

MADRID PROTOCOL

Total Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)

DT-II.IR1413737.2.mjaro

I. Office making the notification:	
Patent Office of the Republic of Poland Trade mark Department Aleja Niepodległości 188/192 P.O. Box 203 00-950 Warsaw, Poland	Phone number: (+48) 22 579 05 55 Fax: (+48) 22 579 00 01
II. Number of the international registration: 1413737	
III. Name of the holder:	
Salk Institute for Biological Studies, 10010 N. Torrey Pines Road La Jolla CA 92037, US	
IV. Provisional refusal based on an ex officio examination	
V. Total provisional refusal affects all the goods and/or services.	
VI. Grounds for refusal (see item VII)	
VII. Information related to the grounds of refusal:	
[X] Other reasons	
Article 129¹.1.2) and Article 129¹.1.3)	
Rights of protection shall not be granted for signs which are not capable of distinguishing, in trade, the goods/services for which they have been applied and consist exclusively of elements which may serve in trade to designate, in particular, the kind, origin, quality, quantity, value, intended purpose, manufacturing process, composition, function or usefulness of the goods. The mark is devoid of any distinctive character and it is not capable of distinguishing, in trade, the services for which it has been applied, and the mark is descriptive.	
VIII. Corresponding essential provisions of the applicable law (see pages 2-4)	
IX. Information related to further procedures:	
i) Any provisional refusal notified to the International Bureau can be subject to comments as to the merit of the refusal by the right holder, to be filed with the Patent Office of the Republic of Poland in Polish language within a period of five months of the receipt of the provisional refusal;	
ii) In proceedings before the Patent Office a patent agent, attorney, legal counsel or a person providing cross-border services within the meaning of the Act on Patent Agents may act as a representative of a party to proceedings. Any persons not having their domicile or seat in the Republic of Poland may only act by a representative. If they did not appoint a representative to conduct the proceedings who is domiciled in the Republic of Poland and do not act by the intermediary of a consul of the Republic of Poland, are obligated to designate a representative for service in the Republic of Poland. In the event of failure to designate a representative who is authorised to accept service of documents, the letters addressed to that party will be placed in the case-file and will be deemed to have been served.	
iii) The obligation shall not apply to persons having their domicile or seat in the European Union, a member state of the European Free Trade Association (EFTA) – parties to the agreement on the European Economic Area or the Swiss Confederation.	
X. Signature or official seal of the Office making the notification	
 Marta Jarosz expert /document signed electronically/	
XI. Date of notification to the International Bureau: 07.03.2019	

