



BUNDESPATENTGERICHT

28 W (pat) 528/22

(Aktenzeichen)

BESCHLUSS

In der Beschwerdesache

...

betreffend die Marke 30 2020 117 956

hat der 28. Senat (Marken-Beschwerdesenat) des Bundespatentgerichts am 21. Juni 2022 unter Mitwirkung des Richters Schödel sowie der Richterinnen Berner und Uhlmann

beschlossen:

1. Der Beschluss der Markenstelle für Klasse 4 des Deutschen Patent- und Markenamtes vom 21. Februar 2022 wird aufgehoben und die Sache zur erneuten Entscheidung an das Deutsche Patent- und Markenamt zurückverwiesen.
2. Die Rückzahlung der Beschwerdegebühr wird angeordnet.

Gründe

I.

Die Wortmarke

LUI OIL

ist am 11. Dezember 2020 angemeldet und am 12. Februar 2021 unter der Nummer 30 2020 117 956 in das beim Deutschen Patent- und Markenamt (DPMA) geführte Register eingetragen worden für Waren und Dienstleistungen der

Klasse 4: Schmiermittel, insbesondere Schmierstoffe und Schmieröle;
technische Öle und Fette; Brennstoffe;

Klasse 35: Einzelhandelsdienstleistungen und Großhandelsdienstleistungen mit den folgenden Produkten: Schmiermittel, insbesondere Schmierstoffe und Schmieröle, technische Öle und Fette, Brennstoffe, Reinigungsmittel, Kühlerfrostschutzmittel.

Gegen die Eintragung dieser Marke, die am 19. März 2021 veröffentlicht worden ist, hat die Beschwerdeführerin Widerspruch erhoben

1. aus dem EM-Teil ihrer am am 8. September 1998 international registrierten und auf eine russische Basisanmeldung vom 13. Mai 1998 zurückgehenden Wort-/Bildmarke IR 699 736 (Widerspruchsmarke zu 1.)

LUKOIL

die Schutz genießt für die Waren und Dienstleistungen der

Klasse 4: Industrial oils and greases; lubricants; non-chemical additives for motor fuel; cutting oils; lubricating grease,

2. aus dem EM-Teil ihrer am am 12. Mai 1997 international registrierten und auf eine russische Basisanmeldung vom 17. Mai 1996 zurückgehenden Wort-/Bildmarke IR 678 637 (Widerspruchsmarke zu 2.)

LUKOIL

die Schutz genießt für die Waren und Dienstleistungen der

- Klasse 1: Chemicals used in industry, science, photography as well as in agriculture, horticulture and forestry (with the exception of fungicides, herbicides and preparations for destroying vermin); unprocessed artificial resins, unprocessed plastic materials; fertilizers; fire-extinguishing compositions; leather-dressing chemicals, including tanning substances; adhesives (adhesive materials) for industrial use; biological, biochemical and bactericidal preparations and microorganism cultures, other than for medical or veterinary use; chemical substances for preserving foodstuffs and flowers; paper (not included in other classes); paper pulp; wood pulp; cinematographic and x-ray films, sensitized but not exposed; films sensitized but not exposed, earth for growing; substrates for soilless growing of plants; cellulose;
- Klasse 2: Paints, varnishes, lacquers; preservatives against rust and deterioration of wood; raw natural resins; mordants; metals in foil and powder form for painters, decorators, printers and artists; badigeon; undercoating for vehicle chassis; primers; coloring agents (not included in other classes) including food dyes and colorants; toners for copying apparatus and machines.
- Klasse(n) 03: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; scale-removing preparations for household purposes; perfumery, cosmetics; soaps; shampoos; make-up;
- Klasse 4: Dust-absorbing, wetting and binding compositions; fuel (including engine fuels) and combustible briquettes; gas and alcohols, not included in other classes; petroleum (raw or refined);

