

THE PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS

Notification of provisional refusal based on opposition according to article 5 and rule 17(3)

I National office notifying the opposition:

Danish Patent and Trademark Office
Helgeshøj Alle 81
DK-2630 Taastrup
Denmark

Telephone: + 45 43 50 80 00
Telefax: + 45 43 50 80 01

II Number of the international registration subject to the opposition **868339**

III Name and address of the holder of the international registration subject to the opposition:

Deutsche Amphibolin-Werke
von Robert Murjahn Stiftung & Co KG
Roßdörfer Strasse 50
64372 Ober-Ramstadt,
Tyskland

IV Name and address of the opponent:

Akzo Nobel Coatings International B.V.
Velperweg 76
NL-6824 BM Arnhem,
Holland

V. Grounds for the opposition:

X Confusingly similar to the following mark(s) (see appendix):

X registered mark applied mark mark used in the course of trade

Lack of distinctive character Company name(s) (see appendix) Other grounds

Provisions of the Danish Trade Marks Act (enclosed): Sect. 23 cf. Sect 15

The provisional refusal affects all goods and services covered by the designation

VI Grounds on which the refusal can be based according to the provisions of the Danish Trade marks Act: Sect. 23 cf. Sect. 13, 14, 15 and 16.

VII The holder of the designation may request a review of the provisional refusal. The request must be received by the Danish Patent and Trademark Office no later than 4 months from the date of the provisional refusal. The request should be filed in Danish.

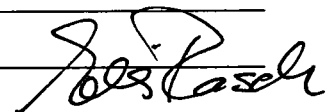
Please *note* that the opposed registration is subject to full examination by the Danish Patent and Trademark Office.

The final refusal may thus not affect all goods and services.

Please note that the final decision on the opposition can be appealed to the Danish Board of Appeal for Patents and Trademarks by either party within a period of 2 months from the date of the final decision.

VIII. Date of the provisional refusal: 6 October 2006

VIII. Signature by the Office: **The Danish Patent and Trademark Office** Ellis Rasch



CHAS.HUDE

Patent- og Varemærkestyrelsen
Helgeshøj Allé 81
2630 Tåstrup

KOPI

Chas. Hude A/S
H.C. Andersens Boulevard 33
1780 København V

Telefon +45 33 19 34 00
Telefax +45 33 19 35 00

www.chashude.com
chashude@chashude.dk
CVR-nr.: 12 93 81 79

32655054 ✓

2. oktober 2006

TELEFAX
43 50 80 01

Reg.nr.: MP 868339 ALLFACOLOR ordmærke
Indehaver: Deutsche Amphibolin-Werke von Robert Murjahn Stiftung & Co. KG
Indsiger: Akzo Nobel Coatings International B.V.
Svarfrist: 2. oktober 2006
Vores ref.: IVM 041762 CKR/PIH

Under henvisning til den internationale varemærkeregistrering nr. MP 868339 ALLFACOLOR i navnet Deutsche Amphibolin-Werke von Robert Murjahn Stiftung & Co. KG, Tyskland, skal jeg på vegne af min klient, Akzo Nobel Coatings International B.V., Holland, nedlægge

INDSIGELSE

i henhold til varemærkelovens § 23, jf. § 15, stk. 1, nr. 2, idet det gøres gældende, at indsiger har ældre rettigheder til varemærket ALPHA, jf. EU-varemærkeansøgning nr. 3491016 ALPHA.

Det gøres i denne forbindelse gældende, at indsigers varemærke ALPHA er quasi-identisk med det første led af ansøgers varemærke ALLFACOLOR, og at sidste del af ansøgers varemærke, COLOR, er direkte beskrivende for de ansøgte varer.

CHAS.HUDE

Da jeg netop har modtaget instruktioner fra min klient til at nedlægge indsigelse, og da min klient er ved at indhente materiale til støtte for den nedlagte indsigelse, skal jeg anmode om en frist på 2 måneder til at supplere indsigelsen.

Jeg ser frem til at modtage Styrelsens bekræftelse herpå.

