



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

Reykjavík, 9 December 2020  
Our reference: 201911-11638, 4.1  
Your reference: 788486

Notification on Provisional refusal of protection in Iceland according to Article 5 and Rule 17(1)

I. Office making the notification:

**The Icelandic Intellectual Property Office**

II. Number of the international registration:

788486

Name of the holder:

SGS Group Management SA, Place des Alpes 1,  
CH-1201 Genève, CH.

Representation of the mark:



III. Provisional refusal based on an *ex officio* examination:

- ☒ For all the goods and/or services  
☐ For some of the goods and/or services:

IV. Grounds for refusal:

- ☒ Absolute grounds: According to Article 12(3) of the Icelandic Trademark Act, No. 45/1997, the rules applying to the use of the collective-, guarantee- and certification marks shall accompany the application. The relevant rules are not accompanied with the application and therefore the application is provisionally refused.
- ☒ Relative grounds: Likelihood of confusion with an earlier registered mark (see item V).



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V. Information relating to an earlier registered mark (see item XI):

*International registration number:*

785924

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VI. Corresponding essential provisions of the applicable law (see item X):

Article 12(3), Article 14 (1) and Article 19 of the Icelandic Trademark Act No. 45/1997.

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VII. Information relating to subsequent procedure:

(i) *Time limit for requesting review:*

3 months from the date of this notification, i.e. **9 March 2021**.

(ii) *Authority to which such request for review should be made:*

The Icelandic Intellectual Property Office

(iii) *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.

If the abovementioned time limit expires, without a request for review being made to the Icelandic Intellectual Property Office, the International Registration shall be considered abandoned in Iceland, cf. Article 19(2) of the Icelandic Trademark Act, No. 45/1997 (see Item X).

(iv) *Possibility for re-examination and further notifications*

The international registration can be resumed, if the holder, within two months from the expiration of the time limit, responds to the provisional refusal, cf. Article 19, paragraph 3 and pays a fee according to the current tariff on fees for Patents, Trade Marks, Designs etc.

The holder will be notified about the final decision and informed of the possibility to appeal to the Board of Appeal for Industrial Intellectual Property Rights if no action is taken before the expiration of the time limit (see point i).

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VIII. Date of notification of the provisional refusal

**09 December 2020**

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IX. Signature of the Office making the notification:

Elfar Elí S. Jakobsson  
Trademark Examiner

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- X. Corresponding essential provisions of the applicable law:  
*Should there be a discrepancy between the English translation and the original text, the original text takes precedence.*

### **Article 12**

An application for the registration of a trademark must be filed in writing to the Icelandic Intellectual Property Office, which handles the registration of trademarks and maintains the Trademark Register. The application shall specify the mark in a clear and precise manner, including an illustration if appropriate, and for what goods or services registration is requested. It shall also give the name, address and other necessary contact information of the individual or enterprise applying and be accompanied by the prescribed fee. In addition, the application shall be in accordance with the provisions of a Regulation, cf. Article 65.

The date of filing shall be the date on which the applicant files the application along with the required information and/or documents in accordance with Paragraph 1.

An application for a collective mark and a guarantee and quality mark shall be accompanied with the rules applicable to the use of the mark, and they shall be published concomitantly with the registration. The rules shall for instance state the following:

1. Who is authorised to use the mark.
2. What conditions apply to the use of the mark and what consequences and disciplinary actions would result from unlawful use of the mark.
3. What rights and obligations the proprietor of the mark has vis-à-vis those using the mark.
4. What rules apply to membership in the society that owns the mark, if the relevant mark is a collective mark.

Parties that manufacture goods or provide services that originate from the same geographical area as the society that is applying for or owns a registered collective mark that indicates this origin shall be permitted to become members of the relevant society or organisation as long as they meet all other requirements of the rules that apply to the use of the mark.

### **Article 14**

A trademark shall not be registered unless a consent of a right holder in question has been obtained:

1. If the mark is liable to be confused with a trademark which has been registered or used in this country when the application for registration was filed and is still being used,
2. If the mark is liable to be confused with a mark which may, in this country, be considered to have been well known, within the meaning of Article 6bis of the Paris Convention for the protection of Industrial Property, at the time the application for registration was filed,
3. 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 was acting in bad faith,
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 deceased 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 an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action.

#### Article 19

If an application for the registration of a trade mark does not comply with legal provisions or if the 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 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.

In instances where the provisional refusal only applies to some of the goods and services sought for, the provisional refusal only applies to that part of the application.

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#### XI. Extract from the Trademark Register:

(111) Registration number: 785924  
(151) Date of registration: 21.6.2002  
(210) Application number: 2471/2002  
(220) Date of filing: 17.9.2002  
(180) Registration valid to: 21.6.2022  
(540) Mark:



(594) Word and Figurative Mark

(730) Name and address of applicant/holder: SGS Société Générale de Surveillance IP SA, Chemin des Avouillons 30, CH-1196 Gland, CH.

(740) Representative: N/A

(511) Classification of goods and services:

Flokkur 35: Price analysis, namely comparison and evaluation of prices of raw materials, goods, manufactured, semi-manufactured, processed and all other types of goods, placement of technical staff; commercial risk assessment and prevention.

Flokkur 36: Damage and loss assessment; financial appraisals and other real estate, equipment, project and industrial property appraisal services; foreign investment project assessment and monitoring; customs assistance, customs-code verification and determining of customs values before boarding.



Flokkur 39: Storage, warehousing, handling and transportation of goods; inspection of vehicles; inspection of containers.

Flokkur 41: Training in various fields, in particular in quality assurance.

Flokkur 42: Inspection, particularly control, supervision and certification of the quality and quantity of raw materials, goods, manufactured, semi-manufactured, processed and all other types of goods, as well as of their conformity to national and international norms, laws, rules, practices and standards and to the contractual requirements agreed upon by clients involved in importing and exporting said goods; control and certification of construction drafting, building and work and of industrial machinery and equipment maintenance and project monitoring; inspection, particularly control, supervision and certification of production or processing methods and of manufacturing processes for equipment, devices and apparatus as well as staff qualification including certification of product quality control procedures, control of measuring apparatus and measuring methods, of sampling and analysis; engineering for the purpose of modernizing sampling devices, equipment, systems, methods and technologies; certification of conformity to national and international norms, standards and other regulatory documents relating to products, services, personnel and management systems; design, namely industrial design regarding construction and use of calibration and sizing systems for dynamic flow measurement, tank calibration and automatic sampling; development of software for container warehousing, storing and handling; assistance to states by means of counseling or consultations with a view to implementing, restructuring and reorganizing their customs systems; laboratory testing, control and analysis of goods and materials; evaluation of the air, soil, water and waste matter, and general studies and counseling in view of their conformity to rules and regulations relating to the environment; pharmaceutical product evaluation; appraisal of damages or loss (engineers' services); production optimization studies.

Flokkur 44: Health services, and in particular medical laboratory analyses, sanitary services.

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