

PROVISIONAL REFUSAL

according to rule 17(1) of the Common Regulations under the Madrid Agreement and Protocol

Refusal not based on opposition

"EX OFFICIO"

I. Office:

INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL

DIREÇÃO DE MARCAS E PATENTES

Campo das Cebolas

1149-035 – LISBOA PORTUGAL

Fax.: 21 887 87 17

Tel.: 21 881 81 00

Link: <https://inpi.justica.gov.pt/>

E-mail: servico.publico@inpi.pt

II. International registration number: 1482770

Trademark elements: MAKE SMOKING HISTORY

III. Name and address of the holder: NJOY, LLC, 155 6TH AVE., 2ND FLOOR NEW YORK, NY 10013, ESTADOS UNIDOS DA AMÉRICA

IV. Grounds for refusal.

Absolute grounds:

Art. 209th – Exceptions

The conditions of [article 208th] are not met by:

- a) - Trademarks that are devoid of any distinctive character;
- b) - Signs that exclusively consist of the form or by another characteristic imposed by the nature of the product itself, the form or by another characteristic of the product necessary for obtaining a technical result or the form or by another characteristic that confers a substantial value on the product;
- c) - Signs that are exclusively made up of indications that may serve in commerce to designate the type, quality, quantity, purpose, value, geographic origin, period or means of production of the product or the service, or other characteristics thereof;
- d) - Trademarks that exclusively consist of signs or indications that have become common use in modern-day language or in the habitual and constant habits of commerce;

V.

Refusal for all the goods and/or services.

VI. Answer to the decision of refusal:

- a) **Time limit to file an answer:** Within one (1) month following the date of the notification of provisional refusal sent by WIPO. Furthermore, this period can be extended once, for one (1) month, at the request of the interested party. The extension of period must be submitted before the first one (1) month period is over.

The answer and payment to this notification can be submitted electronically through the Website online services, available at <https://inpi.justica.gov.pt/> (upon requiring the use of a digital signature certificate). In the case of electronic reply, the applicant will benefit of a fee discount of 50%.

Otherwise, the answer and payment to this notification can be submitted in person or by Mail, with the proper form (available for download at [FORM M4](#)) and the respective means of payment (a bank check, issued to the National Institute of Industrial Property).

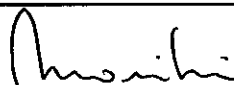
The actual values to be paid can be found at <https://inpi.justica.gov.pt/>. If further clarification is necessary, please contact us via telephone at +351 21 881 81 00 or send an email to servico.publico@inpi.pt

b) Authority to which the answer should be filed:

INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL
DIREÇÃO DE MARCAS E PATENTES
Campo das Cebolas
1149-035 – LISBOA PORTUGAL
Fax.: 21 887 87 17
Tél.: 21 881 81 00
Link: <https://inpi.justica.gov.pt/>
E-mail: servico.publico@inpi.pt

VII. Date of the decision: 2020/03/05

VIII. Date and signature: 2020.03.11 Rafael Rodrigues



IX. Corresponding essential provisions of the applicable law:

Industrial Property Code

(approved by Decree-Law 110/2018 of 10 December)

Art. 208th – Composition of trademark

- 2 – A trademark may consist of a sign or set of signs that can be represented graphically, namely words - including the names of persons - ,drawings, letters, numbers and sounds, the form of the product or respective packaging, or by a sign or set of signs which may be represented in a way which enables the objective of the protection afforded to its holder to be determined in a clear and precise manner, provided that they adequately distinguish the products and services of one company from those of others.

Art. 209th – Exceptions

The conditions of [article 208th] are not met by:

- a) - Trademarks that are devoid of any distinctive character;
- b) - Signs that exclusively consist of the form or by another characteristic imposed by the nature of the product itself, the form or by another characteristic of the product necessary for obtaining a technical result or the form or by another characteristic that confers a substantial value on the product;
- c) - Signs that are exclusively made up of indications that may serve in commerce to designate the type, quality, quantity, purpose, value, geographic origin, period or means of production of the product or the service, or other characteristics thereof;
- d) - Trademarks that exclusively consist of signs or indications that have become common use in modern-day language or in the habitual and constant habits of commerce;

Art. 231th – Grounds for refusal of a registration

- 3 – [...] registration of a trademark is refused when:

- a) - It consists of signs that cannot be represented graphically or in such a way as to establish, in a clear and precise manner, the subject-matter of the protection afforded to its holder;
- b) - It consists of signs devoid of any distinctive character;
- c) - It consists exclusively of signs or indications referred to in Article 209(1) (b) to (d);

[...]

