



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: **1 410 495**

Trademark:  **NTELCRAFT**

III. Name of the holder: **LLC IntelKraft Oborudovanie**

ulitsa Sadovaya-Triumfalnaya,

dom 4/10, pomeshenie II

RU-127006 gorod Moskva (RU)

IV. Information concerning the type of provisional refusal:

- ☐ Provisional refusal based on an *ex officio* examination
- ☒ Provisional refusal based on an opposition (**opposition n°652018000050783**)
- ☐ 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: 12512381 (EUTM)

i) Filing date: **17/01/2014**

ii) Registration date: **29/05/2014**

iii) Name and address of the opponent: **Intel Corporation**

2200 Mission College Boulevard

Santa Clara, California 95052-8119 USA

iv) Reproduction of the mark:

intel

v) List of some of the goods/services:

6 Building and construction materials and elements of metal; Containers, and transportation and packaging articles, of metal; Doors, gates, windows and window coverings of metal; Metal hardware; Statues and works of art of common metals; Structures and transportable buildings of metal; Unprocessed and semi-processed materials of metal, not specified for use; Pipes, tubes and hoses, and fittings therefor, including valves; Railway materials; Packaging, wrapping and bundling articles; Towel dispensers, fixed, of metal; Cables, wires and chains; Locks and keys; Nuts, bolts and fasteners; Welding and soldering materials; Aluminium moulds; Casements of metal; Metal casters; Metal foundry products; Steel castings [semi-finished]; Metal moulds for forming cement products; Signs, and information and advertising displays; Vaults and safes; Work platforms [scaffold towers] of metal; Access platforms [scaffolding] of metal; Framework scaffolding of metal; Metal ladders; Metal scaffolding for facades; Mobile aerial work platforms [scaffolding] of metal; Scaffolding apparatus (Metal -).

7 Agricultural, earthmoving, construction, oil and gas extraction and mining equipment; Dispensing machines; Engines, powertrains, and generic machine parts; Generators of electricity; Machines and machine tools for treatment of materials and for manufacturing; Moving and handling equipment; Pumps, compressors and fans; Robots; Sweeping, cleaning, washing and laundering machines; Agricultural, gardening and forestry equipment; Construction equipment; Spraying machines; Vending machines; Coating machines; Cutting, drilling, abrading, sharpening and surface treatment equipment; Fastening and joining tools and equipment; Filtering machines, separators and centrifuges; Food and beverage processing and preparation equipment; Material production and processing machines; Mills and crushing machines; Printing and bookbinding machines; Shaping and moulding machines; Textile and leather sewing equipment; Waste management and recycling machines; Power drills and bores; Power saws; Welding and soldering equipment; Metal production machines; Paper production machines; Textile production machines; Conveyors and conveyors belts; Lifting and hoisting equipment, elevators and escalators; Opening and closing mechanisms; Packaging machines; Exterior clearing and cleaning equipment; Ironing machines and laundry presses; Robots with articulated arms for manipulating workpieces; Industrial robots; Transportation robots.

9 Apparatus, instruments and cables for electricity; Devices for treatment using electricity; Diving equipment; Information technology and audiovisual equipment; Magnets, magnetizers and demagnetizers; Measuring, detecting and monitoring instruments, indicators and controllers; Navigation, guidance, tracking, targeting and map making devices; Optical devices, enhancers and correctors; Recorded content; Safety, security, protection and signalling devices; Scientific research and laboratory apparatus, educational apparatus and simulators; Apparatus and instruments for accumulating and storing electricity; Apparatus and instruments for controlling electricity; Electric and electronic components; Photovoltaics; Antennas and aerials as components; Electrical circuits and circuit boards; Radio-frequency components; Cable boxes (Electric -); Cable connectors; Cable covers [conduits]; Conduit for electric cables; Connection cables; Electricity conduits; Fuse wire; Analogue circuits; Audio circuit boards; Chipcards; Circuits [electric or electronic]; Control circuits; Controller circuit boards; Electrical circuit boards; Electrical circuits; Electrical control circuits; Electronic circuit boards; Electronic circuits; Electronic control circuits; Electronic logic circuits; Flexible circuit boards; Focusing circuits; Hard disk controllers; Hybrid circuits; Hybrid integrated circuits; Integrated circuit chips; Integrated circuit memory cards for use in playing electronic musical instruments; Integrated circuit modules; Integrated circuits; Integrated electronic circuits; Microchip cards; Microchips; Wafers for integrated circuits; Thick film hybrid

