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1211 Geneva
Switzerland

Danish Patent
and Trademark Office

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2630 Taastrup

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CVR-nr. : 17 03 94 15

Danish Ministry of Economic
and Business Affairs

 **nordic patent institute** Partner

Our Reference: MP1097449
Your Reference:
International Registration: 1097449
Holder: Dochirnie pidpryemstvo
"Konditerska korporatsiia "Roshen"
Mark: FINE CHOCOLATE ROSHEN SINCE
1996 Elegance

19 July 2012

Dear Madam/Sir

Notification of Provisional Refusal Based on Opposition according to Rule 17(3)

An opposition against the validity of the above-mentioned designation of Denmark has been filed with the Danish Patent and Trademark Office by:

Ferrero S.p.A.
Piazzale Pietro Ferrero
I-12051 Alba (CN),
,
Italien

Consequently, the mark is provisionally refused protection in Denmark **for all of the goods/services** covered by the designation.

Grounds for the opposition

The opponent has stated the following reasons for the opposition:

- Identity/risk of confusion with an earlier registered trademark, cf. Section 15(1) (see appendix for trade marks cited by the opponent)

Please note that the opposed registration is subject to full examination by the Danish Patent and Trademark Office, cf. Section 23 of the Danish Trademark Act. We have enclosed an abstract of the relevant sections of the Danish Trade Marks Act and the Order on application and registration, as well as a copy of the opposition

Final decision and appeal

If we do not receive a request for review within the time-limit mentioned above, we will issue a final decision, which is subject to appeal to the Board of Appeal for Patents and Trademarks.

Further information

We have enclosed guidelines on our opposition procedures as well as an abstract of the relevant sections of the Danish Trade Marks Act. For further information about opposition procedures, please contact the examiner.

Request for review of the provisional refusal

The opponent has been granted a two-month time limit to submit further evidence in support of the grounds for the opposition mentioned above. When the opponent's two month time limit has expired, the holder will be granted a four-month time limit to request a review of the provisional refusal.

The holder will be notified of the time limit when the four-month period begins. Please observe that a request for review of the provisional refusal should be filed in Danish.

Yours faithfully

Lone Steinbrecher
Examiner, Trademarks/Design

Appendix

Guidelines on oppositions

We deal with oppositions in two phases:

- The hearing during which the opponent and the holder exchange arguments and documentation through our Office.
- The decision phase during which we review the arguments and documents and make a decision on this basis.

Hearing Procedure

Both parties are entitled to put forth their opinions and arguments. The extent of the hearing depends on the complexity of the case.

It is the role of the Office to make sure that each party is allowed the opportunity to present their arguments. We also provide guidance on aspects we find relevant to the case. The holder is always given the opportunity to respond to the opposition. Thus, at least one exchange of letters will take place.

When the opponent's mark is subject to the requirement of use

Please note that the holder may request the opponent to document that the opponent's mark has been used in accordance with the regulations of requirement of use of The Danish Trade Marks Act, Section 25. Under this provision, a Danish registration must have been in use in Denmark within the last five years. A Community trademark must have been used in at least one of the member states within the last five years. The holder must be able to prove that the mark has been used in relation to the goods and/or services covered by the registration. Otherwise, during the case, the registration will only be seen to cover the goods and services for which use has been documented.

Documents submitted to the Office

Please be aware that any documents submitted to us will be available to the public according to the regulations of The Danish Access to Public Administration Files Act. The material will also be sent to the opponent for comments according to the regulations of The Administration Act.

Time limits

During the hearing, both parties must reply within the time limits laid down by the Office. A time limit may be extended, usually for one or two months, if deemed reasonable.

If one party informs the Office that negotiations for a settlement are taking place, we will suspend the hearing procedure for 6 months. The hearing may be resumed at any time, if one of the parties wish so, or the opposition may remain suspended for 6 months at a time as long as negotiations are ongoing.

Decision

When we judge that the case is sufficiently elucidated, we inform the parties that the hearing procedure is finished, and the case ready to be decided.

When we make the decision, we review and evaluate the arguments and the material submitted by the parties. We also undertake additional investigations if necessary and review earlier practice.

A decision including grounds is sent to both parties. We will also inform the party or parties ruled against about the means to appeal with the Danish Board of Appeal for Patents and Trademarks.

Abstract of the Danish Trade Marks Act and Order on Application and Registration, etc. of Trade Marks and Collective Marks

Signs of which a trade mark may consist

Section 2

- (1) A Trade mark may consist of any sign capable of distinguishing the goods or services of one enterprise from those of other enterprises and capable of being represented graphically, in particular:
- (i) words and word combinations, including slogans, personal names, company names or names of real property;
 - (ii) letters and numerals;
 - (iii) pictures and designs; or
 - (iv) the shape, equipment or packaging of the goods.
- (2) A trade mark right shall not be acquired for signs which consist exclusively of a shape which is dictated by the goods themselves, a shape of goods which is necessary to obtain a technical result or a shape which gives substantial value to the goods.

Registration of trade marks

Section 12

- (1) An application for the registration of a trade mark shall be filed with the Patent and Trademark Office. The application shall contain a reproduction of the trade mark and state the applicant's name or company. Furthermore, the goods or services for which registration of the trade mark is applied for shall be stated.
- (2) The application shall be drawn up in accordance with the provisions laid down pursuant to section 48. The prescribed fee shall accompany the application.
- (3) The Patent and Trade mark Office shall keep a register of trade marks. The Office shall publish registrations, etc.

Grounds for refusal

Section 13

- (1) For a trademark to be registered it shall be of the nature referred to in section 2, including a distinctive character.
- (2) The following trademarks shall not be registered:
- (i) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering the services or other characteristics of the goods or services;
 - (ii) trademarks which consist exclusively of signs or indications which are customarily used to designate the goods or services in the current language or in the established practices of the trade.
- (3) Irrespective of the provisions of sub-sections (1) and (2) a trademark may be registered if, before the filing of the application in consequence of the use which has been made thereof, it has acquired a distinctive character.

Section 14

Furthermore, the following shall not be registered:

- (i) trademarks which are contrary to law, public order or morality;
- (ii) trademarks which are liable to mislead the public, for instance as to the nature, quality or geographical origin of the goods or services;
- (iii) trademarks which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of industrial Property, and trademarks which include badges, emblems and escutcheons which are of public interest, unless the consent of the appropriate authority to their registration has been given;
- (iv) trademarks which without permission consist of or contain an element which can be construed as a personal name or company name to which another party has a legal title, or as a portrayal provided allusion is not made to persons long dead, or which without permission contain a distinctive name of or a picture of the real property of another party;
- (v) trademarks which without permission consist of or contain an element which can be construed as a distinctive title of the protected literary or artistic work of another party or which infringe the copyright in such works or the right to a photograph of another party or the industrial property rights of another party.

Section 15

- (1) A trademark shall not be registered if:
 - (i) it is identical with an earlier trademark, and the goods or services for which the trademark is sought registered are identical with the goods or services for which the earlier trademark is protected, or
 - (ii) there exists a likelihood of confusion including a likelihood of association with the earlier trademark, because the later trademark is identical with or similar to the earlier trademark and the goods or services are identical or similar.
- (2) For the purpose of subsection (1) earlier trademarks mean:
 - (i) marks of the following categories in respect of which the date of application for registration is earlier than the date of application for registration of the trademark, taking account, where appropriate, of the priorities claimed in respect of those marks:
 - (a) Community trademarks;
 - (b) Trademarks registered in this country, or
 - (c) Trademarks registered under international agreements and having effect in this country;
 - (ii) Community trademarks which claim seniority, in accordance with the Regulation on the Community trademark, in relation to a trademark referred to under (i)b) and c), even if the latter trademark has been surrendered or has lapsed;
 - (iii) Applications for trademarks referred to under (i) and (ii), subject to their registration;
 - (iv) Trademarks which, on the date of application for registration of the trademark, or, where appropriate, of the priority claimed in respect of the application for registration of the trademark, are well known in this country, in the sense in which the words "well known" are used in Article 6bis of the Paris Convention.
- (3) A trademark shall, furthermore, not be registered if:
 - (i) it is identical with or similar to an earlier Community trademark, cf. Subsection (2) and is sought registered for goods or services which are not similar to those for which the earlier Community trademark is registered, provided that the earlier Community trademark is well known in the European Union and the use of the later trademark will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trademark;
 - (ii) it is identical with or similar to a "well known" trademark, cf. Subsection (2) (iv), and is sought registered for goods or services which are not similar to those for which the earlier trademark is well known, provided that the use of the later trademark may lead to a likelihood

- of association between the marks, and the use will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark, or
- (iii) it is identical with or only insignificantly distinct from a trademark, which at the date of filing of the application for registration or, where appropriate, of the priority claimed in respect of the application for registration, has commenced to be used in another country and is still in use there for goods or services which are identical with or similar to those for which the later trademark is sought registered, and the applicant at the date of the filing had, or should have had, knowledge of the foreign trademark.
- (4) A trademark shall moreover not be registered if:
- (i) the trademark is identical with or similar to an earlier Danish trademark within the meaning of subsection (2) and is sought registered for goods or services which are not similar to those for which the earlier trademark is registered, where the earlier trademark is well known in this country and where the use of the later trademark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark, or
 - (ii) in consequence of use in this country a right has been acquired to an identical or confusingly similar trademark or to another identical or confusingly similar sign used in the course of trade prior to the date of filing of the application for registration of the later trademark, or, where appropriate, of the priority claimed in respect of the application for registration of the later trademark, if the proprietor of the earlier right can prohibit the use of the later trademark.
- (5) A trademark shall not be excluded from registration pursuant to the provisions of subsections (1) to (4) where the proprietor of the earlier trademark or other earlier rights consents to the registration of the later trademark.

