

## MADRID PROTOCOL

### Model Form 3A: Total Provisional Refusal of Protection (Rule 17(1) of the Common Regulations)

<p>I. Office making the notification:</p> <p>National Intellectual Property Centre of Georgia <b>SAKPATENTI</b> Address: 5, Antioch Str., 3300 Mtskheta <b>Georgia</b> Email: info@sakpatenti.org.ge www.sakpatenti.org.ge</p>
<p>II. Number of the international registration: <b>741975</b></p> <p>International Mark which is the subject of the statement:</p> <p style="text-align: center;"><b>ROSHEN</b></p>
<p>III. Name of the holder: <b>Dochirnie pidpriemstvo "Kondyterska korporatsiia "Roshen"; Elektrykiv vul., 26/9 Kyiv 04176, Ukraine</b></p>
<p>IV. Information concerning the type of provisional refusal:</p> <p><i>Please indicate the type of refusal by checking only one of the following options:</i></p> <p><input checked="" type="checkbox"/> Total provisional refusal based on an <i>ex officio</i> examination</p> <p><input type="checkbox"/> Total provisional refusal based on an opposition</p> <p><input type="checkbox"/> Total provisional refusal based on both an <i>ex officio</i> examination and an opposition</p> <p><i>Where the refusal is based on an opposition, please indicate the name and address of the opponent:</i></p> <p>(i) Name of the opponent:</p> <p>(ii) Address of the opponent:</p>

V. Information concerning the scope of the provisional refusal:

Total provisional refusal affects all the goods and/or services.

VI. Grounds for refusal [(where applicable, see item VII)]: The trademark is similar and liable to be confused with the national trademark "FERRERO ROCHER"+ design, "ФЕРРЕРО РОШЕР", "РОШЕР", registered 1996.10.09 (application date: 1993.07.28), registered 1998.11.25 (application date: 1998.01.29), registered 1998.11.27 (application date: 1998.01.29) under the number 3537, 11102, 11136, for the goods in classes 29, 30 and international trademarks "ROCHER", "FERRERO ROCHER", "ROCHER", registered 1998.02.16, 2003.01.28, 2012-12-21, under the numbers 688261, 799546, 1150368 for the goods in class 30.

VII. Information relating to an earlier mark:

(i) Filing date and number, and, if any, priority date: **1.** 1993-07-28, 1984-02-06. **2.** 1998-01-29. **3.** 1998-01-29.

(ii) Registration date and number (if available): **1.** 1996-10-09, N3537. **2.** 1998-11-25, N11102. **3.** 1998-11-27, N11136. **4.** IR688261, 1998-02-16. **5.** IR799546, 2003-01-28. **6.** IR1150368, 2012-12-21.

(iii) Name and address of the owner: **Dochirnie pidpriemstvo "Kondyterska korporatsiia "Roshen"; Elektrykiv vul., 26/9 Kyiv 04176, Ukraine**

(iv) Reproduction of the mark: **1.** FERRERO ROCHER. **2.** ФЕРРЕРО РОШЕР. **3.** РОШЕР. **4.** ROCHER. **5.** FERRERO ROCHER. **6.** ROCHER

(v) List of the relevant goods and/or services (this list may be in the language of the earlier application or registration): **1.** 30 - ყავა, ჩაი, შაქარი, ბრინჯი, ტაპიოკა, საგო, ყავის შემცვლელი; ფქვილი და ნაფქვავე (ფურაჟის გარდა); პური, ბისკვიტები, ნამცხვრები, ტკბილღვეულები და საკონდიტრო ნაწარმი, ნაყინი; თაფლი, ზაფხულის ვაჟინი; საფუარი, საცხობი ფხვნილები; მარილი, მდოგვი; სიცხარეები, ძმარი, საწებლები; სანელებლები; გამაგრებელი ყინული; კაკაოს პროდუქტები, კერძოდ, პასტები კაკაოს სასმელებისათვის, შოკოლადის პასტები, მინანქარი, სახელდობრ, შოკოლადის მინანქარი, შოკოლადი, დაშაქრული მოხარშული ნუში, შოკოლადის ნაწარმი საახალწლო ნაძვისხის მოსართავად, საკვები პროდუქტები შოკოლადის მინანქრის და ალკოჰოლური შიგთავსით, საშაქარლამო, საკონდიტრო ნაწარმი, კერძოდ, მკვრივი პასტები და მაღალხარისხოვანი საკონდიტრო ნაწარმი; საღებავი რეზინები, უშაქრო საღებავი რეზინები, უშაქრო კანფეტები.