- Klasse 6: Base metals and their alloys; metals in powder form, except those for painters, decorators and artists; metal building materials and frameworks; metal buildings; metal pipes; non-electrical metallic cables and wires; works of art of common metal, not included in other classes; safes; ores of metal; non-electric ironmongery and small items of metal hardware; goods of base metals, not included in other classes; metal foils for wrapping and packaging; filings of metal; gratings of metal; metal fences; cermets; containers (of metal) for liquid fuel and gas; metal vats; poles (of metal) for electric lines;
- Klasse 7: Machines and machine tools; machine parts and machine tools; pumps, not included in other classes; motors (except for land vehicles) and parts thereof; equipment for petroleum extraction and processing, drilling equipment, not included in other classes; pneumatic tube conveyors; building and agricultural apparatus and machinery, including mini-apparatus for tilling; electrical kitchen machines; washing machines; sewing machines; electrical parquet wax-polishers; mechanically operated hand-held tools; electricity generators; vacuum cleaners; equipment used for gas separation, including apparatus equipped with membranes;
- Klasse 9: Scientific, nautical, surveying, photographic, cinematographic, weighing, measuring, signaling, checking (supervision) apparatus and instruments; audiovisual teaching apparatus; apparatus for recording, transmitting, amplifying and reproducing sound or images; telecommunication systems and facsimile machines; solar batteries; electric cells and batteries; telephone and radiotelephone apparatus; radiosonde observation apparatus; electric apparatus and machines used

for executing industrial processes by remote control and for controlling machines; vending machines; automatic coin-operated amusement machines; apparatus for games adapted for use with television receivers or monitors only; lasers, not for medical purposes; data processing equipment and computers; computer peripheral devices and interfaces; recorded computer programs, including programs for games and programs for use in teaching; videotapes, sound recording strips; electronic equipment for computerized workplaces; copying apparatus and machines (including electrostatic or thermal apparatus and machines); clothing for protection against accidents, irradiations and fire, including knee-pads for workers and bullet-proof vests; respiratory masks; integrated circuits; semi-conductors; photovoltaic cells; magnetic identity cards; breathing apparatus, except for artificial respiration; glasses (optical apparatus), binoculars (optical apparatus); spectacle frames; spectacle cases; chemistry apparatus and instruments; electric flat irons; electric door closers; electric devices for attracting and killing insects; slides; projection apparatus; magnetic data media; optical recording disks; sound recording disks; waveguides, optical fibers (light conducting filaments), antennas; smoke detectors; safety restraints (other than for vehicle seats or sports equipment);

Klasse 11: Lighting, heating, cooking, refrigerating, drying, ventilating, water supply and sanitary installations; tanning apparatus; disinfecting apparatus; clarifying installations; purification installations, machinery and apparatus, not included in other classes; desalination plants; air-conditioning installations; cryogenic equipment; electric ovens for household and industrial use, except those intended for experiments; electric

kettles, water heaters and samovars; electrically-heated cushions and blankets, for nonmedical use; sauna systems; shower cubicles; kitchen sinks; gas generators;

Klasse 12: Vehicles; apparatus for locomotion by land, air or water, including sports cars and trucks; bicycles; tractors; cable cars; functional, structural and decorative vehicle components (not included in other classes); apparatus, machines and devices for use in aeronautics, other than delta wings; seat covers for vehicles;

Klasse 14: Jewelry; religious objects, smokers' articles, crockery, tableware (except cutlery), vases, tankards, art objects, ornaments for shoes and clothing, coin purses, chain mesh purses and jewelry cases of precious metals or coated therewith, including those with embedded precious and semi-precious stones; medals, honorary medals, decorations; watches, watch chains, watchbands, cases for clock and watch-making, watch cases, including those which are made of precious metals or coated therewith; precious and semi-precious stones; precious metals, unwrought or semi-wrought; jewelry articles;

Klasse 16: Printed matter, including books, pamphlets, calendars, magazines (periodicals), newspapers, guidebooks; geographical maps; atlases; paintings, engravings; artwork made of papier-mâché not included in other classes; table linen of paper; towels, handkerchiefs and face towels of paper; labels, not of textile; flags and pennants of paper; playing cards; paper or plastic sachets and bags (wrappers, sleeves) used for packaging; plastic film for wrapping; paper for cooking in

microwave ovens; paper and paper goods not included in other classes, paintbrushes; artists' materials; training or teaching material (except apparatus); typewriters; stationery items; office requisites (except furniture); jackets for documents; covers (stationery) (except those which are made of leather and imitation leather); photographs; decalcomanias; stickers (stationery items); indoor aquariums; indoor terrariums (vivariums);

Klasse 19: Nonmetallic building materials, including sawn timber, lumber, framework for building, nonmetallic buildings; bricks, roof tiles and tiles, not of metal; road surfacing material; parquet flooring; granite; marble; artwork of stone, not included in other classes; nonmetallic monuments; nonmetallic jalousies;

Klasse 20: Furniture, pieces of furniture; nonmetallic furniture fittings; nonmetal chests; jewelry cases (not of precious metal); mirrors; frames for paintings and mirrors; moldings for picture frames; animal horns, bones and hooves; artwork (not included in other classes) of wood, cork, reed, birch bark, hemp fiber, horn, bone, plastic materials, mother-of-pearl, whalebone, wax and plaster; beehives; mattresses and pillows, including inflatable mattresses and pillows (for nonmedical use); sleeping bags for camping; goods of plastic materials not included in other classes; packaging containers of plastic, including nonmetal transport pallets, nonmetal boxes and bins, nonmetal barrels, nonmetal baskets; nonmetal containers for liquid fuel; tanks, not of metal nor of masonry; nonmetal bakers' bread baskets; curtain rods; nonmetal bungs and corks; mannequins; matriochkas (nest of Russian dolls);

- Klasse 21: Household or kitchen utensils and containers (not of precious metals or coated therewith), dishes, tableware (not of precious metal), vases, toilet utensils (not included in other classes); boxes of glass, bottles; vacuum bottles; cleaning instruments and equipment; fiberglass other than for insulation or textile use; art objects made of glass, porcelain, terra cotta and earthenware not included in other classes; majolica; birdcages, cages for farm animals; brushes (except paintbrushes);
- Klasse 29: Dried, preserved and cooked vegetables, fruits and mushrooms; jams, fruit jellies, stewed fruit; meat, including preserved meat; protein for human consumption; game; poultry (meat); edible oils and fats; tomato purée; milk and milk products; eggs and powdered eggs; fish and seafood products, including caviar and mussels (not living); preparations for making bouillon; bouillon concentrates, milk-based cream concentrates; crystallized fruits;
- Klasse 32: Beer; fruit juices; vegetable juices (beverages); mineral water (beverages); preserved drinking water; non-alcoholic beverages and preparations for making beverages;
- Klasse 33: Fruit extracts containing alcohol; balms containing alcohol (beverages); alcoholic beverages (except beer);
- Klasse 35: Advertizing; market studies; business and statistical information; sale by auction; import-export agencies; document reproduction; commercial or industrial management assistance; projects (business management assistance); computerized file management; office machines and equipment rental; organization of exhibitions for commercial or advertizing

purposes; employment agencies; business and statistical information on available jobs; business research; efficiency experts; sales promotion (for third parties); services relating to computer-aided sorting and processing of scientific research findings;

Klasse 36: Insurance underwriting; capital investment; credit bureaux; financial information; leasing of real estate; real estate management; mutual funds; charitable fund raising; banking; financial affairs, stock exchange quotations; brokerage; safe deposit services; customs brokerage; factoring;

Klasse 37: Vehicle service stations; vehicle repair, vehicle maintenance, vehicle cleaning; road paving and road surfacing repair; installation, maintenance and repair of machinery, refrigerating apparatus, electrotechnical and electronic apparatus; building construction, repair and cleaning; communication system installation for buildings; rental of construction equipment; explosion work; quarrying services; mining extraction, including gas and petroleum extraction; well drilling; trench digging; pipeline construction and maintenance;

Klasse 38: Communications by telegraphs and telephones; communications by computer terminals; television broadcasting, including cable television broadcasting; radio broadcasting; communications by telex machines and facsimile machines; access to specific communication channels; electronic mail; rental of message sending apparatus;

Klasse 39: Transport by pipelines; passenger or freight transportation; vehicle rental, rental of storage containers; chauffeur services;

garage rental; parking place rental; storage of goods; freight forwarding; tourist offices, except for hotel and boarding house reservations; transport brokerage; packaging of goods; message delivery;

Klasse 40: Purification, including ecological purification, purification of the air, water (ponds, drinking water, sewage water) and soil; woodworking; fur and leather conditioning; wool treating; metal treating; waste treatment (transformation); treatment of materials for making jewelry articles, clothing, works of art and handicrafts, drapery, furniture, technological equipment non-standardized on individual orders;

