



STATE INTELLECTUAL PROPERTY OFFICE OF THE REPUBLIC OF CROATIA

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Zagreb, **29/11/2019**

Our reference: **910-08/19-010/0092**
559-04/2-19-002/IC

Provisional refusal of protection / Privremeno odbijanje

According to Rule 17.1) of the Common Regulations under the Madrid Agreement and Protocol / Sukladno pravilu 17.1) zajedničkog pravilnika Madridskog Sporazuma i Protokola

I. Number of the international registration / Broj međunarodne registracije: **1 455 136**

II. Name of the holder / Ime nositelja:

Barilla G. e R. Fratelli - Società per Azioni
Via Mantova, 166
Parma (PR)
IT

III. ☒ Provisional refusal based on **an ex officio examination** /
Privremeno odbijanje temeljem ispitivanja po službenoj dužnosti:

IV. ☒ Provisional refusal for **some** of the goods and/or services / Privremeno odbijanje **za neke** od proizvoda i/ili usluga:

Class 30 macaroni; pasta; ravioli; spaghetti; noodles; vermicelli [noodles]

Class 35 retail business services and online retail business services featuring the following goods: macaroni, pasta, ravioli, spaghetti, noodles, vermicelli [noodles]

Class 41 education; providing of training; academies [education]; practical training (demonstration); education information; correspondence courses; organising cookery courses; organising of competitions; organization of competitions [education or entertainment]; arranging and conducting of conferences; arranging and conducting of congresses; arranging and conducting of colloquiums; arranging and conducting of seminars; arranging and conducting of symposiums; arranging and conducting of workshops [training]; publication of books; publication of texts, other than publicity texts; publication of electronic books and journals on-line; electronic desktop publishing

Class 43 services for providing food and drink; cafeterias; canteens; restaurants; self-service restaurants; food and drink catering; snack-bars

V. Grounds for refusal / Razlozi odbijanja:

Verbalni znak "MASTERS OF PASTA" nerazlikovan je u odnosu na dio prijavljenih proizvoda i usluga iz razreda 30, 35, 41 i 43 Međunarodne klasifikacije proizvoda i usluga. Engleska riječ „master“ (hrv. gospodar, gazda, majstor, stručnjak, učitelj) označava osobu koja je iznimno vješta u određenoj aktivnosti, dok je „pasta“ na engleskom jeziku naziv za vrstu hrane napravljene od mješavine brašna, jaja i vode koja se formira u različite oblike i zatim kuha (hrv. tjestenina). Prosječni potrošač će ovaj znak doživjeti prvenstveno kao promotivnu poruku koja ga samo informira o tome da su prijavljeni proizvodi u vidu tjestenine i njezinih vrsta spravljeni od strane vrhunskih stručnjaka tog gastronomskog područja ili

da se radi o prodaji takvih proizvoda, tj. da usluge edukacije, tečaja te ponude hrane pružaju takvi eksperti specijalizirani za izradu tjestenine. Stoga, prosječni potrošač neće percipirati znak kao oznaku komercijalnog porijekla proizvoda i usluga te neće moći razlikovati proizvode i usluge jednog poduzetnika od proizvoda i usluga drugih poduzetnika.

Verbal mark "MASTERS OF PASTA" is devoid of any distinctive character in relation to part of the goods claimed in classes 30, 35, 41 and 43 of the International Classification of goods and services. The word „master“ refers to a person extremely skilled at particular activity while „pasta“ represents a type of food made from a mixture of flour, eggs, and water that is formed into different shapes and then boiled. The average consumer will perceive this sign primarily as a promotional message merely informing him that the claimed goods in the form of pasta and its variations are prepared by the top experts in the gastronomic area concerned, or that such products are sold, i. e. that the services of education, training and food providing are offered by such experts specialized in pasta making. Therefore, the average consumer will not perceive the mark as an indication of the commercial origin and will be unable to distinguish the goods and service of one undertaking from those of others.

- VI. Corresponding essential provisions of the applicable law [(see the text in column XI)] / Odgovarajuće bitne odredbe zakona koji se primjenjuje [(vidjeti tekst u rubrici XI)]:

Art. 9 para 1 item 2 / Članak 9. stavak 1. toč. 2.

- VII. Information relating to subsequent procedure / Podaci koji se odnose na tijek postupka:

i) Time limit for filing observations on the provisional refusal / Rok za podnošenje očitovanja na preliminarno odbijanje:

4 months counting from the date of the present notification of provisional refusal, namely until **29/03/2020**.

