



REPUBLIC OF SLOVENIA
MINISTRY OF ECONOMIC DEVELOPMENT AND TECHNOLOGY
SLOVENIAN INTELLECTUAL PROPERTY OFFICE

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Ref.: 31212-1906/2011-3
105SP(434)
Date: 20.03.2012

MADRID AGREEMENT AND PROTOCOL
PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

I.	Office making the notification: Slovenian Intellectual Property Office Kotnikova 6 SI-1000 Ljubljana Slovenia
II.	Number of the international registration: 1097449
III.	Name of the holder: Dotchirne pidpriemstvo "Konditerska korporatzia "Roshen", vul. Pavla Usenka, 8 Kyiv 02105, UA
IV.	Provisional refusal based on an opposition filed by: FERRERO S.P.A.,,Piazzale Pietro Ferrero,1,12051 ALBA (CN),IT Representative of the opponent: ZIVKO MIJATOVIC & PARTNERS, d.o.o.,Kotnikova ulica 5,Slovenija
V.	Provisional refusal for all the goods and/or services requested
VI.	Grounds for refusal (the relevant provisions of the Slovenian Trademark Act are under XI): 44(1) b
VII.	Information relating to an earlier mark/or marks of the opponent i) Number:IR 688261, 799546 ii) Reproduction of the mark and the list of all or relevant goods and/or services: see additional information under XII
VIII.	Information relating to subsequent procedure: (i) Time limit for requesting review:

The holder of the registration may request a review of the provisional refusal. The Slovenian Office must receive the request no later than 3 months* from the date of this provisional refusal (the time limit starts from the date indicated under point X). After a period the Office will issuing its final decision.

*with the written request the deadline may be extended for 3 months

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

Office indicated under I

(iii) Indications concerning the appointment of a representative:

The request for the review must be filed through the intermediary of a representative domiciled in Slovenia. The list of trademark agents is available on <http://www.uil-sipo.si/sipo/addition/resources/patent-and-trademark-agents/>

IX. Date of the notification of provisional refusal: 20.03.2012

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

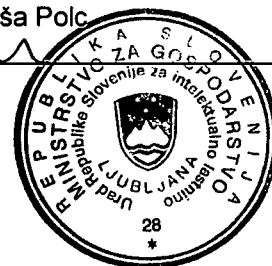
XII. Corresponding essential provisions of the applicable law:

Article 43

Absolute grounds for refusal

(1) A sign shall not be eligible for registration as a mark if:

- (a) it cannot constitute a mark;
- (b) it is devoid of any distinctive character;
- (c) it serves, in trade, to designate merely the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
- (d) it contains or consists of a geographical indication identifying wines or spirits, where the mark application relates to wines or spirits not having this origin;
- (e) it consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
- (f) it consists exclusively of the shape which results from the nature of the goods themselves or is necessary to obtain a technical result or gives substantial value to the goods;
- (g) it is contrary to public order or morality;
- (h) it deceives the public, in particular to the nature, quality or geographical origin of the goods or services;
- (i) it contains official signs or hallmarks for controlling or guaranteeing the quality of goods, or imitations thereof;
- (j) it has not been authorized by the competent authorities and should be refused pursuant to Article 6ter of the Paris Convention;
- (k) it includes or imitates badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention and which are of particular public interest, unless the consent of the competent authorities to its registration has been given;
- (l) it contains or consists of a designation of origin or a geographical indication registered in accordance with the Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 208/92, p. 1), provided that the circumstances referred to in Article 13 of that Regulation exist and the sign does not relate to the same sort of product, and provided that the mark application has been filed after the date of filing of the application for the registration of a designation of origin or a geographical indication with the Commission.



(2) Paragraph 1(b), (c) and (e) shall not apply to marks which acquired a distinctive character through long-term use.

(3) A sign which is ineligible for registration because it contains the name or abbreviation of the name, State armorial bearing, emblem, flag or other official sign of the Republic of Slovenia, or a part thereof, which is in breach of the provisions of paragraph (1)(j) and (k), shall not be used in the course of trade without the consent of the Government of the Republic of Slovenia.

