

Notification of Provisional Refusal based on an Ex Officio Examination (to WIPO)

Pursuant to Rule 17(2) of the Common Regulations under the Madrid Agreement concerning the international registration of marks and the Protocol relating to that Agreement.

I. National office that notifies the refusal of protection:
The Swedish Patent and Registration Office
Box 530, S-826 27 SÖDERHAMN, SWEDEN

Telephone: + 46 8 782 25 00
Telefax: + 46 270 173 51

II. International registration: No: 1408132, foto

III. Holder of the international registration:
Xiaomi Singapore Pte. Ltd.
60 Paya Lebar Road, #08-28 Paya Lebar Square
Singapore 409051
Singapore

IV. The scope of the refusal:
Provisional refusal for ALL goods and/or services

V.

Absolute grounds:

Trademark Act Chapter 5 Art 8:2, Chapter 1 Article 5 and Chapter 2 Article 5:

The trademark is considered to be devoid of any distinctive character in respect of the following goods/services:

Class 9: Adapter plugs; cables, electric; cases for smartphones; covers for smartphones; carriers adapted for mobile phones; cases adapted for mobile phones; cases for mobile phones; cell phone cases; cell phone straps; cell phones; cellular phones; computer game software for use on mobile and cellular phones; conference phones; devices for hands-free use of mobile phones; digital phones; door phones; downloadable graphics for mobile phones; downloadable ring tones for mobile phones; dustproof plugs for jacks of mobile phones; earbuds; ear phones; flip covers for smart phones; hands free devices for mobile-phones; hands free kits for phones; holders adapted for mobile phones; keyboards for mobile phones; keyboards for smartphones; leather cases for mobile phones; mobile phone cases; mobile phone covers; mobile phone sets; mobile phone straps; 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; phone extension jacks; phone extension leads; phone plugs; protective cases for smartphones; protective covers for smartphones; protective films adapted for smartphones; smartphones; smartphones in the shape of a watch; smartwatches; stands adapted for mobile phones; straps for mobile phones; watches that communicate data to smartphones; wireless headsets for smartphones; wrist-mounted smartphones; video phones.

Class 35: Advertisement and publicity services by television, radio, 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; advertisement via mobile phone networks; commercial information services provided by access to a computer database; compilation and systemization of information into computer databases; compiling of information into computer databases; computer assisted business information; 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; audio communications services; audiovisual communication services; 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 radio communications; mobile radio telephone services; 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; provision of private mobile radio communication services; rental of communications apparatus; rental of smartphones; car telephone communications services; cellular radio telephone 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 bulletin board services; 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; 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; 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; 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; secure telecommunications services [providing secure telecommunication connections and access including to computers and the global computer network]; telephone communication services; telephone communications; telephone paging services; telephone services; telephone voice messaging 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; design of mobile telephones; smartphone software design; unlocking of mobile phones; updating of smartphone software; advice relating to the design of computer hardware; advisory services relating to computer programming; advisory services relating to computer software; advisory services relating to computer system analysis; advisory services relating to computer system design; advisory 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 aided graphic design; computer analysis; computer database design consultancy services; computer design; computer design services; computer disaster recovery services; computer engineering; computer firewall services; computer graphics design services; computer hardware design; computer hire; computer network configuration services; computer network design for others; computer network services; computer program advisory services; computer program maintenance services; computer program updating services; computer programming; computer programming consultancy; 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 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 time-sharing; computer virus protection services; 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; copying of computer software; creating of computer programs; creating of home pages for computer networks; data conversion of computer programs and data, not physical conversion; debugging computer software for others; design and development of computer game software; design and development of computer hardware; design and development of computer hardware and software; design and development of computer hardware for the manufacturing industries; design and development of computer software; design and development of wireless computer networks; design and maintenance of computer sites for third parties; design and writing of computer

