


MADRID AGREEMENT AND PROTOCOL
PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

I. Office making the notification: FEDERAL SERVICE FOR INTELLECTUAL PROPERTY (ROSPATENT) 30-1, Berezhkovskaya nab., 125993, Moscow, G-59, GSP-3, Russian Federation Fax: +7 (495) 531-63-53 / phone: +7 (499) 240-60-15
II. Number of the international registration: 1396784
III. Name of the holder: Grupa Topex Sp. z o.o. Sp. k.
IV. Reproduction of the mark: <div style="text-align: center; margin-top: 10px;">  </div>
V. Provisional refusal based on an ex officio examination
VI. PARTIAL provisional refusal concerning SOME of the goods and/or services. Following goods and/or services are NOT affected by refusal: Cl. 06: "Angle irons, padlocks, ropes of metal, wire rope, couplings of metal for chains, chains of metal, safety chains of metal, nuts of metal, wire stretchers (tension links), stretchers for metal bands (tension links), tension links, boxes, tool boxes of metal (empty), rope thimbles of metal, ferrules of metal for handles, chimney pots of metal, rings of metal, stop collars of metal, straps of metal for load handling, straps, of metal, for handling loads, ferrules of metal for handles, chests of metal, springs (metal hardware), screws of metal, steel strip, bands of metal for tying-up purposes, iron strip, bushings (metal hardware), clips of metal, cable clips of metal, pipe or cable clips of metal, vehicle locks of metal, locks (other than electric) of metal, bolt locks, closures of metal for containers, closures of metal for boxes, door closers, non-electric, bolts, bolts (housing), door latches, of metal, stoppers (metal hardware), foils of metal for wrapping and packaging, cotter pins, linchpins, valves of metal (other than parts of machines), tanks of metal, metal staples for construction or industrial use, straps of metal for handling loads, bolts of metal, cashboxes of metal, clothes hooks of metal, bells (non-electric), door bolts, door cases of metal, door fittings, of metal, door frames of metal, door handles of metal, door knockers, openers (non-electric), door scrapers, door stops of metal, stiffeners of metal, fittings of metal for building, fittings of metal for compressed air ducts, fittings of metal for furniture, window fittings of metal, gratings of metal, ironmongery, hinges of metal, hooks of metal, identity plates of metal, door fittings of metal, window fittings of metal, knobs of metal, handles of metal, ladders of metal, letterboxes of metal, clamping rings of metal, locks of metal for bags, nails, grease nipples, numberplates of metal, rivets of metal; lead seals, soldering wire of metal, spring locks, towing cables of metal, profile inserts of metal."

