



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. Name and address of the Office making the notification:

The Norwegian Patent Office
P.O. Box 8160 Dep., N-0033 Oslo, NORWAY

Telephone: + 47 22 38 73 00
Telefax: + 47 22 38 73 01

II. International registration:

980745



III. Date of Subsequent Designation (if any): (yyyy.mm.dd)

IV. Holder of the international registration:

Otkrytoe Aktsionernoe Obchtchestvo Neftyanaya Kompaniya "Lukoil", 11, Sretensky bouvar,
101000 MOSKVA, RU

V. The scope of the refusal:

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Provisional refusal for all goods and/or services

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Provisional partial refusal for some of the services - see under X

VI. Grounds for refusal:

(i)

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Absolute grounds: **Trademark Act Section 16** - The term "presentation of goods on all communication means for retail sales purposes" in class 35 is considered too vague and is not sufficiently specified with regards to the goods or types of goods to which those services relate. As the subject matter of the protection conferred is not adequately precise, the mark must be refused.

(ii)

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Relative grounds: **Trademark Act Section 14.1.6 and 14.1.8**

Likelihood of confusion with:

National registration number(s)

118855 LUK RepSet

126885 LUK CLUTCH SERVICE

160024 LuK

International registration number(s)

731625 LUK

770032 LUK ASG

942474 LuK

VII. You will find more information about the conflicting mark(s) (if any) enclosed under XIII. The relevant provisions of the Norwegian Trademarks Act and Regulations are under XII.

VIII. Date of provisional refusal:

(yyyy.mm.dd)

2009.02.20

Response must be received within:

(yyyy.mm.dd)

2009.05.20

See more information under XI about the time limit and which actions you need to take if you want to request a review of the provisional refusal.

IX. Signature by Office:

THE NORWEGIAN PATENT OFFICE

Hilde Zander

Hilde Zander

(National reference no.: 200814090)

Number of continuation sheets: 8

X. Scope of the provisional refusal in respect of services:

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

Class43 as filed

Class 35 limited to: Demonstration of goods; market study; shop-window dressing; sales promotion (for others); distribution of samples; dissemination of advertising material (leaflets, prospectuses, printed matter, samples); advertising; online advertising on a computer network; television advertising; administrative processing of purchase orders; supply services for third parties (purchase of goods and services for third parties); subcontracting services (commercial assistance).

Class 35 limited to: Washing of cars; washing of vehicles; vehicle polishing; vehicle service stations (filling up with fuel and maintenance); vehicle cleaning.

The international registration will be published for protection with the above-reduced list of services.

Rapid publication of the limited list

If the holder accepts the proposed limitation of the goods/services, and wishes a publication of the mark for these goods/services as soon as possible, he/she may confirm this in writing to the Norwegian Patent Office. If the Norwegian Patent Office does not receive any such confirmation from the holder, the mark will however be published for protection of the limited list of goods/services, after the expiry of all the time limits.

XI. The holder of the registration may request a review of the provisional refusal. The Norwegian Patent Office must receive the request no later than 3 months from the date of this provisional refusal (The time limit is indicated under point VIII). Such request must be filed through the intermediary of a representative domiciled in Norway. Please note that if the Norwegian Patent Office, either subsequent to review or appeal, accept the designation of Norway, a post grant opposition may be filed against the mark within 2 months from the publication of the mark.

If the holder does not respond to this provisional refusal within the time limit, the international registration shall be considered abandoned in Norway for the goods/services that are excluded (Trademark Act Section 50 and 51). The international registration shall be resumed if the holder, through a Norwegian representative, within two months from the expiration of the time limit responds to the provisional refusal and pays the stipulated fee (NOK 650,-). Please note that the Norwegian Patent Office does not send any notifications to the holder that the international registration is abandoned in Norway.

XII. The relevant provisions of the Norwegian Trademarks Act and Regulations regarding the grounds of this provisional refusal:

Section 1

By registration in accordance with the present Act, the exclusive right to use a trademark as a distinctive sign for goods or services of an industrial or commercial establishment may be acquired. A trademark may consist of any sign which is capable of distinguishing the goods or services of one establishment from those of others, and which is capable of being represented graphically, such as words or combinations of words, including slogans, names, figures and pictures, letters and numerals, and the shape of the goods, their get-up and their packaging. The subsequent provisions of this Act made in respect of goods shall also apply to services provided this is not contrary to the context.

