



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

Your Reference:
International Registration No:
WO0000001579478
Examiner: Claire Woodman
Direct Telephone: +44(0)1633814566
Date: 27 May 2021

Intl Reg No: WO0000001579478
Mark: (Figurative)
Holder: Hästens Sängar AB
Class(es): 20, 24, 25

**Notification Of A Provisional Partial 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 in class 25 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. 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 **27 July 2021** 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, (which for the purpose of the Act includes the Isle of Man, the Channel Islands and Gibraltar) 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If one is not provided within this time, the international registration will be treated as withdrawn in whole or part.

Claire Woodman

Trade Marks Registry

Date: 12 May 2021

Our Ref: KA/O15309GB00



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

The Haybarn
Upton End Farm Business Park
Meppershall Road
Stillington, Hitchin
Hertfordshire SG5 3PF
United Kingdom

BY EMAIL: tribunalsection@ipo.gov.uk

NO OF PAGES: 12 in total

OPPOSITION DEADLINE 19 MAY 2021

Dear Sirs

UK Designation of IR Number 1579478 Horse [logo] in Classes 20, 24 and 25 in the name of Hästens Sängar AB

Opposition thereto by MUSTANG - Bekleidungswerke GmbH + Co. KG

Please find attached the following documents in order to oppose the UK designation of IR Number 1579478 Horse [logo] in Class 25.

1. Form TM7 and Statement of Grounds.
2. Fee sheet for £100.00.

Please note that I am sending the documents by email only.

I look forward to receiving confirmation that the opposition has been processed.

Yours faithfully

Katy Adams
Chartered Trade Mark Attorney
Groom Wilkes & Wright LLP
Enc

OP000424402

IP0024933



**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"	IR 1579478	
2. Full name of applicant/holder Whose trade mark you are opposing	Hästens Sångar AB	
3. Full name of opponent	MUSTANG - Bekleidungswerke 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	Karl-Kurz-Straße 44/1	
	Schwäbisch Hall	
	Germany	
	Postcode	D-74523
<p><small>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. <input type="checkbox"/></small></p> <p><small>ADDITIONAL INFORMATION: 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</small></p>		
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.	Groom Wilkes & Wright LLP	
Address The address provided in this section must be in the UK, European Economic Area (EEA) or the Channel Islands.	The Hay Barn, Upton End Farm Business Park,	
	Meppershall Road, Shillington, Hitchin,	
	Hertfordshire	
	Postcode	SG5 3PF

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

info@gwwtrademarks.com

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

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]

-

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

Groom Wilkes & Wright LLP

Name

(BLOCK CAPITALS)

GROOM WILKES & WRIGHT LLP

Date

12 May 2021

8. Your reference

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

KA/O15309GB00

Contact details

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

Katy Adams
01462 714300

Number of sheets attached to this form

11 in total

Checklist

Please make sure you have remembered to:

☐

Sign and date the form

Email your form to us:

Send your form, saved as a PDF to:

forms@ipo.gov.uk

For help saving your form as a PDF see:

<https://www.gov.uk/government/publications/how-to-file-documents-with-the-intellectual-property-office/how-to-file-documents-with-the-intellectual-property-office>

If you cannot email your form, post to:

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	357392
---------------------------------------------	--------

Type of mark Please tick	<input type="checkbox"/> UK	<input checked="" 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.

Please see the attached printout from the EU IPO database.

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)
All goods in Class 25	

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

> GO TO Q4.

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

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 type="checkbox"/>	All goods and services
<input checked="" type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)
All goods in Class 25.	

Q5. 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.

Please see the attached statement of grounds and in particular paragraphs 1-5.



