

MADRID AGREEMENT/MADRID PROTOCOL
CONCERNING THE INTERNATIONAL REGISTRATION OF TRADE MARKS
REFUSAL OF PROTECTION
notified to the International Bureau of the World Intellectual Property Organization (WIPO)
under Article 5 of the Madrid Agreement/Madrid Protocol

The boxes are crossed off when applicable ☒

I.	Office having declared refusal of protection: Deutsches Patent- und Markenamt D-80297 München (Federal Republic of Germany)	Telephone Teleprinter Extension no.	+49 (0)89 2195-0 +49 (0)89 2195-4000 +49 (0)89 2195-4104
II.	No. of the international registration in respect of which protection has been refused: 1 553 216 No. of basic national registration: 20 719 385 A		
III.	Name and address of the holder of the registration in respect of which protection has been refused: ZHANGJIAGANG SHENGGANG, ENVIROMENT FIRE-PROOF, CONSTRUCTION MATERIAL CO., LTD, No.9, South of ZhenBei East Road, Yangshe, Town, Zhangjiagang Economic and, Technological Development Zone, Zhangjiagang, Suzhou City, Jiangsu Province, CN		
IV.	Provisional/final refusal (<i>see item VIII below</i>)		
V.	Grounds for refusal (earlier opposed trade marks and/or other grounds): – <i>see item X</i> –		
VI.	Applicable sections of the national law: – <i>see item X</i> –		
VII.	☒ Refusal for all products/services. ☐ Refusal for all products/services excepting: ☐ Refusal for products/services as follows: – <i>see item X</i> –		
VIII.	Objection to and legal remedies concerning the decision to refuse protection (<i>please quote the international registration no./cl. 19 in all correspondence</i>): The holder of the trade mark may submit his objections to the present refusal to Deutsches Patent- und Markenamt (<i>address as indicated in item I above</i>) within four months from the date on which the notification of refusal was dispatched by WIPO, exclusively through the agency of a representative (<i>Patentanwalt</i> or <i>Rechtsanwalt</i>) who is authorised and empowered to represent the holder of the trade mark in proceedings before the German Patent and Trade Mark Office, before the Federal Patent Court and in civil litigation affecting this trade mark, as well as to file motions for criminal prosecution. The details of the refusal will be communicated to that representative. During the above time limit, the refusal of protection is provisional. In the absence of objections to the refusal within the time limit of four months, the latter will become final without further notification. Within an additional time limit of one month the holder may, however, file an objection (<i>Erinnerung</i>) together with the fee of EUR 150 for objection. In the absence of an objection refusal shall become final. The special motion (<i>Erinnerung</i>) shall be addressed directly to Deutsches Patent- und Markenamt (<i>address as indicated in item I above</i>) through the agency of a representative (<i>Patentanwalt</i> or <i>Rechtsanwalt</i>) who is authorised and empowered to represent the holder of the trade mark in proceedings before the German Patent and Trade Mark Office, before the Federal Patent Court and in civil litigation affecting this trade mark, as well as to file motions for criminal prosecution.		
IX.	Date of pronouncement of refusal: February 22, 2021		



