


**MADRID AGREEMENT/MADRID PROTOCOL  
CONCERNING THE INTERNATIONAL REGISTRATION OF TRADE MARKS**

**REFUSAL OF PROTECTION**

notified to the International Bureau of the World Intellectual Property Organization (WIPO)  
under Article 5 of the Madrid Agreement/Madrid Protocol

The boxes are crossed off when applicable ☒

<b>I.</b>	Office having declared refusal of protection: <b>Deutsches Patent- und Markenamt</b> <b>D-81534 München</b> <b>(Federal Republic of Germany)</b>	Telephone (0 89) 21 95 - 0; Teleprinter (0 89) 21 95 - 22 21 extension no. (0 89) 21 95 - 4651
<b>II.</b>	No. of the international registration in respect of which protection has been refused: <b>962 314</b> No. of basic national registration: <b>1099184</b>	
<b>III.</b>	Name and address of the holder of the registration in respect of which protection has been refused: <b>Gianluca Grandi</b> <b>Rome (RM)</b> <b>(Italy)</b>	
<b>IV.</b>	Provisional/final refusal ( <i>see item VIII. below</i> )	
<b>V.</b>	Grounds for refusal (earlier opposed trade marks and/or other grounds):  - <i>see item X.</i> -	
<b>VI.</b>	Applicable sections of the national law - <i>see item XIII.</i> -	
<b>VII.</b>	<input checked="" type="checkbox"/> Refusal for all products/services. <input type="checkbox"/> Refusal for all products/services excepting: <span style="margin-left: 100px;"><input type="checkbox"/> Refusal for products/services as follows</span> <span style="display: block; text-align: right;">- <i>see item X.</i> -</span>	
<b>VIII.</b>	<p><b>Objection to and legal remedies concerning the decision to refuse protection</b> (<i>please quote the international registration No./Cl. 25 IR in all correspondence</i>):</p> <p>The holder of the trade mark may submit his objections to the present refusal to Deutsches Patent- und Markenamt (address as indicated in item I above)</p> <p style="text-align: center;"><b>within four months</b></p> <p>from the date on which the notification of refusal was dispatched by WIPO, exclusively through the agency of a representative (<i>Patentanwalt or Rechtsanwalt</i>) who is a resident of the Federal Republic of Germany or a national of another member state of the European Union or a contracting state of the European Economic Area to whom the details of the refusal will be communicated. In the latter case a patent attorney or attorney-at-law, resident in the Federal Republic of Germany, has to be authorised to receive service of official communications.</p> <p>During the above time limit, the refusal of protection is provisional. In the absence of objections to the refusal within the time limit of four months, the latter will become final without further notification.</p> <p style="text-align: center;"><b>Within an additional time limit of one month</b></p> <p>the holder may, however, file an objection (<i>Erinnerung</i>) together with the fee of EUR 150.- for objection.</p> <p>In the absence of an objection refusal shall become final.</p> <p>The objection (<i>Erinnerung</i>) shall be addressed directly to Deutsches Patent- und Markenamt (address as indicated in item I above) through the agency of a representative (<i>Patentanwalt or Rechtsanwalt</i>) who is a resident of the Federal Republic of Germany or a national of another member state of the European Union or a contracting state of the European Economic Area.</p>	
<b>IX.</b>	Date of pronouncement of refusal: <b>January 8, 2009</b>	

