OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Trade Marks Department

W211

Alicante, 18/11/2008

Notification of provisional refusal of protection based on an opposition pursuant to Article 5 of the Madrid Protocol and Rule 17 (1), (2) of the Common Regulations under the Madrid Agreement and Protocol and to Rule 115*

International Registration No:	**0946527**
Date of notification to OHIM:	27-12-2007
Trade mark:	BANK FRICK LIECHTENSTEIN
Applicant/Holder:	Bank Frick & Co. Aktiengesellschaft Landstrasse 14 FL-9496 Balzers
Opposition number:	B 1301011

Protection of the above-mentioned mark is provisionally refused for the European Community.

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

I. The grounds for the opposition are as follows:

Conflict with an earlier mark and likelihood of confusion (Article 8(1) and (2) CTMR*).

Conflict with an earlier identical or similar trade mark registered for goods or services which are not similar to those for which the international registration is registered, where the earlier mark has a reputation and where the use without due cause of the international registration would take unfair advantage of or be detrimental to, the distinctive character or the repute of the earlier trademark (Article 8(5) CTMR*).

II. Name and address of the opposing party: **HISCOX, PLC**
1 Great St Helen's
London EC3A 6HX
United Kingdom

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

- type of mark : **Community trade mark**

- filing date, registration date and, if applicable, priority date: **20/04/1998; 18/11/1999**

- filing number and, if different, registration number: **803098**

- reproduction of the mark: (see annex)

* Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.
Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark.

Regulations on the internet:
CTM (http://oami.europa.eu/en/mark/aspects/reg.htm) Madrid Protocol (http://oami.europa.eu/en/mark/madrid/default.htm)

- list of goods and services on which the opposition is based: (see annex)

The opposition is based on more than one earlier right : (see annex)

IV. The provisional refusal relates to

Only to the following goods and services covered by the designation of the EC
Class 36: Insurance; financial affairs; monetary affairs; real estate affairs.

V. The OHIM will notify the opposition separately to the holder of the international registration, including all evidence on which it is based, pursuant to Rule 18(1)*. The OHIM will set time limits for the holder. The notification will open an (extendable) cooling-off period of two months and a further period of two months for the opponent to substantiate the opposition. The notification will set a time limit of, in principle, six months for the holder of the international registration to submit observations.

GROENEVELD, Macarena

Examiner

Annex: 7 pages

CLIFFORD
CHANCE

CLIFFORD CHANCE LLP
10 UPPER BANK STREET
CANARY WHARF
LONDON E14 5JJ

TEL +44 (0)20 7006 1000
FAX +44 (0)20 7006 5555
DX 149120 CANARY WHARF 3
www.cliffordchance.com

FAX

FAX COUNTRY/NUMBER
+34 0651 31344

DATE
3 April 2008

NUMBER OF PAGES INCLUDING THIS PAGE
7

TIME SENT

YOUR REFERENCE

OUR REFERENCE
NHT/ID:OO2546/70-20202012/VGM

TO
OHIM

FROM
Niall Tierney
SENDER FAX: + 44 (0) 20 7006 5555
DIRECT DIAL: + 44 (0) 20 7006 4541

COPY TO

FAX NUMBER FOR COPIES

Dear Sirs,

International Trade Mark Registration no. 946527 BANK FRICK LIECHTENSTEIN & Device in the name of Bank Frick Liechtenstein and opposition thereto by Hiscox Plc

Please find enclosed Notice of Opposition form in relation to the above.

Yours faithfully,

Clifford Chance LLP

UK/1659600/01

238544/70-20202012

IF YOU DO NOT RECEIVE LEGIBLE COPIES OF ALL THE PAGES PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE (EXTENSION 5700) TELEX OR FAX. THIS MESSAGE AND ANY ATTACHMENTS ARE CONFIDENTIAL AND SENT FOR THE PERSONAL ATTENTION OF THE ADDRESSEE(S). THE MESSAGE MAY CONTAIN INFORMATION WHICH IS COVERED BY LEGAL PROFESSIONAL OR OTHER PRIVILEGE.

CLIFFORD CHANCE IS A LIMITED LIABILITY PARTNERSHIP REGISTERED IN ENGLAND AND WALES UNDER NUMBER OC323571. THE FIRM'S REGISTERED OFFICE AND PRINCIPAL PLACE OF BUSINESS IS AT 10 UPPER BANK STREET, LONDON, E14 5JJ. A LIST OF THE MEMBERS IS OPEN TO INSPECTION AT THIS OFFICE. THE FIRM USES THE WORD "PARTNER" TO REFER TO A MEMBER OF CLIFFORD CHANCE LLP OR AN EMPLOYEE OR CONSULTANT WITH EQUIVALENT STANDING AND QUALIFICATIONS. THE FIRM IS REGULATED BY THE SOLICITORS REGULATION AUTHORITY.