Essential provisions of INDUSTRIAL PROPERTY LAW - ACT OF 30 JUNE 2000		
Article 120:	1.	Any sign capable of being represented graphically may be considered a trade mark, provided that such signs are capable of distinguishing the goods of one undertaking from those of other undertakings.
	3.	Any references in this Act to: 3) counterfeit trade marks shall mean identical trade marks illegally used or trade marks which in the course of trade cannot be distinguished from the trade marks registered for the goods covered by the right of protection; 4) earlier trade marks shall mean the trade marks applied for registration or registered basing on the earlier priority.
Article 122:	1.	The provision of Article 120(1) shall not prevent a sign from being considered as a trade mark, if the sign is intended for concurrent use by several parties, including by entrepreneurs, who have jointly applied for the protection thereof, provided that such use is not contrary to public interests and is not intended to mislead the public, in particular as to the nature, intended purpose, quality, properties or origin of the goods (joint right of protection).
	2.	The principles of the use of a trade mark on the basis of a joint right of protection shall be determined by the regulations governing use of trade marks adopted by the parties, including entrepreneurs, referred to in paragraph (1).
Article 129 ¹ :	1.	Rights of protection shall not be granted for signs which: 1) cannot constitute a trade mark; 2) are not capable of distinguishing, in trade, the goods for which they have been applied; 3) consist exclusively of elements which may serve in trade to designate, in particular, the kind, origin, quality, quantity, value, intended purpose, manufacturing process, composition, function or usefulness of the goods; 4) consist exclusively of elements which have become customary in the current language and are used in fair and established business practices; 5) constitute the form of the goods, dictated exclusively by their nature, is necessary in order to achieve a technical result or significantly increases the value of the goods; 6) have been applied for protection in bad faith; 7) are contrary to public order or morality; 8) incorporate an element which being a symbol, especially of a religious, patriotic or cultural nature, whose use would offend religious feelings, sense of patriotism or national tradition; 9) incorporate the symbol of the Republic of Poland (emblem, national colours or national anthem), the insignia of the armed forces, paramilitary organisations or police forces, reproductions of Polish decorations, honorary distinctions or medals, military medals or military insignia, or other official or generally used distinctions and medals, in particular those of government administration, local self-administration or social organisations performing activities in vital public interests, where these organisations' activities extend to the entire territory of the State or to a substantial part thereof, unless the applicant is able to produce evidence of his right, in particular in a form of an authorisation issued by a competent State agency or a self-administration or a permission given by organisation, to use the sign in the course of trade; 10) contain a symbol (armorial bearings, flag or emblem) of another country, name, its abbreviation or symbol (armorial bearings, flag, emblem) of an international organization or a adopted in another country official sign, hallmarks indicating control and warranty if such prohibition follows from international agreements, unless the applicant is able to produce an authorisation of a competent authority, which permits him to use such sign in the course of trade; 11) contain officially recognised sign adopted to be used in the course of trade, especially safety sign, quality label or hallmark of legalization to the extent in which they could mislead the public as to the nature of such sign, unless the applicant is able to prove his right to use the sign; 12) which, as for their nature, may mislead the public, in particular as to the nature, quality or the geographic origin of the product; 13) constitute a protected name of plant variety and relates to plant variety of the same or related species.
	2.	In respect of alcoholic products, any trade mark containing geographical elements discordant with the origin of the product shall be considered to be misleading the public.
	3.	A right of protection shall not be granted for a trade mark containing geographical elements which, although literally true as to the territory, region or a place of origin of the product, which could mislead the public by false representing that the product originates in a different region, famous for the given product. In the case of homonymous geographical indications for wine and beers, protection may be granted, on the condition that the Patent Office shall invite the party who filed the application later to make appropriate changes in the trade mark enabling it to be distinguished from an earlier trade mark.
	4.	A right of protection shall not be granted for a trade mark for identical or similar products if the trade mark is identical or similar to a registered geographical indication, name of origin, traditional name for wine or geographical indication of a spirit, whose protection is ensured by provisions of law and within the scope provided for therein.
Article 130:		Grant of a right of protection under Article 129 ¹ (1)(2)-(4) may not be refused where prior to the date of filing of a trade mark application with the Patent Office the trade mark concerned has acquired, in consequence of its use, a distinctive character in the conditions of the regular trade.

