

# 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.

### ***1 Grounds of refusal of all types of marks***

The Norwegian Trademarks Act allows for the acceptance of word marks, figurative marks, combination marks (figurative elements with text), slogans, three-dimensional marks, and non-traditional marks. The non-traditional marks we have encountered so far are sound marks, color marks and moving image marks. There are so far no applications for scent marks, taste marks or tactile marks. Collective marks will be dealt with in 2) below.

We will in the following describe the various grounds of refusal the Norwegian Trademarks Act (of March 3, 1996) set up and give examples from the Norwegian practice; from the Norwegian IP Office, the Board of Appeals or from the courts. The grounds of refusal will relate to all the types of marks the Norwegian Trademarks Act accepts. If not otherwise stated, the examples would be from the Norwegian IP Office.

The grounds of refusal will be examined ex officio by the Office if not otherwise stated below. Regarding the practice of refusals, the Office pays close attention to the practice within EU, in particular to judgments and orders by the Court of First Instance (CFI) and the European Court of Justice (ECJ).

#### **1.1 A trademark may consist of any sign...capable of being represented graphically.**

The Norwegian Trademarks Act Section 1, second paragraph, states that a trademark may consist of any sign which is capable of distinguishing the goods or services of one establishment from those of others, and which is capable of being represented graphically. As examples of graphical representation, the provision states words or combinations of words, including slogans, names, figures and pictures, letters and numerals, and the shape of the goods, their get-up and their packaging.

#### **Example**

The trademark was applied for as a hologram. The application, which is still pending, is refused due to lack of holographic effect in the submitted reproductions.



## 1.2 A trademark must be capable of distinguishing the goods of the holder from those of others

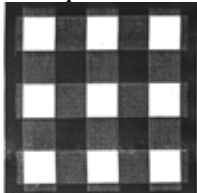
The Norwegian Trademarks Act Section 13, first paragraph, states that a trademark which is to be registered must be capable of distinguishing the goods of the holder from those of others. The trademark may not exclusively, or with no more than minor alterations or additions, indicate the kind, quality, quantity, use, price or geographical origin of the goods or the date of their production. The list is not exhaustive. In deciding whether a trademark has a distinctive character, however, all factual circumstances shall be taken into consideration, in particular how long and how extensively the trademark has been in use.

### Example

The applied for word mark (slogan) **JUST SAIL AWAY** for the classes 36 and 39 (transport services (inter alia; customs clearance, travel insurance, transport) was refused, because it was seen as not capable to function as a commercial origin and the Office meant that there was an overall need to keep the phrase free for all to use.

### Example

The following figurative mark (International registration No 820 409) for the classes 20 and 24 (inter alia; furniture, mattresses, woven textiles) was refused because it was not seen as being able to indicate a commercial origin. The relevant consumers would only see this as an example of the fabric used on the furniture or the textile, and not as someone's trademark.



### Example

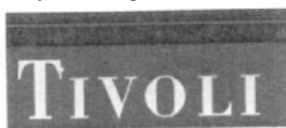
The applied for word mark **CAFÉ COOKIES** for cookies in class 30 was refused registration. The words in English were seen as equal to the words in Norwegian, and descriptive of the goods even if it was argued to be an innovation/new formation of words. The word mark indicates that the goods (cookies) are to be served in a café.

### Example

The word mark **TSI** applied for goods/services in the classes 4, 7, 12 and 37 was refused, because the mark was merely seen as the abbreviation for Turbo Sport Injection, and thus describing central characteristics of all kinds of cars, motors and parts thereof and for inter alia oils.

### Example

The combination mark (figurative and text element) **TIVOLI** applied for services in the class 41 (entertainment and more) was refused registration. The text was seen as describing or indicating the service applied for, and the figurative element was not distinctive enough to carry the registration.