Klasse 41: Organization of shows; educational services; television program production; film production (including videotape film production); publishing of books, of handbooks; publication of texts, other than publicity texts; providing casino facilities (gambling); amusement parks; recording studio services; rental of sound recordings and videotapes; rental of cinematographic and photographic apparatus and accessories; rental of sports equipment (except vehicles); trainer services and operation of sports halls; organization of exhibitions for cultural or educational purposes; holding of seminars, congresses, symposia; impresario services; theatre productions, fashion shows, art gallery opening services; exhibitions for cultural or educational purposes held in bookshops and music stores, (except for sales departments); information pertaining to cultural and educational events; operating lotteries, organization of presentations and round-table discussions;

Klasse 42: Scientific research; surveying (engineer's services) and

technical research; engineering services for drafting scientific works; computer programming; services relating to engineering and know-how; information on new technologies; licencing of intellectual property; information and counseling services (unrelated to business dealings); editorial offices; translation services; legal services; beauty salons; massages, medical assistance; hotels; restaurants (meals); cafés; rest and convalescent homes; providing campground facilities; tourist homes; motels (not included in other classes); photography; industrial design and styling (industrial design); architecture; services provided by designers; providing facilities for exhibitions; rental of temporary accommodation; animal breeding; research and expert evaluations relating to ecology; testing of machines and mechanisms; quality control and granting of quality control certificates for materials, fuel, petroleum and gas; geological research and prospecting; video tape recording (filming),

3. aus dem EM-Teil ihrer am am 12. Mai 1997 international registrierten und auf eine russische Basisanmeldung vom 17. Mai 1996 zurückgehenden Wort-/Bildmarke IR 678 644 (Widerspruchsmarke zu 3.)

LUKOIL

die Schutz genießt für die Waren und Dienstleistungen der

- Klasse 1: Chemicals used in industry, science, photography as well as in agriculture, horticulture and forestry (with the exception of fungicides, herbicides and preparations for destroying vermin);

unprocessed artificial resins, unprocessed plastic materials; fertilizers; fire-extinguishing compositions; leather-dressing chemicals, including tanning substances; adhesives (adhesive materials) for industrial use; biological, biochemical and bactericidal preparations and microorganism cultures other than for medical or veterinary use; chemical substances for preserving foodstuffs and flowers; paper (not included in other classes); paper pulp; wood pulp; cinematographic and x-ray films, sensitized but not exposed; films sensitized but not exposed, earth for growing; substrates for soilless growing of plants; cellulose;

Klasse 2: Paints, varnishes, lacquers; preservatives against rust and deterioration of wood; raw natural resins; mordants; metals in foil and powder form for painters, decorators, printers and artists; badigeon; undercoating for vehicle chassis; primers; coloring substances (not included in other classes) including food dyes and colorants; toners for copying apparatus and machines;

Klasse 3: Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; scale-removing preparations for household purposes; perfumery, cosmetics; essential oils; soaps; shampoos; make-up;

Klasse 4: Dust-absorbing, wetting and binding compositions; fuel (including engine fuels) and combustible briquettes; gas and alcohols not included in other classes; petroleum (raw or refined);

Klasse 6: Base metals and their alloys; metals in powder form, except

those for painters, decorators and artists; metal building materials and frameworks; metal buildings; metal pipes; non-electrical metallic cables and wires; works of art of common metal not included in other classes; safes; ores of metal; non-electric ironmongery and small items of metal hardware; goods of common metals not included in other classes; foils of metal for wrapping and packaging; filings of metal; gratings of metal; metal fences; cermets; containers (of metal) for liquid fuel and gas; metal vats; posts (of metal) for electric lines;

Klasse 7: Machines and machine tools; machine parts and machine tools; pumps, not included in other classes; engines (except for land vehicles) and parts thereof; equipment for petroleum extraction and processing, drilling equipment, not included in other classes; pneumatic tube conveyors; building and agricultural apparatus and machinery, including mini-apparatus for tilling; electrical kitchen machines; washing machines; sewing machines; electric parquet wax-polishers; mechanically operated hand-held tools; electricity generators; vacuum cleaners; equipment used for gas separation, including apparatus equipped with membranes;

