

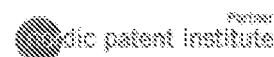
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Danish Ministry of Economic  
and Business Affairs



Our ref: MP1408132  
International Registration: 1408132  
Holder: Xiaomi Singapore Pte. Ltd.  
Mark: foto  
**Time limit:** 3 January 2019

3 September 2018

Dear Madam/Sir

**Notification of Partial Provisional Refusal of IR 1408132 according to Rule 17(2)**

The above-mentioned mark is provisionally refused protection in Denmark for some of the goods and services covered by the designation, namely:

- Class 09** Cases for smartphones; covers for smartphones; carriers adapted for mobile phones; cases adapted for mobile phones; cases for mobile phones; cell phone cases; cell phones; cellular phones; computer game software for use on mobile and cellular phones; conference phones; digital phones; door phones; downloadable graphics for mobile phones; flip covers for smart phones; holders adapted for mobile phones; leather cases for mobile phones; mobile phone cases; mobile phone covers; mobile phone sets; mobile phones; mobile phones for use in vehicles; monopods used to take photographs by positioning a smartphone or camera beyond the normal range of the arm; phone appliances; phone covers; protective cases for smartphones; protective covers for smartphones; protective films adapted for smartphones; smartphones; smartphones in the shape of a watch; smartwatches; watches that communicate data to smartphones; wrist-mounted smartphones; video phones.
- Class 35** Advertisement and publicity services by television, mail; advertisement for others on the Internet; advertising; advertising and promotional services; advertising and publicity services; advertising by mail order; advertising flyer distribution for others; advertising in periodicals, brochures and newspapers; advertising in the popular and professional press; advertising services; advertising through all public communication means; commercial information and advice for consumers [consumer advice shop]; commercial information; compilation of advertisements for use as web pages on the Internet; adver-

tisement via mobile phone networks; commercial information services provided by access to a computer database; on-line advertising on a computer network; online advertising via a computer communications network; online promotion on a computer network; advertising by transmission of on-line publicity for third parties through electronic communications networks.

#### **Class 38**

Advisory services relating to telecommunications; advisory services relating to communications equipment; cellular communications services; cellular telephone communication; communication by mobile telephone; communications by cellular phones; communications by means of mobile phones; communications by mobile phones; communications consultancy; communications via fibre-optic networks; consultancy services relating to telecommunications; data communication by electronic means; data communication services; electronic communication services; electronic network communications; mobile telephone communication; mobile telephone communication services; mobile telephone services; mobile telephony; operation of cellular communications systems; provision of communications information; provision of electronic communications facilities; provision of information relating to communications; car telephone communications services; communication between computers; communication by computer; communication by electronic computer terminals; communication of information by computer; communication services between computers; communication services over computer networks; communications by computer terminals; communications by telephone; computer aided transmission of images; computer aided transmission of information and images; computer aided transmission of messages; computer aided transmission of messages and images; computer communication services; computer communications for the transmission of information; computer data transmission services; computer intercommunication; computer network communication services; computer telephony services; computer transmission of information accessed via a code or a terminal; computer transmission services; computer-aided transmission of messages; electronic communication service by means of computer; electronic transmission of data and documents via computer terminals and electronic devices; forwarding of messages by telephone; providing access to computer networks; providing access to computer software; providing access to online computer databases; providing multiple use access to global computer information networks for the transfer and dissemination of a wide range of information; providing on-line forums for transmission of messages among computer users; providing telecommunications connections to a global computer network; providing user access to a global computer network; providing user access to computer programmes in data networks; providing user access to global computer network and online sites containing information on a wide range of topics; providing user access to global computer networks; provision of access to a global computer network; provision of communications between computers; provision of communications by telephone; secure telecommunications services [providing secure telecommunication connections and access including to computers and the global computer network]; telephone communication services; telephone communications; telephone services; transmission of data by computer; transmission of information by computer; transmission of information by telephone; transmission of information on a wide range of topics, including online and over a global computer network; transmission of information via computers connected to the same telematic network; transmission of messages by computer; transmission of messages by telephone; transmission of telephone calls; video telephone services; web portal services [providing user access to global computer network]; wireless telephone services.

