

Notification of Provisional Refusal of Protection based on an Opposition (to WIPO)

Pursuant to Rule 17(3) 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 Industrial Property Office Telephone: + 47 22 38 73 00
P.O. Box 8160 Dep., N-0033 Oslo, NORWAY Telefax: + 47 22 38 73 01

II. The international registration which is subject to the opposition



**FINE CHOCOLATE ROSHEN SINCE 1996 CLASSIC -
1103380**

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

IV. Name and address of the holder of the international registration which is subject to the opposition:

Dochirnie pidpriemstvo Kondyterska korporatsiia
Roshen
Elektrykiv vul.
26/9
04176
KIEV
UA


IV. Name and address of the opponent(s):

Ferrero SpA
Piazzale Pietro Ferrero 1
12051
ALBA (CN)
IT

VI. Grounds for opposition:

- (i) ☐ Absolute grounds:
(ii) ☒ Relative grounds: 16a
☒ Likelihood of confusion with

International registration number(s):
688261 - ROCHER

799546 - 

☐ Likelihood of confusion with
Tradename(s) :

☐ Likelihood of confusion with mark(s)
which is/are established by use:

See continuation sheet.

VII. The scope of the opposition

- (i) ☒ The opposition affects all goods and services. (Refusal for all goods and services)
(ii) ☐ The opposition affects some of the goods and services. (See continuation sheet under

VIII Relevant provisions of the Norwegian Trademarks Act are enclosed.

IX. A respond to the opposition shall be received by the Norwegian Industrial Property Office no later than 3 months from the date of the notification from the Norwegian Industrial Property Office (The time limit is indicated next to the date of prov. refusal under X). The respond must provide an address of correspondence and be filed in Norwegian, Swedish or Danish. The Norwegian Industrial Property Office will respond in Norwegian. A copy of the opposition will be sent to you upon your request. Please note that the decision made by the Norwegian Industrial Property Office can be appealed to the Appeal board by either party within two months from the date of the decision.

X Date of prov. refusal: 2012.09.14 Response must be received within: 2012.12.14

XI Signature by Office:
Torunn Stillingen

(National Trademark application number: 201200611)

Number of continuation sheets: 5

Prior marks on which the opposition is based :

Priority date (if any) :

(yyyy.mm.dd)

Date of subsequent designation (if any) :

2003.08.29

National registration date and number :

(yyyy.mm.dd)

National application date and number :

2003.11.27 - 200311292

International registration date and number :

1998.02.16 - 688261

Name and address of the holder :

Ferrero SpA

Piazzale Pietro Ferrero 1

12051

ALBA (CN)

IT

Name and address of the Norwegian representative :

Tandbergs Patentkontor AS

Postboks 1570 Vika

0118 OSLO

NO

Reproduction of the former mark :

ROCHER

List of goods and services:

Klasse 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.

Prior marks on which the opposition is based :

Priority date (if any) :
2002.12.06

Date of subsequent designation (if any) :
(yyyy.mm.dd)

National registration date and number :
(yyyy.mm.dd)

National application date and number :
2003.04.24 - 200304043

International registration date and number :
2003.01.28 - 799546

Name and address of the holder :
Ferrero SpA
Piazzale Pietro Ferrero 1
12051
ALBA (CN)
IT

Name and address of the Norwegian representative :
Tandbergs Patentkontor AS
Postboks 1570 Vika
0118 OSLO
NO

Reproduction of the former mark :



List of goods and services:

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.

Extracts from the Norwegian Trademarks Act

§ 3. Establishment of a trademark right

A trademark right may be acquired for the whole of Norway by registering the trademark in the Trademark Register according to the provisions in Chapter 2.

A trademark right may also be acquired for the whole of Norway by international registration according to the provisions in Chapter 10.

A trademark right is acquired without registration when the trademark is established by use. A trademark is considered to be established by use when and for as long as it is well known in the circle of trade in Norway for the relevant goods and services as someone's sign. If such use is established only in part of Norway, the exclusive right has effect only in this territory.

