

MADRID AGREEMENT AND PROTOCOL
PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

I.	Office sending the statement:	Hungarian Intellectual Property Office 1438 Budapest, Pf.415 Fax. : (361) 474 - 5534
II.	Number of the international registration: 157 4744 Date of extension of the mark to Hungary: 2020.11.11	
III.	Name of the holder (or other information enabling the identity of the international registration to be confirmed): Biosoft (Australia) Pty Ltd	
IV.	☒ Provisional refusal based on an ex officio examination Provisional refusal based on an opposition Provisional refusal based on an observation	
V.	☒ Provisional refusal for all the goods and/or services Provisional refusal for some of the goods and/or services: (followed by an indication of the goods and/or services which are affected or are not affected)	
VI.	Grounds for refusal (where applicable, see item VIII): 2. § (2)(a)	
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) List of all or relevant goods and/or services:

Corresponding essential provisions of the applicable law

A sign shall not be granted trade mark protection if it consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or services.

VIII. The trade mark application consists of the words „DERMA” and „PEN”. „Derma” is the latin word for skin, and „pen” is a long, thin object used for writing or drawing with ink. Pen is also commonly used in the medical field, because many devices have a pen shape with a needle that can be used for injections or exfoliation. Therefore the sign is considered descriptive in connection with the applied goods in class 10. It only indicates the kind and intended purpose of the goods, which is the dermabrasion of the skin (for example after a surgery). Pursuant to the above mentioned facts the sign „DERMAPEN” would not identify the above mentioned goods of one undertaking from the other.

Information relating to subsequent procedure:

(i) Time limit for replying the present provisional refusal: 2021.08.20

(ii) Authority to which such reply shall be made:

Hungarian Intellectual Property Office

(iii) Indications concerning the appointment of a representative:

If the applicant is foreign person whose domicile or residence is outside the European Economic Area, he is obliged to appoint an agent entitled to act before the Hungarian Intellectual Property Office

Note: the official language of trademark procedures before the HIPO is Hungarian.

(iv) Procedure in the absence of a reply:

IX. If the applicant does not reply to the invitation within the fixed time limit, the Hungarian Intellectual Property Office shall notify the International Bureau, except when paragraph (5a) is applicable, that the protection of the trade mark extending to Hungary is refused (final refusal), or that protection is only partially recognised by the Hungarian Intellectual Property Office. The Hungarian Intellectual Property Office shall send such notification to the International Bureau after the decision on final refusal or on partial recognition of the protection has become final and binding. If trade mark protection is recognised in part, the date of registration shall be the date of the decision.

If the applicant fails to reply, within the fixed time limit, to an invitation of the Hungarian Intellectual Property Office issued solely upon an opposition, the Hungarian Intellectual Property Office shall decide on the registration of the trade mark on the basis of the available information, and shall notify the International Bureau accordingly, sending either a notification on the final refusal or a notification made in accordance with paragraph (5e).
WARNING: In case of an opposition, the expenses arisen in connection with the opposition can be

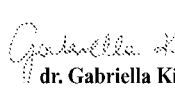


imposed on the losing party by the Hungarian Intellectual Property Office. The amount shall be found in the HIPO's decision.

X. Examiner: Varga Bence Győző
Number of decision: A1574744/4
Date: 2021.05.12

Signature or official seal of the Office sending the statement:

XI.


dr. Gabriella Kiss



Head of the International Trademark Section



ACT XI OF 1997 ON THE PROTECTION OF TRADE MARKS AND GEOGRAPHICAL INDICATIONS

PART ONE

PROTECTION OF TRADE MARKS

Chapter I

SUBJECT MATTER OF TRADE MARK PROTECTION

Signs capable of distinction

Section 1 (1) Trade mark protection may be granted for any signs, provided that these

- a) are capable of distinguishing goods or services from the goods or services of others; and
- b) can be represented in the trade mark register in a manner which enables the authorities and the public to clearly and precisely determine the subject matter of the protection applied for or granted to its holder.

