



World Intellectual Property
Organisation (WIPO)
International Bureau
34, Chemin des Colombettes
1211 Geneva 20
Switzerland

Your Reference:
International Registration No:
WO0000001459845
Examiner: Judith Davies
Direct Telephone: +44(0)1633811043
Date: 17 July 2019

Intl Reg No: WO0000001459845
Mark: sama GLAS (Figurative)
Holder: GUANGDONG SHANGMING
INDUSTRIAL CO., LTD.
Class(es): 21

**Notification Of A Provisional Total Refusal Of Protection Based On An
Opposition By The United Kingdom Intellectual Property Office In
Accordance With Article 5 Of The Madrid Protocol**

I am writing to inform you that following receipt of an opposition to the above trade mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the TM7 'Notice of Opposition', which includes details of any marks referred to in the statement of case, which was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

If the holder of the International Registration wishes to file a counterstatement, they must complete the form TM8 'Notice of defence and counterstatement', which is available at ipo.gov.uk/tmforms and **return it to this office** within **two months** of the date of this letter, that is, on or before **17 September 2019**. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a TM8 will result in the provisional refusal being upheld.

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the TM8 can be extended for a further seven months by the filing the form TM9c 'Request for a cooling off period, which is available at ipo.gov.uk/tmforms

The TM8 should be received on or before the date requested above unless a cooling off period is entered into by the parties.

The holder of the International Registration must provide us with an address for correspondence in the United Kingdom, another EEA state or the Channel

Islands on a form TM33 'Appointment or change of agent or contact address', which is available at ipo.gov.uk/tmforms within this two month period.

If one is not provided within this time the refusal will be made final.

Judith Davies

Trade Marks Registry

[Skip to main content](#)

Intellectual Property Office

Trade mark number

WO0000000545507

Status

Protected

Overview

Trade mark

sahm

Dates

Date of protection of the international registration in UK

09 March 2007

Renewal date

17 November 2019

International registration date

17 November 1989

Designation date

10 March 2006

Office of origin

Germany

Goods and services

Classes and terms

Class 21

Utility and decorative objects made of earthenware, ceramic, porcelain, glass and tin for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses.

Class 34

Ashtrays.

Class 40

Services for perfecting glassware, porcelain and earthenware, especially engraving, cutting, etching, printing, inscribing, painting.

Class 42

Silkscreen printing.

Names and addresses

Holder's name

SAHM GMBH & Co KG

13, Westerwaldstrasse, 56203 HÖHR-GRENZHAUSEN, Germany

WIPO representative name

SCHIEDERMAIR RECHTSANWÄLTE Partnerschaftsgesellschaft

Escherscheimer Landstraße 60, 60322 Frankfurt am Main, Germany

Publications

First advert

Journal

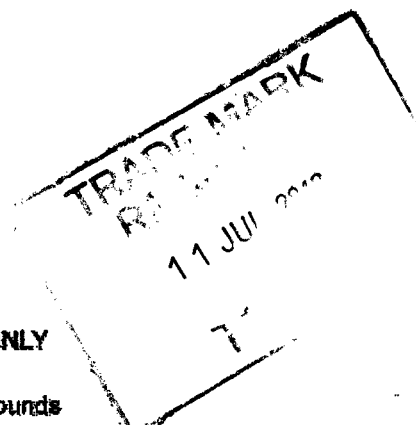
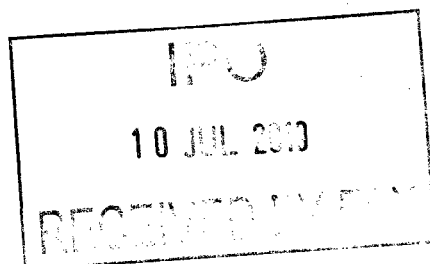
6662

Date of publication

08 December 2006

The information displayed is our version of the details supplied by WIPO. For the official register of the case please refer to the [WIPO website](#).

