



Ministero dello Sviluppo Economico

DIREZIONE GENERALE PER LA TUTELA DELLA PROPRIETÀ INDUSTRIALE
Ufficio Italiano Brevetti e Marchi

MADRID AGREEMENT AND PROTOCOL PROVISIONAL REFUSAL OF PROTECTION Rule 17(1)

I. Office making the notification: MINISTERO DELLO SVILUPPO ECONOMICO Direzione Generale per la Tutela della Proprietà Industriale - Ufficio Italiano Brevetti e Marchi Via Molise, 19 - 00187 ROMA e-mail : dglcuibm.div02@pec.mise.gov.it
II. Number of the international registration: 1579492   Trademark:
III. Name of the holder: F&I Beverages AG Baarerstrasse 52 CH-6300 Zug (CH)
IV. Information concerning the type of provisional refusal: ☐ Provisional refusal based on an <i>ex officio</i> examination ☒ Provisional refusal based on an opposition (opposition n°652021000098723) ☐ Provisional refusal based on both an <i>ex officio</i> examination and an opposition
V. Information concerning the scope of the provisional refusal: ☒ Provisional refusal for all the goods and/or services ☐ Provisional refusal for some of the goods/services
VI. Grounds for refusal : Identity or similarity between the marks and identity or similarity between the goods/services.
VII. Opponent rights: 1) Registration number: 17563801 (EUTM) i) Filing date: 05/12/2017 ii) Registration date: 23/03/2018 iii) Name and address of the opponent: Bacardi & Company Limited Route de Meyrin 267 CH-1217 Meyrin (CH)

iv) Reproduction of the mark:



v) List of all the goods/services:

33 Alcoholic beverages (except beers).

2) Registration number: 890134 (International trademark)

i) Filing date: //

ii) Registration date: **22.05.2006**

iii) Name and address of the opponent: **Bacardi & Company Limited**

Route de Meyrin 267

CH-1217 Meyrin (CH)

iv) Reproduction of the mark:



v) List of all the goods/services:

33 Vodka of French origin.

VIII. Corresponding essential provisions of the applicable law (see text under XII):
Art.12 1), c) and d) of the Italian Industrial Property Rights Code.

IX. Information relating to subsequent procedure:

(i) Time limit for requesting review or appeal:

The holder of the registration may, through a representative appointed according to article 201, request copy of the opposition notice within a period of three months from the date on which he received the notification of this provisional refusal by the International Bureau of WIPO. Furthermore, copy of the notification received by WIPO must be attached to the abovementioned request to the Italian Patent and Trademark Office.

(ii) Authority to which such request for review or appeal should be made:

The holder of the registration may, through a representative appointed according to article 201, submit his objections to the present refusal to *Ufficio Italiano Brevetti e Marchi – Divisone II Affari Giuridici e Normativi - Via Molise, 19 – 00187 ROMA - ITALY*.

(iii) Indications concerning the appointment of a representative:

Where the applicant is not established or domiciled in one of the Member States of the European Economic Area, he can submit his observations only through professional representatives whose names appear on the list maintained for this purpose by the Italian Patent and Trademark Office (see: www.ordine-brevetti.it) or legal practitioners admitted to the Bar Association (see: www.ordineavvocati.it) - (art. 201 - Industrial Property Code).

X. Date of the notification of provisional refusal: **14/02/2022**

Prot. N.: **40004**

XI. Signature or official seal of the Office making the notification:



XII. **Corresponding essential provisions of the applicable law:**

Extract from the Code of Industrial Property Rights

(Legislative Decree of February 10th 2005, n.30)

Art.3 - Treatment of foreigners.

1. Nationals of each Country that is a party to the Paris Convention for the Protection of Industrial Property, Stockholm text of 14 July 1967, ratified by Law No. 424 of 28 April 1976, or the World Trade Organization, and nationals of Countries not parties to those Conventions, but who are domiciled or have an actual industrial or commercial establishment in the territory of a Country that is a party to the Paris Convention for the Protection of Industrial Property, shall be apply, for the matters under this Code, the same treatment applied to Italian nationals. In matters concerning new plant varieties, the treatment applied to Italian nationals shall be apply to nationals of a Country that is a party to the International Union for the Protection of New Varieties of Plants (UPOV), Geneva text of 19 March 1991, ratified by Law No. 110 of 23 March 1998. Concerning topographies of semiconductor products, the treatment applied to Italian nationals shall be apply to nationals of another Country only if the protection applied by that Country to Italian nationals is analogous to that provided for by this Code.