Cl. 07: "Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; electric tools, drilling machines, driver drills, hammer drills, trueing machines, saws, screwdrivers, power screwdrivers, jig-saws, planes, electric stapling presses, mixers, milling machines, cutters (machines), vacuum cleaners, nail guns, bits (parts of machines), chisels, circular saws, grindstones (parts of machines), discs (parts of machines), brushes (parts of machines), grinding wheels, drill chuck keys, intake manifolds for engine and motors, glue guns, spray guns, tyre inflating guns with manometers, inflating guns, washing guns, spray guns, sand blast guns, air and water guns for cleaning, silicone guns, compressed air guns for the extrusion of mastics, electric glue guns, guns (machines), spray guns for paint, guns included in this class, pneumatic wrenches, bearing rod ends, gas-operated cutting torches, machines and apparatus for cleaning and washing (electric), electric power generators, engraving machines, die-cutting and tapping machines, nut-tapping machines, threading machines, compressors (machines), cutters (machines), blades for lawnmowers, reapers (machines), lawnmowers (machines), metalworking machines, mixers (machines), hammers (parts of machines), electric hammers, power hammers, pneumatic hammers, rotary hammers, hammers, tools (parts of machines), hand-held tools, other than hand-operated, riveting machines, knives (parts of machines), electric knives, electric shears, electric scissors, blades (parts of machines), sharpening machines, tables (parts of machines), adhesive bands for pulleys, adhesive tape dispensers (machines), pumps (machines), pumps (parts of machines, engines or motors), air pumps (garage installations), saws (machines), chainsaws, stands for machines, electric machines and apparatus for polishing, pumps (machines), emergency power generators, notches (machine tools), planing machines, mine borers, drill bits (parts of machines), latches (machine tools), conveyors (machines), crushing machines, chucks (parts of machines), blade holders (parts of machines), drill chucks (parts of machines), hoists, cutting machines, finishing machines, die-stamping machines, handling apparatus for loading and unloading, wrapping machines, valves (parts of machines); air suction machines, sharpening machines, compressed air machines, elevators (lifts), jacks (machines), filters for cleaning cooling air, for engines, machines for working glass, crushing machines, grindstones (parts of machines), lubricators (parts of machines), holding devices for machine tools, labellers (machines), mixing machines, painting apparatus, planing machines, pressure reducers (parts of machines), reduction gears other than for land vehicles, rings (parts of machines), soldering apparatus, gas-operated, soldering irons, gas-operated, atomisers (machines), stone working machines, tilt hammers, tools (parts of machines), apparatus for dressing, stirrers (machines), jig-saws, saws (machines), high-pressure washers, grindstones (parts of machines), saw blades (parts of machines), stands (parts of machines), fittings for guns (parts of machines), cartridges for filtering machines, pneumatic air tools, pneumatic tools, expanders (machines), welding machines, wire brushes (parts of machines); welding apparatus, electric; soldering apparatus, electric; soldering irons, electric; electric charge welding apparatus; welding electrodes; soldering lamps."

Cl. 08: "Hand tools (hand operated) for gardening; cutlery; side arms; blades; hand tools (hand-operated), hand tools, non electric, hand tools for agricultural purposes, garden tools (hand-operated), side arms, insecticide atomizers (hand tools), awls, axes, hatchets, bill-hooks, bits (parts of hand tools), hand drills (hand tools), blades (hand tools), blades (weapons), blades for planes, borers, bow saws, braidiers (hand tools), branding irons, breast drills, tin openers (non-electric), caulking irons, centre punches (hand tools), priming irons, chisels, choppers (knives), clamps for carpenters or coopers, cleavers, cutter bars (hand tools), cutlery; cutter bars [hand tools], cutting tools (hand tools), dies (hand tools), diggers (hand tools), ditchers (hand tools), drawing knives, drill holders (hand tools), earth rammers (hand tools), edge tools (hand tools), expanders (hand tools), files (tools), irons, non-electric, scouring knives, frames for handsaws, fruit pickers (hand tools), gouges (hand tools), graving tools (hand tools), grindstones (hand tools), guns (hand tools), hammers (hand tools), hand pumps, hatchets, hunting knives, hoists (hand-operated), jig saws, sharpening steels, knives, mortise chisels, nail drawers (hand tools), nail extractors, needle files, pincers, numbering punches,

plane irons, rabbeting planes, tongs, pincers, pruning knives, pruning scissors, pruning shears, punch pliers (hand tools), punches (hand tools), rasps (hand tools), ratchets (hand tools), razor blades, riveters (hand tools), riveting hammers (hand tools), screw stocks (hand tools), screwdrivers, screwdrivers, blade sharpening instruments, sharpening steels, sharpening stones, grindstones (hand tools), shear blades, shearers (hand instruments), shears, saw blades (parts of hand tools), saw blades, saw holders, saws (hand tools), scaling knives, scissors, scrapers (hand tools), scraping tools (hand tools), shovels (hand tools), sledgehammers, spades (hand tools), spanners (hand tools), wrenches (hand tools), spatulas (hand tools), squares (hand tools), stamping-out tools (hand tools), stamps (hand tools), bushhammers, grindstones, tap wrenches, tube cutters (hand tools), tube cutting instruments, tweezers, scythe stones, sheet metal hammers, crow bars, locksmith accessories, namely handles for hand-operated hand tools, screw stocks, tap wrenches, threading dies, screwdrivers, nail sets, hole cutters; saws for cutting metal, saws for cutting wood, special-purpose saws, angle saws, mitre boxes, coarse files, hand screws, trowels and paint pads, hand tools for glass, tiling tools, squeezers (hand tools), wrenches and pliers for pipes, screwdriver bits, socket sets, sockets and accessories (parts of hand tools), wrenches, automotive wrenches, tackers (hand operated -), grease guns (hand tools), fittings for grease guns (parts of hand tools), hand-operated grease guns, oil suction guns (hand tools), oil pumps (hand tools), multi-purpose hand tools, vices, metal vices, assembly belts, penknives, fitter's knives, knives with utility blade, snap-off blade knives, precision knives; spanners; handles of metal for tools; knife handles of metal; sharpening stones; milling cutters (hand tools); flat irons, electric."

