



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

Reykjavík, 15 June 2022
Our reference: 202102-1308, 4.1
Your reference: 1574744

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:

1574744

Name of the holder:

Biosoft (Australia) Pty Ltd, 14/13a Narabang
Way, Belrose, NSW, 2085, AU.

Representation of the mark:

Dermapen

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: The mark applied for is devoid of distinctive character and is incapable of distinguishing the goods of the holder from those of others. This is because the mark describes significant characteristics of the claimed goods. The mark consists of the term Dermapen. According to Oxford dictionaries, *derma-* means *skin* and *pen* is *an instrument for writing or drawing with ink*. It is unlikely that the average consumer will perceive the mark as a badge of origin as it merely describes the nature and purpose of said goods, namely that they consist of a device, resembling a pen, intended for skin treatments.
- ☐ Relative grounds:

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



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

Article 13 (par.1) (2), (3) and Article 19 of the Icelandic Trademark Act No. 45/1997.

VII. Information relating to subsequent procedure:

(i) *Time limit for requesting review:*

3 months from the date of this notification, i.e. **15 September 2022**

(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*

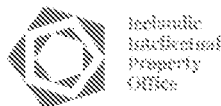
The international registration can be resumed, if the holder, within two months from the expiration of the time limit, responds to the provisional refusal, cf. Article 19, paragraph 3 and pays a fee according to the current tariff on fees for Patents, Trade Marks, Designs etc.

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).

VIII. Date of notification of the provisional refusal

15 June 2022

IX. Signature of the Office making the notification:



Elfar Elí S. Jakobsson
Trademark Examiner

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 13

The following signs or marks shall not be registered:

1. Signs which cannot constitute a trade mark, cf. Paragraph 1 of Article 2.
2. Trademarks which are devoid of any distinctive character for the goods or services applied for.
3. Trademarks which consist exclusively of signs or indications which may, in trade, solely or only with minor alterations or additions, serve to designate e.g. the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service.
4. Trademarks which consist exclusively of signs, phrases or indications which have become customary in the current language or in the bona fide and established practices of the trade.
5. Signs which consist exclusively of the shape or another characteristic, which results from the nature of the goods themselves, which is necessary to obtain a technical result of goods or gives substantial value to the goods.
6. Trademarks which are contrary to public policy or to accepted principles of morality or have a high symbolic value.
7. Trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service.
8. Trademarks which contain a product name, protected under the Act on protection of product names referring to origin, geographical area or traditional specialities, 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.
9. Trademarks without authorisation contain state emblems or other official symbols, flags, emblems of Icelandic municipalities, official inspection or quality signs or anything else which is likely to be confused with the aforementioned symbols and emblems; the prohibition shall only extend to official inspection and quality signs if registration of the mark is sought for the same or similar products as those for which the aforementioned signs and symbols are used.
10. Trademark for wines and spirits which implies a geographical name for wine or spirit may not be registered unless the product originates at the location in question.
11. Trademarks which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with the Act on protection of plant variety rights, and the mark in question concerns a plant variety of the same or of closely related species.
12. Collective mark where the regulations governing use of the mark are contrary to public policy or to accepted principles of morality or where the regulations governing the use of the said collective mark do not fulfil the conditions set forth in Article 12, paragraph 3.
13. Collective mark where the regulations governing the use of the mark prevent any producer from the geographical area concerned from using the mark.
14. Trademark which has been applied for in bad faith.

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 prior to the filing date.

Notwithstanding paragraph 1, point 3 a collective mark or guarantee or certification mark which indicates geographical origin of goods or services may be registered. Such registration does not entitle the proprietor to prohibit a third party from using said geographical origin or indication in the course of trade, provided that third party uses them in accordance with honest practices in industrial or commercial matters.



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.

XI. Extract from the Trademark Register:
