

**Notification of provisional refusal of protection based on an opposition  
(Article 5 of the Madrid Protocol and Rule 17(1) and (2) of the Regulations under the  
Protocol relating to the Madrid Agreement and Article 78 EUTMDR)**

Alicante, 11/02/2025

*International registration No:* **1809275**

*Date of notification to EUIPO:* **12/09/2024**

*Trade mark:* **PROTEX**

*Holder:* **Protex International Limited  
Room 505, Yuanrong Development Center,  
260-1 Xicheng Road,  
Liangxi District,  
Wuxi City  
Jiangsu Province  
China**

*Opposition number:* **B 003225865**

Protection of the abovementioned mark is provisionally refused for the European Union.

The provisional refusal is based on the fact that an opposition has been filed against the international registration.

The Office has notified the opposition separately to the holder of the international registration, including all evidence on which it is based, pursuant to Article 6(1) EUTMDR.

The notification sets a time limit of two months (including relevant notification offset) starting on the day the Office issues the notification, that is until **21/04/2025** for the holder to appoint a representative within the meaning of Article 120(1) EUTMR. Protection of the international registration designating the European Union will be refused in its entirety if the holder fails to appoint a representative within the time limit. In addition, the notification opens an (extendable) cooling-off period, a further period for the opponent to substantiate the opposition and a period for the holder of the international registration to submit observations.

I. The grounds for opposition are as follows.

Conflict with an earlier mark because of likelihood of confusion (Article 8(1)(b) EUTMR);

II. Name and address of the opposing party:

**RICARDO SALUSTIANO MARTINO MARTINEZ  
C/ GENERAL ORAA, 18. 2-6**

**28006 MADRID**  
**Spain**

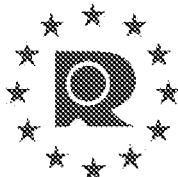
Name and address of the representative:

**Onofre Indalecio Sáez Menchón**  
**Gran Via, 69 -4º Of. 412**  
**28013 Madrid**  
**Spain**

III. The opposition is based on a mark which was the subject of an application or registration.

- type of mark : **National Trade Mark Registration**
- filing date, registration date and, if applicable, priority date: **17/08/2023 - 21/03/2024**
- filing number and, if different, registration number: **ES M4228799**
- reproduction of the mark: (see annex)
- list of goods on which the opposition is based: (see annex)

IV. The provisional refusal relates to all the goods covered by the designation of the European Union.



**GROENEVELD, Macarena**

Enclosures

Fecha consulta: 20/09/2024 09:33:24

Marca nacional M4228799(5) - PROTEX CONSTRUCTION

**Prote**  
**Construction** **X**

Fecha Presentación: 17/08/2023 A LAS 14:41 EN INTERNET

Fecha presentación solicitud otorgada: 17/08/2023

Fecha inicio plazo de 5 años para uso efectivo (art.39 LM): 02/05/2024

Tipo: Figurativa Estado: En vigor

Solicitante / Titular:

Nombre: RICARDO SALUSTIANO MARTINO MARTINEZ  
Dirección: C/ GENERAL ORAA, 18 2 -6  
Localidad: MADRID  
Provincia: Madrid  
Código Postal: 28006  
País de residencia: (ES) ESPAÑA

Representante:

Nombre: ONOFRE INDALECIO SAEZ MENCHON  
Dirección: C/ Gran Vía, 89- 4º Of. 412  
Localidad: Madrid  
Provincia: Madrid  
Código postal: 28013

**Clasificación de Viena:**

27.05.09 27.05.10 27.05.17

**Clases y productos / servicios o actividades solicitados:**

37 IMPERMEABILIZACIONES; IMPERMEABILIZACION DURANTE LA CONSTRUCCION; IMPERMEABILIZACION DE EDIFICIOS

**Clases y productos / servicios o actividades concedidos:**

Los solicitados.

**Actos de tramitación:**

Fecha	Acto de tramitación
27/10/2023	COMUNICACION A TITULARES DERECHOS ANTERIORES (ART. 18,4LM): M2946276
08/11/2023	PUBLICACION DE SOLICITUD
01/04/2024	PUBLIC. CONCESION DE F. RESOL. 21/03/2024

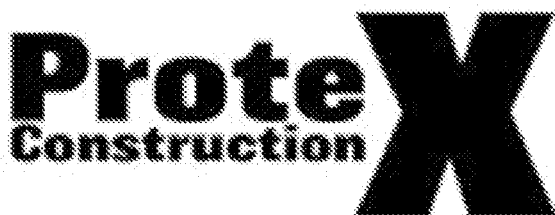


Oficina Española  
de Patentes y Marcas



Consulta de  
Expedientes  
OEPM

## National mark M4228799(5) - PROTEX CONSTRUCTION



**Filing date:** 17/08/2023 TO 14:41 IN INTERNET

**Application submission date granted:** 17/08/2023

**Start date 5-year period for effective use (art.39 LM) 02/05/2024**

**Mark Type:** FIGURATIVE **Status:** In force

**Applicant / Owner:**

**Name:** RICARDO SALUSTIANO MARTINO MARTINEZ

**ADDRESS:** C/ GENERAL ORAA 18, 2-6

**LOCALITY:** MADRID

**PROVINCE:** MADRID

**POSTAL CODE:** 28006

**COUNTRY OF RESIDENCE:** (ES) SPAIN

**Representative:**

**NAME:** ONOFRE INDALECIO SAEZ MENCHON

**ADDRESS:** C/ GRAN VÍA, 69 - 4º OF. 412

**LOCALITY:** MADRID

**PROVINCE:** MADRID

**POSTAL CODE:**28013

**Vienna Classification:**

27.05.09 27.05.10 27.05.17

**Classes and goods / services or activities requested:**

37 Application of waterproof linings; Building sealing; Building sealing

**Classes and products / services or activities granted:**

THE CLAIMED

**Acts of processing:**

<b>Date</b>	<b>Act performed</b>
27/10/2023	COMMUNICATION TO HOLDERS OF PREVIOUS RIGHTS (ART.18.4) M2946276
06/11/2023	PUBLICATION OF THE APPLICATION
01/04/2024	PUBLICATION OF THE GRANTING, RESOLUTION DATED 21/03/2024

# 1. LEGAL BASIS OF OPPOSITION.

In accordance with the terms of article 4 of the REGULATION (EU) 2017/1001 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 14 June 2017 on the European Union trade mark, the following claim is hereby made within the period specified in opposition to the application for the IR trademark which is set out in the terms of the opposition, and which has been requested to distinguish goods in class 19, based on the following arguments:

*Article 4 of the aforesaid Regulation establishes:*

*“A EU trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals . . . provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings”*

It is evident that the sign “PROTEX” contained in the IR trademark application n° 1809275 the object of this opposition does not comply with the above-mentioned requirements, given that the sign is neither appropriate nor capable of distinguishing the goods of the applicant in class 19, from the services of my client due to the clear similarity in terms of the name, phonetics and application with the previously registered Spanish National Trade Mark n° 4228799 PROTEX CONSTRUCTION, therefore the application should be denied.

Moreover, article 8.1 of REGULATION (EU) 2017/1001 establishes that:

*Upon opposition by the proprietor of an earlier trademark, the trademark applied for shall not be registered:*

*(b) if because of its identity with or similarity to the earlier trademark and the identity or similarity of the goods or services covered by the trademarks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trademark is protected; the likelihood of confusion includes the likelihood of association with the earlier trademark”.*

As indicated previously, my client is the proprietor of the earlier Spanish National Trade Mark mentioned, which is similar to the application challenged and accordingly falls within the above-mentioned article 8.1.b) as a sign capable of preventing the registration of and application for a IR trademark by way of opposition on the part of its proprietor.

Indeed, article 8.2 of the cited Council Regulation establishes that:

*“2. For the purposes of paragraph 1, “Earlier trademarks” means:*

*(a) trademarks with a date of application for registration which is earlier than the date of application for registration of the European Union trade mark, taking into account, where appropriate, priority rights claimed in respect of those trademarks, and which fall within the following categories:*  
*iii) trademarks registered in a Member State”.*

## **2. PRIOR RIGHTS OF THE OPPOSING PARTY.**

As is specified in the terms of the opposition, and in the archives and official records of the Spanish Patents and Trademark Office, my client is the proprietor, among others, of the registered Spanish National Trademark detailed below:

- Spanish National Trademark nº 4228799 PROTEX CONSTRUCTION (class 37), applied for on 17/08/2023, granted and currently in force to distinguish:

*NICE CLASSIFICATION 37 APPLICATION OF WATERPROOF LININGS; BUILDING SEALING; BUILDING SEALING*

Accordingly, the Spanish National Trademark is included within the terms of the above-mentioned article 8.2, the effect of which is the rejection of the application for registration of the EUTM trademark.

