


IR 377/2018/W1-1

**MADRID AGREEMENT AND PROTOCOL  
MADRIDER ABKOMMEN UND PROTOKOLL**

PROVISIONAL REFUSAL OF PROTECTION Rule 17 (1)

VORLÄUFIGE SCHUTZVERWEIGERUNG Regel 17 (1)

<p>I. Authority pronouncing the refusal: <b>Austrian Patent Office Dresdner Straße 87 A – 1200 Vienna (Austria)</b></p>	<p>Behörde, die die Schutzverweigerung erlassen hat: <b>Österreichisches Patentamt Dresdner Straße 87 A – 1200 Wien (Österreich)</b></p>
<p>II. Number of the international registration: <b>LUX</b> Nr. der internationalen Registrierung: 1 387 991  Number of the basic registration / application and country of origin: Nr. der Basisregistrierung / -anmeldung und Ursprungsland: 19838063 China</p>	
<p>III. <input checked="" type="checkbox"/> Provisional refusal based on opposition(s) Vorläufige Schutzverweigerung wegen eines(mehrerer) Widerspruchs(-sprüche)  <input type="checkbox"/> Provisional refusal based on both - <i>ex officio</i> examination and opposition Vorläufige Schutzverweigerung wegen absoluter Gründe und Erhebung eines Widerspruchs</p>	
<p>IV. <input checked="" type="checkbox"/> Provisional refusal for all the goods and/or services Vorläufige Schutzverweigerung für alle Waren und/oder Dienstleistungen</p>	
<p>V. Grounds for refusal Gründe der vorläufigen Schutzverweigerung  <input type="checkbox"/> Absolute grounds  <input checked="" type="checkbox"/> Opposition(s) by opponent(s): see VI. Eingelangte Widersprüche: siehe VI.</p>	
<p>VI. Information relating to earlier mark(s) or application(s) Informationen betreffend die ältere(n) Marke(n) oder Anmeldung(en)  1. Type / Registration number / Mark / Filing date / Filing number / Priority date Art / Registernummer / Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum EUTM 011147345 / LUX LUX TOOLS / 011207362 / 2012-09-21    Name and address of the owner(s): Name und Adresse des(der) Inhaber(s): Emil Lux GmbH &amp; Co. KG Emil-Lux-Str. 1 DE-42929 Wermelskirchen  Name and address of the representative: Name und Adresse des Vertreters: Patentanwältin Dipl.-Ing. Dr. techn. Elisabeth Schober, Dipl.-Phys. Dr. phil. Tobias Fox, Dipl.-Ing. Wolfgang Noske Brigittenauer Lände 50 1200 Wien  Referenzzeichen:  Goods and services on which the opposition is based:</p>	

Waren und Dienstleistungen, auf die sich der Widerspruch stützt:

- **1** Tempering and soldering preparations; Adhesives used in industry.
- **3** Cleaning, polishing and abrasive preparations; Abrasive paper.
- **4** Industrial oils and greases; Lubricants; Dust absorbing, wetting and binding compositions; Fuels (including motor spirit) and illuminants; Candles and wicks for lighting.
- **6** Common metals and their alloys; Materials of metal for railway tracks; Ores; Metal building materials; Transportable buildings of metal; Non-electric cables and wires of common metal; Ironmongery, small items of metal hardware; Pipes and tubes of metal; Goods of metal, included in class 6; Garage doors of metal; Tool chests of metal (empty); Statues of common metal; Safes; Fences of metal; Bird houses of metal; Locks (other than electric) of metal; Padlocks; Chains of metal; Hoppers (non-mechanical) of metal; Ladders of metal, stepladders of metal; Pegs of metal; Wall plugs of metal; Fittings of metal for building; Fittings of metal for windows; Fittings of metal for furniture; Door fittings, of metal; Metal door stops; Tensioning and lashing straps; Rods of metal for brazing and welding; Soldering wire of metal; Posts of metal; Wire rope; Workshop equipment, As far as included in international class 06, Including tool holders (aforesaid goods of metal); Tool boxes of metal (empty); Handles of metal for tools and garden implements; Carry straps of metal; Oil cans, special-purpose containers, included in class 6 (the aforesaid goods being of metal); Posts of metal for attaching marking aids, in particular barrier tapes and warning tapes; Gates of metal; metal window screens; Locksets; Pegs of metal; Wall plugs of metal; Trellis and Espaliers; Clips; Clips and nails for hand tackers; Metal legs for furniture and Aluminium; Metal garage door rollers; Rollers of metal for sliding doors; Furniture casters of metal.
- **7** Machines and machine tools, Machine coupling and transmission components (except for land vehicles); Agricultural implements other than hand-operated; Machines and machine tools, Namely colour mixing machines, Building machines, In class 7; Mechanical tools for construction, horticultural and craft purposes, mechanical horticultural and agricultural equipment; Compressors [machines]; Spray guns for paint, Compressed air guns for the extrusion of mastics, Electric glue guns, ELECTRIC POWER STAPLERS; Pistols and pumps for applying paints, mastics and other viscous preparations; Gas-powered soldering irons; Drill chucks (parts of machines), Drilling machines, Electric hand drills, Nut-tapping machines, Drill stands for electric hand drills; Planing machines; Trueing machines, Grinding discs (being a machine part), Cutting discs (parts of machines), Grinding wheels (parts of machines); Saws (machines), Chain saws; Current generators; Welding apparatus, gas-operated; Welding machines, electric; Lawnmowers (machines), Scarifiers (other than hand-operated); Tillers (other than hand-operated); Soil ventilators (other than hand-operated); Snow blowers (other than hand-operated); Snow shovels (other than hand-operated); Snow sweepers (other than hand-operated); Parts for motors and engines, namely spark plugs for internal combustion engines, mufflers for motors and engines (exhausts), petrol and oil filters, filters for cleaning cooling air for motors and engines, cylinders for motors and engines, cylinder heads for motors and engines, pistons for motors and engines, piston rings; Electric roller blind drives, Electric drives for garage doors; Elevators, In particular hoists; Electric arc welding apparatus; Lathes (machine tools); Electric turning machines; Electric straw cutting machines, motorised straw cutting machines; Grindstones (machine parts); Machines for tile laying, gas concrete and dry construction, stone, screed and concrete works, electrical and sanitary installation, masonry, parquet floor, laminate and carpet laying, plastering, painting, wallpapering and welding; Electric tools for construction and DIY, including tool bits therefor; Cordless screwdrivers, chainsaws, grinders, polishers; Drilling hammers, Electric planers, Tile cutting machines, small electric tools, Electric staplers, Electric milling machines; Mechanical garden implements, including lawnmowers and grass-trimming machines; Border shears and chainsaws, and accessories for mechanical garden equipment, namely collecting devices and apparatus covers; Spare parts for mechanical garden tools, included in class 7; Driving machines for tools; Mobile generators; Soldering and welding machines (gas-operated); Compressed air tools; Lathes (machine-operated); Wood-turning lathes (machine-operated); Pressure spraying devices (machine-operated); Couplings other than for land vehicles; Grinding inserts, grindstones and replacement parts for the aforesaid goods; Rollers and wheels for machines; Soldering irons, electric; Welding apparatus.
- **8** Manually operated tools; Hand-operated implements for agricultural, horticultural and forestry purposes, and for structural engineering; Hand-operated vaporisers; Hand-operated guns for applying paints, mastics and other thick fluid products, Guns, hand-operated, for the extrusion of mastics; Spatulas [hand tools]; Cutlery, cutlery of plastic or metal; Silver plate (cutlery); Snow shovels (hand tools); Ice scrapers; Sharpening stones; Tackers (hand-operated); Hand-operated riveting tools; Trowels; Saws (hand tools); Files [hand tools]; Clamps for carpenters or coopers; Tongs [hand tools]; Screwdrivers; Wrenches (hand tools); Hammers (hand tools); Axes; Lawn clippers (hand instruments); Border shears; Planes; Stationery scissors; Riveting pincers; Scraping tools (hand tools); Hand tools for tile laying, gas concrete and dry mortarless construction, stone, screed and concrete works, electrical and sanitary installation, masonry, parquet floor, laminate and carpet laying, plastering; Painting and welding; Hand tools, including cutting, separating, embossing and striking tools, in particular Japanese chisels, borers, rasps, thread cutters, planes, trowels, chisels, screwdrivers, socket wrenches and socket wrench sets, vices, pliers, tool holders, hand-operated grippers and carrying equipment, including stone-carrying equipment, sanding blocks, ferrules of metal, hand riveters, eyelet pliers; Hand-operated tile-cutting apparatus, knives, in particular pocket knives, cutter blades, glass cutters, carpet knives, blades, cutters; Scissors, including household scissors, secateurs, branch, tree and hedge clippers, hand-operated garden implements, including forks, hoes, spades, shovels, rakes, sickles, scythes, trimmers and hand-operated lawnmowers; Hand-operated vaporisers; Hand-operated pneumatic apparatus; Spare parts for the aforesaid goods; electric flat irons.
- **9** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Apparatus for recording, transmission or reproduction of sound or images; Fire-extinguishing apparatus; Electric installation material (included in class 9), Namely electric cables and Electrical wire; Material for electricity mains (wires, cables); Lustre terminals; Plugs, sockets and other contacts [electric connections]; Covers for electric outlets; Cable ducts; Volt meters; Electric welding apparatus; Welding electrode; Solderers' helmets; Electronic control systems for shutters, Time switches, automatic; Electronic monitoring and measuring apparatus, electronic security systems, namely motion detectors, gas, smoke and carbon monoxide alarms, radio transmitters and receivers for controlling light, electric burglar alarm installations, bells (alarm installations), door phones, telephone apparatus; Portable telephones; Answering machines; Vehicle radios, Compact disc players (CDP), Aerials and aerial accessories (included in class 09); Satellite receiving apparatus and aerials, optical data media, video cassettes;

Bicycle computers; Solar energy collectors for electricity generation; Electric batteries, battery charging equipment; Measuring apparatus; Measuring tools; Thermostats; Thermometers (not for medical purposes); Scales; Signs, luminous; Work protection clothing (included in class 9); Protective helmets, protective sports helmets, Arm, knee and wrist guards (work safety); Gloves for protection against accidents; Locks, electric; Gloves for protection; Protective goggles and masks; Safety belts and fastening belts, except for vehicle seats, included in class 9; Voltage detectors; Intercommunication systems; Marking aids, in particular barrier tapes and warning tapes.