Intellectual Property Office is an operating name of the Patent Office

J849761/ 0001 D03312 TM07.....
.11JUL19 100.00 ACCOUNT OP000416922**Intellectual
Property
Office****Form TM7****Notice of opposition and statement of grounds**Fee ☒ £100 Opposition based on Section 5(1) and/or 5(2) ONLY☐ £200 Opposition based on, or including, any other grounds*Note: if you wish to oppose under Section 5(1) and/or 5(2) and one or more other grounds, the fee will be £200***Use this form to notify of an opposition to a trade mark application or international registration, and to set out the grounds on which you are basing this opposition.****Do not use this form if you wish to file a Fast Track opposition under Section 5(1) and/or 5(2); use Form TM7F.**

1. Trade mark number Number of the trade mark you are opposing. If the opposition concerns an international registration, help us identify the correct trade mark by adding "IR"	IR1459845	
2. Full name of applicant/holder Whose trade mark you are opposing	GUANGDONG SHANGMING INDUSTRIAL CO., LTD.	
3. Full name of opponent	SAHM GMBH & Co KG	
Address If the address is not within the United Kingdom, European Economic Area (EEA – which includes the European Union) or the Channel Islands you must have a representative in one of these regions and complete section 4 below	13, Westenwaldstrasse	
	56203 HÖHR-GRENZHAUSEN	
	Germany	
	Postcode	
NOTE: It will no longer be possible for two (or more) parties to jointly oppose a trade mark based on earlier marks/rights that they each own, unless the parties jointly own the relevant earlier marks/rights. Separate oppositions will now be required. See section 30(2A) of the Act.		
Email address Complete if you have no representative and would like us to correspond with you by email		
4. Representative name If you have no representative, go to section 5.	Marks & Clerk LLP	
Address The address provided in this section must be in the UK, European Economic Area (EEA) or the Channel Islands.	15, Fetter Lane	
	London	
	Postcode EC4A 1BW	
NOTE: We will communicate with the representative if this section has been completed.		
Email address Complete if you would like us to correspond with you by email	london@marks-clerk.com	

5. Related proceedings If applicable, select location of any related proceedings and enter the case number allocated to the proceedings.	<input type="checkbox"/> IPO Registry	<input type="checkbox"/> UK Courts	<input type="checkbox"/> EUIPO
	Number		

6. Opposition notification date If you have informed the applicant/holder of an intention to oppose the trade mark application, designation – enter the date you notified them. [**See Note]	28.06.2019
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****Note:** An opposition launched without giving the applicant or holder a reasonable opportunity to withdraw the application, international designation or amendment may result in the opponent being ineligible for an award of costs.

7. Declaration	I believe that the facts stated in this form and the attached statement of grounds are true.
Signature	Marks & Clerk LLP
Name (BLOCK CAPITALS)	MARKS & CLERK LLP
Date	10.07.2019

8. Your reference Complete if you would like us to quote this in communications with you, otherwise leave blank.	XN834278GB
Contact details Name, daytime telephone number of the person to contact in case of query.	Mr Michael Barrett 020 7420 0000
Number of sheets attached to this form	4

Checklist

Please make sure you have remembered to:

Sign and date the form

Complete fee sheet (Form FS2)

Enclose the fee and fee sheet. Make cheques payable to Intellectual Property Office

Where to send

Intellectual Property Office
Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Please tick on what grounds you are opposing the trade mark and continue to the relevant section(s)



Opposition is based on Sections 5(1) or 5(2): The trade mark is either identical or similar to an earlier trade mark and is to be registered for identical and/or similar goods and services.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark.

> COMPLETE SECTION A



Opposition is based on Section 5(3): The trade mark is either identical or similar to an earlier trade mark which has a reputation. Using the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION B



Opposition is based on Section 5(4)(a): Where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier right. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION C



Opposition is based on Section 3: The trade mark is excluded from registration because it describes the goods/services, or is not distinctive, or consists of signs that are customary within the trade, or the application was made in bad faith.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION D



Opposition is based on other grounds.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION E

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

<input type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number
Your trade mark

IR545507

Type of mark
Please tick

☐ UK

☐ EUTM



International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.

sahm

Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?

<input type="checkbox"/>	All goods and services
<input checked="" type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

Class 21: Utility and decorative objects made of earthenware, ceramic, porcelain, glass and tin for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses.

