

*Model Form 3*

**MADRID AGREEMENT AND PROTOCOL  
PROVISIONAL REFUSAL OF PROTECTION**

**Rule 17(1)**

***This form is to be used in the following situation: the Office considers that protection cannot be granted in the Contracting Party concerned (ex officio provisional refusal) or protection cannot be granted in the Contracting Party concerned because an opposition has been filed, or both. In due course, once all the procedures before the Office have been completed, the Office shall send to the International Bureau a statement regarding the final disposition on the status of the mark, using Model Forms 5 or 6, as the case may be.***

I. Office making the notification: <b>Ministry of commerce &amp; industry / intellectual property department / Sultanate of Oman.</b>
II. Number of the international registration: <b>1269362</b>
II. Name of the holder (or other indication enabling the identity of the international registration to be confirmed): <b>VINPROM PESHTERA S.A</b>
IV. <input type="checkbox"/> Provisional refusal based on an <i>ex officio</i> examination <input checked="" type="checkbox"/> Provisional refusal based on an opposition <sup>1</sup> <input type="checkbox"/> Provisional refusal based on both an <i>ex officio</i> examination and an opposition <sup>1</sup>
V. <input checked="" type="checkbox"/> Provisional refusal for all the goods and/or services <input type="checkbox"/> Provisional refusal for some of the goods and/or services: [followed by an indication of the goods and/or services which are affected or are not affected] <sup>2</sup>
VI. Grounds for refusal [(where applicable, see item VII)]:  (VI) article No.36/2 (VII) regulation of the industrial property Law No. 67/2008

<sup>1</sup> The name and address of the opponent should also be provided.

<sup>2</sup> Where all the goods or services included in a given class are to be mentioned, the indication should read "all goods (or all services) in class X". In all cases, a clear indication should be given as to whether those goods and/or services are affected, or are NOT affected.

VII. Information relating to an earlier mark<sup>3</sup> :

(i) Filing date and number, and, if any, priority date:

4371696 Filed on 3.5.2005  
11631983 Filed on 6.3.2013  
12167409 Filed on 24.9.2013 (priority : ITALY 28.6.2013)  
13409719 Filed on 28.10.2014  
726307 Filed on 2.12.1999  
1174331 Filed on 10.7.2013  
1127549 Filed on 18.5.2012  
1127550 Filed on 18.5.2012  
1127751 Filed on 18.5.2012  
1138832 Filed on 22.10.2012  
1152320 Filed on 3.1.2013  
1184756 Filed on 10.9.2013  
1242767 Filed on 10.2.2015

(ii) Registration date and number (if available):

4371696 Registered on 4.8.2006  
11631983 Registered on 25.4.2014  
12167409 Registered on 18.2.2014  
13409719 Registered on 11.3.2015  
726307 Registered on 2.12.1999  
1174331 Registered on 10.7.2013  
1127549 Registered on 18.5.2012  
1127550 Registered on 18.5.2012  
1127751 Registered on 18.5.2012  
1138832 Registered on 22.10.2012  
1152320 Registered on 3.1.2013  
1184756 Registered on 10.9.2013  
1242767 Registered on 10.2.2015

(iii) Name and address of the owner:

SENSI VIGNE & VINI S.R.L.  
Via cerbaia , 107 , Frazione cerbaia 1-51035  
Lamporecchio (PT) – Italy

(iv) Reproduction of the mark:

**SENSI**

(v) List of all or relevant goods and/or services: 33

IX. Information relating to subsequent procedure:

<sup>3</sup> Where the grounds on which the provisional refusal is based relate to an earlier mark, as indicated under item VI. The indication required under this item may be given by annexing a printout from the register or database.

(i) Time limit for requesting review or appeal:  
90 days

(ii) Authority to which such request for review or appeal should be made:  
Omani Intellectual Property Directorate

(iii) Indications concerning the appointment of a representative:  
A local agent must be appointed to defend the application and a list of registered agents is attached.

X. Date of the notification of provisional refusal:  
28.1.2016

XI. Signature or official seal of the Office making the notification:



XII. Corresponding essential provisions of the applicable law:

Article no. 38/2/(B)(C)(D):

(b) Any interested person may, within the period of ninety (90) days and in the prescribed manner, give notice to the Registrar of opposition, which shall be reasoned and in writing, to the registration of the mark on the grounds that one or more of the requirements of Sections 1 and 37(2) and the Regulations pertaining thereto are not fulfilled.

(d) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the mark should be registered.

The wine producing company, SENSI, was actually established in 1890, as may be deduced from the enclosed\* documentation and trademarks, and established itself right from the very beginning as one of the leading and best known companies in its sector.

We enclose\* a Chamber of Commerce search certificate for SENSI VIGNE & VINI S.R.L. (we clarify, for completeness, that the date of incorporation refers to the company as S.R.L., while the commercial business of the wine producing company actually started several decades earlier, as indicated above - 1890).

From the very beginnings this wine company has been a leader in its market sector, not just at national level, but also European and worldwide.

Both the name SENSI VIGNE & VINI S.R.L. and its own numerous SENSI trademarks (and many others) have, over all these decades, acquired great fame and notoriety at international and world level.