Gebyr kr. 2.500 bedes trukket på vor konto nr. PDK 13 i henhold til aftale.

Venlig hilsen

Chas. Hude A/S



Christian Kragelund

Registerudskrift
(Extract of Register)

OHIM status: Opposition pending

(210) Sagsnummer : EU003491016

(442) EU publication date: 2004-12-06

(220) EU date of filing: 2003-10-31

(730) Indehaver : Akzo Nobel Coatings International B.V.
Velperweg 76
6824 BM
Arnhem
Holland

(740) Fuldmægtig : Annemiek Elizabeth Johanna Kadijk
(750) Adresse : Velperweg 76, P.O. Box 9300
6824 BM
Arnhem
Holland

(540) Mærke : ALPHA

(511) Klasser og : Klasse 02: Vægmaling.
varefortegnelse

(591) Farvetekst :

Udskrift slut
(End of Extract)

Guidelines on oppositions

We will deal with the opposition in two phases:

- The hearing phase during which the opponent and the proprietor through us exchange arguments and material.
- The decision phase during which we review the arguments and the material and based on that make a decision.

The hearing phase.

Both parties have the right to express their opinions. The extent of the hearing depends on the complexity of the case.

Our part in the hearing phase is to make sure that the parties get the possibility of expressing their opinions and views. We will also guide on the elements we consider relevant. There will be at least one exchange of letters as the proprietor always will be given the possibility of commenting on the opposition.

We would like to inform you that the proprietor during the opposition process has the possibility of requesting the opponent to document that the mark has been in use in accordance with the regulations of requirement of use of The Danish Trade Marks Act. According to the regulations a mark must have been in use in this country within the last five years. A CTM must have been used in one of the member states within the last five years. The mark must have been used for the goods and/or services covered by the registration. Otherwise the registration will only be considered to cover the goods and services for which use has been documented.

The material submitted to us will be available to the public according to the regulations of The Danish Access to Public Administration Files Act. The material will also be sent to the other party for comments according to the regulations of The Administration Act.

In the hearing phase both parties must reply within the time limits laid down. The time limit may be extended after a specific evaluation and will usually be one to two months.

If the parties choose to negotiate on a settlement, we will make a further extension of the time limit if we are sure that both parties agree on the extension.

When we evaluate the case to be sufficient discussed, it is ready for decision and we will send a notifying letter to the parties. The decision will be forwarded within two months from this.

The decision.

When we make the decision, we review and evaluate the arguments and the material submitted by the parties. We will also examine the case ourselves, among other things regarding previous practice.

When making the decision, we evaluate the registration as a whole and can attach importance to issues which the parties have not discussed.

We will forward a reasoned decision to both parties. The party, with whom we do not fully agree, will also be informed of the possibilities of bringing the decision before The Board of Appeal for Patents and Trademarks.

Extract from the Danish Trade Marks Act

Grounds for refusal Section 13

- (1) For a trademark to be registered it shall be of the nature referred to in section 2, including a distinctive character.
- (2) The following trademarks shall not be registered:
 - (i) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering the services or other characteristics of the goods or services;
 - (ii) trademarks which consist exclusively of signs or indications which are customarily used to designate the goods or services in the current language or in the established practices of the trade.
- (3) Irrespective of the provisions of sub-sections (1) and (2) a trademark may be registered if, before the filing of the application in consequence of the use which has been made thereof, it has acquired a distinctive character.

Section 14 Furthermore, the following shall not be registered:

- (i) trademarks which are contrary to law, public order or morality;
- (ii) trademarks which are liable to mislead the public, for instance as to the nature, quality or geographical origin of the goods or services;
- (iii) trademarks which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property, and trademarks which include badges, emblems and escutcheons which are of public interest, unless the consent of the appropriate authority to their registration has been given;
- (iv) trademarks which without permission consist of or contain an element which can be construed as a personal name or company name to which another party has a legal title, or as a portrayal provided allusion is not made to persons long dead, or which without permission contain a distinctive name of or a picture of the real property of another party;
- (v) trademarks which without permission consist of or contain an element which can be construed as a distinctive title of the protected literary or artistic work of another party or which infringe the copyright in such works or the right to a photograph of another party or the industrial property rights of another party.

