



The International Bureau, WIPO
34, Chemin des Colombettes
1211 Geneva 20
Switzerland

Reykjavík, 28 August 2020
Reference: 202008-7579, 4.3

Notification of provisional refusal based on an opposition according to Article 5 and Rule 17(3)

I. Office making the notification:

The Icelandic Intellectual Property Office

II. Number of the international registration:

1482377

III. Name of the holder:

CHEN HAIHUI, NO. 9, AREA C, ZHENGJIA VILLAGE, ZEGUO TOWN, WENLING CITY, ZHEJIANG PROVINCE, China.

IV. Information on publication and opposition period:

The registration of the trademark was published in the IPO Gazette on 15 July 2020
The opposition period was 2 months from the date of publication, i.e.: 15 September 2020.
The opposition was filed on 27 August 2020.

V. ☒ Provisional refusal based on an opposition

Opponent: Aktieselskabet af 21. november 2001, Fredskovvej, 7330 Brande, Denmark.

Representative of the opponent: Árnason Faktor ehf., Guðríðarstíg 2-4, 113 Reykjavík, Iceland.

VI. ☒ Provisional refusal for all the goods and/or services

☐ Provisional refusal for some of the goods and/or services:

Class 14 *Jewelry charms; necklaces; jewelry; clocks; wristwatches; straps for wristwatches; watch chains; watch cases [parts of watches]; presentation boxes for watches; watch pocket (cover).*



VII. Grounds for the opposition:

The opposition is based on Articles 14(1)(6), 14(1)(8) and 4(1) of the Icelandic Trademark Act No. 45/1997 cf. Item XII with reference to registered trademarks of the proprietor cf. Item XI.

VIII. Information relating to subsequent procedure:

Time limit for requesting review:

3 months from the date of this notification, i.e. 28 November 2020.

Authority to which such request for review should be made:

The Icelandic Intellectual Property Office, cf. Item I.

Indications concerning the appointment of a representative:

According to Article 35(1) of the Icelandic Trademark Act No. 45/1997, a request for review must be filed via the intermediary of a representative residing in the European Economic Area, a member state of the European Free Trade Association (EFTA) or the Faroe Islands.

The Icelandic Intellectual Property Office communicates with applicants and proprietors of trademark registrations or their representatives in Icelandic according to Article 35(4). The office may accept documentation in foreign languages in exceptional circumstances.

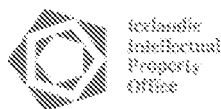
Information on appeal procedure:

A final decision of the Icelandic Intellectual Property Office may be appealed to the Board of Appeal by either party within 2 months from the date of the decision.

IX. Date of the notification of opposition:

27 August 2020.

X. Signature or official seal of the Office notifying the opposition:



XI. Extract from the Icelandic Trademark Register:

(111) Registration number: V0039081

(151) Date of registration: 4.1.2001

(210) Application number: 2902/2000

(220) Date of filing: 21.8.2000

(180) Registration valid to: 4.1.2021

(540) Trademark: **ONLY**

(730) Applicant/Owner: Aktieselskabet af 21. november 2001, Fredskovvej, 7330 Brande, Denmark.

(740) Agent: Sigurjónsson & Thor ehf., Lágmúla 7, 108 Reykjavík, Iceland.



(511) Classification of goods and services:

- Class 14** *Góðmálmar og blöndur úr þeim svo og vörur úr góðmálmum eða húðaðar með þeim og ekki heyra undir aðra flokka; skartgripir, gimsteinar; klukkur og tæki til tímamælinga.*
- Class 18** *Leður og leðurlíki og vörur gerðar úr þessum efnum og ekki eru taldar í öðrum flokkum; skinn og húðir; ferðakoffort og ferðatöskur; regnhlífar, sólhlífar og göngustafir; svipur, aktygi og reiðtygi.*
- Class 25** *Fatnaður, skófatnaður, höfuðfatnaður.*

XII. Corresponding essential provisions of the applicable law:

The following are the applicable provisions of the Icelandic Trademark Act No. 45/1997:

Article 4

Trade mark right prevents anyone other than the proprietor of the trade mark from using commercially a sign which is the same as or similar to his trade mark if:

1. it is used for the same or similar goods or services as are covered by the trade mark right and
2. there is a danger of confusion, including the conclusion that there is a connection between marks.

Despite the provisions of the first paragraph concerning the same or similar goods and services, the proprietor of a trade mark may also prohibit its use for other goods and services if the trade mark is well known in this country and the use would comprise misuse or lessen the distinctive nature of the characteristics or reputation of the known mark.

The mark may not be referred to in selling spare parts or accessories for a product without the consent of the proprietor, if this is done in such manner that it could be assumed that the accessories originated with the proprietor or that he had authorised the use of the mark.

Article 13

It is a condition for registration that a trade mark be suitable for distinguishing the goods and services of the proprietor from those of other parties. A mark which indicates exclusively, or with only minor alterations or additions, the type of product or service, condition, quantity, use, price, origin or when it was produced or the service provided, shall not be deemed to possess sufficiently distinctive characteristics. The same shall apply to a sign or word combination which is common in trade or is used in everyday speech.

In order to determine whether a mark has sufficiently distinctive characteristics all circumstances must be considered, in particular how long and to what extent the mark has been in use.