Article 44

Relative grounds for refusal

(1) Further, a sign shall not be eligible for registration as a mark if:

- (a) it is identical with an earlier mark of another owner, and the goods or services for which the registration is applied for are identical with the goods or services for which the earlier mark is registered;
- (b) because of its identity with or similarity to the earlier mark of another owner and the identity or similarity of the goods or services covered by the sign and the mark there exist the likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier mark;
- (c) because of its identity with or similarity to an earlier mark of another owner, registered for goods or services which are not identical with or similar to the goods or services for which the registration has been applied for, the use without due cause of such sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark, or if it would indicate a connection between the goods or services and the owner of the earlier mark, and provided that the interests of the owner of the earlier mark are likely to be damaged by such use;
- (d) it is identical with or similar to a mark or unregistered sign, which is in the Republic of Slovenia a well-known mark within the meaning of Article 6bis of the Paris Convention or Article 16(3) of the TRIPS Agreement;
- (e) the owner of the mark registered in any Member State of the Union established under the Paris Convention, hereinafter referred to as "the Paris Union", or the World Trade Organisation, hereinafter referred to as "the WTO", proves that his agent or representative applied, without the owner's consent, for the registration of the sign in his own name;
- (f) its use would contradict an earlier right to a name, personal portrayal, plant variety, geographical indication or other industrial property right, or an earlier copyright, unless the owner of the earlier right gives his express consent to the registration of such sign.

(2) "Earlier mark" within the meaning of paragraph (1) means:

- (a) mark which was applied for or registered in the Republic of Slovenia on the basis of a national application before the date of filing of the application for the later mark or, if priority is claimed, the date of priority;
- (b) mark for which the protection was sought in the Republic of Slovenia on the basis of an international application before the date of filing of the application for the later mark or, if priority is claimed, the date of priority.

XII: Information relating to an earlier mark/or marks of the opponent

- additional sheets/printout from the register or database:

**MADRID**

The International Trademark System

Printed : 20/03/2012

799546 - FERRERO ROCHER

Countries AG AL AM AT AU AZ BA BG BT BX BY CH CN CU CZ DK DZ EE EG ES FI FR GB GE GR HR
HU IE IS JP KE KG KP KZ LI LR LS LT LV MA MC MD ME MK MN MZ NO PL PT RO RS RU SD
SE SG SI SK SL SM SZ TJ TM TR UA UZ VN YU ZM

151 Date of the registration
28.01.2003

180 Expected expiration date of the registration/renewal
28.01.2013

270 Language of the application
French

Current Status

732 Name and address of the holder of the registration
FERRERO S.P.A.
Piazzale Pietro Ferrero, 1
I-12051 ALBA (CN) (IT)

812 Contracting State or Contracting Organization in the territory of which the holder has a real and effective industrial or commercial establishment
IT

740 Name and address of the representative
JACOBACCI & PARTNERS S.P.A.
Corso Regio Parco 27
I-10152 TORINO (TO) (IT)

770 Name and address of the previous holder
FERRERO S.P.A.
Piazzale Pietro Ferrero
ALBA (CN) (IT)

540 Mark

531



International Classification of the Figurative Elements of Marks (Vienna Classification) - VCL(5)
05.07.06 ; 08.01.19 ; 26.01.02 ; 26.01.05 ; 27.05.01 ; 29.01.01 ; 29.01.02 ; 29.01.07

591 Information concerning colors claimed
Gold, red, white, green, light brown, yellow.
Or, rouge, blanc, vert, marron clair, jaune.