software; design of computer codes; design of computer databases; design of computer hardware; design of computer languages; design of computer programs; design of computer software; design of computers; design of computers for others; design of mobile telephones; design of telephones; 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 programs for electronic cash register systems; developing computer software; development and creation of computer programmes for data processing; development of computer based networks; development of computer codes; development of computer hardware for computer games; development of computer programmes; development of computer software; development of computer software application solutions; development of computer system; diagnosis of faults in computer software; 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; 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 programmes; 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; modifying of computer programs; 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 on computer technology and programming via a web site; providing information, including online, about design and development of computer hardware and software; provision of information relating to computer programming; provision of information relating to computer programs; remote computer backup services; rental and maintenance of computer software; 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 and computer software; rental of computer hardware and software; rental of computer middleware; rental of computer programs; rental of computer software; rental of computer software and programs; rental of computers; renting computer software; repair of computer software; repair of damaged computer programs; research and development of computer software; research relating to computer programming; research relating to computers; research, development, design and upgrading of computer software; scientific computer programming services; security assessment services for computer networks; security risk assessment services relating to computer systems; services for maintenance of computer software; services for renting computers; services for reproducing computer programs; services for updating computer software; 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; updating of computer programs; updating of computer programs for third parties; updating of computer software; 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; upgrading of computer software; writing and updating computer software; writing of computer programs; writing of computer software; recovery of computer data; development of computer programs recorded on data media (software) designed for use in construction and automated manufacturing (cad/cam); computer software design for others.

VI. You will find more information about the conflicting mark(s) (if any) enclosed under XII.
The relevant provisions of the Swedish Trademark Act are under XII.

VII. Date of provisional refusal: 12/12/2018
Response must be received within: 12/03/2019

VIII. Signature by the Office:
THE SWEDISH PATENT AND REGISTRATION OFFICE

Marta Hugosson

IX. If the holder does not contest the provisional refusal within 3 months, protection is given for:

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Rapid publishing of the limited list

If the holder wishes for rapid publishing of the designated trade mark – for the goods/services which are not subject to refusal – the holder may send an explicit request to PRV that the designation of Sweden is partially withdrawn for the goods/services which are subject to the provisional refusal. This request must be signed in original.

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X. Request for a review

The holder of the registration may request a review of the provisional refusal. The Swedish Patent and Registration Office must receive the request no later than 3 months from the date of this provisional refusal. Such request must provide an address for correspondence and be filed in Swedish, Danish, Norwegian or English. The Swedish Patent and Registration Office will respond in Swedish.

XI. Final decision

If this provisional refusal is not contested, or if any of the invoked grounds remain after a request for review, the Swedish Patent and Registration Office will issue a final decision in this matter.

Only applicable to partial refusals: once the final decision takes legal effect (no appeal is filed), the international registration designating Sweden will be published for protection with this above list of goods and services. If the final decision is appealed the case will be remitted to the Patent and Market Court.

Post grant opposition

Please note that to the extent the designation of Sweden is accepted, a post grant opposition may be filed against the mark within 3 months from the publication of the mark.

XII. The relevant provisions of the Swedish Trademarks Act regarding the grounds of this provisional refusal:
Trademark Act Chapter 5 Art 8:2, Chapter 1 Article 5 and Chapter 2 Article 5

Number of continuation sheets: 5

Chapter 1. Basic Provisions

Article 5. A trade symbol shall be considered to be distinctive if it is able to distinguish goods or services that are being made available in one business activity from those that are being made available in another one.

Lack of distinctiveness may be caused by the fact that a trade symbol consists only of signs or indications that

1. in the course of trade show the kind, quality, quantity, intended use, value, geographical origin or other characteristics, or the time of production, of the goods or services, or
2. in common language or according to established practice in trade have become a customary denomination for the goods or services.

In the determination of whether a symbol is distinctive, consideration shall be given to whether it can acquire distinctiveness through use.

Chapter 2. National Registration of Trademarks

Article 5. In order for a trademark to be registered, it must have distinctiveness in respect of the goods or services to which it relates.

