



World Intellectual Property Organisation (WIPO)

International Bureau

34, chemin des Colombettes

1211 Geneva 20

Switzerland

Our Ref: OPP/71840/TS/KB

Your Ref: TM "Vespismo"

Date: 4th November 2008

Trade Marks Registry

Cardiff Road
Newport
South Wales
NP10 8QQ

Switchboard: 01633 814000
Direct Line: 01633 811013
Fax: 01633 811175
Minicom: 0645 222250
Website: www.ipo.gov.uk

Please quote our complete reference on all correspondence

Dear Sirs

**NOTIFICATION OF A TOTAL REFUSAL OF PROTECTION BASED ON AN
OPPOSITION BY THE UNITED KINGDOM INTELLECTUAL PROPERTY
OFFICE IN ACCORDANCE WITH ARTICLE 5 OF THE MADRID PROTOCOL**

RE: International Registration number : 962314
For the mark : VESPISMO
Holder of the International Registration : Gianluca Grandi
Opposition number : 71840

I must advise you that following receipt of an opposition to the above Trade Mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the Form TM7 (Notice of Opposition) that was received by the United Kingdom Trade Mark Registry.

We also attach:

Copies of the marks referred to in the statement of case.

Form TM8, for any reply to this opposition to be filed.

Form TM33 for an agent/ address for service in the United Kingdom to be appointed.



If the holder of the International Registration wishes to file a counterstatement, they must complete the attached Form TM8 and **return it to this office** together with the counterstatement 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 Form TM8 and counterstatement 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 Form TM8 can be extended for a further seven months by the filing of a Form TM9c.

The Form TM8 and counterstatement should be received on or before **4th January 2009** 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 on the attached TM33 within this two month period. If one is not provided within this time the refusal will be made final.

Yours faithfully

A handwritten signature in black ink, appearing to read "K. Brain", is written over the typed name.

Kimberley Brain

TRIBUNAL SECTION ASSISTANT CASEWORK EXAMINER

24.OCT.2008 12:41

SHP BRISTOL

VO.112 3

**Intellectual
Property
Office** ☐ ☐ ☐ ☐

For Creativity and Innovation

Form TM7

Official fee £200 due with this form

UK - IPO
BH

24 OCT 2008

RECEIVED BY FAX

J411702/ 001 D00085 TM07.....
27OCT08 200709 ACCOUNT M962314

Tribunal

29 OCT 2008

**Notice of opposition
and statement of grounds**

Please read the notes below before completing this form

1. Trade mark number.	M962314
2. Full name of the applicant, international registration holder, or registered proprietor.	Gianluca Grandi
3. Full name and address (including postcode) of the opponent.	Piaggio & C. S.p.A Viale Rinaldo Piaggio, 25 56025 Pontedera (PI) Italy
4. Name and address (including postcode) of the opponent's representative (if any).	Stevens Hewlett & Perkins 1 St Augustine's Place Bristol BS1 4UD United Kingdom
5. Are there any related proceedings currently with the Registry or the courts? If so, give application, registration or opposition number.	
6. State the date that you notified the applicant, international registration holder, or registered proprietor that you intend to oppose the trade mark application, international designation or amendment. (Please see note below)	
7. Declaration. Your signature.	I believe that the facts stated in this notice and in the attached statement of grounds are true. <i>Stevens Hewlett & Perkins</i>
Your name in BLOCK CAPITALS.	STEVENS HEWLETT & PERKINS
Date.	24th October 2008
8. Name and daytime phone number of the person we should contact in case of query.	Mr Peter W Cornford 0117 9226 007
9. Your reference.	PWC/LS/G04464
10. Number of sheets attached to this form.	This is sheet 1 of 25

Notes Number every extra sheet and say in question 10 above how many you have used.

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

Before completing this form you should read the explanatory notes available.

Rev MAY08

UK Intellectual Property Office is an operating name of the Patent Office

Page 1

Form TM7

24-OCT-2008 12:43

From: 01179105721

ID:

24. OCT. 2008 12:41

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VO. 112 2, 4

2

Use this sheet if you are basing your opposition on section 3 of the Trade Marks Act.