Klasse 9: Scientific, nautical, surveying, photographic, cinematographic, weighing, measuring, signaling, checking (supervision) apparatus and instruments; audiovisual teaching apparatus; apparatus for recording, transmitting, amplifying and reproducing sound or images; telecommunication systems and facsimile machines; solar batteries; electric cells and batteries; telephone and radiotelephone apparatus; radiosonde observation apparatus; electric apparatus and machines used

for executing industrial processes by remote control and for controlling machines; vending machines; automatic coin-operated amusement machines; apparatus for games adapted for use with television receivers or monitors only; lasers, not for medical purposes; data processing equipment and computers; computer peripheral devices and interfaces; recorded computer programs, including programs for games and programs for use in teaching; videotapes, sound recording strips; electronic equipment for computerized workplaces; copying apparatus and machines (including electrostatic or thermal apparatus and machines); clothing for protection against accidents, irradiation and fire, including knee-pads for workers and bullet-proof vests; respiratory masks; integrated circuits; semi-conductors; photovoltaic cells; magnetic identity cards; breathing apparatus, except for artificial respiration; spectacles, binoculars; spectacle frames; spectacle cases; chemistry apparatus and instruments; electric flat irons; electric door closers; electric devices for attracting and killing insects; slides; projection apparatus; magnetic data media; optical recording disks; sound recording disks; waveguides, optical fibers (light conducting filaments), antennas; smoke detectors; safety restraints (other than for vehicle seats or sports equipment);

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blankets, for nonmedical use; sauna systems; shower cubicles; kitchen sinks; gas generators;

Klasse 12: Vehicles; apparatus for locomotion by land, air or water, including sports cars and trucks; bicycles; tractors; cable cars; functional, structural and decorative vehicle components (not included in other classes); apparatus, machines and devices for use in aeronautics, with the exception of delta wings; seat covers for vehicles;

Klasse 14: Jewelry; religious objects, smokers' articles, crockery, tableware (except cutlery), vases, tankards, works of art, ornaments for shoes and clothing, coin purses, chain mesh purses and jewelry cases of precious metals or coated therewith including those with embedded precious and semi-precious stones; medals, honorary medals, decorations; watches, watch chains, watchbands, cases for clock and watch-making, watch cases, including those which are made of precious metals or coated therewith; precious and semi-precious stones; precious metals, unwrought or semi-wrought; jewelry articles;

Klasse 16: Printed matter, including books, pamphlets, calendars, magazines (periodicals), newspapers, guidebooks; geographical maps; atlases; paintings, engravings; works of art of papier-mâché not included in other classes; table linen of paper; towels, pocket handkerchiefs and face towels of paper; labels, not of textile; flags and pennants of paper; playing cards; paper or plastic sachets and bags (wrappers, sleeves) used for packaging; plastic film for wrapping; paper for cooking in microwave ovens; paper and paper goods not included in other

classes, paintbrushes; artists' materials; training or teaching material (except apparatus); typewriters; stationery items; office requisites (except furniture); folders for documents; covers (stationery) (except for those which are made of leather and imitation leather); photographs; decalcomanias; stickers (stationery items); indoor aquariums; indoor terrariums (vivariums);

Klasse 19: Nonmetallic building materials, including sawn timber, lumber, framework for building, nonmetallic buildings; non metallic bricks, roof tiles and tiles; road surfacing material; parquet flooring; granite; marble; art objects of stone, not included in other classes; nonmetallic monuments; nonmetallic jalousies;

Klasse 20: Furniture, pieces of furniture; nonmetallic furniture fittings; chests, not of metal; jewelry cases (not of precious metals); mirrors; frames for paintings and mirrors; moldings for picture frames; animal horns, bones and hooves; works of art (not included in other classes) made of wood, cork, reed, birch bark, hemp fiber, horn, bone, plastic materials, mother-of-pearl, whalebone, wax and plaster; beehives; mattresses and pillows, including inflatable mattresses and pillows (for nonmedical use); sleeping bags for camping; articles of plastics not included in other classes; packaging containers of plastic, including transport pallets, not of metal, nonmetal boxes and bins, barrels, not of metal, baskets, not of metal; containers, not of metal, for liquid fuel; tanks, not of metal nor of masonry; non-metallic bakers' bread baskets; curtain rods; nonmetallic bungs and corks; mannequins; matriochkas (nest of Russian dolls);

