

MADRID PROTOCOL

PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

I.	Office making the notification: 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
II.	Number of the international registration: 1204161
III.	Name of the holder: Bio-tec Biologische Naturverpackungen GmbH & Co. KG
IV.	☒ Provisional refusal based on an <i>ex officio</i> examination ☐ Provisional refusal based on an opposition ☐ Provisional refusal based on both an <i>ex officio</i> examination and an opposition
V.	☐ Provisional refusal for all the classes ☒ Provisional refusal for some of the classes: Class 5: capsules (filled) for medical purposes (included in this class); pharmaceutical and veterinary products. Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services;

VI. The application does not conform to the requirements provided for under article 1 & 10(a) of the Israeli trademarks law (see text under XII), because of the following ground(s): (where applicable, see item VII/ VIII):

1. The proposed goods "capsules (filled) for medical purposes (included in this class); pharmaceutical and veterinary products" in **class 5** are too broad and should be narrowed and rephrased so that they will consist of items which are within the scope of the applicant's actual use or intention to use. The applicant must indicate the diseases or treatments for which the pharmaceuticals are used; the nature of the products as well as the material with which the capsules are filled.

According to article 1 & 10 (a)

2. The proposed goods/services "Scientific and technological services and research and design relating thereto; industrial analysis and research services" in **class 42** are too broad and should be narrowed and rephrased so that they will consist of items which are within the scope of the applicant's actual use or intention to use.

According to article 1 & 10 (a)

Please note if the applicant does not respond within the time limit, the goods/services that will be protected in classes 5&42 won't include the items indicated in this office action.

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

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

IX. Information relating to subsequent procedure:

- (i) Time limit for requesting review or appeal begins: 26/07/2015.
Time limit for requesting review or appeal end: 26/10/2015.
- (ii) 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: 972-2-5651627, Fax: 972-2-6467026
E-mail: trademarks@justice.gov.il

- (iii) 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.

X. Date of the notification of provisional refusal: 26/07/2015

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



Merav Baron, Trademarks examiner

XII. 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 registered abroad	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 – 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.
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.	
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 year after such removal be deemed to be a registered trademark.	
Circular of the	m.n. Dealing with the list of goods relating to pharmaceutical and medical preparations in class 5.	

Registrar	39	
Circular of the Registrar	m.n. 61	Dealing with the eligible for registration as a trade mark of three dimension marks.
Circular of the Deputy Registrar	I.A. 56	Dealing with changes and corrections of trademark applications.