

MADRID PROTOCOL

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

DT-III.IR1536751.2.eklim

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: **1536751**

III. Name of the holder:

LABORATOIRES VIVACY, 44 rue Paul Valéry Paryż, FR

IV. Provisional refusal based on an opposition

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:

☐ Earlier European Union mark

YALU; 13.12.2017; application No. 1410088; Priorité: 13.06.2017,
Holder: SOFAR SWISS SA; Via Nassa 3 CH-6900 Lugano, CH

Details concerning the earlier mark(s) – see appendix

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

IX. Information related to further procedures:

i) The Patent Office of the Republic of Poland will send the received notice of opposition relating to the international registration in question directly to the holder of that registration with information on the procedure. The cooling-off period is set to expire two months after receipt of the notice of opposition by the holder. The holder may submit comments on opposition within said two months. After the expiry of the cooling-off period The Patent Office of the Republic of Poland will invite the holder to file the observations on the opposition. The observations must be filed directly with The Patent Office of the Republic of Poland.

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:

Ewa Klimek
expert

/document signed electronically/

XI. Date of notification to the International Bureau: 03.12.2020

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

Article 132¹

(1) After consideration of the opposition referred to in Article 152^{6a}(1) or Article 152¹⁷(1), and having deemed it justified, right of protection shall not be granted for sign:

- 1) whose use infringes third parties' personal or economic rights;
- 2) which is identical to a trade mark, which has been granted a right of protection with earlier priority to another party for identical products;
- 3) which is identical or similar to a 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 is 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 is 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;
- 6) if, pursuant to the national law or the European Union legislation providing for protection of a geographical indication or a designation of origin, a person authorised to exercise the rights arising from an earlier filing of an application for a geographical indication or a designation of origin, subject to its subsequent registration, is entitled to prohibit the use of a subsequent trade mark.

(2) The ground for the opposition referred to in Article 152^{6a}(1) or Article 152¹⁷(1) may also be trade mark 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 129¹(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.

Article 133

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 152¹⁷(1) shall be dismissed.

Article 152^{6a}

(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 personal 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 designation of the Republic of Poland for the extension of the protection of an international trade mark is filed, the Patent Office shall, when applying the procedure, form and language as provided for in the Agreement or the Protocol, notify the International Bureau of a statement of grounds which may prevent the protection of the international trade mark in whole or in part (provisional refusal of protection based on an opposition).

(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.

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 152¹⁹

(1) Patent Office shall, without delay, notify the applicant of an opposition and inform parties of the possibility of an amicable settlement of the dispute within two months of the date of delivery of the information.

(2) The time limit referred to in paragraph (1) may be extended to six months upon joint request of the parties.

(3) After the expiry of the time limit referred to in paragraph (1), the Patent Office shall invite the applicant to comment on the opposition within a fixed time limit. In the comments to the opposition the applicant shall include objections and cite all factual circumstances and supporting evidence.

(4) Within the time limit referred to in paragraph (3) the applicant may raise an objection of the lack of actual use of an earlier trade mark during an uninterrupted period of five years prior to the filing date of a trade mark being the subject of opposition for goods included in the opposition unless there are significant reasons for the lack of use or the period of five years from the registration of an earlier trade mark has not expired. If the objection is found to be justified, the Patent Office shall dismiss the opposition.

(5) Patent Office shall submit the comments on the opposition to the party filing the opposition and shall fix a time limit for him to react and to complete evidence. The provision of Article 169(6) shall apply accordingly.

(6) The applicant may make comments on the evidence and claims presented pursuant to paragraph (5) by the party filing the opposition within the time limit fixed by the Patent Office.

(7) Patent Office may invite the party to the proceedings to present within a fixed time limit, its position in respect of the materials presented by the other party or the Patent Office.

(8) Patent Office shall disregard claims and evidence which were not presented within the fixed time limit unless the party proves that they could not have been put forward or that the need to present them arose later. Further claims and supporting evidence shall be admitted within a month from the date on which the possibility or the need of presenting them arose.

Article 152²⁰

Patent Office shall consider the opposition within its limits and shall be bound by the legal basis indicated by the party submitting the opposition.

Article 152²¹

After the consideration of the opposition the Patent Office shall take a decision on dismissing the opposition or on finding it justified in whole or in part.

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.

Potwierdzam zgodność kopii z dokumentem elektronicznym:

Identyfikator dokumentu	1308458.7761321.9948216
Nazwa dokumentu	2. IR - wstępna odmowa całkowita od 15.4.16-sprzeciw-j.ang.pdf
Tytuł dokumentu	2. IR - wstępna odmowa całkowita od 15.4.16-sprzeciw-j.ang
Sygnatura dokumentu	DT-III.IR1536751.2.eklim
Data dokumentu	2020-12-03 00:00:00
Skrót dokumentu	5EE2E27D6618938F170FA35D0B5F0DD1DFD95D68
Wersja dokumentu	1.5
Data podpisu	2020-12-03
Podpisane przez	Ewa Jolanta Klimek Ekspert
Rodzaj certyfikatu	Certyfikat kwalifikowany podpisu elektronicznego
	I.Z/D 3 98 1 1 8969
Data wydruku:	2020-12-03 11:29 17
Autor wydruku:	Klimek Ewa