2, 3, 4 and 5 (omissis)

Art. 7 – Subject Matter of Registration

1. A trademark may consist of any sign, and in particular words, including personal names, designs, letters, numerals, sounds, the shape of a goods or of their packaging, the color combinations or tones, provided that such signs are capable:

a) of distinguishing the goods or services of one undertaking from those of other undertakings, and

b) of being represented on the 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.

Art. 8 - Portraits of person, names and well known signs

1. Portraits of person shall not be registered as trademarks without their consent, and after their death, without the consent of the spouse and children; if there are no such relatives or after their death, of the parents and other ancestors, and if there are no such ancestors or after their death, of the relatives up and including the fourth degree.

2. The names of persons other than those who apply for registration may be registered as trademarks, provided that their use is not such as to harm the reputation, esteem or dignity of those who have the right to bear those names. The Italian Patents and Trademarks Office shall however have the right to make the registration conditional upon the consent as set forth in paragraph 1. In any event, the registration shall not prevent persons having the right to the name to use in the business chosen by them, if the requirements are met as set forth in Article 21, paragraph 1.

3. If well known, the following may be registered or used as trademarks only by the qualified person, or with the consent of the same, or of the persons indicated in paragraph 1: names of persons, signs used in the fields of art, literature, science, politics or sports, the designations and abbreviations of events and those of entities and associations without economic purposes, as well as the characteristic emblems of the same.

Art. 9 – Shape trademarks

1. Signs shall not be registered as trademarks if they consist exclusively of :

a) the shape, or another characteristic, which results from the nature of the goods themselves;

b) the shape, or another characteristic, of goods which is necessary to obtain a technical result;

c) the shape, or another characteristic, which gives substantial value to the goods.

Art. 10 – Coats of arms

1. Coats of arms and other signs considered in existing international conventions on the subject matter, in the cases and the conditions mentioned therein, as well as the signs containing symbols, emblems and coats of arms which are in the public interest including signs referable to the forces of public order and armed forces and the names of the States and Italian territorial public bodies shall not be registered as trademarks, unless the consent of the competent authorities to their registration has been given.

1-bis. Words, figures or signs which cause harm to the image or reputation of Italy cannot be registered.

2. If a trademark contains words, figures or signs with political meaning or a highly symbolic value, or containing heraldic elements, before registration, the Italian Patents and Trademarks Office shall send the copy of the trademarks and whatever else may be necessary to the relevant or competent public administrations, to receive their opinion, in accordance with the provisions of paragraph 4.

3. The Italian Patents and Trademarks Office may act in accordance with provisions of paragraph 2 in all cases where there is a doubt that trademark could be contrary to the law, the public policy or accepted principles of morality.

4. If the relevant or competent administration, referred to paragraphs 2 and 3, gives adverse opinion to the registration of the trademark, the Italian Patents and Trademarks Office shall reject the application.

Art.11 - Collective mark.

1. Legal persons governed by public law and the associations of manufacturers, producers, suppliers of services or traders, excluding the companies referred to in the Book V, Title V, Chapter V, VI and VII of the Italian Civil Code, may obtain the registration of collective marks and may grant the use of them to producers or traders.

2. The regulations governing use of the collective marks, including controls and relative sanctions, must be attached to the application for registration in accordance with the requirements of article 157, paragraph 1-bis; modifications to the regulations must be communicated by the owners to the Italian Patent and Trademark Office to be included in the files referred to in Article 185.

3. The provisions of paragraphs 1 and 2 shall apply to foreign collective marks registered in the Country of origin.

4. By way of derogation from Article 13, paragraph 1, signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute collective mark.

Any person whose products or services come from the designated geographical area has the right both to use the mark and to become a member of the association which is the proprietor of the mark, provided that all the requirements of the regulation are met.

In this case the Italian Patent and Trademark Office may refuse the registration, by a grounded decision, when the marks requested could create situations of unjustified privilege or cause harm to the development of analogous initiatives in the same region. The Italian Patent and Trademark Office may consult the relevant or competent public administrations, categories or bodies. The registration of a collective mark consisting of a geographical name shall not entitle the proprietor to prohibit third parties from using in the course of trade such signs, provided that he uses them in accordance with the principles of professional ethics.

5. Collective marks are subject to all other provisions of this Code to the extent of which do not contrast with their nature.

Art. 11bis - Certification mark

1. Any natural or legal person, including institutions, authorities and bodies accredited in matters of certification, in order to guarantee the origin, nature or quality of certain products or services, may apply for certification marks provided that such person does not carry on a business involving the supply of goods or services of the kind certified.

2. The regulations governing use of the certification marks, including controls and relative sanctions, must be attached to the application for registration in accordance with the requirements of article 157, paragraph 1-ter; modifications to the regulations must be communicated by the owners to the Italian Patent and Trademark Office to be included in the files referred to in Article 185.

3. The provisions of paragraphs 1 and 2 shall apply to foreign certification or guarantee marks registered in the Country of origin.

4. By way of derogation from Article 13, paragraph 1, signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute certification mark.

In this case the Italian Patent and Trademark Office may refuse the registration, by a grounded decision, when the marks requested could create situations of unjustified privilege or cause harm to the development of analogous initiatives in the same region. The Italian Patent and Trademark Office may consult the relevant or competent public administrations, categories or bodies. The registration of a certification mark consisting of a geographical name shall not entitle the proprietor to prohibit third parties from using in the course of trade such signs, provided that he uses them in accordance with the principles of professional ethics.

5. Certification marks are subject to all other provisions of this Code to the extent of which do not contrast with

their nature.

Art.12 – Novelty

1.Signs shall not be registered as trademarks if, on the filing date of the application, any of the following applies:

a) (omissis);

b) (omissis);

c) They are identical to a trademark already registered by others in the Country or having effect in the Country following an application filed on an earlier date or having effect from an earlier date due to a right of a priority or a valid claim of seniority for identical goods or services;

d)They are identical or similar to a trademark that has already registered by others in the Country or having effect in the Country following an application filed on an earlier date or having effect as from an earlier date due to a right of priority or a valid claim of seniority for goods and services that are identical or similar, if due to the identity or similarity between the signs and the identity or similarity between the goods or services there exists a likelihood of confusion on the part of the public, than can also consist of a likelihood of association between the two signs:[...]

e);f); 2. and 3. (omissis)

Art. 13 – Distinctive character

1.Signs which are devoid of any distinctive character shall not be registered as trademarks. These include:

a) trade marks which consist exclusively of signs which have become customary in the current language or in the established practices of the trade;

b) trade marks which consist exclusively of general designations of goods or services or descriptive indications which refer to them, such as of signs 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 service.

2. By way of derogation from paragraph 1, signs which have acquired a distinctive character prior to application for registration, as a consequence of the use which has been made of it, may be registered as trademarks.

3. and 4. (omissis)

Art. 14 – Lawfulness and third- party rights

1.The following shall not be registered as trademarks:

a) signs which are contrary to the law, public policy or to accepted principles of morality;

b) signs which are of such a nature as to deceive the public, in particular as to the geographical origin, nature or quality of the goods or services.

c) (omissis)

c-bis) Signs which are excluded from registration, pursuant to the European Union legislation or national law or to international agreements to which the Union or the State is party, providing for protection of designations of origin and geographical indications;

c-ter) signs which are excluded from registration pursuant to the European Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine;

c-quater) signs which are excluded from registration pursuant to the European Union legislation or international agreements to which the Union is party, providing for protection of traditional specialities guaranteed;

c-quinquies) Signs which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with the European Union legislation or national law, or international agreements to which the Union or the State is a party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species.

1. bis and 2. (omissis)

Art. 17 - International Registration

1. The provisions in force pursuant to the international conventions have to be respected with regard to the registration of trademarks on the World Intellectual Property Organization (WIPO).

