



**ESTONIAN PATENT OFFICE**  
**TRADEMARK DEPARTMENT**

**THE PROTOCOL RELATING TO THE MADRID AGREEMENT**  
**CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

**NOTIFICATION OF *EX OFFICIO* PROVISIONAL REFUSAL**

notified to the International Bureau of the World Intellectual Property Organization (WIPO)  
according to Article 5 of the Madrid Protocol

- I. Name and address of the office refusing protection: 1 (3)
- The Estonian Patent Office**  
**Trademark Department**  
**Toompuiestee 7**  
**15041 Tallinn**  
**ESTONIA**  
**Telephone: + 372 627 7927**
- II. Number of the international registration which is the subject of the provisional refusal:
- 1561853**
- III. Other information concerning the international registration which is the subject of the provisional refusal:  
Verbal elements of the mark: **MEDSPA**
- IV. The grounds for this provisional refusal are the following:
- The sign **MEDSPA** only indicates the kind and intended purpose of the goods and services indicated in item VI, namely that the goods and services in question are provided by or are related to medical spas (also known as medispas, medspas).  
The sign **MEDSPA** is not distinctive for goods and services indicated in item VI, because it is devoid of any distinctive character.
- Therefor the IR 1561853 cannot be registered in Estonia for goods and services indicated in item VI.**
- V. Provision of the Estonian Trademark Act applicable on the subject (enclosed):  
Section 9 subsections 1(2) and 1(3).
- Section 9 subsection 1(6) (applicable in case the sign becomes deceptive as a result of the limitation of the list of goods).
- VI. The grounds referred to in item IV affect:
- a) all goods and services in classes 3 and 44.**
- b) following goods in class 5: Tanning pills; sea water for medicinal bathing; lead water; mineral waters for medical purposes; thermal water; nutritional supplements; dietetic foods adapted for medical purposes; antioxidant pills; balms for medical purposes; dietetic beverages adapted for**

medical purposes; medicated massage candles; deodorants, other than for human beings or for animals; balsamic preparations for medical purposes; medicinal mud; mud for baths; dietary supplements with a cosmetic effect; vaginal washes for medical purposes; medicated after-shave lotions; medicated hair lotions; lotions for pharmaceutical purposes; medicinal oils; slimming pills; pomades for medical purposes; phytotherapy preparations for medical purposes; acne treatment preparations; therapeutic preparations for the bath; sunburn ointments; pharmaceutical preparations for skin care; antibacterial soap; disinfectant soap; medicated shampoos; dietetic substances adapted for medical use; suppositories; medicinal tea; herbal teas for medicinal purposes; food supplements; dietary supplements.

c) following services in class 35: Organization of trade fairs for commercial purposes; conducting, arranging and organizing trade shows and trade fairs for commercial purposes; retail and wholesale services, also online or through downloadable applications and new technologies, relating to eau de cologne, toilet water, scented water, hair conditioners, bases for flower perfumes, massage candles for cosmetic purposes, depilatory wax, mustache wax, make-up powder, mouthwashes, not for medical purposes, hair dyes, cosmetics, cosmetics for animals, cosmetics for children, cosmetic preparations for eyelashes, eyebrow cosmetics, cosmetic creams, skin whitening creams, dentifrices, deodorants for pets, deodorants for human beings or for animals, vaginal washes for personal sanitary or deodorant purposes, cleansers for intimate personal hygiene purposes, non medicated, ethereal essences, herbal extracts for cosmetic purposes, extracts of flowers [perfumes], massage gels, other than for medical purposes, dental bleaching gels, hair spray, almond milk for cosmetic purposes, cleansing milk for toilet purposes, after-shave lotions, hair lotions, lotions for cosmetic purposes, lip glosses, mascara, beauty masks, eyebrow pencils, cosmetic pencils, cosmetic kits, oils for toilet purposes, cotton wool for cosmetic purposes, pomades for cosmetic purposes, potpourris [fragrances], sun-tanning preparations [cosmetics], cosmetic preparations for baths, aloe vera preparations for cosmetic purposes, collagen preparations for cosmetic purposes, douching preparations for personal sanitary or deodorant purposes [toiletries], phytocosmetic preparations, bath preparations, not for medical purposes, toiletry preparations, eye-washes, not for medical purposes, hair straightening preparations, hair waving preparations, sunscreen preparations, cosmetic preparations for slimming purposes, cosmetic preparations for skin care, depilatory preparations, perfumery, antiperspirants [toiletries], make-up preparations, nail care preparations, shaving preparations, make-up removing preparations, perfumes, air fragrancing preparations, lipsticks, bath salts, not for medical purposes, cakes of toilet soap, soap, shampoos, nail polish, talcum powder, for toilet use, cosmetic dyes, beard dyes, tissues impregnated with cosmetic lotions, make-up, tanning pills, sea water for medicinal bathing, lead water, mineral waters for medical purposes, thermal water, nutritional supplements, dietetic foods adapted for medical purposes, food for babies, amino acids for medical purposes, anaesthetics, antioxidant pills, dressings, medical, balms for medical purposes, dietetic beverages adapted for medical purposes, sedatives, medicated massage candles, medicated sweets, adhesive plasters, vitamin supplement patches, collagen for medical purposes, collyrium, compresses, decoctions for pharmaceutical purposes, medicated toothpastes, deodorants, other than for human beings or for animals, air deodorising preparations, depuratives, digestives for pharmaceutical purposes, elixirs [pharmaceutical preparations], enzymes for medical purposes, medicinal herbs, balsamic preparations for medical purposes, medicinal mud, mud for baths, milk ferments for pharmaceutical purposes, ferments for pharmaceutical purposes, immunostimulants, medicinal infusions, dietary supplements with a cosmetic effect, mineral food supplements, vaginal washes for medical purposes, medicated after-shave lotions, medicated hair lotions, lotions for pharmaceutical purposes; eyepatches for medical purposes; medicines for human purposes; medicinal oils, hormones for medical purposes, royal jelly for pharmaceutical purposes, pastilles for pharmaceutical purposes, slimming pills, pomades for medical purposes, chemical preparations for pharmaceutical purposes, chemical preparations for medical purposes, preparations of trace elements for human and animal use, enzyme preparations for medical

