

Notification of Provisional Refusal based on an Ex Officio Examination (to WIPO)

Pursuant to Rule 17(2) of the Common Regulations under the Madrid Agreement concerning the international registration of marks and the Protocol relating to that Agreement.

I. National office that notifies the refusal of protection:
The Swedish Patent and Registration Office
Box 530, S-826 27 SÖDERHAMN, SWEDEN

Telephone: + 46 8 782 25 00
Telefax: + 46 270 173 51

II. International registration: No: 1520869, NutriBalance Repair

III. Holder of the international registration:
Henkel AG & Co. KGaA
Henkelstraße 67
40589 Düsseldorf
Tyskland

IV. The scope of the refusal:
Provisional refusal for ALL goods and/or services

V. Grounds for refusal:

Relative grounds:

Trademark Act Chapter 5 Article 8:2 and Chapter 2 Article 8:1, item 2:

The mark is confusingly similar to the Community Trademark(s):
009657685 DIESE BY NUTRIBALANCE

VI. You will find more information about the conflicting mark(s) (if any) enclosed under XII.
The relevant provisions of the Swedish Trademark Act are under XII.

VII. Date of provisional refusal: 27/10/2020
Response must be received within: 27/01/2021

VIII. Signature by the Office:
THE SWEDISH PATENT AND REGISTRATION OFFICE

Marta Hugosson

IX. If the holder does not contest the provisional refusal within 3 months, protection is given for:

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Rapid publishing of the limited list

If the holder wishes for rapid publishing of the designated trade mark – for the goods/services which are not subject to refusal – the holder may send an explicit request to PRV that the designation of Sweden is partially withdrawn for the goods/services which are subject to the provisional refusal. This request must be signed in original.

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X. Request for a review

The holder of the registration may request a review of the provisional refusal. The Swedish Patent and Registration Office must receive the request no later than 3 months from the date of this provisional refusal. Such request must provide an address for correspondence and be filed in Swedish, Danish, Norwegian or English. The Swedish Patent and Registration Office will respond in Swedish.

XI. Final decision

If this provisional refusal is not contested, or if any of the invoked grounds remain after a request for review, the Swedish Patent and Registration Office will issue a final decision in this matter.

Only applicable to partial refusals: once the final decision takes legal effect (no appeal is filed), the international registration designating Sweden will be published for protection with this above list of goods and services. If the final decision is appealed the case will be remitted to the Patent and Market Court.

Post grant opposition

Please note that to the extent the designation of Sweden is accepted, a post grant opposition may be filed against the mark within 3 months from the publication of the mark.

XII. The relevant provisions of the Swedish Trademark Act regarding the grounds of this provisional refusal:
Trademark Act Chapter 5 Article 8:2 and Chapter 2 Article 8:1, item 2

Number of continuation sheets: 5

Chapter 1. Basic Provisions

Article 5. A trade symbol shall be considered to be distinctive if it is able to distinguish goods or services that are being provided in one business activity from those of another.

Lack of distinctive character may be caused by the fact that a trade symbol consists only of signs or indications that

1. in the course of trade show the kind, quality, quantity, intended use, value, geographical origin or other characteristics, or the time of production of the goods, or rendering of the services, or
2. in common language or according to established practice in trade have become a customary denomination for the goods or services.

In the determination of whether a symbol is distinctive, consideration shall be given to whether it can acquire distinctiveness thorough use.

Chapter 2. National Registration of Trademarks

Article 5. In order for a trademark to be registered, it must have distinctiveness in respect of the goods or services to which it relates.

Article 7. A trademark may not be registered if the trademark

1. is contrary to law or other regulations or to principles of morality or public policy,
2. is likely to deceive the public concerning the nature, quality, geographical origin or any other circumstance related to the goods or services,
3. contains, without permission, such a State or international emblem or such a municipal coat of arms that, by law or other statute, must not be used unauthorized as a trademark, or something that can be easily confused with such an emblem or such a coat of arms,
4. contains, without permission, such a mark, which according to the Act (2014:812) for protection of marks in the international and humanitarian law, must not be used unauthorized as a trademark, or something that can be confused with such a mark,
5. contains a protected designation of origin, a protected geographical indication, a traditional expression for wine or a traditional speciality guaranteed, to the extent such protection exists for the designation within the Union legislation,
6. contains or consists of something which is likely to be perceived as a geographical designation for wine or spirit beverages and the trademark concerns wine or spirit beverages of another origin, or
7. contains or, reproduce in their essential elements, an earlier plant variety denomination, which concerns a plant variety of the same or related plant variety species, to the extent the plant variety is protected according to the Plant Breeders Right Act (1997:306) or the Union legislation.