Cl. 09: "Scientific, nautical, surveying, optical, weighing, measuring, signalling, checking (supervision), life-saving apparatus and instruments; apparatus and instruments for conducting, transforming, accumulating, regulating or controlling electricity; fire-extinguishing apparatus; accumulators, electric, accumulators, electric, for vehicles, acidimeters for batteries, alarms, sound alarms, fire alarms, acoustic (sound) alarms, alarm bells, electric, theft prevention installations, electric, electric locks, batteries for lighting, batteries for pocket lamps, batteries, electric, battery chargers, detectors, metal detectors for industrial and army use, smoke detectors, light dimmers (regulators), electric, distance measuring apparatus, calipers, lasers, not for medical purposes, levelling instruments, levelling staffs (surveying instruments), surveyors' levels (spirit levels), instruments for determining the horizontal, measures, measuring instruments, measuring instruments for special purposes, slide calipers, rulers (measuring instruments), rulers (measuring instruments), micrometer screws for optical instruments, micrometers, scales, precision balances, precision measuring apparatus, roll-up measuring tapes (short), folding rules, measuring tapes, masonry levels, spirit levels, laser levels, manometers, probes, slope indicators, temperature indicators, pressure gauges, automatic indicators of low pressure in vehicle tyres, pressure indicator plugs for valves, pressure indicators, pressure measuring apparatus, binoculars, monoculars, prisms (optics), protection devices for personal use against accidents, protective clothing, life-saving clothing, protective work clothing [for protection against accident or injury], reflective articles for wear, for the prevention of accidents, elbow protectors (protective -) for use against accidents [other than sports articles], shin guards for protection against injury [other than sports articles or parts of sports suits], safety helmets, protective masks, workmen's protective face-shields, gloves for protection against accidents, filters for respiratory masks, goggles, protecting masks, gas masks, dust protection masks, dust masks, helmets, welding shields and goggles, gloves for protection against radiation, gloves for divers, solderers' helmets, plugs and other contacts (electric connections), voltmeters, connections for wires and electric lines, application start-up platform, computer software enabling Internet and P2P connections via a computer network; electronic publications, electronic notice boards, laser."

Cl. 11: "Apparatus and installations for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply; bicycle lights, solar collectors [heating], lighters for gas, water heaters, filters [parts of household or industrial installations], filters for

air conditioning, gas lamps, gas burners, miners' lamps, lamp globes, laboratory lamps, laboratory burners, Chinese lanterns, lamp shades, lamp globes, lamp mantles, burners for lamps, lamp fixtures, safety lamps, electric lamps, sockets for electric lights, luminous tubes for lighting, arc lamps, oil lamps, lamps, ultraviolet ray lamps, not for medical purposes, lanterns, electric pocket torches, lanterns for lighting, gas scrubbing apparatus, oil-scrubbing apparatus, air purifying apparatus and machines, brackets for gas burners, security devices for lighting, lighting apparatus for vehicles, ceiling lights, light bulbs, burners, brackets for gas burners, oil burners, gas scrubbers [parts of gas installations], lamp reflectors, halogen lamp fittings included in this class, workshop lamps, glue-heating appliances, hot air apparatus, electric light bulbs; heat guns."

