

IR 133/2019/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</b>  <b>Dresdner Straße 87</b>  <b>A – 1200 Vienna (Austria)</b></p>	<p>Behörde, die die Schutzverweigerung erlassen hat:  <b>Österreichisches Patentamt</b>  <b>Dresdner Straße 87</b>  <b>A – 1200 Wien (Österreich)</b></p>
<p>II. Number of the international registration:  <b>Mi Cloud</b>          Nr. der internationalen Registrierung: 1 433 787</p> <p>Number of the basic registration / application and country of origin:          Nr. der Basisregistrierung / -anmeldung und Ursprungsland: 28028402 China</p>	
<p>III. <input checked="" type="checkbox"/> Provisional refusal based on opposition(s)          Vorläufige Schutzverweigerung wegen eines(mehrerer) Widerspruchs(-sprüche)</p> <p><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><input type="checkbox"/> Provisional refusal for some of the goods and/or services:          Vorläufige Schutzverweigerung für die folgenden Waren und/oder Dienstleistungen:</p> <p><input type="checkbox"/> Admission only for the following goods and/or services:          Zulassung nur für folgende Waren und/oder Dienstleistungen:</p>	
<p>V. Grounds for refusal          Gründe der vorläufigen Schutzverweigerung</p> <p><input type="checkbox"/> Absolute grounds</p> <p><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)</p> <p>A)</p> <p>Type / Registration number / Mark / Filing date / Filing number / Priority date          Art / Registernummer / Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum</p> <p>EUTM 011571866/ ICLOUD/13.02.2013</p> <p>Name and address of the owner(s):          Name und Adresse des(der) Inhaber(s):          Apple Inc.          One Apple Park Way          US-95014 Cupertino</p> <p>Name and address of the representative in this opposition procedure:          Name und Adresse des Vertreters im gegenständlichen Widerspruchverfahren:</p>	

KWR Karasek Wietrzyk Rechtsanwälte GmbH  
Fleischmarkt 1  
A - 1010 Wien

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

**cl. 9:** Computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; computer software, namely, operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; pre-recorded computer programs for personal information management, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device and a fixed or remote station or device.

**cl. 35 :** Computerized database and file management; data processing services; computerized data storage and retrieval services; computerized data storage and retrieval services for text, data, image, audio, video, and multimedia content; creating indexes of information, sites and other resources available on global computer networks and other electronic and communications networks for others; searching, browsing and retrieving information, sites, and other resources available on global computer networks and other electronic and communications networks for others; organizing content of information provided over a global computer network and other electronic and communications networks according to user preferences; providing an online searchable database of text, data, image, audio, video, and multimedia content in the fields of computer hardware, computer software, consumer electronics, telecommunications and multimedia goods, mobile phones, handheld digital electronic devices, and other consumer electronics and accessories, peripherals, and carrying cases for such products.

**cl. 39:** Physical storage of electronically stored data, text, images, audio and video; physical storage services for archiving electronic data.

**cl. 42:** Application service provider (ASP) services featuring software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; providing search engines for obtaining data on a global computer network.

B)

**Type / Registration number / Mark / Filing date / Filing number / Priority date**  
**Art / Registernummer / Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum**

EUTM 014067755/ ICLOUD/31.05.2011/

**Name and address of the owner(s):**  
**Name und Adresse des(der) Inhaber(s):**  
Apple Inc.  
One Apple Park Way  
US-95014 Cupertino

**Name and address of the representative in this opposition procedure:**  
**Name und Adresse des Vertreters im gegenständlichen Widerspruchsverfahren:**

