

MADRID PROTOCOL

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

DT-II.IR1516084.2.jmysl

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

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II. Number of the international registration: **1516084**

III. Name of the holder:

Derkach Nataliia Mykolaivna, vul. Klinichna 23-25, kv. 173, Kyiv 03110 , UA

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:

Article 129¹:1.2) and 129¹:1.3)

Rights of protection shall not be granted for signs which are not capable of distinguishing, in trade, the goods 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 consists exclusively of the elements: "Artro" (derives from the word „ARTHROSIS" which is a degenerative disease of a joint) and "Patch" (means a piece of material, e.g. such as adhesive plaster, used medically usually to cover a wound) being a sign which may serve in trade to designate the kind, quality, intended purpose, function of the goods and other characteristics of the goods in classes 5,10. The mark is devoid of any distinctive character. It is considered that the designation "Artro-patch" should be available for the other manufacturers in the relevant field to use and cannot be monopolized through registration as a trade mark.

VIII. Corresponding essential provisions of the applicable law (see next pages)

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

Joanna Mysiek-Szymaniak
expert
/document signed electronically/

XI. Date of notification to the International Bureau: 30.10.2020

Essential provisions of INDUSTRIAL PROPERTY LAW - ACT OF 30 JUNE 2000

Article 120

(1) Any sign may be considered a trade mark, provided that it is capable of distinguishing the goods of one undertaking from those of other undertakings and capable of being represented on the trade mark register in a manner which enables to determine the clear and precise subject matter of the protection afforded.

(2) Within the meaning of paragraph (1) the following, in particular, may be considered a trade mark: word, including personal name, design, letter, digit, colour, the three-dimensional shape of goods or of their packaging, as well as sound.

Article 122

(1) The provision of Article 120(1) shall not prevent a sign from being considered 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 interest 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 129¹

(1) Right of protection shall not be granted for a sign which:

- 1) cannot constitute a trade mark;
- 2) is not capable of distinguishing, in trade, the goods for which registration is sought;
- 3) consists 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) consists exclusively of elements which have become customary in the current language and are used in fair and established business practices of the trade;
- 5) consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves, which is necessary to obtain a technical result or gives substantial value to the goods;
- 6) have been applied for protection in bad faith;
- 7) is contrary to public order or morality;
- 8) incorporates an element of high symbolic value, in particular of a religious, patriotic or cultural nature, the use of which would offend religious feelings, patriotic feelings or national tradition;
- 9) incorporates 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) contains a symbol (armorial bearings, flag or emblem) of another country, name, its abbreviation or symbol (armorial bearings, flag, emblem) of an international organization or of 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) contains 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 goods;
- 13) represents or reproduces in its' essential elements, a plant variety denomination registered in the Republic of Poland with earlier priority, or registered in accordance with the European Union legislation or international agreement to which the Republic of Poland is a party, providing protection for plant variety rights, and which is in respect of plant varieties of the same or closely related species.

(2) In respect of alcoholic products, any trade mark containing geographical element 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 element which, although literally true as to the territory, region or a place of origin of the product, could mislead the public that the product originates in a different region known for the given product. In case of homonymous geographical indications for wine and beers, protection may be granted, provided 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 which is excluded from registration pursuant to the national law, the European Union legislation or to international agreement, providing for protection of geographical indication, designation of origin, traditional term for wine or traditional speciality guaranteed, within the scope provided for therein.

Article 130

Grant of a right of protection under Article 129¹(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 normal trade conditions.

Article 136

(1) An organisation which has the capacity in its own name to have rights and obligations, established to represent interests of entrepreneurs, and a legal person governed by public law, may be granted a right of protection for a collective trade mark. The collective trade mark is intended to distinguish the goods:

- 1) in case of an organisation - of its members,
- 2) in case of a legal person governed by public law - of persons authorised to use the mark under the regulations governing its use
- from the goods of other undertakings.

(1¹) The right to use a collective trade mark:

- 1) in case of an association – the association itself or its members are entitled to use a collective trade mark;
- 2) in case of a legal person governed by public law – that legal person or persons authorised to use the mark under the regulations governing its use are entitled to use a collective trade mark.

Article 136¹

(1) A right of protection for a collective trade mark shall not be granted where the provisions of Article 136 or Article 138 (3) and (4) - are not satisfied, or where:

- 1) the regulations governing use of the mark are contrary to public policy or to accepted principles of morality;
- 2) the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be a sign other than a collective mark.

(2) A right of protection for a collective trade mark shall be granted if, as a result of amendments to the regulations governing use of the mark, the circumstances referred to in paragraph (1) subparagraphs 1 and 2 do not occur, and if the conditions referred to in Article 136 or Article 138 (3) and (4) were fulfilled.

Article 136²

(1) Any natural or legal person, including institutions, authorities and bodies governed by public law, who does not carry on a business involving the supply of goods of the kind certified, may be granted a right of protection for a guarantee trade mark. The guarantee trade mark is intended to distinguish goods which are certified by the right holder of that mark, in particular, in respect of used material, mode of manufacture of goods, quality, accuracy or other characteristics, from goods which are not so certified.

(2) Guarantee trade mark may consist of elements which may serve, in the course of trade, to indicate geographical origin of goods.

(3) Article 129¹ paragraph (1) subparagraph 3 shall not apply to the extent that it provides grounds for refusal to grant the right of protection for a sign which consists exclusively of elements that may serve, in trade, as an indication of origin of goods. Such a guarantee trade mark shall not entitle to prohibit a third party from using in the course of trade such signs, provided that third party uses them in accordance with honest practices in industrial and commercial matters.

