

IR 762/2018/W1-1

MADRID AGREEMENT AND PROTOCOL
MADRIDER ABKOMMEN UND PROTOKOLL

PROVISIONAL REFUSAL OF PROTECTION Rule 17 (1)

VORLÄUFIGE SCHUTZVERWEIGERUNG Regel 17 (1)

I.	Authority pronouncing the refusal: Austrian Patent Office Dresdner Straße 87 A – 1200 Vienna (Austria)	Behörde, die die Schutzverweigerung erlassen hat: Österreichisches Patentamt Dresdner Straße 87 A – 1200 Wien (Österreich)
II.	Number of the international registration: Nr. der internationalen Registrierung: 1 420 001 Number of the basic registration / application and country of origin: Nr. der Basisregistrierung / -anmeldung und Ursprungsland: 81984 Kazakhstan	
III.	☒ Provisional refusal based on opposition(s) Vorläufige Schutzverweigerung wegen eines(mehrerer) Widerspruchs(-sprüche)	
IV.	☒ Provisional refusal for all the goods and/or services Vorläufige Schutzverweigerung für alle Waren und/oder Dienstleistungen	
V.	Grounds for refusal Gründe der vorläufigen Schutzverweigerung ☒ Opposition(s) by opponent(s): see VI. Eingelangte Widersprüche: siehe VI.	
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 UM/ 10732733/ AIWA/16.3.2012/ 2) Type / Registration number / Mark / Filing date /Filing number / Priority date Art / Registernummer /Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum UM/ 254326/ aiwa /6.5.1996/ 3) Type / Registration number / Mark / Filing date /Filing number / Priority date Art / Registernummer /Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum AT/144181/ aiwa /14.11.1991/ 4) Type / Registration number / Mark / Filing date /Filing number / Priority date Art / Registernummer /Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum AT/ 60687/ AIWA / 18.7.1967/ Name and address of the owner(s): Name und Adresse des(der) Inhaber(s): AIWA CO, Ltd. 1-6-3, Higashi-gotanda, Shinagawa-ku, Tokyo 1410022 Japan Name and address of the representative: Name und Adresse des Vertreters: Sonn&Partner Riemergasse 14 1010 Wien Referenzzeichen: E 3599	

