



Intellectual  
Property  
Office

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

**Your Reference:**  
**International Registration No:**  
WO0000001393518  
**Examiner:** Lara Hayes  
**Direct Telephone:** +44(0)1633811033  
**Date:** 25 February 2021

**Intl Reg No:** WO0000001393518  
**Mark:** Sahara PREMIUM (Figurative)  
**Holder:** RIVEDIL DI CODARDO COSIMO  
**Class(es):** 2

**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**

Dear Sirs,

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 TM7F '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](http://ipo.gov.uk/tmforms) and **return it to this office** within **two months** of the date of this letter, that is, on or before **26 April 2021**. 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 a available at [ipo.gov.uk/tmforms](http://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.

Yours faithfully,

*Lara Hayes*  
**Trade Marks Registry**

[Skip to main content](#)

# **Intellectual Property Office**

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**Trade mark number**

UK00801493895

**Status**

Registered

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## **Overview**

**Trade mark**

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## **Dates**

**Filing date**

19 July 2019

**Date of entry in register**

27 March 2020

**Renewal date**

19 July 2029

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## **Priority details**

**Priority date**

19 July 2019

**Priority country**

Serbia

**TM from which priority claimed**

Ž-1108/2019

**Claim**

Whole

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**Goods and services****Classes and terms**

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**Class 2**

Paints.

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**Names and addresses****Owner(s) name**

**Preduzeće za proizvodnju, promet i usluge "MAXIMA" d.o.o.**

Dragiše Mišovića 16 32240 Lučani, Serbia

**Country of Incorporation**

Serbia

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**IPO representative name**

**Živko Mijatović & Partners**

Sturientski trg 4 11000 Beograd, Serbia

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Intellectual Property Office is an operating name of the Patent Office



Intellectual  
Property  
Office

FD 18/02/21 £100.00  
OP600001612  
IP0015385

## Form TM7F

### Notice of FAST TRACK opposition and statement of grounds

#### Fee £100

Use this form to notify of a fast track 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 your grounds are not limited to Section 5(1) and/or 5(2) based on already registered or protected marks, (use form TM7 instead).

**Do not use this form** if any of the earlier marks on which the opposition is based had been registered/protected for 5 years or more on the date that the opposed mark was published in the Journal AND you are not including proof of use of the mark(s) with this Notice (use Form TM7 instead).

#### 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"

WO0000001393518

#### 2. Full name of applicant/holder

Whose trade mark you are opposing

RIVEDIL DI CODARDO COSIMO

#### 3. Full name of opponent

##### 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

**PLEASE NOTE:** Publication of name and address and other information you provide. We publish the owner's name and address and other information you provide in our searchable records. You should provide a business or PO Box address if you do not want your home address published. I understand that name and address details and other information I provide will be published. ☐

Preduzeće za proizvodnju, promet i usluge "MAXIMA" d.o.o.

Dragiše Mišovića 16,  
32240 Lučani,  
Serbia

Postcode

**ADDITIONAL 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 38(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.

Novagraaf UK

**Address**

The address provided in this section must be in the UK, European Economic Area (EEA) or the Channel Islands.

Suite 8, Lowery House, 17 Marble Street, Manchester

Postcode M2 3AW

**Email address**

Complete if you would like us to correspond with you by email

info.manchester@novagraaf.co.uk

**5. Related proceedings**

If applicable, select location of any related proceedings and enter the case number allocated to the proceedings.

IPO Registry

UK Courts

EUIPO

Number

info.manchester@novagraaf.co.uk

**6. Opposition notification date**

If you have informed the applicant/holder of an intention to oppose the trade mark application, international registration – enter the date you notified them. [**\*\*See Note**]

N/A

**\*\*Note:** An opposition launched without giving the applicant or holder a reasonable opportunity to withdraw the application, international registration or amendment may result in the opponent being ineligible for an award of costs.

**7. Signature**

*Novagraaf UK*

**Name**

(**BLOCK CAPITALS**)

NOVAGRAAF UK

**Date**

18 February 2021

**8. Your reference**

Complete if you would like us to quote this in communications with you, otherwise leave blank.

1771447K/GB

**Contact details**

Name, daytime telephone number of the person to contact in case of query.

Michael Freeman

0161 281 3000

Number of sheets attached to this form

0

**Checklist**

Please make sure you have remembered to:

- ☐ Sign and date the form
- ☐ Complete fee sheet
- ☐ 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

No more than three earlier trade marks may be relied upon to support this opposition. If you are relying upon more than one earlier mark you must repeat this section, including your statements to the points Q.1 to Q.13 below (to the extent relevant) for each earlier mark.

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

#### ABOUT THE EARLIER TRADE MARK

**Trade mark number**

Your trade mark

1493895

**Type of mark**

Please tick

☐ UK

☐ EUTM



International

**Date the mark became registered or  
protection was granted**

27 March 2020

**Representation of your trade mark**

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

*Sahara*

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

<input checked="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> )

**Q2. STATEMENT OF USE - Was the date on which the earlier trade mark became registered or protected 5 years or more before the application date (or priority date, if applicable) of the application or international registration you wish to oppose? This is the period referred to below as 'the relevant period'.**

☐

Yes

☒

No > Go To Q11

**If 'Yes' you must complete the statement below and also Q3 to Q10, before continuing to Q11.**

I, (name)..... of (address) ..... and  
holding the position of (position in company) ..... , state the  
following in answer to the following questions.

**Q3. For which of the goods and services listed at Q1 is use of the trade mark being claimed?**

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**Q4. If the opposition is based upon a European Union Trade Mark or an International Registration protected in the Community, please explain where in the Community the mark has been used in the relevant period?**

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**Q5.** If the opposition is based on a national registration, or an international registration protected by the UK, please indicate if the mark has been used throughout the UK or, if only used locally or regionally, state where in the UK the mark was used.

