

Israeli Patent Office, Trademarks Department

1 Agudat Sport Hapoel St., Technological Garden, Building No. 5,
Jerusalem, 9695101, Israel

Fax: 972-2-6467026

E-mail: trademarks@justice.gov.il

NOTIFICATION OF PROVISIONAL REFUSAL

According to Madrid protocol, Rule 17(1)

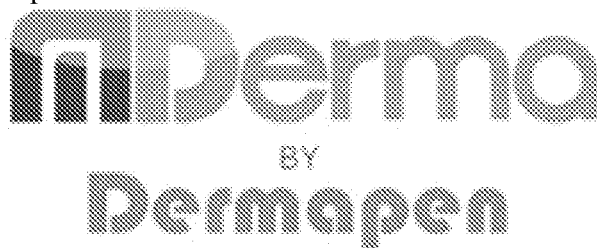
I.	Date of the notification of provisional refusal: 24/05/2021
II.	International Registration Number: 1574744
III.	Name of the holder: Biosoft (Australia) Pty Ltd
IV.	☒ Provisional refusal based on an <i>ex officio</i> examination ☐ Provisional refusal based on an opposition
V.	☒ Provisional refusal for all the classes ☐ Provisional refusal for some of the classes:
VI.	The application does not conform to the requirements of the Israeli trademarks law under article/s: 11 (9), 56F (a)(1)&18 of the trademark ordinance (see text under XV).
VII.	Grounds for refusal: - The mark resembles in a way that is liable to create confusion with a prior mark no. 324909 for similar or identical goods or services. According to article 11(9) of the trademark ordinance - see details under IX - If the applicant manages to overcome the aforementioned refusal [according to article 11 (9)], the acceptance will be stipulated by the following condition: The applicant must give his consent for a notification regarding the acceptance of the above mentioned application to be delivered to the owner of mark no. 252243 . According to article 56F (a)(1)&18 of the trademark ordinance - see details under IX

VIII. If the applicant does not respond within the time limit (3 months of the issue date), a secondary examination will be conducted, if no other grounds for refusal are raised at that time :

- ☒ The international registration shall be considered abandoned in Israel.
- ☐ The goods/services protected in class/es _____ - won't include the items indicated in this office action.
- ☐ Class/es _____ - will be omitted from the application.
- ☐ The mark shall be accepted according to the stipulations stated above.

IX. Information relating to an earlier registered mark/s :

- (i) Filing date and number, and, if any, priority date:
26/11/2019, **324909**
- (ii) Registration date and number (if available):
05/04/2021
- (iii) Name and address of the owner:
Dermapen IP Holdings, LLC, 1975 West Bay Dr. Suite 301, Largo, Florida 33770,
U.S.A.;
- (iv) Reproduction of the mark:



- (v) List of all or relevant classes:
10: Needles and multiple hypodermic needles for use in a vibrating method for performing skin treatment procedures; needles and hypodermic needles for use with skin devices; medical devices, namely, surgical devices that facilitate the identification, separation or ablation of biologic tissues; apparatus for the regeneration of stem cells for medical purposes; skin treatment devices using multiple needles in a vibrating method for performing skin treatment procedures.

- (i) Filing date and number, and, if any, priority date:
03/01/2013, **252243**
- (ii) Registration date and number (if available):
06/08/2014
- (iii) Name and address of the owner:
Dermagen LLC, PO BOX 34628, Seattle, WA 98124, U.S.A.;
- (iv) Reproduction of the mark:

DERMAGEN
- (v) List of all or relevant classes:
5: Creams, fillers and chemicals to be introduced below the dermal layer of the face; all included in class 5.
10: Skin treatment devices using multiple needles in a vibrating method for performing skin treatment procedures; needles for use with such devices; all included in class 10.
16: Training materials for use with skin treatment devices; all included in class 16

X. Information relating to the identical or similar trade mark application/s :

XI. Time limit for requesting review or appeal begins: 24/05/2021.
Time limit for requesting review or appeal end: 24/08/2021.

XII. Authority to which such request for review or appeal should be made:

Israeli Patent Office, Trademarks Department
1 Agudat Sport Hapoel St., Technological Garden, Building No. 5,
Jerusalem, 9695101, Israel
Phone: 972-73-3927290, Fax: 972-2-6467026
E-mail: trademarks@justice.gov.il

XIII. Indications concerning the appointment of a representative:

In order to file a request for review or appeal, you will need to appoint a representative domiciled in Israel.