IR1553216

X. (Title and date of the applicable national law)

Extract from the Trade Mark Law

Version of 19/10/2013, Section 96 updated

Absolute obstacles to protection

8. - (1) Signs eligible for protection as a trade mark within the meaning of section 3 which cannot be depicted graphically shall be excluded from registration.
- (2) The following trade marks shall be excluded from registration
1. those which are devoid of any distinctive character for the goods or services,
 2. which consist exclusively of signs or indications which may serve, in the course of trade, to designate the nature, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services or to designate other characteristics of the goods or services,
 3. which consist exclusively of signs or indications which have become customary in the current usage or in the bona fide and established practices of the trade to designate the goods or services,
 4. which are of such a nature to mislead the public, in particular with regard to the nature, the quality or the geographical origin of the goods or services,
 5. which are contrary to public policy or to accepted principles of morality,
 6. which contain state coats of arms, state flags or other sovereign state symbols or coats of arms of a domestic locality or of a domestic municipal or other local authority association,
 7. which contain official certification marks or hallmarks which are excluded from registration as a trade mark in accordance with a notice made by the Federal Ministry of Justice in the Federal Law Gazette (BGBl.),
 8. which contain coats of arms, flags or other symbols, seals or designations of international intergovernmental organisations which are excluded from registration as a trade mark in accordance with a notice made by the Federal Ministry of Justice in the Federal Law Gazette,
 9. the use of which can evidently be prohibited in the public interest in accordance with other provisions, or
 10. which have been applied for in bad faith.
- (3) Subs. 2 Nos. 1, 2 and 3 shall not apply if, prior to the point in time of the decision on registration, the trade mark has become established in the trade circles involved as a result of its use for the goods or services for which the application was filed.
- (4) Subs. 2 Nos. 6, 7 and 8 shall also be applied if the trade mark contains the imitation of a sign listed there. Subs. 2 Nos. 6, 7 and 8 shall not be applied if the applicant is empowered to include in the trade mark one of the signs listed therein, even if it can be confused with one of the other signs listed therein. Subs. 2 No. 7 shall furthermore not be applied if the goods or services for which the trade mark application was filed are neither identical with nor similar to those for which the certification mark or hallmark has been introduced. Subs. 2 No. 8 shall further not be applied if the trade mark applied for is not suitable to create among the public the incorrect impression of a connection with the international intergovernmental organisation.

Trade marks that have been filed or registered as relative obstacles to protection

9. - (1) The Registration of a trade mark may be cancelled
1. if it is identical to a trade mark applied for or registered which has older seniority and the goods or services for which it was registered are identical with the goods or services for which the trade mark with older seniority was filed or registered,
 2. if the likelihood of confusion exists, including the likelihood of association between the trade marks, for the public because of its identity with or similarity to a trade mark applied for or registered with older seniority and owing to the identity or similarity of the goods or services covered by both trade marks, or
 3. if it is identical with or similar to a trade mark applied for or registered with older seniority and has been registered for goods or services which are not similar to those for which the trade mark with older seniority has been filed or registered, if the trade mark with older seniority is a trade mark which has a reputation in this country and the use of the registered trade mark would without due cause take unfair advantage of, or be detrimental to, the distinctive character or the repute of the trade mark which has a reputation.
- (2) Applications for trade marks shall only constitute a ground for refusal within the meaning of subs. 1 if they are registered.

Opposition

42. - (1) Within a three-month period after the date of the publication of the registration of the trade mark in accordance with section 41, the proprietor of a trade mark or of a commercial designation with older seniority may lodge an opposition against the registration of the trade mark.
- (2) The opposition may only invoke that the trade mark may be cancelled
1. because of a trade mark applied for or registered with older seniority in accordance with section 9,
 2. because of a well-known mark with older seniority in accordance with section 10 in conjunction with section 9,
 3. because of its registration for an agent or representative of the trade mark proprietor in accordance with section 11, or
 4. because of a trade mark not registered with older seniority in accordance with section 4 No. 2 or of a commercial designation with older seniority in accordance with section 5 in conjunction with section 12.
- (3) (repealed)

Objection of insufficient use, decision on the opposition

43. - (1) If the opposition has been lodged by the proprietor of a registered trade mark with older seniority, he/she shall, if the other party disputes the use of the trade mark, make a plausible case that he/she, within the last five years prior to the publication of the registration of the trade mark which is targeted by the opposition, has been used in accordance with section 26 insofar as it has been registered for at least five years at this point in time. If the period of five years of non-use ends after the publication of the registration, the opponent, if the other party disputes the use, must make a plausible case that the trade mark has been used in accordance with section 26 within the past five years prior to the decision on the opposition. Only those goods or services shall be taken into consideration in the decision with respect to which a plausible case has been made for use.
- (2) If the examination of the opposition reveals that the trade mark is to be cancelled for all or part of the goods or services in respect of which it is registered, the registration shall be cancelled in full or in part. If the registration of the trade mark cannot be cancelled, the opposition shall be refused.
- (3) If the registered trade mark is to be cancelled because of one or several trade marks with older seniority, the proceedings on further objections may be suspended until a decision has been handed down with legal force on the registration of the trade mark.
- (4) Section 52 subs. 2 and 3 shall be applied mutatis mutandis in the event of cancellation in accordance with subs. 2.