### Example

The word mark **MAGTECH** applied for goods in the classes 9 and 42 was refused registration by the Board of Appeals. The joining of the two words MAG and TECH was not seen as creating a new distinctive expression, and thus merely seen as indication of characteristics of the applied for goods/services.

### **Example**

The following figurative mark applied for goods in class 3 was refused by the Board of Appeals after a post-registration opposition, because it was merely seen as a depiction of toothpaste and thus devoid of distinctiveness.



## **1.3 A trademark must not consist exclusively of the shape of the goods or their packaging**

The Norwegian Trademarks Act Section 13, second paragraph, states that trademarks which consist exclusively of the shape of the goods or their packaging may not be registered if the shape or the packaging results from the nature of the goods themselves, is necessary to obtain a technical result, or imparts considerable value to the goods.

### **Example**

The following three-dimensional mark applied for coffee in class 30 was refused registration as it was seen as consisting exclusively of the goods' packaging.



### **Example**

The following three-dimensional mark applied for goods in the classes 3, 5 and 21, was refused as it was seen as consisting exclusively of the goods' packaging.



## **1.4 A trademark may not be contrary to law or public order or is liable to cause offence**

The Norwegian Trademarks Act Section 14, first paragraph, No. 1, states that a trademark may not be registered if it is contrary to law or public order or is liable to cause offence.

### Examples of contrary to law

If a trademark applied for goods in the classes 3 and 5 contains the word **APOTEK** (Norwegian for “pharmacy”) and the holder is not permitted by the state to operate a pharmacy, the mark will be refused.

The following combination mark **DR. BATZ** (figurative + text element) applied for services in the classes 35 and 42 was refused, because it contains an element that resembles the Red Cross. Per February 2009, case is still pending.



### Examples of contrary to public order or liable to cause offence

We do not have much practice regarding this provision. A typical example here would be refusal of the swastika for all goods and services.

The word mark **MEKKA** (Norwegian for “Mecca”) applied for goods in the classes 29 and 30 (pork meat etc), was refused registration as it would be seen as liable to cause offence for Muslims.



The combination mark was registered for tobacco.

### 1.5 A trademark may not be liable to deceive

The Norwegian Trademarks Act Section 14, first paragraph, No. 2, states that a trademark may not be registered if it is liable to deceive.

The Norwegian IP Office will refuse any trademark liable to deceive or mislead a significant part of the relevant public, in relation to the kind of the goods/services, quality, quantity, use, price, country of origin or nationality.

#### Example

The following combination mark **HOLLAND HOUSE** (figurative + text element) applied for goods in the classes 32 and 33, was refused registration by the Board of Appeals. The applicant was from the United Kingdom, and a significant part of the Norwegian public would be deceived to believe that the goods originate from the Netherlands. The applicant did not specify that the goods in question did come from the Netherlands.



### **Example**

The word mark **BLEND OF AMERICA** applied for goods in class 25 was registered by the Board of Appeals as it was not seen as deceiving the public, but distinctive as it was merely suggesting the origin of the goods. The applicant was from Denmark.

### **Example**

The word mark **SANTOS** applied for goods in the classes 11 and 21 (coffee machines etc) was registered by the Board of Appeals, as it was seen as distinctive for coffee machines and not deceiving the public. The applicant was from Switzerland.

### **Example**

Registration of the word mark **MOZELL** was confirmed by the Norwegian Supreme Court (1995) for all goods in class 32 (like beers, mineral and aerated waters and other non-alcoholic drinks), as the court found that even if the mark might give an association to the valley Mosel in Germany and wine from Mosel, the public would not be deceived.

## **1.6 A trademark may not include official coats of arms, flags, official emblems...**

The Norwegian Trademarks Act Section 14, first paragraph, No. 3, states that without authorization by the competent authorities, a trademark may not include official coats of arms, flags or other official emblems or badges, including official national or foreign certification or hallmarks or stamps required for goods identical with or similar to those for which registration is applied. A trademark may further not include coats of arms, flags or other emblems, abbreviations or designations of intergovernmental organizations, or international marks, seals or signs the unauthorized use of which is forbidden by law. Nor shall the trademark be registered if it includes anything liable to be confused with such emblems or badges, etc.