- ☐ 3(1)(a) It is a sign which does not satisfy the requirements of section 1(1) because:
- ☒ 3(1)(b) It is a trade mark which is devoid of any distinctive character because:
it is immature, whether by nature or nurture and incapable of
functioning to serve as a sole source indicator.
- ☒ 3(1)(c) It is a trade mark which consists 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 goods or rendering of
services, or other characteristics of goods or services because:
it is descriptive of a movement of people who like VESPA motorcycles
and VESPA merchandise/memorabilia .cf. VESPISTI
- ☐ 3(1)(d) It is a trade mark which consists exclusively of signs or indications which
have become customary in the current language or in the bona fide and
established practices of the trade because:
- ☐ 3(6) It is a trade mark which should not be registered for some or all of the goods
and services in the application as the application was made in bad faith
because:
- ☐ other State any other part of section 3 you rely on and give your grounds:
- ☐ State which of the applicant's goods or services you oppose under Section 3
grounds:
- ☒ All
- ☐ Some (please specify)

24. OCT. 2008 12:41

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VO. 112 P. 5

3

Use this sheet if you are basing your opposition on sections 5(1) or 5(2) of the Trade Mark Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☐ 5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark.
- ☐ 5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of the earlier trade mark

Number: 1529384

Is it a UK, Community or International mark? UK

Representation of the mark:

VESPA

1. What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?

- ☐ All
- ☒ Some (please specify)

Class 25:

Coats, mantles, raincoats, dresses, suits, skirts, jackets, trousers, waistcoats, shirts, t-shirts, blouses, jerseys, sweaters, blazers, cardigans, stockings, socks, underwear, corsets, nightgowns, pyjamas, bathrobes, bathing suits, sun suits, jeans, sport jackets, wind-resistant jackets, anoraks, sweatsuits, ties, neckties, scarves, shawls, foulards, caps, hats, gloves, sashes, belts; boots, shoes and slippers; all being articles of clothing; all included in Class 25.

24. OCT. 2008 12:42

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2. **Statement of use provision**— Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the opposed application?

☒ Yes ☐ No

- 3(a). If yes, and the mark has been used, for which of the goods and services listed at question 1 is use claimed?

☐ All
☐ Some (please specify)

Or,

- 3(b). If yes and the mark has not been used, please state any proper reasons for non use.

Details of the mark you are opposing

4. Which goods or services in the application do you claim are identical or similar to those covered by the earlier mark and listed at question 3 (or at question 1 if the statement of use does not apply)?

☒ All
☐ Some (please specify)

Use this space to give any further information to explain why you consider that there is a likelihood of confusion e.g. why you consider the respective marks or goods and/or services to be similar?

In addition to VESPISMO being visually, phonetically and conceptually similar to VESPA, the word is descriptive of a movement of people who like VESPA goods (such as motorcycles, motorcycle clothing and memorabilia). The goods for which registration is sought are identical to those for which VESPA is registered.

24 OCT 2008 12:42 SHP BRISTOL

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Case details for Trade Mark 1529364

Explanation of terms used on this page

Case history including, where available, licensee details

Mark

Mark text:

VESPA

Mark claim/limit:

The mark consists of the Italian word meaning "Wasp".

Status

Status:

Registered

Classes:

09, 18, 25

Relevant dates

Filing date:

11 March 1993

Next renewal date:

11 March 2010

Registration date:

19 May 1995

Publication in Trade Marks Journal

First advert:

Journal:

6037

Page:

4899

Publication date:

10 August 1994

Registration:

Journal:

6083

Publication date:

12 July 1995

Renewal:

Journal:

6319

Publication date:

15 March 2000

Assignment:

Journal:

6393

Publication date:

24 OCT. 2008 12:42 by numtSHP BRISTOL

VO. 112 age 83

6

22 August 2001

Merger:**Journal:**

6316

Publication date:

23 February 2000

List of goods or services**Class 09:**

Sunglasses, eyeglasses, eyeglass cases, contact lenses, face shields, safety goggles, protective or safety helmets, batteries, battery chargers, batteries for motor vehicles, radios for motor vehicles, speedometers for motor vehicles, tachometers; all included in Class 9.

Class 18:

Handbags, suitcases, trunks, travelling bags, clutch bags, vanity cases (sold empty); purses, billfolds, attache cases, wallets, briefcases, belts, key-cases, passport cases, business and credit card cases; umbrellas; all included in Class 18.

Class 25:

Coats, mantles, raincoats, dresses, suits, skirts, jackets, trousers, waistcoats, shirts, t-shirts, blouses, jerseys, sweaters, blazers, cardigans, stockings, socks, underwear, corsets, nightgowns, pyjamas, bathrobes, bathing suits, sun suits, jeans, sport jackets, wind-resistant jackets, anoraks, sweatsuits, ties, neckties, scarves, shawls, foulards, caps, hats, gloves, sashes, belts; boots, shoes and slippers; all being articles of clothing; all included in Class 25.