Processing of applications

Section 20

- (1) If the application does not comply with this Act or the provisions laid down pursuant to this Act, or if the Patent and Trademark Office has other objections to the acceptance of the application, the Patent and Trademark Office shall notify the applicant accordingly and invite him to file his observations within a specified time limit.

Opposition

Section 23

- (1) When the registration has been published, opposition may be filed against the validity of the registration. The opposition, which shall be reasoned, shall be filed with the Patent Office within two months from the date of publication. A fee, the amount of which shall be fixed by the Minister of Business and Industry, shall accompany the opposition.
- (2) If opposition has been filed, the Patent Office shall examine the registration in accordance with section 20. Section 28 (5) shall also apply during the examination. The proprietor of the registered right shall be notified of the opposition and be given an opportunity to submit his observations.
- (3) If the registration is maintained, the person having filed the opposition and the proprietor of the right shall be given notice hereof.
- (4) If the registration is declared void in part or in full, the decision to that effect shall be published when it is final.

Order on Application and Registration, etc. of Trade Marks and Collective Marks no. 364 of 21 May 2008

Section 2

(1) The application shall indicate:

(ii) the goods and/or services for which the registration of the mark is requested grouped in classes in compliance with the classification in the Nice Agreement of 1957 with subsequent amendments concerning international classification of goods and services for the purpose of registration of trade-marks...

Registerudskrift
(Extract of Register)

Endelig gyldig

(210) Sagsnummer : MP799546

(100) Reg proc slut d. : 2003-09-02
(800) Offentligg. dato : 2003-07-02
(800) Designeringsdato: 2003-01-28

(730) Indehaver : FERRERO S.p.A.
Piazzale Pietro Ferrero,
I-12051 ALBA CN
Italien

(740) International fuld. : JACOBACCI & PARTNERS S.P.A.
(750) Adresse : Corso Regio Parco 27
I-10152 TORINO (TO)
Italien

(540) Mærke :



(511) Klasser og varefortegnelse : Klasse 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.

(591) Farvetekst : Gold, red, white, green, light brown, yellow.

(300) Prioritet : 2002-12-06
TO 2002 C003576
Italien

(230) Udstillingsprioritet:

(800) Int. reg. dato : 2003-01-28

(800) Gazettenr : 07/2003

Udskrift slut
(End of Extract)

Registerudskrift
(Extract of Register)

Endelig gyldig

(210) Sagsnummer : MP688261

(100) Reg proc slut d. : 2004-07-26
(800) Offentligg. dato : 2004-05-26
(800) Designeringsdato: 2003-08-29

(730) Indehaver : FERRERO S.p.A.
Piazzale Pietro Ferrero,
I-12051 ALBA CN
Italien

(740) International fuld. : JACOBACCI & PARTNERS SpA
(750) Adresse : Corso Regio Parco, 27
I-10152 TORINO
Italien

(740) National fuldm. : Awapatent A/S
(750) Adresse :

(540) Mærke : ROCHER

(511) Klasser og : Klasse 30: Coffee, tea, sugar, rice, tapioca, sago, coffee substitutes; flour and milled
varefortegnelse : 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.

(591) Farvetekst :

(800) Int. reg. dato : 1998-02-16

(800) Gazettenr : 23/2003

Udskrift slut
(End of Extract)

To: 3 - PVS Voprettelsen nye sager
From: - PVS Patent- og Varemærkestyrelsens officielle postkasse
Subject: VS: Indsigelse mod dansk designering af MP nr. 1097449 FINE CHOCOLATE ROSHEN SINCE 1996 ELEGANCE (fig) - vores ref AWA#854563
Sent: Tue Jul 17 09:05:11 2012
Importance: Normal

Fra: Stine Felten [mailto:Stine.Felten@awapatent.com]
Sendt: 17. juli 2012 09:02
Til: - PVS Patent- og Varemærkestyrelsens officielle postkasse
Emne: Indsigelse mod dansk designering af MP nr. 1097449 FINE CHOCOLATE ROSHEN SINCE 1996 ELEGANCE (fig) - vores ref AWA#854563

Se venligst vedhæftede.

Med venlig hilsen

Stine Felten

Trademark Coordinator / Varemærkekoordinator

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