




Ministero dello Sviluppo Economico

DIPARTIMENTO PER L'IMPRESA E L'INTERNAZIONALIZZAZIONE
DIREZIONE GENERALE PER LA LOTTA ALLA CONTRAFFAZIONE
Ufficio Italiano Brevetti e Marchi

MADRID AGREEMENT AND PROTOCOL

PROVISIONAL REFUSAL OF PROTECTION

Rule 17(1)

I.	Office making the notification: MINISTERO DELLO SVILUPPO ECONOMICO Direzione Generale per la Lotta alla Contraffazione - Ufficio Italiano Brevetti e Marchi Via Molise, 19 - 00187 ROMA e-mail : imp.lcuibm.div2@pec.sviluppoeconomico.gov.it
II.	Number of the international registration: 1 103 380 Trademark: 
III.	Name of the holder (or other indication enabling the identity of the international registration to be confirmed): Dochirnie pidpriemstvo "Kondyterska korporatsiia "Roshen" Elektrykiv vul., 26/9 Kyiv 04176 (UA)
IV.	<input type="checkbox"/> Provisional refusal based on an <i>ex officio</i> examination <input checked="" type="checkbox"/> Provisional refusal based on an opposition <input type="checkbox"/> Provisional refusal based on both an <i>ex officio</i> examination and an opposition
V.	<input checked="" type="checkbox"/> Provisional refusal for all the goods and/or services <input type="checkbox"/> Provisional refusal for some of the goods/services:
VI.	Grounds for refusal : Identity or similarity between the marks and identity or similarity between the goods/services.

VII. Opponent rights:

1) Registration number: **740137** (*National Registration*)

i) Application number: **TO1997C003321**

ii) Filing date: **16/12/1997** (**Renewed N.1303187**)

iii) Date of registration: **16/02/1998**

iv) Priority date: //

v) Seniority date: //

vi) Name and address of the opponent: **FERRERO S.P.A.**
Piazzale Pietro Ferrero, 1
12051 ALBA (CN)

vii) Reproduction of the mark: **ROCHER**

viii) List of some goods:

Cl.30: Pasticceria e confetteria, cioccolata, praline.

2) Registration number: **513867** (*National Registration*)

i) Application number: **40288-C/88**

ii) Filing date: **11/03/1988** (**Renewed N.1303737**)

iii) Date of registration: **02/10/1989**

iv) Priority date: //

v) Seniority date: //

vi) Name and address of the opponent: **FERRERO S.P.A.**
Piazzale Pietro Ferrero, 1
12051 ALBA (CN)

vii) Reproduction of the mark: **ROCHER**

viii) List of some goods:

Cl.30: Cioccolato, cioccolatini e praline, prodotti commestibili con copertura in cioccolato.

VIII. Corresponding essential provisions of the applicable law [(see text under XII)]:
Art.12 1), d) of the Italian Industrial Property Rights Code.

IX. Information relating to subsequent procedure:

(i)

Time limit for requesting review or appeal:

The holder of the registration may request a copy of the opposition notice.
within three months from the date on which the Office issues the provisional refusal.

(ii)

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

The holder of the registration may submit his objections to the present refusal to *Ufficio Italiano Brevetti e Marchi – Divisone II Affari Giuridici e Normativi - Via Molise, 19 – 00187 ROMA -ITALY*.

(111)

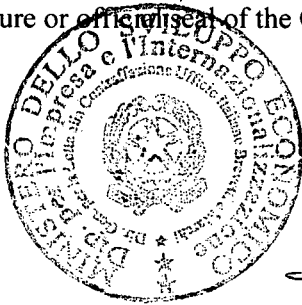
Indications concerning the appointment of a representative:

Where the holder isn't established or domiciled in Italy, he may submit his objections exclusively through an agent registered in the roll kept for this purpose by the Italian Patent and Trademark Office (see: www.ordine-brevetti.it) or a lawyer registered in the appropriate professional roll (see: www.ordineavvocati.it) - (artt. 201- Code of Industrial Property Rights).