571 Description of the mark
The mark consists in an oval imprint arranged horizontally and bordered by a thick gold line on a white background,

with in its interior a double line of varying widths coloured gold and red; in the centre the denomination, FERRERO ROCHER, of which the word FERRERO forms part of the applicant's commercial name, in original upper-case brown type; below, superimposed on the border line, the image of a chocolate with gold wrapping set in a gold and brown Swedish-style paper cup; on the top of the chocolate, an oval imprint arranged horizontally, with an outer gold line and a fine red inner line and a white fill containing in the centre the denomination FERRERO ROCHER, arranged on two lines, in original brown upper-case type; on the left a partial representation of a brown and light brown unwrapped praline; on the right a representation of a light brown and yellow hazelnut with a green leaf; all on a white background. La marque consiste dans une empreinte ovale disposée horizontalement limité par un trait épais de couleur or sur fond blanc, avec à l'intérieur un double trait de différente épaisseur de couleur or et rouge; au centre la dénomination, disposée sur deux lignes, FERRERO ROCHER, dont le mot FERRERO fait partie de la dénomination sociale de la requérante, en caractères d'imprimerie majuscules originaux de couleur marron; dans la partie inférieure, superposée par rapport au trait de limite, l'image d'un chocolat emballé de couleur or posé sur caissette suédoise de couleur or et marron; dans la partie supérieure du chocolat, empreinte ovale disposée horizontalement, avec un trait externe de couleur or et un trait interne, fin et rouge et un fond blanc contenant au centre la dénomination disposée sur deux lignes, FERRERO ROCHER, en caractères d'imprimerie majuscules originaux de couleur marron; sur la gauche, représentation partielle d'une praline sans emballage de couleur marron et marron clair; sur la droite représentation d'une noisette avec feuille verte, marron clair et jaune; le tout sur fond blanc.

511 International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) - NCL(8)
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.

822 Basic registration
IT, 28.01.2003, 881970

300 Data relating to priority under the Paris Convention and other data relating to registration of the mark in the country of origin
IT, 06.12.2002, TO 2002 C003576

831 Designation(s) under the Madrid Agreement
DZ

832 Designation(s) under the Madrid Protocol
AG - AU - DK - EE - FI - GB - GE - GR - IE - IS - JP - LT - NO - SE - SG - TM - TR - UZ - ZM

834 Designation(s) under the Madrid Protocol by virtue of Article 9sexies
AL - AM - AT - AZ - BA - BG - BT - BX - BY - CH - CN - CU - CZ - EG - ES - FR - HR - HU - KE - KG - KP - KZ - LI - LR - LS - LV - MA - MC - MD - ME - MK - MN - MZ - PL - PT - RO - RS - RU - SD - SI - SK - SL - SM - SZ - TJ - UA - VN

527 Indications regarding use requirements
GB - IE - SG

Registration : 2003/7 Gaz, 15.05.2003, AG, AL, AM, AT, AU, AZ, BA, BG, BT, BX, BY, CH, CN, CU, CZ, DK, DZ, EE, EG, ES, FI, FR, GB, GE, GR, HR, HU, IE, IS, JP, KE, KG, KP, KZ, LI, LR, LS, LT, LV, MA, MC, MD, MK, MN, MZ, NO, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, SM, SZ, TJ, TM, TR, UA, UZ, VN, YU, ZM

Total provisional refusal of protection : 2003/11 Gaz, 10.07.2003, GB

Total provisional refusal of protection : 2003/11 Gaz, 10.07.2003, AU

Total provisional refusal of protection : 2003/13 Gaz, 07.08.2003, IE

Grant of protection : 2003/18 Gaz, 16.10.2003, JP

Total provisional refusal of protection : 2003/19 Gaz, 30.10.2003, SG

Grant of protection subject to opposition : 2004/1 Gaz, 19.02.2004, GE

Grant of protection subject to opposition : 2004/2 Gaz, 04.03.2004, TR

Grant of protection : 2004/6 Gaz, 29.04.2004, KG

Total provisional refusal of protection : 2004/6 Gaz, 29.04.2004, NO

Disclaimer : 2004/6 Gaz, 29.04.2004, CU

Total provisional refusal of protection : 2004/6 Gaz, 29.04.2004, RO

Opposition possible after the 18 months time limit : 2004/7 Gaz, 13.05.2004, SG

Statement indicating that protection of the mark is protected for some of the goods and services requested : 2004/7 Gaz, 13.05.2004, IE

Partial provisional refusal of protection : 2004/8 Gaz, 20.05.2004, RU

Grant of protection : 2004/11 Gaz, 10.06.2004, GE

Statement indicating that the mark is protected for all the goods and services requested : 2004/16 Gaz, 15.07.2004, GB