EUTM file information

YALU
1410088

Timeline



Trade mark information

Name	YALU	Filing date	
Filing number	1410088	Registration date	13/12/2017
Basis	IR (Search on WIPO database)	Expiry date	13/12/2027
Date of receipt	28/06/2018	Designation date	13/12/2017
Type	Word	Filing language	French
Nature	Individual	Second language	Italian
Nice classes	3, 5, 35 (Nice Classification)	Application reference	S376/160
Vienna Classification		Trade mark status	Opposition pending
		Acquired distinctiveness	No

Goods and services

français (fr)

3 Savons; produits de parfumerie; huiles essentielles; lotions de soins capillaires; gel anti-âge; lotions anti-âge; hydratants anti-âge à usage cosmétique; crèmes anti-vieillessement; crèmes antirides; crèmes pour le visage (non médicamenteux); cold-cream à usage non médical; cosmétiques pour le traitement des rides; préparations cosmétiques antirides pour le visage à usage topique; crèmes cosmétiques; crème pour blanchir la peau; eaux de toilette; eaux de senteur; préparations d'aloë vera à usage cosmétique; arômes alimentaires [huiles essentielles]; astringents à usage cosmétique; baumes autres qu'à usage médical; cosmétiques; cosmétique pour cils; cosmétiques pour les sourcils; gels de massage autres qu'à usage médical; cosmétiques, à savoir gels; gels hydratants [cosmétiques]; gels pour le visage; gels cosmétiques pour le contour des yeux; crèmes, lotions et gels hydratants; graisses à usage cosmétique; gelée de pétrole à usage cosmétique; lait d'amandes à usage cosmétique; laits de toilette; lotions à usage cosmétique; masques de beauté; huiles de toilette; huiles pour la parfumerie; huiles à usage cosmétique; pommades à usage cosmétique; préparations cosmétiques pour le bronzage de la peau; préparations cosmétiques pour le bain; préparations cosmétiques pour l'amincissement; préparations cosmétiques pour le soin de la peau; produits de parfumerie; préparations de maquillage; produits de toilette; serviettes imprégnées de lotions cosmétiques; cosmétiques pour la peau; crèmes non médicamenteuses pour la peau.

5 Préparations dermatologiques; produits pharmaceutiques dermatologiques; substances pharmaceutiques

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non), compléments homéopathiques (à usage médical et non), médicaments homéopathiques, produits pharmaceutiques homéopathiques; substances diététiques à usage médical et substances alimentaires diététiques; compléments alimentaires; compléments vitaminés; compléments nutritionnels; compléments antioxydants; compléments probiotiques; produits, substances, préparations pharmaceutiques et produits, substances, préparations parapharmaceutiques.

35 Services de vente au détail et en gros pour des tiers également par correspondance et par autres moyens de communications y compris internet de savons, produits de parfumerie, huiles essentielles, lotions de soins capillaires, gel anti-âge, lotions anti-âge, hydratants anti-âge à usage cosmétique, crèmes anti-âge, crèmes anti-rides, crèmes pour le visage [non médicamenteux], cold-cream à usage non médical, cosmétiques pour le traitement des rides, préparations cosmétiques anti-rides pour le visage à usage topique, crèmes cosmétiques, crème pour blanchir la peau, eaux de toilette, eaux de senteur, préparations d'aloë vera à usage cosmétique, arômes (huiles essentielles), astringents à usage cosmétique, baumes autres qu'à usage médical, cosmétiques, cosmétique pour cils, cosmétiques pour les sourcils, gels de massage autres qu'à usage médical, cosmétiques, à savoir gels, gels hydratants [cosmétiques], gels pour le visage, gels cosmétiques pour le contour des yeux, crèmes, lotions et gels hydratants, graisses à usage cosmétique, gelée de pétrole à usage cosmétique, lait d'amandes à usage cosmétique, laits de toilette, lotions à usage cosmétique, masques de beauté, huiles de toilette, huiles pour la parfumerie, huiles à usage cosmétique, pommades à usage cosmétique, préparations cosmétiques pour le bronzage de la peau, préparations cosmétiques pour le bain, cosmétiques pour l'amincissement, préparations cosmétiques pour le soin de la peau, produits de parfumerie, préparations de maquillage, produits de toilette, serviettes imprégnées de lotions cosmétiques, cosmétiques pour la peau, crèmes dermatologiques [non médicamenteux]; services de vente au détail et en gros pour des tiers également par correspondance et par autres moyens de communications y compris internet de préparations dermatologiques, produits pharmaceutiques dermatologiques, substances pharmaceutiques dermatologiques, préparations pharmaceutiques à usage dermatologique, crèmes à usage dermatologique, gels à usage dermatologique, lotions pour la peau à usage médical, lotions de soin pour la peau à usage médical, préparations de soin pour la peau à usage médical, cold-cream à usage médical, compléments alimentaires, préparations et substances nutritionnels, minéraux, diététiques (à usage médical et non), nutraceutiques, vitaminés, antioxydants, pour la flore intestinale bactériens et préparations alimentaires et substances homéopathiques (à usage médical et non), substances diététiques à usage médical et substances alimentaires diététiques, compléments alimentaires, compléments vitaminés, compléments nutritionnels, compléments antioxydants, complément probiotiques, produits, substances, préparations pharmaceutiques; aide à la direction des affaires en matière de franchisage.

