

**THE PROTOCOL
RELATING TO THE MADRID AGREEMENT
CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS**

PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

I. Office making the notification:

**STATE PATENT BUREAU
OF THE REPUBLIC OF LITHUANIA
Kalvarijų g. 3, LT-09310 Vilnius
LITHUANIA**

Tel.: (370-5) 27 80 267

Fax.: (370-5) 27 50 723

II. Number of the international registration:

1 103 380

III. Name of the holder and other indications of the international registration:

Name of the holder: **Dochirne pidpryemstvo "Kondyterska korporatsiia "Roshen"**
Verbal elements of the Mark: **FINE CHOCOLATE ROSHEN SINCE 1996 CLASSIC, fig**
Basic application: **UA, 31.10.2011, M201117347**

IV. Provisional refusal based on an opposition

Name and address of the opponent:

FERRERO S.P.A.

Piazzale Pietro Ferrero 1

12051 Alba, Cuneo (IT)

Name and address of the representative:

Marija Lenkutienė

Patentinių paslaugų centras, UAB

J.Basanavičiaus g. 11/1

LT-03108 Vilnius

Tel. +370 5 212 3558, Fax. +370 5 212 3557

V. ☒ Provisional refusal for all the goods and services.

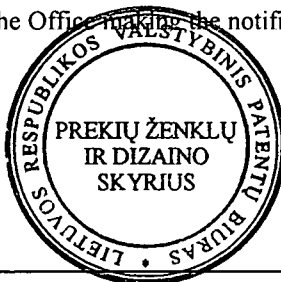
☐ Provisional refusal for some of the goods:
[followed by an indication of the goods and/or services which are affected or are not affected]

X. Date of the notification of provisional refusal:

25.04.2012

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

Head of the Register
Administration Subdivision



Stela Ivanova

* - if the space available is insufficient, see a continuation sheet

Number of continuation sheets: 6

CONTINUATION SHEET

No: 1 of IV

VI. Grounds for refusal [(where applicable, see item VII)]:

- ☒ The mark would infringe rights acquired by third parties resulting from an earlier registration(s)
- ☐ Other grounds.

Opposition filed with the Division of Appeals of the State Patent Bureau on: 16.04.2012 No. PTZ-57

VII. Information relating to an earlier mark:*

Community Trade Marks (copy enclosed):

.....

National registration (extract enclosed):

.....

International registration (copy enclosed):

No 688261

.....

No 799546

.....

VIII. Corresponding essential provisions of the Lithuanian Law on Trade Marks [(see text under XII):*]

Article 7 (1)(2) and 7 (3)

IX. Information relating to subsequent procedure:

The proprietor of a mark of international registration against which an opposition has been filed must within a five months period from the date of this notification present a justified reply to opposition. The justified reply should be addressed to the Appeals Division of the State Patent Bureau. It should be presented in Lithuanian language and an address for the correspondence in the territory of the Republic of Lithuania should be indicated. Where the trademark owner is not a resident of the Republic of Lithuania or another member state of the European Union, neither he has subsidiary or representation registered in the Republic of Lithuania or another member state of the European Union, the justified reply should be presented through a patent attorney of the Republic of Lithuania. The list of patent attorneys is available on <http://www.vpb.gov.lt/engl/>. The time limit expires on **25.09.2012**.

XII. Corresponding essential provisions of the Lithuanian Law on Trade Marks:

Article 5. Signs of Which a Mark May Consist

Marks, with respect to which legal protection under this Law is applicable, may consist of signs, in particular:

- 1) words, personal surnames, names, artistic pseudonyms, names of the legal entities, slogans;
- 2) letters, numerals;
- 3) drawings, emblems;
- 4) three-dimensional forms (the shape of goods, their packaging or containers);
- 5) colours or combinations of colours, their compositions;
- 6) any combination of signs specified in subparagraphs 1-5 of this Article.

Article 6. Absolute Grounds for Refusal of Registration or Invalidation of a Mark

1. A sign shall not be recognised as a mark and shall be refused registration or the registration of a registered mark shall be declared invalid if:

- 1) the sign cannot constitute a mark under the requirements of Article 5;
- 2) the sign is devoid of any distinctive character;
- 3) it has become customary in the current language or in the *bona fide* and established practices of the trade;
- 4) it consists 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, the mode of production or other characteristics of the goods and/or services;
- 5) the sign is of such a nature as to mislead the public, for instance as to the nature, quality or geographical origin of the goods and/or services;
- 6) the sign is contrary to accepted principles of morality or public policy, including ethics of society and humanitarian principles;
- 7) the sign consists exclusively of the shape which results from the nature of the goods themselves or the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods;
- 8) the sign consists of the official or traditional (abbreviated) state name of the Republic of Lithuania, or armorial bearings, flag or other state heraldic objects or any imitation from a heraldic point of view, also official signs and hallmarks indicating control and warranty, stamps, medals or marks of distinction, unless the permission for their use in a mark has been issued according to the established procedure by the institution authorised by the Government of the Republic of Lithuania;
- 9) it consists of the signs the registration of which has not been authorised by the competent authorities of other states or international organisations and the registration of which is to be refused or invalidated pursuant to Article 6ter of the Paris Convention;
- 10) it is a sign of high symbolic value, in particular a religious symbol;
- 11) it contains or consists of a geographical indication with respect to goods not originating in the territory indicated, if use of the indication in the mark for such goods in the Republic of Lithuania is of such a nature as to mislead the public as to the true place of origin of the goods. The above provision shall also be applicable against a geographical indication which, although literally true as to the place of origin of the goods, falsely represent to the public that the goods originate in another territory;
- 12) it contains or consists of a geographical indication identifying wines for wines or spirits for spirits not originating in the place indicated by the geographical indication in question, even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as "kind", "type", "style", "imitation" or the like.