Class 40: Services for perfecting glassware, porcelain and earthenware, especially engraving, cutting, etching, printing, inscribing, painting.

Q2. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the application date (or priority date, if applicable) of the application or international registration you wish to oppose?

☒ Yes

☐ No > GO TO Q4

Q3. Has the trade mark been used in the 5-year period ending on the date of application (or priority date, if applicable) of the opposed mark?

☒ Yes

☐ No > GO TO Q3b

Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?

<input type="checkbox"/>	All goods and services
<input checked="" type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

Class 21:
Utility and decorative objects made of glass for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses.

Class 40:
Services for perfecting glassware

> GO TO Q4.

TM7

Q3b. Please state any proper reasons for non-use.

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DETAILS OF THE TRADE MARK YOU ARE OPPOSING

Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1?

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.

<p>Please refer to paragraphs 4 to 13 of the Statement of Grounds enclosed.</p>

SECTION B: Opposition is based on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending trade mark, that is identical with or similar to an earlier mark which has a reputation.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number
Your trade mark

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Type of mark
Please tick

<input type="checkbox"/>	UK	<input type="checkbox"/>	EUTM	<input type="checkbox"/>	International
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Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.

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Q1. For which goods or services covered by your earlier trade mark does it have a reputation?

<input type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

Q2. For which goods or services in the application (you are opposing) would use of the applicant's mark take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark?

<input type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

Q3. Is it claimed that the similarity between the reputed earlier trade mark and the later trade mark is such that the relevant public will believe that they are used by the same undertaking or think that there is an economic connection between the users of the trade marks?

☐ Yes

☐ No

Use this space to supply any further information

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QUESTIONS 4 TO 6 SHOULD BE ANSWERED IF THERE IS ANY OTHER BASIS FOR YOUR CLAIM OTHER THAN FOR YOUR ANSWER TO Q.3

Q4. Is there any other basis for your claim of unfair advantage? If so, please explain what the advantage would be to the holder of the later mark, and why it is unfair.

Q5. Is there any other basis for your claim of detriment to the reputation of the earlier mark? If so, please explain what the detriment would be and how it would occur.

Q6. Is there any other basis for your claim of detriment to the distinctive character of the earlier mark? If so, please explain what the detriment would be and how it would affect the economic behaviour of the relevant public.

Q7. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the application date (or priority date, if applicable) of the application or International registration you wish to oppose?

☐ Yes

☐ No > GO TO Q10

Q8. Has the trade mark been used in the 5-year period ending on the date of application (or priority date, if applicable) of the opposed mark?

☐ Yes

☐ No > GO TO Q9b

Q9a. For which of the goods and services listed at Q1 is trade mark use being claimed?

<input type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

> GO TO Q10

Q9b. Please state any proper reasons for non-use.

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Q10. Use this space to give any further information to explain why you are opposing the application on this ground.

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SECTION C: Opposition is based on Section 5(4)(a) of the Trade Marks Act, where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER UNREGISTERED TRADE MARK

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.

Q1. When and where was the earlier right first used in the UK?

Date used:

Enter date of first use

Where used:

Enter name of city/region or specify
'throughout UK' if used nationally

Q2. On which goods or services has the earlier right been used for?

--

DETAILS OF THE TRADE MARK YOU ARE OPPOSING

Q3. For which goods or services (of the application that you are opposing) do you consider that use of the applicant's mark would amount to passing off?

	All goods and services
	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q4. Why would use of the applicant's trade mark be contrary to law, particularly the law of passing off?

--

SECTION D: Opposition is based on section 3 of the Trade Marks Act on the basis that the trade mark fails to satisfy certain requirements of a trade mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need

Please tick and complete the relevant section(s) that apply. (Use a continuation sheet if necessary)

☐

3(1)(a) It is a sign that does not does not satisfy the requirements of section 1(1) because:

☐

3(1)(b) It is a trade mark which is devoid of any distinctive character because:

☐

3(1)(c) It is a trade mark which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services because:

☐

3(1)(d) It is a trade mark which consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade because:

☐

3(6) It is a trade mark which should not be registered for some or all of the goods and services in the application as the application was made in bad faith:

☐

Other State any other part of section 3 you rely on and give your grounds:

State which of the applicant's goods or services you oppose under Section 3 grounds

☐

All goods and services

☐

Some goods and services *(please specify below, use a continuation sheet if necessary)*

SECTION E: Opposition is based on any other grounds

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Use this sheet if you are basing your opposition on any other grounds and tick the appropriate box.