Opposition possible after the 18 months time limit : 2004/21 Gaz, 19.08.2004, NO

Total provisional refusal of protection : 2004/21 Gaz, 19.08.2004, SE

Opposition possible after the 18 months time limit : 2004/23 Gaz, 02.09.2004, SE

Statement indicating that protection of the mark is protected for some of the goods and services requested : 2004/24 Gaz, 09.09.2004, RU

Opposition possible after the 18 months time limit : 2004/32 Gaz, 04.11.2004, AU

Opposition possible after the 18 months time limit : 2004/37 Gaz, 09.12.2004, NO

Statement indicating that the mark is protected for all the goods and services requested : 2004/37 Gaz, 09.12.2004, RO

Statement indicating that the mark is protected for all the goods and services requested : 2004/43 Gaz, 20.01.2005, AU

Statement indicating that the mark is protected for all the goods and services requested : 2005/19 Gaz, 16.06.2005, SG

Statement indicating that the mark is protected for all the goods and services requested : 2005/43 Gaz, 01.12.2005, SE

Continuation of effect : 2010/2 Gaz, 04.02.2010, ME

Statement indicating that protection of the mark is protected for some of the goods and services requested : 2008/26 Gaz, 31.07.2008, CU

Grant of protection : 2008/49 Gaz, 08.01.2009, TR

Statement indicating that protection of the mark is protected for some of the goods and services requested : 2009/6 Gaz, 26.02.2009, CU

**MADRID**

The International Trademark System

Printed : 20/03/2012

688261 - ROCHER

Countries AG AL AM AN AT AZ BA BG BQ BX BY CH CN CU CW CZ DK DZ EE EG ES FI GE GR HR HU
IE KE KG KP KZ LI LR LS LT LV MA MC MD ME MK MN MZ NO PL PT RO RS RU SD SE SI SK
SL SM SX SZ TJ TM TR UA UZ VN YU ZM

151 Date of the registration

16.02.1998

180 Expected expiration date of the registration/renewal

16.02.2018

270 Language of the application

French

Current Status**732 Name and address of the holder of the registration**

FERRERO S.P.A.

Piazzale Pietro Ferrero, 1

I-12051 ALBA (CN) (IT)

812 Contracting State or Contracting Organization in the territory of which the holder has a real and effective industrial or commercial establishment

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Corso Regio Parco, 27

I-10152 TORINO (IT)

770 Name and address of the previous holder

FERRERO S.P.A.

Piazzale Pietro Ferrero

ALBA (CN) (IT)

540 Mark

ROCHER

541 Reproduction of the mark where the mark is represented in standard characters**571 Description of the mark**

The mark consists of the word: ROCHER.

La marque consiste dans le mot: ROCHER.

566 Translation of the mark or of words contained in the mark

ROCHER

511 International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification) - NCL(7)
29

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruit and vegetables; jellies, jams, compotes; eggs, milk and dairy products; edible oils and fats.

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.

822 Basic registration
IT, 16.02.1998, 740137

300 Data relating to priority under the Paris Convention and other data relating to registration of the mark in the country of origin
IT, 16.12.1997

300 Data relating to priority under the Paris Convention and other data relating to registration of the mark in the country of origin
IT, 16.12.1997, TO 97C 3321

831 Designation(s) under the Madrid Agreement
DZ

832 Designation(s) under the Madrid Protocol
AG - BQ - CW - DK - EE - FI - GE - GR - IE - LT - NO - SE - SX - TM - TR - UZ - ZM

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527 Indications regarding use requirements
IE

Registration : 1998/10 Gaz, 02.07.1998, AL, AM, AT, AZ, BA, BG, BX, BY, CN, CU, CZ, DZ, EG, ES, HR, HU, KG, KP, KZ, LI, LR, LV, MA, MC, MD, MK, MN, PL, PT, RO, RU, SD, SI, SK, SL, TJ, UA, UZ, VN, YU