2. International trademarks registered on the World Intellectual Property Organization (WIPO) of Geneva, based on the Madrid Agreement concerning the International Registration of Marks, Stockholm text of 14 July 1967, ratified by law no.424 of 28 April 1976, and the respective Protocol, adopted in Madrid on 27 June 1989, ratified by law no.169 of 12 March 1996, designating Italy as the country in which protection is requested, have to meet the requirements set for national trademarks by this Code.

3. The Italian Patent and Trademark Office carries out the examination of the international trademarks designating Italy in compliance with the provisions applied to applications for national trademarks.

Art. 135 – Board of Appeal

1. An appeal may be filed to the Board of Appeal against decisions of the Italian Patent and Trademark Office that totally or partially reject an application or request, refuse registration or prevent the recognition of a right, and in the other cases provided for by this Code.

Art. 136 –Lodgement of appeals

The appeal must be notified, under penalty of inadmissibility, to the Italian Patent and Trademark Office and to at least one of the interested parties to whom the act directly refers within the mandatory term of 60 days from

the date on which the interested party received the communication or has knowledge of the contested act or, with regard to the documents for which individual communication is not required, from the day on which the deadline for publication has expired, if this is required by law or regulation, except the obligation to integrate with further notifications to the other interested parties, if ordered by the Board of Appeal.

Art. 170 – Examination of applications

1. The examination of applications which have been found to meet the formal requirements is aimed at determining:

a) for trademarks: if Article 11 may be applied when collective marks are involved or if 11-bis may be applied when certification marks are involved; if the word, design or sign can be registered as a trademark pursuant to Articles 7, 8, 9, 10, 13, paragraph 1 and 14, paragraph 1, letters a), b), c-bis), c-ter), c-quater) and c-quinquies); if the conditions indicated in Article 3, paragraph 1, are met.

b) (omissis)

Art. 171 - Examination of the International trademarks

1. The Italian Patent and Trademark Office carry out the examination of international trademarks designating Italy in accordance with the rules relating to national trademarks, pursuant to Article 170, paragraph 1, letter a).

2. If the Italian Patent and Trademark Office deems that the trademark shall not be registered in full or in part, or if an opposition has been filed by third parties pursuant to Article 176, the Office shall proceed pursuant to Article 5 of the Madrid Agreement for the International Registration of Marks, Stockholm text of 14 July 1967, ratified by Law no. 424 of 28 April 1976 or the respective Protocol of 27 June 1989, ratified by Law No. 169 of 12 March 1996, to issue a provisional refusal of the international registration and gives notice to the World Intellectual Property Organization.

3. The provisional refusal under paragraph 2 is issued within one year for international registrations based on the Madrid Agreement for the International Registration of Marks, and within eighteen months for those based on the respective Protocol. The terms start on the dates respectively specified in the above-mentioned International Conventions.

4. If a provisional refusal is issued, the protection of the trademark shall be the same of a trademark application filed at the Italian Patent and Trademark Office.

5. Within the mandatory term set out by the Italian Patent and Trademark Office, the owner of an international registration, for which a provisional refusal has been communicated to the World Intellectual Property Organization, through an attorney appointed in accordance with Article 201, may submit his own arguments, or request a copy of the opposition paper based on which the provisional refusal was issued. In the latter case, if the owner of the international registration requests a copy within the required period, the Office shall send the notice to the parties as Article 178, paragraph 1, and apply the other rules on the opposition proceeding set forth by Articles 178 et seq.

6. If within the term indicated in paragraph 5, the owner of the international registration does not submit his arguments, or does not request a copy of the opposition paper in accordance with the prescribed rules, the Italian Patent and Trademark Office shall issue the final refusal.

7. The Italian Patent and Trademark Office shall notify to the World Intellectual Property Organization the final decisions relating to international trademarks designating Italy.

8. 9. and 10. (omissis)

Art. 201 – Representation

1.2.3. (omissis)

4. The appointment may be granted only to attorneys registered on a specific Register established for this purpose to the Council of the Industrial Property Consultants Institute.

4-bis. Citizens of the European Union authorized to practice the same profession in one of the Member State can be registered in the Register according to the procedures set out in Legislative Decree 9 November 2007, no. 206.

5. (omissis)

6. The appointment may also be granted to a lawyer admitted to the Bar Association.