Section 15

- (1) A trademark shall not be registered if:
 - (i) it is identical with an earlier trademark, and the goods or services for which the trademark is sought registered are identical with the goods or services for which the earlier trademark is protected, or
 - (ii) there exists a likelihood of confusion including a likelihood of association with the earlier trademark, because the later trademark is identical with or similar to the earlier trademark and the goods or services are identical or similar.
- (2) For the purpose of subsection (1) earlier trademarks mean:
 - (i) marks of the following categories in respect of which the date of application for registration is earlier than the date of application for registration of the trademark, taking account, where appropriate, of the priorities claimed in respect of those marks:
 - (a) Community trademarks;
 - (b) Trademarks registered in this country, or
 - (c) Trademarks registered under international agreements and having effect in this country;
 - (ii) Community trademarks which claim seniority, in accordance with the Regulation on the Community trademark, in relation to a trademark referred to under (i)b) and c), even if the latter trademark has been surrendered or has lapsed;
 - (iii) Applications for trademarks referred to under (i) and (ii), subject to their registration;
 - (iv) Trademarks which, on the date of application for registration of the trademark, or, where appropriate, of the priority claimed in respect of the application for registration of the trademark, are well known in this country, in the sense in which the words "well known" are used in Article 6bis of the Paris Convention.
- (3) A trademark shall, furthermore, not be registered if:
 - (i) it is identical with or similar to an earlier Community trademark, cf. Subsection (2) and is sought registered for goods or services which are not similar to those for which the earlier Community trademark is registered, provided that the earlier Community trademark is well known in the European Union and the use of the later trademark will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trademark;
 - (ii) it is identical with or similar to a "well known" trademark, cf. Subsection (2) (iv), and is sought registered for goods or services which are not similar to those for which the earlier trademark is well known, provided that the use of the later trademark may lead to a likelihood of association between the marks, and the use will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark, or
 - (iii) it is identical with or only insignificantly distinct from a trademark, which at the date of filing of the application for registration or, where appropriate, of the priority claimed in respect of the application for registration, has commenced to be used in another country and is still in use there for goods or services which are identical with or similar to those

for which the later trademark is sought registered, and the applicant at the date of the filing had, or should have had, knowledge of the foreign trademark.

- (4) A trademark shall moreover not be registered if:
- (i) the trademark is identical with or similar to an earlier Danish trademark within the meaning of subsection (2) and is sought registered for goods or services which are not similar to those for which the earlier trademark is registered, where the earlier trademark is well known in this country and where the use of the later trademark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark, or
 - (ii) in consequence of use in this country a right has been acquired to an identical or confusingly similar trademark or to another identical or confusingly similar sign used in the course of trade prior to the date of filing of the application for registration of the later trademark, or, where appropriate, of the priority claimed in respect of the application for registration of the later trademark, if the proprietor of the earlier right can prohibit the use of the later trademark.
- (5) A trademark shall not be excluded from registration pursuant to the provisions of subsections (1) to (4) where the proprietor of the earlier trademark or other earlier rights consents to the registration of the later trademark.

Opposition
Section 23

- (1) When the registration has been published, opposition may be filed against the validity of the registration. The opposition, which shall be reasoned, shall be filed with the Patent Office within two months from the date of publication. A fee, the amount of which shall be fixed by the Minister of Business and Industry, shall accompany the opposition.
- (2) If opposition has been filed, the Patent Office shall examine the registration in accordance with section 20. Section 28 (5) shall also apply during the examination. The proprietor of the registered right shall be notified of the opposition and be given an opportunity to submit his observations.
- (3) If the registration is maintained, the person having filed the opposition and the proprietor of the right shall be given notice hereof.
- (4) If the registration is declared void in part or in full, the decision to that effect shall be published when it is final.