Section 5(1),(2),(3)	If the opponent is claiming protection for an earlier trade mark under Section 5(1)(c) which is a well known trade mark as defined in Section 58(1). See ††Note below.
Section 5(4)(b)	An earlier right by virtue of the law of copyright or the law relating to industrial property rights.
Section 5(6)	Registered in the name of an agent or representative.
Rule 25(2)	Opposition to amendment after publication.
Rule 29	Regulations for collective or certification marks.
Rule 30(4)	Amendment of regulations for collective or certification marks.
Rule 32(3)	Alteration of registered mark.
Rule 53(2)	Removal of matter from the register.
Others	Others

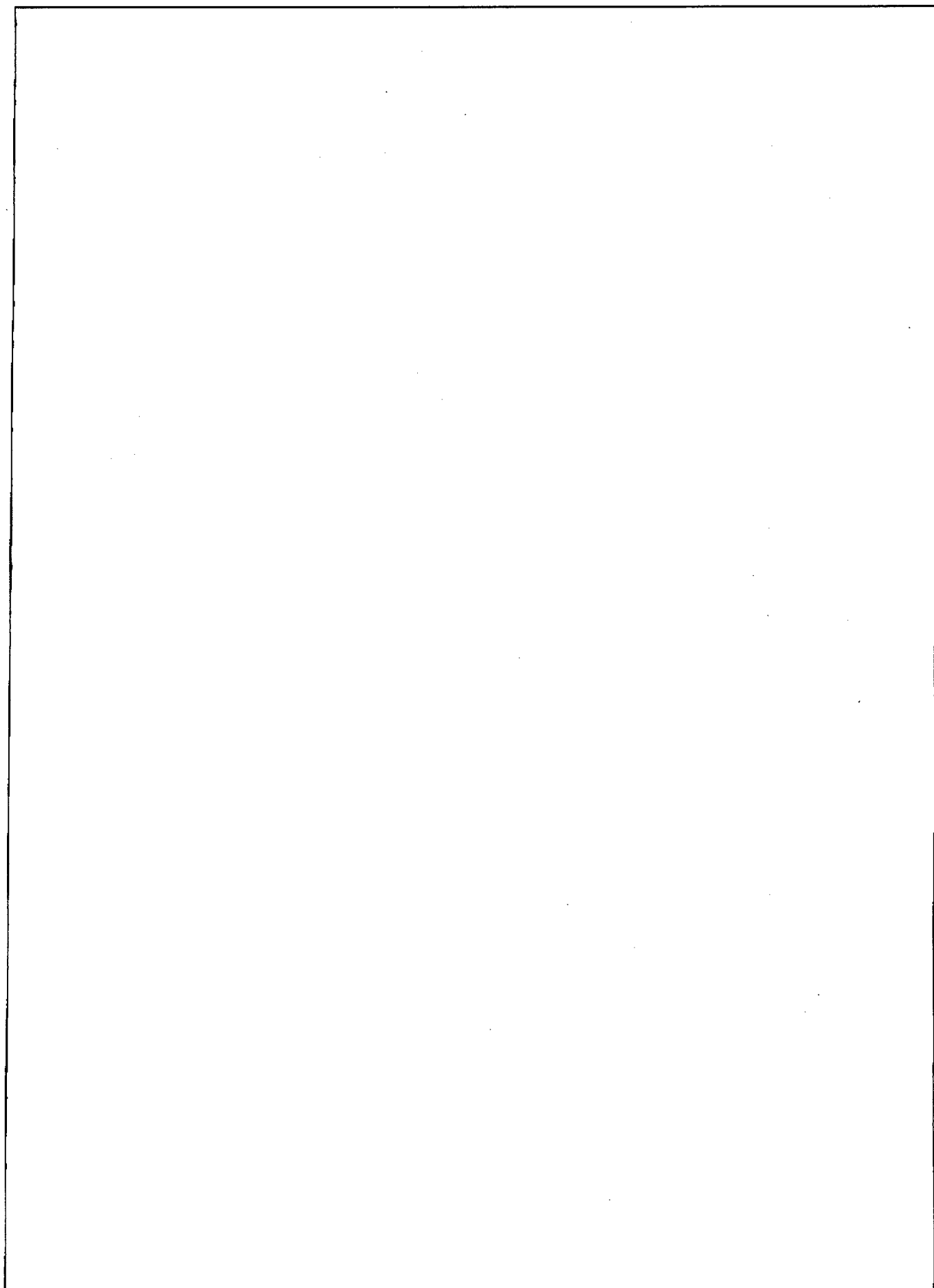
Others: †† For opposition on these grounds the following details should be supplied in the area below:

- Representation of the mark
- Details of any reference number and related jurisdiction if relevant
- Details of goods and services covered by the earlier mark
- Details of goods and services (in the application) which you consider to be similar/identical to those covered by the earlier mark.

Alternatively you may wish to adapt Section A and Section B of this form.

Give details (including details of any right relied upon) to support the application under these grounds.
(Use a continuation sheet if necessary)

[CONTINUED] Details to support your opposition under these grounds



The Trade Marks Act 1994 (as amended)

IN THE MATTER of the UK
Designation of International
Registration No.
WO0000001459845 SAMA GLAS
(stylised) in Class 21 in the name of
GUANGDONG SHANGMING
INDUSTRIAL CO., LTD.
(hereinafter referred to as "the
Applicant")

-and-

IN THE MATTER of an Opposition
thereto in the name of SAHM GMBH
& Co KG (hereinafter referred to as
"the Opponent")

Statement of Grounds

1. The Opponent is the registered proprietor of International Registration No.

sahm
WO0000000545507 designating the UK in classes 21, 34, 40 and 42 (the Opponent's Mark). Details of the Opponent's Mark and the goods relied upon for opposition purposes are set out hereunder:

Region	Registration No.	Mark	Goods
IR (UK)	WO0000000545507	sahm	<p><u>Class 21</u> <i>Utility and decorative objects made of earthenware, ceramic, porcelain, glass and tin for household and industrial use (for gastronomy), especially drinking vessels such as glasses, jugs, beer mugs, tankards, tumblers, beakers, goblets, tulip-shaped beer glasses, boot-shaped beer glasses, balloon-shaped glasses, small glasses.</i></p> <p><u>Class 40</u> <i>Services for perfecting glassware, porcelain and earthenware, especially engraving, cutting, etching, printing, inscribing, painting.</i></p>

2. On 15 November 2018 the Applicant sought to protect International Registration No.

sama
GLAS
WO0000001459845 (hereinafter "the Contested Application") in the UK for the following goods in class 21:

Class 21

Daily glassware [including cups, plates, pots, cylinders]; kitchen utensils; drinking vessels; daily porcelain [including pots, bowls, plates, pots, jars, cans]; daily pottery [including pots, bowls, plates, jars, pots, casseroles, pots, pottery utensils]; works of art of porcelain, ceramic, earthenware, terra-cotta or glass; enamelled glass, not for building; bottles; cleaning instruments, hand-operated; coffee percolators, non-electric

3. Protection under the Opponent's Mark was applied for in the UK on 10 March 2006. The Opponent's Mark therefore constitutes an earlier trade mark within the meaning of s.6(1)(a) of the Trade Mark Act 1994.