X.	<p><b>Supplementary box</b> grounds for refusal - item V. -</p> <p style="text-align: center;">International Trade Mark 962 314</p> <p>The company (companies) mentioned below has (have) lodged opposition to the admission of the trade mark because of earlier national (M) or international (IR) application or registration of its (their) trade mark(s) listed below (Sec. 9, 42, 107, 114 Trade Mark Law; Art. 6 quinquies B No 1 Paris Convention):</p> <p>PIAGGIO &amp; C. SPA, Pontedera (PI), Italien (IR 598 112 VESPA).</p> <p><u>Note:</u></p> <p>If no representative has been appointed within the provisional time limit of the first four months, this fact constitutes in itself a ground for refusal after the notification concerning the refusal of protection has become final (Sec. 96, 107 Trade Mark Law).</p>		
XII.	<p><b>Annexes (crossed off below)</b></p> <p><input checked="" type="checkbox"/> 1 reproduction of 1 opposed trade mark(s) including a figurative element or a special graphic design</p> <p><input type="checkbox"/> List specifying the registration number as well as the relevant goods/services in respect of each opposed trade mark</p> <p><input type="checkbox"/> List of professional representatives</p> <p><input type="checkbox"/> List of goods/services</p>	XI.	<p><b>Signature or official seal of the administration which pronounced the refusal</b></p> <p style="text-align: center;"></p>

### XIII. (Title and date of the applicable national law)

## Extract from the Trade Mark Law

version of 9 December 2004

#### Absolute Grounds for Refusal

8. - (1) Signs that are capable of being protected as a trade mark within the meaning of Section 3, but not capable of being represented graphically, shall not be registered.

(2) The following shall not be registered:

1. trade marks which are devoid of any distinctive character with respect to the goods or services;
2. 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 the rendering of the services, or to designate other characteristics of the goods or services;
3. trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona-fide* and established practices of the trade for designating goods or services;
4. trade marks which are of such a nature as to deceive the public, in particular, as to the nature, quality or geographical origin of the goods or services;
5. trade marks which are contrary to public policy or to accepted principles of morality;
6. trade marks which include armorial bearings, flags or other emblems of State, or armorial bearings of a locality, an association of communities or an association of other communal entities within the country;
7. trade marks which include official signs and hallmarks, indicating control and warranty, which, according to a notice published by the Federal Ministry of Justice in the Federal Law Gazette (*Bundesgesetzblatt*), cannot be validly registered as trade marks;
8. trade marks which include armorial bearings, flags or other signs, seals, or designations, of international intergovernmental organisations which, according to a notice published by the Federal Ministry of Justice in the Federal Law Gazette, cannot be validly registered as trade marks;
9. trade marks the use of which can obviously be prohibited pursuant to other provisions in the public interest; or
10. trade marks which have been filed in bad faith.

(3) Subsection (2), Nos. 1, 2 and 3, shall not apply if the trade mark has, before the date of the decision on registration and following the use which has been made of it, established itself in affected trade circles as the distinguishing sign for the goods or services for which it has been filed.

(4) Subsection (2), Nos. 6, 7 and 8, shall also apply if the trade mark includes the imitation of a sign specified therein. Subsection (2), Nos. 6, 7 and 8, shall not apply where the applicant is authorised to include one of the signs specified therein in his trade mark even if it may be confused with another of the signs specified therein. Furthermore, subsection (2), No. 7, shall not apply where the goods or services for which the application for registration of the trade mark has been filed are neither identical with nor similar to those for which the sign or hallmark, indicating control or warranty, has been introduced. Furthermore, subsection (2), No. 8, shall not apply where the trade mark filed is not of such a nature as to falsely suggest to the public that a connection exists between the trade mark and the international intergovernmental organisation.

#### Filed or Registered Trade Marks as Relative Grounds for Refusal

9. - (1) Registration of a trade mark may be cancelled

1. if it is identical with an earlier filed or registered trade mark, and the goods or services for which the trade mark is registered are identical with the goods or services for which the earlier trade mark is filed or is registered;
  2. if because of its identity with, or similarity to, the earlier filed or registered trade mark, and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the other trade marks;
- (...)

#### Opposition

42. - (1) Within a period of three months following the date of publication of the registration of the trade mark pursuant to Section 41, the proprietor of an earlier trade mark may give notice of opposition to registration of the trade mark.

(2) The opposition may only be based on the grounds that the trade mark may be cancelled due to

1. an earlier filed or earlier registered trade mark pursuant to Section 9 (1), No. 1 or 2;
2. an earlier well-known trade mark pursuant to Section 10 in conjunction with Section 9 (1), No. 1 or 2; or
3. its registration for an agent or representative of the proprietor of the trade mark pursuant to Section 11.