#### **Class 42**

Design and development of software in the field of mobile applications; smartphone software design; advisory services relating to computer programming; advisory services relating to computer software; advisory services relating to computer system design; computer aided graphic design; computer engineering; computer graphics design

services; computer network design for others; computer network services; computer program advisory services; computer programming; computer programming consultancy; computer site design; computer software advisory services; computer software consultancy; computer software consulting; computer software design; computer software development; computer software programming services; computer software rental; computer software development; computer software programming services; computer software rental; computer system analysis; computer system design; computer system integration services; computer systems analysis; computer systems design; computer systems integration services; computer technology consultancy; computer website design; configuration of computer software; consultancy in the design and development of computer hardware; consultancy in the field of computer security; consultancy in the field of computer software; consultation services relating to computer software; conversion of computer programs and data, other than physical conversion; creating of computer programs; creating of home pages for computer networks; data conversion of computer programs and data, not physical conversion; design and development of computer software; design and development of computer software;; design and maintenance of computer sites for third parties; design and writing of computer software; design of computer codes;; design of computer programs; design of computer software; design, maintenance, development and updating of computer software; design, maintenance, rental and updating of computer software; designing computer software for controlling self-service terminals; developing computer software; development and creation of computer programmes for data processing; development of computer based networks; development of computer codes; development of computer programmes; development of computer software; development of computer software application solutions; development of computer system; digital compression of computer data; document data transfer from one computer format to another; duplication of computer programs; engineering services relating to computer programming; engineering services relating to computers; modifying of computer programs; providing information on computer technology and programming via a web site; providing information, including online, about design and development of computer software; provision of information relating to computer programming; provision of information relating to computer programs; rental and maintenance of computer software; rental of computer software; rental of computer software; rental of computer middleware; rental of computer programs; rental of computer software; rental of computer software and programs; renting computer software; research and development of computer software; research relating to computer programming;; research, development, design and upgrading of computer software; scientific computer programming services; services for maintenance of computer software; services for updating computer software; updating of computer software; updating of computer programs; updating of computer programs for third parties; updating of computer software; upgrading of computer software; writing and updating computer software; writing of computer programs; writing of computer software; development of computer programs recorded on data media (software) designed for use in construction and automated manufacturing (cad/cam); computer software design for others.

The reasons for the refusal are given in the enclosed examination report. The holder may request a review of the refusal before **3 January 2019**. Further information about procedures is found in the report.

Yours faithfully

Zebbie Elisabeth Oyier Gaya  
Legal Adviser, Trademarks/Design, Master of Law

## Examination Report

### Grounds for refusal

We have found that the mark is descriptive and thus lacks distinctive character, cf. the Danish Trade Marks Act, Sections 13(1) and 13(2)(1).

The mark consists of the Danish word FOTO (in English PHOTO), which refers to a photography or a picture.

Consequently, the trade mark may serve to designate the nature or characteristic of the above-mentioned goods in class 09. For the majority of the above-mentioned goods, the trade mark FOTO may indicate a nature of the goods, namely that they may consist of or contain a photo, e.g. personalized photo phone cases. For the remaining goods, the mark may indicate that the goods can take, display or edit photos.

Regarding the above-mentioned services in class 35, the trade mark FOTO may serve to designate the nature or characteristic, namely that the promotional, advertisement or communication services relate to promotion, advertising or communication through photos.

For a significant part of the above-mentioned services in Class 38, the trade mark FOTO may indicate a quality, namely transmission and other transfers of photos. The trade mark FOTO may also indicate a feature for some of the services, namely the subject of the internet pages or networks.

Regarding the above-mentioned services in Class 42, the trade mark FOTO may indicate that they involve design, development or manging of photo software as well as advice on the development of photo software.

Please be informed that the Danish Trade Marks Act Section 13(3) allows for the registration of marks, which have acquired distinctiveness through use.

### Request for review of the provisional refusal

You may request a review of the provisional refusal **within 4 months** from the date of issue of the provisional refusal.

Please observe that documents or evidence submitted by you will be available to the public according to the regulations of The Danish Access to Public Administration Files Act.

A request for review shall be send by post or e-mail to:

Address

Patent- og Varemærkestyrelsen  
Helgeshøj Allé 81  
DK-2630 Taastrup  
Denmark

E-mail

pvs@dkpto.dk

### Final refusal and appeal

If you do not reply within the time-limit mentioned above, we will issue a final refusal, which is subject to appeal to the Board of Appeal for Patents and Trademarks.