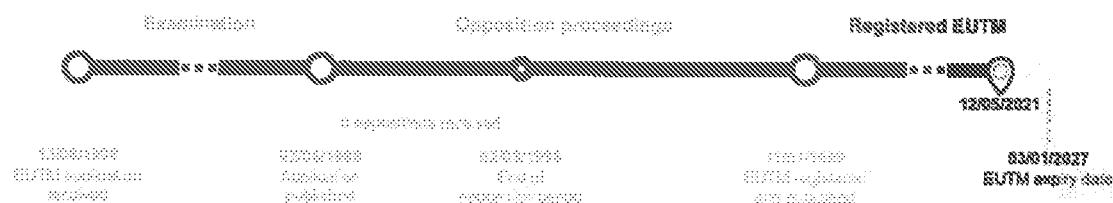
Protect your intellectual property in the European Union

EUTM file information

(Trade mark without text)

000357392

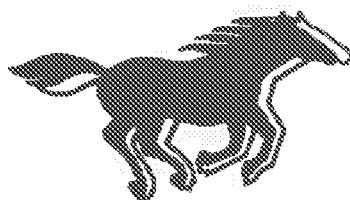
Timeline



Trade mark information

Name	(Trade mark without text)	Filing date	03/01/1997
Filing number	000357392	Registration date	10/11/1998
Basis	EUTM	Expiry date	03/01/2027
Date of receipt	13/08/1996	Designation date	
Type	Figurative	Filing language	German
Nature	Individual	Second language	English
Nice classes	3, 9, 14, 16, 18, 24, 25, 26, 28, 30, 32, 34, 41 (Nice Classification)	Application reference	HRM 62940 EU
Vienna Classification	03.03.01 (Vienna Classification)	Trade mark status	Registered
		Acquired distinctiveness	No

Graphic representation



Goods and services

English (en)

- 3 Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; perfumery, deodorising preparations for personal use; Fragrant air freshening sprays.
- 9 Spectacles and sunglasses; recording discs, compact discs, music and video cassettes, magnetic and optical image and sound carriers; apparatus for reproduction of sound or images; amusement apparatus adapted for use with television receivers only; amusement machines; computer games; electronic games; recorded optical and magnetic data recording

carriers containing printed matter or programs, in particular computer games, machine-readable data carriers of all types; electronic newspapers; instructional and teaching materials (except apparatus) in the form of games programs, films and image/text and sound recordings on data carriers of all types.

14 Goods of precious metals and their alloys or coated therewith, namely craft objects, decorative objects, tableware (except cutlery), table bases, ashtrays, cigar and cigarette cases, cigar and cigarette holders; jewellery, precious stones; fashion jewellery, cuff links, tie pins.

16 Paper, cardboard; goods of paper and cardboard, namely boxes for packaging, bags for packaging, paper handkerchiefs, paper hand towels, paper napkins; printed matter, magazines, photographs, stationery; instructional and teaching material (except apparatus) in the form of printed matter, games.

18 Goods of leather and imitations of leather, namely bags and other containers not suitable for carrying objects, and small goods of leather, in particular purses, pocket wallets, key wallets; hand bags, shopping bags, sports bags, briefcases, school satchels, rucksacks, trunks and travelling bags, umbrellas and parasols.

24 Textiles and textile goods, curtains, blinds, household linen, table and bed linen; bed and table covers; tissues, of textile; imitation animal skin and fleece fabrics.

25 Clothing, corsets, sportswear, clothing of leather, belts, shoes, footwear for sports, headgear.

26 Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; zippers; belt clasps; pom-poms (haberdashery); artificial flowers.

28 Games and playthings; electrical and electronic games; gymnastic and sporting apparatus; special bags for sports equipment.

30 Coffee, tea, cocoa, rice, tapioca, sago, artificial coffee; coffee, tea, cocoa and chocolate drinks; cereals (except foodstuffs for animals); bread, pastries and cakes, ices, honey, treacle; yeast, baking-powder; edible salts, mustard; vinegar, sauces (except salad dressings); spices; ice.

32 Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices.

34 Smokers' articles, namely tobacco boxes, cigar and cigarette holders, cigar and cigarette cases, ashtrays, all aforesaid goods not of precious metals, their alloys or plated therewith; pipe racks, pipe cleaners, cigar cutters, pipes, lighters, pocket machines for rolling cigarettes; cigarette papers, cigarette filters, tobacco, cigars, cigarettes, smoker's tobacco, chewing tobacco, snuff, cigarettes containing tobacco substitutes, not for medical purposes.