Names and addresses**Proprietor:**

Piaggio & C. S.p.A.

Viale Rinaldo Piaggio, 25, 56025 Pontedera (PI), Italy

Incorporated country:

Italy

Residence country:

Italy

Customer's ref:

PAN/38332

Effective assignment date:

05 July 2001

ADP number:

0807137001

Other cases owned by this proprietor**Agent:**

D. Young & Co.

120 Holborn, London, EC1N 2DY

ADP number:

0000059001

Service:

D. Young & Co.

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7

120 Holborn, London, EC1N 2DY
ADP number:
0000059001

Earlier rights notification

Opted in for notifications

Explanation of terms used on this page

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P. 10

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Use this sheet if you are basing your opposition on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

☒ 5(3) It is identical with or similar to an earlier mark which has a reputation.

Details of the earlier trade mark

Number: 1529364

Is it a UK, Community or International mark? UK

Representation of the mark:

VESPA

1. For which goods or services covered by the earlier mark does it have a reputation?

☒ All

☐ Some (please specify)

2. State the goods or services in the application for which you say that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

☒ All

☐ Some (please specify)

3. What do you say the unfair advantage or detriment would be?

Any use of the mark in the UK would be parasitic and would, therefore, take advantage of the repute of the earlier mark. Further, the distinctiveness of the earlier mark would be blurred. In this way, use of the later mark would be detrimental to the distinctive character of the earlier mark.

24 OCT 2008 12:42

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2. 11

4. **Statement of use provision-** Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication of the opposed application? ⁹

☒ Yes ☐ No

- 5(a). If yes, for which goods and services listed at question 1 is use claimed?

☒ All

☐ Some (please specify)

Or,

- 5(b). If yes and the mark has not been used, please state any proper reasons for non use.

Use this space to give any further information to explain why you are opposing the application on this ground.

The mark, the subject of the application, conveys the impression on account of its nature, that it is derived from the Opponent's earlier mark and business and that, as a result, the subject mark free-rides on that.

24 OCT 2008 12:42
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VO. 11290112 12

10

**Case details for Trade Mark 1529364**Explanation of terms used on this pageCase history including, where available, licensee details**Mark**

Mark text:

VESPA

Mark claim/limit:

The mark consists of the Italian word meaning "Wasp".

Status

Status:

Registered

Classes:

09, 18, 25

Relevant dates

Filing date:

11 March 1993

Next renewal date:

11 March 2010

Registration date:

19 May 1995

Publication in Trade Marks Journal

First advert: .

Journal:

6037

Page:

4899

Publication date:

10 August 1994

Registration:

Journal:

6083

Publication date:

12 July 1995

Renewal:

Journal:

6319

Publication date:

15 March 2000

Assignment:

Journal:

6393

Publication date:

24 OCT. 2008, 12:42 by numtSHP BRISTOL

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11.

22 August 2001

Merger:

Journal:

6316

Publication date:

23 February 2000

List of goods or services**Class 09:**

Sunglasses, eyeglasses, eyeglass cases, contact lenses, face shields, safety goggles, protective or safety helmets, batteries, battery chargers, batteries for motor vehicles, radios for motor vehicles, speedometers for motor vehicles, tachometers; all included in Class 9.

Class 18:

Handbags, suitcases, trunks, travelling bags, clutch bags, vanity cases (sold empty); purses, billfolds, attache cases, wallets, briefcases, belts, key-cases, passport cases, business and credit card cases; umbrellas; all included in Class 18.

Class 25:

Coats, mantles, raincoats, dresses, suits, skirts, jackets, trousers, waistcoats, shirts, t-shirts, blouses, jerseys, sweaters, blazers, cardigans, stockings, socks, underwear, corsets, nightgowns, pyjamas, bathrobes, bathing suits, sun suits, jeans, sport jackets, wind-resistant jackets, anoraks, sweatsuits, ties, neckties, scarves, shawls, foulards, caps, hats, gloves, sashes, belts; boots, shoes and slippers; all being articles of clothing; all included in Class 25.

Names and addresses**Proprietor:**

Piaggio & C. S.p.A.

