



OIFIG NA bPAITINNÍ
PATENTS OFFICE

Oifigí an Rialtais
Bóthar Hebron
Cill Chainnigh
Éire

Government Buildings
Hebron Road
Kilkenny
Ireland

Tel: (00-353-56) 7720111
Lo-Call: 1890-220223

Fax: (00-353-56) 7720100
Lo-Call Fax: 1890-220120

E-mail: patlib@entemp.ie
Website: www.patentsoffice.ie

World Intellectual Property Organisation
34, Chemin des Colombettes
PO Box 18
1211 Geneva 20
Switzerland

Date of Notification: 28 September 2009
Our Reference: TMOPP 2452

International Registration No: 0950870
Mark: METRO
Device
Holder: MIP METRO Group Intellectual Property GmbH & Co. KG

**Notification of the Irish Patents Office of refusal of protection
based on opposition**

Dear Sir/Madam,

This notification is issued pursuant to Article 5 of the Protocol relating to the Madrid Agreement concerning the International Registration of Marks and Rule 17(3) of the Common Regulations under the Agreement and Protocol, and is to inform you that protection for this mark is refused for the reasons set out below. [*Any references to Sections are to Sections of the Trade Marks Act, 1996 and to Rules are to Rules of the Trade Marks Rules, 1996.*]

Opposition to the granting of protection to the mark has been filed under Section 43 and Rule 18. A copy of the Notice of Opposition is enclosed.

The following are the Opponent's details:

Name: Metro International S.A.

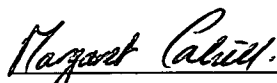
Address: 11 Boulevard Royal
L-2449 Luxembourg
Luxembourg

Address for Service: ANNE RYAN & CO
60, Northumberland Road
Ballsbridge
Dublin 4
Ireland

1. Where the Opponent has cited an earlier registration or pending application as grounds for the opposition, the details of the relevant mark(s) are as outlined in the enclosed printout(s). *Please see attached printout in respect of National Trade Mark Registration Number 219849.*
2. The refusal is in respect of the services in Class 35 insofar as it covers wholesale and retail trade services in relation to publication, newspapers and magazines, books and printed matter for which protection is sought.
3. The Holder may file a counter-statement, under Rule 19(1), in duplicate, not later than 27 December 2009.
4. If a counter-statement is not received within the time allowed, the Holder will be deemed to have withdrawn his request for protection of the mark. Under Rule 63(2) an extension of time for the purpose of filing a counter-statement is not allowed.
5. A counter-statement must be accompanied by an address for service within the European Community as required by Rule 10 as amended by Statutory Instrument 621 of 2007; failure to furnish such address will result in the Holder being deemed to have abandoned his request for protection.

Please quote our reference in all future correspondence.

Yours faithfully,



Margaret Cahill
Trade Marks Opposition Section
Direct Line (00 353 56) 7720185

TRADE MARKS ACT, 1996

IN THE MATTER OF
International Registration
No. 0950870
"METRO" (device) in
Class 35
in the name of MIP
METRO Group
Intellectual Property
GmbH & Co. KG

- and -

IN THE MATTER OF
an Opposition thereto by
Metro International S.A.

NOTICE OF OPPOSITION

We, Metro International S.A., a body corporate organised and existing under the laws of Luxembourg, of 11 Boulevard Royal, L-2449 Luxembourg, Luxembourg (hereinafter referred to as "the Opponents") hereby give notice of our intention to oppose the conferring of protection in the State to the mark METRO (device) (hereinafter referred to as "the Trade Mark") in Class 35 insofar as it covers wholesale and retail trade services in relation to publications, newspapers and magazines, books and printed matter advertised under Registration No. 0950870 in Patents Office Journal No. 2127 on June

24, 2009, in the name of MIP METRO Group Intellectual Property GmbH & Co. KG (hereinafter referred to as “the Proprietors”).

The Grounds of Opposition are as follows:

1. The Opponents have for many years carried on the business of marketing printed matter including daily newspapers and advertising papers.
2. The Opponents are the proprietors of Trade Mark Registration No. 219849 for the mark metro (device) covering goods in Class 16. An extract from the Register in respect of Trade Mark Registration No. 219849 is attached to this Notice of Opposition as Annex 1. Trade Mark Registration No. 219849 will be hereinafter referred to as “the Earlier Trade Mark”.
3. The Earlier Trade Mark is in use in connection with printed matter, including daily newspapers and advertising papers and the Earlier Trade Mark denotes and has long denoted both to the trade and the public goods manufactured by the Opponents and distinguishes such goods from the like goods of other manufacturers and traders.

