

PROVISIONAL REFUSAL

according to rule 17(1) of the Common Regulations under the Madrid Agreement and Protocol

Refusal not based on opposition

“EX OFFICIO”

I. Office:

INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL
DIREÇÃO DE MARCAS E PATENTES
Campo das Cebolas
1149-035 – LISBOA PORTUGAL
Fax.: 21 886 98 59
Tel.: 21 881 81 00
Link: <http://www.inpi.pt/>
E-mail: atm@inpi.pt

II. International registration number: 1232192

Trademark elements: **ENIGMA BY SIBERIAN HEALTH**

III. Name and address of the holder: GOROKHOVSKAYA TATYANA GERMANOVNA
KRASNYI PROSPEKT, D. 49, KV. 58, RU-630091 NOVOSIBIRSK, RÚSSIA (FEDERAÇÃO DA)

IV. Grounds for refusal.

Relative grounds: reproduction or imitation of all or part of a trademark previously registered by another person for identical or similar products or services that may mislead or confuse the consumer or comprise the risk of association with the already registered trademark;

a) Corresponding essential provisions of the applicable law under X: Article 239 – 1 A), IPC.

V. Conflicting rights.

Application/registration number: CTM 010918662

Filing Date: 28/05/2012

Registration date (if available): 09/10/2012

Name and address of the owner: RDPR Limited

41 New England Street
New England Quarter
Brighton BN1 4GQ
REINO UNIDO

Trademark: ENIGMA

List of goods and/or services on which the conflict is based: Perfume; fine fragrance.(CLASS 03);
Perfumed candles; scented candles. (CLASS 04).

VI. Refusal for all the goods and/or services.

Adhesives for cosmetic purposes; after-shave lotions; almond milk for cosmetic purposes; aloe vera preparations for cosmetic purposes; amber [perfume]; antiperspirant soap; astringents for cosmetic purposes; balms other than for medical purposes; bath salts, not for medical purposes; beauty masks; breath freshening sprays; cakes of toilet soap; cleansing milk for toilet purposes; cosmetics; cosmetic creams; cosmetic dyes; cosmetic kits; cosmetic pencils; cosmetic preparations for baths; cosmetic preparations for eyelashes; cosmetic preparations for skin care; cosmetic preparations for slimming purposes; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; decorative transfers for cosmetic purposes; dentifrices; deodorants for human beings or for animals; deodorant soap; depilatory preparations; douching preparations for personal sanitary or deodorant purposes [toiletries]; eau de Cologne; eyebrow cosmetics; fumigation preparations [perfumes]; greases for cosmetic purposes; hair dyes; hair lotions; hair spray; hair waving preparations; joss sticks; lip glosses; lipsticks; lotions for cosmetic purposes; make-up; make-up preparations; make-up powder; make-up removing preparations; mascara; massage gels other than for medical purposes; medicated soap; mouth washes, not for medical purposes; nail care preparations; nail polish; neutralizers for permanent waving; oils for cosmetic purposes; oils for perfumes and scents; oils for toilet purposes; perfumes; perfumery; pomades for cosmetic purposes; potpourris [fragrances]; scented water; scented wood; shampoos; skin whitening creams; soap; sunscreen preparations; sun-tanning preparations [cosmetics]; tissues impregnated with cosmetic lotions; toiletries; toilet water. **CLASS 03.**

VII. Answer to the decision of refusal:

a) **Time limit to file an answer:** Within one (1) month following the date of the notification of provisional refusal sent by WIPO. Furthermore, this period can be extended once, for one (1) month, at the request of the interested party, online at <http://www.inpi.pt/>, by fax (+351 218 869 859), or by paper form.

b) **Authority to which the answer should be filed:**

INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL
DIREÇÃO DE MARCAS E PATENTES
Campo das Cebolas
1149-035 – LISBOA PORTUGAL
Fax.: 21 886 98 59
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E-mail: atm@inpi.pt