Viale Rinaldo Piaggio, 25, 56025 Pontedera (PI), Italy

Incorporated country:

Italy

Residence country:

Italy

Customer's ref:

PAN/38332

Effective assignment date:

05 July 2001

ADP number:

0807137001

Other cases owned by this proprietor**Agent:**

D. Young & Co.

120 Holborn, London, EC1N 2DY

ADP number:

0000059001

Service:

D. Young & Co.

<http://www.ipo.gov.uk/domestic?domesticnum=1529364>

23/10/2008

24-OCT-2008 12:44 From: 01179105721

ID:

24.OCT.2008 12:43

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12

Use this sheet if you are basing your opposition on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

☒ 5(3) It is identical with or similar to an earlier mark which has a reputation.

Details of the earlier trade mark

Number: 1061865

Is it a UK, Community or International mark? UK

Representation of the mark:

VESPA

1. For which goods or services covered by the earlier mark does it have a reputation?

☒ All

☐ Some (please specify)

2. State the goods or services in the application for which you say that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

☒ All

☐ Some (please specify)

3. What do you say the unfair advantage or detriment would be?

Any use of the mark in the UK would be parasitic and would, therefore, take advantage of the repute of the earlier mark. Further, the distinctiveness of the earlier mark would be blurred. In this way, use of the later mark would be detrimental to the distinctive character of the earlier mark.

24 OCT. 2008 12:43 SHP BRISTOL
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Case details for Trade Mark 1061865

Explanation of terms used on this page

Case history including, where available, licensee details

Mark

Mark text:
VESPA

Status

Status:
Registered
Class:
12

Relevant dates

Filing date:
22 April 1976
Next renewal date:
22 April 2017

Publication in Trade Marks Journal

First advert:
Journal:
5180
Page:
2491
Publication date:
07 December 1977

Renewal:
Journal:
6679
Publication date:
13 April 2007

Assignment:
Journal:
6393
Publication date:
22 August 2001

List of goods or services

Class 12:
Land vehicles and parts and fittings therefor included in Class 12

Names and addresses

<http://www.ipso.gov.uk/domestic?domesticnum=1061865>

23/10/2008

24 OCT. 2008. 12:43y number SHP BRISTOL

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14

Proprietor:

Piaggio & C. S.p.A.

Viale Rinaldo Piaggio, 25, 56025 Pontedera (PI), Italy

Incorporated country:

Italy

Residence country:

Italy

Effective assignment date:

05 July 2001

ADP number:

0807137001

Other cases owned by this proprietor**Agent:**

D. Young & Co.

120 Holborn, London, EC1N 2DY

ADP number:

0000059001

Service:

D. Young & Co.

120 Holborn, London, EC1N 2DY

ADP number:

0000059001

Other particulars**Restrictions on exclusive use:**

The mark consists of an Italian word meaning "Wasp".

Earlier rights notification**Opted in for notifications****Explanation of terms used on this page**

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VO. 112 ? 17

4. **Statement of use provision— Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication of the opposed application?** 15

☒ Yes ☐ No

- 5(a). If yes, for which goods and services listed at question 1 is use claimed?

☒ All
☐ Some (please specify)

Or,

- 5(b). If yes and the mark has not been used, please state any proper reasons for non use.

Use this space to give any further information to explain why you are opposing the application on this ground.

The mark, the subject of the application, conveys the impression on account of its nature, that it is derived from the Opponent's earlier mark and business and that, as a result, the subject mark free-rides on that.

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P. 18

Use this sheet if you are basing your opposition on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending mark.

18

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

☒ 5(3) It is identical with or similar to an earlier mark which has a reputation.

Details of the earlier trade mark

Number: 678204

Is it a UK, Community or International mark? UK

Representation of the mark:



1. For which goods or services covered by the earlier mark does it have a reputation?

☒ All

☐ Some (please specify)

2. State the goods or services in the application for which you say that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

☒ All

☐ Some (please specify)

3. What do you say the unfair advantage or detriment would be?

Any use of the mark in the UK would be parasitic and would, therefore, take advantage of the repute of the earlier mark. Further, the distinctiveness of the earlier mark would be blurred. In this way, use of the later mark would be detrimental to the distinctive character of the earlier mark.

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VO. 112 3. 19

4. **Statement of use provision— Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication of the opposed application?** 17

☒ Yes ☐ No

- 5(a). If yes, for which goods and services listed at question 1 is use claimed?

☒ All
☐ Some (please specify)

Or,

- 5(b). If yes and the mark has not been used, please state any proper reasons for non use.

Use this space to give any further information to explain why you are opposing the application on this ground.

The mark, the subject of the application, conveys the impression on account of its nature, that it is derived from the Opponent's earlier mark and business and that, as a result, the subject mark free-rides on that.