§ 4 Content of a trademark right

A trademark right has the effect that no one, without the consent of the proprietor of the trademark right (the trademark proprietor), may use in an industrial or commercial undertaking:

- a. any sign which is identical with the trademark for goods or services for which the trademark is protected
- b. any sign which is identical with or similar to the trademark for identical or similar goods or services if there exists a likelihood of confusion, such as if the use of the sign may give the impression that there is a link between the sign and the trademark.

For a trademark which is well known in Norway, the trademark right implies that no one, without the consent of the trademark proprietor, may use a sign that is identical with or similar to the trademark for similar or any other goods or services, if the use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute (goodwill) of the well-known trademark.

Use is considered to include the following:

- a. affixing the trademark to goods or to the packaging thereof
- b. offering goods for sale or otherwise putting them on the market, stocking or delivering them under the sign, or offering or supplying services thereunder
- c. importing or exporting goods under the trademark
- d. using the sign on business documents and in advertising.

Verbal use of the sign is also considered as use.

§ 14. General conditions of registration

A trademark to be registered shall consist of a sign which is capable of being protected pursuant to Section 2 and capable of being represented graphically. It shall have distinctive character as a sign for the relevant goods or services.

A trademark cannot be registered if it exclusively, or only with insignificant changes or additions, consists of signs or indications that:

- a) indicate the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, the time of production of the goods or of the rendering of the services or other characteristics of the goods or services, or
- b) constitute customary designations for the goods or services according to normal linguistic usage or to loyal, established business practice.

The conditions in paragraphs one and two shall be met on both the date of application and the date of registration. When assessing a proposed trademark pursuant to paragraph one, sentence two, and paragraph two, it is necessary to take into consideration all circumstances that prevailed on the date of application, in particular effects of use of the trademark prior to this time.

A sign that is used in an industrial or commercial undertaking to indicate the geographical origin of goods or services may, without impediment by the provisions in paragraph two, be registered as a collective mark.

15. Trademarks that conflict with public interests

A trademark cannot be registered if it:

- a) is contrary to law or public order or is liable to cause offence,
- b) is liable to deceive, for example in respect of the nature, quality or geographical origin of

the goods or services, or

c) contains, without authorization, escutcheons or another sign covered by Section 328, paragraph one, no. 4, or paragraph two of the Norwegian Penal Code, a national flag or anything that is liable to be understood as such a sign or flag.

For wine and spirits, it is not permissible to register a trademark that consists of or contains anything that is liable to be understood as a geographical indication of origin, unless the geographical origin of the goods is in accordance with the indication.

§ 16. Trademarks that conflict with the rights of others

A trademark cannot be registered without the consent of the relevant proprietor of rights if:

a) use of the trademark would infringe the right of another in this country to a trademark or business name or another business sign,

b) the trademark is liable to be confused with a trademark, business name or other business sign that someone else started to use as a the distinctive sign for goods or services before the applicant and is still using, and the applicant was aware of this use when the application for registration was filed, in such way that the filing shall be considered to have taken place in conflict with honest practices in industrial or commercial matters

c) the trademark contains something that is liable to be perceived as another person's name, stage name or portrait, unless it obviously refers to a person who is long dead,

d) the trademark contains something that is liable to be perceived as the distinctive title of another's protected creative or intellectual work or it infringes another's right in Norway to a creative or intellectual work or a photography or a design, or

e) the trademark infringes another's right in Norway to a designation protected in regulations pursuant to Act no. 6 of 17 June 1932 on Quality Control of Agricultural Goods, etc. or Act no. 124 of 19 December 2003 on Food Production and Food Safety, etc.

§ 26. Opposition

When the registration of a trademark is published, any person may file an opposition to the registration. An opposition shall be filed in writing and shall be received by the Norwegian Industrial Property Office within three months of the date of publication.

The opposition shall include:

a) the name and address of the person filing the opposition

b) a specification of the registration to which the opposition applies

c) the grounds on which the opposition is based

d) necessary documentation of circumstances invoked in support of the opposition.

The opposition shall also meet the requirements set forth by the King in regulations.

When an opposition has been received by the Norwegian Industrial Property Office, it shall be recorded in the Trademark Register and a notice thereof published.