Our client, SENSI VIGNE & VINI S.R.L., therefore bases the present opposition on its following priority trademarks:

- Community Trademark Registration LUNGARNO CABERNET TOSCANA - SENSI N° 4371696, filed on 03.05.2005 and granted on 04.08.2006 in Class 33;
- Community Trademark SENSI N° 11631983 filed on 06.03.2013 and granted on 25.04.2014 in classes 29, 33 and 35;
- Community Trademark Registration 18 K SENSI no.12167409 filed on 24.09.2013 and granted on 18.02.2014 in class 33 (priority: ITALY 28.06.2013);

- Community Trademark SPRITZIN' BY SENSI N° 13409719 filed on 28.10.2014 and granted on 11.03.2015 in class 33;
- International Trademark Registration SENSI N° 726307 registered on 02.12.1999 in classes 29 and 33 (and subsequently renewed);
- International Trademark Registration 18 K SENSI N°1174331 registered on 10.07.2013 in class 33;
- International Trademark Registration DOLCEVITA DEI SENSI N°1127549 registered on 18.05.2012 in class 33;
- International Trademark Registration SENSI 1890 CAMPOLUCE N°1127550 registered on 18.05.2012 in class 33;
- International Trademark Registration CANTO ROSSO DEI SENSI N°1127751 registered on 18.05.2012 in class 33;
- International Trademark Registration MEMORIE DEI SENSI N°1138832 registered on 22.10.2012 in class 33;
- International Trademark Registration PRIMAVERA DEI SENSI N°1152320 registered on 03.01.2013 in class 33;
- International Trademark Registration VIAGGIO SENSI N°1184756 registered on 10.09.2013 in class 33;
- International Trademark Registration SENSIWINE N°1242767 registered on 10.02.2015 in class 33;

Herewith enclosed\* the certificate for those trademarks.

We also wish to underline the fact that SENSI also corresponds with the name of the founding family of the company SENSI VIGNE E VINI S.R.L., to which it gave its name. That name, therefore, as well as being famous and having historicity, also corresponds with the trade name of the above mentioned company.

That company name must be understood to be protected in all of the union countries under Article 8 of the Paris Convention on Industrial Property, which states the following:

*"the trade name will be protected in all the Union Countries whether or not it makes part of an industrial or commercial trademark".*

We refer you to that Article 8 and successive Articles of that Paris Convention.

From the day it was established, our client and its trademarks have seen a huge growth at national, community and international levels.

Furthermore, we indicate for completeness, our client has always participated, and continues to participate, at the most important and prestigious International Trade Fairs for wines, and at the world's most important events in the sector, as may be deduced from the enclosed\* documentation.

Furthermore, our client has won numerous **PRESTIGIOUS INTERNATIONAL AWARDS** for the quality of its wines and its other products, and for numerous years has been involved in many publicity campaigns, which have made the name SENSI VIGNE E VINI S.R.L. and its SENSI trademarks world-famous.

In this case we recommend you view the enclosed\* documentation.

**The great fame and notoriety of the SENSI trademarks and products is also easily seen from the fact that they are published in the most important and best known newspapers, magazines and publications worldwide (see enclosed\* documentation).**

**Our client's SENSI trademarks are therefore, very obviously, famous and well-known trademarks at international and worldwide levels. They distinguish very prestigious wines, the fruit of many decades of agronomic work and research, as well as a long list of other products such as food, oils and many others.**

We also indicate for completeness that our client is the owner of numerous other trademarks granted over likewise numerous years throughout most of the world, confirming its huge, intense and widespread international presence.

We therefore wish to indicate the following grounds.

The complete identity between the counterpart's SENSE trademark application and our client's priority trademark / trade name SENSI is totally obvious, and is set as the basis of the present opposition.

Analysing the counterpart's mark in its entirety and comparing it to our client's priority trademark, one can note that identity

**SENSE**

**SENSI**

**(counterpart)**

**(our client)**

The adversary mark is identical to our client's entire trademark.

The final letter E, moreover, is pronounced as "I". Therefore, there is a complete phonetical identity.

The letter E, in the final part of the sign, is not an element that can differentiate the counterpart's trademark application from our client's trademark and company name/trade name.

There is, very obviously, no element that could differentiate the counterpart's mark from our client's priority trademark and company name.

It is obvious that the counterpart has carried out a **VERY SERIOUS ACT OF COUNTERFEIT** by filing a trademark application that is identical to our client's priority trademark.

Furthermore, with regard to the comparison between the products lists, the total identity of the products claimed also appears just as obvious.

The counterpart is actually claiming products in class 33, which are completely identical to those claimed by our client in the same class 33.

In fact, in that class the counterpart has claimed nothing more than products belonging to the same, identical market sector as the products claimed by our client with priority (wines, etc.).

It is obvious that the average consumer, facing the counterpart's products, will incur very serious phenomena of association and confusion, to the detriment and damage of our client.

Therefore, the analysis unequivocally highlights the fact that the counterpart's trademark is identical to our client's priority trademarks.

The conceptual structure of the counterpart's trademark are identical to those of our client's priority trademarks.

It is therefore very obvious that the average consumer, also in consideration of their average attention level in relation to the type of products and services under consideration, will incur serious phenomena of confusion and association to the detriment and damage of our client.

The counterpart's mark totally lacks even the slightest minimum level of originality and distinction that could distinguish it from our client's priority trademark, and naturally, as previously indicated, its company / trade name.

**From all this one can therefore deduce the identity of the counterpart's mark with our client's priority trademark and its trade / company name, with the consequence that such identity will certainly create very serious phenomena of confusion and association between the marks in question, to the detriment and damage of our client.**

**Therefore, also in consideration of the average consumer's attention levels, the counterpart's attempt to counterfeit in order to unfairly exploit**



the notoriety of our client's trademark, which boasts rights that greatly predate the counterpart.

All this, furthermore, has caused and is causing grave damage to our client.