- **10** Hearing protectors.
- **11** Apparatus for lighting heating steam generating cooking refrigerating drying ventilating water supply and sanitary purposes; Sanitary apparatus.
- **12** Vehicles; Apparatus for locomotion by land, air or water; Load and transport rollers; Rollers and Wheels for vehicles; Hose carts; Rollers and Wheels for barrows and Sack-barrows.
- **16** Paper, cardboard and goods made from these materials (included in class 16); Printed matter; Bookbinding material; Photographs; Stationery; Adhesives for stationery or household purposes; Artists' materials; Paintbrushes; Typewriters and office requisites (except furniture); Instructional and teaching material (except apparatus); Plastic materials for packaging, included in class 16.
- **17** Rubber, gutta-percha, gum, mica and goods made from these materials and not included in other classes; Packing, stopping and insulating materials; Flexible pipes, not of metal; Insulating gloves; Self-adhesive tapes, other than stationery and not for medical or household purposes; Plastic film, Namely pond liners and Building membranes.
- **18** Leather and imitations of leather, and goods made of these materials and not included in other classes; Saddlery; Tool bags (empty); Tool chests of leather (empty); Tool bags (empty), not of metal, not of leather.
- **19** Building materials (non-metallic); Non-metallic rigid pipes for building; Asphalt, pitch and bitumen; Non-metallic transportable buildings; Monuments, not of metal.
- **20** Furniture, mirrors, picture frames; Goods (not including in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; Dowels, not of metal; Wall plugs, not of metal; Window fittings, not of metal; Furniture fittings, not of metal; Door fittings, not of metal; Locks (other than electric), not of metal; Pasting tables; Racks [furniture]; Tool stands, Not of metal; Door stoppers, not of metal; Workshop equipment, included in class 20, including tool cabinets, small parts storage boxes, open storage boxes, sorting boxes, tool holders, machine tables, tool stands, workbenches (the aforesaid goods not of metal); Workshop equipment (furniture), including tool cabinets, storage boxes for small parts, open storage boxes, sorting boxes, machine tables, tool stands, workbenches (the aforesaid goods being of metal); Paste tables, clamping tables; Tool boxes and tool chests (empty), not of metal, not of leather; Handles for tools and garden implements, not of metal; Plastic chains, rope and chain clamps, bolts, plugs, screws, nuts, washers, hooks, rivets (the aforesaid goods all not of metal); Transport pallets; Special-purpose containers, not of masonry, not of metal, included in class 20; Ladders of wood or plastic, stepladders, not of metal; Furniture glides of felt and plastic; Furniture feet of wood and plastic; Coat hangers; Casters of metal for beds; Casters, not of metal, for beds; Furniture casters, not of metal.
- **21** Household or kitchen utensils and containers (not of precious metal or coated therewith); Combs and sponges; Brushes (except paint brushes); Articles for cleaning purposes; Steelwool; Brooms; Funnels.
- **22** Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (so far as included in class 22); Raw fibrous textile materials; Tensioning and lashing straps, not of metal.
- **24** Textiles and textile goods, not included in other classes.
- **25** Clothing, footwear, headgear.
- **26** Ribbons and braid; Buttons, hooks and eyes, pins and needles; Velcro.

2. Type / Registration number / Mark / Filing date / Filing number / Priority date  
 Art / Registernummer / Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum  
 EUTM 011147361 / LUX / 2012-08-29

Name and address of the owner(s):  
 Name und Adresse des(der) Inhaber(s):  
 Emil Lux GmbH & Co. KG  
 Emil-Lux-Str. 1  
 DE-42929 Wermelskirchen

Name and address of the representative:  
 Name und Adresse des Vertreters:  
 Patentanwälte Dipl. -Ing. Dr. techn. Elisabeth Schober, Dipl. -Phys. Dr. phil. Tobias Fox, Dipl.-Ing. Wolfgang Noske  
 Brigittenauer Lände 50  
 1200 Wien

Referenzzeichen:

Goods and services on which the opposition is based:  
 Waren und Dienstleistungen, auf die sich der Widerspruch stützt