Article 14

A trade mark may not be registered:

1. if it contains, without authorisation, state emblems, official international symbols, emblems of Icelandic municipalities, official inspection or quality signs, specific names of these identifications of anything else likely to be confused with the abovementioned symbols and emblems; the prohibition shall include only official inspection and quality signs if registration of the mark is sought for the same or similar products as those for which the abovementioned signs and symbols are used;
2. if the mark is liable to cause confusion, for instance, as to the type of product, condition or origin.
3. if the mark is contrary to law or public order or likely to cause offence,
4. if the mark contains anything which may give cause to conclude that it is the name of an active commercial operation or the name or portrait of another person, providing this does not involve individuals long dead or if the mark includes a distinctive name of real property or an illustration of it,



5. if the mark contains anything which may cause it to be interpreted as the distinctive title of a protected literary or artistic work or if it infringes the copyright of another person to such work or other intellectual property right,
6. if the mark is liable to be confused with a trade mark which has been registered in this country or which has been in use here when the application for registration was filed and is still in use here,
7. if the mark is liable to be confused with a mark which may be considered to have been widely known in this country at the time the application for registration was filed,
8. if the mark is liable to be confused with a trade mark which has been internationally registered, provided that this registration was valid in this country before the application was filed, cf. Article 59,
9. if the mark is liable to be confused with a mark which has been in use in another country, at the time the application was filed or from the priority date, and is still in use there for the same or similar goods/services as the younger mark is to be registered for, and the applicant knew or should have known of the foreign mark.
10. if there already is a product name, protected under the Law on protection of product names referring to origin, geographical area or traditional specialties, for the same or similar products as the application for the registration of a mark applies and the application for the protection of the product name was filed before the application for the registration of said trademark.]

Notwithstanding the provisions of points 4-9, a mark may be registered if the consent of the trade mark proprietor or other rightsholder has been given.

A trade mark for wines and spirits which implies a geographical name for wine or spirits may not be registered unless the product originates at the location in question.

Article 19

If an application for the registration of a trade mark does not comply with legal provisions or if the Patent Office is of the opinion that other barriers should cause the rejection of the registration, the applicant shall be sent a reasoned statement of refusal and he shall be given the opportunity to express himself or emend the application within a specified time limit.

Upon the expiry of this period the Patent Office will re-examine its position towards the application.

Should the applicant fail to submit comments or emend the application within the specified time limit referred to in the first paragraph, the application shall be cancelled.

At the request of the applicant, an application shall be re-examined if the applicant, within two months of the expiration of the time limit referred to in the first paragraph, expresses himself concerning the case or emends the application, and provided the re-examination fee is paid.

Article 22

The registration of a trade mark may be opposed after its publication. Oppositions shall be filed in writing to the Patent Office within two months of the date of publication and include the grounds for opposition and the prescribed fee.

If oppositions are raised to the registration of a trade mark the Patent Office shall re-examine the registration in accordance with the provisions of Article 19. The proprietor of the registration shall be notified of the oppositions and given the opportunity to file his comments thereon.

If the Patent Office does not take the oppositions into consideration a formal ruling to this effect shall be made known to the opponent and the proprietor of the registration.

If the Patent Office does take the oppositions into consideration a formal ruling on the full or partial invalidation of the registration of the mark, shall be made known to the opponent and the proprietor of the registration.

The result of the ruling referred to in the third and fourth paragraphs shall be published in the Patent Gazette.

Article 35

The proprietor of a trade mark, who is not domiciled in this country, must have an agent residing in the European Economic Area, a member state of the European Free Trade Association (EFTA) or the Faroe Islands. The agent must be authorised by the proprietor of the mark to receive summons, as well as other notification concerning the mark, on his behalf with binding effect on the proprietor. The name and address of the agent shall be entered in the Register of Trade Marks.

Should no agent be appointed or should an agent resign from such representation, the proprietor of a mark is obliged to rectify this matter within a time limit decided by the Patent Office. If the address of the proprietor of a trade mark is unknown the notice of the time limit should be published in the Patent Gazette. Should no agent be



appointed in accordance with the above before the expiry of the time limit the mark shall be eradicated from the Register.

The legal venue in court cases filed in accordance with this Act, where the proprietor of a trade mark is not domiciled in this country, shall be in Reykjavík.

The Patent Office shall communicate with applicants and proprietors of trade mark registrations or their agents in Icelandic. In exceptional instances the Office may accept documentation in foreign languages.

Article 63

Decisions and rulings by the Patent Office in accordance with this Act may be referred to the Board of Appeal by the parties involved in the case within two months from the date the decision was taken. The appeal fee shall be paid within the same time limit. Should payment not be received with the time limit prescribed, the appeal shall be rejected as inadmissible.

A three-person committee, the Board of Appeal, appointed by the Minister shall issue a ruling in cases of dispute. The chairman of the committee, who shall be a lawyer with specialized knowledge of intellectual property rights, shall be appointed by the Minister for a three-year term at a time. The Minister shall appoint other members of the committee to issue rulings in individual cases of dispute.

Should the parties involved seek a ruling from a Court, they should initiate proceedings within three months of the date when the Patent Office or the Board of Appeal made its decision.

Copy: Árnason Faktor ehf., Guðríðarstíg 2-4, 113 Reykjavík, Iceland.