

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

Reykjavík, 27 April 2016

Our ref.: 201510-8679, 4.1.
Your ref.: 1269362

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

I. Office making the notification:

Icelandic Patent Office

II. Number of the international registration:

1269362

III. Name of the holder:

"VINPROM PESHTERA" S.A., 5 "Dunav" bul., BG-4000 Plovdiv, BG.

IV. ☒ Provisional refusal based on an *ex officio* examination:

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

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

VI. Grounds for refusal (see further item VII if Article 14):

☐ Absolute grounds:

☒ Relative grounds: Likelihood of confusion with an earlier registered mark.

VII. Information relating to an earlier mark (see Item XIII):

International registration number:
822288



VIII. Corresponding essential provisions of the applicable law (see Item XII):

Article 14(1)(6) of the Icelandic Trademark Act No. 45/1997.

IX. Information relating to subsequent procedure:

(i) *Time limit for requesting review or appeal:*

4 months from the date of this notification, i.e. **29 August 2016**

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

The Icelandic Patent 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 has to 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 Patent 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 Patent Office, the International Registration shall be considered abandoned in Iceland, cf. Article 19(2) of the Icelandic Trademark Act, No. 45/1997 (see Item XII). 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 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.

X. Date of the notification of provisional refusal:

27 April 2016

XI. Signature of the Office making the notification:

Ingibjörg V. Friðbjörnsdóttir
Trademark Examiner

XII. Corresponding essential provisions of the applicable law:

Articles 14 and 19 of the Icelandic Trademark Act, No. 45/1997.



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.
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 right holder 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 amends the application, and provided the re-examination fee is paid.

XIII. Extract from the Trademark Register:

(111) Registration number: 822288

(151) Date of registration: 16.3.2004

(210) Application number: 1508/2012

(220) Date of filing: 29.5.2012

(180) Registration valid to: 16.3.2024

(540) Trademark: SIXTH SENSE

(730) Applicant/Owner: EDNOLITCHNO DRUJESTVO S OGRANITCHENA OTGOVORNOST
"FINANSKONSULT", Altzeka str. 16, BG-4000 PLOVDIV, BG.

(300) Priority date: 23.10.2003, BG, 67467.

(511) Classification of goods and services:

33 Alcoholic beverages (except beers).