

The International Bureau, WIPO
34, chemin des Colombettes
CH-1211 Geneva
Switzerland

Danish Patent
and Trademark Office

Helgesøvej 81
DK-2530 Hørsholm
(Postal address)

Fingertvej 3F
DK-7430 Ikast

Tel : +45 43 50 80 00
E-mail : pps@dkpto.dk
Web : www.dkpto.dk
CVR nr : 17 03 94 15

Ministry of Industry, Business
and Financial Affairs

 Partner
nordic patent institute

Our ref: MP1505998
Your Reference:
International Registration: 1505998
Holder: GAON S.r.l.
Mark: TOP NOTCH
Time limit: 18 June 2020

18 February 2020

Dear Madam/Sir

Notification of Total Provisional Refusal of IR 1505998 according to Rule 17(2)

The above-mentioned mark is provisionally refused protection in Denmark for all of the goods covered by the designation.

The reasons for the refusal are given in the enclosed examination report. The holder may request a review of the refusal before 18 June 2020. Further information about procedures is found in the report.

Yours faithfully

Jennifer Tran
Legal adviser, Master of Laws (LL.M.), Trademark and Design

Examination Report

Grounds for refusal

We have found that the mark is descriptive with respect to all of the goods in the designation, namely:

Class 03: Beauty care preparations; hand care preparations; nail varnish; make-up preparations for hands and nails; cosmetic preparations for drying nail varnish; false nails; nail varnish removers; nail-strengthening preparations; gel nail removers; cosmetics; hair and skin care preparations; make-up.

The mark consists of the words TOP NOTCH.

“Top-notch” is according to Oxford’s online dictionary, Lexico, defined as “*of the highest quality; excellent*”.¹ The mark TOP NOTCH is therefore descriptive as it serves to designate the quality of all the goods in the designation, namely that these goods are of the highest quality or excellent products.

Similarly, we have previously refused:

The logo for 'topgrass.dk' is displayed in a stylized, lowercase font. The letters are bold and have a slightly irregular, hand-drawn appearance. The '.dk' part is smaller and positioned to the right of 'topgrass'.

- VA 2018 00977 , refused for goods in class 27 as the mark will be understood and interpreted as a description of the goods, namely that these goods are grass of the highest quality.
- VA 2002 00356 PERFECT, refused for goods in class 2 as the mark serve to designate the quality of the goods, namely that these are perfect.

We refer to Section 13(1)(3) of the Danish Trademarks Act.

Please be informed that the Danish Trade Marks Act Section 13(2) 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 should be sent by post or e-mail to:

Address

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

E-mail

pvs@dkpto.dk

¹ <https://www.lexico.com/definition/top-notch>

Final refusal and appeal

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

Appendix A: Guide concerning Confusingly Similar Marks

Appendix B: Abstract of the Danish Trade Marks Act

Appendix A

Guide concerning Confusingly Similar Trademarks

The Danish Patent and Trademark Office has searched for marks applied for or registered in the Danish territory, which are confusingly similar to your trademark. We have assessed whether there is a likelihood of confusion between the marks, i.e. whether the marks are similar visually as well as phonetically and whether the goods and services covered by your application are identical with or similar to those covered by the earlier right. **We refer to the Danish Trade Marks Act, section 15, containing rules concerning identical and confusingly similar trademarks.**

If we have found conflicting marks we have included a search report as well as extracts of our register of any confusingly similar marks.

If we have found earlier rights you may consider the following options:

- to register your mark irrespective of the earlier right - or
- to limit the list of goods and services in order to avoid that your application covers goods and services similar to those covered by the earlier right - or
- to obtain a letter of consent from the proprietors of the earlier right permitting you to make use of and register your trademark in Denmark.

If we do not hear from you before the expiration of the time limit mentioned in our letter, we will register your trademark irrespective of the earlier rights, if any, mentioned in the search report.

Registration

Please be informed that the proprietor of the earlier right can file an opposition against the registration of your trademark if you choose to have your trademark registered irrespective of the earlier right.

Limitation

If the earlier right does not cover all the goods and services, for which your trademark is applied, you can limit your application in order to avoid that your application covers goods and services similar to those covered by the earlier right. You must file a new list of goods and services, if you wish to limit your application. Please be informed that we can assist you in connection with the wording of such a list.

Written consent

A written consent must be unconditional, and it must permit you to register the applied trademark for the goods and services covered by the application. If the consent does not include all goods and services applied for, you must limit your application in accordance with the consent. The letter of consent must be dated and duly signed by the proprietor of the earlier right. We can only accept a copy, if it is attested.

Appendix B

Abstract of the Danish Trade Marks Act

Signs of which a trade mark may consist

Section 2

A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- i) distinguishing the goods or services of one undertaking from those of other undertakings; and
- ii) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

Application and registration of trade marks

Section 11

- (1) An application for the registration of a trade mark shall be filed with the Patent and Trade mark Office. The application shall contain information in accordance with the provisions laid down pursuant to section 48. The application fee prescribed by section 60(a)(1) shall be paid.

Section 12

- (1) The goods and services in respect of which trade mark registration is applied for shall be classified in conformity with the Nice Classification. Where the applicant requests registration for more than one class, the applicant shall group the goods and services according to the classes of the Nice Classification, each group being preceded by the number of the class to which that group of goods or services belongs, and shall present them in the order of the classes.
- (2) The goods and services for which protection is sought shall be identified by the applicant with sufficient clarity and precision to enable the Office and economic operators, on that sole basis, to determine the extent of the protection sought.
- (3) The general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision set out in this provision.

Examination of applications

Section 16

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

Section 13

(1) The following shall not be registered:

- (i) Signs which cannot constitute a trade mark.
- (ii) Trade marks which are devoid of any distinctive character.
- (iii) 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, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services.
- (iv) Trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) A trade mark shall not be excluded from registration in accordance with paragraph 1(2)-(4), if, before the date of application for registration, following the use which has been made of it, it has acquired a distinctive character.

Section 14

Furthermore, the following shall not be registered:

- 1) signs which consist exclusively of:
 - a) the shape, or another characteristic, which results from the nature of the goods themselves,
 - b) the shape, or another characteristic, of goods which is necessary to obtain a technical result,
 - c) the shape, or another characteristic, which gives substantial value to the goods.
- 2) Trade marks which are contrary to law, public order or morality.
- 3) Trade marks which are liable to mislead the public, for instance as to the nature, quality or geographical origin of the goods or services.
- 4) Trade marks 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 trade marks which include badges, emblems and escutcheons which are of public interest, unless the consent of the appropriate authority to their registration has been given.
- 5) Trade marks which are excluded from registration pursuant to Union legislation or the national law of the Member State concerned, or to international agreements to which the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications.
- 6) Trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine.
- 7) Trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional specialities guaranteed.
- 8) Trade marks which consist of, or reproduce in their essential elements, an earlier plant variety denomination protected by plant variety sort rights and which are in respect of plant varieties of the same or closely related species.