- **1** Tempering and soldering preparations; Adhesives used in industry.
- **3** Cleaning, polishing and abrasive preparations; Abrasive paper.
- **4** Industrial oils and greases; Lubricants; Dust absorbing, wetting and binding compositions; Fuels (including motor spirit) and illuminants.
- **6** Common metals and their alloys; Materials of metal for railway tracks; Ores; Metal building materials; Transportable buildings of metal; Non-electric cables and wires of common metal; Ironmongery, small items of metal hardware; Pipes and tubes of metal; Goods of metal, included in class 6; Garage doors of metal; Tool chests of metal (empty); Safes; Locks (other than electric) of metal; Padlocks; Hoppers (non-mechanical) of metal; Ladders of metal, stepladders of metal; Pegs of metal; Wall plugs of metal; Fittings of metal for building; Fittings of metal for furniture; Tensioning and lashing straps; Rods of metal for brazing and welding; Soldering wire of metal; Posts of metal; Wire rope; Workshop equipment, As far as included in international class 06, Including tool holders (aforesaid goods of metal); Tool boxes of metal (empty); Handles of metal for tools and garden implements; Carry straps of metal; Oil cans, special-purpose containers, included in class 06 (the aforesaid goods being of metal); Posts of metal for attaching marking aids, in particular barrier tapes and warning tapes; Gates of metal; Locksets; Pegs of metal; Wall plugs of metal; Trellis and Espaliers; Clips; Clips and nails for hand tackers; Metal garage door rollers; Rollers of metal for sliding doors; none of the aforementioned goods being blinds, shutters, windows, skylights, roof-windows or accessories hereto.
- **7** Machines and machine tools, Machine coupling and transmission components (except for land vehicles); Agricultural implements other than hand-operated; Machines and machine tools, Namely colour mixing machines, Building machines, In class 7; Mechanical tools for construction, horticultural and craft purposes, mechanical horticultural and agricultural equipment; Compressors [machines]; Spray guns for paint, Compressed air guns for the extrusion of mastics, Electric glue guns, ELECTRIC POWER STAPLERS; Pistols and pumps for applying paints, mastics and other viscous preparations; Gas-powered soldering irons; Drill chucks (parts of machines), Drilling machines, Electric hand drills, Nut-tapping machines, Drill stands for electric hand drills; Planing machines; Trueing machines, Grinding discs (being a machine part), Cutting discs (parts of machines), Grinding wheels (parts of machines); Saws (machines), Chain saws; Current generators; Welding apparatus, gas-operated; Welding machines, electric; Lawnmowers (machines), Scarifiers (other than hand-operated); Tillers (other than hand-operated); Soil ventilators (other than hand-operated); Snow blowers (other than hand-operated); Snow shovels (other than hand-operated); Snow sweepers (other than hand-operated); Parts for motors and engines, namely spark plugs for internal combustion engines, mufflers for motors and engines (exhausts), petrol and oil filters, filters for cleaning cooling air for motors and engines, cylinders for motors and engines, cylinder heads for motors and engines, pistons for motors and engines, piston rings; Electric drives for garage doors; Elevators, In particular hoists; Electric arc welding apparatus; Lathes (machine tools); Electric turning machines; Electric straw cutting machines, motorised straw cutting machines; Grindstones (machine parts); Machines for tile laying, gas concrete and dry construction, stone, screed and concrete works, electrical and sanitary installation, masonry, parquet floor, laminate and carpet laying, plastering, painting, wallpapering and welding; Electric tools for construction and DIY, including tool bits therefor; Cordless screwdrivers, chainsaws, grinders, polishers; Drilling hammers, Electric planers, Tile cutting machines, small electric tools, Electric staplers, Electric milling machines; Mechanical garden implements, including lawnmowers and grass-trimming machines; Border shears and chainsaws, and accessories for mechanical garden equipment, namely collecting devices and apparatus covers; Spare parts for mechanical garden tools, included in class 7; Driving machines for tools; Mobile generators; Soldering and welding machines (gas-operated); Compressed air tools; Lathes (machine-operated); Wood-turning lathes (machine-operated); Pressure spraying devices (machine-operated); Couplings other than for land vehicles; Grinding inserts, grindstones and replacement parts for the aforesaid goods; Rollers and wheels for machines; Soldering irons, electric; Welding apparatus; none of the aforementioned goods being blinds, shutters, windows, skylights, roof-windows or accessories hereto.
- **8** Manually operated tools; Hand-operated implements for agricultural, horticultural and forestry purposes, and for structural engineering; Hand-operated vaporisers; Hand-operated guns for applying paints, mastics and other thick fluid products, Guns, hand-operated, for the extrusion of mastics; Spatulas [hand tools]; Snow shovels (hand tools); Ice scrapers; Sharpening stones; Tackers (hand-operated); Hand-operated riveting tools; Trowels; Saws (hand tools); Files [hand tools]; Clamps for carpenters or coopers; Tongs [hand tools]; Screwdrivers; Wrenches (hand tools); Hammers (hand tools); Axes; Lawn clippers (hand instruments); Border shears; Planes; Stationery scissors; Riveting pincers; Scraping tools (hand tools); Hand tools for tile laying, gas concrete and dry mortarless construction, stone, screed and concrete works, electrical and sanitary installation, masonry, parquet floor, laminate and carpet laying, plastering; Painting and welding; Hand tools, including cutting, separating, embossing and striking tools, in particular Japanese chisels, borers, rasps, thread cutters, planes, trowels, chisels, screwdrivers, socket wrenches and socket wrench sets, vices, pliers, tool holders, hand-operated grippers and carrying equipment, including stone-carrying equipment, sanding blocks, ferrules of metal, hand riveters, eyelet pliers; Hand-operated tile-cutting apparatus, knives, in particular pocket knives, cutter blades, glass cutters, carpet knives, blades, cutters; Scissors, including household scissors, secateurs, branch, tree and hedge clippers, hand-operated garden implements, including forks, hoes, spades, shovels, rakes, sickles, scythes, trimmers and hand-operated lawnmowers; Hand-operated vaporisers; Hand-operated pneumatic apparatus; Spare parts for the aforesaid goods; electric flat irons.
- **9** Signalling, life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; Fire-extinguishing apparatus; Electric installation material (included in class 9), Namely electric cables and Electrical wire; Material for electricity mains (wires, cables); Lustre terminals; Plugs, sockets and other contacts [electric connections]; Covers for electric outlets; Cable ducts; Volt meters; Electric welding apparatus; Welding electrode; Solderers' helmets; Time switches, automatic; Electronic security systems, namely motion detectors, gas, smoke and carbon monoxide detectors, electric theft prevention installations, bells (warning devices), optical data media, video cassettes; Solar energy collectors for electricity generation; Electric batteries, battery charging equipment; Thermostats; Thermometers (not for medical purposes); Scales; Work protection clothing (included in class 9); Protective helmets, protective sports helmets, Arm, knee and wrist guards (work safety); Gloves for protection against accidents; Locks, electric; Gloves for protection; Protective goggles and masks; Safety belts and fastening belts, except for vehicle seats, included in class 9; Voltage detectors; Intercommunication systems; Marking aids, in particular barrier tapes and warning tapes; none of the aforementioned goods being blinds, shutters, windows, skylights, roof-