## **3. EXTENT OF THE OPPOSITION.**

As indicated in the terms of the opposition, it is filed in relation to the all goods included in the EUTM trademark application challenged in class 19, more specifically:

*NICE CLASSIFICATION 19 WOODEN FLOORING; RESIN COMPOSITE PLYWOOD; RUBBER FLOORING; BUILDING MATERIALS, NOT OF METAL; PARQUET FLOORING; FLOORS, NOT OF METAL; FLOOR BOARDS OF PLASTIC; VENEERED PLYWOOD; REFRACTORY CONSTRUCTION MATERIALS, NOT OF METAL; VINYL FLOOR.*

## 4. EXISTENCE OF A LIKELIHOOD OF CONFUSION BETWEEN THE MARKS.

As is indicated above, the opposing mark complies with the requirements established in article 8.1 to prevent the registration of the EUTM Trademark application challenged given that, as can be seen, there is a significant similarity between the two names and they are used to distinguish similar goods and services.

### A) Similarity of names, phonetics and concept.

In accordance with the ruling of the European Community Court of Justice, “with regard to the graphic, phonetic or conceptual similarity between the marks in conflict, the Court must focus on the overall impression made by the respective signs, particularly taking into consideration their principal distinctive elements” (Judgment of the Court of Justice, case C-251/96 Sabel BV v Puma AG Rudolf Dassler Sport (1997) DO OAMI 1/98, p. 91, paragraph 22 et seq.)

The signs which must be compared are as follows:

CHALLENGED TRADEMARK

OPPOSING TRADEMARK



**PROTEX**



**Prote**  
Construction **X**

Before comparing the two marks, it must be taken into account that the earlier trademark is registered in Spain, and that the goods and services in relation to which there could be a likelihood of confusion are aimed at the public in general, and as such the reference consumer is the average Spanish consumer and what must be considered is the impression produced in relation to such persons, and its meaning and pronunciation in Spanish.

It should be noted that in the appreciation of composite marks, the element which has the greatest impact on the consumer is generally the denomination, because the consuming public does not usually closely examine signs and tends to refer to the same by their verbal element (this being the easiest way to refer to a specific mark).

In accordance with the abovementioned general principle, it can be concluded that the principal element of the previously existing mark is “**PROTEX**”, and that of the requested mark is “**PROTEX**”.

As can be seen, visually the two signs coincide insofar that the principal element of the requested mark is fully integrated within the previously existing mark.

Consequently, considering the importance of the visual and phonetic coincidences between the two opposing signs, a similar overall impression can be said to be generated.

Precisely this likelihood of confusion is what the EU Trademark Regulation intends to prevent, not only because it is established in this manner in Article 8.1., but also because it presides the philosophy of said Regulation, which in the Preamble states, in paragraph 8:

*Whereas the protection afforded by a EU Trade Mark, the function of which is in particular to guarantee the trademark as an indication of origin...; whereas the protection applies also in cases of similarity between the mark and the sign, .... whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trademark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trademark and the sign and between the goods or services..."*

## **B) Similarity of application.**

To the name similarities of the trade marks in conflict it is necessary to add the goods and services covered by both of them, without a doubt producing confusion amongst the consumers, not being able to distinguish the ownership or business origin. This constitutes another important and essential argument.

In effect, the mark challenged distinguishes:

*NICE CLASSIFICATION 19 WOODEN FLOORING; RESIN COMPOSITE PLYWOOD; RUBBER FLOORING; BUILDING MATERIALS, NOT OF METAL; PARQUET FLOORING; FLOORS, NOT OF METAL; FLOOR BOARDS OF PLASTIC; VENEERED PLYWOOD; REFRACTORY CONSTRUCTION MATERIALS, NOT OF METAL; VINYL FLOOR.*

As can be seen, the goods referred to are directly related to the services covered by the opponent trademark:

*NICE CLASSIFICATION 37 APPLICATION OF WATERPROOF LININGS; BUILDING SEALING; BUILDING SEALING*

From examining the mentioned goods, with the services protected by the earlier trademark, it is evident that they are of the same nature, they have identical end users and they are used in the same manner, thus they compete with each other.

*To this end, the Court declared in the Canon judgement that to appreciate the similarity existing between the designated goods it is necessary to take into account all the pertinent factors that characterises the relationship existing between the goods: their nature, their destination (identical or similar use), their use, complementary goods and services and competing/interchangeable goods or services (satisfaction of an identical or similar demand)*

It should be taken into account that all these goods and services are aimed at the general public and are mutually complementary due to the close connection existent between them, and that users may therefore be led to believe that the company responsible for manufacturing all these goods is one and the same.

This impression is further reinforced because the goods are offered together through the same distribution channels and can be acquired at the same sales outlets.

We must insist that the services protected by the opposing mark involve a wide range of goods which should be treated as an indivisible whole containing goods similar to those of the applicant.

## **5. ASSESSMENT OF THE RISK OF CONFUSION/ INTERDEPENDENCE BETWEEN SIMILARITY OF NAMES, PHONETICS AND APPLICATION**

The above statements clearly show that the marked denominative and phonetic similarity of the signs in conflict, and their applicative relation, give rise to the existence of a considerable likelihood of confusion amongst consumers.