If the holder fails to submit his observations in the prescribed time limit, the Office shall decide upon refusing the protection, as the case may be, for all or part of the goods or services /

4 mjeseca računajući od datuma ove obavijesti o preliminarnom odbijanju, odnosno do **29/03/2020**. Ako se nositelj međunarodne registracije ne očituje u propisanom roku, Zavod će donijeti rješenje o odbijanju zaštite, ovisno o slučaju, za sve ili za dio proizvoda ili usluga

ii) Authority to which observations on the provisional refusal shall be filed / Nadležno državno tijelo kojem se podnosi očitovanje na preliminarno odbijanje:

STATE INTELLECTUAL PROPERTY OFFICE OF THE REPUBLIC OF CROATIA / Državni zavod za intelektualno vlasništvo Republike Hrvatske

iii) Indications concerning the appointment of a representative / Navodi u svezi imenovanja zastupnika:

The holder of an international trademark registration may file observations on the present provisional refusal and on the grounds for refusal only by the intermediary of a representative established in the Republic of Croatia / Nositelj međunarodne registracije žiga može se očitovati na ovo preliminarno odbijanje i očitovati se na razloge odbijanja isključivo uz posredovanje domaćeg zastupnika

Trademark Department
Service for Examination of Trademarks

Signature of the Examiner

Ivana Combaj

XI. Corresponding essential provisions of the applicable law:

Absolute grounds for refusal – Article 9 of the Trademarks Act (OG No. 14/2019)

(1) The following shall not be registered :

1. signs which do not conform to the requirements of Article 6 of this Act;
2. trademarks which are devoid of any distinctive character;
3. trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or to designate other characteristics of the goods or services;
4. trademarks which consist exclusively of signs or indications which have become customary in the everyday language or in good faith and the established practices of the trade;
5. signs which consist exclusively of: (a) the shape, or another characteristic, which results from the nature of the goods themselves; (b) the shape, or another characteristic, of goods which is necessary to obtain a technical result; (c) the shape, or another characteristic, which gives substantial value to the goods;
6. trademarks which are contrary to public policy or to accepted principles of morality;
7. trademarks 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 services;
8. trademarks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention;
9. trademarks which are not covered by Article 6ter of the Paris Convention, and which include the name or abbreviation of the name, national coat of arms, emblem, flag or other official sign of the Republic of Croatia, or a part thereof, and the imitation thereof, except with the consent of the competent authority of the Republic of Croatia;
10. trademarks which are excluded from registration, pursuant to Union legislation or national law of the Republic of Croatia or to international agreements to which the Union or the Republic of Croatia is a party, providing for protection of designations of origin and geographical indications;
11. trademarks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is a party, providing for protection of traditional terms for wine;
12. trademarks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is a party, providing for protection of traditional specialities guaranteed;
13. trademarks which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or national law of the Republic of Croatia, or international agreements to which the Union or the Republic of Croatia is a party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species;
14. trademarks which can be banned from using in public interest in accordance with the provisions of other legal regulations having effect in the Republic of Croatia.

(2) Grounds from paragraph (1) points 2, 3 and 4 of this Article shall not apply if the trademark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it, before the date of filing of the application for the registration.

Designation and classification of goods and services - Article 35

- (1) Goods and services in relation to which an application for registration of a trademark is filed shall be classified in conformity with the system of the Nice Classification.
- (2) The goods and services for which the protection of the trademark is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought.
- (3) For the purposes of paragraph (2) of this Article, the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision set out in this Article.
- (4) The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term.
- (5) Goods and services that are not clearly covered by the literal meaning of general terms or indications of the class headings of the Nice Classification shall not be regarded as included in the application for trademark registration or, as the case may be, in the registered trademark.
- (6) Where the applicant requests registration for more than one class, the applicant shall group the goods and services according to the classes of the Nice Classification, each group being preceded by the number of the class to which that group of goods or services belongs, and shall present them in the order of the classes.
- (7) Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification. Goods and services shall not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

Apsolutni razlozi za odbijanje – Članak 9. Zakona o žigu ("Narodne novine", 14/2019)

(1) Neće se registrirati:

1. znakovi koji ne udovoljavaju uvjetima iz članka 6. ovoga Zakona;
2. žigovi koji nemaju nikakav razlikovni karakter;
3. žigovi koji se sastoje isključivo od oznaka ili podataka koji u trgovini mogu služiti za označavanje vrste, kakvoće, količine, namjene, vrijednosti, zemljopisnoga podrijetla ili vremena proizvodnje proizvoda ili pružanja usluge, ili za označavanje drugih karakteristika proizvoda i usluga;
4. žigovi koji se sastoje isključivo od oznaka ili podataka koji su postali uobičajeni u svakodnevnom govoru ili u dobroj vjeri i ustaljenoj trgovačkoj praksi;
5. znakovi koji se sastoje isključivo od: (a) oblika, ili drugog obilježja, koji proizlazi iz vrste samih proizvoda, (b) oblika, ili drugog obilježja, proizvoda potrebnoga za postizanje nekoga tehničkog rezultata, (c) oblika, ili drugog obilježja, koji proizvodima daje bitnu vrijednost;
6. žigovi koji su protivni javnom poretku ili prihvaćenim moralnim načelima;
7. žigovi koji su takve naravi da javnost mogu dovesti u zabludu, primjerice u odnosu na vrstu, kakvoću ili zemljopisno podrijetlo proizvoda ili usluga;
8. žigovi koji nemaju odobrenje nadležnih tijela i koji moraju biti odbijeni prema članku 6.ter. Pariške konvencije
9. znakovi koji nisu obuhvaćeni člankom 6.ter. Pariške konvencije, a sadržavaju naziv ili kraticu, državni grb, amblem, zastavu ili drugi službeni znak Republike Hrvatske ili nekoga njezina dijela te njihovo oponašanje, osim uz odobrenje nadležnoga tijela Republike Hrvatske;
10. žigovi koji su isključeni iz registracije na temelju zakonodavstva Europske unije ili pravnih propisa Republike Hrvatske ili međunarodnih sporazuma kojih je Europska unija ili Republika Hrvatska stranka, kojima se osigurava zaštita oznaka izvornosti i oznaka zemljopisnog podrijetla;
11. žigovi koji su isključeni iz registracije u skladu sa zakonodavstvom Europske unije ili međunarodnim sporazumima kojih je Europska unija stranka, kojima se osigurava zaštita tradicionalnih izraza za vina;
12. žigovi koji su isključeni iz registracije u skladu sa zakonodavstvom Europske unije ili međunarodnim sporazumima kojih je Europska unija stranka, kojima se osigurava zaštita zajamčeno tradicionalnih specijaliteta;
13. žigovi koji se sastoje od ranije denominacije biljne sorte, ili je reproduciraju u svojim bitnim elementima, koja je registrirana u skladu sa zakonodavstvom Europske unije ili pravnim propisima Republike Hrvatske ili međunarodnim sporazumima kojih je Europska unija ili Republika Hrvatska stranka, koji pružaju zaštitu prava na biljnu sortu i koji se odnose na biljne sorte iste ili blisko srodne vrste;
14. žigovi čija uporaba može biti zabranjena u javnom interesu u skladu s odredbama drugih pravnih propisa koji imaju učinak u Republici Hrvatskoj.

(2) Razlozi iz stavka 1. točaka 2., 3. i 4. ovoga članka ne primjenjuju se ako je, prije datuma prijave za registraciju, žig slijedom njegove uporabe stekao razlikovni karakter u odnosu na proizvode ili usluge za koje je zatražena registracija.

Označivanje i klasifikacija proizvoda i usluga - članak 35. Zakona o žigu

(1) Proizvodi i usluge iz prijave za registraciju žiga razvrstavaju se u razrede u skladu sa sustavom Nicanske klasifikacije.

(2) Podnositelj prijave mora dovoljno jasno i precizno identificirati proizvode i usluge za koje se traži zaštita žiga kako bi nadležna tijela i gospodarski subjekti isključivo na temelju prijave mogli odrediti opseg zaštite koja se traži.

(3) Za potrebe stavka 2. ovoga članka mogu se upotrebljavati opće oznake uključene u naslove razreda iz Nicanske klasifikacije ili drugi opći izrazi, pod uvjetom da zadovoljavaju potrebne standarde jasnoće i preciznosti utvrđene u ovom članku.

(4) Uporaba općih izraza, uključujući opće oznake naslova razreda Nicanske klasifikacije, tumači se tako da uključuje sve proizvode i usluge koji su jasno obuhvaćeni doslovnim značenjem oznake ili izraza.

(5) Proizvodi i usluge koji nisu jasno obuhvaćeni doslovnim značenjem općeg izraza ili općom oznakom naslova razreda Nicanske klasifikacije ne smatraju se obuhvaćenim prijavom za registraciju žiga ili, ovisno o slučaju, registriranim žigom.

(6) Ako podnositelj prijave zahtijeva registraciju više od jednog razreda, tada grupira proizvode i usluge prema razredima Nicanske klasifikacije, pri čemu svakoj grupi prethodi broj razreda kojemu ta grupa proizvoda ili usluga pripada te ih navodi prema redoslijedu razreda.

(7) Proizvodi i usluge ne smatraju se međusobno sličnima na temelju toga što se pojavljuju u istom razredu Nicanske klasifikacije. Proizvodi i usluge ne smatraju se međusobno različitim na temelju toga što se pojavljuju u različitim razredima Nicanske klasifikacije.