KWR Karasek Wietrzyk Rechtsanwälte GmbH  
Fleischmarkt 1  
A - 1010 Wien

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

**cl.9:** Accessories, parts, fittings, and testing apparatus for all of the following goods: Computer hardware; microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers, disk drives, adapters, adapter cards, connectors and drivers; blank computer storage media; magnetic data carriers; computer software; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; computer software and firmware, namely, operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; computer hardware and software for providing integrated telephone communication with computerized global information networks; pre-recorded computer programs for personal information management, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device and a fixed or remote station or device; downloadable electronic publications in the nature of books, plays, pamphlets, brochures, newsletters, journals, magazines, and periodicals on a wide range of topics of general interest; handheld digital electronic devices and software related thereto; MP3 and other digital format audio players; hand held computers, tablet computers, personal digital assistants, electronic organizers, electronic notepads; mobile digital electronic devices, global positioning system (GPS) devices, telephones; handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, and other digital data; cordless telephones; mobile telephones; parts and accessories for mobile telephones; facsimile machines, answering machines, cameras, videophones, telephone-based information retrieval software and hardware; electronic handheld units for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; electronic communication equipment and instruments; telecommunications apparatus and instruments; fonts, typefaces, type designs and symbols in the form of recorded data; chips, discs and tapes bearing or for recording computer programs and software; random access memory, read only memory; solid state memory apparatus; computer and electronic games; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; apparatus for data storage; hard drives; miniature hard disk drive storage units; audio video discs, CD-ROMs, and digital versatile discs; mouse pads; batteries; rechargeable batteries; chargers; chargers for electric batteries; headphones; stereo headphones; in-car headphones; stereo speakers; audio speakers; audio speakers for home; monitor speakers; speakers for computers; personal stereo speaker apparatus; radio receivers, amplifiers, sound recording and reproducing apparatus, electric phonographs, record players, high fidelity stereo apparatus, tape recorders and reproducing apparatus, loudspeakers, multiple speaker units, microphones; digital audio and video devices; audio cassette recorders and players, video cassette recorders and players, compact disc players, digital versatile disc recorders and players, digital audio tape recorders and players; digital music and/or video players; radios; video cameras; audio, video, and digital mixers; radio transmitters; car audio apparatus; computer equipment for use with all of the aforesaid goods; electronic apparatus with multimedia functions for use with all of the aforesaid goods; electronic apparatus with interactive functions for use with all of the aforesaid goods Parts and fittings for all the aforesaid goods Covers, bags and cases adapted or shaped to contain all of the aforesaid goods, made of leather, imitations of leather, cloth, or textile materials.

**cl.35:** Advertising agency services; advertising, marketing, and promotion services; advertising and marketing consultation; sales promotion services; promoting the goods and services of others; conducting market research; analysis of advertising response and market research; preparation, production, and dissemination of advertisements and advertising material for others; media planning services; administration of consumer loyalty programs; arranging and conducting incentive rewards programs to promote the sale of goods and services; business services, namely, dissemination of advertising for others via computer networks and global communication networks; compilations of directories for publishing on the Internet and other electronic, computer and communications networks; retail store and online retail store services in the fields of computer hardware, computer software, consumer electronics, telecommunications and multimedia goods, mobile phones, handheld digital electronic devices, and other consumer electronics and accessories, peripherals, and carrying cases for such products; retail store services provided via the Internet and other computer, electronic and communications networks in the field of computer hardware, computer software, consumer electronics, telecommunications and multimedia goods and accessories, mobile phones, handheld digital electronic devices, and other consumer electronics and accessories, peripherals, and carrying cases for such products; retail store services in the field of books, magazines, periodicals, newsletters, journals and other publications on a wide range of topics of general interest, provided via the Internet and other computer, electronic and communications networks; retail store services in the field of entertainment featuring movies, television programs, sporting events, musical works, and audio and audiovisual works, via the Internet and other computer, electronic and communications networks; retail store services featuring computer, electronic and entertainment products, telecommunications apparatus, mobile phones, handheld mobile digital electronic devices, and other consumer electronics, computer software, and accessories, peripherals, and carrying cases for such products, via the Internet and other computer, electronic and communications networks; product demonstrations provided in-store and via global communications networks and other electronic and communications networks; information, advisory and consultancy services relating to all the aforesaid.

**cl.37:** Repair and installation services; maintenance, installation and repair of computer hardware, computer peripherals and consumer electronic devices; consulting services in the field of maintenance of computer hardware, computer peripherals, and consumer electronic devices.

**cl.38:** Providing user access to the Internet (service providers).

**cl.41:** Providing an online searchable database of text, data, image, audio, video, and multimedia content in the field of entertainment featuring music, video, film, books, periodicals, television, games and sports; information, advisory and consultancy services relating to all the aforesaid.

C)

Type / Registration number / Mark / Filing date / Filing number / Priority date  
Art / Registernummer / Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum

EUTM 013002928/ ICLOUD/13.02.2013/

Name and address of the owner(s):

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

Apple Inc.  
One Apple Park Way  
US-95014 Cupertino

Name and address of the representative in this opposition procedure:

Name und Adresse des Vertreters im gegenständlichen Widerspruchsverfahren:

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

**cl.9:** Mouse pads; batteries; rechargeable batteries; chargers; chargers for electric batteries; headphones; stereo headphones; in-ear headphones; stereo speakers; audio speakers; audio speakers for home; monitor speakers; speakers for computers; personal stereo speaker apparatus; loudspeakers, multiple speaker units, microphones; covers, bags and cases adapted or shaped to contain all of the aforesaid goods, made of leather, imitations of leather, cloth, or textile materials.

