

# Submission from the Norwegian IP Office to SCT

## *Introduction*

This submission contains of two parts; 1) Grounds of refusal of all types of marks and 2) technical and procedural aspects relating to the registration of certification and collective marks.

## *2. Technical and procedural aspects relating to the registration of certification and collective marks*

### **2.1 Certification marks**

A certification mark certifies the nature of origin of the goods/services to which is has been applied. This includes for example, region or location or origin, materials of construction, method of manufacture, quality assurance, accuracy of the goods/services or any definable characteristic of the goods/services. It can also certify manufacture or provision of services by members of a union or other organization to certain standards.<sup>1</sup>

The Norwegian IP Office does not register certification marks per se.

### **2.2 Collective marks**

A collective trademark is a trademark owned by an organization (such as an association), whose members use it to identify themselves with a level of quality or accuracy, geographical origin, or other characteristics set by the organization. A collective trademark can be used by a variety of traders, rather than just one individual concern, provided that the trader belongs to the association.

The Norwegian IP Office registers collective marks. The Office has a separate register for collective marks.

The term “collective trademarks” is by the Norwegian IP Office used on two quite different types of signs and marks, according to the Collective Marks Act of March 3, 1961 No. 5.

An **association** may by registration gain an exclusive right to a trademark or other sign for its members. This is stated in the Norwegian Collective Marks Act Section 1, first paragraph.

Furthermore, a **public authority, foundation, establishment or another union** which appoints norms or standards for or carries out control with goods or services, may obtain an exclusive right to a trademark or other sign for use of such goods and services for which the norm or standard applies.

### **Example of a collective mark for an association**

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<sup>1</sup> Definition by INTA, see [http://inta.org/index.php?option=com\\_content&task=view&id=179&Itemid=59&getcontent=1](http://inta.org/index.php?option=com_content&task=view&id=179&Itemid=59&getcontent=1)

Consorzio per la Tutela del Formaggio Grana Padano



The Consortium for the Preservation of Grana Padano can grant to firms producing, seasoning or prepackaging cheese products with designation of origin Grana Padano or of quality GRANA PADANO, the right to use the collective mark GRANA PADANO. The right is subject to submittance of a request, after acceptance of compliance of their production with specific requirements set forth in "REGOLAMENTO PER L'USO DEI MARCHI COLLETTIVI DEL CONSORZIO PER LA TUTELA DEL FORMAGGIO GRANA PADANO". The requirements refer to raw materials, processing, production hygienic and sanitary conditions and any other physical-chemical, organoleptic or productive requirement.

Controls and supervision may be carried out whenever deemed suitable by personnel working for the Consortium.

In case of non-fulfilment or infringement of the regulation The Executive Committee of the Consortium shall decide sanctions according to the seriousness of the act. The sanctions can consist of written warning, money sanctions, suspension of the grant, definitive repeal of the grant as well as judicial or administrative court action.

#### **Example of a collective mark for an association**

The collective mark MÜNCHNER BIER (IR 655337) was registered for "beer" in class 32. The holder is Verein Münchener Brauereien e.V., München, Germany. The published Trademark Regulations governing the geographic collective mark Münchner Bier are the following:

##### 1. Trade Mark proprietor

1.1 The Association which owns the Trade Mark bears the name Verein Münchener Brauereien e.V. Munich is the head office, place of jurisdiction and place of performance for claims derived from these regulations.

1.2 According to § 7 of its Statutes, the Association is legally represented by the Chairman and, in his absence, by the Vice-chairman.

1.3 The object of the Association is, among other things, to protect the name Münchner Bier which has a geographic origin and to safeguard trade mark rights at home and abroad.

##### 2. Aim of the trade mark

2.1 The trade mark is to identify Münchner Bier

2.2 The trade mark is to prove that the product identified by it originates from a business located within the municipal boundaries of the city of Munich and complies with the definition of beer (§ 9 Preliminary Beer Law) applicable to the official inspection of foodstuffs.

2.3 According to the certificate from the Munich Chamber of Trade and Industry dated 28.2.1972, the place of origin extends to the municipal boundaries of the city of Munich.

##### 3. Configuration and formation of the trade mark

3.1 The trade mark consists of the words Münchner Bier

3.2 The trade mark is recognized by the RAL as a guarantee of German geographic origin and is administered by it (RAL-RG 0172).

#### 4. Rights attached to the trade mark

4.1. The trade mark proprietor derives rights from registration of the trade mark, in particular in the case of unlawful use or other interference in the trade mark or in use of the trade mark.