§ 27. Processing of oppositions

If the opposition does not meet the conditions in Section 26, the Norwegian Industrial Property Office shall set a reasonable time limit to comment on it and, if possible, remedy the deficiencies. If the deficiencies are not remedied before the expiry of the time limit, the opposition shall be rejected, unless the Norwegian Industrial Property Office considers that a new time limit should be set for correction.

The trademark proprietor shall be notified of the opposition as soon as possible and be given the opportunity to comment.

If two or more oppositions have been filed to the same registration, the Norwegian Industrial Property Office may join the cases as one case if no reasoned objection to this is made.

The Norwegian Industrial Property Office shall only consider factors that invoked in the opposition. If an opposition is withdrawn, the Norwegian Industrial Property Office may continue the processing of the opposition if there are special reasons for doing so.

§ 28. The right to the trademark

If an appellant requests that the registration of a trademark be transferred to him, the Norwegian Industrial Property Office shall transfer the registration if the right to the trademark is substantiated. In such case, the appellant shall pay a new application fee.

Section 21, paragraphs two to five, shall apply correspondingly.

§ 70. Request for an international trademark registration to take effect in Norway

When the Norwegian Industrial Property Office receives notification from the International Bureau with a request from the proprietor for an international trademark registration to take

effect in Norway, the Norwegian Industrial Property Office shall examine whether the requirements for registration set forth in Sections 14 to 16 are met.

If the requirements for registration are met, the Norwegian Industrial Property Office shall record the international trademark registration in the Trademark Register and publish a notification stating that it has taken effect in Norway.

If the requirements for registration have not been met, the Norwegian Industrial Property Office shall refuse, in full or in part, to grant the international registration effect in Norway. The International Bureau shall be notified of such refusal within 18 months after the Norwegian Industrial Property Office received notification as stated in paragraph one.

In the event of refusal, the proprietor of the international registration may, subject to the requirements set forth in regulations, request that the Norwegian Industrial Property Office's first department reassess whether the international registration is to take effect in Norway.

Section 23 applies correspondingly to the Norwegian Industrial Property Office's processing of a request for an international trademark registration to take effect in Norway. Section 19 applies if the proprietor of the international registration has invoked priority.

§ 71. Opposition

Any person may, within three months after the publication date, file an opposition against an international trademark registration taking effect in Norway. Section 26 applies correspondingly to the filing and publication of oppositions. Sections 27 and 28 apply correspondingly to the processing of oppositions.

If a condition for registration pursuant to Sections 14 to 16 has not been met, the Norwegian Industrial Property Office shall rule that the international registration will not take effect, in full or in part, in Norway if the time limit pursuant to Section 70, paragraph three, sentence two, has not expired, or the Norwegian Industrial Property Office has, within the prescribed period, given the International Bureau notification that an opposition may be filed after the expiry of the time limit and notification of the opposition has been sent within one month after the expiry of the time limit for opposition.

If the conditions for registration have been met, the Norwegian Industrial Property Office shall reject the opposition.

The proprietor of the international registration and the person making the opposition shall be notified of the Norwegian Industrial Property Office's decision in opposition cases. When a final decision has been made in the case, the outcome shall be recorded in the Trademark Register and published.

§ 77. Address for correspondence

Notifications from the Norwegian Industrial Property Office to an applicant, a registration proprietor, an opposing party or a party requesting an administrative review under Section 40 are always considered to have been submitted when they have been sent to the address that the person in question specified most recently to the Norwegian Industrial Property Office. The address is recorded in the Trademark Register. For applicants and trademark proprietors who have a representative, notification may be sent to the representative.

If the registered address proves to be incorrect, the notification or a summary of it, including information that the document is available at the Norwegian Industrial Property Office, shall be included in Norsk Varemerketidende (the Norwegian Trademark Journal),

If service or any other procedural notification cannot be submitted at the registered address or the representative, paragraph two applies correspondingly to a court. In such case, the document shall be considered to have been served or notification to have been given four weeks after publication in Norsk Varemerketidende (the Norwegian Trademark Journal).

If an applicant or registration proprietor has otherwise appointed a representative to represent him in matters concerning the application or registration, the name and address of the representative shall be recorded in the Trademark Register. The same applies if an opposition party or a party requesting an administrative review has appointed a representative to represent him in matters concerning the opposition or the review request.