Domestic representative

96. - (1) Any person who has neither their residence nor principal place of business nor an establishment in Germany may participate in the proceedings before the German Patent and Trade Mark Office or the Federal Patent Court which are regulated under this Act and assert the rights deriving from a trade mark only if he has appointed as his representative a lawyer or patent attorney who is authorised and empowered to represent him in proceedings before the German Patent and Trade Mark Office, before the Federal Patent Court and in civil litigation affecting this trade mark, as well as to file motions for criminal prosecution.
- (2) The place where a representative appointed pursuant to subsection (1) has his commercial premises shall be deemed, within the meaning of section 23 of the Code of Civil Procedure, to be the place where the asset is located; if there are no such commercial premises, the place where the representative is residing in Germany shall be decisive or, if there is no such place, the place where the German Patent and Trade Mark Office has its seat.
- (3) The legal termination of the appointment of a representative in accordance with subsection (1) shall not become effective until the German Patent and Trade Mark Office or the Federal Patent Court has been informed of both the termination of this appointment and the appointment of another representative.

Application of the provisions of this Act; language

107. (1) The provisions of this Act shall be applied mutatis mutandis to the international registration of trade marks in accordance with the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement on Marks) carried out through the intermediary of the Patent Office or whose protection covers the territory of the Federal Republic of Germany unless provided otherwise in this Chapter or in the Madrid Agreement on Marks.
- (2) All and any applications, as well as other communications in the proceedings for international registration and the list of goods and services, shall be submitted in either French or English, at the choice of the applicant.

Opposition

114. - (1) The publication of the registration (section 41) for internationally-registered trade marks shall be substituted by publication in the Information Notice published by the International Bureau of the World Intellectual Property Organisation.
- (2) The time limit to lodge the opposition (section 42 subs. 1) against the granting of protection for internationally-registered trade marks shall commence on the first day of the month following the month stated as the issue month of the edition of the Information Notice containing the publication of the internationally-registered trade mark.
- (3) Refusal of protection shall take the place of the cancellation of the registration (section 43 subs. 2).

Extract from the Trade Mark Ordinance version of 11 May 2004

Section 46 Refusal of Protection

(1) Where protection is, in full or in part, refused to an international registration the protection of which has been extended to the territory of the Federal Republic of Germany under Article 3^{ter} of the Madrid Agreement or under Article 3^{ter} of the Protocol Relating to the Madrid Agreement, and where this refusal is communicated to the International Bureau of the World Intellectual Property Organization to be transmitted to the proprietor of the international registration, the time limit for appointing a representative in Germany shall, to avoid final refusal, be fixed to four months from the date on which notification of refusal was dispatched by the International Bureau of the World Intellectual Property Organization.

(2) Where the refusal of protection has become final because the proprietor of the international registration has failed to appoint a representative in Germany, a special motion (*Erinnerung*) or an appeal from the refusal shall be filed with the German Patent and Trade Mark Office within one further month after the time limit under subsection (1). Instructions about the proprietor's right to appeal shall be attached to the refusal. Section 61(2) of the Trade Mark Act shall apply *mutatis mutandis*.