Article 7. A trademark may not be registered if it

1. is contrary to law or other statutory provisions or to morality or public order,
2. is likely to deceive the public as regards the kind, quality, geographical origin or any other circumstance related to the goods or services,
3. contains, without permission, such a State or international emblem or such a municipal coat of arms that, by law or other statute, must not be used unwarrantedly as a trademark, or something that might be easily confused with such an emblem or such a coat of arms.

A trademark may, furthermore, not be registered if it contains or consists of something that is likely to be regarded as a geographical indication for wines or spirits and is related to wines or spirits of a different origin.

Article 8. A trademark may not be registered if it

1. is identical with an earlier trade symbol for goods or services of the same kind,
2. is identical with or is similar to an earlier trade symbol for goods or services of the same or similar kind, if there is, due to this fact, a risk of confusion, including the risk that the use of the trademark gives the impression that there is a link between the party using the trademark and the holder of the trade symbol,
3. is identical with or similar to an earlier trade symbol which is known in a considerable portion of those to whom it is addressed, and the use of the trademark would attract undue advantage of, or without legitimate reason cause damage to, the distinctiveness or reputation of the trade symbol, or
4. may easily be confused with a symbol that is used in this country or in a foreign country at the time of the application and is still in use, if the applicant was in bad faith at the time of the application.

As a trade symbol referred to in the first Paragraph, 1 to 3, is deemed

1. a trademark that is registered pursuant to this Chapter,
2. a trademark that is registered on the basis of an international trademark registration which is valid in Sweden pursuant to Chapter 5,
3. a trade symbol that is established on the market, if the protection based on the establishment on the market is valid within a considerable part of the country, and
4. a Community Trade Mark.

Article 9. The obstacles to registration referred to in Article 8, first Paragraph, 1- 3, apply *mutatis mutandis* also as regards

1. a registered trade name that is being used in commercial activities,
2. such a name or a business symbol other than one protected pursuant to Chapter 1, Article 8, if the protection applies within a considerable part of the country.

Article 10. A trademark may not be registered if it contains or consists of

1. something that is likely to convey the impression of being someone else's trade name,
2. something that is likely to convey the impression of being someone else's distinctive family name, generally known artistic name or similar name, if the use of the trademark would cause disadvantage for the holder of the name and if the name does not obviously relate to someone who is long deceased,
3. a picture of someone else that does not obviously relate to someone who is long deceased,
4. something that violates someone else's copyright in a literary or artistic work or someone else's right in a photographic picture or in a design.

Article 11. The provisions of Articles 8 to 10 do not constitute an obstacle to registration if the holder of the earlier right consents to the registration.

Chapter 5. International Trademark Registration

Article 8. If the Patent and Registration Office receives a notification from the International Bureau to the effect that someone has applied for an international trademark registration to be extended to Sweden, the Office shall examine whether there exists any obstacle to this.

An obstacle to the extension to Sweden of the international trademark application exists if there would have been an obstacle to a national registration of the trademark pursuant to Chapter 2, Articles 4 to 11.

If the Patent and Registration Office considers that an obstacle exists under the second Paragraph, the Office shall inform the International Bureau that the international trademark registration cannot, wholly or in part, be extended to Sweden. Such information shall be given within 18 months from the date of the notification and contain the grounds why the registration cannot be extended here.

Article 9. If the Patent and Registration Office has informed the International Bureau under Article 8, third Paragraph, the Office shall not earlier than three months after the information was transmitted decide that the international trademark registration shall not, wholly or in part, extend to Sweden if at that point in time an obstacle referred to in Chapter 2, Articles 4 to 11 still exists.

Article 10. If no obstacle referred to in Chapter 2, Articles 4 to 11 exists, the Patent and Trademark Office shall enter the trademark in the Trademark Register and publish a notice that the international trademark registration is valid in Sweden.

If the Patent and Trademark Office has decided that the international trademark registration shall partly not be valid in Sweden, the entry of the trademark in the Trademark Register and the publication of a notice shall concern only the remainder of the goods or services when the decision has taken legal force.