(2) Trade mark protection may be granted, in particular, for the following signs:

- a) words, word combinations, including personal names and slogans;
- b) letters, numerals;
- c) figures, pictures;
- d) two- or three-dimensional forms, including the shape of goods or of their packaging;
- e) colours, colour combinations, light signals, holograms;
- f) sound signals;
- g) motion signs;
- h) position signs;
- i) multimedia signs;
- j) patterns; or
- k) combinations of different signs.

Absolute grounds for refusal

Section 2 (1) A sign not meeting the requirements specified in section 1 shall not be granted trade mark protection.

(2) A sign shall not be granted trade mark protection if:

- a) it consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
- b) it consists exclusively of signs or indications which have become established and customary in the current language or in the bona fide practices of the trade;
- c) it is, for any other reason, devoid of any distinctive character;
- d) it consists exclusively of

- da) a shape, or another characteristic, which results from the nature of the goods,
- db) the shape, or another characteristic, of goods which is necessary to obtain the intended technical result, or
- dc) a shape, or another characteristic, which gives substantial value to the goods.

(3) Pursuant to paragraph (2)(a) to (c) the sign shall not be excluded from trade mark protection if – by virtue of its use – it has become distinctive either before the date of application or thereafter, but before the date of registration.

Section 3 (1) A sign shall not be granted trade mark protection if:

- (a) it is contrary to public policy or accepted principles of morality;
- b) it is of such a nature as to deceive the consumers, in particular regarding the nature, quality, geographical origin or other characteristics of the goods or services;
- (c) its registration was applied for in bad faith.

(2) A sign shall not be granted trade mark protection if:

(a) it consists of, or contains any of the signs listed in Article 6^{ter}(1) of the Paris Convention for the Protection of Industrial Property, provided that

(aa) such a sign – if it is not a State flag – has been communicated according to Article 6^{ter}(3), and

(ab) the registration of the sign – consisting of or containing an official sign or hallmark indicating control and warranty – was applied for in respect of identical or similar goods as officially identified by the signs referred to;

(b) it consists of a badge, emblem or escutcheon, not covered by point (a), the use of which is of public interest, or if it contains such badge, emblem or escutcheon;

c) it includes – in a manner determining the general impression of the sign – a symbol which strongly expresses a religious or other conviction.

(3) Trade mark protection may be granted with the consent of the competent authority for signs which consist of or contain the signs specified under paragraph 2(a) and (b).

(4) A sign shall not be granted trade mark protection if:

a) trade mark protection is applied for after the date of application of a geographical indication protected pursuant to Part VII of this Act, in relation to goods which are of the same type as the goods designated by the geographical indication, and its use would be contrary to section 109(2),

b) it is excluded from protection pursuant to European Union legislation providing for protection of designations of origin and geographical indications, or

c) it is excluded from protection pursuant to an international agreement, to which the European Union or Hungary is party, providing for protection of designations of origin and geographical indications.

(5) A sign shall not be granted trade mark protection if it is excluded from protection pursuant to European Union legislation, or an equivalent international agreement to which the European Union is party, providing for the protection of traditional terms for wine.

(6) A sign shall not be granted trade mark protection if it is excluded from protection pursuant to European Union legislation regulating the registration of traditional specialities guaranteed, or an

equivalent international agreement to which the European Union is party.

(7) A sign shall not be granted trade mark protection if – in respect of plant varieties of the same or closely related species – it consists of, or reproduces in its essential elements, an earlier plant variety denomination, which has been registered in the plant variety register pursuant to

- a) European Union legislation providing for plant variety protection,
- b) the Patent Act, or
- c) an international agreement to which the European Union or Hungary is party, providing for plant variety protection.