integrated circuits; Thick film hybrid circuits; Thermosonic bonding apparatus; Telecommunications circuit board units; Software programmable microprocessors; Smart cards [integrated circuit cards]; Silicon chips [electronic components]; Silicon chips; Signal processors for audio speakers; Semiconductor chips; Programmable logic arrays; Printed electronic circuits; Printed electrical circuits; Printed circuit expansion boards; Printed circuit board contact probes; Multichip modules; Microcontrollers; Electronic components; Electronic ballasts for operating discharge lamps; Electronic miniature relays; Electronic semi-conductors; Electronic touch sensitive switches; Electrotechnical components; Fibre optic panels; Microelectronic components; Power connectors; Radar connectors; Semiconductors; Semiconductor wafers; Semiconductor elements; Semiconductor apparatus; Diodes; Audio/visual and photographic devices; Communications equipment; Data processing equipment and accessories (electrical and mechanical); Data storage devices; Replicating apparatus; Signal cables for IT, AV and telecommunication; Audio devices and radio receivers; Display devices, television receivers and film and video devices; Image capturing and developing devices; 3D spectacles; Audiovisual apparatus; Cameras; Antennas and aerials as communications apparatus; Broadcasting equipment; Computer networking and data communications equipment; Point-to-point communications equipment; Apparatus for the transmission of data; Cable modems; Communication modems; Computer hardware for telecommunications; Computer network hubs; Computer networking hardware; Computer networks; Data communications apparatus; Data communications hardware; Ethernet controllers; LAN [local operating network] hardware; Local area networks; Mobile data apparatus; Network access server hardware; Network servers; Telephone modems; VPN [virtual private network] hardware; WAN [wide area network] hardware; Wide area networks; Wireless computer peripherals; Wireless local area network devices; Mobile phones; Digital phones; Intercommunication apparatus; Internet phones; Keyboards for mobile phones; Leather cases for mobile phones; Local mobile telephone systems; Point-to-point receivers; Satellite telephones; Smartphones; Solar powered telephones; Speakerphones; Wireless telephony apparatus; Video telephones; Video conferencing apparatus; Tri-band telephones; Telephones; Telephones incorporating intercommunication systems; Computers and computer hardware; Calculators; Payment terminals, money dispensing and sorting devices; Peripherals adapted for use with computers; Ticket dispensers; Computer components and parts; Add-on-cards for computers; Central processing units; Components for computers; Computer chips; Computer circuit boards; Computer controllers; Computer graphics boards; Computer memory devices; Computer memory hardware; Computer modules; Computer network adapters; Computer housings; Computer interface boards; Computer buses; Computer card adapter; Computer accelerator board; Computer buffers; Central processing unit boards; Cases adapted for computers; Card reading equipment; Card readers for credit cards; Cabinets adapted to hold computers; Video graphics controller; Video cards; Video graphics accelerator; Touch pads [electronic]; System boards (mother cards); Sound cards; Solid-state memories; Smart card readers; Semi-conductor memory units; RAM [random access memory] card; PC boards; Optical memories; Multiprocessor chips; Multimedia accelerator boards; Motherboards; Modems; Microprocessors; Microprocessor cores; Microprocessor controls; Microprocessor cards; Memory storage devices; Memory modules; Memory expansion modules; Memory expansion cards; Memory devices; Memory cards; Memory boards; Memory apparatus; Memories for data processing equipment; Math coprocessor; Magnetic hard discs; Magnetic hard disc drives; Logic circuits; Magnetic disk drives; Internal modems; Internal cooling fans for computers; Interface cards for data processing equipment in the form of printed circuits; Integrated circuit memories; Heat sinks; Hard disk drives; Hard discs; Graphics cards; Floppy disk drives; Flash memory card; Flash card readers; Flash card adapters; Electronic memory units; Electronic memory integrated circuit chips; Electronic memory circuits; Electronic card readers; Disk drives for computers; Data bus interface units; Data buffers; Computer sub-assemblies; Computer serial ports; Computer parallel ports; Computers; Computer hardware; Laptop computers; Personal computers; Computer