XIV. Signature:



Rimona Ishaya, Trademarks examiner

XV. Corresponding essential provisions of the applicable law:

Definition	1.	In this Ordinance -“Trademark” – means a mark used, or intended to be used, by a person in relation to goods he manufactures or deals in;
Marks eligible for registration	8.	(a) No mark is eligible for registration as a trademark unless it is adapted to distinguish the goods of the proprietor of the mark from those of other persons (a mark so adapted being hereinafter referred to as a “distinctive mark”). (b) In determining whether a trademark is distinctive, the Registrar or the Court may, in the case of a trademark in actual use, take into consideration the extent to which such use has rendered such trademark in fact distinctive for goods in respect of which it is registered or intended to be registered.
Limitation to certain colors	9.	A trademark may be limited in whole or in part to one or more specified colors, and in such a case the fact that it is so limited shall be taken into consideration by the Registrar or Court having to decide as to the distinctive character of such trademark. If and so far as a trademark is registered without limitation of color, it shall be deemed to be registered for all colors.
The scope of registration	10.	(a) A trademark must be registered in respect of particular goods or classes of goods. (b) Any question as to the class within which any goods fall shall be determined by the Registrar, whose decision shall be final.
Marks ineligible for registration	11.	The following marks are not eligible for registration: (1) A mark referring to some connection with the President of the State or his household or to presidential patronage or a mark from which any such connection or patronage might be inferred; (2) Flags and emblems of the State or its institutions, flags and emblems of foreign states or international organizations, and any mark resembling any of these; (3) Public armorial bearings, official signs or seals used by any State to indicate control or warranty, and any sign resembling any of these and any sign from which it might be inferred that its proprietor enjoys the patronage of or supplies goods or renders services to a head of State or a Government, unless it is proved to the Registrar that the proprietor of the mark is entitled to use it; (4) Marks in which the following words appear – “patent”, “patented”, “by royal letters patent”, “registered”, “registered design”, “copyright”, “to counterfeit this is forgery” or words to like effect; (5) Marks which are or may be injurious to public policy or morality; (6) Marks likely to deceive the public, marks which contain false indications of origin and marks which encourage unfair trade competition; (6A) A mark containing a geographical marking in relation to goods that do not originate in the geographical area indicated, or a geographical marking that could be misleading in relation to the genuine geographical area of the origin of the goods; (6B) A mark containing a geographical marking that is verbally correct but contains a false representation to the effect that the goods originate in another geographical area;

		(7) Marks identical with or similar to emblems of exclusively religious significance;
		(8) A mark on which the representation of a person appears, unless the consent of such person has been obtained; in the case of the representation of a deceased person, the Registrar shall request the consent of his survivors unless, in his opinion, reasonable grounds exist for not doing so;
		(9) A mark identical with one belonging to a different proprietor, which is already on the register in respect of the same goods or description of goods, or so nearly resembling such a mark as to be calculated to deceive;
		(10) A mark consisting of numerals, letters or words which are in common use in trade, to distinguish or describe goods or classes of goods or which bear direct reference to their character and quality, unless the marks have a distinctive character within the meaning of Section 8(b) or 9;
		(11) A mark whose ordinary signification is geographical or a surname, unless represented in a special manner or unless having a distinctive character within the meaning of Section 8(b) or 9;
		(12) A mark that identifies wine or an alcoholic drink containing a geographical signification, if the origin of the wine or alcoholic drink is not in that same geographical area;
		(13) A mark that is identical to or resembles so as to deceive, a well known mark even if it is not a registered trademark, in relation to goods in respect of which the mark is well known or in respect of goods of the same description;
		(14) A mark that is identical to or resembles a well known trademark that is a registered trademark, and this even if it is in respect of goods that are not of the same description, if the mark whose registration is being requested could indicate a connection between the goods in respect of which the mark is required and the proprietor of the registered mark, and the proprietor of the mark is liable to be adversely affected as a result of the use of the requested mark.
Mark identical with name of other person	12.	The Registrar may refuse an application for registration of a trademark identical or resembling the name or business name of another person, or containing a name identical or resembling as aforesaid, if the mark is likely to deceive the public or to cause unfair competition.
Name or description of goods	13.	Where a mark also contains a name or description of any goods, the Registrar may refuse to register it in respect of other goods; but he may so register it if in actual use the mark varies according to the goods for which it is used, and the applicant adds a note to such effect on his application.
Registration of certification mark	14.	(a) The Registrar may register a certification mark if he is satisfied that the proprietor of the mark is competent to certify the characteristics to be designated by the mark. (b) A certification mark is capable of registration even if it lacks distinctiveness as required by Section 8(a). (c) A certification mark may only be transferred with the permission of the Registrar.
Registration of collective mark	15.	(a) The Registrar may register a collective mark if he is satisfied that it is intended for use by the members of the body of persons concerned and that such body has control over the use of the mark by its members. (b) For all purposes of this Ordinance, the use of a collective mark by a member of the body shall be deemed to be the use thereof by such body, whether or not the body itself uses or intends to use it. (c) A collective mark may only be transferred with the permission of the Registrar.
Registration of marks	16.	(a) Notwithstanding the provisions of Section 8-11, the Registrar shall not refuse to register a trademark that is registered as a trademark in its country of origin unless any of the following apply

