



Ministero dello Sviluppo Economico

DIREZIONE GENERALE PER LA LOTTA ALLA CONTRAFFAZIONE
Ufficio Italiano Brevetti e Marchi

**MADRID AGREEMENT AND PROTOCOL
PROVISIONAL REFUSAL OF PROTECTION
Rule 17(1)**

I. Office making the notification:

MINISTERO DELLO SVILUPPO ECONOMICO

Direzione Generale per la Lotta alla Contraffazione - Ufficio Italiano Brevetti e Marchi

Via Molise, 19 - 00187 ROMA

e-mail : dglcuibm.div02@pec.mise.gov.it

II. Number of the international registration: **1 400 991**

Trademark:



III. Name of the holder: **OCTOVISIO GMBH**

Kurfuerstendamm 224 10719 Berlin (DE)

IV. Information concerning the type of provisional refusal:

- ☐ Provisional refusal based on an *ex officio* examination
- ☒ Provisional refusal based on an opposition (**opposition n°652018000047091**)
- ☐ Provisional refusal based on both an *ex officio* examination and an opposition

V. Information concerning the scope of the provisional refusal:

- ☒ Provisional refusal for **all** the goods and/or services
- ☐ Provisional refusal for some of the goods/services:

VI. Grounds for refusal : Identity or similarity between the marks and identity or similarity between the goods/services.

VII. Opponent rights:

1) Registration number: 000262931 (EUTM)

i) Filing date: **06/05/1996**

ii) Registration date: **28/04/2004**

iii) Name and address of the opponent: **DECATHLON**

Service Juridique PI 4, boulevard de Mons

F-59650 Villeneuve d'Ascq FRANCE

iv) Reproduction of the mark: **DECATHLON**

v) List of some of the goods/services:

18 Leather and imitations of leather, articles of leather or imitation leather (except for cases adapted to the products they are designed to hold, gloves and belts), animal skins, trunks and suitcases, umbrellas, parasols and canes, whips and saddlery, harnesses, rucksacks and alpine walking sticks, camping, beach, travel, school and food bags, travelling sets, animal collars, animal vests, muzzles, saddles, whips, saddle attachments, horse covers, saddle covers, headstalls for horses, feeding bags, harnesses, knee bandages for horses, walking stick seats, school satchels, wallets, game bags, clothing covers (travel), purses, wallets, key holders (leather), straps for skates, slings for carrying children, wheeled shopping bags.

24 Textiles and textile goods, bed and table covers, adhesive fabrics for application by heat, upholstery fabrics, bath linen (except clothing), billiard cloths, oilcloth (table cloths), sleeping bags (sheeting), tissues of textile for removing make-up, mosquito nets, labels of cloth, canvas for tapestry or embroidery, flags, blinds of textile.

25 Clothing, sports clothing except diving suits, shoes (except orthopaedic shoes), headgear, swimming trunks, caps, dressing gowns, sweaters, socks, football boots, beach shoes, ski boots, sports shoes, shirts, water ski suits, underwear, babies' napkins of textile, cyclists' clothing, soles for footwear, gloves, studs for football boots, non-slipping devices for shoes, tips for footwear, suspenders, belts, ties.

26 Lace and embroidery, ribbons and braid, buttons, hooks and eyes, pins and needles, artificial flowers, small pins, fastenings for clothing, ornamental badges, hair bands and nets, hair pins, hair-slides, hair, false hair, fancy goods, zippers, shoe laces, buttons, snap fasteners.

28 Games and playthings, gymnastic and sporting articles (except clothing, mats and shoes) except those relating to decathlon events and except discuses for sports, javelins, shots and discuses for throwing and poles; Decorations for Christmas trees, building blocks (playthings), hang gliders, paragliders, kites, artificial fishing bait, fishing rods, reels for fishing rods, landing nets for anglers, harpoon guns (sporting articles), hooks, fishing line, decoys for hunting or fishing, items for shooting, targets, clay pigeon traps, clay pigeons, fencing weapons, foils, fencing masks, discuses for sport, darts, base-ball gloves, boxing gloves, protective clothing (sports articles), machines for physical exercise and appliances for gymnastics, exercisers (expanders), exercise bicycles, exercise benches, abdominal exercising equipment, trampolines, running tracks, oars, billiard cues, billiard tables, billiard balls, golf clubs, golf balls, guts and cords for rackets, tennis rackets, badminton rackets, squash rackets, skis, ski bindings, water skis, dumb-bells, skittles, swimming webs, ice skates, roller skates, skateboards, sailboards, surfboards, masts, booms, table football, table tennis tables, tennis nets, table tennis bats, table tennis balls, slides, shuttlecocks (games), conjuring apparatus, model vehicles, toy masks, toys for pets, swings, Christmas crackers, toy masks.

35 Advertising except that relating to decathlon events; business management except that relating to decathlon events; business administration except that relating to decathlon events; office functions; newspaper subscription services for others; business management, business administration, business information; import-export agencies, commercial information agencies, cost price analysis, employment agencies; publicity columns preparation except that relating to decathlon events, shop window dressing, demonstration of goods, marketing studies, organisation of exhibitions for commercial or advertising purposes, computerized file management, rental of advertising space, marketing research, opinion polling, television advertising except that relating to decathlon events, public relations except those relating to decathlon events, document reproduction.

36 Insurance, financial affairs, monetary affairs, real estate affairs, accident insurance, factoring, banking services, credit card services, currency exchange, issuing of travellers' cheques, charitable fund raising, real estate management, apartment house management, organisation of lotteries.

38 Telecommunications, news and information agencies, press agencies, communications by computer terminals, broadcasting of television programmes, radio and television programmes (except programmes dedicated to decathlon competitions); electronic mail and

data communication services.

41 Education, training, entertainment, sporting and cultural activities, publication of books and magazines, lending libraries, animal training, production of shows and films, agencies for actors, rental of films, phonographic recordings, cinema projection apparatus and theatre scenery, organisation of competitions for educational or training purposes; arranging and conducting of colloquiums, conferences and congresses, organization of exhibitions for cultural or educational purposes; (none of the aforesaid services relating to decathlon events).

42 Providing of food and drink, temporary accommodation, medical, hygienic and beauty care, veterinary and agricultural services, legal services, scientific and industrial research, computer programming, detective agencies, night guards, dating agencies, marriage bureaux, chemical analyses, animal breeding, pet grooming, catering, architecture, copyright management, Turkish baths, videotape recordings, cocktail lounge services, beauty salons, providing of patents, providing of cafes, restaurants, cafeterias, holiday camp services (accommodation); canteens, chiropractors, dating services, hairdressing salons, computer consultancy, evening dress rental, child care facilities, providing campsite facilities, underwater exploration, horoscopes, gardening, licensing of intellectual property, rental of buildings, software development, massages, medical services.

VIII. Corresponding essential provisions of the applicable law (see text under XII): Art.12 1), c) and d) of the Italian Industrial Property Rights Code.

IX. Information relating to subsequent procedure:

(i) Time limit for requesting review or appeal:

The holder of the registration may, through a representative appointed according to article 201, request copy of the opposition notice within a period of three months from the date on which he received the notification of this provisional refusal by the International Bureau of WIPO. Furthermore, copy of the notification received by WIPO must be attached to the abovementioned request to the Italian Patent and Trademark Office.

(ii) Authority to which such request for review or appeal should be made:

The holder of the registration may, through a representative appointed according to article 201, submit his objections to the present refusal to *Ufficio Italiano Brevetti e Marchi - Divisione II Affari Giuridici e Normativi - Via Molise, 19 - 00187 ROMA - ITALY*.

(iii) Indications concerning the appointment of a representative:

Where the applicant is not established or domiciled in a Member State of the European Union or in the European Economic Area, he may submit his objections through a registered agent in the roll kept for this purpose by the Italian Patent and Trademark Office (see: www.ordine-brevetti.it) or a lawyer registered in the appropriate professional role (see: www.ordineavvocati.it) – (art. 201-203 Code of Industrial Property Rights).

X. Date of the notification of provisional refusal

Prot. N.:

Ministero dello Sviluppo Economico

AOO_Politiche industriali e Tutela

Struttura: **DGLCUIBM_Div08**

REGISTRO UFFICIALE

Prot. n. 0079075 - 09/04/2019 - USCITA

XI. Signature or official seal of the Office making the notification



[Handwritten signature]

XII. Corresponding essential provisions of the applicable law:

Extract from the Code of Industrial Property Rights

(Legislative Decree of February 10th 2005, n.30)

Art. 17 - International Registration

1. For the registration of trademarks with the World Intellectual Property Organization (WIPO), the provisions in force pursuant to international conventions shall remain valid.
2. International trademarks registered with the World Intellectual Property Organization (WIPO) of Geneva, based on the Madrid Agreement concerning the International Registration of Marks, Stockholm text of 14 July 1967, ratified by law no.424 of 28 April 1976, and the respective Protocol, adopted in Madrid on 27 June 1989, ratified by law no.169 of 12 March 1996, containing the designation of Italy as the country in which protection is requested, must meet the requirements set for national trademarks by this Code.
3. The Italian Patent and Trademark Office carries out the examination of the international trademarks that designate Italy in compliance with the applicable provisions of the applications for national trademarks.

Art. 7 - Subject Matter of Registration

1. A trademark consist of any sign which capable of being represented graphically, and in particular words, including personal names, designs, letters, numerals, sounds, the shape of a goods or of their packaging, the color combinations or tones, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertaking.

Art. 8 - Portraits of person, names and well known signs

1. Portraits of person shall not be registered as trademarks without the persons' consent, and after their death, without the consent of the spouse and children; if there are no such relatives or after their death, of the parents and other ancestors, and if there are no such ancestors or after their death, of the relatives up and including the fourth degree.
2. The names of persons other than those who apply for registration may be registered as trademarks, provided that their use is not such as to harm the reputation, creditworthiness or dignity of those who have the right to bear those names. The Italian Patents and Trademarks Office shall however have the right to make the registration conditional upon the consent as set forth in paragraph 1. In any event, the registration shall not prevent persons having the right to the name to use in the business chosen by them, if the requirements are met as set forth in Article 21(1).
3. If well known, the following may be registered or used as trademarks only by the qualified person, or with the consent of the same, or of the persons indicated in paragraph 1: names of persons, signs used in the fields of art, literature, science, politics or sports, the designations and abbreviations of events and those of entities and associations without economic purposes, as well as the characteristic emblems of the same.

Art. 9 - Shape trademarks

1. Signs shall not be registered as trademarks if they consist solely of the shape dictated by the nature of the product, the shape of the product necessary to obtain a technical result, or of the shape that gives substantial value to the product.

Art. 10 - Coats of arms

1. Coats of arms and other signs considered in existing international conventions on the subject matter, in the cases and the conditions mentioned therein, as well as the signs containing symbols, emblems and coats of arms which are in the public interest shall not be registered as trademarks, unless the consent of the appropriate authorities to their registration has been given.
2. If a trademark contains words, figures or signs with political meaning or a highly symbolic value, or containing heraldic elements, before registration, the Italian Patents and Trademarks Office shall send the copy of the trademarks and whatever else may be necessary to the relevant or appropriate public agencies, to receive their opinion, in accordance with the provisions of paragraph 4.
3. The Italian Patents and Trademarks Office may act in accordance with provisions of paragraph 2 in all cases where there is a doubt that trademark could be contrary to the law, the public policy or accepted principles of morality.
4. If the relevant or appropriate agency, as per paragraphs 2 and 3, expresses an opinion against the registration of the trademark, the Italian Patents and Trademarks Office shall reject the application.

Art.12 - Novelty

1. Signs shall not be registered as trademarks if as of the date of filing of the application any of the following applies:
 - a) (omissis);
 - b) (omissis);
 - c) They are identical to a trademark already registered by others in the Country or having effect in the Country following an application filed on an earlier date or having effect from an earlier date due to a right of a priority or a valid claim of seniority for identical goods or services;
 - d) They are identical or similar to a trademark that has already registered by others in the Country or having effect

in the Country following an application filed on an earlier date or having effect as from an earlier date due to a right of priority or a valid claim of seniority for goods and services that are identical or similar, if due to the identity or similarity between the signs and the identity or similarity between the goods or services there exists a likelihood of confusion on the part of the public, than can also consist of a likelihood of association between the two signs; [...]
e);f); 2. 3. (omissis)

Art. 13 – Distinctive character

1. Signs lacking a distinctive character shall not be registered as trademarks. These include:

- a) those consisting only of signs that have become commonly used in current language or in the common practices of the trade;
- b) those consisting of general designations of goods or services or descriptive indications that refer to them, such as signs that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the good or of the rendering of the service or other characteristics of the good or service.

2. Notwithstanding paragraph 1, signs that have acquired a distinctive character prior to application for registration, due to the use that has been made of them, may be registered as trademarks.

3. (omissis)

4. (omissis)

Art. 14 – Lawfulness and third-party rights

1. The following shall not be registered as trademarks:

a) signs that are contrary to the law, public policy or accepted principles of public morality;

b) signs that can mislead the public, in particular as to the geographical origin, nature or quality of the goods or services.

c) (omissis)

Art. 135 – Board of Appeal

1. An appeal may be filed with the Board of Appeal against decisions of the Italian Patent and Trademark Office that totally or partially reject an application or request, refuse registration or prevent the recognition of a right, and in the other cases provided for by this Code, within the mandatory term of 60 days from the date of receipt of the notification of the decision.

(omissis)

Art. 170 – Examination of applications

1. The examination of applications which have been found to meet the formal requirements, is aimed at determining:

- a) for trademarks: if Article 11 may be applied when collective marks are involved; if the word, design or sign can be registered as a trademark pursuant to Articles 7, 8, 9, 10, 13, paragraph 1 and 14, paragraph 1, letters a) and b); if the conditions indicated in Article 3 are met.

b) (omissis)

Art. 171 – Examination of the International trademarks

1. (omissis)

2. If the Italian Patent and Trademark Office deems that the trademark shall not be registered in full or in part, or if an opposition has been filed by third parties pursuant to Article 176, the Office shall proceed pursuant to Article 5 of the Madrid Agreement for the International Registration of Marks, Stockholm text of 14 July 1967, ratified by Law no. 424 of 28 April 1976 or the respective Protocol of 27 June 1989, ratified by Law No. 169 of 12 March 1996, to issue a provisional refusal of the international registration and gives notice to the World Intellectual Property Organization.

3. The provisional refusal under paragraph 2 is issued within one year for international registrations based on the Madrid Agreement for the International Registration of Marks, and within eighteen months for those based on the respective Protocol. The terms start on the dates respectively indicated in the cited International Conventions.

4. In the case of provisional refusal, the protection of the trademark shall be that of a trademark application filed with the Italian Patent and Trademark Office.

5. Within the mandatory term set out by the Italian Patent and Trademark Office, the owner of an international registration, for which a provisional refusal has been communicated to the World Intellectual Property Organization, through an attorney appointed in accordance with Article 201, may submit his own arguments, or request a copy of the opposition paper based on which the provisional refusal was issued. In the latter case, if the owner of the international registration requests a copy within the required period, the Office shall send the notice to the parties as Article 178, paragraph 1, and apply the other rules on the opposition proceeding set forth by Articles 178 et seq.

6. If within the term indicated in paragraph 5, the owner of the international registration does not submit his arguments, or does not request a copy of the opposition paper in accordance with the rules indicated above, the Italian Patent and Trademark Office shall issue the final refusal.

7. The Italian Patent and Trademark Office shall notify the World Intellectual Property Organization of the final decisions relating to international trademarks designating Italy.

Art. 201 – Representation

1.2.3.(omissis)

4. The appointment may be granted only to attorneys registered in a specific Register established for that purpose at the Board of the Industrial Property Consultants Institute.

5. (omissis)

6. The appointment may also be granted to a lawyer admitted to the Bar.