

Notification of ex-officio provisional total refusal of protection (Article 5 of the Madrid Protocol, Rule 17(1) and (2) of the Regulations under the Protocol relating to the Madrid Agreement, and Article 33 EUTMR)

Alicante, 03/03/2021

International registration number: **1574744**
Name of the holder: **Biosoft (Australia) Pty Ltd**
Trade mark: **Dermapen**

The Office has examined your international registration designating the European Union to ensure that it does not fall under any of the grounds for refusal established under Article 7 EUTMR.

The sign

The application consists of the verbal mark '**Dermapen**'.

Legal basis for the objection

Article 7(1)(b) and (c) EUTMR

The sign you have applied for is ineligible for registration under Article 7(1)(b) and (c) and Article 7(2) EUTMR because it describes the nature and purpose of the goods for which protection is sought and is devoid of any distinctive character.

The goods for which this objection is raised are these (all the goods in the list of specifications):

10 *Medical devices for microneedling and dermabrasion.*

The assessment of descriptiveness is based on how the relevant consumer would perceive the sign in relation to the goods and/or services for which protection is sought. In the present case, the English speaking consumer would understand the sign as having the following meaning: An instrument resembling a pen to be applied to the skin.

The abovementioned meaning of the words 'derma' and 'pen' composing the trade mark can be supported by the following dictionary references:

DERMA: *Dermis (skin).*

PEN: *A pen is a long thin object which you use to write in ink.*

Information extracted from *Collins Dictionary* on 03/03/2021 at www.collinsdictionary.com

Therefore, the relevant consumers will perceive the sign '**Dermapen**' as describing that the holder's instruments for microneedling and dermabrasion consist of a dermatological pen (a device resembling a pen) intended for skin treatments, and will not perceive this verbal expression as the manufacturing or commercial origin of these instruments, namely, as a trade mark.

Lack of distinctiveness

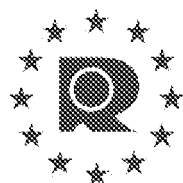
Given that the sign has a clear descriptive meaning, it is also devoid of any distinctive character and therefore objectionable under Article 7(1)(b) EUTMR, as it is incapable of performing the essential function of a trade mark, which is to distinguish the goods and/or services of one undertaking from those of its competitors.

Consequently, taken as a whole, the sign for which protection is sought is descriptive and devoid of any distinctive character, and is not capable of distinguishing the goods to which an objection has been raised within the meaning of Article 7(1)(b) and (c) and Article 7(2) EUTMR.

The holder of the international registration is obliged to be represented before the Office by a legal practitioner or professional representative that is entitled to represent third parties before the EUIPO (Articles 119(2) and 120(1) EUTMR). Protection of the international registration for the European Union will be refused in whole if a representative is not appointed within the time limit indicated under II.

I. Time Limit

The holder of the international registration is hereby given a time limit of two months to overcome the ground for refusing protection indicated and to comply with the requirements indicated above. Failure to do so will mean that after expiry of the time limit, the Office will render a decision in which it refuses the protection in whole or in part. Said decision may be appealed. The time limit of two months to reply to the present refusal will start on the day the present notification was issued by the Office (Article 193(2), (3) and (4) EUTMR). Any such reply of the holder of the international registration shall be addressed to the EUIPO only.



Mercedes SIERRA
Examiner

AG2Review done by Elna ISAKSSON - This communication has been reviewed in accordance with the Office's latest initiative for quality enhancing and sharing knowledge, introduced by Decision No EX-20-06 of the Executive Director.
