

## MADRID PROTOCOL

**Model Form 3B: Partial Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)**

I. Office making the notification:  
National Intellectual Property Centre of Georgia

**SAKPATENTI**

Address: 5, Antioch Str., 3300 Mtskheta

**Georgia**

Email: [info@sakpatenti.org.ge](mailto:info@sakpatenti.org.ge)

[www.sakpatenti.org.ge](http://www.sakpatenti.org.ge)

II. Number of the international registration: 1487010

III. Name of the holder: TALAGAEVA ELENA VLADIMIROVNA; Kommunisticheskaya St., d. 3, kv. 145, Ramenskoe, RU-140002 Moskovskaya oblast, Russian Federation

IV. Information concerning the type of provisional refusal:

*Please indicate the type of refusal by checking only one of the following options:*

☒ Partial provisional refusal based on an *ex officio* examination

☐ Partial provisional refusal based on an opposition

☐ Partial provisional refusal based on both an *ex officio* examination and an opposition

*Where the refusal is based on an opposition, please indicate the name and address of the opponent:*

(i) Name of the opponent:

(ii) Address of the opponent:

V. Information concerning the scope of the provisional refusal:

*Please indicate the scope of the refusal, by choosing one of the two listed options below and, where applicable, list the relevant goods and/or services:*

☒ Partial provisional refusal affects only the following goods and/or services:

☐ Partial provisional refusal does NOT affect the following goods and/or services:

List of goods and/or services:

**03 - Amber [perfume]; aromatics [essential oils]; freshening sprays; balms, other than for medical purposes; lip glosses; polishing stones (cosmetics); petroleum jelly for cosmetic purposes; cotton wool for cosmetic purposes; adhesives for cosmetic purposes; scented water; javelle water; lavender water; toilet water; incense; depilatory wax; mustache wax; massage gels, other than for medical purposes; heliotropine; dental bleaching**

gels; geraniol; make-up; deodorants for pets; deodorants for human beings or for animals; depilatory preparations; scented wood; perfumes; greases for cosmetic purposes; perfumery; decorative transfers for cosmetic purposes; ionone [perfumery]; shaving stones [astringents]; alum stones [astringents]; smoothing stones; eyebrow pencils; cosmetic pencils; adhesives for affixing false eyelashes; adhesives for affixing false hair; hair rinses [shampoo-conditioners]; beard dyes; colorants for toilet purposes; cosmetic dyes; cosmetic creams; skin whitening creams; hair spray; nail polish; hair lotions; lotions for cosmetic purposes; after-shave lotions; beauty masks; oils for perfumes and scents; oils for cosmetic purposes; oils for toilet purposes; essential oils; essential oils of cedarwood; essential oils of lemon; essential oils of citron; oils for cleaning purposes; bergamot oil; gaultheria oil; jasmine oil; lavender oil; almond oil; rose oil; oil of turpentine for degreasing; whiting; almond milk for cosmetic purposes; cleansing milk for toilet purposes; musk [perfumery]; deodorant soap; shaving soap; cakes of toilet soap; antiperspirant soap; soap for foot perspiration; soap; almond soap; mint for perfumery; cosmetic kits; emery (cosmetics); nail art stickers; false nails; eau de Cologne; bases for flower perfumes; joss sticks; non-medicated dentifrices; pumice stone; lipstick cases; hydrogen peroxide for cosmetic purposes; breath freshening strips; teeth whitening strips; lipsticks; pomades for cosmetic purposes; shaving preparations; cosmetic preparations for baths; bath preparations, not for medical purposes; hair straightening preparations; hair waving preparations; douching preparations for personal sanitary or deodorant purposes [toiletries]; denture polishes; mouthwashes, not for medical purposes; cosmetic preparations for slimming purposes; eye-washes, not for medical purposes; lacquer-removing preparations; make-up removing preparations; nail care preparations; cleaning preparations (cosmetics); preparations for cleaning dentures; collagen preparations for cosmetic purposes; aloe vera preparations for cosmetic purposes; sunscreen preparations; make-up powder; nail varnish removers; vaginal washes for personal sanitary or deodorant purposes; scouring solutions; false eyelashes; tissues impregnated with cosmetic lotions; tissues impregnated with make-up removing preparations; bath salts, not for medical purposes; astringents for cosmetic purposes; eyebrow cosmetics; make-up preparations; sun-tanning preparations [cosmetics]; hair dyes; neutralizers for permanent waving; cosmetic preparations for eyelashes; cosmetic preparations for skin care; cosmetics; cosmetics for animals; mascara; cleansers for intimate personal hygiene purposes, non medicated; bleaching preparations [decolorants] for cosmetic purposes; antiperspirants [toiletries]; toiletry preparations; phytocosmetic preparations; talcum powder, for toilet use; cotton sticks for cosmetic purposes; terpenes [essential oils]; henna [cosmetic dye]; shampoos

