, solar collectors (heating), flushing tanks, electric kettles, bath installations, cooking utensils, electric, laboratory lamps, refrigerating cabinets, refrigerating appliances and installations, electrically heated footmuffs, steam facial apparatus (saunas), nuclear reactors, lamp mantles, ventilation hoods, desalinisation plants, hot water heating installations, lighting apparatus and installations, luminous tubes for lighting, bakers' ovens, urinals (sanitary fixtures), polymerisation installations, air cooling apparatus, griddles (cooking appliances), radiators (heating), regulating and safety accessories for water apparatus, sanitary apparatus and installations, flares, sterilisers, air purifying apparatus and machines, drying apparatus and machines, lamps, light reflectors (lights), automobile lights, heat accumulators, hot air apparatus, autoclaves (electric pressure cookers), pressure water tanks, toasters, microwave ovens (cooking apparatus), cooking apparatus and installations, fans (air-conditioning), ventilation (air-conditioning) installations and apparatus, filaments for electric lamps, hair driers, water distribution installations, lighting apparatus for vehicles, discharge tubes, electric, for lighting, heat exchangers (not parts of machines), water purifying apparatus and machines, disinfectant apparatus, water supply installation, air filtering installations, water filter kits, cooling installations for water, water purification installations, installations for conditioning air, water conduit installations, watering installations, automatic, water softening installations, light bulbs.

## VI.

**Refusal for all the goods.**

## VII. Answer to the decision of refusal:

- a) **Time limit to file an answer:** Within one (1) month following the date of the notification of provisional refusal sent by WIPO. Furthermore, this period can be extended once, for one (1) month, at the request of the interested party, online at <http://www.inpi.pt/>, by fax (+351 218 869 859), or by paper form.

**b) Authority to which the answer should be filed:**

**INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL**

DIREÇÃO DE MARCAS E PATENTES

Campo das Cebolas

1149-035 – LISBOA PORTUGAL

Fax.: 21 886 98 59

Tel.: 21 881 81 00

Link: <http://www.inpi.pt/>

E-mail: [atm@inpi.pt](mailto:atm@inpi.pt)

**VIII. Date of the decision:** 2017/04/07

**IX. Date and signature:** 2017.04.10 Nuno Anunciação

*Nuno Anunciação*

## **X. Corresponding essential provisions of the applicable law:**

### **Industrial Property Code**

(approved by Decree-Law 36/2003 of 5 March and amended by Decree-Law 318/2007 of 26 September, Decree-Law 360/2007 of 2 November, Decree-Law 143/2008 of 25 July and Law 16/2008 of 1 April)

#### **Art. 222<sup>nd</sup> – Composition of trademark**

- 1 – A trademark may consist of a sign or set of signs that can be represented graphically, namely words - including the names of persons - , drawings, letters, numbers and sounds, the form of the product or respective packaging, provided that they adequately distinguish the products and services of one company from those of others.
- 2 – A trademark may also consist of advertising phrases for the respective products or services, provided that they are distinct in character, regardless of the protection conferred upon them by copyright.

#### **Art. 223<sup>rd</sup> – Exceptions**

The conditions of [article 222<sup>nd</sup>] are not met by:

- a) - Trademarks that are devoid of any distinctive character;
- b) - Signs that exclusively consist of the form imposed by the nature of the product itself, the form of the product necessary for obtaining a technical result or the form that confers a substantial value on the product;
- c) - Signs that are exclusively made up of indications that may serve in commerce to designate the type, quality, quantity, purpose, value, geographic origin, period or means of production of the product or the service, or other characteristics thereof;
- d) - Trademarks that exclusively consist of signs or indications that have become common use in modern-day language or in the habitual and constant habits of commerce;
- e) - Colours, save where they are combined with each other or with graphics, wording or other particular and distinctive elements.

#### **Art. 238<sup>th</sup> – Grounds for refusal of a registration**

- 1 – [...] registration of a trademark is refused when:
  - a) - It consists of signs that cannot be represented graphically;
  - b) - It consists of signs devoid of any distinctive character;
  - c) - It consists exclusively of signs or indications referred to in Article 223(1) (b) to (e);[...]
- 4 – Registration of a trademark will also be refused if it contains in some or all of its constitutive elements:
  - a) - symbols, crests, emblems or distinctions of the state, municipalities or other Portuguese or foreign public or private bodies, the emblem and name of the Red Cross or other similar bodies and any signs covered by Article 6-ter of the Paris Convention for the Protection of Industrial Property;
  - b) - signs of a high symbolic value, such as religious symbols, unless these are authorised;
  - c) - expressions or figures that are contrary to the law, morals, public order and morality;
  - d) - signs that may mislead the public, namely as to the nature, properties, utility or geographic origin of the product or service for which the trademark is designed.
- 5 – Registration of a trademark that is made up exclusively of the national flag of the Portuguese Republic or some of its constitutive elements will also be refused.
- 6 – Registration will also be refused for a trademark that contains, amongst other elements, the national flag, wherever the trademark is likely to:
  - a) - mislead the public as to the geographic origin of the products or services for which it is designed;
  - b) - lead the consumer to erroneously think that the products or services come from an official body;
  - c) - generate disrespect or a diminution of prestige for the national flag or any of its elements.

#### **Art. 239<sup>th</sup> – Other grounds for refusal**

- 1 – Further grounds for refusal of registration of a trademark are:
  - a) - reproduction or imitation of all or part of a trademark previously registered by another person for identical or similar products or services that may mislead or confuse the consumer or comprise the risk of association with the already registered trademark;
  - b) - reproduction or imitation of all or part of a logotype already registered by another person to distinguish an entity whose activity is identical or similar to the products or services for which the trademark is designed, if it is likely to mislead or confuse the consumer;
  - c) - violation of other industrial property rights;
  - d) - the use of names, portraits or any other expressions or figurations without the authorisation of the persons they relate to or, if these are deceased, of their heirs or relatives to the fourth degree or, if authorisation is obtained, if it generates disrespect or diminution of prestige for those persons;
  - e) - recognition that the applicant's intent is one of unfair competition or that unfair competition is a possible outcome, regardless of the applicant's intention.
- 2 – When cited in an opposition, the following are also grounds for refusal:
  - a) - reproduction or imitation of a business or corporate name and other distinctive signs, or merely a characteristic part thereof, that do not belong to the applicant or where the applicant is not authorised to use them, if it is likely to mislead or confuse the consumer;
  - b) - violation of copyright;

The English version of the Industrial Property Code is available at: <http://www.inpi.pt/>