**cl.35:** Advertising agency services; advertising, marketing, and promotion services; advertising and marketing consultation; sales promotion services; promoting the goods and services of others; conducting market research; analysis of advertising response and market research; preparation, production, and dissemination of advertisements and advertising material for others; media planning services; administration of consumer loyalty programs; arranging and conducting incentive rewards programs to promote the sale of goods and services; retail store and online retail store services in the fields of computer hardware, computer software, consumer electronics, telecommunications and multimedia goods, mobile phones, handheld digital electronic devices, and other consumer electronics and accessories, peripherals, and carrying cases for such products; retail store services provided via the Internet and other computer, electronic and communications networks in the field of computer hardware, computer software, consumer electronics, telecommunications and multimedia goods and accessories, mobile phones, handheld digital electronic devices, and other consumer electronics and accessories, peripherals, and carrying cases for such products; retail store services in the field of books, magazines, periodicals, newsletters, journals and other publications on a wide range of topics of general interest, provided via the Internet and other computer, electronic and communications networks; retail store services in the field of entertainment featuring movies, television programs, sporting events, musical works, and audio and audiovisual works, via the Internet and other computer, electronic and communications networks; retail store services featuring computer, electronic and entertainment products, telecommunications apparatus, mobile phones, handheld mobile digital electronic devices, and other consumer electronics, computer software, and accessories, peripherals, and carrying cases for such products, via the Internet and other computer, electronic and communications networks; product demonstrations provided in-store and via global communications networks and other electronic and communications networks.

**cl.37:** Repair and installation services; maintenance, installation and repair of computer hardware, computer peripherals and consumer electronic devices; consulting services in the field of maintenance of computer hardware, computer peripherals, and consumer electronic devices.

**cl.42:** Design and creation of advertisements and advertising material for others.

D)

Type / Registration number / Mark / Filing date / Filing number / Priority date  
Art / Registernummer / Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum

EUTM 014597736/ ICLOUD/25.09.2015/

Name and address of the owner(s):  
Name und Adresse des(der) Inhaber(s):  
Apple Inc.  
One Apple Park Way  
US-95014 Cupertino

Name and address of the representative in this opposition procedure:  
Name und Adresse des Vertreters im gegenständlichen Widerspruchsverfahren:

**cl.9:** Computers, computer peripheral devices, computer terminals; computer hardware; microprocessors, memory boards, monitors, displays, keyboards, cables, modems, printers, disk drives, adapters, adapter cards, connectors and drivers; blank computer storage media; magnetic data carriers; computer software; computer software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; computer software and firmware, namely, operating system programs, data synchronization programs, and application development tool programs for personal and handheld computers; computer hardware and software for providing integrated telephone communication with computerized global information networks; pre-recorded computer programs for personal information management, database management software, character recognition software, telephony management software, electronic mail and messaging software, paging software, mobile telephone software; database synchronization software, computer programs for accessing, browsing and searching online databases, computer software for the redirection of messages, Internet e-mail, and/or other data to one or more electronic handheld devices from a data store on or associated with a personal computer or a server; computer software for the synchronization of data between a remote station or device and a fixed or remote station or device; downloadable electronic publications in the nature of books, plays, pamphlets, brochures, newsletters, journals, magazines, and periodicals on a wide range of topics of general interest; handheld digital electronic devices for data processing, information processing, storing and displaying data, transmitting and receiving data, transmission of data between computers and software related thereto; MP3 and other digital format audio players; hand held computers, tablet computers, personal digital assistants, electronic organizers, electronic notepads; mobile digital electronic devices, global positioning system (GPS) devices, telephones; handheld and mobile digital electronic devices for the sending and receiving of telephone calls, faxes, electronic mail, and other digital data; cordless telephones; mobile telephones; parts and accessories for mobile telephones; facsimile machines, answering machines, cameras, videophones, telephone-based information retrieval software and hardware; electronic handheld units for the wireless receipt, storage and/or transmission of data and messages, and electronic devices that enable the user to keep track of or manage personal information; electronic communication equipment and instruments; telecommunications apparatus and instruments; fonts, typefaces, type designs and symbols in the form of recorded data; chips, discs and tapes bearing or for recording computer programs and software; random access memory, read only memory; solid state memory apparatus; computer games; user manuals in electronically readable, machine readable or computer readable form for use with, and sold as a unit with, all the aforementioned goods; apparatus for data storage; hard drives; miniature hard disk drive storage units; audio video discs, CD-ROMs, and digital versatile discs; computer equipment for use with all of the aforesaid goods; electronic communications apparatus with multimedia functions for use with the aforesaid goods; electronic communications apparatus with interactive functions for use with the aforesaid goods; accessories, parts, fittings, and testing apparatus for all of the aforesaid goods; parts and fittings for all the aforesaid goods.