registered abroad	—	Registration of the mark in Israel will infringe rights acquired in Israel by another person; The mark lacks any dimension that gives it a distinctive characteristic; a trade mark will not be disqualified for registration if it is distinct from the trademark registered in its country of origin in respect of details that do not alter its distinctive characteristic and do not adversely affect the identification of the registered mark in its country of origin. The mark consists exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity place of origin, intended purpose, time of production or value of the goods; The mark is customary in current language or bona fide and established trade practices in Israel; The mark is contrary to public policy or to normality; The mark is likely to deceive the public. (b) "Country of origin", in relation to a trademark whose registration is requested under this Section – means a Member State in which the Applicant has an effective or serious industrial or commercial establishment, and if he has no such establishment within the territory of such State – a Member State in which he is domiciled, and if he does not have a domicile within the territory of such State – the Member State of which he is a national. (c) Where the Registrar accepts for registration a mark which would not have been registered but for the provisions of subsection (a), such fact shall be indicated in the publication of the application and in the Register.
Application	17.	Any person claiming to be the proprietor of a trademark being used by or intended to be used by him and who wishes to register it, shall submit an application to that effect to the Registrar in the prescribed manner
Division of the application	17A.	(a) A person who has submitted an application as stated in Section 17(a) in respect of several classes of goods, may, as long as no trade mark in the subject matter of the application has been registered under Section 26, apply to the Registrar for a division of the application into separate applications, according to classes of the goods, in the prescribed manner (referred to in this section as – an application for division); the Registrar having decided on such a division, that date of each of the applications that have been so separated shall be the date on which the original application was submitted. (b) Where an application for division has been submitted, after publication of receipt of the original application under Section 23, any objection submitted under Section 24 to registration of the trademark that is the subject of the original application shall be deemed to have been submitted in respect of each of the separated applications in so far as the objection relates to it.
Powers of Registrar	18.	(a) Subject to the provisions of this ordinance the Registrar may refuse an application or accept it as it is or subject to conditions, amendments or modifications, or subject to such limitations as he deems it proper to impose as to mode or place of use or otherwise. (b) In relation to an application for registration of a trademark in respect of a number of classes of goods, the Registrar may require its division into several applications, and the date of submission of each of the applications so separated shall be the date of submission of the application that was divided.
	19.	Where the Registrar has refused an application his decision shall be subject to an appeal to the District Court, and the Registrar shall be the Respondent in such an appeal.
Requirement disclaimer	21.	(a) If a trademark contains matter common to the trade or otherwise of a non-distinctive character and it appears to the Registrar that the proprietor of the mark is not entitled to the exclusive use of