A trademark that refers to a collective-, guarantee- or a control trademark may not be registered if the conditions for the use of the mark is contrary to principles of morality or public policy.

A collective mark, as referred to in Article 6, may furthermore not be registered if the conditions do not permit membership in the association for all who provide goods and services which the mark concerns and the goods and services have their origin in the geographical area which the mark concerns.

Article 8. A trademark may not be registered if the trademark

1. is identical with an earlier trade symbol for goods or services of the same kind,
2. is identical with or is similar to an earlier trade symbol for goods or services of the same or similar kind if there is, due to this fact, a risk of confusion including the risk that the use of the trademark gives the impression that there is a link between the party using the trademark and the holder of the trade symbol,
3. is identical with or similar to an earlier trade symbol which is known in a considerable portion of those to whom it is addressed and the use of the trademark, without legitimate reason, would attract undue advantage of, or cause damage to the distinctiveness or reputation of the trade symbol irrespective of if the use concerns goods or services of the same, similar or other kind, or
4. may be confused with a mark that was used in this country or in a foreign country at the time of the application and is still in use if the applicant was in bad faith at the time of the application.

As a trade symbol referred to in the first Paragraph, 1 to 3, is deemed

1. a trademark that is registered pursuant to this Chapter,
2. a trademark that is registered on the basis of an international trademark registration which is valid in Sweden pursuant to Chapter 5,
3. a trade symbol that is established on the market, if the protection based on the establishment on the market is valid within a considerable part of the country, and
4. a EU Trade Mark.

Article 9. The obstacles to registration referred to in Article 8, first Paragraph, 1- 3, apply *mutatis mutandis* also as regards

1. a registered trade name that is being used in commercial activities,
2. such a name or a business symbol, other than a trade name, protected pursuant to Chapter 1, Article 8, if the protection applies within a considerable part of the country.

Article 10. A trademark may not be registered if it contains or consists of

1. something that is likely to convey the impression of being someone else's trade name,
2. something that is likely to convey the impression of being someone else's distinctive family name, generally known artistic name or similar name, if the use of the trademark would cause disadvantage for the holder of the name and if the name does not obviously relate to someone who is long deceased,
3. a picture of someone else that does not obviously relate to someone who is long deceased,
4. something that violates someone else's copyright in a literary or artistic work or some else's right in a photographic picture or in a design.

Article 11. The provisions of Articles 8 to 10 Paragraphs 1-4 do not constitute grounds for refusal of registration, if the holder of the earlier right consents to the registration.

Chapter 5. International Trademark Registration

Article 8. If the Patent and Registration Office receives a notification from the International Bureau to the effect that someone has applied for an international trademark registration to be extended to Sweden, the Office shall examine whether there exists any obstacle to this.

An obstacle to the extension of the international trademark application to Sweden exists if there would have been an obstacle to a national registration of the trademark pursuant to Chapter 2, Articles 4 to 11.

If the Patent and Registration Office considers that an obstacle exists under the second Paragraph, the Office shall inform the International Bureau that the international trademark registration cannot, wholly or in part, be extended to Sweden. Such information shall be given within 18 months from the date of the notification and contain the grounds why the registration cannot be extended here.

Article 9. If the Patent and Registration Office has informed the International Bureau under Article 8, third Paragraph, the Office shall not earlier than three months after the information was transmitted decide that the international trademark registration shall not, wholly or in part, extend to Sweden if at that point in time an obstacle referred to in Chapter 2, Articles 4 to 11 still exists.

Article 10. If no obstacle referred to in Chapter 2, Articles 4 to 11 exists, the Patent and Registration Office shall enter the trademark in the Trademark Register and publish a notice that the international trademark registration is valid in Sweden.

If the Patent and Registration Office has decided that the international trademark registration shall partly not be valid in Sweden, the entry of the trademark in the Trademark Register and the publication of a notice shall concern only the remainder of the goods or services when the decision has taken legal force.

Article 14. At the request of the holder of the international trademark registration and of the opponent the Swedish Patent and Registration Office shall decide a specified period of time of at least two months in order to make possible for the parties to reach an agreement. The period of time can be extended at the request of the parties.

Article 16. After an opposition has been filed, the Patent and Registration Office shall decide that the international trademark registration shall, wholly or in part, not extend to Sweden if grounds for refusal referred to Chapter 2, Articles 4 to 11, exists to its extension here. This applies if nothing else follows from Article 17.

An opposition that is wholly or in part based on grounds for refusal referred to in Chapter 2, Articles 8 to 10, shall be rejected in those parts if it has been filed by someone who does not act in his own interest and the holder of the registration so requests.