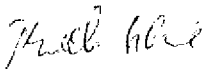
**cl.38:** Telecommunications; communication and telecommunication services; telecommunication access services; communications by computer; communication between computers; electronic sending of data and documentation via the Internet or other databases; supply of data and news by electronic transmission; providing telecommunication access to websites and electronic news services online allowing the download of information and data; providing telecommunication access to web sites on the Internet; delivery of digital music by telecommunications; providing wireless telecommunications via electronic communications networks; wireless digital messaging, paging services, and electronic mail services, including services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; communication by computer, computer intercommunication; telex, telegram and telephone services; broadcasting or transmission of radio and television programs; time sharing services for communication apparatus; provision of telecommunications access and links to computer databases and the Internet; electronic transmission of streamed and downloadable audio and video files via computer and other communications networks; webcasting services (transmission); delivery of messages by electronic transmission; provision of connectivity services and access to electronic communications networks, for transmission or reception of audio, video or multimedia content; provision of telecommunications connections to electronic communication networks, for transmission or reception of audio, video or multimedia content; providing telecommunication access to digital music web sites on the Internet; providing telecommunication access to MP3 web sites on the Internet; delivery of digital music by

telecommunications; provision of telecommunications connections to the Internet or computer databases; electronic mail services; telecommunication of information (including web pages); video broadcasting, broadcasting pre-recorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via a global computer network; streaming of video content via a global computer network; subscription audio broadcasting via a global computer network; audio broadcasting; audio broadcasting of spoken word, music, concerts, and radio programs, broadcasting pre-recorded videos featuring music and entertainment, television programs, motion pictures, news, sports, games, cultural events, and entertainment-related programs of all kinds, via computer and other communications networks; streaming of audio content via a global computer network; electronic transmission of audio and video files via communications networks; communication services, namely, matching users for the transfer of music, video and audio recordings via communication networks; providing on-line bulletin boards for the transmission of messages among computer users concerning entertainment, music, concerts, videos, radio, television, film, news, sports, games and cultural events; rental and hire of communication apparatus and electronic mail-boxes; electronic communications consultancy; facsimile, message collection and transmission services; transmission of data and of information by electronic means, computer, cable, radio, teleprinter, teletext, electronic mail, telecopier, television, microwave, laser beam, communications satellite or electronic communication means; transmission of data by audio-visual apparatus controlled by data processing apparatus or computers; information, advisory and consultancy services relating to all the aforesaid; provision of telecommunication access time to web-sites featuring multimedia materials; providing telecommunication access to databases and directories via communications networks for obtaining data in the fields of music, video, film, books, television, games and sports; providing users with telecommunication access time to electronic communications networks with means of identifying, locating, grouping, distributing, and managing data and links to third-party computer servers, computer processors and computer users; providing user access to the Internet (service providers); providing temporary internet access to use on-line non-downloadable software to enable users to program audio, video, text and other multimedia content, including music, concerts, videos, radio, television, news, sports, games, cultural events, and entertainment-related programs.

**cl.42:** Application service provider (ASP) services featuring computer software; application service provider (ASP) services featuring software for authoring, downloading, transmitting, receiving, editing, extracting, encoding, decoding, displaying, storing and organizing text, graphics, images, and electronic publications; scientific and technological services and research and design relating thereto; design and development of computer hardware and software; computer hardware and software consulting services; rental of computer hardware and software apparatus and equipment; multimedia and audio-visual software consulting services; computer programming; support and consultation services for developing computer systems, databases and applications; information relating to computer hardware or software provided on-line from a global computer network or the Internet; creating and maintaining web-sites; hosting the web-sites of others; providing search engines for obtaining data via communications networks; application service provider (ASP) services featuring software for use in connection with online music subscription service, software that enables users to play and program music and entertainment-related audio, video, text and multimedia content, and software featuring musical sound recordings, entertainment-related audio, video, text and multimedia content; providing search engines for obtaining data on a global computer network; information, advisory and consultancy services relating to all the aforesaid; operating search engines; computer consulting and support services for scanning information into computer discs.

**cl.45:** Online social networking services; providing a social networking website.

☐ 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) <b>Section 29a and the following § 29a ff</b>	
VIII.	Information relating to subsequent procedure / Information über das weitere Verfahren Reply/response to the provisional refusal / Äußerung auf die Schutzverweigerung <ul style="list-style-type: none"> <li>(i) Time limit for reply / Äußerungsfrist: <b>24/09/2019</b></li> <li>(ii) Representative - see XI. "Provisions of the applicable law" (Section 61 Subsections 1 and 4 Trade Mark Act). Vertreterregelung - siehe XI. „Provisions of the applicable law“ (§ 61 Abs. 1 und 4 MSchG).</li> <li>(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.</li> <li>(iv) In case the trademark holder does not file within the time limit set out in (i) a written statement, which fulfils 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 trade mark holder has to submit one written statement responding to each opposition raised, otherwise the opposition, to which the trade mark 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 trade mark also has the opportunity to request the opponent/s to furnish proof of use of the trade mark/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.         </li> <li>(v) Authority to address the reply: see I. Behörde, an die die Äußerung zu richten ist: siehe I.</li> </ul>	
IX.	Date of provisional refusal Datum der vorläufigen Schutzverweigerung 24/05/2019	Number of Annexes: Zahl der Anhänge:
X.	Signature or official seal of the Office Unterschrift oder Amtsstempel der Behörde Rechtskundiges Mitglied      Silvie Frösch 	
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)  Section1 A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of their packaging, or sounds, provided that such signs are capable of	



- 1) distinguishing the goods or services of one undertaking from those of other undertakings; and
- 2) being represented on the trademark register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

#### 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 and their registration is capable of conveying the impression of an existing connection to that organization or of misleading the public in regard to the existence of such a connection. 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 or any other characteristic which results from the nature of the goods themselves, or 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. pursuant to Union legislation or national law including international agreements to which Austria is party, providing for protection of designations of origin and geographical indications, are excluded from registration;
10. pursuant to Union legislation or national law including international agreements to which Austria is party, providing for protection of traditional terms for wine, are excluded from registration;
11. pursuant to Union legislation or national law including international agreements to which Austria is party, providing for protection of traditional specialties, are excluded from registration;
12. consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or national law including international agreements to which Austria is party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species.

(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 or 2, a well-known trademark according to Article 6bis of the Paris Convention or a designation of origin or geographical indication in accordance with section 32a.

(1a) Opposition may be based on one or more prior rights as described in Subsection (1), provided that they all belong to the same holder or applicant. If the opposition is based on a Union trademark section 30 subsection 4 shall apply mutatis mutandis. If the opposition is based on a well-known trademark, this trademark has to be well known according to Article 6bis of the Paris Convention at the time of filing or priority. Opposition may be based on some or all of the goods and services of the earlier right and may be directed against some or all the goods and services of the contested trademark.

(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 filing or priority 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 revocation of Section 33a (no genuine use) do not apply at the day of filing or priority of the earlier trademark. Documents provided to furnish evidence of genuine use of the trademark shall be transmitted to the holder of the contested trademark to allow for any comments. 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 revocation based on or equivalent

to 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. For the purpose of the opposition procedure, the trademark of the opponent shall be deemed to be valid only in respect of that goods and goods and services of the trademark where there has been genuine use.

(3a) Until the end of the time limit to respond by filing a written statement according to subsection 1 or of the time limit to respond according to subsection 3 upon joint request of the Parties and without further need for substantiation a time limit up to a maximum of 6 months starting with the day the request has been received by the Office to allow for amicable settlement shall be granted. Open time limits according to subsections 1 and 3, notwithstanding further options to extend them based on reasons deemed to be considerable, shall end at the same time as the limit allowing for amicable settlement.

(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 or designation of origin or geographical indication, 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 filed mark 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

(1) Anyone acting as representative before the Patent Office shall have his domicile or principal place of business in the European Economic Area (EEA) or in the Swiss Confederation; 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.

(2) ....

(3) ....

(4) A person having neither domicile nor principal place of business in the European Economic Area (EEA) or in the Swiss Confederation 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 Cancellation Department such persons may only claim rights when being represented by an attorney at law, a patent attorney or a notary public. [...].