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Case details for Trade Mark 678204

Explanation of terms used on this page

Case history including, where available, licensee details

Mark



Mark text:
Vespa

Status

Status:
Registered
Class:
12

Relevant dates

Filing date:
25 March 1949
Next renewal date:
25 March 2018

Publication in Trade Marks Journal

First advert:
Journal:
3754
Page:
270
Publication date:
22 March 1950
Renewal:
Journal:
6721

<http://www.ipo.gov.uk/domestic?domesticnum=678204>

24-OCT-2008 12:44 From: 01179105721

TO:

23/10/2008

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19

Publication date:

01 February 2008

Assignment:

Journal:

6393

Publication date:

22 August 2001

List of goods or services

Class 12:

Motor cycles.

Names and addresses

Proprietor:

Piaggio & C. S.p.A.

Viale Rinaldo Piaggio, 25, 56025 Pontedera (PI), Italy

Incorporated country:

Italy

Residence country:

Italy

Effective assignment date:

05 July 2001

ADP number:

0807137001

Other cases owned by this proprietor

Agent:

D. Young & Co.

120 Holborn, London, EC1N 2DY

ADP number:

0000059001

Service:

D. Young & Co.

120 Holborn, London, EC1N 2DY

ADP number:

0000059001

Other particulars

Restrictions on exclusive use:

The translation of the Italian word forming the subject of the mark is "Wasp".

Earlier rights notification

Opted in for notifications

Explanation of terms used on this page

<http://www.ipo.gov.uk/domestic?domesticnum=678204>

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24-OCT-2008 12:45 From: 01179105721

ID:

24. OCT. 2008 12:43

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p. 22

Use this sheet if you are basing your opposition on section 5(3) of the Trade Marks Act on the basis of an earlier registered or pending mark.

20

Please note that opposition based on these grounds can only be made by the proprietor of an earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

☒ 5(3) It is identical with or similar to an earlier mark which has a reputation.

Details of the earlier trade mark

Number: 1200683

Is it a UK, Community or International mark? UK

Representation of the mark:

VESPA

1. For which goods or services covered by the earlier mark does it have a reputation?

☒ All

☐ Some (please specify)

2. State the goods or services in the application for which you say that use of the applicant's mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

☒ All

☐ Some (please specify)

3. What do you say the unfair advantage or detriment would be?

Any use of the mark in the UK would be parasitic and would, therefore, take advantage of the repute of the earlier mark. Further, the distinctiveness of the earlier mark would be blurred. In this way, use of the later mark would be detrimental to the distinctive character of the earlier mark.

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p. 23

4. **Statement of use provision--** Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication of the opposed application? 21

☒ Yes ☐ No

- 5(a). If yes, for which goods and services listed at question 1 is use claimed?

☒ All

☐ Some (please specify)

Or,

- 5(b). If yes and the mark has not been used, please state any proper reasons for non use.

Use this space to give any further information to explain why you are opposing the application on this ground.

The mark, the subject of the application, conveys the impression on account of its nature, that it is derived from the Opponent's earlier mark and business and that, as a result, the subject mark free-rides on that.

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24 OCT 2008 12:44 - my number SHP BRISTOL

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Case details for Trade Mark 1200683

Explanation of terms used on this page

Case history including, where available, licensee details

Mark

Mark text:

VESPA

Status

Status:

Registered

Class:

12

Relevant dates

Filing date:

28 July 1983

Next renewal date:

28 July 2014

Publication in Trade Marks Journal

First advert:

Journal:

5576

Page:

1824

Publication date:

24 July 1985

Renewal:

Journal:

6540

Publication date:

23 July 2004

Assignment:

Journal:

6393

Publication date:

22 August 2001

List of goods or services

Class 12:

Motor land vehicles; motorcycles, bicycles, scooters (vehicles); parts and fittings included in Class 12 for all the aforesaid goods.

Names and addresses

<http://www.ipso.gov.uk/domestic?domesticnum=1200683>

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ID:

23/10/2008

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Proprietor:

Piaggio & C. S.p.A.