for animals [non-medicated grooming preparations]; shampoos for pets [non-medicated grooming preparations]; dry shampoos; shampoos; herbal extracts for cosmetic purposes; extracts of flowers [perfumes]; ethereal essences; badian essence; mint essence [essential oil].

VI. Grounds for refusal [(where applicable, see item VII)]:

A sign or combination of signs shall not be registered as a trademark where it is not capable of distinguishing the relevant goods and/or is descriptive in respect of the goods for which its registration is requested. The sign “ФИТОКОСМЕТИК” that is applied for trademark registration is descriptive and devoid of any distinctive character as the mark consists exclusively of an indication which would be perceived by relevant consumer as providing direct information about the kind (beauty care products, cosmetics) and characteristics (plant based cosmetics) of the goods applied for. Given that the sign has a clear descriptive meaning, it is also devoid of any distinctive character. Therefore, the sign is incapable to distinguish the goods of the one undertaking from those of others.

**VII. Information relating to an earlier mark:**

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

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

(iii) Name and address of the owner:

(iv) Reproduction of the mark:

(v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration):

**VIII. Corresponding essential provisions of the applicable law:**

**Article 4(1)(c), Article 4 (1)(d)**

**IX. Information relating to the possibility to request a review or file an appeal:**

(i) Time limit for requesting review or appeal:

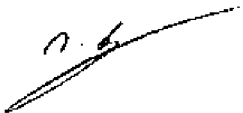
(ii) **This statement can be appealed at Sakpatenti Chamber of Appeals no later than 3 months or Mtskheta Regional Court no later than 1 month from the date of its publication in the WIPO Gazette of International Marks.**

(iii) Authority to which such request for review or appeal should be made:

**This statement can be appealed at Sakpatenti Chamber of Appeals or Mtskheta Regional Court.**

(iv) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:

**Be informed that proceedings in Georgia are carried out in the Georgian language. The request may be filed through the representative with a registered address in Georgia or a patent attorney of Georgia.**

(v) Other requirements, if any:		
X. Signature or official seal of the Office making the notification:		
Head of the Trademarks, Geographical Indications and Designs Department		Irakli Kasradze
<b>XI. Date of the notification to the International Bureau: 2020-06-19</b>		

## **XII. Extract from the Trademark Law of Georgia**

### **Article 3. TRADEMARK**

1. A trademark is a sign or combination of signs that can be represented graphically and is capable of distinguishing the goods or services or both (hereinafter referred to as "goods") of one undertaking from those of other undertakings.
2. The sign may be a word or words, including proper names, letters, figures, sounds, a design or a three-dimensional figure, including the shape of goods or their wrapping and also other packaging, including colors or combination of colors.
3. The trademark is protected by registration at «Sakpatenti» or by virtue of international agreement.
4. Well-known trademarks in Georgia are protected without registration, under Article 6<sup>bis</sup> of the Paris Convention. The trademark is recognized as well-known by the Chamber of Appeals of «Sakpatenti» or by the court, in its competence, upon the request of an interested person.

### **Article 4. ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION**

1. A sign, or combination of signs shall not be registered as a trademark where it:
  - (a) does not comply with the requirements of Article 3 (1) of this Law;
  - (b) represents a single non-stylized (standard) letter or figure, or a single colour taken separately;
  - (c) is not capable of distinguishing the relevant goods;
  - (d) is descriptive in respect of the goods for which its registration is requested, consists exclusively of the kind, quality, quantity, feature, value, intended purpose, geographical origin, place of sale, time or other characteristics of the goods or can be regarded as such;
  - (e) is widely used as a generic term for the particular type of goods;
  - (f) represents a widely established trade term or sign, characteristic of goods, for which registration is sought;
  - (g) insults or is contrary to national dignity, religious sentiment and traditions and moral standards;
  - (h) is likely to deceive the public (as to the feature, quality, geographical origin or other characteristics of the goods);
  - (i) completely or in any of its constituent elements coincides with the national emblems or the flags, emblem or full or abbreviated names of foreign states; the emblems of intergovernmental or other international organizations or their abbreviated or full names; official control, warranty and test hallmarks, signs (including certification marks of goods) seals, orders and medals; the official or historical names, emblems and State flags of the constituent parts of Georgia; the banknotes of Georgia or the imitation of the forgoing; such a sign may be included in a trademark, as a feature not qualifying for protection, if the permission of the Ministry of Culture or the holder has been obtained.
2. A three-dimensional sign shall not be registered as a trademark, where its shape:
  - (a) is established exclusively by the nature of the goods;
  - (b) is necessary for a technical result to be achieved.
3. The provisions of paragraph 1(c), (d), (e), (f), and (h) above shall not apply if, before a decision is taken on its registration, a
  - trademark has become distinctive through use in the course of trade in relation to the goods specified in the application.