- Klasse 21: Household or kitchen utensils and containers (not of precious metals or coated therewith), dishes, tableware (not of precious metal), vases, toilet utensils (not included in other classes); boxes of glass, bottles; vacuum bottles; cleaning instruments and equipment; fiberglass other than for insulation or textile use; works of art made of glass, porcelain, terra cotta and earthenware not included in other classes; majolica; birdcages, cages for farm animals; brushes (except paintbrushes);
- Klasse 29: Dried, preserved and cooked vegetables, fruits and mushrooms; jams, fruit jellies, compotes; meat, including preserved meat; protein for human consumption; game; poultry (meat); edible oils and fats; tomato purée; milk and milk products; eggs and powdered eggs; fish and seafood products, including caviar and mussels (not living); preparations for making bouillon; bouillon concentrates, milk-based cream concentrates; crystallized fruits;
- Klasse 32: Beer; fruit juices; vegetable juices (beverages); mineral water (beverages); preserved drinking water; non-alcoholic beverages and preparations for making beverages;
- Klasse 33: Fruit extracts containing alcohol; balms containing alcohol (beverages); alcoholic beverages (except beer);
- Klasse 35: Advertizing; market studies; business and statistical information; auctioning; import-export agencies; document reproduction; commercial or industrial management assistance; projects (business management assistance); computerized file management; office machines and equipment rental; organization of fairs and exhibitions for commercial or

promotional purposes; employment agencies; business and statistical information on available jobs; business research; efficiency experts; sales promotion (on behalf of third parties); services relating to computer-aided sorting and processing of scientific research findings;

Klasse 36: Insurance underwriting; capital investment; credit bureaux; financial information; leasing of real estate; real estate management; mutual funds; charitable fund raising; banking; financial affairs, stock exchange quotations; brokerage; safe deposit services; customs brokerage; factoring;

Klasse 37: Vehicle service stations; vehicle repair, vehicle maintenance, vehicle cleaning; road paving and road surfacing repair; installation, maintenance and repair of machinery, refrigerating apparatus, electrotechnical and electronic apparatus; building construction, repair and cleaning; communication system installation for buildings; rental of construction equipment; explosion work; quarrying services; mining extraction, including gas and petroleum extraction; drilling of wells; trench digging; pipeline construction and maintenance;

Klasse 38: Communications by telegraphs and telephones; communications by computer terminals; television broadcasting, including cable television broadcasting; radio broadcasting; communications by telex machines and facsimile machines; access to specific communication channels; electronic mail; rental of message sending apparatus;

Klasse 39: Transport by pipeline; passenger and freight transportation; vehicle rental, rental of storage containers; chauffeur services;

garage rental; parking place rental; storage of goods; freight forwarding; tourist offices, except for hotel and boarding house reservations; transport brokerage; packaging of goods; message delivery;

Klasse 40: Purification, including ecological purification, purification of the air, water (ponds, drinking water, sewage water) and soil; woodworking; fur and leather conditioning; wool treating; metal treating; processing of waste (transformation); treatment of materials for use in making jewelry articles, clothing, works of art and handicrafts, drapery, furniture, technological equipment non-standardized on individual orders;

Klasse 41: Organization of shows; educational services; television program production; film production (including videotape film production); publishing of books, of manuals; publication of texts, other than publicity texts; providing casino facilities (gambling); amusement parks; recording studio services; rental of sound recordings and videotapes; rental of cinematographic and photographic apparatus and accessories; rental of sports equipment (except vehicles); trainer services and operation of sports halls; organization of exhibitions for cultural or educational purposes; holding of seminars, congresses, symposia; impresario services; theatre productions, fashion shows, art gallery opening services; exhibitions for cultural or educational purposes held in bookshops and music stores (except for sales departments); information pertaining to cultural and educational events; operating lotteries, organization of presentations and round-table discussions;

Klasse 42: Scientific investigations; surveying (engineer's services) and technical research; engineering work for drafting scientific works; computer programming; services relating to engineering and know-how; information on new technologies; licencing of intellectual property; advisory and information services (unrelated to business dealings); editorial offices; translation services; legal services; beauty salons; massages, medical assistance; hotel services; restaurants (meals); cafés; rest and convalescent homes; providing campground facilities; tourist homes; motels (not included in other classes); photographs; industrial design and styling (industrial design); architecture; services provided by designers; providing facilities for exhibitions; rental of temporary accommodation; animal breeding; research and expert evaluations relating to ecology; testing of machines and mechanisms; quality control and granting of quality control certificates for materials, fuel, petroleum and gas; geological research and prospecting; video tape recording (filming),

4. aus dem EM-Teil ihrer am 8. September 1998 international registrierten und auf eine russische Basisanmeldung vom 13. Mai 1998 zurückgehenden Wort-/Bildmarke IR 699 471 (Widerspruchsmarke zu 4.)