4. The Trade Mark applied for offends against the provisions of the Trade Marks Act, 1996, and, in particular, it offends against the provisions of Sections 6, 8 and 10 thereof.
5. The Trade Mark for which registration is sought offends against the provisions of section 6 of the Trade Marks Act, 1996, in that it is not a trade mark as defined in that section as it is not capable of distinguishing the goods of the Proprietors from those of other undertakings.
6. Use of the Trade Mark by the Proprietors is likely to deceive the relevant public and registration of the Trade Mark in the State would offend against the provisions of Section 8(3)(b) of the Trade Marks Act, 1996.
7. The Trade Mark offends against the provisions of Section 10(1) of the Trade Marks Act, 1996, in that it is essentially identical to the Earlier Trade Mark owned by the Opponents and it is to be registered for services which embrace identical goods for which the Earlier Trade Mark is protected, so that there exists a likelihood of confusion on the part of the relevant public which includes the likelihood of association with the Earlier Trade Mark.
8. The Trade Mark offends against the provisions of Section 10(2) of the Trade Marks Act, 1996, in that it is similar to the Earlier Trade Mark owned by the Opponents and it is to be registered for services which embrace identical

goods for which the Earlier Trade Mark is protected, so that there exists a likelihood of confusion on the part of the relevant public which includes the likelihood of association with the Earlier Trade Mark.

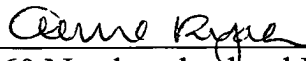
9. The Trade Mark offends against the provisions of Section 10(3) of the Trade Marks Act, 1996, in that it is similar to the Earlier Trade Mark owned by the Opponents and it is to be registered for services embracing similar goods for which the Earlier Trade Mark is protected, to the extent that the Earlier Trade Mark has a reputation in the State and in the wider European Community and use of the Trade Mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Earlier Trade Mark.
10. The Trade Mark offends against the provisions of Section 10(4) of the Trade Marks Act, 1996, in that it should not be registered as its use in the State is liable to be prevented by virtue of a rule of law protecting a sign used in the course of trade.
11. The Trade Mark offends against the provisions of Section 8(1)(b) of the Trade Marks Act, 1996, in that it is devoid of any distinctive character.

12. The Opponents respectfully request that the Controller exercise his discretion and refuse registration and thus extension of protection to the State of the Trade Mark and make an award of costs in favour of the Opponents.

Dated this 23rd day of September, 2009.

Metro International S.A.

By: ANNE RYAN & CO.

By: 
60 Northumberland Road,
Ballsbridge,
Dublin 4,
Ireland.

Agents for the Opponents

Annex 1



IRISH PATENTS OFFICE
OIFIG NA bPATINNÍ

Register of Trademarks**REGISTER OF TRADE MARKS**

Status Registered **Registration No.** 219849

Proprietor **Metro International S.A.**
11 Boulevard Royal
L-2449 Luxembourg
LUXEMBOURG

**Representation of
Mark**



Goods & Services **Class: 16**
Printed matter, including daily newspapers and advertising papers.

**Date of
Registration** 14/12/1998

**Date of
Publication of
Registration** 02/06/2004

Priority Date

**Registration
Renewed** 01/07/2008

**Address for
Service** **ANNE RYAN & CO.**
60 Northumberland Road
Ballsbridge
Dublin 4
IRELAND

Notings The mark is proceeding with the consent of the proprietors of
registered trade mark numbers 214567 and 214566.

13/12/2005 Change of Address for Service from F.R. KELLY & CO., 27 Clyde
Road, Dublin 4, IE to ANNE RYAN & CO., 60 Northumberland Road,
Dublin 4, IE recorded on 08/12/2005.

29/08/2006

Licence No.20510: Fortunegreen Limited of 3rd Floor, Embassy House, Ballsbridge, Dublin 4, , IE, recorded as exclusive licensee. Duration of the licence: without limit.

19/09/2008

Assignment No. 5972: from Tidnings AB Metro , Box 45075, S-104 30 Stockholm, Sweden to Metro International S.A., 11 Boulevard Royal, L-2449 Luxembourg, Luxembourg, by virtue of a Deed of Assignment dated 30/07/2008.

[Back to Previous Page](#)[Top of Page](#)[Database Home](#)[Go to Trade Mark
Query](#)

Patents Office, Government Buildings, Hebron Road, Kilkenny, Ireland | Phone: 353 56 7720111 | Fax: 353 56 7720100 |
E-mail: patlib@entemp.ie