To this end, Article 8.1.b) of Council Regulation is brought to the attention of the Opposition Division:

*“The likelihood of confusion includes the likelihood of association with the earlier trademark”*

In this case there is no doubt whatsoever regarding the existence of a high likelihood of association by consumers, who will believe that these phonetically and denominatively similar signs for related goods will have the same business origin.

It is necessary to highlight that the Opposition Division, in Resolution NO.57/1998 dated the 6<sup>th</sup> of August 1998, made a more detailed interpretation of the likelihood of confusion through the likelihood of association, allowed by the EU Trade Mark Regulation, establishing in this sense the following:

*“... the likelihood of confusion also includes cases in which the public, rather than confusing the trademarks directly, attributes to the proprietor of the earlier trademark an element contained in both trademarks. Elements of the trademark that are different are simply seen by the public as a characterisation of certain products or groups of products of the holder of the earlier trademark. The public considers that the products bearing the new trademark are originated in the same undertaking”.*

On the other hand, it is necessary to bear in mind the jurisprudence of the Supreme Courts of Justice of the European Communities, according to which when analysing the likelihood of confusion between two trademarks it is necessary to bear in mind the **INTERDEPENDENCE** existing between the similarity of the goods that the trademarks intend to distinguish and the similarity between the signs, so that **a lesser similarity between the goods and services that the trademarks intend to distinguish can be compensated by a greater similarity between the opposed signs, and vice versa.**

By way of example, it is possible to highlight the Judgment handed down on the 29th of September 1996 by the Courts of Justice of the European Communities, in the matter C-39/97: Canon Kabushiki Kaisha vs. Metro-Goldwyn-Mayer, Inc., which states the following in paragraph 17:

*“The overall appraisal of the likelihood of confusion implies a clear interdependence between the elements taken into account and, in particular, the similarity between the trademarks and that existing between the designated products or services. Thus, a low degree of similarity between the designated goods or services may be compensated by a high degree of similarity between the trademarks, and vice versa. Indeed, the interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to interpret the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trademark in the market and the degree of similarity with the sign and between the designated goods or services.”*

## 6. CONCLUSIONS.

Having certified the existence of my client's rights to earlier Trademark, and in light of the marked similarity between the names, phonetics and concept of the two trademarks under consideration, together with their similarity of application, we respectfully request on behalf of our client that the IR Trade Mark application the object of this opposition be denied.

That in accordance with the terms of Article 109 EUTMR the Office expressly declare that the opposing party shall be liable to pay the fees and costs incurred by the other party which have been essential to these proceedings



Onofre I. Sáez Menchón  
Authorised representative no. 40.345

**General Authorisation**  
 **Individual Authorisation**

Representative's reference No. 40345

**I / We**

**Name/s**

ID No. of authorisator/s **RICARDO SALUSTIANO MARTINO MARTINEZ**

**Address**

Street and house number or  
equivalent **C/ GENERAL ORAA 18, 2ºB**  
City and postal code **28005 MADRID**  
Country **SPAIN**  
Telephone number/s  
Telefax number/s

**do hereby authorise**

**Nature of  
representative**

- Professional representative  
No. on the list of professional  
representatives \_\_\_\_\_  
 Legal practitioner  
 Association of representatives  
 Employee

**Name of representative or  
association of representatives**

**ONOFRE INDALECIO SAEZ MENCHON**

**Address (piece of business)**

Street and house number or  
equivalent **C/ GRAN VIA 69-4º OF 412**  
City and postal code **28013 MADRID**  
Country **ESPAÑA**  
Telephone number/s **+34 915220031**  
Telefax number/s **+34 915235341**

**to represent me/us before the European Union Intellectual Property  
Office**

**General authorisation**  in all proceedings as applicant or proprietor in relation to all present or future European trade  
mark applications or registrations, as well as in all other proceedings before the Office  
**Individual authorisation**  in the following proceedings

**Sub-authorisation**

may be given  may not be given

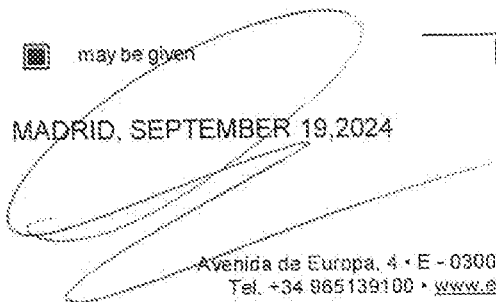
**Signature/s**

Place and date

Signature

Name of person/s signing

**MADRID, SEPTEMBER 19, 2024**



Alicante, 22/10/2024

Onofre Indalecio Sáez Menchón  
Gran Vía, 69 -4° Of. 412  
28013 Madrid  
Spain

### Receipt of notice of opposition

<i>Number of the opposition:</i>	003225865
<i>Your reference:</i>	OPPO1809275PROTEX
<i>Trade mark:</i>	W01809275
<i>Opponent:</i>	RICARDO SALUSTIANO MARTINO MARTINEZ C/ GENERAL ORAA, 18. 2-6 28006 MADRID Spain

Your notice of opposition, directed against the abovementioned trade mark, was received by the Office on **22/10/2024 at 09:18:56** .