<u>Article 132¹:</u>	1.	After consideration of the opposition referred to in Article 152 ^{6a} (1) or Article 152 ¹⁷ (1), and having deemed it justified, rights of protection shall not be granted for signs: 1) whose use infringes third parties' personal or economic rights; 2) which are identical to a trade mark, which has been granted a right of protection with earlier priority to another party for identical products; 3) which are identical or similar to trade mark, which has been granted a right of protection with an earlier priority to another party for identical or similar products, if there is a risk of misleading the public, which includes in particular the risk of associating the trade mark with an earlier trade mark; 4) which are identical or similar to a renowned trade mark for which a right of protection with an earlier priority has been granted to another person for any kind of goods, if the use of the trade mark filed without reasonable cause would bring unfair advantage to the applicant or be detrimental to the distinctive character or the repute of the earlier trade mark; 5) which are identical or similar to a trade mark which, prior to the date according to which the priority to obtain a right of protection is determined, has been commonly known in the Republic of Poland and used as a trade mark intended to mark products identical or similar to those of another party, if there is a risk of misleading the public, which includes in particular the risk of associating the trade mark with a commonly known trade mark.
	2.	The ground for the opposition referred to in Article 152 ^{6a} (1) or Article 152 ¹⁷ (1) may also be trade marks applications with earlier priority, referred to in paragraph (1)(2)-(4), provided that they are granted the right of protection. Until final termination of earlier granting procedures, the opposition proceedings shall be suspended.
	3.	Where an earlier trade mark has been applied for protection or registered according to the procedure provided for in Article 4, provisions of paragraph (1) and (2) shall apply accordingly.
	4.	The protection of a trade mark containing signs referred to in Article 129 ¹ (1)(8)-(11), or signs relating to the origin of the goods shall not exclude the possibility of obtaining the right of protection by another party for a trade mark containing the same elements for identical or similar goods if such trade marks can be easily distinguished in the course of trade.
<u>Article 133:</u>		If the holder of the earlier trade mark or the holder of the earlier personal or economic right express written consent to the grant of a right of protection for later trade mark, the opposition referred to in Article 152 ^{6a} (1) or Article 152 ¹⁷ (1) shall be dismissed.
<u>Article 136:</u>	1.	Any organisation enjoying the status of legal entity and established in order to represent interests of entrepreneurs, may be granted a right of protection for a trade mark intended for use in the course of trade by that organisation and the entities grouped therein (collective trade mark).
	2.	The principles of the use of a trade mark in the course of trade by the organisation referred to in paragraph (1) and by the entities grouped therein shall be determined by the regulations governing use of trade marks adopted by that organisation.
<u>Article 137:</u>	1.	Any organisation enjoying the status of legal entity, which itself refrains from using the trade mark, may be granted a right of protection for a trade mark intended for use by entrepreneurs, which follow the rules laid down in the regulations governing use of trade marks adopted by the entitled organisation and are liable to control by that organisation to this extent (collective guarantee trade mark).
	2.	A holder of the right of protection for a collective guarantee trade mark may not, without important reasons, deny entrepreneurs, which meet the conditions specified in the regulations referred to in paragraph (1), the right to use that trade mark.
<u>Article 138:</u>	3.	An application concerning a collective trade mark, collective guarantee trade mark or an application concerning a trade mark filed in order to obtain a joint right of protection shall be accompanied by the regulations governing use of trade marks.
	4.	The regulations referred to in paragraph (3) shall, in particular, specify the manner of use of the trade mark, common properties of the goods for which the mark is intended, the principles of verifying those properties, and the consequences of failure to comply with the rules of the regulations. The regulations governing use of collective guarantee trade marks shall additionally be required to specify the detailed conditions for and the procedure of recognition by the entitled organisation of other entrepreneurs to use the trade mark.
<u>Article 152²:</u>	1.	Where the Patent Office finds that the requirements for the extension to the territory of the Republic of Poland of the protection resulting from the international registration have not been satisfied for the reasons referred to in Article 129 ¹ , the Office shall take a decision on definitive refusal to grant the protection for the international trade mark in the territory of the Republic of Poland.
	2.	Before the decision, referred to in paragraph (1), is taken, the Patent Office shall, when applying the procedure, form and language as provided for in the Agreement or the Protocol, transmit to the International Bureau a notification of the grounds which prevent the protection of an international trade mark to be granted in the territory of the Republic of Poland (preliminary refusal to grant the protection), and shall fix the time limit for the holder of the international trade mark registration, within which he is expected to submit his observations in this matter.
<u>Article 152³:</u>		Where the requirements for the extension to the territory of the Republic of Poland of the protection resulting from the international registration have not been satisfied only in respect of certain goods, for the reasons referred to in Article 129 ¹ , the Patent Office shall take a decision on refusal to grant the protection for the international trade mark in the territory of the Republic of Poland in respect of these goods. The provision of Article 152 ² (2) shall apply accordingly.
<u>Article 152⁶:</u>	4.	Patent Office may take a decision on refusal to grant the protection for an international trade mark in the territory of the Republic of Poland if it becomes aware of the circumstances referred to in Article 129 ¹ , even after to publication of information on designation of the Republic of Poland for the extension of the protection for an international trade mark. The provision of Article 152 ² (2) shall apply accordingly.

