

PROVISIONAL REFUSAL

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

Refusal based on an opposition

I. Office:

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

II. International registration number: 1387991

Trademark elements: LUX

III. Name and address of the holder: GUANGZHOU DARING INTERNATIONAL FORWARDING CO., LTD. RM. 719, NO. 799, SANYUANLI AVENUE, BAIYUN DIST. GUANGZHOU, CHINA

IV. Grounds for refusal:

a) Corresponding essential provisions of the applicable law under IX:

Art.239, N.1, a), Art.245, Art. 17, Art.252, do CPI

V. Opponent rights.

Application/registration number: 011087178(EUTM)

Filing Date: 01/08/2012

Registration date (if available): 12/12/2012

Priority date (if any): N.A.

Name and address of the opponent:

LUX INDUSTRIES LIMITED, 39 Kali Krishna Tagore Street, WEST BENGAL, CALCUTTA 700007 LA INDIA

Trademark:



List of goods and services on which the opposition is based:

Class 25: Garments and undergarments.

VI. Refusal for all the goods.

VII. Answer to the decision of refusal:

- a) Time limit to file an answer:** Within two (2) months following the date of the notification of provisional refusal sent by WIPO. This period can be extended once, for one (1) month, at the request of the interested party. The extension of period must be submitted before the first two (2) month period is over.

The answer and payment to this notification can be submitted electronically through the Website online services, available at www.inpi.pt (upon requiring the use of a digital signature certificate). In the case of electronic reply, the applicant will benefit of a fee discount of 50%.

Otherwise, the answer and payment to this notification can be submitted in person or by Mail, with the proper form (available for download at **FORM M4**) and the respective means of payment (a bank check, issued to the National Institute of Industrial Property).

The atual values to be paid can be found at www.inpi.pt. If further clarification is necessary, please contact us via telephone at **+351 21 881 81 00** or send an email to atm@inpi.pt

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

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E-mail: atm@inpi.pt

VIII. Date and signature: 2018.05.21 Jose Alves Ribeiro

IX. 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. 222nd – 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. 223rd – Exceptions

- 1 – The conditions of [article 222nd] 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. 238th – 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. 239th – 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>

Marca Internacional N.º 1387991

Exmo. Senhor Director da Direcção de Marcas e Patentes
do Instituto Nacional da Propriedade Industrial, I.P.



600028 Y

RECLAMAÇÃO

LUX INDUSTRIES LIMITED, sociedade indiana, com sede em 39 Kali Krishna Tagore Street, West Bengal, Calcutta 700007, India (doravante aqui denominada "a Reclamante"),

r e c l a m a

contra a eventual concessão de protecção, em Portugal, ao registo internacional da marca N.º 1387991, depositada na Secretaria Internacional de Genebra, em 11 de Dezembro de 2017, por **GUANGZHOU DARING INTERNATIONAL FORWARDING CO., LTD.**, sociedade chinesa, com sede em Rm. 719, No. 799, Sanyuanli Avenue, Baiyun Dist., Guangzhou, China (doravante aqui denominada "a Depositante"), nos termos e com os fundamentos seguintes:

1º

A marca em causa, mista, é caracterizada pelo seguinte conjunto gráfico-figurativo

LUX

2º

Propõe-se a mesma marca assinalar os seguintes produtos na Classe 25 da Classificação Internacional:

"Tee-shirts; smocks; clothing; sports jerseys; knitwear [clothing]; shoes; hats; hosiery; scarves; leather belts [clothing]"

Porém,

3º

A Reclamante é titular do registo de marca na União Europeia Nº 11087178



apresentada em 1 de Agosto de 2012, concedida em 12 de Dezembro de 2012 e que assinala os seguintes produtos na Classe 25 da Classificação Internacional:

"Garments and undergarments".

Ora,

4º

Entre as marcas

LUX

(da Depositante)

e



(da Reclamante)

EXISTEM GRAVOSAS SEMELHANÇAS GRÁFICAS E FONÉTICAS QUE INDUZIRÃO O CONSUMIDOR EM ERRO OU CONFUSÃO FÁCIL.

De facto,

5º

Ambos os sinais contêm a mesma palavra "LUX".

6º

Acréscce ainda que o aspecto gráfico da marca da Depositante não é suficiente para gerar a necessária distintividade.

7º

Aliás, a palavra "PREMIUMS", descritiva de uma qualidade ou característica dos produtos é genérica (cf. acórdão de 22.05.2012, processo T60/11, «Premium/Suisse Premium»), recaindo assim todo o carácter distintivo da marca da Reclamante apenas sobre a expressão "LUX".

8º

Assim, as marcas em conflito produzem SEMELHANÇA gráfica e fonética marcante porquanto a marca reclamada reproduz a marca da Reclamante.

9º

A Reclamante sente-se prejudicada, a título legítimo, com a eventual protecção e concorrência da marca depositada, porquanto

10º

Entre as marcas em apreço verifica-se a coexistência interdita no Artigo 239.º, N.º 1, alínea a) do Código da Propriedade Industrial, que tem por objectivo garantir a propriedade e exclusivo assegurados na lei.

11º

Os produtos implicados são idênticos e/ou similares: são todos artigos de vestuário.

12º

As circunstâncias acima referidas não tornam fácil a sua diferenciação, a menos que se proceda a um exame atento ou de confronto.

13º

Em direito de propriedade industrial, o significado dos factos cumulativos que antecedem é dado pelo Artigo 245.º do referido Código, preceito este definidor do conceito de imitação de marca.

14º

Configura-se, assim, por simultaneidade dos respectivos requisitos, a figura jurídica da imitação de marca definida na lei (Artigo 245.º do CPI), em razão do que o pedido de marca em questão incorre no disposto no Artigo 239.º, N.º 1, alínea a) do mesmo diploma legal.

15º

Além disso, o Tribunal de Justiça da União Europeia estabeleceu o princípio básico segundo o qual a apreciação global do risco de confusão implica uma certa interdependência entre os fatores tomados em conta, nomeadamente a semelhança das marcas e dos produtos ou serviços designados. Assim, um reduzido grau de semelhança entre os produtos e serviços designados pode ser compensado por um elevado grau de semelhança entre as marcas e inversamente (acórdão de 29.09.1998, processo C-39/97, «Canon», ponto 17, coletânea I-05507).

16º

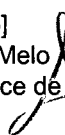
A impugnação é tempestiva porque deduzida dentro do prazo previsto no Artigo 17.º *ex vi* Artigo 252.º do Código citado, o qual termina no dia 8 de Maio de 2018.

Termos em que, pelo exposto e pelo mais que doutamente for suprido, se espera e se requer seja negada protecção à marca internacional N.º 1387991.

E. D.

O Agente Oficial da Propriedade Industrial

[Autenticação]
Lourenço de Melo
Portugal Saluce de
Sampaio



Assinado de forma digital por [Autenticação]
Lourenço de Melo Portugal Saluce de Sampaio
DN: cn=[Autenticação] Lourenço de Melo
Portugal Saluce de Sampaio, sn=de Melo
Portugal Saluce de Sampaio,
givenName=Lourenço, c=PT, o=J.E.DIAS
COSTA LDA, ou=Certificado para pessoa
singular, [Autenticação],
serialNumber=IDCPT-10972793
Dados: 2018.05.08 16:27:42 +01'00'

LOURENÇO DE SAMPAIO
Agente Oficial da Propriedade Industrial
Rua do Salitre, 195
1269-063 LISBOA

Lisboa, 8 de Maio de 2018.