Section 14

A trademark may not be registered if:

1. it is contrary to law or public order or is liable to cause offence;
2. it is liable to deceive;
3. without authorisation by the competent authorities, it includes official coats of arms, flags or other official emblems or badges, including official national or foreign certification or hallmarks or stamps required for goods identical with or similar to those for which registration is applied, or coats of arms, flags or other emblems, abbreviations or designations of intergovernmental organisations, or international marks, seals or signs the unauthorised use of which is forbidden

Int. reg. Number: 980745

by law. Nor shall the trademark be registered if it includes anything liable to be confused with such emblems or badges, etc. as referred to in this section. Foreign emblems or badges, etc., with the exception of flags of States, shall nevertheless not prevent registration until they have been published in a notice in the publication issued by the Patent Office;

4. it includes anything liable to be understood as another person's business name or as another person's name or portrait and which obviously does not refer to a person long dead;
5. it includes anything liable to be understood as the distinguishing title of the protected artistic, literary or musical work of another person, or infringes the copyright to such a work or the photography or design rights of another person;
6. it is liable to be confused with the name or business name of another person or with a trademark registered for another person in accordance with an application filed earlier, or which was established by use for another person at the time when the application for registration was filed;
7. it is liable to be confused with a trademark which someone else has started to use before the applicant, and the applicant was aware of this use when he filed his application for registration;
8. it is liable to be confused with an international registration of a trademark, provided that this registration is effective in Norway in accordance with section 53 from an earlier date than the date of the filing of the application.

In cases as mentioned in subparagraphs 4 to 8 of the first paragraph, registration may nevertheless take place if the holder of the earlier right consents and there are no other obstacles to registration.

Trademarks which consist of or contain geographical indications with respect to wine or spirits, may not be registered for wine and spirits, unless the product has the geographical origin the indication indicates.

Section 16

A trademark shall be registered for specified goods within specified classes of goods. Provisions with respect to the classification of goods shall be laid down by the King.

Guide to the following INID codes:

(111): National registration number/ International registration number
(151): Date of national registration/Date of international registration
(180): Date of expiry
(210): National application number
(220): National application date /Date of notification
(300): Data relating to priority (if any)
(540): Reproduction of the mark
(541): Indication relating to the nature or kind of mark (in Norwegian)
(546): Indication relating to the nature or kind of mark (in Norwegian)
(571): Description of the mark
(731): Name of the applicant
(732): Name of the proprietor
(740): Power of attorney
(511): List of goods and services
(450): Date of publication

XIII. Prior marks cited ex officio

(111) **Reg.nr.:** 118855
(151) **Reg.dato.:** 1984.10.11
(180) **Registreringen** 2014.10.11
utløper:
(210) **Søknadsnr.:** 19813322
(220) **Inndato:** 1981.12.01
(300) **Søknadsprioritet** 1981.06.04 DE L 25 071/12 WZ
(540) **Gjengivelse av merket:**

LUK RepSet

(541) **Merket er et ordmerke**
(731) **Søker:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Bühl, DE
(732) **Innehaver:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Bühl, DE
(740) **Fullmektig:**
Oslo Patentkontor AS, Postboks 7007 Majorstua, 0306 OSLO, NO
(511) **Vare-/ tjenestefortegnelse:**
Klasse:12 Clutcher; clutchplater og -utløsere; bremses; ledd- og drivaksler; samtlige forannevnte varer for landkjøretøyer; vannpumper (sirkulasjonspumper) til motorer for landkjøretøyer.

(111) **Reg.nr.:** 126885
(151) **Reg.dato.:** 1986.11.06
(180) **Registreringen** 2016.11.06
utløper:
(210) **Søknadsnr.:** 19853264
(220) **Inndato:** 1985.09.02
(300) **Søknadsprioritet** Ingen
(540) **Gjengivelse av merket:**



(546) **Merket er et kombinert merke**
(731) **Søker:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Bühl, DE
(732) **Innehaver:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Bühl, DE
(740) **Fullmektig:**
Acapo AS, Postboks 1880 Nordnes, 5817 BERGEN, NO
(511) **Vare-/ tjenestefortegnelse:**
Klasse:4 Hele klassene.
Klasse:7 Hele klassene.
Klasse:12 Hele klassene.
Klasse:17 Hele klassene.
Klasse:41 Hele klassene.

(111) **Reg.nr.:** 160024
(151) **Reg.dato.:** 1993.11.11
(180) **Registreringen** 2013.11.11
utløper:
(210) **Søknadsnr.:** 19922907
(220) **Inndato:** 1992.06.09
(300) **Søknadsprioritet** 1991.12.18 DE L 35 346/12 Wz
1992.04.08 DE L 35 736/12 Wz

(540) **Gjengivelse av merket:**

LuK

(541) **Merket er et ordmerke**

(731) **Søker:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Bühl, DE

(732) **Innehaver:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Bühl, DE

(740) **Fullmektig:**
Acapo AS, Postboks 1880 Nordnes, 5817 BERGEN, NO

(511) **Vare-/ tjenestefortegnelse:**

Klasse:12 Deler til landgående kjøretøyer (ikke opptatt i andre klasser).