Relative grounds for refusal

Section 4 (1) A sign shall not be granted trade mark protection:

(a) with respect to identical goods or services, if the sign with the later date of priority is identical with an earlier trade mark;

b) if because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade mark, there exists a likelihood of confusion on the part of the consumers; including the case where the likelihood of confusion is present because consumers may link the sign to the earlier trade mark by way of association;

c) if its date of priority is of a later date than that of an earlier, identical or similar trade mark which has a reputation in Hungary, or, in the case of an EU trade mark, in the European Union, irrespective of whether the goods or services for which it is applied are identical with, or similar to, those for which the earlier trade mark is registered, where use of that sign without due cause would be detrimental to, or take unfair advantage of, the distinctive character or the repute of the trade mark with a reputation.

(2) For the purposes of this section ‘earlier trade mark’ means:

a) all

aa) trade marks registered under this Act, including trade marks registered under international agreements which have effect in Hungary,

ab) EU trade marks registered under Regulation 2017/1001/EU of the European Parliament and the Council (hereinafter ‘EU Trade Mark Regulation’),

the date of application – or where applicable – the date of claimed priority of which is earlier than the application for registration of the trade mark;

b) for the purposes of paragraph (1)(a) and (b), signs which – irrespective of their registration – on the date of application for registration of the trade mark, or, where appropriate, of the priority claimed in respect of the application for registration of the trade mark, are considered to be well known in Hungary pursuant to Article 6bis of the Paris Convention;

c) EU trade marks which validly claim seniority, in accordance with the EU Trade Mark Regulation, of a trade mark referred to in point (a)(aa), even when the protection of the latter trade mark has been surrendered or allowed to lapse;

d) applications for the registration of trade marks referred to in points (a) and (c), subject to

their registration,
with the understanding that where this Act refers to an earlier or later trade mark, the provisions laid down in this paragraph shall apply *mutatis mutandis* with respect to their chronological order.

(3) A sign shall not be excluded from trade mark protection if it is in conflict with an earlier trade mark which has not been put to use by its holder in accordance with the provisions of section 18, or the protection of which no longer exists at the filing date of the trade mark application.

(4) *[repealed]*

Section 5 (1) No sign shall be granted trade mark protection which

a) would infringe a right relating to the personality of others, in particular the right to a name or the right of personal portrayal;

b) would conflict with someone else's copyright or related right, or industrial property right.

(2) Trade mark protection shall not be granted for

a) a sign, if its use could be prohibited, by virtue of a sign which has been genuinely used earlier, in the course of trade, without registration in Hungary, by the earlier user pursuant to another law;

b) a sign the use of which could be prohibited by the person entitled to exercise the rights arising from geographical indications based on European Union legislation or national law providing for protection of designations of origin and geographical indications, provided that the application for registration of the designation of origin or geographical indication had been filed prior to its date of application for registration, and subject to the subsequent registration of the designation of origin or of the geographical indication.

(3) The priority of the trade mark application shall be taken into account when deciding whether the application for the registration of the right, use, designation of origin or geographical indication is to be considered as filed earlier for the purposes of paragraphs (1) and (2).

Section 6 A sign shall not be granted trade mark protection if a representative or agent of the holder of a trade mark applies for registration thereof in his own name without the holder's authorization, unless the representative or agent justifies his action.

Declaration of consent

Section 7 (1) A sign shall not be excluded from trade mark protection pursuant to section 4, section 5(1) or section 5(2)(a), or the trade mark shall not be declared invalid pursuant to the grounds for refusal laid down in these provisions, if the holder of the earlier conflicting right consents to the registration of the sign.

(2) A declaration of consent shall be valid if drawn up in a public deed or private deed of full probative value.

(3) The declaration of consent may not be withdrawn nor may it be replaced by a court decision.

Eligibility for trade mark protection

Section 8 (1) Trade mark protection shall be granted for a sign if

- (a) it satisfies the requirements of section 1 and is not excluded from trade mark protection under the terms of sections 2 to 7, and
- (b) the relevant application meets the requirements laid down in this Act.

[...]