Throughout the UK (tick)

☐

or, in the following areas

**Q6.** Please provide a list of examples of the mark in use in the relevant period and indicate against each such entry the goods/services for which you claim it shows use of the mark. Examples of use of the mark could include in price lists, brochures, advertisements, invoices etc. The documents included in your list should be attached as exhibits, which should be clear and easy to read. Each exhibit should be numbered, e.g. exhibit 1, exhibit 2 etc. and the pages of each exhibit should also be numbered, e.g. 1/7, 2/7 and so on. The total number of pages attached as exhibits to this TM7F should not exceed 100 pages. (If you cannot provide examples of the mark in use, please go to Q7.)

*Note: If you cannot provide examples from the relevant period but provide more recent examples instead, you must state clearly whether the mark was used in the same form and in the same ways during the relevant period or in some part of that period.*

**Q7.** If no examples are available, a statement of how the mark was used during the relevant period should be provided along with an explanation as to why no examples of the mark in use are available.

**Q8.** Please provide details of the number of sales achieved under the mark in the UK (or in the EU if the earlier mark is registered or protected at Community level) during the relevant period. These figures should, if possible, be provided on an annual basis and, if possible, be split in relation to each of the goods/services for which use of the mark is claimed; estimates should be provided if exact figures are not readily available.

*Note: You may provide financial turnover figures to illustrate the level of sales under the mark, but if you do please also provide an indication of the typical unit price for the product or service.*

**Q9.** If you consider that the information already provided clearly shows genuine use of the mark during the relevant period in relation to the goods/services for which use is claimed, please go to Q10. If you wish to supplement the information already provided, please state how much was spent promoting the mark in the UK (or in the case of a European Union Trade Mark, in the Community) during the relevant period. Ideally, this should be broken down by year. Estimates may be provided if exact figures are not readily available.

**Q10.** Please provide any other information that you consider to be relevant.

**Statement of truth – to be completed by the person identified at Q2 above**

I believe that the facts stated in this form are true.

**Signature**

**Name (BLOCK CAPITALS)**

**Date**

## DETAILS OF THE TRADE MARK YOU ARE OPPOSING

**Q11. Please tick the relevant section(s) that apply.**

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

**Q12. 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 and 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>

**Q13. Use this space to supply any further information about why you consider there is a likelihood of confusion and for example why you consider the respective marks or goods and/or services to be similar.**

<p>(1) The mark applied for is highly similar to the Opponent's earlier mark. The dominant element in mark applied for is the word "Sahara" which is visually, aurally, and conceptually identical with the earlier mark "Sahara". The word "PREMIUM" in the mark applied for is a non-distinctive element likely to indicate to the relevant consumer a superior quality version of the goods of the Opponent.</p> <p>(2) The mark applied for is proposed to be registered for goods in Class 02 identical with and/or similar to the Class 02 goods for which the earlier mark is protected, in particular but not solely in respect of "Paints".</p> <p>(3) Considering the above, and the impact of imperfect recollection by the relevant public, there is a likelihood of confusion on the part of the public as regards the mark applied for with the earlier mark. Consequently, registration of the mark applied for would be contrary to Section 5(2)(b) and we request that it be refused registration in its entirety under the provisions of Section 5(2)(b). We also request an award of costs to the Opponent.</p>
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## Helen Cooper

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**From:** Forms  
**Sent:** 19 February 2021 11:02  
**To:** Trademark.Examination  
**Cc:** ProcessedFeeBearingForms  
**Subject:** TM7 FD 18/02/21 FW: NGUK Ref.: 1771447K/GB Notice of Opposition against Trade Mark No WO0000001393518  
**Attachments:** Form TM7F.pdf  
**Categories:** Helen

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**From:** Team-Freeman | Novagraaf <Team-Freeman@novagraaf.com>  
**Sent:** 18 February 2021 16:46  
**To:** Tribunalsection <Tribunalsection@ipo.gov.uk>; Forms <Forms@ipo.gov.uk>  
**Subject:** NGUK Ref.: 1771447K/GB Notice of Opposition against Trade Mark No WO0000001393518

Dear Sir/Madam

Opposition against Trade Mark No WO0000001393518  
In the name of RIVEDIL DI CODARDO COSIMO  
By Preduzeće za proizvodnju, promet i usluge "MAXIMA" d.o.o.

Please find attached Form TM7F Notice of FAST TRACK opposition against the above-identified trade mark application.

Kind regards

**Alison Bowden**  
CITMA Paralegal

Novagraaf UK | Office address Suite 8b, Lowry House, 17 Marble Street, Manchester M2 3AW |  
T: +44 (0)161 281 3000 | E : [info.manchester@novagraaf.com](mailto:info.manchester@novagraaf.com)



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Please ensure all invoices are sent to [invoicesUK@novagraaf.com](mailto:invoicesUK@novagraaf.com). Invoices sent to any other email address will not be accepted and processed for payment

Please consider the environment before printing this email

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Novagraaf UK is the trading name of J.E. Evans-Jackson & Co (registered no. 02484420). Its registered office is at: 27/28 Eastcastle Street, London W1W 8DH. Regulated by IPREG.

**All supplier invoices should be addressed to Novagraaf UK.**

**Business continuity during COVID-19 outbreak:** please note that, as a precautionary measures, all Novagraaf staff have moved to remote working and our offices have been temporarily closed. We have the systems and IT infrastructure to ensure that we can continue as normal, with minimal disruption. Our full team therefore continues to be available to respond to your needs.