It was given the above opposition number.

**Please quote this number in all future communications regarding the opposition.**

Please note that EUIPO will not send an invoice.

**Operations Department**

#### Thank you for filing online

Our online services make it easier for you to file your notice of opposition, send attachments and spot any mistakes. Filing online is also quicker and safer than using fax or post, as you can be sure your notice of opposition reaches EUIPO instantly via our secure servers.

Date of receipt (DD/MM/YYYY) 22/10/2024	Number of pages (including this one) 4
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### Acknowledgement of receipt of a Notice of opposition

Your notice of opposition has been submitted successfully.  
We thank you for choosing to use the online OPPOSITION form.

Opposition number:	003225865
Date of submission:	22/10/2024
Time of submission:	09:18
Number of attached files:	4
Payment method:	Credit card
Payment ID number:	24EWRCH1

Please indicate the opposition number in any further communication with the EUIPO.

## NOTICE OF OPPOSITION

Your reference:

OPPO1809275PROTE  
X

<b>Opponent(s)</b>	Opponent EUIPO ID: <span style="border: 1px solid black; padding: 2px;">1691110</span>
Name of legal entity or first name and surname:	RICARDO SALUSTIANO MARTINO MARTINEZ
Type:	Natural Person
Street address:	C/ GENERAL ORAA, 18. 2-6
City:	MADRID
Postal Code:	28006
Country:	Spain
Postal address (if different):	
Telephone number:	
E-mail address:	
Website:	

<b>Representative(s)</b>	EUIPO representative ID: <span style="border: 1px solid black; padding: 2px;">40345</span>
Name or legal name:	Onofre Indalecio Sáez Menchón
Type:	Lawyer
Street address:	Gran Via, 69 -4° Of. 412
City:	Madrid
Postal Code:	28013
Country:	Spain
Postal address (if different):	Onofre Indalecio Sáez Menchón Gran Via, 69 -4° Of. 412 E-28013 Madrid Spain
Telephone number:	915220031
E-mail address:	onofre@saezbenitoabogados.es
Website:	

<b>Challenged entity</b>	Challenged registration ID: <span style="border: 1px solid black; padding: 2px;">W01809275</span>
Type of entity	IR
Name of the owner/holder:	Protex International Limited
Designation date:	31/05/2024
Representation of the trade mark	PROTEX
Trade mark type	Figurative
Representation of mark	PROTEX

<b>Language of proceedings</b>	<input checked="" type="checkbox"/> First language: EN (English) <input type="checkbox"/> Second language: FR (French)
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<b>Extent of the application</b>	<input checked="" type="checkbox"/> Against all the goods and services <input type="checkbox"/> Against some of the goods and services
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## NOTICE OF OPPOSITION

<b>Class</b>	<b>Goods and services</b>
19 (EN)	Wooden flooring; resin composite plywood; rubber flooring; building materials, not of metal; parquet flooring; floors, not of metal; floor boards of plastic; veneered plywood; refractory construction materials, not of metal; vinyl floor.

**Grounds for opposition**

**Selected ground number 1**

Article 8(1)(b) EUTMR - There exists a likelihood of confusion on the part of the public

**Basis of opposition**

Type of basis	National trade mark application/registration
Territory(ies)	Spain
Name of the owner/applicant	RICARDO SALUSTIANO MARTINO MARTINEZ
Application date	17/08/2023
Filing number	M4228799
Registration number	M4228799
Registration date	21/03/2024
Trade mark type	Figurative
Representation of the earlier right	 <p style="text-align: center;"><input type="checkbox"/> Colour(s) claimed</p>
Verbal elements	PROTEX CONSTRUCTION

The opposing party accepts that the necessary information for this trade mark is imported from the relevant online official database, accessible through TMVIEW, and that this source is used for substantiation purposes without prejudice to its right or obligation to provide any additional information that may be necessary to comply with the substantiation requirements of Article 7(2) and (4) EUTMDR

**Goods and services used as basis**  Based on all the goods and services  
 Based on part of the goods and services, namely:

<b>Class</b>	<b>Goods and services</b>
37 (EN)	Application of waterproof linings; Building sealing; Building sealing