2. In the cases provided for in subparagraphs 2, 3 or 4 of paragraph 1 of this Article, a sign may be recognised as a mark and its registration may not be invalidated if, before the date of application for registration, after the date of filing of the application or registration of the mark and following the use which has been made of it, it has acquired distinctive character.

Article 7. Other Grounds for the Invalidation of Registration

1. Registration of a mark shall be declared invalid if the mark is:

- 1) identical with an earlier mark, and the goods and/or services for which the mark is registered are identical with the goods and/or services for which the earlier mark is applied for or is registered;
- 2) identical with or similar to the earlier mark and because of the identity or similarity of the goods and/or services covered by the marks there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier mark;
- 3) identical with the mark recognised as well-known in the Republic of Lithuania in the manner prescribed by Article 9 of this Law, the proprietor of which is another person, or because of its similarity to the mark it is liable to mislead the public;
- 4) identical with the name of the legal entity or processing a misleading likelihood to the name of the legal entity, whose proprietor is another person who acquired the right to the name of the legal entity in the Republic of Lithuania before the date of filing of the application for the registration of the mark or the date of the priority, if on the specified date the firm had a right to engage in identical or similar trade to which the goods and/or services covered by the registered mark may be attributed;

5) identical with the geographical indication protected in the Republic of Lithuania or possessing a misleading likelihood thereto, except for the indication incorporated in the mark as the disclaimer, for which registration is applied for by a person entitled to use the geographical indication;

6) identical with the protected industrial design or any other object of industrial property, literary, scientific or artistic work protected under the copyright, the name or surname or artistic pseudonym of a famous person, or the portrait of another person or its likelihood to the above is misleading, except in cases where consent has been granted by the owner of the rights or the successor to them.

7) identical with, or similar to, an earlier Community trade mark and where the later mark is to be, or has been registered for goods and (or) services which are not similar to those for which the earlier Community trade mark is registered, where the earlier Community trade mark has a reputation in the European Community and where the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trade mark (...)

3. Registration of the mark may be declared invalid where it becomes evident that the application for the registration of a mark was made in bad faith by the applicant.

Article 11. Filing of an Application

(...) Foreign nationals who are not permanent residents of the Republic of Lithuania or another member state of the European Union, and legal persons of foreign states who do not have a subsidiary or representation registered in the Republic of Lithuania or another member state of the European Union, shall file applications to the State Patent Bureau and perform all actions relating to the registration of the mark with the State Patent Bureau, including also representation at the Appeals Division, through the patent attorney of the Republic of Lithuania (...)

Article 18. Opposition

1. Within a period of three months following the publication of the registered Mark in the Official Bulletin of the State Patent Bureau, the interested person may give to the Appeals Division a justified written opposition to registration of the mark on the grounds that it may not be registered under Articles 6 and 7 of this Law (...)

7. The decision made by the Appeals Division may be appealed against to the Vilnius County Court within six months from the day of adoption thereof.

8. Decisions made by the Appeals Division shall be published in the Official Bulletin of the State Patent Bureau.

Article 19. Appeal and Opposition Examination at the State Patent Bureau

(...)

2. The applicant, the interested person, the proprietor of the mark against which opposition has been filed or the representatives of the above persons shall have the right to take part in the appeal or opposition proceedings at the Appeals Division (...)

Article 34. Special Provisions Applicable to International Registration of a Mark

(...)

4. The proprietor of a mark of international registration against which an opposition has been filed must within a five months period from the date of Notification of Refusal to the International Bureau appoint his representative in the manner laid down in paragraph 2 of Article 11 of this Law and present a justified reply to opposition. Failure to present a justified reply to the opposition shall be considered as a refusal to take part in the examination of the opposition and shall not prevent the Appeals Division from examining the opposition in the absence of the proprietor of the mark of international registration or his representative. If the proprietor of the mark of international registration to which the opposition is filed fails to appoint his representative, the decision made by the Appeals Division shall not be communicated to the proprietor of the mark of international registration (...)

Article 49. Institutions Having Jurisdiction in Disputes Relating to Marks

1. The Appeals Division of the State Patent Bureau shall deal with disputes provided for in Article 18 of this Law.

2. The Vilnius County Court shall deal with disputes relating to:

- 1) decisions of the Appeals Division of the State Patent Bureau;
- 2) invalidation of registration of a mark;
- 3) revocation of registration of a mark;
- 4) enforcement of the proprietor's rights;
- 5) recognition of the mark as well-known in the Republic of Lithuania;
- 6) Community trade marks as defined in Articles 90-101 of the Council Regulation on Community trade

mark.



MADRID

The International Trademark System

Printed : 24/04/2012

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

IT

740 Name and address of the representative

JACOBACCI & PARTNERS SpA

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



MADRID

The International Trademark System

Printed : 24/04/2012

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 limitée 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