purposes, phytotherapy preparations for medical purposes, vitamin preparations, pharmaceutical preparations, acne treatment preparations, therapeutic preparations for the bath, sunburn ointments, pharmaceuticals, pharmaceutical preparations for skin care, mouthwashes for medical purposes, tonics [medicines], antibacterial soap, disinfectant soap, syrups for pharmaceutical purposes, medicated shampoos, dietetic substances adapted for medical use, suppositories, medicinal tea, herbal teas for medicinal purposes, tissues impregnated with pharmaceutical lotions, food supplements, dietary supplements, vitamin supplements.

d) following services in class 41: Academies [education]; cultural activities; providing of training; conducting of instructional, educational and training courses for young people and adults; conducting of educational courses; conducting of training workshops; conducting of training seminars; consultancy relating to training, further training and education; distance learning courses; teaching; practical training [demonstration]; advanced training; training in the use of surgical, medical, dental and veterinary instruments and apparatus; providing educational courses relating to diet; providing educational courses in the field of diet and health care; providing on-line training; providing information about education; organization of training; organization of competitions [education or entertainment]; organization of congresses and conferences for cultural and educational purposes; organization of exhibitions for cultural or educational purposes; arranging of symposiums and training workshops; arranging and conducting of conferences, congresses, seminars, symposiums, training courses, classes and lectures.

VII. The owner of the registration may request a review of the provisional refusal. The request shall be received by Estonian Patent Office no later than within 4 months from the date of the provisional refusal.

The time limit expires **18/06/2021** (dd/mm/yyyy).

**The request has to be filed through the authorized patent attorney of the Republic of Estonia** (section 13 subsection 2 of the Estonian Trademark Act). List of patent attorneys is available at <http://www.epa.ee/>

**Please note** that if the owner of the registration fails to respond by the due date, the registration shall be deemed to be withdrawn for goods and services mentioned in item VI (section 38 subsection 2 of the Estonian Trademark Act). The owner may request that processing be resumed (section 47 subsection 3 of the Estonian Trademark Act).

**Please note** that if the mark is protected subsequent to reviewal of the provisional refusal an interested person may contest the owners right to a trade mark within two months as of the publication of the trade mark (section 41 subsection 2 of the Estonian Trademark Act).

VIII. Date on which the provisional refusal was pronounced: 18/02/2021 (dd/mm/yyyy).

IX. Signature of the Office:

Ekke-Kristian Erilaid  
Senior Examiner

## **Extract from the Estonian Trademark Act**

### **§ 9. Absolute circumstances which preclude legal protection**

(1) Legal protection is not afforded to the following signs:

2) signs which are devoid of any distinctive character.

3) signs which consist exclusively of signs or indications which designate the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services.

6) signs which are of such a nature as to mislead the consumer as to the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services

### **§ 13. Representative for performing acts related to legal protection of trade marks**

(2) A person with no residence, seat or commercial or industrial enterprise operating in Estonia shall authorise a patent attorney as the person's representative to perform procedures related to trade marks at the Patent Office and at the Board of Appeal, except the filing of an application.

### **§ 38. Examination of trade marks**

(2) If an examination reveals circumstances which preclude the legal protection of a trade mark, the Patent Office shall notify the applicant thereof and set a term of at least two months for eliminating said circumstances or giving explanations. If the applicant fails to respond within the set term, the application is deemed to be partially or fully withdrawn.

### **§ 41. Adjudication of appeals and revocation applications**

(2) An interested person may contest an applicant's right to a trade mark at the Board of Appeal if any circumstances specified in subsection § 10 of this Act which preclude legal protection exist. The term for filing a revocation application is two months from the publication of the notice of the decision to register a trade mark.

### **§ 47. Withdrawal of applications, termination and resumption of processing**

(2) If an application is withdrawn in the manner specified in subsection (1) of this section or deemed to be partially or fully withdrawn in the cases specified in subsections 37 (3) and 38 (2) of this Act, processing of the respective part is terminated and the applicant is notified thereof. If processing is terminated, the application documents are not returned and the state fee is not refunded.