VIII. Date of the decision: 2015/07/14

IX. Date and signature: 2015.07.31 Ana Paula Pessoa



X. Corresponding essential provisions of the applicable law:

Industrial Property Code

(approved by Decree-Law 36/2003 of 5 March and amended by Decree-Law 318/2007 of 26 September, Decree-Law 360/2007 of 2 November, Decree-Law 143/2008 of 25 July and Law 16/2008 of 1 April)

Art. 222nd – Composition of trademark

- 1 – A trademark may consist of a sign or set of signs that can be represented graphically, namely words - including the names of persons - , drawings, letters, numbers and sounds, the form of the product or respective packaging, provided that they adequately distinguish the products and services of one company from those of others.
- 2 – A trademark may also consist of advertising phrases for the respective products or services, provided that they are distinct in character, regardless of the protection conferred upon them by copyright.

Art. 223rd – Exceptions

The conditions of [article 222nd] are not met by:

- a) - Trademarks that are devoid of any distinctive character;
- b) - Signs that exclusively consist of the form imposed by the nature of the product itself, the form of the product necessary for obtaining a technical result or the form that confers a substantial value on the product;
- c) - Signs that are exclusively made up of indications that may serve in commerce to designate the type, quality, quantity, purpose, value, geographic origin, period or means of production of the product or the service, or other characteristics thereof;
- d) - Trademarks that exclusively consist of signs or indications that have become common use in modern-day language or in the habitual and constant habits of commerce;
- e) - Colours, save where they are combined with each other or with graphics, wording or other particular and distinctive elements.

Art. 238th – Grounds for refusal of a registration

- 1 – [...] registration of a trademark is refused when:
 - a) - It consists of signs that cannot be represented graphically;
 - b) - It consists of signs devoid of any distinctive character;
 - c) - It consists exclusively of signs or indications referred to in Article 223(1) (b) to (e);
- [...]
- 4 – Registration of a trademark will also be refused if it contains in some or all of its constitutive elements:
 - a) - symbols, crests, emblems or distinctions of the state, municipalities or other Portuguese or foreign public or private bodies, the emblem and name of the Red Cross or other similar bodies and any signs covered by Article 6-ter of the Paris Convention for the Protection of Industrial Property;
 - b) - signs of a high symbolic value, such as religious symbols, unless these are authorised;
 - c) - expressions or figures that are contrary to the law, morals, public order and morality;
 - d) - signs that may mislead the public, namely as to the nature, properties, utility or geographic origin of the product or service for which the trademark is designed.
- 5 – Registration of a trademark that is made up exclusively of the national flag of the Portuguese Republic or some of its constitutive elements will also be refused.
- 6 – Registration will also be refused for a trademark that contains, amongst other elements, the national flag, wherever the trademark is likely to:
 - a) - mislead the public as to the geographic origin of the products or services for which it is designed;
 - b) - lead the consumer to erroneously think that the products or services come from an official body;
 - c) - generate disrespect or a diminution of prestige for the national flag or any of its elements.

Art. 239th – Other grounds for refusal

- 1 – Further grounds for refusal of registration of a trademark are:
 - a) - reproduction or imitation of all or part of a trademark previously registered by another person for identical or similar products or services that may mislead or confuse the consumer or comprise the risk of association with the already registered trademark;
 - b) - reproduction or imitation of all or part of a logotype already registered by another person to distinguish an entity whose activity is identical or similar to the products or services for which the trademark is designed, if it is likely to mislead or confuse the consumer;
 - c) - violation of other industrial property rights;
 - d) - the use of names, portraits or any other expressions or figurations without the authorisation of the persons they relate to or, if these are deceased, of their heirs or relatives to the fourth degree or, if authorisation is obtained, if it generates disrespect or diminution of prestige for those persons;
 - e) - recognition that the applicant's intent is one of unfair competition or that unfair competition is a possible outcome, regardless of the applicant's intention.
- 2 – When cited in an opposition, the following are also grounds for refusal:
 - a) - reproduction or imitation of a business or corporate name and other distinctive signs, or merely a characteristic part thereof, that do not belong to the applicant or where the applicant is not authorised to use them, if it is likely to mislead or confuse the consumer;
 - b) - violation of copyright;

[...]

The English version of the Industrial Property Code is available at: <http://www.inpi.pt/>