X. Date of the notification of provisional refusal: **20 LUG. 2012**

Prot. N.: **163016**

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



**Il Dirigente della Divisione XIII
D.ssa Stefania Barincasa**

Stefania Barincasa

XII. Corresponding essential provisions of the applicable law:

Extract from the Code of Industrial Property Rights

(Legislative Decree of February 10th 2005, n.30)

Art. 17 - International Registration

1. The provisions of the international conventions in force shall remain effective with respect to the registration of trademarks with the World Intellectual Property Organization (WIPO) in Geneva.
2. Marks registered with WIPO, on the basis of the Madrid Agreement, Stockholm text, July 14, 1967, ratified with law April 28, 1976, no.424, and the relative Protocol, adopted in Madrid on June 27,1989, ratified with law March 12, 1996, no.169, and concerning Italy as the Country where the relevant protection is required, must meet the requirements set forth by this Code in relation to national trade marks.
3. The Italian Patents and Trademarks Office shall examine international trade marks concerning Italy in compliance with the provisions applicable to applications for national trade marks.

Art. 7 – Subject Matter of Registration

1. Any sign which can be represented graphically, particularly words, including personal names, designs, letters, numbers, sounds, the shape of a product or of its packaging, color combinations or tonalities, provided that they are capable of distinguishing the goods or services of one company from those of other companies, may be registered as a trade mark.

Art. 8 - Portraits of person, personal names, well known trade marks

1. Portraits of person may not be registered as marks without their consent or, after their death, without the consent of their spouse and children or, if there are no spouse or children or after their own death, of their parents or other descendants or, if there are no parents or other descendants or after their death also, of the other relatives up to the fourth degree inclusive.
2. Personal names other than the name of the person seeking registration may be registered as marks provided that their use does not damage the reputation, credit or dignity of those who are entitled to bear such names. However, the Italian Patents and Trademarks Office shall be entitled to subordinate the registration to the consent set forth under paragraph 1 of this Article. Registration shall in no case prevent those entitled to such name from using it in the trade name of their choice, in the circumstances referred to article 21. 1).
3. If they are well known, the following may be registered or used as marks only by those entitled to them or with their consent or with the consent of the persons referred to in paragraph 1: personal names, signs used in the artistic, literary, scientific, political or sports fields, names of abbreviations of exhibitions and events, and non-profit bodies and associations, as well as the characteristic emblems thereof.

Art. 9 – Shape trade marks

1. Signs consisting exclusively of the shape imposed by the nature of the product, of the shape necessary to obtain a technical result or of the shape which gives substantial value to the product shall not be eligible for trade mark registration.

Art. 10 – Escutcheons

1. The escutcheons and the other signs referred to in international conventions governing such matters, in those cases and under those conditions laid down by the said conventions, as well as the signs containing symbols, emblems and escutcheons which are of public interest cannot be eligible for registration as trademarks, unless the competent authority has authorized the registration thereof.
2. When a mark contains words, figures or signs having a political meaning or a high symbolic value, as well as heraldic elements, the Italian Patents and Trademarks Office shall send, prior to the relevant registration, a sample of the mark and any other elements which may be useful to the interested or competent public authorities to solicit their opinion, in compliance with the provisions set forth in paragraph 4.
3. The Italian Patents and Trademarks Office has the power to act in compliance with provisions of paragraph 2 any time, when there is a suspicion that the mark could be contrary to the law, to the public policy or the accepted principles of morality.
4. Should the interested or competent authority referred to in paragraphs 2 and 3, issue opinion contrary to the registration of the mark, the Italian Patents and Trademarks Office shall reject the application.