#### 5. Authorized users

5.1 Any manufacturer of Münchner Bier which meets the conditions of section 2.2 has the right to use the trade mark.

5.2 Authorized users may use the trade mark only for products which satisfy the conditions for Münchner Bier according to section 2.2. Only with the consent of the Association do traders have the right to use the trade mark for products of the above-mentioned type brought on the market by manufacturers without previous trade mark identification. The Association may refuse or revoke consent if the respective trader does not guarantee or no longer guarantees that he will observe the conditions mentioned in section 2.2

5.3 The trade mark regulations concerning the circle of users may not be amended. The German Patent Office must be advised of amendments to the conditions mentioned in section 2.2. The Association is obliged to backdate the amendment if the German Patent Office or the Federal Cartel Authority considers this necessary to ensure that the authorized user is kept free or owing to a resultant unauthorized restriction to competition.

#### 6. Rights and duties of members

6.1 The trade mark proprietor is entitled and obliged 6.1.1 to monitor compliance with the provisions of these regulations by the authorized users and the use of the trade mark in the uniform design to be established by the Association;

6.1.2 to proceed against any unauthorized or incorrect use of the trade mark and against interference in or infringement of the authorized use of the trade mark;

6.1.3 if appropriate, to register the trade mark as a collective mark or control mark in other states and internationally.

6.2 Trade mark users are obliged

6.2.1 to use the trade mark in compliance with regulations and correctly;

6.2.2 to inform the trade mark proprietor of any use which violates the Law or the regulations;

6.2.3 to do everything in their power to enhance and protect the good reputation of the trade mark, in particular to promote its purpose as a guarantee of geographic origin. If permitted by the Association, the trade mark user is also entitled himself to take legal action against misuse and to claim compensation for damages.

6.3 Trade mark users are responsible for use of the trade mark in identifying their products. The trade mark proprietor, his agencies or authorized representatives are not liable for third parties.

#### 7. Final clause

7.1 The collective mark for Münchner Bier is administered by the RAL as a guarantee of German geographic origin.

7.2 These trade mark regulations are recognized by the RAL.

7.3 The Association is obliged to submit amendments to the trade mark regulations to the RAL for expert comments before advising the German Patent Office in compliance with section 5.3.

#### **Example of a collective mark as a control mark for a public authority**

A collective mark registered for the Directorate for Nature Management (DN) shows a symbol that shall be used on for example public documents relating to the Huntsman's Exam, and only by authorized instructors and those who have passed the mentioned exam.



### **General remarks to collective marks**

The provisions of the Norwegian Trademarks Act apply also to collective marks, to the extent they fit. This means that the provisions for assessing possible likelihood of confusion must apply to the same extent for collective marks as for trademarks. The provisions for use will also apply to collective marks.

There is the same requirement for distinctiveness for collective marks as for trademarks. A collective mark must be distinctive to be registered. However, there is not necessarily the same need to keep certain descriptive terms or words free for the public to use, if all the serious traders in the specific area of business all are members of the same association applying for a collective mark consisting of the term in question.

The most important deviations for collective marks are based on the fact that the collective marks have a different function than trademarks. While a trademark will indicate the origin of the goods or services of a certain trademark holder, the collective mark will indicate the origin of the goods or services to an association or group of traders.

The procedure for registration of collective marks is the same as for trademarks, with two exceptions, namely the fees are somewhat higher and the applicant must submit regulations concerning the use of the mark.

Infringement cases may only be made by the holder of the collective mark, the association, and not by its members. The holder may however claim compensation for damages on behalf of its members.

### **The regulations concerning the use of the mark**

A requirement for collective marks is that regulations for the use of the mark must be submitted.

The regulations shall normally specify:

- The name and seat of the organization
- Information on the members authorized to use the collective mark, including their names, addresses and seats
- The conditions of membership
- The conditions of use of the collective mark

- The prescriptions relating to the control of the use of the collective mark
- The order of proceedings against unauthorized use of the collective trademark.

The main purpose of the regulations is to protect consumers against misleading practices.

### **2.3 Hallmarks**

The Paris Convention Article 6ter also mentions “hallmarks indicating control and warranty [...]”.

A hallmark is an official mark of guaranteed metal content, and is struck on items made of precious metals such as platinum, gold and silver.

The Norwegian IP Office registers hallmarks in the Hallmark Register. A hallmark must not be regarded as a trademark. The provisions of the Norwegian Trademarks Act will not apply here. Consideration must be made to the fact that hallmarks are meant to be struck discreetly onto jewellery and tiny objects.

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