still X.	Supplementary box grounds for refusal – <i>item V</i> – International Trade Mark 1 553 216 The extension of protection of a trade mark consisting of or containing non-Latin characters is subject to special rules (Secs. 119, 124, 32 (3), 36(1) no. 2, 36 (4) Trade Mark Act, Sec. 15 (2), (4) Trade Mark Ordinance; Art. 5 Protocol Relating to the Madrid Agreement; Art. 6 quinquies B Paris Convention. If these requirements are not met, the trade mark will be refused on formal grounds. The trade mark is a descriptive indication/sign in respect of the goods/services mentioned whose use cannot be reserved for a single applicant but must be kept free for all competitors; it is devoid of any distinctive character (Sec. 119, 124, 113, 37, 8 (2) Nos 1, 2 Trade Mark Law; Art. 5 Protocol Relating to the Madrid Agreement; Art 6 quinquies B Paris Convention). <u>Note:</u> If no representative has been appointed within the provisional time limit of the first four months, this fact constitutes in itself a ground for refusal after the notification concerning the refusal of protection has become final (Sec. 96, 119 Trade Mark Law).
XII. Annexes (crossed off below) ☐ 1 reproduction of 0 opposed trade marks including a figurative element or a special graphic design ☐ List specifying the registration number as well as the relevant goods/services in respect of each opposed trade mark ☐ List of professional representatives ☐ List of goods/services	XI. Signature or official seal of the administration which pronounced the refusal 

Dear Madam, Sir,

The Office of Germany originally sent the attached notification to WIPO within the applicable refusal period, and WIPO promptly sent a copy of this notification to the holder or representative, as the case may be, at the email address indicated for this purpose.

WIPO has become aware that this electronic communication might not have reached the intended recipient due to a number of reasons (e.g., spam filtering settings, full inbox or incorrect email address).

To redress the situation, WIPO is sending this communication again. Please, take note that the time limit to reply to this notification begins on the date on which WIPO resent the notification to the holder or representative, as the case may be.

We take advantage of this opportunity to request that you review your email spam filtering settings to ensure they do not block communications sent from “@Rpost” and “@E-marks”, check your email inbox to make sure it is not full or update your email address to receive electronic communications from WIPO.

De nuestra consideración:

La Oficina de Alemania envió originalmente la notificación adjunta a la OMPI dentro del período de denegación aplicable, y la OMPI envió inmediatamente una copia de esta notificación al titular o su mandatario, según sea el caso, a la dirección de correo electrónico indicada para este fin.

La OMPI ha tomado conocimiento de que es posible que esta comunicación electrónica no haya llegado al destinatario previsto debido a una serie de razones (por ejemplo, la configuración del filtro de spam, la bandeja de entrada llena o la dirección de correo electrónico incorrecta).

Para corregir la situación, la OMPI envía de nuevo esta comunicación. Tenga en cuenta que el plazo para responder a esta notificación comienza a partir de la fecha en que la OMPI reenvía la notificación al titular o a su mandatario, según sea el caso.

Aprovechamos esta oportunidad para solicitarle que revise la configuración de filtrado de spam de su correo electrónico para asegurarse de que no bloquee las comunicaciones enviadas desde “@Rpost” y “@E-marks”, verifique la bandeja de entrada de su correo electrónico para asegurarse de que no esté llena o actualice su dirección de correo electrónico para recibir comunicaciones electrónicas de la OMPI.

Madame, Monsieur,

L'Office de l'Allemagne a initialement envoyé la notification ci-jointe à l'OMPI dans le délai de refus applicable, et l'OMPI a envoyé à bref délai une copie de cette notification au titulaire ou à son mandataire, selon le cas, à l'adresse électronique indiquée à cette fin.

L'OMPI a pris connaissance du fait que cette communication électronique pourrait ne pas être parvenue au destinataire prévu pour un certain nombre de raisons (par exemple, paramètres du filtre de protection contre les courriers électroniques non sollicités (antispam), boîte aux lettres électronique pleine ou adresse électronique incorrecte).

Pour remédier à cette situation, l'OMPI envoie à nouveau cette communication. Veuillez noter que le délai pour répondre à cette notification commence à courir à partir de la date à laquelle l'OMPI a renvoyé la notification au titulaire ou à son mandataire, selon le cas.

Nous profitons de cette occasion pour vous demander de vérifier les paramètres de votre filtre de protection contre les courriers électroniques non sollicités (antispam) pour vous assurer qu'ils ne bloquent pas les communications envoyées depuis "@Rpost" et "@E-marks", de vérifier votre boîte aux lettres électronique pour vous assurer qu'elle n'est pas pleine ou de mettre à jour votre adresse électronique pour recevoir des communications électroniques de l'OMPI.