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (OHIM)
NOTICE OF OPPOSITION

Number of pages (including this one)	6	Opponent's/representative's reference number (not more than 20 characters) NHT/ID:OO2546	14/01/2003

Opponent ID number 41814 ☐ multiple opponents

Name of legal entity or first name and surname	Hiscox Plc
Tel, fax, e-mail	
Address Street and number / City and postal code / Country	1 Great St Helen's, London, EC3A 6HX
Postal address (if different)	
Nationality	England and Wales

Representative ID number 10576 ☐ multiple representatives

Name	Clifford Chance LLP
Tel, fax, e-mail	020 7006 1000 / 020 7006 5555
Address Street and number / City and postal code / Country	10 Upper Bank Street London E14 5JJ United Kingdom
Postal address (if different)	

Type of representative ☐ legal practitioner ☐ professional representative ☐ association of representatives ☐ employee

Challenged application CTMA / IR No 000946527 Date of publication (DD/MM/YYYY) 07 / 01 / 2008

Name of CTM applicant or IR holder: Bank Frick & Co Aktiengesellschaft Balzers

Language of the opposition: ES ☐ DE ☐ EN ☑ FR ☐ IT ☐

Extent of the opposition

☐ against all the goods and services in the application

☑ against part of the goods and services in the application, namely:

Insurance; financial affairs, monetary affairs, real estate afairs.

☐ continuation sheet(s)

Payment of fee Total € 350

Current account with OHIM

☑ Account No 925

☐ Do not use my current account with OHIM

Transfer to account of OHIM

☐ Banco Bilbao Vizcaya Argentaria

☐ La Caixa

Date of transfer (DD/MM/YYYY) / /

Signature

Name: Niall Tierney (Rep No. 164)

Signature:

NOTICE OF OPPOSITION

BASIS OF OPPOSITION: TRADE MARK REGISTRATION / APPLICATION

Identification of the earlier mark ☑ Trade mark registration ☐ Trade mark application

☑ Community trade mark ☐ National trade mark ☐ International registration with effect in one or more Member State(s)

Member State(s)

EM BG BX CZ DK DE EE GR ES FR IE IT CY LV LT HU MT AT PL PT RO SI SK FI SE GB

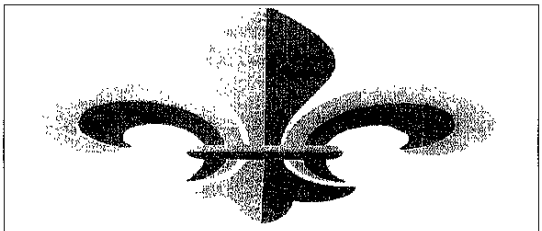
Filing date (DD/MM/YYYY) 20 / 04 / 1998

Filing number 000803098

Registration date (DD/MM/YYYY) 18 / 11 / 1999

Registration number 000803098

Representation of the mark *(in colour if applicable)*



☐ attached

Type of mark

☐ Word mark

☑ Figurative mark

☐ Other (specify)

Goods and services on which the opposition is based:

☑ all the goods and services covered by the registration / application

☐ part of the goods and services, namely:

☐ continuation sheet(s)

Entitlement of opponent

☑ Owner ☐ Authorised licensee

Copy of registration / application ☑ attached ☐ to follow

Translation ☐ attached

Grounds for opposition

☐ **Article 8(1)(a) CTMR** - the CTMA IR is identical to the earlier mark and covers identical goods and/or services

☑ **Article 8(1)(b) CTMR** - there exists a likelihood of confusion on the part of the public

☑ **Article 8(5) CTMR** - the use without due cause of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark

Explanation of grounds and other remarks:

☑ continuation sheet(s)

Territory where the earlier mark has a reputation:

EM BG BX ✓ CZ DK DE ✓ EE GR ES ✓ FR ✓ IE ✓ IT ✓ CY LV LT HU MT AT PL PT RO SI SK FI SE ✓ GB ✓

Goods and services for which the trade mark has a reputation

☑ all the goods and services covered by the registration / application

☐ part of the goods and services covered by the registration/application, namely:

☐ continuation sheet(s)

Evidence of reputation ☐ attached ☑ to follow Translation ☐ attached

NOTICE OF OPPOSITION

BASIS OF OPPOSITION: WELL-KNOWN TRADE MARK (Art.6 bis of the Paris Convention)

Identification of the earlier mark

Member State/s where the trade mark is well known

BG ✓ BE ✓ CZ DK DE ✓ ES GR ES ✓ FR ✓ IE ✓ IT ✓ CY LV LT LU HU MT NL ✓ AT PL PT RO SI SK FI SE GB ✓

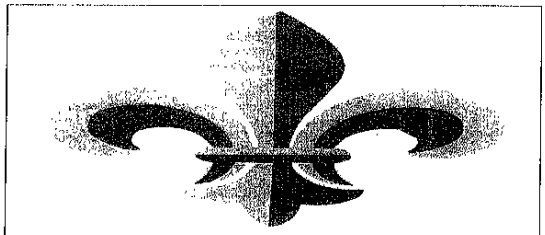
Type of mark

☐ Word mark

☑ Figurative mark

☐ Other (specify)

Representation of the mark *(in colour if applicable)*



☐ attached

Goods and/or services for which the trade mark is well known:

Insurance services; private client insurance services; commercial insurance services; insurance brokerage; insurance agency services; insurance consultation and information services; underwriting services; re-insurance services; marine, non-marine and aviation insurance and re-insurance services; financial advisory, consultation, planning and information services; actuarial services.

