

**MADRID AGREEMENT AND PROTOCOL
MADRIDER ABKOMMEN UND PROTOKOLL**

PROVISIONAL REFUSAL OF PROTECTION Rule 17 (1)
VORLÄUFIGE SCHUTZVERWEIGERUNG Regel 17 (1)

I.	Authority pronouncing the refusal: Austrian Patent Office Dresdner Straße 87 A – 1200 Vienna (Austria)	Behörde, die die Schutzverweigerung erlassen hat: Österreichisches Patentamt Dresdner Straße 87 A – 1200 Wien (Österreich)
II.	Number of the international registration: Nr. der internationalen Registrierung: 1 501 102 Number of the basic registration / application and country of origin: Nr. der Basisregistrierung / -anmeldung und Ursprungsland: BAZ1720408 Bosnia and Herzegovina	
III.	☒ Provisional refusal based on opposition(s) Vorläufige Schutzverweigerung wegen eines(mehrerer) Widerspruchs(-sprüche) ☐ Provisional refusal based on both - <i>ex officio</i> examination and opposition Vorläufige Schutzverweigerung wegen absoluter Gründe und Erhebung eines Widerspruchs	
IV.	☒ Provisional refusal for all the goods and/or services Vorläufige Schutzverweigerung für alle Waren und/oder Dienstleistungen ☐ Provisional refusal for some of the goods and/or services: Vorläufige Schutzverweigerung für die folgenden Waren und/oder Dienstleistungen:	
V.	Grounds for refusal Gründe der vorläufigen Schutzverweigerung ☐ Absolute grounds ☒ Opposition(s) by opponent(s): see VI. Eingelangte Widersprüche: siehe VI.	
VI.	Information relating to earlier mark(s) or application(s) Informationen betreffend die ältere(n) Marke(n) oder Anmeldung(en) Type / Registration number / Mark / Filing date / Filing number / Priority date Art / Registernummer / Marke / Anmeldedatum / Anmeldenummer / Prioritätsdatum IR 1.398.414 / VIFIT / 2017-03-27 / BX: 2017-01-04 1345994 Name and address of the owner(s): Name und Adresse des(der) Inhaber(s): FrieslandCampina Nederland B.V. Stationsplein 4 NL-3818 LE Amersfoort Goods and services on which the opposition is based: Waren und Dienstleistungen, auf die sich der Widerspruch stützt: Cl. 29: Dairy products; milk; milk products; milk powder; dairy-based beverages; milk shakes; flavoured milk powder for making beverages; whey, whey powder; curd; milk protein; cheese; fermented milk; fermented milk products; kefir; yoghurt; cream; dairy products for dietetic purposes (not for medical use); preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; edible oils and fats. Cl. 30: Coffee, tea, cocoa and drinks based thereon; rice, cereals, corn, oats and foodstuffs based thereon; muesli; drinks in powder form containing cocoa, coffee or tea; candy bars; cereal and muesli bars; nutritional bars included in this class; sesame seeds; chocolate; chocolate coated foodstuffs; chocolate based foodstuffs; pastry; confectionery; desserts, namely mousses, blancmanges, pudding, frozen yoghurt, ice cream; powder for making ice cream.	

Cl. 32: Powders and other preparations for making beverages; sports drinks; sports beverages; isotonic beverages; energy drinks; whey beverages; smoothies.	
VII. Applicable provisions of the national law (see text last pages) Anwendbare Bestimmungen des nationalen Gesetzes (siehe Gesetzesauszug auf den letzten Seiten) Section 29a and the following § 29a ff	
VIII. Information relating to subsequent procedure / Information über das weitere Verfahren Reply/response to the provisional refusal / Äußerung auf die Schutzverweigerung (i) Time limit for reply / Äußerungsfrist: 25/08/2020 (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). (iii) The original opposition request(s) and any accompanying documents will then be communicated to the person or representative appointed once a written reply has been received . Der/die Original-Widersprüche und allfällige Beilagen werden dann an die benannte Person oder den benannten Vertreter zugestellt, sobald eine schriftliche Äußerung eingelangt ist. (iv) In case the trademark holder does not file within the time limit set out in (i) a written statement, which 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. (v) Authority to address the reply: see I. Behörde, an die die Äußerung zu richten ist: siehe I.	
IX. Date of provisional refusal Datum der vorläufigen Schutzverweigerung 25/05/2020	Number of Annexes: Zahl der Anhänge: -
X. Signature or official seal of the Office Unterschrift oder Amtsstempel der Behörde Rechtskundiges Mitglied Young-Su Kim	
XI. Supplementary information Zusätzliche Information Data concerning the trademark(s) cited as base for opposition may be found using the following links: Registerdaten der Widerspruchsmarke(n) finden Sie unter: http://www.patentamt.at http://www.wipo.int/ipdl/en/madrid http://oami.europa.eu/CTMOnline/RequestManager/de_SearchBasic	

XII.

- I. Corresponding essential provisions of the applicable law: Austrian Trade Mark Act
(Federal Law Gazette No. 260/1970 in its current version / Bundesgesetzblatt Nr. 260/1970 idgF)

Section 1

A trade mark may consist of any 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 specialities, 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. [....].