Cl. 16: "Drawing rulers, pencils, paintbrushes, seals (stamps), painters' brushes, rollers, paint rollers, wall-painting rollers; ceiling brushes (flat paintbrushes), rolls (paintbrushes), roller handles, painting films, painting sets, tracing tools for creating lines on surfaces, self-adhesive pads, adhesive tapes for stationery or household purposes, adhesives (glues) for stationery or household purposes, marking chalk, chalk holders, paper knives (office requisites)."

VII. Grounds for refusal

Absolute grounds: **The following term "heat guns" repeats in the list of goods in class 11. We inform you that the duplicates (reiterations) of terms in the list of goods or/and services is deemed as a technical error in accordance with the Civil Code of the Russian Federation. The duplicates (reiterations) will be deleted in the list of goods or/and services in the Final decision following by provisional refusal after time limit expiring (six month). If you do not agree with the deletion of duplicates (reiterations) you have to present your response with arguments through a trademark attorney registered on the territory of the Russian Federation.**

Disclaimer required for the following element or elements of the mark that are not protectable: **TOOLS for all claimed goods.**

N.B. A disclaimer states that the owner **will not claim exclusive rights** to the specified element or elements that are not protectable in the mark **apart from the mark as a whole**. A disclaimer does not physically remove element or elements of a mark that are not protectable from your mark or affect the appearance of your mark. A disclaimer statement will appear on the final statement of grant of protection.

VIII. Corresponding essential provisions of the applicable law [(see text under XII and Annex 1)]:

1497 (3); 1483 (1) (3)


IX. Information relating to subsequent procedure:

(i) TIME LIMIT for submitting your response and requesting review: **SIX (6) MONTHS** from the date of the notification of provisional refusal indicated under X. Please note that the extension of the time period established for response is NOT permitted.

(ii) Authority to which such request for review or appeal should be made: **Federal Service for Intellectual Property (ROSPATENT)**

(iii) Indications concerning the appointment of a representative:

Under Article 1247 of Part IV of the Civil Code of the Russian Federation "citizens permanently residing out of the territory of the Russian Federation and foreign legal entities shall exercise proceedings with the federal executive authority for the intellectual property through **patent attorneys**, registered by this federal authority, unless otherwise provided for by an international treaty of the Russian Federation".

Information Search for Russian Patent Attorneys: http://www.fips.ru/sitedocs/patpov_en.htm	
X.	Date of the notification of provisional refusal: 01/11/2018
XI.	Signature of the Office making the notification: <div style="text-align: right;"> Larisa Titova</div>
XII.	Corresponding essential provisions of the applicable law: Civil Code of the Russian Federation (as amended up to Federal Law No. 35-FZ of March 12, 2014) (for excerpts see Annex 1)

Annex 1

Civil code of the Russian Federation (excerpts)

Article 1477. The Trademark and the Service Mark

1. An exclusive right certified by a trademark certificate (Article 1481) is recognized for the trademark, i.e. a designation serving for individualizing goods of legal entities or individual entrepreneurs.
2. The rules of the present Code concerning trademarks are applicable to service marks, i.e. to designations serving for individualizing the works or services performed/provided by legal entities or individual entrepreneurs respectively.

Article 1479. The Effect of Exclusive Right to a Trademark on the Territory of the Russian Federation

An exclusive right to a trademark registered by the federal executive governmental body charged with intellectual property matters is effective on the territory of the Russian Federation as well as in the other cases envisaged by an international treaty of the Russian Federation.

Article 1482. The Types of Trademarks

1. Word, image, 3-dimensional and other designations or combinations thereof may be registered as trademarks.
2. A trademark may be registered in any color or in any color-combination.

Article 1483. Grounds for Refusing State Registration to a Trademark

1. No trademark state registration shall be granted to designations not having a distinguishing capability or composed only of elements:

- 1) that have come into general usage as designations for goods of a certain kind;
- 2) being generally-accepted symbols and terms;
- 3) that characterizes goods, for instance indicating their kind, quality, quantity, properties, intended purpose, value, and the time, place and method of their manufacture or sale;
- 4) representing a form of goods that is defined exclusively or mainly by the properties or intended purpose of the goods.