(3) (deleted)

#### Objection Due to Non-use; Decision on the Opposition

43. - (1) If the proprietor of an earlier registered trade mark has given notice of opposition, he shall, if the other party contests the use of the trade mark, substantiate by *prima facie* evidence that, during the period of five years preceding the publication of the registration of the trade mark against which a notice of opposition has been given, the earlier registered trade mark has been put to use pursuant to Section 26, provided the earlier trade mark has at that date been registered for not less than five years. If the period of five years of non-use ends after the publication of the registration, the opponent shall, if the other party contests that use, substantiate by *prima facie* evidence that, during the period of five years preceding the decision on the opposition, the trade mark has been put to use pursuant to Section 26. In the decision, only those goods or services shall be considered of which use has been substantiated by *prima facie* evidence.

(2) If examination of the opposition reveals that the trade mark must be cancelled in respect of some or all of the goods or services for which it is registered, the registration shall be cancelled in full or in part. If the registration of the trade mark cannot be cancelled, the opposition shall be rejected.

(3) If the registered trade mark has to be cancelled because of one or several earlier trade marks, the proceedings with regard to further oppositions may be suspended until a decision on the registration of the trade mark has become final. (...)

#### Domestic Representative

96. - (1) Any person having neither a residence nor a seat nor an establishment in Germany may take part in proceedings before the Patent Office or the Patent Court, regulated by this Law, and may claim the rights conferred by the trade mark, only if he has appointed a patent attorney or an attorney-at-law in Germany as his representative, who shall be authorised to represent him in Patent Office and Patent Court proceedings and in civil litigation affecting the mark, and also file requests for the institution of criminal proceedings.

(2) Nationals of member states of the European Union or another contracting state of the Agreement on the European Economic Area may be appointed as representatives within the meaning of subsection 1 for rendering a service within the meaning of the Treaty Establishing the European Community, if they are authorised to pursue professional activities under any of the professional titles appearing in the respective applicable version of the annex to Section 1 of the Law on the Professional Activities of European Lawyers in Germany of 9 March 2000 [*Gesetz über die Tätigkeit europäischer Rechtsanwälte in Deutschland*] (BGBl. I p. 182) or the annex to Section 1 of the Law on the Qualifying Examination for Gaining Admission to the Profession of Patent Attorney of 6 July 1990 [*Gesetz über die Eignungsprüfung zur Zulassung zur Patentanwaltschaft*] (BGBl. I p. 1349, 1351). In such case, proceedings can only be conducted, if an attorney-at-law or a patent attorney in the Federal Republic of Germany has been appointed as authorised recipient.

(3) The place where the representative, appointed under subsection 1, has his business premises shall be deemed, within the meaning of Section 23 of the Code of Civil Procedure, to be the place where the assets are located. If there are no business premises, then the place where the representative has his domicile in Germany shall be relevant and, in the absence thereof, the place where the Patent Office has its seat.

(4) The termination of the appointment of a representative under subsection 1 shall be effective only after the termination of the appointment and the appointment of a new representative have been communicated to the Patent Office or the Patent Court.

#### Application of the Provisions of this Law; Language

107. (1) The provisions of this Law shall be applicable *mutatis mutandis* to the international registration of marks under the Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement) which are effected through the intermediary of the Patent Office or the protection of which extends to the territory of the Federal Republic of Germany unless otherwise provided in this Chapter or in the Madrid Agreement.

(2) All requests and other communications in the procedure concerning international registrations and the list of goods and services shall be submitted in French.

#### Examination as to Absolute Grounds for Refusal

113. - (1) International registration of marks shall be examined as to absolute grounds for refusal under Section 37 in the same way as marks in respect of which an application for registration has been filed. Section 37(2) shall not apply.

(2) Rejection of the application (Section 37(1)) shall be replaced by refusal of protection.