41 Production of films, film rental, film projection, production of radio and television programmes; presentation of entertainment, text, images and music via transmission and communications networks; publication of books, newspapers, and periodicals; organising cultural exhibitions.

Description

No data

Owners

MUSTANG - Bekleidungswerke GmbH + Co. KG

ID	151875	Country	DE - Germany	Correspondence address	
Organisation	MUSTANG - Bekleidungsw GmbH + Co. KG	State/country	n/a	MUSTANG - Bekleidungswerke GmbH + Co. KG Karl-Kurz-Straße 44/1 D-74523 Schwäbisch Hall ALEMANIA	Hidden. You can set your contact details to be publicly available via the User Area.
Legal status	Legal entity	Post code	74523		Hidden. You can set your contact details to be publicly available via the User Area.
		Address	Karl-Kurz- Straße 44/1		Hidden. You can set your contact details to be publicly available via the User Area.

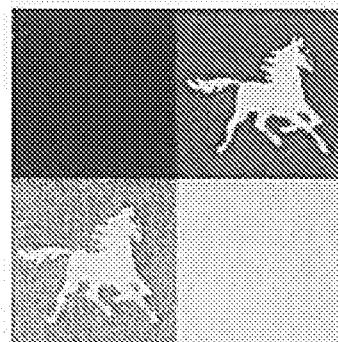
Representatives

CÖSTER & PARTNER RECHTSANWÄLTE MBB

ID	14012	Country	DE - Germany	Correspondence address	
Organisation	n/a	State/country	n/a	Cöster & Partner Rechtsanwälte mbB Theodorstrasse 9 90489 Nürnberg ALEMANIA	Hidden. You can set your contact details to be publicly available via the User Area.
Legal status	Legal person	Town	Nürnberg		
Type	Association	Post code	90489		Hidden. You can set your

TRADE MARKS ACT 1994

**IN THE MATTER OF
UK Designation of IR No. 1579478**



In Classes 20, 24 and 25

in the name of

Hästens Sångar AB

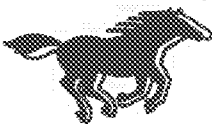
And

Opposition thereto by

MUSTANG - Bekleidungswerke GmbH + Co. KG

STATEMENT OF GROUNDS OF OPPOSITION

1. MUSTANG - Bekleidungswerke GmbH + Co. KG ("the Opponent") is the proprietor of the following Trade Mark Registration ("the Opponent's Mark"):

Country	Reg. No.	App. Date	Reg. Date Renewal Date	Mark	Goods upon which the opposition is based
EU	357392	03/01/1997	10/11/1998 03/01/2027		Class 25: Clothing, corsets, sportswear, clothing of leather, belts, shoes, footwear for sports, headgear.

2. The Opponent's Mark has a filing date which predates the filing date of the UK Designation of IR Number 1579478 Horse [logo] in Classes 20, 24 and 25 in the name of Hästens Sångar AB ("the Applicant's Mark"). As such, the Opponent's Mark constitutes an earlier mark within the meaning of Section 6(1) (a) of the Trade Marks Act 1994 ("the Act").

3. The Opponent's Mark consists of a Horse logo moving towards the right. The Applicant's Mark also contains of a Horse [logo] moving towards the right. The Opponent's Mark is referred to as a Horse [logo] and so is the Applicant's Mark. The Opponent submits that the Applicant's Mark is visually very similar and phonetically and conceptually identical and/or very similar to the Opponent's Mark. The Applicant's Mark is likely to be viewed by the average consumer as the name of a range of goods in Class 25 owned by, or connected or associated with, the Opponent. On this basis, the Applicant's Mark could serve to designate the same source of commercial origin as the Opponent's Mark.
4. This Opposition is directed against all of the goods applied for in Class 25 by the Applicant. The Opposition is based on all of the goods in Class 25 covered by the Opponent's Mark. The Applicant's Mark has been filed in respect of the following goods:

Class 25

Clothes, namely pyjamas, night gowns and robes; footwear, namely slippers and down socks; headwear, namely night caps and sleep masks.

The goods for which the Applicant's Mark has been filed in Class 25 are either identical and/or similar to the Opponent's goods in Class 25 because the Opponent's goods cover the broad terms clothing, footwear, and headgear.

5. The close similarity between the Applicant's Mark and the Opponent's Mark and the identity and/or similarity of the respective goods in Class 25 covered by the marks is such that there exists a high risk of confusion between them, including a likelihood of association. It is submitted that if the Registrar is so minded to not consider that direct confusion arises, applying the tests in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, there would nevertheless at the very least be indirect confusion between the respective marks. The Applicant's Mark therefore contravenes Section 5(2)(b) of the Act.
6. The relief claimed by the Opponent is the refusal of the Applicant's Mark in its entirety and an award of costs in these proceedings.

Groom Wilkes & Wright LLP

GROOM WILKES & WRIGHT LLP

Representative for the Opponent

12 May 2021

Fees and payment

We will only process the form with this section completed (one form per payment)

To check the correct fee for this form, search on [GOV.UK](http://gov.uk) for 'trade mark forms and fees'

Total Fee Paying (£)

100.00

Your own reference (Optional)

KA/O15309GB00

Your contact details should we have a query

Name

Katy Adams

Email

info@gwwtrademarks.com

Phone

01462 714300

How would you like to pay?

Tick one

☐

Using a debit or credit card – you will need the internet to pay by card



Go to our secure website – <https://fees.ipa.gov.uk/pay>



Enter your name, email address and total amount to pay from above



As proof of payment, write below the 16-digit reference number displayed from the online payment screen.

DO NOT write your debit/credit card number



Deduct from IPO deposit account

IPO deposit account number

☐

Cheque – make payable to 'Intellectual Property Office'

☐

Bank transfer

Reference – use your IPO deposit account number if you have one or an application number or your name if you don't.

Use the following bank account details

Sort code	20-18-23
Account number	80531766
Account name	Intellectual Property Office
SWIFT code	BARCGB22
IBAN number	GB92 BARC 2018 2380 5317 66

Jessica Duthie

From: Forms
Sent: 13 May 2021 08:47
To: Trademark.Examination
Cc: ProcessedFeeBearingForms
Subject: FD 12.5.2021 OP000424402 TM7 FW: Deadline 19 May 2021 : UK Designation of IR No. 1579478 Horse [logo] in Classes 20, 24 and 25 in the name of Hästens Sängar AB / Opposition thereto by MUSTANG - Bekleidungswerke GmbH + Co. KG
Attachments: Scanned from a Xerox Multifunction Printer.pdf
Categories: Jessica

From: Katy Adams <kadams@gwwtrademarks.com>
Sent: 12 May 2021 14:41
To: Tribunalsection <Tribunalsection@ipo.gov.uk>; Forms <Forms@ipo.gov.uk>
Subject: Deadline 19 May 2021 : UK Designation of IR No. 1579478 Horse [logo] in Classes 20, 24 and 25 in the name of Hästens Sängar AB / Opposition thereto by MUSTANG - Bekleidungswerke GmbH + Co. KG

Dear Sirs

Please see the attached letter, TM7, Statement of Grounds and fee sheet to oppose the United Kingdom designation of IR Number 1579478 Horse [logo] in Class 25.

I look forward to receiving confirmation that the opposition has been processed.

Yours faithfully

Katy Adams



Groom Wilkes & Wright LLP
The 'Haybarn'
Upton End Farm Business Park
Meppershall Road
Shillington, Hitchin
Hertfordshire, SG5 3PF

Tel: +44 01462 714 300 Fax: +44 01462 714 301
Email: info@gwwtrademarks.com
Website: www.gwwtrademarks.com

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