windows or accessories hereto.

- **10** Hearing protectors.
- **12** Load and transport rollers; Rollers and Wheels for vehicles; Hose carts; Rollers and Wheels for barrows and Sack-barrows.
- **16** Printed matter; Bookbinding material; Photographs; Adhesives for stationery or household purposes; Artists' materials; Paintbrushes; Typewriters and office requisites (except furniture); Instructional and teaching material (except apparatus).
- **17** Flexible pipes, not of metal; Insulating gloves; none of the aforementioned goods being blinds, shutters, windows, skylights, roof-windows or accessories hereto.
- **18** Tool bags (empty); Tool chests of leather (empty); Tool bags (empty), not of metal, not of leather.
- **19** Building materials (non-metallic); Non-metallic rigid pipes for building; Asphalt, pitch and bitume; none of the aforementioned goods being blinds, shutters, windows, skylights, roof-windows or accessories hereto.
- **20** Dowels, not of metal; Wall plugs, not of metal; Locks (other than electric), not of metal; Pasting tables; Racks [furniture]; Tool stands, Not of metal; Door stoppers, not of metal; Workshop equipment, included in class 20, including tool cabinets, small parts storage boxes, open storage boxes, sorting boxes, tool holders, machine tables, tool stands, workbenches (the aforesaid goods not of metal); Workshop equipment (furniture), including tool cabinets, storage boxes for small parts, open storage boxes, sorting boxes, machine tables, tool stands, workbenches (the aforesaid goods being of metal); Paste tables, clamping tables; Tool boxes and tool chests (empty), not of metal, not of leather; Handles for tools and garden implements, not of metal; Plastic chains, rope and chain clamps, bolts, plugs, screws, nuts, washers, hooks, rivets (the aforesaid goods all not of metal); Transport pallets; Special-purpose containers, not of masonry, not of metal, included in class 20; Ladders of wood or plastic, stepladders, not of metal; Furniture glides of felt and plastic; Coat hangers; Casters of metal for beds; Casters, not of metal, for beds; none of the aforementioned goods being blinds, shutters, windows, skylights, roof-windows or accessories hereto.
- **21** Sponges; Articles for cleaning purposes; Steelwool; Brooms; Funnels.
- **22** Ropes, string, nets, tents, tarpaulins, sails, sacks and bags (so far as included in class 22); Raw fibrous textile materials; Tensioning and lashing straps, not of metal; none of the aforementioned goods being blinds, shutters, windows, skylights, roof-windows or accessories hereto.
- **26** Hooks and eyes, pins and needles; Velcro.

3. Type / Registration number / Mark / Filing date / Filing number / Priority date

Art / Registernummer / Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum

EUTM 004355558 / LUX LUX / 2005-03-22



Name and address of the owner(s):

Name und Adresse des(der) Inhaber(s):

Emil Lux GmbH & Co. KG

Emil-Lux-Str. 1

DE-42929 Wermelskirchen

Name and address of the representative:

Name und Adresse des Vertreters:

Patentanwälte Dipl. -Ing. Dr. techn. Elisabeth Schober, Dipl. -Phys. Dr. phil. Tobias Fox, Dipl.-Ing. Wolfgang Noske

Brigittenauer Lände 50

1200 Wien

Referenzzeichen:

Goods and services on which the opposition is based:

Waren und Dienstleistungen, auf die sich der Widerspruch stützt:

- **1** Tempering and soldering preparations, adhesives used in industry, cartridges for hot melt guns.
- **3** Abrasives, sandpaper.
- **4** Industrial oils and greases; lubricants.
- **6** Ironmongery and small items of hardware of common metals and metal alloys, in particular nails, pins, screws, washers, nuts, rivets, clamps, hooks, eyelets, plugs; non-electric cables and wires of common metal; wire ropes, chains of metal and accessories therefor, included in class 6; cable clips of metal; padlocks; workshop equipment, included in class 6, including tool cabinets, small parts storage boxes, open storage boxes, sorting boxes, tool holders, machine tables, tool stands,

workbenches (the aforesaid goods of metal); tool chests and toolboxes (empty) of metal; handles of metal for tools and garden implements; carry straps of metal; load and transport rollers, rollers and wheels, included in class 6; oil cans, hoppers, special-purpose containers, included in class 6 (the aforesaid goods of metal); marker aids, in particular shut-off and warning bands, posts for fixing the aforesaid goods.