### **Article 5. RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION**

A trademark shall not be registered if it:

- (a) is identical to another trademark registered for the same goods;
- (b) is identical to the trademark of a third party and the goods are so similar as to create a risk of confusion between the marks, including confusion based on association;
- (c) is similar to the trademark of a third party and the goods are identical or so similar as to create a risk of confusion between the marks, including confusion based on association;
- (d) is identical or similar to a trademark well known in Georgia, existing before filing the application, so that there is a risk of confusion with it, including confusion based on association; this rule shall apply even where the lists of goods are different;
- (e) is identical or so similar to an appellation of origin or geographical indication protected in Georgia that there is a risk of confusion with it, including confusion based on association and the registration of trademark is requested for the identical or similar goods, or using such a trademark will result in using the reputation of the protected appellation of origin or geographical indication. This provision shall not apply if an appellation of origin or geographical indication is involved as a feature not qualifying for protection in the trademark of a person entitled to use it.
- (f) is identical to an industrial design protected in Georgia except where registration of the trademark is sought by the holder of the exclusive rights in the industrial design;
- (g) is identical or similar to registered trademark a third party enjoying good reputation in Georgia, and if the use of that trademark creates unfair advantages for its applicant or damages the reputation of the protected trademark; this rule shall apply where there are different lists of goods;
- (h) includes names, pseudonyms, facsimiles, portraits of persons famous in Georgia without the consent of these persons or their legatees, and if they belong to the history and culture of Georgia without the permission of the Ministry of Culture, Monuments Protection and Sport of Georgia;
- (i) includes the names of historical monuments of Georgia or of reproductions thereof without the permission of the Ministry of Culture, Monuments Protection and Sport of Georgia.

#### **Article 16. OPPOSITION TO THE EXAMINATION DECISION AT THE CHAMBER OF APPEALS**

1. The decision of the examination as to form may be opposed by the applicant before the Chamber of Appeals within three months after having been taken.
2. A decision of the substantive examination to refuse the registration of the trademark in respect of all or part of the list of goods may be opposed by the applicant before the Chamber of Appeals within three months after having been taken.
3. Repealed (20.12.2005 № 2380 is in force from March 1, 2006)
4. Within three months from the date of publication of the trademark data in the Bulletin, any party concerned has the right to bring an action before the Chamber of Appeals against the decision of the examination to grant registration only on the grounds that the requirements of Article 4 or Article 5 is violated. The enacted decision of the court concerning the trademark registration is not allowed to be appealed at the Chamber of Appeals on the same grounds.
5. The Chamber of Appeals shall consider the appeal within three months from the date of its filing.

6. The decision of the Chamber of Appeals may be appealed in a court.

**ARTICLE 32. REGULATIONS GOVERNING THE USE OF COLLECTIVE MARKS**

1. An application for a collective mark shall comply with the requirements of Article 9 and be accompanied by the regulations governing the use of the collective mark.

2. The regulations governing the use of the collective mark shall include:

- (a) the name of the association;
- (b) the names and legal addresses of the members of the association;
- (c) the aim of the association;
- (d) the conditions governing the use of the collective mark and overseeing that use;
- (e) the rights and obligations of the members of the association regarding infringement of the rights in the collective mark;
- (f) a list of the goods and common characteristics or indications for which the collective mark is intended.

3. If the collective mark contains a geographical name, the regulations governing the use of the mark must provide that any party whose goods originate within the geographical region so named, and who meets the conditions for use of the mark laid down in those regulations, has the right to become a member of the association and use the mark.

4. Any interested person is entitled to inspect the regulations governing the collective mark.