The logo for LUKOIL, featuring the word "LUKOIL" in a bold, black, sans-serif font. The letter "O" is replaced by a stylized black oil drop.

die Schutz genießt für die Waren und Dienstleistungen der

Klasse 4: Industrial oils and greases; lubricants; non-chemical additives for motor fuel; cutting oil; lubricating grease.

Mit Beschluss vom 21. Februar 2022 hat die Markenstelle für Klasse 4 des DPMA durch einen Beamten des gehobenen Dienstes eine Verwechslungsgefahr aufgrund des Widerspruchs aus den Widerspruchsmarken zu 1.) und 3.) bejaht und die angegriffene Marke gelöscht. Zur Begründung hat sie ausgeführt, die einander gegenüberstehenden Waren und Dienstleistungen seien identisch oder wenigstens hochgradig ähnlich. Die Widerspruchsmarken verfügten über eine durchschnittliche Kennzeichnungskraft. Es bestehe eine die Verwechslungsgefahr begründende hinreichende klangliche Ähnlichkeit zwischen den beiderseitigen Marken, da diese in fünf von sechs Buchstaben sowie deren Abfolge übereinstimmten, wobei die Anfänge und Endungen der Markennörter identisch seien. Sie verfügten jeweils über zwei Silben und denselben Sprechrhythmus.

Hiergegen richtet sich die Beschwerde des Inhabers der angegriffenen Marke. Er trägt vor, ihm sei der Widerspruch nicht zugestellt worden. Von dem vorliegenden Verfahren habe er erst durch den angefochtenen Beschluss erfahren. Auf telefonische Nachfrage habe die Markenstelle mitgeteilt, dass der Widerspruch auf postalischem Weg ohne Anforderung eines Empfangsbekennnisses an seine Verfahrensbevollmächtigten übersandt worden sei. Er habe bereits bei Anmeldung der angegriffenen Marke die Nutzung des elektronischen Postfachs beantragt. Über dieses sei ihm auch der angefochtene Beschluss zugestellt worden.

Der Inhaber der angegriffenen Marke beantragt,

1. den Beschluss der Markenstelle für Klasse 4 des Deutschen Patent- und Markenamtes vom 21. Februar 2022 aufzuheben und die Sache zur erneuten Entscheidung an das Deutsche Patent- und Markenamt zurückzuverweisen,
2. die Rückzahlung der Beschwerdegebühr anzuordnen.

Wegen der weiteren Einzelheiten wird auf den Akteninhalt Bezug genommen.

II.

Die nach § 66 Abs. 1 i. V. m. § 64 Abs. 6 MarkenG statthafte Beschwerde ist zulässig und führt gemäß § 70 Abs. 3 Nr. 2 MarkenG zur Aufhebung der angefochtenen Entscheidung und zur Zurückverweisung der Sache an das Deutsche Patent- und Markenamt.

1. Das Verfahren vor dem DPMA leidet an einem wesentlichen Mangel, weil die Markenstelle dem Inhaber der angegriffenen Marke den Widerspruch nicht zugestellt hat.

a) Nach § 70 Abs. 3 Nr. 2 MarkenG kann das Beschwerdegericht die angefochtene Entscheidung aufheben, ohne in der Sache selbst zu entscheiden, wenn das Verfahren vor dem Patent- und Markenamt an einem wesentlichen Mangel leidet. Von einem wesentlichen Mangel des Verfahrens im Sinne des § 70 Abs. 3 Nr. 2 MarkenG ist auszugehen, wenn es nicht mehr als ordnungsgemäße Grundlage für die darauf beruhende Entscheidung des DPMA anzusehen ist (BGH GRUR 1962, 86, 87 – Fischereifahrzeug).

b) Der Senat konnte vorliegend nicht feststellen, dass dem Inhaber der angegriffenen Marke der Widerspruch der Widersprechenden nachweislich zugegangen ist. In der elektronischen Akte befindet sich weder ein Empfangsbekanntnis seiner Zustellungsbevollmächtigten noch ein anderer Zustellungsnachweis. Der Vortrag des Inhabers der angegriffenen Marke, erst durch den angefochtenen Beschluss von dem vorliegenden Widerspruchsverfahren erfahren zu haben, ist daher nicht widerlegbar und glaubhaft.

