

MADRID AGREEMENT AND PROTOCOL
PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

I.	Office making the notification: Ukrainian Intellectual Property Institute 1 Hlazunova str. Kyiv-42, 01601 Ukraine
II.	Number of the international registration: 1574744
III.	Name of the holder: Biosoft (Australia) Pty Ltd 14/13a Narabang Way, Belrose, NSW, 2085 (AU)
IV.	<input checked="" type="checkbox"/> Provisional refusal based on an <i>ex officio</i> examination <input type="checkbox"/> Provisional refusal based on an opposition <input type="checkbox"/> Provisional refusal based on both an <i>ex officio</i> examination and an opposition
V.	<input checked="" type="checkbox"/> Provisional refusal for all the goods and/or services <input type="checkbox"/> Provisional refusal for the following goods and/or services:
VI.	Grounds for refusal: According to the LAW OF UKRAINE "On Protection of Rights to Marks for Goods and Services" the sign shall not be registered as trademark because the sign is similar to such an extent that it may be confused, in particular, associated with trademark that was earlier registered in Ukraine in the name of another person for identical or similar goods.
VII.	Information relating to an earlier mark: International registration № 1513095 of 26.11.2019 on the name of Dermapen IP Holdings, LLC; 1975 West Bay Dr. Suite 301 Largo, Florida 33770 (US)
VIII.	Corresponding essential provisions of the applicable law (see text under XII): Article 6.3.1

IX. Information relating to subsequent procedure:

(i) Time limit for requesting review or appeal:

A response of the holder of the international registration shall be given within the period of three months from the date of sending such notification.

The term shall be prolonged but no more than by six months, in the event a relevant request is submitted and a fee for the submission of it is paid prior to the expiry of such term.

If, regardless of taking appropriate measures by the applicant, the term is missed but during six months from the time of expiry of such term a relevant request is submitted along with a response and a fee for its submission is paid, the rights of the applicant concerning the application shall be restored.

(ii) Authority to which such request for review, appeal or response should be made:

The State Enterprise "Ukrainian Intellectual Property Institute" (Ukrpatent)

(iii) Foreigners, stateless persons, foreign legal entities and other persons having the place of permanent residence or permanent location outside Ukraine shall exercise their rights in relations with the Ukrpatent through representatives on intellectual property matters (patent attorneys) registered under the regulations approved by the central executive body ensuring the state policy formation and implementation in the intellectual property sphere.

(iv) Indications concerning the appointment of a representative:

<https://ukrpatent.org/uk/articles/patent-attorneys>

X. Date of the notification of provisional refusal: 10.12.2021

XI. Signature or official seal of the Office making the notification:



Head of the Department of
International Trademark Registrations

Svitlana Muratova

XII. Corresponding essential provisions of the applicable law:

Section II
LEGAL PROTECTION OF TRADEMARKS

Article 5. Terms of Legal Protection Provision

1. The legal protection is provided to a trademark that is not contrary to public order and generally accepted principles of morality, requirements of the *Law of Ukraine On Condemnation of the Communist and National-Socialist (Nazi) Totalitarian Regimes in Ukraine and Prohibition of Propaganda of Their Symbols* and is not subject to grounds for refusal of legal protection defined by this Law.
2. Any sign or any combination of signs may be the subject of a trademark. Such signs may be, in particular, words, including personal names, letters, numerals, figurative elements, colors, the shape of products or their packaging, sounds, provided that such signs are suitable to distinguish the goods or services of one person from the goods or services of other persons, are appropriate for their reproduction in the Register in such a way as to enable clear and precise scope of the granted legal protection. The names or pseudonyms of persons who held administrative posts in the Communist Party (the position of a Secretary for the District Committee and above), in the highest agencies of the state power and administration of the USSR, the Ukrainian Soviet Socialist Republic (Ukrainian Socialist Soviet Republic), other union or autonomous Soviet republics (except the cases related to the development of the Ukrainian science and culture), who worked in the Soviet state security agencies, the names of the USSR, the Ukrainian Soviet Socialist Republic (Ukrainian Socialist Soviet Republic), other Soviet Union republics and their derivatives, names connected with the activities of the Communist Party, the establishment of the Soviet power in the territory of Ukraine or in the separate administrative and territorial units, persecution of the participants in the struggle for independence of Ukraine in the XX century cannot be the subject of a trademark. .