#### Opposition

114. - (1) For the purpose of international registrations, publications of the registration (Section 41) shall be replaced by publication in the gazette published by the International Bureau of the World Intellectual Property Organization<sup>1</sup>.

(2) The time limit for lodging opposition (Section 42(1)) against the grant of protection for international registrations shall start on the first day of the month following the month indicated on the issue of the gazette containing the publication of the international registration.

(3) Cancellation of the registration (Section 43(2)) shall be replaced by refusal of protection.

## Extract from the Trade Mark Ordinance version of 11 May 2004

#### Section 46

#### Refusal of Protection

(1) Where protection is, in full or in part, refused to an international registration the protection of which has been extended to the territory of the Federal Republic of Germany under Article 3ter of the Madrid Agreement or under Article 3ter of the Protocol Relating to the Madrid Agreement, and where this refusal is communicated to the International Bureau of the World Intellectual Property Organization to be transmitted to the proprietor of the international registration, the time limit for appointing a representative in Germany shall, to avoid final refusal, be fixed to four months from the date on which notification of refusal was dispatched by the International Bureau of the World Intellectual Property Organization.

(2) Where the refusal of protection has become final because the proprietor of the international registration has failed to appoint a representative in Germany, an objection to or an appeal from the refusal shall be filed with the German Patent and Trade Mark Office within one further month after the time limit of four months under subsection (1). Instructions about the proprietor's right to appeal shall be attached to the refusal. Sec. 61(2) of the Trade Mark Law shall apply *mutatis mutandis*.

<sup>1</sup> Gazette OMPI des marques internationales/WIPO Gazette of International Marks (published fortnightly) (Editor's note).

<sup>2</sup> Federal Law Gazette

598112

- 151 Date of the registration  
10.02.1993
- 180 Expected expiration date of the registration/renewal  
10.02.2013
- 270 Language of the application  
French
- Current Status
- 732 Name and address of the holder of the registration  
PIAGGIO & C. SPA  
Viale Rinaldo Piaggio, 25  
I-56025 PONTEDERA (PI) (IT)
- 811 Contracting State of which the holder is a national  
IT
- 740 Name and address of the representative  
ING. BARZANO' & ZANARDO MILANO  
S.p.A.  
Via Borgonuovo 10  
I-20121 MILANO (IT)
- 770 Name and address of the previous holder  
PIAGGIO & C. SPA  
Viale Rinaldo Piaggio, 25  
PONTEDERA (PI) (IT)
- 540 Mark  
**VESPA**
- 511 International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) - NCL(6)
- 09 Appareils et instruments scientifiques, nautiques, géodésiques, électriques, photographiques, cinématographiques, optiques, de pesage, de mesurage, de signalisation, de contrôle (inspection), de secours (sauvetage) et d'enseignement; appareils pour l'enregistrement, la transmission, la reproduction du son ou des images; supports d'enregistrement magnétiques, disques acoustiques; distributeurs automatiques et mécanismes pour appareils à prépaiement; caisses enregistreuses, machines à calculer, équipement pour le traitement de l'information et les ordinateurs; extincteurs.
- 18 Cuir et imitations du cuir, produits en ces matières non compris dans d'autres classes; peaux d'animaux; malles et valises; parapluies, parasols et cannes; fouets et sellerie.
- 25 Vêtements, chaussures, chapellerie.
- 821 Basic application  
IT, 29.12.1992, MI 9002 C/92
- 822 Basic registration  
IT, 10.02.1993, 587 059
- 300 Data relating to priority under the Paris Convention and other data relating to registration of the mark in the country of origin  
IT, 29.12.1992, MI 9002 C/92
- 831 Designation(s) under the Madrid Agreement  
DZ - EG
- 834 Designation(s) under the Madrid Protocol by virtue of Article 9sexies  
AT - BX - CH - CN - CZ - DE - ES - FR - HR - KP - MA - MC - PL - PT - SI - SK - VN
- ☐ Registration
- 450 Publication number and date  
1993/3 LMi, 14.05.1993