The said elements may be included in a trademark as non-protected elements, unless they dominate therein.

- 1.1. The provisions of paragraph 1 of this article are not applicable to designations which:

- 1) have acquired a distinctive capability as the result of the use thereof;
 - 2) consist only of the elements referred to in subparagraphs 1 - 4 of paragraph 1 of this article and forming a combination that has the distinctive capability.
2. No trademark state registration shall be granted to designations that are related to objects that are not subject of legal protection in accordance with Article 1231.1 of the present Code, or that are confusingly similar to them.
3. No trademark state registration shall be granted to designations which are or comprise elements:
- 1) which are false or capable of misleading the consumer concerning goods or the manufacturer of goods;
 - 2) which conflict with the public interest and with humanity and moral principles.
4. No trademark state registration shall be granted to designations identical or similar to the extent of confusion with the official names and images of especially-precious objects of cultural heritage of the peoples of the Russian Federation or objects of world cultural or natural heritage, and also with images of cultural valuables preserved in collections, collected items and stocks if registration is sought in the names of persons not being owners without the consent of the owners or persons authorized by the owners for these designations to be registered as trademarks.
5. In accordance with an international treaty of the Russian Federation, no trademark state registration shall be granted to designations which are or which comprise elements protected in a member state of that international treaty as designations allowing identification of wines or alcoholic beverages as originating from its territory (produced within the borders of a geographical object of that state) and having a special quality, reputation or other characteristics predominantly defined by the origin thereof, if the trademark is intended for designating wines or alcoholic beverages not originating from the territory of the given geographical object.
6. No trademark registration shall be granted to designations identical or confusingly similar with:
- 1) other persons' trademarks, which were applied for registration (article 1492) with respect to similar goods and having an earlier priority, if the application for state registration of the said trademark has not been withdrawn, deemed withdrawn or no decision has been taken with respect to the refusal in its state registration;
 - 2) other persons' trademarks protected in the Russian Federation, including under an international treaty of the Russian Federation for similar goods and having an earlier priority;
 - 3) other persons' trademarks that have been recognized in the procedure established by the present Code as well-known trademarks in the Russian Federation, in respect of similar goods from earlier date than the priority of the claimed designation.
- The registration of a designation as trademark for similar goods confusingly similar to any of the trademarks indicated in sub-points 1 and 2 of the present point is allowed with the consent of the right holder provided that such a registration shall not cause confusion to a consumer. The consent can not be withdrawn by the right holder.
- The provisions provided by the fifth paragraph of this point shall not apply in respect of designations confusingly similar to collective marks.
7. No trademark registration shall be granted to designations identical or confusingly similar to an appellation of origin of goods, protected in accordance with the present Code, as well as to a designations, that were applied for registration as such until the priority date of the trademark, except for the case when such an appellation or a designation confusingly similar to it is included as a non-protected element into a trademark registered in the name of a person having the exclusive right for such an appellation, if the registration of the trademark is carried out with respect to the same goods for the individualization of which the appellation of origin is registered.
8. No trademark registration shall be granted for similar goods to designations identical or confusingly similar to a company name or a commercial name (specific elements of such names) protected in the Russian Federation or with the name of a selection invention registered in the State Register of Protected selection inventions to which rights has emerged owned by other persons in the Russian Federation prior to the priority date of the trademark being registered.

9. No trademark registration shall be granted to designations identical to:

1) the title/name of a scientific, literary or artistic work, a character or quotation from such work, known in the Russian Federation as of the date of filing of the trademark state registration application (Article 1492) or to an artistic work or a fragment thereof without the consent of the right holder, if rights to the relevant work emerged prior to the priority date of the trademark being registered;

2) the name (article 19), pseudonym (paragraph 1 of article 1265 and subparagraph 3 of paragraph 1 of article 1315) or designations that are derived from them, a portrait or a facsimile of a person known in the Russian Federation on the date of filing of the application, without the consent of that person or his successor;

3) an industrial design, mark of compliance, in respect of which rights has emerged prior to the priority date of the trademark being registered.