☐ continuation sheet(s)

Grounds for opposition

☐ **Article 8(1)(a) CTMR** - the CTMA IR is identical to the earlier mark and covers identical goods and/or services.

☑ **Article 8(1)(b) CTMR** - there exists a likelihood of confusion on the part of the public.

Explanation of grounds and other remarks:

☑ continuation sheet(s)

Evidence of the mark being well known ☐ attached ☑ to follow Translation ☐ attached

NOTICE OF OPPOSITION

BASIS OF OPPOSITION: NON-REGISTERED MARK OR SIGN USED IN THE COURSE OF TRADE

Identification of the earlier right

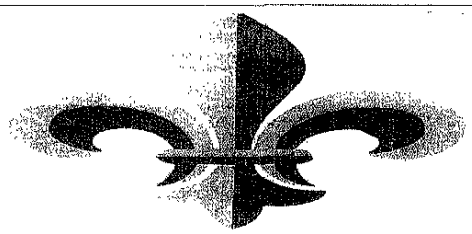
Nature of rights ☑ Non-registered trade mark ☐ Trade name ☐ Company name
☐ Other (specify):

Territory / Member State(s)

EM	BG	BE	CZ	DK	DE	EE	GR	ES	FR	IE	IT	CY	LV	LT	LU	HU	MT	NL	AT	PL	PT	RO	SI	SK	FI	SE	GB
										☑																	☑

Type of mark / sign
☐ Word mark / sign
☑ Figurative mark / sign
☐ Other (specify)

Representation of the mark / sign *(in colour if applicable)*



☐ attached

Goods, services or activities for which the mark / sign is used in the course of trade:

Insurance services; private client insurance services; commercial insurance services; insurance brokerage; insurance agency services; insurance consultation and information services; underwriting services; re-insurance services; marine, non-marine and aviation insurance and re-insurance services; financial advisory, consultation, planning and information services; actuarial services.

☐ continuation sheet(s)

Entitlement
☑ Owner
☐ Person authorised under the applicable law

Grounds for opposition
☑ **Article 8(4) CTMR** – The earlier non-registered trade mark / sign is used in the course of trade and is of more than mere local significance and, pursuant to the law govening it, the trade mark/sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Explanation of grounds and other remarks:

☑ continuation sheet(s)

Evidence of use/protection : ☐ attached ☑ to follow Translation ☐ attached

RESET FORM

page number 4 of 6

03/04/2008 10:52 020-7006-3600

COMMUNITY TRADE MARK REGULATION NO. 40/94

NOTICE OF OPPOSITION BY Hiscox Plc against Application No. 000946527 BANK FRICK & CO AKTIENGESELLSCHAFT BALZERS (Figurative) in the name of Bank Frick & Co Aktiengesellschaft Balzers

EXPLANATION OF GROUNDS

1. Hiscox Plc,. Public Limited Company ("the Opponent") is the proprietor of Community Trade Mark No. 000803098 ("the Earlier Trade Mark"). The Earlier Trade Mark includes a well-known trade mark as contemplated by Article 6 of the Paris Convention 1893.

2. The mark applied for ("the Sign") offends against Article 8(1)(b) of Community Trade Mark Regulation No. 40/94 (hereinafter referred to as "the Regulation") in that it is similar to the Earlier Trade Mark and covers identical goods and services. Consequently, there exists a likelihood of confusion, which includes the likelihood of association with the Earlier Trade Mark.

3. Further, or in the alternative, the Sign offends against Article 8(1)(b) of the Regulation in that it is similar to the Earlier Trade Mark and covers similar goods and services. Consequently, there exists a likelihood of confusion which includes the likelihood of association with the Earlier Trade Mark.

4. Further, or in the alternative, the Sign offends against Article 8(4) of the Regulation in that the Opponent is the proprietor of rights within the European Union which are capable of prohibiting the use of subsequent trade marks pursuant to the laws of the various individual Member States of the European Union; such rights consisting of an earlier Sign used in the course of trade of more than the mere local significance and/or a non-registered trade mark. The Opponent's rights include the earlier Signs set out in the Notice of Opposition.

5. Further, or in the alternative, the Sign offends against Article 8(5) of the Regulation in that the Opponent is the proprietor or Earlier Trade Mark with a reputation in the European Union. The Sign is similar to the Earlier Trade Mark, and the use without due course of the Sign on identical, similar and/or dissimilar goods and services to those for which the Earlier Trade Mark are protected will take unfair advantage and be detrimental to, the distinctive character or repute of the Earlier Trade Mark.

6. The Opponent requests that the application is refused in its entirety.

7. The Opponent requests an award of costs in these proceedings.

.....

Niall Tierney
Representative No.164
Clifford Chance LLP
Representatives for the Opponent

Dated: 3 April 2008