(4) The rules governing use of a guarantee trade mark are specified in the regulations governing use of the mark.

Article 136³

(1) A right of protection for a guarantee trade mark shall not be granted if the conditions referred to in Article 136² or Article 138 (6) and (7), are not satisfied, or where:

- 1) the regulations governing use of the mark are contrary to public policy or to accepted principles of morality;
- 2) the public is liable to be misled as regards the character or the significance of the mark, in particular if it is likely to be taken to be a sign other than a guarantee trade mark.

(2) A right of protection for a guarantee trade mark shall be granted if, as a result of the amendments to the regulations governing use of the mark, the circumstances referred to in paragraph (1) subparagraph 1 and 2 do not occur, and if the conditions referred to in Article 136² or Article 138 (6) and (7) were fulfilled.

Article 138

(3) An application concerning a collective 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 the mark.

(4) The regulations referred to in paragraph (3) shall specify, in a clear and precise manner, in particular:

- 1) the rules of use of the mark, including consequences of the infringement of the regulations' provisions;
- 2) the persons authorised to use the mark, or the conditions of membership of the association referred to in Article 136 (1) – in case of a collective trade mark;
- 3) the persons referred to in Article 122 (1) – in case of a joint right of protection of a trade mark.

(6) An application concerning a guarantee trade mark shall be accompanied by the regulations governing use of the mark.

(7) The regulations, referred to in paragraph (6), shall specify, in a clear and precise manner, in particular:

- 1) the persons authorised to use the mark;
- 2) the characteristics to be certified by the mark and the manner of testing those characteristics;
- 3) the way of supervising the use of the mark;
- 4) the rules of the use of the mark, including consequences of infringement of the regulations' provisions.

Article 141

(1) When specifying in the trade mark application the goods for which the mark is intended, the applicant shall be required to use technical terminology in the Polish language and explicit terms, and to present the list of the goods

grouped according to an accepted classification system. Lists containing more than 15 words shall be drawn up on a separate sheet.

Article 152^{1a}

(1) On receiving notification from the International Bureau on designation of the Republic of Poland for the extension of the protection of an international trade mark, the Patent Office shall, without delay, publish the information on such designation in "*Biuletyn Urzędu Patentowego*" [Bulletin of the Patent Office].

(2) Third parties may submit their observations on the occurrence of the circumstances referred to in Article 129¹, Article 136¹ and Article 136³.

Article 152²

(1) If it is found that the requirements for the extension to the territory of the Republic of Poland of the protection resulting from international registration have not been satisfied for reasons referred to in Article 129¹, Article 136¹, Article 138 (3) and (4), and Article 141, 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 from being granted in the territory of the Republic of Poland (provisional refusal of 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.

(2) Following expiry of the time limit referred to in paragraph (1), the Patent Office shall issue a decision on regarding grant of protection for the international trade mark in the territory of the Republic of Poland (decision regarding grant of protection) unless an opposition referred to in Article 152^{6a} (1) has been filed.

Article 152³

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 reasons referred to in Article 129¹, Article 136¹, Article 138 (3) and (4), as well as Article 141, the Patent Office shall issue 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 152²(1) shall apply accordingly.

Article 152^{6b}

(1) Following an ineffective expiration of the time limit to file opposition referred to in Article 152^{6a}(1), the Patent Office shall issue a decision on the grant of protection for an international trade mark in the territory of the Republic of Poland (decision on the grant of protection), unless the Office finds that the requirements for the extension of the protection of the international trade mark to the territory of the Republic of Poland had not been fulfilled for reasons referred to in Article 129¹, Article 136¹, Article 138 (3) and (4), and Article 141. The Patent Office shall transmit the said decision along with a notification to the International Bureau within the time limits provided for in the Agreement or the Protocol. The transmission procedure, form and language of the notification shall be governed by the Agreement or the Protocol.

(2) Following the final termination of all opposition proceedings the Patent Office shall refuse to grant the protection for an international trade mark in the territory of the Republic of Poland within the scope in which the oppositions were considered justified, whereas in the remaining scope it shall extend the protection of the international trade mark to the territory of the Republic of Poland.

Article 152^{6c}

(1) If no obstacles preventing the grant of a right of protection referred to in Article 129¹ and Article 136¹ were found by the Patent Office, the conditions referred to in Article 138 (3) and (4) and Article 141 were satisfied, and no opposition referred to in Article 152^{6a} (1) was filed, the Patent Office shall, within the time limits provided for in the Agreement or the Protocol, issue a decision on grant of protection. The decision along with the notification shall be transmitted to the International Bureau in compliance with transmission procedure, in the form and language as provided for in the Agreement or the Protocol.

(2) In the case indicated in paragraph (1), the decision on grant of protection shall not be served upon the right holder.

Article 152⁷

The decision regarding grant of protection shall be liable to a party's request for re-examination of the matter. A time limit for submitting the request shall be 3 months from the date of service of the decision on the right holder. The provisions of Article 244 paragraphs (1¹) to (1⁴), and (5), Article 244¹ and Article 245 shall apply accordingly.

Article 152^{7a}

Following a final termination of the proceeding concerning the extension of protection of an international trade mark to the territory of the Republic of Poland, the Patent Office shall transmit to the International Bureau a notification of the decision issued as a result of the said proceedings, unless the decision along with notification, were transmitted under Article 152^{6b}(1).

Article 236

(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.