**Entitlement**  Owner/Co-owner  Authorised licensee  
 Person authorised under the applicable law

## NOTICE OF OPPOSITION

<b>Evidence in support and translations</b>	<input checked="" type="checkbox"/> Attached consultaExterna.xhtml.pdf SITADEX INGLES.pdf		<input type="checkbox"/> To follow
<b>Arguments</b>			
<b>Uploaded File(s)</b>			
<b>Title</b>		<b>Confidential</b>	
	ALLEGATIONS.pdf	---	
<b>Title</b>		<b>Confidential</b>	
	AUTHORISATION.pdf	---	
<b>Fees</b>			
Payment method	Credit card		
Opposition of EUTM fee		320.00 €	
Total amount		320.00 €	
<b>Signature</b>			
<b>First name and Surname</b>	<b>Capacity of the signatory</b>		
ONOFRE INDALECIO SAEZ MENCHON	Legal practitioner		

**Annexes:**

<b>Selected ground number 1</b>
consultaExterna.xhtml.pdf
SITADEX INGLES.pdf
<b>Arguments</b>
ALLEGATIONS.pdf
AUTHORISATION.pdf
<b>Annexes to Arguments (Evidence)</b>
No attachments

Fecha consulta: 20/09/2024 09:33:24

Marca nacional M4228799(5) - PROTEX CONSTRUCTION

**Prote**  
**Construction** **X**

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Fecha presentación solicitud otorgada: 17/08/2023

Fecha inicio plazo de 5 años para uso efectivo (art.39 LM): 02/05/2024

Tipo: Figurativa Estado: En vigor

Solicitante / Titular:

Nombre: RICARDO SALUSTIANO MARTINO MARTINEZ  
Dirección: C/ GENERAL ORAA, 18 2 -6  
Localidad: MADRID  
Provincia: Madrid  
Código Postal: 28006  
País de residencia: (ES) ESPAÑA

Representante:

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Los solicitados.

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01/04/2024	PUBLIC. CONCESION DE F. RESOL. 21/03/2024



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de Patentes y Marcas



Consulta de  
Expedientes  
OEPM

## National mark M4228799(5) - PROTEX CONSTRUCTION



**Filing date:** 17/08/2023 TO 14:41 IN INTERNET

**Application submission date granted:** 17/08/2023

**Start date 5-year period for effective use (art.39 LM) 02/05/2024**

**Mark Type:** FIGURATIVE **Status:** In force

**Applicant / Owner:**

**Name:** RICARDO SALUSTIANO MARTINO MARTINEZ

**ADDRESS:** C/ GENERAL ORAA 18, 2-6

**LOCALITY:** MADRID

**PROVINCE:** MADRID

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27.05.09 27.05.10 27.05.17

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**Classes and products / services or activities granted:**

THE CLAIMED

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<b>Date</b>	<b>Act performed</b>
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06/11/2023	PUBLICATION OF THE APPLICATION
01/04/2024	PUBLICATION OF THE GRANTING, RESOLUTION DATED 21/03/2024

# 1. LEGAL BASIS OF OPPOSITION.

In accordance with the terms of article 4 of the REGULATION (EU) 2017/1001 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 14 June 2017 on the European Union trade mark, the following claim is hereby made within the period specified in opposition to the application for the IR trademark which is set out in the terms of the opposition, and which has been requested to distinguish goods in class 19, based on the following arguments:

*Article 4 of the aforesaid Regulation establishes:*

*“A EU trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals . . . provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings”*

It is evident that the sign “PROTEX” contained in the IR trademark application n° 1809275 the object of this opposition does not comply with the above-mentioned requirements, given that the sign is neither appropriate nor capable of distinguishing the goods of the applicant in class 19, from the services of my client due to the clear similarity in terms of the name, phonetics and application with the previously registered Spanish National Trade Mark n° 4228799 PROTEX CONSTRUCTION, therefore the application should be denied.

Moreover, article 8.1 of REGULATION (EU) 2017/1001 establishes that:

*Upon opposition by the proprietor of an earlier trademark, the trademark applied for shall not be registered:*

*(b) if because of its identity with or similarity to the earlier trademark and the identity or similarity of the goods or services covered by the trademarks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trademark is protected; the likelihood of confusion includes the likelihood of association with the earlier trademark”.*

As indicated previously, my client is the proprietor of the earlier Spanish National Trade Mark mentioned, which is similar to the application challenged and accordingly falls within the above-mentioned article 8.1.b) as a sign capable of preventing the registration of and application for a IR trademark by way of opposition on the part of its proprietor.