**2.** 29 - ხორცი, თევზი, ფრინველი და ნანადირევი; დაკონსერვებული, გამომშრალი და თბურად დამუშავებული ბოსტნეული და ხილი, მურაბები, კომპოტები; კვერცხი, რძე და რძის პროდუქტები; ზეთი და საკვები ცხიმები;

**30** - ყავა, ჩაი, შაქარი, ბრინჯი, საგო, ყავის შემცვლელი; ფქვილი და მარცვლეულის პროდუქტები (ფურაჟის გარდა); პური, გალეტები, ნამცხვარი, ნაწარმი ფქვილისაგან და საკონდიტრო ნაწარმი, საკვები ყინული; თაფლი, ზაფხულის; საფუარი და საცხობი ფხვნილები; მარილი, მდოგვი; წიწაკა, ძმარი, საწებელი; სანელებლები; ყინული; კაკაო, კაკაოს პროდუქტები, სახელდობრ, კაკაოს პასტა; გარსი, სახელდობრ, შოკოლადისა, შოკოლადი, შოკოლადის კვერცხები, პრალინე, შოკოლადისაგან დამზადებული საშობაო ნაძვისხის მოსართავები, შოკოლადის გარსისაგან დამზადებული პროდუქტები ალკოჰოლური შიგთავსით; შაქრის ნაწარმი; საკონდიტრო ნაწარმი, მათ შორის, თხელი და მაგარი ცომეული; საღებავი რეზინი, უშაქრო საღებავი რეზინი, უშაქრო კანფეტები.

**3.** 29 - ხორცი, თევზი, ფრინველი და ნანადირევი; დაკონსერვებული, გამომშრალი და თბურად დამუშავებული ბოსტნეული და ხილი, მურაბები, კომპოტები; კვერცხი, რძე და რძის პროდუქტები; ზეთი და საკვები ცხიმები;

30 - ყავა, ჩაი, შაქარი, ბრინჯი, საგო, ყავის შემცვლელი; ფქვილი და მარცვლეულის პროდუქტები (ფურაჟის გარდა); პური, გაღებები, ნამცხვარი, ნაწარმი ფქვილისაგან და საკონდიტრო ნაწარმი, საკვები ყინული; თაფლი, ბადაგი; საფუარი და საცხობი ფხვნილები; მარილი, მდოგვი; წიწკა, ძმარი, საწებელი; სანელებლები; ყინული; კაკაო, კაკაოს პროდუქტები, სახელოდორ, კაკაოს პასტა; გარსი, სახელოდორ, შოკოლადისა, შოკოლადი, შოკოლადის კვერცხები, პრალინე, შოკოლადისაგან დამზადებული საშობაო ნამცხვრის მოსართავეები, შოკოლადის გარსისაგან დამზადებული პროდუქტები ალკოჰოლიანი შიგთავსით; შაქრის ნაწარმი; საკონდიტრო ნაწარმი, მათ შორის, თხელი და მაგარი ცომეული; საღებავი რეზინი, უმაქრო საღებავი რეზინი, უმაქრო კანფეტები.

4. 30 - Coffee, tea, sugar, rice, tapioca, sago, coffee substitutes; flour and milled cereal products (except for fodder); bread, biscuits, cakes, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; cooking salt, mustard; pepper, vinegar, sauces; spices; ice for refreshment, cocoa, cocoa products, namely paste for cocoa drinks, chocolate paste, toppings and, particularly, chocolate toppings, chocolate, pralines, chocolate articles for use as Christmas tree decorations, food products consisting of an edible chocolate casing filled with alcohol, sweet products, pastries, including fine and long-life pastries; chewing gum, sugar-free chewing gum, sugar-free sweets.

5. 30 - Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flours and milled cereal products (except for fodder); bread, biscuits, cakes, pastry and confectionery, edible ice; honey, treacle; yeast, baking powder; cooking salt, mustard; pepper, vinegar, sauces; spices; ice for refreshment, cocoa, cocoa products, namely paste for cocoa beverages, chocolate paste, toppings and, including, chocolate toppings, chocolate, pralines, chocolate articles for Christmas-tree decorations, food products consisting of an edible chocolate casing filled with an alcoholic liquid, sweet products, pastries, including fine pastry and longlife pastry; chewing-gum, sugarless chewing gum, sugarless candies.

6. 30 - Coffee, tea, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals (excluded forages); bread, biscuits, cakes, pastry and confectionery, edible ice-creams; honey, treacle; yeast and baking-powder; salt, mustard; pepper, vinegar, sauces; spices; ice; cocoa, cocoa-based products, specially paste for chocolate beverages, chocolate paste, chocolate, cocoa-based spread creams, pralines, chocolate products for Christmas trees decorations, products consisting of edible chocolate toppings with alcoholic stuff, sugar articles, pastry, namely fresh and long life pastry; chewing gum, chewing gum without sugar, candies without sugar.