- **7** Machines and machine tools; and accessories and spare parts therefor, included in class 7; machines for tile laying, gas concrete and dry mortarless construction, stone, screed and concrete works, electrical and sanitary installation services, masonry services, parquet floor, laminate and carpet laying, plastering; electric tools for construction and DIY, including tool bits therefor; cordless screwdrivers, chainsaws, grinders, polishers; hammer drills, drilling machines, power planers, tile-cutting machines, compressors, small electric tools, electric staplers, electric milling cutters; mechanical garden implements, including lawnmowers and grass-trimming machines; straw cutters, hedge trimmers and chainsaws, and accessories for mechanical garden implements, namely collecting devices and apparatus covers; spare parts for mechanical garden tools, included in class 7; driving machines for tools; mobile generators; hot melt guns; soldering and welding apparatus (gas-powered), electric welding machines; compressed air tools.
- **8** Hand tools and implements (hand-operated), and accessories therefor, included in class 8, hand tools for tile laying, gas concrete and dry mortarless construction, stone, screed and concrete works, electrical and sanitary installation services, masonry services, parquet floor, laminate and carpet laying, plastering; hand tools, including cutting, separating, embossing and impact tools, in particular hatchets, axes, drills, files, rasps, thread cutters, hammers, planers, clips, trowels, spatulas, chisels, saws, spanners, screwdrivers, socket wrenches and sockets for wrenches, vices, tongs, tool holders, hand-operated gripping and carrying apparatus, including stone-carrying apparatus, sanding blocks, clamps, riveting pincers, eyelet punches, hand tackers and clamps and nails therefor; hand-operated tile-cutting apparatus, knives, in particular pocket knives, cutter lames, glass cutters, carpet knives, blades, cutters; scissors, including household scissors, secateurs, branch, tree and hedge clippers, hand-operated garden implements, including forks, hoes, spades, shovels, rakes, sickles, scythes, trimmers and hand-operated lawnmowers; snow shovels; hand-operated vaporisers; hand-operated pneumatic apparatus.
- **9** Meters and measuring tools; tape measures, rules, rulers, plumb bobs, angles, protractors, compasses, floats and browning rods, browning rods with spirit levels, spirit levels, including using laser technology, measuring gauges, vernier calipers; electrical gauges; scribing apparatus; thermometers; metal detectors; material for electricity mains (cables, wires), electrical installation material; soldering apparatus and welding apparatus (electric); clothing for protection against accidents and safety wear, included in class 9, goggles, protective masks, dust masks, filters for protective masks, hearing protectors, included in class 9, work gloves and protective gloves, included in class 9, protective helmets, knee pads, accessories in the field of welding safety, namely protective clothing, gloves, aprons, sleeves, protective face masks, protective face shields, welding goggles; safety belts and fastening belts, except for vehicle seats, included in class 9.
- **11** Sanitary installation material; water sprinklers, showers and sprinklers.
- **12** Load and transport rollers, rollers and wheels, included in class 12; Hose carts.
- **16** Painting and wallpapering tools, included in class 16, including paint brushes, special-purpose paint brushes, brushes, rollers, wipers, painting tools for macerating, stamping, stencilling, wiping and speckling; paint trays and stripping frames, spatulas and scrapers; lining paper for protection against paint splashes and dirt; marking aids, in particular chalk and holders, carpenters' pencils, rulers; adhesives and adhesive tapes for stationery and household purposes; artists' materials.
- **17** Foils of plastic (other than for packaging); adhesive tapes for craft purposes, double-sided adhesive tape for carpet laying, adhesive tape being insulating material; cords of rubber; insulating gloves; gaskets; packing, stopping and insulating materials, included in class 17; hoses, garden hoses, and couplings and junctions therefor, included in class 17.
- **18** Tool bags, tool aprons and toolboxes (empty) of leather and imitations of leather.
- **20** Workshop equipment, included in class 20, including tool cabinets, small parts storage boxes, open storage boxes, sorting boxes, tool holders, machine tables, tool stands, workbenches (the aforesaid goods not of metal); paste tables, clamping tables; tool bags, tool chests and toolboxes (empty), not of metal, not of leather; handles for tools and garden implements, not of metal; load and transport rollers, rollers and wheels, included in class 20; plastic chains, rope and chain clamps, bolts, plugs, screws, nuts, washers, hooks, rivets (the aforesaid goods all not of metal); transport pallets; special-purpose containers, not of masonry, not of metal, included in class 20.
- **21** Gloves for household and cleaning purposes, gardening gloves; articles for cleaning purposes; scrubbers, wipers; sponges; brushes (except paint brushes), brooms, hand brushes, broom sets; steel wool for cleaning; funnels; buckets; extensions and telescopic rods for handles; clotheslines; traps; plant pots, plant and flower holders (included in class 21); towel and soap holders.
- **22** Ropes and accessories therefor, included in class 22, nets; string, cords; tarpaulins; carry straps, not of metal.
- **24** Non-woven textile fabrics.
- **25** Workclothes, included in class 25, gloves and work gloves, included in class 25.
- **26** Velcro.