Article 6. Grounds for Refusal of Legal Protection

1. According to this Law, the legal protection shall not be granted for signs that represent or imitate:
 - state armorial bearings, flags and other state symbols (emblems);
 - full or abbreviated official names of states or international two-letter codes of states;
 - emblems and abbreviated or full names of international intergovernmental organizations;
 - official control, guarantee or testing seals, stamps;
 - decorations and other honorable distinctions.

The said signs may be included as non-protected elements of a trademark, provided that there is the consent of the relevant authorized body or the owners thereof. The authorized body for granting permission to use the official name and international two-letter code of the Ukrainian state in a trademark shall be a collegial body established by the NIPO.
2. According to this Law, the legal protection shall also not be provided for signs which:
 - are usually not distinctive in nature and have not obtained such a character through their use;
 - consist only of signs that are generally used in the modern language or in fair and constant trade practices on goods and services;
 - consist only of signs or data which are descriptive while using in terms of goods and services referred to in the application or due to them, show the type, quality, composition, quantity, properties, intended purpose, value of goods and services, geographical origin, the place and time of production or selling of goods or provision of services, or other specifications of goods or services;
 - may mislead the public with regard to the goods or services, namely, as to their nature, quality or geographical origin;
 - may mislead the public with regard to the person manufacturing the product or rendering the service;

- consist exclusively of signs that are commonly used symbols and terms;
- represent only the form imposed by the nature of a product itself or by the necessity to obtain a technical result, or by the form which gives substantial value to a product;
- reproduce the name of a plant variety registered or applied for registration in Ukraine or which has been granted legal protection in accordance with an international agreement of Ukraine before the date of filing an application for a trademark containing such a sign, and if the claimed sign concerns a plant variety of the same or related species;
- contain geographical indications (including for wines and spirits) registered or applied for registration in Ukraine, or which are granted legal protection in compliance with the relevant international agreement of Ukraine, prior to the date of filing an application for a trademark which contains such an indication, and if the priority has been claimed - prior to the date of priority for the same or related goods, if when using the sign applied for reputation of a geographical indication is used and/or the sign applied for misleads the public as to the special quality, characteristics and true origin of the product.

The signs referred to in paragraphs two, three, four, seven and eight of this clause may be included in a trademark as non-protected elements in the event that these signs are not dominative in the image of the trademark.

The signs referred to in paragraphs two, three, four, seven and eight of this clause may be granted legal protection in the event that they have acquired distinctive character as a result of their use prior to the date of application.

3. Signs shall not be registered as trademarks when as of the date of filing an application or, if the priority is claimed, as of the date of priority, they are identical or similar to such an extent that they may be confused, in particular, associated with:
 - trademarks that were earlier registered or filed for the registration in Ukraine in the name of another person for identical or similar goods and services;
 - trademarks of other persons if such trademarks are protected without registration in the territory of Ukraine on the basis of the international agreements of Ukraine, namely, the trademarks recognized as well-known in compliance with Article 6bis of the Paris Convention in terms of identical or similar goods and services;
 - trademarks of other persons, if such trademarks are protected without registration in the territory of Ukraine on the basis of the international agreements of Ukraine, namely, the trademarks recognized as well-known in compliance with Article 6bis of the Paris Convention in terms of non-related goods and services, if the use of a trademark by another person in regard to such non-related goods and services indicates the connection between them and the owner of a well-known trademark and may harm the interests of such owner;
 - trade names that are known in Ukraine and belong to other persons who have acquired the right to the said names before the date of filing the applications with the NIPO with respect to identical or similar goods and services;
 - conformity marks (certification marks) registered in accordance with the established procedure;
 - trademarks used by another person in a foreign state, if an application is filed on his own behalf by an agent or a representative of such person within the meaning of Article 6septies of the Paris Convention without such person's authorization and there are no proofs that justify such filing if there is an opposition by such person.
4. Signs shall not be registered as trademarks if they reproduce:
 - industrial designs the rights to which belong to other persons in Ukraine;
 - titles of scientific, literary and artistic works known in Ukraine or quotations and characters from the said works as well as the artistic works and their fragments without the consent of copyright holders or their successors in title;
 - surnames, first names, pseudonyms and their derivatives, portraits and facsimiles of persons known in Ukraine without their consent.
5. Signs that contradict the requirements of Article 5(2) of this Law and the Law of Ukraine On Condemnation of the Communist and National-Socialist (Nazi) Totalitarian Regimes in Ukraine and Prohibition of Propaganda of Their Symbols shall not be granted legal protection and shall

not be registered as trademarks.