Indeed, article 8.2 of the cited Council Regulation establishes that:

*“2. For the purposes of paragraph 1, “Earlier trademarks” means:*

*(a) trademarks with a date of application for registration which is earlier than the date of application for registration of the European Union trade mark, taking into account, where appropriate, priority rights claimed in respect of those trademarks, and which fall within the following categories:*  
*iii) trademarks registered in a Member State”.*

## **2. PRIOR RIGHTS OF THE OPPOSING PARTY.**

As is specified in the terms of the opposition, and in the archives and official records of the Spanish Patents and Trademark Office, my client is the proprietor, among others, of the registered Spanish National Trademark detailed below:

- Spanish National Trademark nº 4228799 PROTEX CONSTRUCTION (class 37), applied for on 17/08/2023, granted and currently in force to distinguish:

*NICE CLASSIFICATION 37 APPLICATION OF WATERPROOF LININGS; BUILDING SEALING; BUILDING SEALING*

Accordingly, the Spanish National Trademark is included within the terms of the above-mentioned article 8.2, the effect of which is the rejection of the application for registration of the EUTM trademark.

## **3. EXTENT OF THE OPPOSITION.**

As indicated in the terms of the opposition, it is filed in relation to the all goods included in the EUTM trademark application challenged in class 19, more specifically:

*NICE CLASSIFICATION 19 WOODEN FLOORING; RESIN COMPOSITE PLYWOOD; RUBBER FLOORING; BUILDING MATERIALS, NOT OF METAL; PARQUET FLOORING; FLOORS, NOT OF METAL; FLOOR BOARDS OF PLASTIC; VENEERED PLYWOOD; REFRACTORY CONSTRUCTION MATERIALS, NOT OF METAL; VINYL FLOOR.*

## 4. EXISTENCE OF A LIKELIHOOD OF CONFUSION BETWEEN THE MARKS.

As is indicated above, the opposing mark complies with the requirements established in article 8.1 to prevent the registration of the EUTM Trademark application challenged given that, as can be seen, there is a significant similarity between the two names and they are used to distinguish similar goods and services.

### A) Similarity of names, phonetics and concept.

In accordance with the ruling of the European Community Court of Justice, “with regard to the graphic, phonetic or conceptual similarity between the marks in conflict, the Court must focus on the overall impression made by the respective signs, particularly taking into consideration their principal distinctive elements” (Judgment of the Court of Justice, case C-251/96 Sabel BV v Puma AG Rudolf Dassler Sport (1997) DO OAMI 1/98, p. 91, paragraph 22 et seq.)

The signs which must be compared are as follows:

CHALLENGED TRADEMARK

OPPOSING TRADEMARK



**PROTEX**



**Prote**  
Construction **X**

Before comparing the two marks, it must be taken into account that the earlier trademark is registered in Spain, and that the goods and services in relation to which there could be a likelihood of confusion are aimed at the public in general, and as such the reference consumer is the average Spanish consumer and what must be considered is the impression produced in relation to such persons, and its meaning and pronunciation in Spanish.

It should be noted that in the appreciation of composite marks, the element which has the greatest impact on the consumer is generally the denomination, because the consuming public does not usually closely examine signs and tends to refer to the same by their verbal element (this being the easiest way to refer to a specific mark).

In accordance with the abovementioned general principle, it can be concluded that the principal element of the previously existing mark is “**PROTEX**”, and that of the requested mark is “**PROTEX**”.

As can be seen, visually the two signs coincide insofar that the principal element of the requested mark is fully integrated within the previously existing mark.

Consequently, considering the importance of the visual and phonetic coincidences between the two opposing signs, a similar overall impression can be said to be generated.

Precisely this likelihood of confusion is what the EU Trademark Regulation intends to prevent, not only because it is established in this manner in Article 8.1., but also because it presides the philosophy of said Regulation, which in the Preamble states, in paragraph 8:

*Whereas the protection afforded by a EU Trade Mark, the function of which is in particular to guarantee the trademark as an indication of origin...; whereas the protection applies also in cases of similarity between the mark and the sign, .... whereas the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trademark on the market, the association which can be made with the used or registered sign, the degree of similarity between the trademark and the sign and between the goods or services..."*

## **B) Similarity of application.**

To the name similarities of the trade marks in conflict it is necessary to add the goods and services covered by both of them, without a doubt producing confusion amongst the consumers, not being able to distinguish the ownership or business origin. This constitutes another important and essential argument.