Art.12 – Novelty

1. Signs cannot be registered as a mark if on the filing date of the application:

- a) (omissis);
- b) (omissis);
- c) They are identical to a trademark that has already been registered in the State by others or that is effective in the State following an application filed on an earlier date, or having effect as from an earlier date because of a prior right or a valid claim of seniority, for identical goods or services;
- d) They are identical or similar to a trademark that has already been registered in the State by others or is effective in the State following an application filed on an earlier date, or having effect as from an earlier date because of a prior right or a valid claim of seniority, for identical or similar goods and services, where the identity or similarity of the signs and the identity or similarity of the goods or services might create a likelihood of confusion for the public, such likelihood of confusion including a likelihood of association between the two signs; [...]
- e); f); 2. 3. (omissis)

Art. 13 – Distinctive character

1. Signs lacking in distinctive character shall not be eligible for trademark registration and particularly:

- a) those consisting exclusively in signs which have become customary in the current language or in the established practices of the trade;
- b) those constituted exclusively by generic names of goods or services or by descriptive statements relating thereto, such as signs which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or time of production of the goods or of the provision of the service, or other characteristics of the product or service.

2. By derogation to paragraph 1 above, signs which, by reason of their use, have acquired a distinctive character prior to the date of application for registration, may be the subject of a trade mark registration.

Art. 14 – Lawfulness and rights of third parties

1. The following signs shall not be eligible for trademark registration:

- a) signs contrary to law, public policy or accepted principles of morality;
- b) signs capable of deceiving the public, in particular as to the geographical origin, nature or quality of the goods or services.
- c) (omissis)

Art. 135 – Board of Appeal

1. A petition may be filed before the Board of Appeal against decisions of the Italian Patents and Trademarks Office totally or partially rejecting an application or refusing the recordings or prohibiting the recognition of a right and in the other cases provided by the law, within 60 days from the communication of the decision.
(omissis)

Art. 170 – Examination of applications

1. The examination of applications that have been formally approved is aimed at verifying:

- a) for trademarks: if article 11 applies for collective trademarks; if the word, image or sign may be registered as a trademark according to articles 7, 8, 9, 10, 13, paragraph 1 and 14, paragraph 1, letters a) and b); if the conditions set forth under article 3 are met.
- b) (omissis)

Art. 171 – Examination of the International trademarks

1. (omissis)

2. When it considers that a trademark cannot be registered in whole or in part, or an opposition has been filed by a third party according to article 176, the Italian Patents and Trademarks Office, shall issue, according to article 5 of the Madrid Agreement for the International Trademarks Registration, text of Stockholm 14 July 1967, ratified by law “8 April 1976, no. 424 or to the relevant Protocol 27 June 1989, ratified by law 12 March 1996, a provisional refusal of the International Registration and inform the World Intellectual Property Organization.

3. The provisional refusal set forth under paragraph 2 shall be issued within one year for the International Trademarks Registrations based on the Madrid Agreement for the International Trademarks Registrations and within eighteen months for those based on the relevant Protocol. Said terms run from the dates respectively indicated in the afore-said International Conventions.

4. In the case of provisional refusal, the protection of the trademark is the same as the one for a trademark application filed before the Italian Patents and Trademarks Office.

5. Within the final term fixed by the Italian Patents and Trademarks Office, the holder of an International Registration, in relation to which a temporary refusal was communicated to the World Intellectual Property Organization, may, through a representative appointed according to article 201, present its own submissions, or request copy of the opposition on which the issue of the temporary refusal was based. In this latter case, if the holder of an International Registration requests the copy within the granted term, the Office shall communicate to the parties the notice set forth under article 178, paragraph 1, and shall apply the other provisions relating to the opposition procedure set forth under article 178 and following.

6. If within the term set forth in paragraph 5, the holder of an International Registration does not present its own submissions, or does not request a copy of the opposition according to the prescribed procedure, the Italian Patents and Trademarks Office shall issue a final refusal.

7. The Italian Patents and Trademarks Office shall communicate to the World Intellectual Property Organization the final decisions in relation to the International Trademarks designating Italy.

Art. 201 – Representation

1. 2. 3. (omissis)

4. The assignment may be conferred only to representatives that are registered in a register created before the Council of professional consultants in intellectual property.

5. (omissis)

6. The assignment may be conferred to a lawyer registered in his professional register.