VII. Applicable provisions of the national law (see text last pages)  
Anwendbare Bestimmungen des nationalen Gesetzes (siehe Gesetzesauszug auf den letzten Seiten)  
**Section 29a and the following § 29a ff**

VIII. Information relating to subsequent procedure / Information über das weitere Verfahren  
Reply/response to the provisional refusal / Äußerung auf die Schutzverweigerung

(i) Time limit for reply / Äußerungsfrist: 27/12/2018

<p>(ii) The appointment of a representative or – if applicable - a person domiciled in Austria and entitled to receive communications is compulsory (Section 61 Subsections 1 and 4 Trade Mark Act). Die Benennung eines Vertreters oder – sofern anwendbar – eines im Inland wohnhaften Zustellungsbevollmächtigten verpflichtend (§ 61 Abs. 1 und 4 MSchG).</p> <p>(iii) The original opposition request(s) and any accompanying documents will then be communicated to the person or representative appointed once a written reply has been received . Der/die Original-Widersprüche und allfällige Beilagen werden dann an die benannte Person oder den benannten Vertreter zugestellt, sobald eine schriftliche Äußerung eingelangt ist.</p> <p>(iv) In case the trademark holder does not file within the time limit set out in (i) a written statement, which fulfills the requirements of (ii), the refusal will be declared final without further proceedings by the Austrian Patent Office. In case of more than one opposition the trademark holder has to submit one written statement responding to each opposition raised, otherwise the opposition, to which the trademark holder does not respond, will be granted in total. The same applies if no response to the absolute grounds raised –if applicable- has been submitted. Within the time limit set out in (i) the holder of the trademark also has the opportunity to request the opponent/s to furnish proof of use of the trademark/s the opposition/s is/are based on (§ 29 b (3) MSchG). The written statement and any attachment/s shall be accompanied by copies corresponding to the number of oppositions raised. Bringt der Markeninhaber der angegriffenen Marke innerhalb der unter (i) gesetzten Frist keine schriftliche Äußerung, die die Vorgaben aus (ii) erfüllt, ein, so hat das Österreichische Patentamt ohne weiteres Verfahren die endgültige Schutzverweigerung zu verfügen. Im Falle von mehreren Widersprüchen muss sich der Markeninhaber in einem gemeinsamen Schriftsatz erkennbar zu jedem der zugestellten Widersprüche inhaltlich äußern, andernfalls wird einem Widerspruch, auf welchen keine Äußerung des Markeninhabers erfolgt ist, im vollem Umfang stattgegeben. Innerhalb der in (i) genannten Frist hat der Markeninhaber auch die Möglichkeit, den Widersprechenden aufzufordern, den Nachweis der Benutzung für die Widerspruchsmarke/n zu erbringen (§ 29 b Abs. 3 MSchG). Der schriftlichen Äußerung und allfälligen Beilagen sind Kopien in der entsprechenden Anzahl der Widersprüche anzuschließen.</p> <p>(v) Authority to address the reply: see I. Behörde, an die die Äußerung zu richten ist: siehe I.</p>	
IX. Date of provisional refusal Datum der vorläufigen Schutzverweigerung  24/08/2018	Number of Annexes: Zahl der Anhänge: -
X. Signature or official seal of the Office Unterschrift oder Amtsstempel der Behörde  Rechtskundiges Mitglied Mag. Claudia Berger	
XI. Supplementary information Zusätzliche Information  Data concerning the trademark(s) cited as base for opposition may be found using the following links: Registerdaten der Widerspruchsmarke(n) finden Sie unter:  <a href="http://www.patentamt.at">http://www.patentamt.at</a> <a href="http://www.wipo.int/ipdl/en/madrid">http://www.wipo.int/ipdl/en/madrid</a> <a href="http://oami.europa.eu/CTMOnline/RequestManager/de_SearchBasic">http://oami.europa.eu/CTMOnline/RequestManager/de_SearchBasic</a>	
XII.  I. Corresponding essential provisions of the applicable law: Austrian Trade Mark Act (Federal Law Gazette No. 260/1970 in its current version / Bundesgesetzblatt Nr. 260/1970 idgF)  Section 1 A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.  Section 4 (1) Excluded from registration shall be signs which 1. consist exclusively (a) of state coats of arms, national flags or other national emblems or of the coats of arms of Austrian provincial or	