Description

No data

Owners

SOFAR SWISS SA

ID	n/a	Country	CH - Switzerland	Hidden. You can set your contact details to be publicly available via the User Area.
Organisation	n/a	State/country	n/a	
Legal status	Aktiengesellschaft (AG)	Town	n/a	
		Post code	n/a	Hidden. You can set your contact details to be publicly available via the User Area.
		Address	Via Nassa 3 CH-6900 Lugano	
				Hidden. You can set your contact details to be publicly available via the User Area.

Representatives

HOFFMANN · EITLE PATENT- UND RECHTSANWÄLTE PARTMBB

ID	10624	Country	DE - Germany	Correspondence address	
Organisation	n/a	State/country	n/a	HOFFMANN · EITLE Patent- und Rechtsanwälte PartmbB Postfach 81 04 20 D-81904 München ALEMANIA	Hidden. You can set your contact details to be publicly available via the User Area.
Legal status	Legal person	Town	München		
Type	Association	Post code	81925		
		Address	Arabellastr. 30		Hidden. You can set your contact details to be publicly available via the User Area.

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Correspondence

From	Procedure	Filing number	Subject	Date	Actions
	Opposition	003067805	B200B	24/11/2020	
	Opposition	003067805	B200A	23/11/2020	
IR		1410088	MPER1 - Notification of the entry / deletion of a representative in the EUIPO database	10/09/2020	
	Opposition	003067805	B227B - Notification to the applicant/holder of suspension of the opposition proceedings	12/05/2020	
	Opposition	003067805	B227A - Notification to the opponent of suspension of the opposition proceedings	12/05/2020	
	Opposition	003067805	B228B - Notification to the applicant/holder of refusal of the request for suspension	14/04/2020	
	Opposition	003067805	B228A - Notification to the opponent of refusal of the request for suspension	14/04/2020	
	Opposition	003067805	B236B	03/03/2020	
	Opposition	003067805	B236A - Notification to the applicant/holder of observations from the opponent	03/03/2020	
	Opposition	003067805	B224B	07/01/2020	

Showing 1 to 10 of 48 entries

IR transformation

No data

Seniority

No data

Exhibition priority

No data

Priority

Country	Filing number	Date	Status
Switzerland	707452	13/06/2017	Claimed

Showing 1 to 1 of 1 entries

Publications

Bulletin number	Date	Section	Description
2018/124	04/07/2018	M.1	IR_M_1

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Cancellation

No data

Recordals

No data

Oppositions

Filing number	Date	Grounds	Opponent	Representative	Language	Reference	Status	Extent of op
003067805	02/11/2018	Likelihood of confusion	FIDIA FARMACEUTICI S.p.A.	DR. KUNZ-HALLSTEIN RECHTSANWÄLTE	French	S376/127W1j22/pfr	Suspended	Class 3 S produits parfume essentiel soins cap anti-âge; âge; hyd âge à us; cosmétic anti-vieil crèmes a crèmes p [non mé; cold-crea non mé; cosmétic traiteme préparat cosmétic pour le v topique; cosmétic pour bla eaux de de sente préparat vera à us cosmétic alimenta essentiel astringer cosmétic autres q; médical; cosmétic cosmétic sourcils; massage usage m cosmétic gels; gels [cosméti pour le v cosmétic contour crèmes, l hydratar usage co gelée de usage co d'amand cosmétic toilette; f usage co masques huiles de huiles pc parfume usage co normmar

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Filing number	Date	Grounds	Opponent	Representative	Language	Reference	Status	Extent of of
								préparat cosmétic bain; pré cosmétic l'aminicis préparat cosmétic soin de l. produits parfume préparat maquilla de toilette imprégn- cosmétic cosmétic peau; cri médicam pour la p Préparat dermato produits pharmac dermato substanc pharmac dermato préparat pharmac usage dermato crèmes à dermato à usage dermato lotions p usage m de soin p usage m préparat pour la p médical; médicam pour la p complén alimenta supplém nutrition complén minérau. complén diététiqu médical préparat nutraceut vitaminé antioxyd flore inte préparat bactérier préparat alimenta médical complén homéop. usage m médicam homéop. produits pharmac homéop. substanc diététiqu médical alimenta diététiqu

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Filing number	Date	Grounds	Opponent	Representative	Language	Reference	Status	Extent of op
								nutrition complén antioxyd complén probiotic produits, préparat pharmac produits, préparat parapha

Showing 1 to 1 of 1 entries

Appeals

No data

Decisions

No data

Renewals

No data

Trade mark relations

No data

International Applications

No data

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