

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

Reykjavík 25. febrúar 2015

Our ref.: 4.1
Your ref.: 1222763.

Regarding: Notification of an ex officio provisional refusal of protection according to Article 5 and Rule 17(1).

1. Notifying office:

Icelandic Patent Office
Engjateigur 3, IS-150 Reykjavík, Iceland

Telephone: + (354) 580 9400
Telefax: + (354) 580 9401

2. International registration number: 1222763.

3. Mark:



4. Holder of the international registration: PayPal, Inc., 2065 Hamilton Avenue, San Jose
CA 95125, US.

5. Time limit to request a review: 26.06.2015 (see item 9).

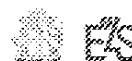
6. Grounds of provisional refusal:

The mark is confusingly similar to the following registration:

Icelandic registration number:

1282/2007

(See appendix I)



7. Applicable law to the grounds of provisional refusal:

Article 14.6 of the Icelandic Trademark Act No. 45/1997. (See appendix II).

8. Goods and/or services affected by the provisional refusal:

- ☒ Refusal for all goods/and or services (total provisional refusal)
- ☐ Refusal for the following goods/and or services (partial provisional refusal):

9. Request for review of the provisional refusal:

The holder of the right may request a review of the provisional refusal. The request must be filed in Icelandic through the intermediary of a representative residing in the European Economic Area, in a member state of the incorporation of the European Free Trade Association or in the Faroe Islands cf. Article 52(1) and 35 of the Icelandic Trademark Act. Please observe that the international registration is subject to full examination by the Icelandic Patent Office.

If the time limit expires, the international registration can be resumed if the holder, within two months from the expiration of the time limit responds to the provisional refusal and pays a fee according to Regulation no. 804/2014 on fees for Patents, Trade Marks, Designs etc.

10. Final refusal and appeal:

If the abovementioned time limits expire, without a request for review being made to the Icelandic Patent Office, the International Registration shall be considered abandoned in Iceland, cf. Article 19(2) (see appendix II) of the Icelandic Trademark Act, No. 45/1997. 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.

On the behalf of the Icelandic Patent Office,

Ingibjörg V Friðbjörnsdóttir

Attached: Appendix I: Extract from the Icelandic Trademark Register.
Appendix II: Article 14 and 19 of the Icelandic Trademark Act, No. 45/1997.

Extract from the Icelandic Trademark Register.

(111) Registration number: 1282/2007

(151) Date of registration: 30.11.2007

(210) Application number: 1240/2007

(220) Date of filing: 20.4.2007

(180) Registration valid to: 30.11.2017

(540) Trademark:

PayPal

(730) Applicant/Owner: PayPal, Inc., 2211 North First Street, San Jose, CA 95131, US.

(740) Agent: Kjartan Ragnars, hrl., Hrauntungu 66, 200 Kópavogi, IS.

(511) Classification of goods and services:

- 9 Búnaður og tæki notuð við vísindi, siglingar, landmælingar, ljósmyndun, kvikmyndatöku og -sýningar; sjóntæki, vogir, mælingatæki, merkjasendingatæki, eftirlitstæki, björgunartæki, kennslutæki og -búnaður; búnaður og tæki til að leiða, kveikja og slökkva á, breyta, safna, stilla eða stjórna rafmagni; tæki sem notuð eru til að taka upp eða flytja hljóð eða mynd; segulgagnaberar, gagnadiskar; sjálfsalar og vélbúnaður fyrir myntstýrð tæki; búðarkassar, reiknivélar, gagnavinnslubúnaður og tölvur; slökkvitæki; tölvuhugbúnaður fyrir úrvinnslu rafrænna greiðslna og til þess að millifæra greiðslur til og frá öðrum; staðfestingarhugbúnaður, sem hala má niður á alheimsnetkerfi og/eða skrá í tölvumiðil; segulkóðuð kreditkort og greiðslukort; þráðtengd og þráðlaus tölvuþáttatæki; músamottur; tölvuöryggistæki, þ.á m. auðkennis- eða öryggislyklar (óútreiknanlegar kóðareiknivélar) til þess að eiga aðgang að hýsigagnatölvu banka.
- 36 Tryggingastarfsemi; fjármálastarfsemi; gjaldmiðlaviðskipti; fasteignaviðskipti; fjármálaþjónusta, einkum sú, sem felur í sér að gera mögulega millifærslu greiðslna og kaup varnings og þjónustu, sem aðrir bjóða, með rafrænum samskiptanetkerfum; uppgjör og lúkning fjármálagerninga með rafrænum samskiptanetkerfum; útvegum fjölbreyttrar og margvíslegrar greiðslu- og fjármálaþjónustu, einkum kreditkortþjónustu, útgáfa greiðslukorta og lánsheimilda, vinnsla og útsending reikninga og greiðsla þeirra, greiðsluþjónusta, útvegum öruggra greiðsluafhendinga, og peningamarkaðssjóða; fjármálaþjónusta, þ.á m. útvegum verndar gegn fjársvikum og þjónusta í sambandi við forvörn og lausn ágreiningsmála.

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 above-mentioned 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 cause confusion 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.

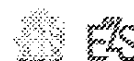
9. if the mark is liable to be confused with a mark which has been in use in another country, at the time the application was filed or from the priority date, and is still in use there for the same or similar goods/services as the younger mark is to be registered for, and the applicant knew or should have known of the foreign mark.

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