If you do not appeal our final decision, we will publish the mark for the remaining goods and services, namely:

- Class 09** Adapter plugs; cables, electric; cell phone straps; devices for hands-free use of mobile phones; downloadable ring tones for mobile phones; dustproof plugs for jacks of mobile phones; earbuds; ear phones; hands free devices for mobile-phones; hands free kits for phones; keyboards for mobile phones; keyboards for smartphones; mobile phone straps; phone extension jacks; phone extension leads; phone plugs; stands adapted for mobile phones; straps for mobile phones; wireless headsets for smartphones.
- Class 35** Advertisement and publicity services by radio; compilation and systemization of information into computer databases; compiling of information into computer databases; computer assisted business information.
- Class 38** Audio communications services; audiovisual communication services; mobile radio communications; mobile radio telephone services; provision of private mobile radio communication services; rental of communications apparatus; rental of smartphones; cellular radio telephone services; computer bulletin board services; maritime radio-telephone network services; netcasting [broadcasting over a global computer network]; paging services [radio, telephone or other means of electronic communication]; pay telephone communication services; radio telephone communication services; radio/telephone paging services; rental of access time to global computer networks; rental of cellular telephones; rental of computer communication apparatus and instruments; rental of telecommunication equipment including telephones and facsimile apparatus; rental of telephone apparatus; rental of telephone circuits; rental of telephone lines; rental of telephones; telephone paging services; telephone voice messaging services.
- Class 42** Design of mobile telephones; unlocking of mobile phones; updating of smartphone software; advice relating to the design of computer hardware; advisory services relating to computer system analysis; services relating to the design and development of computer hardware; analytical services relating to computers; back-up of computer data; computer aided design of molds; computer analysis; computer database design consultancy services; computer design; computer design services; computer disaster recovery services; computer firewall services; computer hardware design; computer hire; computer network configuration services;; computer program maintenance services; computer program updating services; computer programming in the medical field; computer programming of computer games; computer programming of video games; computer programming services for commercial analysis and reporting; computer rental; computer research services; computer security consultancy; computer security engineering; computer security services [design and development of secure computer hardware, software and systems]; computer security services [programming and software installation, repair and maintenance services]; computer security services [testing and risk assessment of computer networks]; computer security threat analysis for protecting data; computer services in the nature of hosting web sites for others; computer time-sharing; computer virus protection services; copying of computer software; debugging computer software for others; design and development of computer game software; design and development of computer hardware; design and development of computer hardware; design and development of computer hardware for the manufacturing industries; design and development of wireless computer networks; design of computer databases; design of computer hardware; design of computer languages; design of computers; design of computers for others; design of mobile telephones; design of telephones; developing computer programs for electronic cash register systems; development of computer hardware for computer games; diagnosis of faults in computer software; hosting computer sites [web sites]; installation and maintenance of computer software; installation of computer software; installation, maintenance and repair of computer software;

installation, maintenance and repair of software for computer systems; installation, repair and maintenance of computer software; installing computer programs; rental of computers in a café environment; leasing of computer apparatus; leasing of computer programs; leasing of computers; maintenance and updating of computer software; maintenance and upgrading of computer software; maintenance of computer programs; maintenance of computer programs; maintenance of computer software; maintenance of computer software relating to computer security and prevention of computer risks; maintenance of computer software used for operating filling apparatus and machines; monitoring of computer systems by remote access; monitoring of computer systems for detecting unauthorized access or data breach; monitoring of computer systems to detect breakdowns; personal computer hire; preparation of reports relating to computer programs; preparation of reports relating to computers; professional consultancy relating to computer security; providing information, including online, about design and development of computer hardware; rental of computer apparatus; rental of computer equipment; rental of computer firmware; rental of computer hardware; rental of computer hardware and computer peripherals; rental of computer hardware; rental of computer hardware; rental of computers; repair of computer software; repair of damaged computer programs; research relating to computers; security assessment services for computer networks; security risk assessment services relating to computer systems; services for renting computers; services for re-producing computer programs; technical advice relating to operation of computers; testing of computer installations; testing of computer programs; testing of computer software; testing of computers; updating of computer software relating to computer security and prevention of computer risks; updating of home pages for computer networks; updating of computer programs for memory banks of computer systems; recovery of computer data.

### **Further information**

Please see Appendices A and B for information on our search of **earlier rights** (relative grounds for refusal) and an abstract of the relevant sections of the Danish Trade Marks Act.

You are welcome to contact us if you have any questions.

Appendix A: Information about search results

Appendix B: Abstract of the Danish Trade Marks Act

## **Appendix A**

### **Information about search results**

We have conducted a search in the relevant Danish registers for earlier conflicting rights, such as trademarks, company names and personal names.

Please find the result of our search by following the link below:

<http://onlineweb.dkpto.dk/pvsonline/Varemaerke?action=104&xsagID=MP1408132&language=en>

Please note that the search result has not been examined for relative grounds. You can request an examination of relative grounds by contacting our Office.

Please be informed that there might be conflicting Community trademarks and/or trademarks under the Protocol relating to the Madrid Agreement of which we either had no knowledge at all or about which we had no information as to the extent of the trademarks at the time of our search. You should also be aware that other rights which are not included in our search, such as design rights, copyright or closely similar company names, may serve as relative grounds.

### **General information concerning the relative grounds for refusal**

Please note that the rights mentioned in the search report can act as possible grounds for refusal, only if the holders of the cited rights should file an opposition against the validity of the designation in Denmark.

Therefore you may choose to have the designation published in the Danish Trademark Gazette irrespective of the earlier rights. This allows a third party to file an opposition within a period of 2 months from the date of publication.

Should an opposition be filed against the designation, we will inform you accordingly and invite you to comment on the opposition before the Danish Patent and Trademark Office makes a decision. If no opposition is filed within the time limit, the designation will be granted full validity in Denmark.

If you wish to overcome the earlier rights before the designation is published, you can choose to:

Supply us with a letter of consent from the proprietors of the earlier rights, permitting you to make use of the trademark in Denmark and have the trademark published in the Danish Trademark Gazette

and/or

Limit the list of goods and services in order to avoid that the designation covers goods and services similar to those covered by the earlier rights. Please note that a limitation of the list of goods and services should be submitted to the International Bureau (Form MM6) according to Rule 25 of the Common Regulations.

The possibility of overcoming earlier rights through a written consent and/or a limitation of the list of goods and services is also at hand during an opposition procedure.

## **Appendix B**

### **Abstract of the Danish Trade Marks Act and Order on Application and Registration, etc. of Trade Marks and Collective Marks**

#### *Signs of which a trade mark may consist*

##### **Section 2**

(1) A Trade mark may consist of any sign capable of distinguishing the goods or services of one enterprise from those of other enterprises and capable of being represented graphically, in particular:

- (i) words and word combinations, including slogans, personal names, company names or names of real property;
- (ii) letters and numerals;
- (iii) pictures and designs; or
- (iv) the shape, equipment or packaging of the goods.

(2) A trade mark right shall not be acquired for signs which consist exclusively of a shape which is dictated by the goods themselves, a shape of goods which is necessary to obtain a technical result or a shape which gives substantial value to the goods.

#### *Registration of trade marks*

##### **Section 12**

(1) An application for the registration of a trade mark shall be filed with the Patent and Trademark Office. The application shall contain a reproduction of the trade mark and state the applicant's name or company. Furthermore, the goods or services for which registration of the trade mark is applied for shall be stated.

(2) The application shall be drawn up in accordance with the provisions laid down pursuant to section 48. The prescribed fee shall accompany the application.

(3) The Patent and Trade mark Office shall keep a register of trade marks. The Office shall publish registrations, etc.

#### *Processing of applications*

##### **Section 20**

(1) If the application does not comply with this Act or the provisions laid down pursuant to this Act, or if the Patent and Trademark Office has other objections to the acceptance of the application, the Patent and Trademark Office shall notify the applicant accordingly and invite him to file his observations within a specified time limit.

#### *Grounds for refusal*

##### **Section 13**

(1) For a trademark to be registered it shall be of the nature referred to in section 2, including a distinctive character.

(2) The following trademarks shall not be registered:

- (i) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering the services or other characteristics of the goods or services;



- (ii) trademarks which consist exclusively of signs or indications which are customarily used to designate the goods or services in the current language or in the established practices of the trade.
- (3) Irrespective of the provisions of sub-sections (1) and (2) a trademark may be registered if, before the filing of the application in consequence of the use which has been made thereof, it has acquired a distinctive character.

#### Section 14

Furthermore, the following shall not be registered:

- (i) trademarks which are contrary to law, public order or morality;
- (ii) trademarks which are liable to mislead the public, for instance as to the nature, quality or geographical origin of the goods or services;
- (iii) trademarks which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of industrial Property, and trademarks which include badges, emblems and escutcheons which are of public interest, unless the consent of the appropriate authority to their registration has been given;

### **Order on Application and Registration, etc. of Trade Marks and Collective Marks no. 364 of 21 May 2008**

#### *Section 2*

(1) The application shall indicate:

- (ii) the goods and/or services for which the registration of the mark is requested grouped in classes in compliance with the classification in the Nice Agreement of 1957 with subsequent amendments concerning international classification of goods and services for the purpose of registration of trademarks...