Viale Rinaldo Piaggio, 25, 56025 Pontedera (PI), Italy

Incorporated country:

Italy

Residence country:

Italy

Customer's ref:

98768

Effective assignment date:

05 July 2001

ADP number:

0807137001

Other cases owned by this proprietor**Agent:**

Stevens, Hewlett & Perkins

1 St Augustine's Place, Bristol, BS1 4UD

ADP number:

0001545002

Service:

Stevens, Hewlett & Perkins

1 St Augustine's Place, Bristol, BS1 4UD

ADP number:

0001545002

Earlier rights notification

Opted in for notifications

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Use this sheet if you are basing your opposition on section 5(4)(a) of the Trade Marks Act. 24

Please note that opposition based on these grounds can only be made by the proprietor of an earlier right.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☒ 5(4)(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

Representation or details of the earlier mark, sign or right.
VESPA

If the opposition is under Section 5(4)(a), please answer the following questions.

1. When and where was the earlier right first used in the UK?
The mark has been in use throughout the UK for many decades.
2. State in relation to which goods and services the earlier right has been used.
The mark has been used in relation to a wide range of motorcycles, motorcycle parts and accessories for motorcycles including eyewear, leather goods, clothing, footwear and headgear as well as for memorabilia.
3. State which goods or services of the application you oppose under Section 5(4)(a).
☒ All
☐ Some (please specify)
4. Now state why you consider use of the applicant's mark would be contrary to law, particularly the law of passing off.
There is goodwill and reputation attaching to the business and to the goods of the Opponent in the mind of the buying public that are symbolised by the earlier mark. If the Applicant were to use the mark applied for in respect of the goods, the subject to the application, this would deceive the public as to the origin of the goods, including, but not limited to, the generation of a supposition of business relations between the Applicant and the Opponent. Such deception resulting from an erroneous belief engendered by misrepresentation would invariably damage the business of the Opponent who would, therefore, be entitled to prevent use of its mark by the Applicant in the UK by virtue of the law of passing-off.

24. OCT. 2008 12:44

SHP BRISTOL

VO. 112 P. 27

Use this sheet if you are basing your opposition on section 5(4)(a) of the Trade Marks Act. 25

Please note that opposition based on these grounds can only be made by the proprietor of an earlier right.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

- ☒ 5(4)(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.

Representation or details of the earlier mark, sign or right.

Claspa

If the opposition is under Section 5(4)(a), please answer the following questions.

1. When and where was the earlier right first used in the UK?
The mark has been in use throughout the UK for many decades.
2. State in relation to which goods and services the earlier right has been used.
The mark has been used in relation to a wide range of motorcycles, motorcycle parts and accessories for motorcycles including eyewear, leather goods, clothing, footwear and headgear as well as for memorabilia.
3. State which goods or services of the application you oppose under Section 5(4)(a).
☒ All
☐ Some (please specify)
4. Now state why you consider use of the applicant's mark would be contrary to law, particularly the law of passing off.
There is goodwill and reputation attaching to the business and to the goods of the Opponent in the mind of the buying public that are symbolised by the earlier mark. If the Applicant were to use the mark applied for in respect of the goods, the subject to the application, this would deceive the public as to the origin of the goods, including, but not limited to, the generation of a supposition of business relations between the Applicant and the Opponent. Such deception resulting from an erroneous belief engendered by misrepresentation would invariably damage the business of the Opponent who would, therefore, be entitled to prevent use of its mark by the Applicant in the UK by virtue of the law of passing-off.

24. OCT. 2008 12:44

SHP BRISTOL

VO. 112 2. 28

Use this sheet if you are basing your opposition on any other grounds and tick the appropriate box.

26

Statement of other grounds of opposition.

- ☐ Section 5(1),(2), (3) If the opponent is claiming protection for an earlier trade mark under Section 8(1)(c) which is a well known trade mark as defined in Section 56(1)
- ☐ Section 6(4)(b) An earlier right by virtue of the law of copyright, design right or registered designs
- ☐ Section 60 Acts of agent or representative.
- ☐ Rule 18(2) Applications amended after publication.
- ☐ Rule 22 Regulations for collective or certification marks.
- ☐ Rule 23(4) Amendment of regulations for collective or certification marks.
- ☐ Rule 25(3) Alteration of registered mark.
- ☐ Rule 45(2) Removal of matter from the register.
- ☐ Rule 47(1) Reclassification of specification.
- ☐ Others

Give details to support your opposition under these grounds:

IBIS Register sheet for Case Number: 1529364**Version: 1.10.1.0**
Version Date: 25.08.2007**Customer reference:** PAN/38332
Case status: Registered**Reason for this version:**
Trade Mark opted in by default to receive citation notifications.**Mark type:** Word Only**Classes:** 09, 18, 25**Number in series:** 1**Mark text:**
VESPA**Date filed:** 11.03.1993
Next renewal date: 11.03.2010**Registration date:** 19.05.1995**Journal section:** Journal No.:
First advert: 6037
Registration: 6083
Renewal: 6319
Assignment: 6393
Merger: 6316**Page:** 4899
Publication date:
10.08.1994
12.07.1995
15.03.2000
22.08.2001
23.02.2000**Class:** 09

Sunglasses, eyeglasses, eyeglass cases, contact lenses, face shields, safety goggles, protective or safety helmets, batteries, battery chargers, batteries for motor vehicles, radios for motor vehicles, speedometers for motor vehicles, tachometers; all included in Class 9.