c) Indem die Markenstelle in der Sache entschieden hat, ohne sicherzustellen, dass der Inhaber der angegriffenen Marke zu dem Widerspruch Stellung nehmen konnte, hat sie gegen den Grundsatz der Gewährung rechtlichen Gehörs gemäß § 59 Abs. 2 MarkenG verstoßen. In Rechtsprechung und Literatur wird überwiegend die Ansicht

vertreten, dass dieser Mangel in den meisten Fällen geheilt werden kann, da das Beschwerdegericht im Rahmen des Amtsermittlungsgrundsatzes gemäß § 73 Abs. 1 MarkenG das rechtliche Grhör nachträglich gewähren kann (vgl. BPatG 29 W (pat) 120/05 – HIER GEWINNEN SIE MEHR; 25 W (pat) 100/09 – Azzaro/Azzurro; Knoll in Ströbele/Hacker/Thiering, Markengesetz, 13. Aufl., § 70 Rdnr. 16). Im vorliegenden Fall ist der Verfahrensverstoß jedoch zu gravierend, als dass mit der nachträglichen Gewährung des rechtlichen Gehörs die Rechte des Inhabers der angegriffenen Marke in ausreichendem Maße gewahrt werden könnten. Durch die mangelnde Zustellung des Widerspruchs ist dieser in der Wahrnehmung seiner Rechte nicht bloß eingeschränkt, sondern vollständig gehindert. Ihm wird damit eine Entscheidungsinstanz genommen, so dass das Verfahren an das DPMA zurückzuverweisen ist (vgl. BPatG 28 W (pat) 28/19; Albrecht in BeckOK MarkenR, 29. Ed. 1.4.2022, MarkenG § 70 Rdnr. 39).

Eine andere Beurteilung ergibt sich auch nicht unter dem Gesichtspunkt der Prozessökonomie. Da der angefochtene Beschluss erst vor vier Monaten ergangen ist, wiegt der durch die Zurückverweisung eintretende Zeitverlust nur gering gegenüber dem ansonsten erfolgenden Verlust einer Entscheidungsinstanz.

2. Die Rückzahlung der Beschwerdegebühr ist nach § 71 Abs. 3 MarkenG anzuordnen. Dies entspricht der Billigkeit, weil nicht ausgeschlossen werden kann, dass die Beschwerde bei korrekter Sachbehandlung vermieden worden wäre.

III.

Gründe für eine Kostenauflegung aus Billigkeitsgründen nach § 71 Abs. 1 Satz 1 MarkenG sind nicht gegeben.

IV.

Rechtsmittelbelehrung

Gegen diesen Beschluss ist das Rechtsmittel der Rechtsbeschwerde nur gegeben, wenn gerügt wird, dass

1. das beschließende Gericht nicht vorschriftsmäßig besetzt war,
2. bei dem Beschluss ein Richter mitgewirkt hat, der von der Ausübung des Richteramtes kraft Gesetzes ausgeschlossen oder wegen Besorgnis der Befangenheit mit Erfolg abgelehnt war,
3. einem Beteiligten das rechtliche Gehör versagt war,
4. ein Beteiligter im Verfahren nicht nach Vorschrift des Gesetzes vertreten war, sofern er nicht der Führung des Verfahrens ausdrücklich oder stillschweigend zugestimmt hat,
5. der Beschluss aufgrund einer mündlichen Verhandlung ergangen ist, bei der die Vorschriften über die Öffentlichkeit des Verfahrens verletzt worden sind, oder
6. der Beschluss nicht mit Gründen versehen ist.

Die Rechtsbeschwerdeschrift muss von einer beim Bundesgerichtshof zugelassenen Rechtsanwältin oder von einem beim Bundesgerichtshof zugelassenen Rechtsanwalt unterzeichnet und innerhalb eines Monats nach

Zustellung des Beschlusses beim Bundesgerichtshof, Herrenstraße 45a, 76133 Karlsruhe eingereicht werden. Die Frist kann nicht verlängert werden.

Schödel

Berner

Uhlmann

Li