6. Signs referred to in paragraphs two to five and seven of Article 6(3) and paragraph two of Article 6(4) may be registered as trademarks, if consent is given by a certificate holder of the earlier registered trademark or the holder of the other earlier acquired right and there is no possibility to mislead the consumers.

- (151) **26.11.2019**
- (180) 26.11.2029
- (270) English
- (571) The mark consists of a letter "M" in grey stylized in 3D format followed by the letter "D" stylized in a 3D format organized to form the logo "MDerma" in orange followed by the the wording "by Dermapen" in light blue color.

La marque se compose d'une lettre "M" stylisée en gris et en 3D suivie de la lettre "D" stylisée en 3D organisées pour former le logo "MDerma" en orange suivi de l'intitulé "by Dermapen" en bleu clair

- (591) The mark consists of a letter "M" in grey stylized in 3D format followed by the letter "D" stylized in a 3D format organized to form the logo "MDerma" in orange followed by the the wording "by Dermapen" in light blue color.

The color(s) grey, orange, light blue is/are claimed as a feature of the mark.

La marque se compose d'une lettre "M" stylisée en gris et en 3D suivie de la lettre "D" stylisée en 3D organisées pour former le logo "MDerma" en orange suivi de l'intitulé "by Dermapen" en bleu clair

Les couleurs grise, orange et bleu clair sont revendiquées en tant qu'éléments distinctifs de la marque

- (732) **Dermapen IP Holdings, LLC**
1975 West Bay Dr. Suite 301
Largo, Florida 33770; US
- (811) US
- (842) Limited Liability Company, Delaware

- (740) **Maria Johnson**
De Novo Legal, PC
2055 Corte Del Nogal
Carlsbad CA 92011; US

- (770) **Dermapen IP Holdings, LLC**
11 Baymont St. #1104
Clearwater FL 33767; US

- (821) US, 20.05.2019, 88438387

- (832) Ukraine is designated under the Madrid Protocol

- (511) **Cl.: 10**

- 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.

Aiguilles et aiguilles hypodermiques multiples utilisées dans une méthode vibrante pour la réalisation d'opérations de traitement de la peau; aiguilles et aiguilles hypodermiques destinées à des dispositifs pour la peau; dispositifs médicaux, à savoir dispositifs chirurgicaux facilitant l'identification, la séparation ou l'ablation de tissus biologiques; appareils pour la régénération de cellules souches à usage médical; dispositifs de traitements cutanés utilisant plusieurs aiguilles au moyen d'une méthode utilisant les vibrations pour la réalisation de procédés de traitement de la peau.

Registration

- (450) 2020/4 Gaz, 06.02.2020
- (832) BG - BH - BR - BY - CA - CN - CO - CU - EG - EM - IL - IN - IR - JP - KP - KR - MA - MX - PL - RU - SG - TH - TR - **UA** - VN
- (580) 06.02.2020

UA Ex Officio examination completed but opposition or observations by third parties still possible, under Rule 18bis(1)

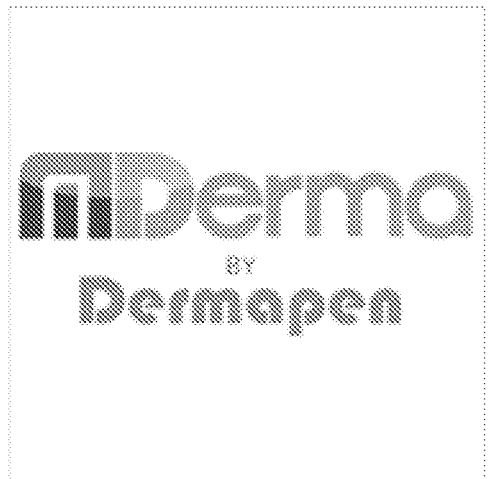
- (450) 2020/44 Gaz, 12.11.2020

Opposition end date:

23.01.2021

UA Statement of grant of protection made under Rule 18ter(1)

- (450) 2021/4 Gaz, 11.02.2021



27.05.00 27.05.10 29.01.00 29.01.13