- local authorities;
  - (b) of official certification or guarantee signs which are used in Austria or – pursuant to a notice to be published in the Federal Law Gazette (Section 6 subsection 2) – in a foreign state, for the same goods or services as those for which the mark is intended for, or for similar goods or services;
  - (c) of signs of international organizations to which a member state of the Paris Union for the Protection of Industrial Property belongs, provided the signs have been promulgated in the Federal Law Gazette. The last sentence of Section 6(2) shall apply to such promulgation;
  - 2. cannot constitute a trade mark in accordance with Section 1;
  - 3. are devoid of any distinctive character;
  - 4. consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
  - 5. consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade to designate the good or service;
  - 6. consist exclusively of the shape which results from the nature of the goods themselves, or of the shape of goods which is necessary to obtain a technical result, or of the shape which gives substantial value to the goods;
  - 7. are contrary to public policy or to accepted principles of morality;
  - 8. are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the good or service;
  - 9. contain or consist of a geographical indication identifying wines and intended for wines which do not have that origin, or identifying spirits and intended for spirits which do not have that origin.
- (2) Registration shall, however, be admissible in the cases of subsection 1 clauses 3, 4 and 5, if the sign has acquired a distinctive character in Austria in the circles concerned following the use which has been made of it prior to application.

#### Section 29a

- (1) Within a period of three months following the date of publication of the registration of a mark (Section 17 subsection 5), opposition to this registration may be raised. It shall only be based on a mark fulfilling the conditions of Section 30 subsection 1. The same applies for applications subject to their registration.
- (2) In case of registration of a mark under the Madrid Agreement concerning the international registration of marks, Federal Law Gazette No. 400/1973 and under the Protocol relating to the Madrid Agreement concerning the international registration of marks, Federal Law Gazette No. 32/1999, the publication in the gazette, issued by the International Bureau of the World Intellectual Property Organization, replaces the publication referred to in subsection 1. The opposition period starts on the first day of the month following the month the gazette has been issued, in which the publication of the international registration is contained.
- (3) The substantiated opposition must be received by the Patent Office at the last day of the time period at the latest. It shall be filed in writing and along with all attachments also in duplicate.
- (4) ...
- (5) ...
- (6) The opportunities to file a request for cancellation with the Cancellation Department remain unaffected.

#### Section 29b

- (1) Upon expiration of the opposition period the owner of the mark shall be informed about all oppositions timely received and be invited to submit a written reply within a reasonable period of time which may be extended upon justified reasons. Within this period, the trademark holder has the possibility to request the opponent/s to furnish proof of use of the trademark/s the opposition/s is/are based on according to section 29b subsection 3. If the owner of a contested mark does not file a written statement within the time limit, the relevant legal department shall, in accordance with the request, without any further proceedings order the total or partial invalidity of the mark, even if the opposition is based on an application not registered yet at the date the decision is taken. The provisions for the cancellation procedures in section 35 subsection 5 shall apply mutatis mutandis unless otherwise indicated hereinafter.
- (2) ...
- (3) If opposition is based on a mark which, at the date of the registration of the mark opposed, has been registered more than 5 years ago, the opposition shall only be granted if, following a request by the owner of the mark opposed, satisfactory evidence is provided within a reasonable period of time that the conditions for cancellation of Section 33a (no genuine use) do not apply. If within the period of 2 months following the transmittal of the documents presented to furnish evidence of genuine use the owner of the mark files a request for cancellation based on Section 33a with the competent authorities directed at the mark of the opponent and, within a reasonable period of time, furnishes evidence about this fact the opposition procedure shall be adjourned and resumed ex officio or upon request after the decision in the cancellation procedure has become final.
- (4) ...
- (5) ...
- (6) As far as a mark has been finally declared invalid, or, as far as, following ex officio legal examination (Section 20), protection of an international registration has been refused finally, or, as far as a mark has been cancelled based on a final decision concerning a request to the Cancellation Department with retroactive effect to the beginning of the period of protection, a pending opposition to the mark shall be deemed settled to the respective extent and the parties shall be informed about this fact. The opposition procedure shall be closed in the same manner if during the pendency of the opposition procedure the procedure to register the application, the opposition is based on, is closed without leading to registration, or, if the mark, opposition is based on, finally loses protection in Austria.
- (7) Costs of the opposition procedure shall be borne by each party on its own.

#### Section 30 subsection 1

- (1) The owner of an earlier mark being still valid may request the cancellation of a mark provided that either
- 1. the two marks and the goods and services the marks are registered for are identical,
  - or
  - 2. the two marks and the goods and services the marks are registered for are identical or similar so that there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the earlier mark.



Section 61 subsections 1 and 4

(1) Anyone acting as representative before the Patent Office or the Supreme Patent and Trademark Senate shall have his domicile or principal place of business in Austria; in regard to attorneys at law, patent attorneys and notaries public though the respective professional regulations shall apply. The representative shall demonstrate his authorisation by a written power of attorney which shall be presented in original version or by way of a duly certified copy. If several individuals are authorised collectively, each of them shall also be authorised to represent individually.

(4) A person having neither domicile nor principal place of business in Austria may claim rights under this Federal Act before the Patent Office only when being represented by a representative fulfilling the requirements of subsection 1. Before the Cancellations-Department of the Patent Office such persons may only claim rights when being represented by an attorney at law, a patent attorney or a notary public. If domicile or principal place of business are within the EEA or in the Swiss Confederation the appointment of a person domiciled in Austria and authorized to receive communications will suffice to claim rights under this Federal Act.