Klasse:37 Reparasjon av deler til landgående kjøretøyer.

Klasse:40 Resirkulering av deler til landgående kjøretøyer.

Klasse:41 Undervisning og opplæring vedrørende måling, testing og reparasjon av motorkjøretøyer.

(111) **Reg.nr.:** 731625
 (151) **Reg.dato.:** 1999.11.17
 (180) **Registreringen** 2009.11.17
utløper:
 (210) **Søknadsnr.:** 200005945
 (220) **Inndato:** 2000.05.18
 (300) **Søknadsprioritet** 1999.05.17 DE 399 28 179.7/07
 (540) **Gjengivelse av merket:**



(546) **Merket er et kombinert merke**

(571) **Beskrivelse av merket:**

Merket er i Farger

(731) **Søker:**

LuK Lamellen und Kupplungsbau Beteiligungs KG, Industriestrasse 3, 77815 BÜHL, DE

(732) **Innehaver:**

LuK Lamellen und Kupplungsbau Beteiligungs KG, Industriestrasse 3, 77815 BÜHL, DE

(740) **Fullmektig:**

Acapo AS, Postboks 1880 Nordnes, 5817 BERGEN, NO

Haft von Puttkamer Berngruber, Czybulka Patentanwälte, 38 Franziskanerstrasse, 81669 MÜNCHEN, DE

(511) **Vare-/ tjenestefortegnelse:**

Klasse:4 Oil and grease for use in the drive chain, except motor oils; lubricants; liquid and gaseous fuels.

Klasse:7 Hydraulic pumps and motors, hydraulic accessories, included in this class for utilization with or in connection with steering devices, gear boxes, travelling devices, speed-controls and coupling-controls and regulations, namely compensating reservoirs, hydraulic valves, bearings, joints, filters, fluid containers, transmission devices or driving shafts for pumps as well as spare parts for utilization in mechanical workshops.

Klasse:9 Control units, control systems with electronic units for vehicles, in particular for utilization with the aforesaid products, like hydraulic pumps or motors or parts; apparatus and devices included in this class for use in or in connection with land vehicles.

Klasse:12 Parts of on and off-road vehicles, in particular the aforesaid products like hydraulic pumps or motors or parts or control devices systems, for utilization with or in connection with land vehicles.

Klasse:25 Clothing.

Klasse:37 Repair of motor vehicles and parts for on and off-road vehicles.

Klasse:40 Recycling of motor vehicles and parts for on and off-road vehicles.

Klasse:41 Training of staff for the measuring, checking and repairing of parts of vehicles.

(111) **Reg.nr.:** 770032
(151) **Reg.dato.:** 2001.09.18
(180) **Registreringen** 2011.09.19
utløper:
(210) **Søknadsnr.:** 200115172
(220) **Inndato:** 2001.12.20
(300) **Søknadsprioritet** Ingen
(540) **Gjengivelse av merket:**

LUK ASG

(541) **Merket er et ordmerke**
(731) **Søker:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Industriestrasse 3, 77815 BÜHL, DE
(732) **Innehaver:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Industriestrasse 3, 77815 BÜHL, DE
(740) **Fullmektig:**
Acapo AS, Postboks 1880 Nordnes, 5817 BERGEN, NO
(511) **Vare-/ tjenestefortegnelse:**
Klasse:12 Transmissions and clutch assemblies for motor vehicles as well as devices for
automatized or automatic actuation, regulation and control thereof.

(111) **Reg.nr.:** 942474
(151) **Reg.dato.:** 2007.09.26
(180) **Registreringen** 2017.09.26
utløper:
(210) **Søknadsnr.:** 200714563
(220) **Inndato:** 2007.11.29
(300) **Søknadsprioritet** 2007.03.26 DE 307 20 671.8/12
(540) **Gjengivelse av merket:**



(546) **Merket er et kombinert merke**
(731) **Søker:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Industriestrasse 3, 77815 BÜHL, DE
(732) **Innehaver:**
LuK Lamellen und Kupplungsbau Beteiligungs KG, Industriestrasse 3, 77815 BÜHL, DE
(740) **Fullmektig:**
Zacco Norway AS, Postboks 2003 Vika, 0125 OSLO, NO
(511) **Vare-/ tjenestefortegnelse:**
Klasse:12 Parts of land vehicles included in this class.