The provisions of this paragraph shall also apply in respect of designations confusingly similar to the objects indicated therein.

10. No trademark registration shall be granted in respect of similar goods to designations, elements of which are protected in accordance with present Code, means of individualization of other persons protected, confusingly similar to them, as well as objects referred to in paragraph 9 of this article. The state registration as trademarks of designations is allowed with the appropriate consent under paragraph 6 and subparagraphs 1 and 2 of paragraph 9 of this article.

11. On the grounds provided by present article, no legal protection shall be granted to trademarks registered in accordance with the international treaties of the Russian Federation.

Article 1492 (3). The Trademark Application

3. The trademark application shall comprise the following:

1) an application for the state registration of a designation as a trademark with reference to the applicant, his/its place of residence/whereabouts;

2) the designation being declared;

3) a list of the goods for which the trademark state registration is sought and which are classified under the classes of the International Classification of Goods and Services for Marks Registration;

4) a description of the designation being declared.

Article 1496. The Consequences of Coincidence of the Priority Dates of Trademarks

1. If applications were filed by different applicants for identical trademarks in respect of fully coinciding or partially coinciding lists of goods, and these applications have one and the same priority date the trademark so declared for the goods of which lists coincide may be registered only in the name of one of the applicants to be chosen by agreement between them.

2. If applications for identical trademarks for fully or partially coinciding lists of goods have been filed by one and the same applicant, and these applications have one and the same priority date, the trademark for the goods for which the said lists are coincident may be registered only under one of the applications to be chosen by the applicant.

3. If applications for identical trademarks have been filed by different applicants (Item 1 of the present article), then within six months after the receipt of a relevant notice from the federal executive governmental body charged with intellectual property matters they shall notify that federal body of the agreement they have reached in choosing the specific application whereby the state registration will be sought for the trademark. During the same term the applicant that has filed applications for identical trademarks shall notify of his/its choice made (Item 2 of the present article).

Unless during the established term the federal executive governmental body charged with intellectual property matters receives the said notice or a petition for extension of the established term, the trademark applications shall be deemed withdrawn on the basis of a decision of that federal body.

Article 1497 (3). The Expert Examination of a Trademark Application and the Making of Amendments to Application Documents

3. A change in the details of the applicant is a trademark application, for instance in the event of assignment or transfer of the right of registering the trademark or due to a change in the name of the applicant, and also the correction of obvious and technical errors in application documents may be made until the state registration of the trademark (Article 1503).

Article 1511. The State Registration of a Collective Mark

1. The application for registration of a collective mark (collective mark application) filed with the federal executive governmental body charged with intellectual property matters shall be accompanied by a charter of the collective mark comprising the following:

- 1) the name of the association authorized to register the collective mark in its name (right holder);
- 2) a list of the persons entitled to use the collective mark;
- 3) the purpose of registration of the collective mark;
- 4) a list of the uniform characteristics of quality of, or other common characteristics of the goods which are going to be designated by the collective mark;
- 5) terms for using the collective mark;
- 6) provisions on the procedure for monitoring the use of the collective mark;
- 7) provisions on liability for a breach of the charter of the collective mark.

2. In addition to the details required by Articles 1503 and 1504 of the present Code the following shall be entered into the State Register of Trademarks and a certificate of a collective mark: information on the persons entitled to use the collective mark. This information and also an abstract from the charter of the collective mark on the uniform characteristics of the quality, and the common characteristics, of the goods for which this mark is registered shall be published by the federal executive governmental body charged with intellectual property matters in the gazette. The right holder shall notify the federal executive governmental body charged with intellectual property matters of the amendments made to the charter of a collective mark.

3. If a collective mark is used on goods not having uniform quality characteristics or other common characteristics the legal protection of the collective mark may be terminated before due date in full or in part under a court decision adopted at the application of any person concerned.

4. A collective mark and a collective mark application may be transformed into a trademark and a trademark application respectively and vice versa. The procedure for such transformation shall be established by the federal executive governmental body charged with normative legal regulation in the area of intellectual property.

Corresponding essential provisions of the applicable law