VIII. Corresponding essential provisions of the applicable law: Article 5 (C).

IX. Information relating to the possibility to request a review or file an appeal:

(i) Time limit for requesting review or appeal:

**This statement can be appealed at Sakpatenti Chamber of Appeals no later than 3 months or Mtskheta Regional Court no later than 1 month from the date of its publication in the WIPO Gazette of International Marks.**

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

**This statement can be appealed at Sakpatenti Chamber of Appeals or Mtskheta Regional Court.**

(iii) Whether the request for review or appeal has to be filed in a specific language and/or through the intermediary of a representative whose address is within the territory of the Contracting Party:

**Be informed that proceedings in Georgia are carried out in the Georgian language.**

**The request may be filed through the representative with a registered address in Georgia or a patent attorney of Georgia.**

(iv) Other requirements, if any:

X. Signature or official seal of the Office making the notification:

Head of the Department

Irakli Kasradze

XI. Date of the notification to the International Bureau:

## **IX. Extract from the Trademark Law of Georgia**

### **Article 3. TRADEMARK**

1. A trademark is a sign or combination of signs that can be represented graphically and is capable of distinguishing the goods or services or both (hereinafter referred to as "goods") of one undertaking from those of other undertakings.
2. The sign may be a word or words, including proper names, letters, figures, sounds, a design or a three-dimensional figure, including the shape of goods or their wrapping and also other packaging, including colors or combination of colors.
3. The trademark is protected by registration at «Sakpatenti» or by virtue of international agreement.
4. Well-known trademarks in Georgia are protected without registration, under Article 6<sup>bis</sup> of the Paris Convention. The trademark is recognized as well-known by the Chamber of Appeals of «Sakpatenti» or by the court, in its competence, upon the request of an interested person.

### **Article 4. ABSOLUTE GROUNDS FOR REFUSAL OF REGISTRATION**

1. A sign, or combination of signs shall not be registered as a trademark where it:
  - (a) does not comply with the requirements of Article 3 (1) of this Law;
  - (b) represents a single non-stylized (standard) letter or figure, or a single colour taken separately;
  - (c) is not capable of distinguishing the relevant goods;
  - (d) is descriptive in respect of the goods for which its registration is requested, consists exclusively of the kind, quality, quantity, feature, value, intended purpose, geographical origin, place of sale, time or other characteristics of the goods or can be regarded as such;
  - (e) is widely used as a generic term for the particular type of goods;
  - (f) represents a widely established trade term or sign, characteristic of goods, for which registration is sought;
  - (g) insults or is contrary to national dignity, religious sentiment and traditions and moral standards;
  - (h) is likely to deceive the public (as to the feature, quality, geographical origin or other characteristics of the goods);
  - (i) completely or in any of its constituent elements coincides with the national emblems or the flags, emblem or full or abbreviated names of foreign states; the emblems of intergovernmental or other international organizations or their abbreviated or full names; official control, warranty and test hallmarks, signs (including certification marks of goods) seals, orders and medals; the official or historical names, emblems and State flags of the constituent parts of Georgia; the banknotes of Georgia or the imitation of the foregoing; such a sign may be included in a trademark, as a feature not qualifying for protection, if the permission of the Ministry of Culture or the holder has been obtained.
2. A three-dimensional sign shall not be registered as a trademark, where its shape:
  - (a) is established exclusively by the nature of the goods;
  - (b) is necessary for a technical result to be achieved.
3. The provisions of paragraph 1(c), (d), (e), (f), and (h) above shall not apply if, before a decision is taken on its registration, a trademark has become distinctive through use in the course of trade in relation to the goods specified in the application.

### **Article 5. RELATIVE GROUNDS FOR REFUSAL OF REGISTRATION**

- A trademark shall not be registered if it:
- (a) is identical to another trademark registered for the same goods;
  - (b) is identical to the trademark of a third party and the goods are so similar as to create a risk of confusion between the marks, including confusion based on association;
  - (c) is similar to the trademark of a third party and the goods are identical or so similar as to create a risk of confusion between the marks, including confusion based on association;
  - (d) is identical or similar to a trademark well known in Georgia, existing before filing the application, so that there is a risk of confusion with it, including confusion based on association; this rule shall apply even where the lists of goods are different;
  - (e) is identical or so similar to an appellation of origin or geographical indication protected in Georgia that there is a risk of confusion with it, including confusion based on association and the registration of trademark is requested for the identical or similar goods, or using such a trademark will result in using the reputation of the protected appellation of origin or geographical indication. This provision shall not apply if an appellation of origin or geographical indication is involved as a feature not qualifying for protection in the trademark of a person entitled to use it.
  - (f) is identical to an industrial design protected in Georgia except where registration of the trademark is sought by the holder of the exclusive rights in the industrial design;
  - (g) is identical or similar to registered trademark a third party enjoying good reputation in Georgia, and if the use of that trademark creates unfair advantages for its applicant or damages the reputation of the protected trademark; this rule shall apply where there are different lists of goods;
  - (h) includes names, pseudonyms, facsimiles, portraits of persons famous in Georgia without the consent of these persons or their legatees, and if they belong to the history and culture of Georgia without the permission of the Ministry of Culture, Monuments Protection and Sport of Georgia;
  - (i) includes the names of historical monuments of Georgia or of reproductions thereof without the permission of the Ministry of Culture, Monuments Protection and Sport of Georgia.