carrying cases; Computer database servers; Computer docking station; Computer hardware for use in computer-assisted software engineering; Computer mainframes; Computer servers; Computer systems; Computer terminals for banking purposes; Digital tablets; Electronic mail servers; File servers; Electronic notebooks; Graphics tablets; Handheld personal computers; Interactive computer systems; Internet servers; Intranet servers; Microcomputer apparatus; On-board computers; Personal computers incorporating dietary aid computer software; Coin-operated mechanisms; Keyboard terminals; Joy sticks; Interactive terminals; Information display terminals; Input devices for computers; Graphic terminals; Graphic display terminals; Filter screens for computer screens; Dust covers for computers; Electronic mail terminals; Data protection backup units; Covers (Shaped -) for computers; Computing visual display units; Computer whiteboards; Computer terminals; Computer telephony equipment; Computer swivelling stands; Computer stylus; Computer screens; Computer mice; Computer keyboards; Computer joysticks; Compact disc players for use with computers; Backup drives for computers; Arm rests for use with computers; Magnetic tape units for computers; Monitors; Monitors [computer hardware]; Mouse [computer peripheral]; Mouse mats; PC cards; Pens (Electronic -) [visual display units]; Screens; Speakers for computers; Trackballs [computer apparatus]; View data terminals; Trackballs; Wireless computer mice; Wrist rests for computer mouse users; Wrist rests for use with computers; Image scanners; Photocopiers; Printers; Controllers (regulators); Measuring, counting, alignment and calibrating instruments; Monitoring instruments; Sensors and detectors; Testing and quality control devices; Lasers; Optical enhancers; Opticians' goods; Corrective eyewear; Sunglasses; Databases (electronic); Media content; Software; Computer databases; Computer operating systems; Games software; Application software; Network access server operating software; Computer operating system software; Communications processing computer software; Computer operating programs, recorded; Operating and user instructions stored in digital form for computers and computer software, in particular on floppy disks or CD-ROM; Operating computer software for main frame computers; Computer software adapted for use in the operation of computers; Access control devices; Alarms and warning equipment; Protective and safety equipment; Signalling apparatus; Eye protection; Head protection.

35 Advertising, marketing and promotional services; Business analysis, research and information services; Business assistance, management and administrative services; Commercial trading and consumer information services; Advertising, marketing and promotional consultancy, advisory and assistance services; Distribution of advertising, marketing and promotional material; Loyalty, incentive and bonus program services; Product demonstrations and product display services; Provision of advertising space, time and media; Public relations services; Trade show and exhibition services; Collection and systematization of business data; Market research; Accountancy, book keeping and auditing; Administrative data processing; Business consultancy and advisory services; Clerical services; Human resources management and recruitment services; Rental of office machines; Auctioneering services; Department store retail services connected with the sale of beauty products, toiletries, machines for household use, hand tools, optical goods, domestic electrical and electronic equipment; Retail or wholesale services for pharmaceutical, veterinary and sanitary preparations and medical supplies; Retail services connected with the sale of furniture; Retail store services in the field of clothing.

37 Building, construction and demolition; Extermination, disinfection and pest control; Mining, and oil and gas extraction; Rental of tools, plant and equipment for construction and demolition; Shipbuilding; Alarm, lock and safe installation, maintenance and repair; Building maintenance and repair; Cleaning and care of fabric, textile, leather, fur and goods made thereof; Clock and watch repair; Computer hardware and telecommunication apparatus installation, maintenance and repair; Furniture maintenance and repair; Glazing, installation, maintenance and repair of glass, windows and blinds; HVAC (Heating, ventilation and air conditioning) installation, maintenance and

repair; Lift and elevator installation, maintenance and repair; Plumbing installation, maintenance and repair; Re-inking and refilling of toner cartridges; Rental of cleaning and washing machines and equipment; Tyre maintenance and repair; Vehicle service, repair, maintenance and refuelling.

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 Indu

X. Date of the notification of provisional refusal

Prot. N.:

Ministero dello Sviluppo Economico

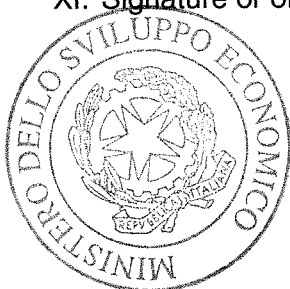
AOO Politiche industriali e Tutela

Struttura: **DGLCUIBM_Div08**

REGISTRO UFFICIALE

Prot. n. **0172577 - 02/07/2019 - USCITA**

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



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.