Class: 18

Handbags, suitcases, trunks, travelling bags, clutch bags, vanity cases (sold empty); purses, billfolds, attache cases, wallets, briefcases, belts, key-cases, passport cases, business and credit card cases; umbrellas; all included in Class 18.

Class: 25

Coats, mantles, raincoats, dresses, suits, skirts, jackets, trousers, waistcoats, shirts, t-shirts, blouses, jerseys, sweaters, blazers, cardigans, stockings, socks, underwear, corsets, nightgowns, pyjamas, bathrobes, bathing suits, sun suits, jeans, sport jackets, wind-resistant jackets, anoraks, sweatsuits, ties, neckties, scarves, shawls, foulards, caps, hats, gloves, sashes, belts; boots, shoes and slippers; all being articles of clothing; all included in Class 25.

Proprietor ADP number: 0807137001**Effective date of assignment:** 05.07.2001**Proprietor:**

Piaggio & C. S.p.A., Viale Rinaldo Piaggio, 25, 56025 Pontedera (PI), Italy

Proprietor residence country: Italy**Proprietor incorporation country:** Italy**Agent ADP number:** 0000059001**Agent:**

D. Young & Co., 120 Holborn, London, EC1N 2DY

Service ADP number: 0000059001**Service:**

D. Young & Co., 120 Holborn, London, EC1N 2DY

Mark claim / limit:

The mark consists of the Italian word meaning "Wasp".

Opted In for Notifications:

Opted in for notifications. Preferred UK/EU address for service.

*****END OF REPORT*****

IBIS Register sheet for Case Number: 1061865**Version:** 1.9.1.1
Version Date: 15.01.2008**Case status:** Registered
Registration part: A**Reason for this version:**

15.01.2008;014;ADP NUMBER CHANGED BY CLEANUP 00050869;SLSGRI

Mark type: Word Only**Class:** 12**Number in series:** 1**Mark text:**
VESPA**Date filed:** 22.04.1976**Next renewal date:** 22.04.2017**Journal section:** **Journal No.:****First advert:** 5180**Page:**

2491

Publication date:

07.12.1977

Renewal: 6679

13.04.2007

Assignment: 6393

22.08.2001

Class: 12

Land vehicles and parts and fittings therefor included in Class 12

Proprietor ADP number: 0807137001**Effective date of assignment:** 05.07.2001**Proprietor:**

Piaggio & C. S.p.A., Viale Rinaldo Piaggio, 25, 56025 Pontedera (PI), Italy

Proprietor residence country: Italy**Proprietor incorporation country:** Italy**Agent ADP number:** 0000059001**Agent:**

D. Young & Co., 120 Holborn, London, EC1N 2DY

Service ADP number: 0000059001**Service:**

D. Young & Co., 120 Holborn, London, EC1N 2DY

Restrictions on exclusive use:

The mark consists of an Italian word meaning "Wasp".

Opted in for Notifications:

Opted in for notifications. Preferred UK/EU address for service.

*****END OF REPORT*****

IBIS Register sheet for Case Number: 678204

Version: 1.11
Version Date: 16.01.2008Case status: Registered
Registration part: AReason for this version:
16.01.2008;014;Trade Mark Renewed;ERENEW

Mark type: Stylised Word Mark

Class: 12

Vienna classification list: '27. . '

Number in series: 1

Mark text:
VespaDate filed: 25.03.1949
Next renewal date: 25.03.2018

Journal section:	Journal No.:	Page:	Publication date:
First advert:	3754	270	22.03.1950
Renewal:	6721		01.02.2008
Assignment:	6393		22.08.2001

Class: 12
Motor cycles.