Section 5(2)(b) of the Trade Mark Act 1994

4. The marks to be compared are:

The Opponent's Mark	The Contested Application
sahm	sama GLAS

5. Visually the Contested Application coincides in the first two letters of the Opponent's Mark, "S" and "A" with the letter "M" appearing in the third and fourth positions of the respective signs. The Contested Application is broken into two words, with the first word "SAMA" being visually similar to the Opponent's Mark, the prefix differing in only one letter and being the same length.
6. Although phonetically "SAHM" and "SAMA GLAS" differ in length, generally consumers pay more attention to the beginning of signs, which is where the respective marks coincide. Taking into account the silent 'h' in the Opponent's Mark, the mark "SAHM" would be pronounced almost identically to the prefix "SAMA", with the exception of the letter "A" at the end of the word.
7. Conceptually, the Opponent's Mark has no meaning to the relevant consumer and is inherently distinctive for the goods and services for which it is registered. In the Contested Application, the prefix "SAMA" also has no meaning, whereas the suffix "GLAS" would create associations in the minds of the relevant consumer with "GLASS", a noun defined as "*a hard, transparent material, used to make windows, bottles, and other objects*" (Cambridge Dictionary, <https://dictionary.cambridge.org/dictionary/english/glass>). The suffix "GLAS" describes the goods claimed in the Contested Application and is therefore descriptive. The dominant and distinctive element is therefore the prefix "SAMA".
8. We accordingly submit that the relevant public will consider the Contested Application to be visually, phonetically and conceptually similar to the Opponent's Mark.
9. The Applicant has applied for goods in Class 21 that are identical and similar in nature, intended purpose, methods of use to the goods registered under the Opponent's Mark in Class 21 and the respective goods have the same end users and move through the same trade channels.
10. The Applicant has applied for goods in Class 21 that are similar to the services registered under the Opponent's Mark in Class 40, owing to their complementarity.
11. In view of the similarity between the respective trade marks and the identity and similarity between the respective goods in question, there exists a likelihood of confusion arising on the part of the relevant public. The likelihood of confusion includes a likelihood of association. Registration of the Applicant's mark would accordingly offend against the provisions of s. 5(2)(b) of the Trade Marks Act 1994.

12. The Opponent reserves the right to submit additional evidence and submissions in support of this opposition if the application is not withdrawn.
13. The Opponent seeks the total refusal of IR designation to the UK No. WO0000001459845 SAMA GLAS (stylised) in Class 21 in the name of GUANGDONG SHANGMING INDUSTRIAL CO., LTD.
14. The Opponent requests that an award of costs is made in its favour.

Dated this 10th Day of July 2019

Michael Barrett

.....
MARKS & CLERK LLP

Representative of the Opponent

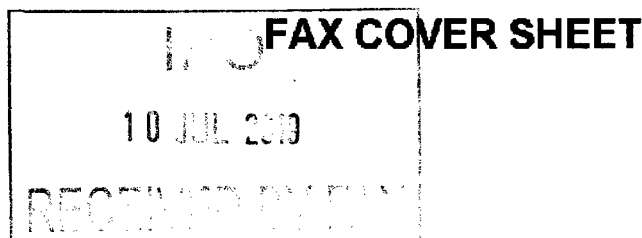
Mr Michael Barrett

Marks&Clerk LLP

Patent and Trade Mark Attorneys



Fax No:	01633 817777
To:	
Attn:	
From:	Anderson, Cheryl
Subject:	TM7 and Statement of Grounds - Opposition to UK Designation of International Trade Mark
Date:	10 July 2019 at 16:42
No. of pages:	23



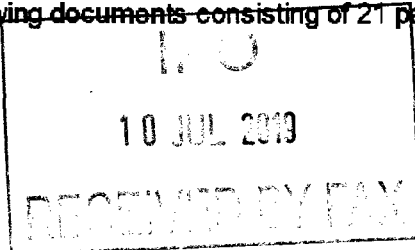
90 Long Acre, London, WC2E 9RA
Tel: +44 (0)20 7420 0000 Fax: +44 (0)20 7836 3339
Email: london@marks-clerk.com <http://www.marks-clerk.com>

Marks & Clerk LLP is a limited liability partnership and is registered in England and Wales with registered number OC343273. A list of members' names is open to inspection at our registered office, 90 Long Acre, London WC2E 9RA

Dear Sirs

Please find enclosed the following documents consisting of 21 pages in total:

- TM7
- Statement of Grounds
- Fee Sheet



Yours faithfully

Cheryl Anderson | Trade Mark Administrator
for **Marks & Clerk LLP**

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canderson@marks-clerk.com | 15 Fetter Lane, London EC4A 1BW, UK

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