- 4 – Registration of a trademark will also be refused if it contains in some or all of its constitutive elements:

- a) - symbols, crests, emblems or distinctions of the state, municipalities or other Portuguese or foreign public or private bodies, the emblem and name of the Red Cross or other similar bodies and any signs covered by Article 6-ter of the Paris Convention for the Protection of Industrial Property;
- b) - signs of a high symbolic value, such as religious symbols, unless these are authorised, where applicable, and except where they are customary in the current language or in the fair practice of trade in the goods or services to which the mark is intended and which are accompanied by elements which give it distinctive character;
- c) - expressions or figures that are contrary to the law, morals, public order and morality;
- d) - signs that may mislead the public, namely as to the nature, properties, utility or geographic origin of the product or service for which the trademark is designed;
- e) - signs or indications contrary to national law, European Union law or international agreements to which the European Union is a party, which confer protection of designations of origin and geographical indications;
- f) - signs or indications which contain in any or all of their elements traditional terms for wine which are protected by European Union law or by international agreements to which the European Union is a party;
- g) - signs or indications which contain, in all or some of their components, traditional specialties guaranteed that are protected by European Union law or by international agreements to which the European Union is a party;
- h) - signs or indications which contain, in all or some of their elements, plant variety denominations which are protected by European Union law or by international agreements to which the European Union is a party.

- 5 – Registration of a trademark that is made up exclusively of the national flag of the Portuguese Republic or some of its constitutive elements will also be refused.

- 6 – Registration will also be refused for a trademark that contains, amongst other elements, the national flag, wherever the trademark is likely to:

- a) - mislead the public as to the geographic origin of the products or services for which it is designed;
- b) - lead the consumer to erroneously think that the products or services come from an official body;
- c) - generate disrespect or a diminution of prestige for the national flag or any of its elements.

- 6 – When invoked by an interested party, it is also grounds for refusing to acknowledge that the application for registration was made in bad faith.

Art. 232th – Other grounds for refusal

- 7 – Further grounds for refusal of registration of a trademark are:

- a) - The reproduction of a trademark already registered by another person for identical products or services;
- b) - The reproduction of a trademark already registered by another person for similar products or services or the imitation, in whole or in part, of a trademark previously registered by another person for identical or similar products or services that may mislead or confuse the consumer or comprise the risk of association with the already registered trademark;
- c) - The reproduction of a logotype already registered by another person to distinguish an entity whose activity is identical to the

products or services for which the trademark is designed;

- d) - The reproduction of a logotype already registered by another person to distinguish an entity whose activity is similar to the products or services for which the trademark is designed or imitation in whole or in part, of a logotype already registered by another person to distinguish an entity whose activity is identical or similar to the products or services for which the trademark is designed, if it is likely to mislead or confuse the consumer;
- e) - The reproduction or imitation, in whole or in part, of a designation of origin or a geographical indication deserving protection under this Code, European Union legislation or international agreements to which the European Union is a party, and whose application has been filed before the date of filing of the trade mark application or, if applicable, before the date of the respective priority claimed, subject to its subsequent registration;
- f) - The violation of other industrial property rights;
- g) - The use of names, portraits or any other expressions or figurations without the authorisation of the persons they relate to or, if these are deceased, of their heirs or relatives to the fourth degree or, if authorisation is obtained, if it generates disrespect or diminution of prestige for those persons;
- h) - Recognition that the applicant's intent is one of unfair competition or that unfair competition is a possible outcome, regardless of the applicant's intention.

2 - When cited in an opposition, the following are also grounds for refusal:

- a) - reproduction or imitation of a business or corporate name and other distinctive signs, or merely a characteristic part thereof, that do not belong to the applicant or where the applicant is not authorised to use them, if it is likely to mislead or confuse the consumer;
- b) - violation of copyright;

[...]