Proprietor ADP number: 0807137001 Effective date of assignment: 05.07.2001

Proprietor:

Piaggio & C. S.p.A., Viale Rinaldo Piaggio, 25, 56025 Pontedera (PI), Italy

Proprietor residence country: Italy

Proprietor incorporation country: Italy

Agent ADP number: 0000059001

Agent:

D. Young & Co., 120 Holborn, London, EC1N 2DY

Service ADP number: 0000059001

Service:

D. Young & Co., 120 Holborn, London, EC1N 2DY

IBIS Register sheet for Case Number: 678204

Version: 1.11
Version Date: 16.01.2008

Restrictions on exclusive use:

The translation of the Italian word forming the subject of the mark is "Wasp".

Opted in for Notifications:

Opted in for notifications. Preferred UK/EU address for service.

*****END OF REPORT*****

IBIS Register sheet for Case Number: 1200683**Version:** 1.9
Version Date: 15.01.2008**Customer reference:** 98768
Case status: Registered
Registration part: A**Reason for this version:**

15.01.2008;013;ADP NUMBER CHANGED BY CLEANUP 00050869;SLSGRI

Mark type: Word Only**Class:** 12**Number in series:** 1**Mark text:**
VESPA**Date filed:** 28.07.1983
Next renewal date: 28.07.2014

Journal section:	Journal No.:	Page:	Publication date:
First advert:	5576	1824	24.07.1985
Renewal:	6540		23.07.2004
Assignment:	6393		22.08.2001

Class: 12

Motor land vehicles; motorcycles, bicycles, scooters (vehicles); parts and fittings included in Class 12 for all the aforesaid goods.

Proprietor ADP number: 0807137001**Effective date of assignment:** 05.07.2001**Proprietor:**

Plaggio & C. S.p.A., Viale Rinaldo Piaggio, 25, 56025 Pontedera (PI), Italy

Proprietor residence country: Italy**Proprietor Incorporation country:** Italy**Agent ADP number:** 0001545002**Agent:**

Stevens, Hewlett & Perkins, 1 St Augustine's Place, Bristol, BS1 4UD

Service ADP number: 0001545002**Service:**

Stevens, Hewlett & Perkins, 1 St Augustine's Place, Bristol, BS1 4UD

Opted in for Notifications:

Opted in for notifications. Preferred UK/EU address for service.

*****END OF REPORT*****



Form TM8

Nil Fee

For Creativity and Innovation

Notice of defence and counterstatement

Please read the guidance notes on the next page before filling in this form.

Trade Marks Registry
Concept House
Cardiff Road, Newport
South Wales NP10 8QQ

	(Lowest) Class
1. Trade mark number.	
2. Full name of the applicant or registered proprietor.	
3. Opposition, invalidation, revocation, or rectification number.	
4. Name and address (including postcode) of the agent (if any).	
5. Do you want the opponent to provide proof of use? (see note)	
6. If you answered 'Yes' to question five, please state for which goods and services you require proof.	
7. Counterstatement	

Counterstatement (continued from previous sheet)

8.	Declaration	I believe that the facts stated in this notice of defence and counterstatement are true.
	Your signature.	
	Your name in BLOCK CAPITALS.	
	Date.	
9.	Name and daytime phone number of the person we should contact in case of query.	
	Your reference.	
	Number of sheets attached to this form.	This is sheet 1 of

If the parties to this dispute have not considered mediation, would you like to receive information on the subject?

☐ Yes ☐ No

Notes If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 9 how many sheets you have used.

Boxes 2 and 4: At least one of these should be located in the UK.

Box 5: Only applies in opposition, or similarly in the case of invalidation proceedings, where the person opposing or invalidating your mark may have provided a statement of use and only applies to grounds of opposition or invalidation raised under sections 5(1) and 5(2) and 5(3) of the Trade Marks Act.

Intellectual Property Office **Form TM33**
Office **Nil Fee**

For Creativity and Innovation

Appointment or change of agent or contact address

Trade Marks Registry
 Concept House
 Cardiff Road, Newport
 South Wales NP10 8QQ

Please read the note below before filling in this form.

1 Trade mark numbers affected. (Please put an 'M' in front of Madrid marks). (List on a separate sheet if there is not enough space on this form).	(Lowest) Class
2 Full name of the a) proprietor; or b) opponent as now shown on our records.	
3 Name and address (including postcode) of the new agent or contact address Trade Marks ADP number (if you know it).	
4 Declaration. Signature. Name in BLOCK CAPITALS. Date.	We have been appointed by the above proprietor or opponent.
5 Name and daytime phone number of the person we should contact in case of query.	
Your reference.	
Number of sheets attached to this form.	This is sheet 1 of

Note We suggest you check the proprietor's name and the marks they own by doing a proprietor search on our website www.ipo.gov.uk before you fill in the form.