A decision that the registration shall not extend to Sweden may be based only on a fact that has been communicated to the International Bureau within 18 months from the date of the notification under Article 8, first Paragraph. If the time for opposition, according to Article 11, has expired after that time limit, the decision may nevertheless be based on circumstances that have been communicated to the International Bureau within a month from the expiry of the time limit for opposition. This applies under condition that the Patent and Registration Office within the time limit of 18 months has informed the International Bureau that a notification about such a decision may be communicated later.

If, due to an opposition, the Patent and Registration Office, decides that the registration shall, wholly or in part, not extend to Sweden, the trademark shall to a corresponding extent be removed from the Trademark Register when the decision has taken legal force. A notice about the decision shall be published.

Article 17. If an opposition against the protection of the international trademark registration in Sweden is based on that an earlier registered trademark according to Chapter 2 Article 8 constitutes an obstacle and it on the day of filing or, as the case may be, it from the day of priority of the international registration has elapsed more than five years since the registration of the earlier trademark was finally decided, the following applies. It may be decided that the international registration shall not be granted protection here only if the earlier trademark was taken in real use concerning the goods and services, on which the opposition is based on in the manner referred to in Chapter 3 Article 2 or, if the earlier trademark is a EU-Trademark, on which the opposition is based on in the manner referred to in the Councils Regulation (EU) 2017/1001 of June the 14 2017 regarding EU-Trademarks, within the five years before the date of filing or the date of priority of the international registration.

If the earlier trademark has not been used to the extent which is provided for in the first Paragraph, it may still be decided that the international registration shall not be granted protection in Sweden if there are legitimate reasons to that the earlier trademark not has been used in the required extent.

BILAGA

Registreringsnummer: 1520869
Registreringsdag: 2020-01-07
Ansökningsnummer: 1520869
Ingivningsdag: 2020-01-07

Märkestyp: Ord
Text i märket: NutriBalance Repair

Klassificering:

3: Non-medicated cosmetics; non-medicated soaps; non-medicated hair lotions; preparations for caring, cleaning, tinting, dyeing, coloring, fixing, styling and perming of hair.

Innehavare: Henkel AG & Co. KGaA , Henkelstraße 67
40589 Düsseldorf, Tyskland.

BILAGA

Registreringsnummer: 009657685

Registreringsdag: 2011-08-15

Ansökningsnummer: 009657685

Ingivningsdag: 2011-01-13

Märkestyp: Ord

Text i märket: DIESE BY NUTRIBALANCE

Klassificering:

3: Kosmetika, inklusive naturlig kosmetika; Parfymenivaror; Kosmetiska preparat för hudvård; Kosmetiska preparat för bantningsändamål; Toalettvålar; Deodoranter för personligt bruk; Tandpulver, -kräm och -pastor; Hårlotioner; Schamponeringsmedel; Blekningspreparat och andra ämnen för användning vid tvätt; Rengörings- och skurmedel; Rengöringsmedel ingående i denna klass; Tvål.

5: Farmaceutiska preparat och naturläkemedel; Receptfria farmaceutiska specialiteter; Plåster, förbandsmaterial; Desinfektionsmedel, bakteriedödande medel; Livsmedelspreparat för bantning för medicinsk användning; Spädbarnsmat; Medicinskt te; Medicinska dietdekokter; Näringstillskottspreparat baserade på spårämnen; Rumsluftrenare; Luftdeodoriseringsanordningar; Luftreningspreparat; Preparat för avlägsnande av odör från tyger; Deodoranter för rum och mattor.

29: Konserverade livsmedel baserade på kött, fisk och grönsaker; Mjölksprodukter (inkluderande ost, yoghurt och smör); Geléer; Sylt och marmelad; Ätliga oljor; Sojabönor; Fukt, torkad, tillagad, i sås, som mos; Extrakt och blandningar av extrakt från färskväxter och växtsafter som ingår i sammansättningen av flytande och/eller fasta näringstillskott avsedda att sväljas; Växtextrakt för livsmedel; Livsmedel baserade på grönsaksproteiner.

30: Teer; Icke-medicinska örtteer; Essenser för livsmedel; Drycker baserade på choklad; Isglass; Spannmålsprodukter; Såser; Dressing; Småkakor; Skorpor; Kex och skorpor; Pasta; Ris; Kaffe och kaffeersättning; Chokladpulver; Vinäger; Mjöl; Honung; Salt; Senap; Ketchup; Majonnäs; Salladssåser; Kryddor.

Innehavare: F. LIMA, S.A., Largo do Movimento das Forças Armadas, 1
Alfragide
2720-391 Amadora, Portugal.

Ombud: FURTADO - MARCAS E PATENTES, S.A., Avenida Duque de Ávila, 66-7º
1050-083 Lisboa, Portugal.