



World Intellectual Property
Organisation (WIPO)
International Bureau
34, Chemin des Colombettes
1211 Geneva 20
Switzerland

Your Reference:
International Registration No:
WO0000001232192
Examiner: Heather Harrison
Direct Telephone: +44(0)1633814142
Date: 07 July 2015

Please reply by **07 September 2015** quoting the International Registration number

Intl Reg No: WO0000001232192
Mark: ENIGMA BY SIBERIAN HEALTH
Holder: Gorokhovskaya Tatyana Germanovna
Class(es): 3

Notification Of A Provisional Total Refusal Of Protection Based On An Opposition By The United Kingdom Intellectual Property Office In Accordance With Article 5 Of The Madrid Protocol

I am writing to inform 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 TM7 'Notice of Opposition', which includes details of any marks referred to in the statement of case, which was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

If the holder of the International Registration wishes to file a counterstatement, they must complete the form TM8 'Notice of defence and counterstatement', which is available at ipo.gov.uk/tmforms and **return it to this office** within **two months** of the date of this letter, i.e. on or before **07 September 2015**. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a TM8 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 TM8 can be extended for a further seven months by the filing the form TM9c 'Request for a cooling off period, which is available at ipo.gov.uk/tmforms

The TM8 should be received on or before the date requested above 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, another EEA state or the Channel Islands on a form TM33 'Appointment or change of agent or contact address', which is available at ipo.gov.uk/tmforms within this two month period.

If one is not provided within this time the refusal will be made final.

Yours faithfully,

Heather Harrison

Trade Marks Registry



Intellectual Property Office

Case details for trade mark UK 00002602684

Trade mark

**Trade
mark:**

ENIGMA

Status:

Registered

Relevant dates

Filing date:

28 November 2011

Date of entry in register:

02 March 2012

Renewal date:

28 November 2021

List of goods

Class 3:

Perfume; fine fragrance.

Class 4:

Perfumed candles; scented candles.

Name and Address details

Owner(s) name:

RDPR Limited

41 New England Street, New England
Quarter, Brighton, United Kingdom,
BN1 4GQ

Country of Incorporation:

United Kingdom

[View owner's other trade marks](#)

IPO representative name:

JA Kemp

14 South Square, Gray's Inn, London,
United Kingdom, WC1R 5JJ

Publication details

First advert:

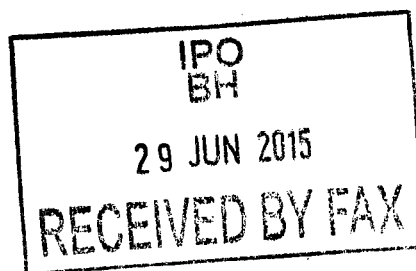
Journal : 6919 Date of publication :
23 December 2011

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Intellectual
Property
Office



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30JUN15 100.00 ACCOUNT 0P000404607

Form TM7

Notice of opposition and statement of grounds

Fee ☒ £100

Opposition based on Section 5(1) and/or 5(2) ONLY

☐ £200

Opposition based on, or including, any other grounds

Note: If you wish to oppose under Section 5(1) and/or 5(2) and one or more other grounds, the fee will be £200

Use this form to notify of an opposition to a trade mark application or international registration and to set out the grounds on which you are basing this opposition.

Do not use this form if you wish to file a Fast Track opposition under Section 5(1) and/or 5(2): use Form TM7F.

1. Trade mark number

Number of the trade mark you are opposing. If the opposition concerns an International Registration, help us identify the correct trade mark by adding "IR"

IR1232192

2. Full name of applicant/holder

Whose trade mark you are opposing

Gorokhovskaya Tatyana Germanovna

3. Full name of opponent

Person opposing the trade mark

RDPR Limited

Address

If the address is not within the United Kingdom, European Economic Area (EEA – which includes the European Union) or the Channel Islands you must have a representative in one of these regions and complete section 4 below

41 New England Street

New England Quarter

Brighton

United Kingdom

Postcode BN1 4GQ

Email address

Complete if you have no representative and would like us to correspond with you by email

4. Representative name

If you have no representative, go to section 5.

J A Kemp

Address

The address provided in this section must be in the UK, European Economic Area (EEA) or the Channel Islands.

14 South Square

Gray's Inn

London

United Kingdom

Postcode WC1R 5JJ

NOTE: We will communicate with the representative if this section has been completed.

Email address

Complete if you would like us to correspond with you by email

mail@jakemp.com

5. Related proceedings

If applicable, select location of any related proceedings and enter the case number allocated to the proceedings.

IPO Registry

UK Courts

OHIM

Number

6. Opposition notification date

If you have informed the applicant/holder of an intention to oppose the trade mark application, designation — enter the date you notified them.
[**See Note]

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

7. Declaration

I believe that the facts stated in this form and the attached statement of grounds are true.