In effect, the mark challenged distinguishes:

*NICE CLASSIFICATION 19 WOODEN FLOORING; RESIN COMPOSITE PLYWOOD; RUBBER FLOORING; BUILDING MATERIALS, NOT OF METAL; PARQUET FLOORING; FLOORS, NOT OF METAL; FLOOR BOARDS OF PLASTIC; VENEERED PLYWOOD; REFRACTORY CONSTRUCTION MATERIALS, NOT OF METAL; VINYL FLOOR.*

As can be seen, the goods referred to are directly related to the services covered by the opponent trademark:

*NICE CLASSIFICATION 37 APPLICATION OF WATERPROOF LININGS; BUILDING SEALING; BUILDING SEALING*

From examining the mentioned goods, with the services protected by the earlier trademark, it is evident that they are of the same nature, they have identical end users and they are used in the same manner, thus they compete with each other.

*To this end, the Court declared in the Canon judgement that to appreciate the similarity existing between the designated goods it is necessary to take into account all the pertinent factors that characterises the relationship existing between the goods: their nature, their destination (identical or similar use), their use, complementary goods and services and competing/interchangeable goods or services (satisfaction of an identical or similar demand)*

It should be taken into account that all these goods and services are aimed at the general public and are mutually complementary due to the close connection existent between them, and that users may therefore be led to believe that the company responsible for manufacturing all these goods is one and the same.

This impression is further reinforced because the goods are offered together through the same distribution channels and can be acquired at the same sales outlets.

We must insist that the services protected by the opposing mark involve a wide range of goods which should be treated as an indivisible whole containing goods similar to those of the applicant.

## **5. ASSESSMENT OF THE RISK OF CONFUSION/ INTERDEPENDENCE BETWEEN SIMILARITY OF NAMES, PHONETICS AND APPLICATION**

The above statements clearly show that the marked denominative and phonetic similarity of the signs in conflict, and their applicative relation, give rise to the existence of a considerable likelihood of confusion amongst consumers.

To this end, Article 8.1.b) of Council Regulation is brought to the attention of the Opposition Division:

*“The likelihood of confusion includes the likelihood of association with the earlier trademark”*

In this case there is no doubt whatsoever regarding the existence of a high likelihood of association by consumers, who will believe that these phonetically and denominatively similar signs for related goods will have the same business origin.

It is necessary to highlight that the Opposition Division, in Resolution NO.57/1998 dated the 6<sup>th</sup> of August 1998, made a more detailed interpretation of the likelihood of confusion through the likelihood of association, allowed by the EU Trade Mark Regulation, establishing in this sense the following:

*“... the likelihood of confusion also includes cases in which the public, rather than confusing the trademarks directly, attributes to the proprietor of the earlier trademark an element contained in both trademarks. Elements of the trademark that are different are simply seen by the public as a characterisation of certain products or groups of products of the holder of the earlier trademark. The public considers that the products bearing the new trademark are originated in the same undertaking”.*

On the other hand, it is necessary to bear in mind the jurisprudence of the Supreme Courts of Justice of the European Communities, according to which when analysing the likelihood of confusion between two trademarks it is necessary to bear in mind the **INTERDEPENDENCE** existing between the similarity of the goods that the trademarks intend to distinguish and the similarity between the signs, so that **a lesser similarity between the goods and services that the trademarks intend to distinguish can be compensated by a greater similarity between the opposed signs, and vice versa.**

By way of example, it is possible to highlight the Judgment handed down on the 29th of September 1996 by the Courts of Justice of the European Communities, in the matter C-39/97: Canon Kabushiki Kaisha vs. Metro-Goldwyn-Mayer, Inc., which states the following in paragraph 17:

*“The overall appraisal of the likelihood of confusion implies a clear interdependence between the elements taken into account and, in particular, the similarity between the trademarks and that existing between the designated products or services. Thus, a low degree of similarity between the designated goods or services may be compensated by a high degree of similarity between the trademarks, and vice versa. Indeed, the interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to interpret the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trademark in the market and the degree of similarity with the sign and between the designated goods or services.”*

## 6. CONCLUSIONS.

Having certified the existence of my client's rights to earlier Trademark, and in light of the marked similarity between the names, phonetics and concept of the two trademarks under consideration, together with their similarity of application, we respectfully request on behalf of our client that the IR Trade Mark application the object of this opposition be denied.

That in accordance with the terms of Article 109 EUTMR the Office expressly declare that the opposing party shall be liable to pay the fees and costs incurred by the other party which have been essential to these proceedings



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Authorised representative no. 40.345

**General Authorisation**  
 **Individual Authorisation**

Representative's reference No. 40345

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No. on the list of professional  
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**to represent me/us before the European Union Intellectual Property  
Office**

**General authorisation**  in all proceedings as applicant or proprietor in relation to all present or future European trade  
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**Individual authorisation**  in the following proceedings

**Sub-authorisation**

may be given  may not be given

**Signature/s**

Place and date

Signature

Name of person/s signing

**MADRID, SEPTEMBER 19, 2024**