Article 15. After an opposition has been filed, the Patent and Registration Office shall decide that the international trademark registration shall, wholly or in part, not extend to Sweden if an obstacle referred to Chapter 2, Articles 4 to 11, exists to its extension here. If no such obstacle exists, the opposition shall be rejected. An opposition that is wholly or in part based on an obstacle referred to in Chapter 2, Articles 8 to 10, shall be rejected in those parts if it has been filed by someone who does not act in his own interest and the holder of the registration so requests.

A decision that the registration shall not extend to Sweden may be based only on a circumstance that has been communicated to the International Bureau within 18 months from the date of the notification under Article 8, first Paragraph. If the time for opposition has expired after that time limit, the decision may nevertheless be based on circumstances that have been communicated to the International Bureau within a month from the expiry of the time limit for opposition. This applies on condition that the Patent and Registration Office within the time limit of 18 months has informed the International Bureau that a notification about such a decision may be communicated later.

If, due to an opposition, the Patent and Registration Office, decides that the registration shall, wholly or in part, not extend to Sweden, the trademark shall to a corresponding extent be removed from the Trademark Register when the decision has taken legal force. A notice about the decision shall be published.

BILAGA

Registreringsnummer: 1408132
Registreringsdatum: 2017-12-26
Ansökningsnummer: 1408132
Ingivningsdatum: 2017-12-26

foto

Märkestyp: Figur

Text i märket: foto

Klassificering:

9: Adapter plugs; cables, electric; cases for smartphones; covers for smartphones; carriers adapted for mobile phones; cases adapted for mobile phones; cases for mobile phones; cell phone cases; cell phone straps; cell phones; cellular phones; computer game software for use on mobile and cellular phones; conference phones; devices for hands-free use of mobile phones; digital phones; door phones; downloadable graphics for mobile phones; downloadable ring tones for mobile phones; dustproof plugs for jacks of mobile phones; earbuds; ear phones; flip covers for smart phones; hands free devices for mobile-phones; hands free kits for phones; holders adapted for mobile phones; keyboards for mobile phones; keyboards for smartphones; leather cases for mobile phones; mobile phone cases; mobile phone covers; mobile phone sets; mobile phone straps; 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; phone extension jacks; phone extension leads; phone plugs; protective cases for smartphones; protective covers for smartphones; protective films adapted for smartphones; smartphones; smartphones in the shape of a watch; smartwatches; stands adapted for mobile phones; straps for mobile phones; watches that communicate data to smartphones; wireless headsets for smartphones; wrist-mounted smartphones; video phones.

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designing computer software for controlling self-service terminals; developing computer programs for electronic cash register systems; developing computer software; development and creation of computer programmes for data processing; development of computer based networks; development of computer codes; development of computer hardware for computer games; development of computer programmes; development of computer software; development of computer software application solutions; development of computer system; diagnosis of faults in computer software; 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; 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; modifying of computer programs; 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 on computer technology and programming via a web site; providing information, including online, about design and development of computer hardware and software; provision of information relating to computer programming; provision of information relating to computer programs; remote computer backup services; rental and maintenance of computer software; 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 and computer software; rental of computer hardware and software; rental of computer middleware; rental of computer programs; rental of computer software; rental of computer software and programs; rental of computers; renting computer software; repair of computer software; repair of damaged computer programs; research and development of computer software; research relating to computer programming; research relating to computers; research, development, design and upgrading of computer software; scientific computer programming services; security assessment services for computer networks; security risk assessment services relating to computer systems; services for maintenance of computer software; services for renting computers; services for reproducing computer programs; services for updating computer software; 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; updating of computer programs; updating of computer programs for third parties; updating of computer software; 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; upgrading of computer software; writing and updating computer software; writing of computer programs; writing of computer software; recovery of computer data; development of computer programs recorded on data media (software) designed for use in construction and automated manufacturing (cad/cam); computer software design for others.

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