Signature

J A Kemp

Name

(BLOCK CAPITALS)

J A KEMP

Date

29 Jun 2015

8. Your reference

Complete if you would like us to quote this in communications with you, otherwise leave blank.

Y40360GB BRM/sbg

Contact details

Name, daytime telephone number of the person to contact in case of query.

Ben Mooneapilly

01865 406 100

Number of sheets attached to this form

Checklist

Please make sure you have remembered to:

☒ Sign and date the form

☐ Complete fee sheet (Form FS2)

☐ Enclose the fee and fee sheet. Make cheques payable to Intellectual Property Office
Where to send

Intellectual Property Office
Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Please tick on what grounds you are opposing the trade mark and continue to the relevant section(s)

☒

Opposition is based on Sections 5(1) or 5(2): The trade mark is either identical or similar to an earlier trade mark and is to be registered for identical and/or similar goods and services.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark.

> **COMPLETE SECTION A**

☐

Opposition is based on Section 5(3): The trade mark is either identical or similar to an earlier trade mark which has a reputation. Using the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark. Ticking this box means that the total fee for this form is £200.

> **COMPLETE SECTION B**

☐

Opposition is based on Section 5(4)(a): Where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier right. Ticking this box means that the total fee for this form is £200.

> **COMPLETE SECTION C**

☐

Opposition is based on Section 3: The trade mark is excluded from registration because it describes the goods/services, or is not distinctive, or consists of signs that are customary within the trade, or the application was made in bad faith.

Note: Ticking this box means that the total fee for this form is £200.

> **COMPLETE SECTION D**

☐

Opposition is based on other grounds.

Note: Ticking this box means that the total fee for this form is £200.

> **COMPLETE SECTION E**

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

<input type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

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

ABOUT THE EARLIER TRADE MARK

Trade mark number
Your trade mark

00002602684

Type of mark
Please tick



UK

Community

International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.

ENIGMA

Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

Q2. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the publication date of the application you wish to oppose?

☐ Yes

☒ No > GO TO Q4

Q3. Has the trade mark been used?

☐ Yes

☐ No > GO TO Q3b

Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?

<input type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

> GO TO Q4.

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Q3b. Please state any proper reasons for non-use.

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DETAILS OF THE TRADE MARK YOU ARE OPPOSING

Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1 or Q3a (whichever is applicable)?

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services <i>(please specify below, use a continuation sheet if necessary)</i>

Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.

The mark applied for reproduces in its entirety, the Opponent's ENIGMA mark which, in relation to the goods for which the earlier mark is registered (and for which registration of the later mark is sought), is highly distinctive. In this connection, it is an established principle of trade mark law that the scope of protection afforded to highly distinctive trade marks is greater than the scope of protection afforded to marks with a low distinctive character. Whilst the mark applied for includes the addition of the words BY SIBERIAN HEALTH, these are wholly descriptive and the word ENIGMA clearly has an independent distinctive role in the mark applied for. Moreover, it is trite law that consumers pay greater attention to the beginning of a mark. As a result, the common element ENIGMA is to be considered most noticeable and dominant in the mark applied for.

In addition, the principle of interdependence established in the Canon case provides that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods. The goods of the mark applied for are highly similar and, in some cases, identical to the goods of the Opponent's earlier registration. Consequently, the differences between the marks which result from the addition of the descriptive elements 'BY SIBERIAN HEALTH' to the mark applied for, ought to be offset by the close proximity of the goods against which this Opposition is directed.

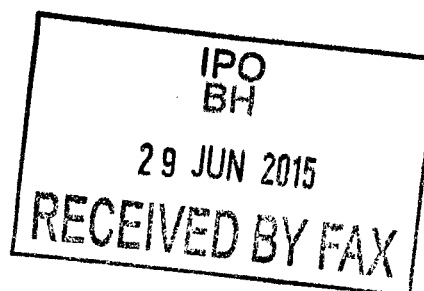
In view of the above, the Applicant considers that a likelihood of confusion is inevitable.

TM7

J A • KEMP

BY FAX

UK Intellectual Property Office
Concept House
Cardiff Road
Newport
NP10 8QQ



29 June 2015

Dear Sirs

UK Designation of International Trade Mark Registration No. 1232192
ENIGMA by Siberian Health
in Class 3
in the name of Gorokhovskaya Tatyana Germanovna
and Opposition thereto by RDPR Limited
Our Ref: Y40360GB BRM

Please find enclosed the following:

- Form TM7, a Notice of Opposition in the name of RDPR Limited;
- A Fee Sheet authorising the deduction of the official fee from our deposit account

We look forward to hearing from you.

Yours faithfully

J A KEMP

PATENT ATTORNEYS • TRADE MARK ATTORNEYS
LONDON • OXFORD • MUNICH

14 South Square, Gray's Inn, London WC1R 5JJ
T +44 20 3077 8600 F +44 20 7242 8932
mail@jakemp.com www.jakemp.com

A list of our partners is available at our principal place of business at the address above. Regulated by IPREG