Total provisional refusal of protection : 1999/1 Gaz, 18.02.1999, EG

Total provisional refusal of protection : 1999/1 Gaz, 18.02.1999, ES

Total provisional refusal of protection : 1999/5 Gaz, 15.04.1999, KG

Total provisional refusal of protection : 1999/5 Gaz, 15.04.1999, BY

Total provisional refusal of protection : 1999/5 Gaz, 15.04.1999, RU

Partial provisional refusal of protection : 1999/6 Gaz, 29.04.1999, SK

Partial provisional refusal of protection : 1999/6 Gaz, 29.04.1999, MD

Partial provisional refusal of protection : 1999/11 Gaz, 08.07.1999, TJ

Partial provisional refusal of protection : 1999/7 Gaz, 13.05.1999, UA

Total provisional refusal of protection : 1999/7 Gaz, 13.05.1999, PL

Total provisional refusal of protection : 1999/8 Gaz, 27.05.1999, KZ

A request for review or an appeal has been lodged : 1999/18 Gaz, 14.10.1999, BY

Statement indicating that the mark is protected for all the goods and services requested : 1999/20 Gaz, 11.11.1999, UA

Statement indicating that the mark is protected for all the goods and services requested : 1999/23 Gaz, 23.12.1999, BY

Statement indicating that the mark is protected for all the goods and services requested : 1999/25 Gaz, 03.02.2000, MD

Statement indicating that protection of the mark is protected for some of the goods and services requested : 1999/25 Gaz, 03.02.2000, EG

Statement indicating that the mark is protected for all the goods and services requested : 1999/25 Gaz, 03.02.2000, KG

Statement indicating that protection of the mark is protected for some of the goods and services requested : 1999/25 Gaz, 03.02.2000, ES

Statement indicating that the mark is protected for all the goods and services requested : 2000/3 Gaz, 16.03.2000, SK

Statement indicating that the mark is protected for all the goods and services requested : 2000/4 Gaz, 30.03.2000, KZ

Statement indicating that the mark is protected for all the goods and services requested : 2000/13 Gaz, 03.08.2000, TJ

Statement indicating that the mark is protected for all the goods and services requested : 2000/19 Gaz, 26.10.2000, RU

Statement indicating that the mark is protected for all the goods and services requested : 2001/9 Gaz, 07.06.2001, ES

Subsequent designation : 2001/10 Gaz, 21.06.2001, TR

Grant of protection subject to opposition : 2002/10 Gaz, 27.06.2002, TR

Statement indicating that the mark is protected for all the goods and services requested : 2002/12 Gaz, 25.07.2002, PL

Subsequent designation : 2003/23 Gaz, 25.12.2003, AG, AN, BQ, CH, CW, DK, EE, FI, GE, GR, IE, KE, LS, LT, MZ, NO, SE, SM, SX, SZ, TM, ZM

Grant of protection subject to opposition : 2004/1 Gaz, 19.02.2004, IE

Grant of protection : 2004/13 Gaz, 24.06.2004, IE

Partial provisional refusal of protection : 2004/37 Gaz, 09.12.2004, CH

Grant of protection subject to opposition : 2004/36 Gaz, 02.12.2004, GE

Total provisional refusal of protection : 2004/43 Gaz, 20.01.2005, NO

Total provisional refusal of protection : 2004/44 Gaz, 03.02.2005, FI

Grant of protection : 2005/7 Gaz, 24.03.2005, GE

Opposition possible after the 18 months time limit : 2005/7 Gaz, 24.03.2005, NO

Renunciation : 2005/37 Gaz, 20.10.2005, CH

Opposition possible after the 18 months time limit : 2005/16 Gaz, 26.05.2005, FI

Statement indicating that the mark is protected for all the goods and services requested : 2005/37 Gaz, 20.10.2005, NO

Statement indicating that the mark is protected for all the goods and services requested : 2005/50 Gaz, 19.01.2006, FI

Continuation of effect : 2010/2 Gaz, 04.02.2010, ME

Renewal : 2008/8 Gaz, 27.03.2008

Limitation : 2011/34 Gaz, 15.09.2011, LT