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

- 1) **Class 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; Magnetic data carriers, recording discs; mechanisms for coin-operated apparatus; Cash registers, calculating machines, data processing equipment and computers; Fire-extinguishing apparatus; Electronic machines, apparatus and their parts, namely audio and/or video electronic apparatus, electronic communication apparatus; computer program for downloading, managing processing and playing audio, motion pictures, text and still image data; downloadable music, audio, video and image; downloadable computer software for wireless transmission and synchronization of audio, video, text, multimedia, movie, and music files and streams to and between a computer, computer-enabled television, other computer-enabled audio and video display device, cell phone, mobile computer, or other mobile device; downloadable video game software; computer software; computers; computer peripheral devices; handheld computers; tablet computers; personal digital assistants; computer terminals; portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, audio and video files; portable and handheld digital electronic devices for displaying electronically published materials, namely, books, journals, newspapers, magazines, multimedia presentations; portable and handheld digital electronic devices for data processing, information processing, storing and displaying data, transmitting and receiving data, transmission of data between computers, global positioning system (GPS) devices and telephones; wired and wireless remote controls for portable and handheld digital electronic devices; telephones; mobile phones; smartphones; home audio and video players and/or recorders; portable and personal audio and video players and/or recorders; MP3 and other digital format audio and video players and/or recorders; cameras; video cameras; televisions; portable televisions; electronic circuits, magnetic discs, optical discs, magnetic optical discs, CD-ROMs (Compact Disc ROMs), magnetic tapes and Digital Versatile Disc ROMs encoded with video game programs for personal use; electronic circuits, magnetic discs, optical discs, magnetic optical discs, CD-ROMs (Compact Disc ROMs), magnetic tapes and Digital Versatile Disc ROMs encoded with video game programs for business use; controllers, joysticks, memory cards, volume controllers, mouse for video game machines with television for personal use; magnetic discs, optical discs, magnetic optical discs, CD-ROMs (Compact Disc ROMs), magnetic tapes and Digital Versatile Disc ROMs encoded with magazines, books, newspapers, maps, pictures, images and literal information; apparatus and instruments for scientific research in laboratories; measuring apparatus by standard measuring units; measuring apparatus by derived measuring units; precision measuring machines and instrument; material testing machines and instruments; surveying machines and instruments; astronomic measuring machines and instruments; thermo sensitive plastic film sheets for temperature indication; power distribution and/or control apparatus; rotary, converters; phase modifiers; dry cells; wet cells; accumulators and batteries; photovoltaic cells; electric or magnetic meters and testers; electric wires; electric cables; telescopes; microscopes; eyeglasses and goggles; parts and accessories for eyeglasses and goggles; life nets; lifebelts; lifejackets; life-buoys; electron microscopes; electronic desk calculators; word processors; X-ray tubes (not for medical use); photo-sensitive tubes; vacuum tubes; rectifier tubes; cathode ray tubes; discharge tubes; thermistors; diodes; transistors; electron tubes; semi-conductor elements (semi-conductor devices); integrated circuits; large scale integrated circuits; electric hair-curlers for household use; electric buzzers for household use; exposed cinematographic films; exposed slide films; slide film mounts; pre-recorded video discs and tapes; glasses (eyewear) and sunglasses; fire extinguishers.
- 2) **Class 9:** Scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
- 3) **Kl.9:** Wissenschaftliche, Schiffs-, Vermessungs-, elektrische, photographische, Film-, optische, Wäge-, Mess-, Signal-, Kontroll-, Rettungs- und Unterrichtsapparate und -instrumente; Geräte zur Aufzeichnung, Übertragung und Wiedergabe von Ton und Bild; Magnetaufzeichnungsträger, Schallplatten; Verkaufsautomaten und Mechaniken für geldbetätigte Apparate; Registrierkassen, Rechenmaschinen, Datenverarbeitungsgeräte und Computer; Feuerlöschgeräte;
Kl.11: Beleuchtungs-, Heizungs-, Dampferzeugungs-, Koch-, Kühl-, Trocken-, Lüftungs- und Wasserleitungsgeräte sowie sanitäre Anlagen;
- 4) **Kl.9:** physikalische, chemische, optische und elektrotechnische Geräte, Vermessungs-, Schiffs-, Wäge-, Signal-, Meß- und Überwachungsgeräte, photographische, Film- und Rundfunkgeräte, Lautsprecher, Sprechmaschinen, Rechenmaschinen, Schreib- und Zählkassen, Mikrophone, Plattenspieler, Tonbandgeräte, Fernsehgeräte, Tonabnehmerköpfe, Fernsehaufzeichnungs- und Wiedergabegeräte, Rundfunkaufnahme- und Wiedergabegeräte, Teile und Zubehör dieser Waren und andere elektrische Geräte und Instrumente und deren Teile und Zubehör;

☐ see annexes (extract from register or opposition form)
siehe Annex(e) (Auszug aus dem Register oder Widerspruchsformular)

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: 19/04/2019 (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). (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. (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. (v) Authority to address the reply: see I. Behörde, an die die Äußerung zu richten ist: siehe I.	
IX. Date of provisional refusal Datum der vorläufigen Schutzverweigerung 19/12/2018	Number of Annexes: Zahl der Anhänge:
X. Signature or official seal of the Office Unterschrift oder Amtsstempel der Behörde Rechtskundiges Mitglied Susanna Kernthaler	
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: http://www.patentamt.at http://www.wipo.int/ipdl/en/madrid http://oami.europa.eu/CTMOnline/RequestManager/de_SearchBasic	

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.