<u>Article 152^{6a}.</u>	1. Within three months from the date of publication of the information on the designation of the Republic of Poland for the extension of the protection for an international trade mark, the holder of the right to an earlier trade mark or to an earlier moral or economic rights may file an opposition against the grant of the protection for an international trade mark in the territory of the Republic of Poland for the reasons referred to in Article 132¹(1)-(3). The said time limit shall be non-restorable. 2. If an opposition against the grant of the protection for an international trade mark in the territory of the Republic of Poland is filed, the Patent Office shall notify the International Bureau a statement of the grounds resulting from the opposition which may prevent the protection of the international trade mark in the territory of the Republic of Poland from being granted. 3. The provisions of Article 152¹⁷(2)-(7) and Articles 152¹⁸-152²³ shall apply accordingly to the proceedings relating to the opposition against the designation of the Republic of Poland for the extension of the protection for an international trade mark.
<u>Article 152⁷.</u>	Patent Office's decisions on definitive refusal to grant the protection for the international trade mark in the territory of the Republic of Poland may be subject to a request for re-examination of the matter within the time limit of five months from the date of publication in the International Register as defined in the Agreement and the Protocol of the information on refusal to grant the protection for the international trade mark in the territory of the Republic of Poland. The provisions of Article 244 (1 ¹)-(1 ⁴) and (5), Article 244 ¹ and 245 shall apply accordingly.
<u>Article 162:</u>	3. The right of protection for a collective trade mark may be transferred as a joint right of protection to the entrepreneurs grouped in the organisation referred to in Article 136. In a contract of transfer of the right the rules governing the use of that trade mark should determine be to the extent as it is provided for in respect of the regulations referred to in Article 122(2). 4. The right of protection for a trade mark may also be transferred in respect of certain goods for which the right of protection has been granted, if the goods for which the trade mark remains registered on behalf of the vendor are not of the same kind. Once transferred, the right in question shall be dealt with as independent of the right enjoyed by the vendor. 5. The contract of transfer of a share in the joint right of protection shall be valid subject to the consent given by all of the joint owners. 6. Paragraphs (1), (3) to (5) shall apply accordingly to the right deriving from an application filed with the Patent Office, for which no right of protection has yet been granted.
<u>Article 236:</u>	1¹. In proceedings before the Patent Office in matters relating to filing and processing of applications and maintaining the protection of trade marks a patent agent, attorney, legal counsel or a person providing cross-border services within the meaning of the Act on Patent Agents may act as a representative of a party to proceedings. 3. In the matters referred to in paragraph (1) and (1¹), any persons not having their domicile or seat in the Republic of Poland may only act when represented by a patent agent, attorney or a legal counsel. The obligation shall not apply to persons having their domicile or seat in the European Union, a member state of the European Free Trade Association (EFTA) – parties to the agreement on the European Economic Area or the Swiss Confederation.
<u>Article 244:</u>	1. Decisions of the Patent Office shall be liable to a party's request for re-examination of the matter within the meaning of the Code of Administrative Procedure. 1¹. Subject to paragraphs (1²) to (1⁴), the provisions of the Code of Administrative Procedure governing deciding on appeals from decisions shall apply accordingly to proceedings on re-examination of the matter. 1². Requests for re-examination of the matter shall require to be substantiated. 1³. In the case referred to in Article 89(2) of the Code of Administrative Procedure a hearing shall also be conducted at the applicant's request. 1⁴. The matter shall be re-examined by an expert appointed by the President of the Patent Office. 3. Paragraphs (1) and (1¹) to (1⁴) shall apply accordingly to orders.
<u>Article 248:</u>	Decisions taken and orders issued by the Patent Office shall be subject to complaint to the administrative courts.
<u>Article 254:</u>	Any final decision of the Patent Office which terminates the proceedings and grossly violates law may be subject to complaint lodged by the President of the Patent Office, the General Prosecutor of the Republic of Poland and the Ombudsman to the administrative court within a period of six months from the party being served with the decision.
<u>Article 315:</u>	1. Rights conferred in respect of inventions, utility models, ornamental designs, topographies of integrated circuits, trade marks and rationalisation projects, existing at the time of entry into force of this Act, shall remain effective. To these rights the previous provisions are applicable, unless the provisions of this Part stipulate otherwise. 2. Legal relationships established prior to the entry into force of this Act shall continue to be governed by the previous provisions. 3. Statutory requirements for the grant of a patent, a right of protection or a right in registration shall be assessed under the provisions effective at a date of filing with the Patent Office of an application concerning an invention, a utility model, a trade mark or topography of an integrated circuit. However, the provision of Article 37(2) shall apply to patent and utility model applications pending at the date of entry into force of this Act.