**831 Designation(s) under the Madrid Agreement**

BX - CH - CN - CZ - DE - DZ - ES - FR - KP - MA - MC - PT - SK - VN

**580 Date of recording (date of notification from which the time limit to notify the refusal starts)**

23.04.1993

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

BX

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

CH

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

CN

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

CZ

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

DZ

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

ES

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

FR

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

MA

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

MC

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

PT

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

SK

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

VN

☐ **862 Partial provisional refusal of protection**

KP

**450 Publication number and date**

Before April 1st, 1996, provisional refusals were not published

Delete from list:

25

☐ **861 Total provisional refusal of protection**

DE

**450 Publication number and date**

Before April 1st, 1996, provisional refusals were not published

☐ **Subsequent designation**

450 Publication number and date  
1994/2 LMi, 19.04.1994

831 Designation(s) under the Madrid Agreement  
AT

580 Date of recording (date of notification from which the time limit to notify the refusal starts)  
16.03.1994

891 Date of subsequent designation (Rule 24(6) of the Common Regulations)  
28.02.1994

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

AT

☐ 898 Other final decision  
DE

450 Publication number and date  
1994/8 LMi, 18.10.1994

Delete from list:

25

☐ Subsequent designation

450 Publication number and date  
1996/19 Gaz, 07.02.1997

831 Designation(s) under the Madrid Agreement  
HR - SI

580 Date of recording (date of notification from which the time limit to notify the refusal starts)  
26.12.1996

891 Date of subsequent designation (Rule 24(6) of the Common Regulations)  
17.10.1996

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

HR

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

SI

☐ 895 Statement indicating that the mark is protected for all the goods and services requested  
KP

450 Publication number and date  
1997/13 Gaz, 14.08.1997

☐ Subsequent designation

450 Publication number and date  
1998/9 Gaz, 18.06.1998

831 Designation(s) under the Madrid Agreement  
EG

851 Limitation of the list of goods and services  
EG

List limited to:

09

Appareils et instruments scientifiques, nautiques, géodésiques, électriques, photographiques, cinématographiques, optiques, de pesage, de mesurage, de signalisation, de contrôle (inspection), de secours (sauvetage) et d'enseignement; appareils pour l'enregistrement, la transmission, la reproduction du son ou des images; supports d'enregistrement magnétiques, disques acoustiques; distributeurs automatiques et mécanismes pour appareils à prépaiement; caisses enregistreuses, machines à calculer, équipement pour le traitement de

l'information et les ordinateurs; extincteurs.

**580** Date of recording (date of notification from which the time limit to notify the refusal starts)  
28.05.1998

**891** Date of subsequent designation (Rule 24(6) of the Common Regulations)  
30.03.1998

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

EG

☐ Subsequent designation

**450** Publication number and date  
1998/20 Gaz, 19.11.1998

**831** Designation(s) under the Madrid Agreement  
DE

**851** Limitation of the list of goods and services  
DE

List limited to:

25 Vêtements, chaussures, chapellerie.

**580** Date of recording (date of notification from which the time limit to notify the refusal starts)  
22.10.1998

**891** Date of subsequent designation (Rule 24(6) of the Common Regulations)  
07.08.1998

☐ Designated contracting party(ies) for which the second installment has been paid (Rule 40(3))

**450** Publication number and date  
2003/4 Gaz, 03.04.2003

**831** Designation(s) under the Madrid Agreement  
DE - EG - HR - SI

☐ Subsequent designation

**450** Publication number and date  
2003/13 Gaz, 07.08.2003

**831** Designation(s) under the Madrid Agreement  
PL

**580** Date of recording (date of notification from which the time limit to notify the refusal starts)  
17.07.2003

**891** Date of subsequent designation (Rule 24(6) of the Common Regulations)  
07.05.2003

The refusal period has expired and no notification of provisional refusal has been recorded (application of Rule 5 preserved)

PL