		such matter or part thereof, he may, in deciding whether such trademark shall be entered or shall remain on the Register, as a condition thereof require that the proprietor disclaim any right to the exclusive use of such matter or make other such disclaimer as he may deem necessary in order to define his rights under the registration. (b) A disclaimer under this Section shall not affect any rights of the proprietor of the trademark except such as arise out of the registration of the mark.
Objection	24.	(a) Any person may within three months, from the date of the advertisement file with the Registrar a notice of objection to registration of the trademark. (a1) The following are the grounds for objection to registration of a trademark: (1) There is due cause and by virtue thereof the Registrar is empowered under the provisions of this ordinance to refuse the application for registration; (2) The objector claims to be the proprietor of the mark. (b) The aforesaid notice shall be given in the prescribed manner and shall set out therein details of the grounds of the objection. (c) The Registrar shall send a copy of the notice to the applicant. (d) The applicant shall send to the Registrar, in the prescribed manner and within the prescribed time, a counterstatement to the objection, setting forth the grounds on which he relies for his application. (e) If the applicant does not send a counterstatement as aforesaid he shall be deemed to have abandoned his application. (f) If the applicant sends a counterstatement, the Registrar shall furnish a copy thereof to the person who has notice of objection and shall, after hearing the parties, if so required, consider the evidence and shall decide whether to allow the registration and if so on what conditions.
Rival claims to identical marks	29.	(a) Where separate applications are made by different persons to be registered as proprietors of identical trademarks or those that are similar so as to deceive, in respect of the same goods or description of goods, and the special application was submitted as the previous application was accepted, the Registrar may refrain from accepting any of the applications until their rights are determined by agreement between them approved by the Registrar, and in the absence of such agreement or approval the Registrar shall decide, for reasons that shall be recorded as to which application shall continue to be processed in accordance with this ordinance. (b) An appeal shall lie against the Registrar's decision under subsection (a), to a District Court within 30 days from the date of the Registrar's decision. (c) The appellant shall deliver to the Registrar notice of filing of an appeal under subsection (b) within 30 days of the date of its filing. (d) In an appeal under subsection (b) the Court shall if so required, hear the Registrar.
Restrictions on the registration of variety denominations	31.(a)	A denomination of a variety shall not be registered in the Register of Rights if - in respect of agricultural crops of the same species - an identical denomination or an identical or similar description under the Trade Marks Ordinance (New Version) 5732-1972 is still registered, and no denomination shall be registered under the said Ordinance in respect of aforesaid crops, if - at any time - an identical or similar denomination of a variety was registered in the Register of Rights.
Un-renewed trademark	34.	Where a trademark has been removed from the register for nonpayment of the fee for renewal, such trademark shall, never the less, for the purpose any application for registration for a period of one

Notice of refusal or of filing of objection	56F	year after such removal be deemed to be a registered trademark. (a) Within 18 months of the date on which an Israel-designated application was sent to the Registrar, he shall send notice of each of the following to the International Bureau, pursuant to the provisions of this chapter: (1) A decision that the trademark is not eligible for registration or 30 that an application can only be accepted on conditions, with amendments , modifications or limitations, under the provisions of Section 18; (2) Filing of objections to registration of the trademark, or the existence of a possibility of submitting objections as aforesaid even after the said period of 18 months.
Standards law 1953 prohibitions	13. (a)	Persons must not - (1)use the terms Standard, Standard and norm, or words close to them, in any of their declarations (hereafter: protected terms) to describe a specification or technical rules for which no Standard or Official Standard was proclaimed ; (2)use any of the protected terms as a name for their business or for the activities of their business, without a permit from the Minister of Industry and Trade; this provision shall not apply to a person who made aforesaid use before this Law came into effect . (3)describe any commodity - in writing, orally or in any other way whatsoever - in a manner liable to create the impression that a permit to mark it with a Standard mark or with a supervision mark was issued, unless he learned that such a permit actually was issued ; (4)mark a commodity in a manner liable to create the impression that it conforms to a Standard or to an Official Standard, otherwise than by marking it lawfully with a Standard mark ; (5) describe or mark any commodity in a manner liable to create the impression that the Institution supervises its production, if the Institution does not supervise its production
Restriction on the registration of merchandise marks	14	Notwithstanding the provisions of the Merchandise Marks Ordinance 1938, after a Standard mark or a supervision mark has been determined, no merchandise mark shall be registered that is similar to that Standard mark or supervision mark, or is liable to create the impression that its owner was given a permit to use that Standard mark or supervision mark; after this Law comes into effect, a merchandise mark that includes one of the protected terms shall be registered only by permit from the Minister of Industry and Trade.
Appellations of origin and geographical indications (protection) law, 5725-1965		The improper use of a registered appellation of origin is an infringement of the right to an appellation of origin even if the true origin of the goods is indicated beside the appellation of origin and even if the appellation appears in translation or accompanied by expressions such as "kind", "type", "class", "imitation" or the like.