This provision is based on Article 6ter of the Paris Convention. For a trademark consisting of the Norwegian flag to be registered in Norway, the Ministry of Foreign Affairs must give consent to the use of the flag.

### **Example**

The following combination mark **NORWEGIAN DIVER** (figurative + text element) applied for goods in class 9, was refused registration due to consisting of the Norwegian flag.



### **Example**

The following combination mark **in-water boot Kiel** (figurative + text element) applied for services in the classes 35 and 41, was refused as it was seen as consisting of the European Union flag.



### **1.7 A trademark may not be understood as another person's business name or as another person's name or portrait...**

The Norwegian Trademarks Act Section 14, first paragraph, No. 4, states that a trademark may not be registered if it includes anything liable to be understood as another person's business name or as another person's name or portrait and which obviously does not refer to a person long dead.

#### **Another person's business name**

There is no requirement that there is a likelihood of confusion between the trademark applied for and the business name. It is sufficient that the business name is a part of the mark applied for.

#### **Example**

The collective mark **nye-sko** (figurative + text element) applied for goods in class 25 (shoes etc) was confirmed registrable by the Board of Appeals in spite of opposition from the business name NYE SKO AS. The text "nye sko" was disclaimed as it means "new shoes" in Norwegian. The Board of Appeals stated that the relevant public would not see the text as another's business name, but merely descriptive of the goods concerned.



#### **Another person's name or portrait and which obviously does not refer to a person long dead**

The Norwegian Personal Names Act states that a family name with less than 200 carriers is protected. If such a name is applied for as a trademark and the applicant is not a carrier himself nor has consent for registration by a carrier, the trademark will be refused registration.

The time perspective of a person long dead is uncertain, but 50 years could be an indicator.

#### **Example**

The combination mark **Blue REBEL JAMES DEAN** (figurative + text element) applied for goods in class 25, was confirmed registrable by the Board of Appeals in spite of opposition to the use of James Dean from successors of James Dean's family. James Dean was considered to be a person long dead (he died September 1955). The use of James Dean for clothes could also indicate style of clothes (t-shirts and jeans).



### **1.8 A trademark may not be liable to be understood as the distinguishing title of the protected artistic, literary or musical work of another person...**

The Norwegian Trademarks Act Section 14, first paragraph, No. 5, states that a trademark may not include anything liable to be understood as the distinguishing title of the protected artistic, literary or musical work of another person, or infringes the copyright to such a work or the photography or design rights of another person.

This ground of refusal will most likely be applicable during the post-opposition phase and not commented on by the Office ex officio.

#### **Example**

The word mark **NO LOGO** was registered for "telecommunication-services" in class 38. The Office stated in the post-opposition case that the question is whether **NO LOGO** is liable to be understood as the distinguishing title of a protected work, namely the book "No Logo" by Naomi Klein. The Office decided that the word mark **NO LOGO** would be able to indicate the commercial origin of telecommunication-services, and would not be understood as the distinguishing title of the protected work of another person.

#### **Example**

The word mark **PEER GYNT** was registered for knitting yarn in class 23 and knitted clothes in class 25. It was refused registration for entertainment-services (class 41), because Peer Gynt is the title of and character from a famous Henrik Ibsen play. The Office stated that even though Peer Gynt is part of the public domain, since Henrik Ibsen died more than 70 years ago, it should still be kept free and available for all to use for entertainment-services (theaters, plays, films, etc).

#### **Example**

The word marks **DONALD DUCK** and **MICKEY MOUSE**, applied by Disney Enterprises Inc., are however registered for goods in the classes 3, 14, 18 and 20.

### **1.9 A trademark may not be liable to be confused with the name or business name of another person or with a trademark registered for another person**

The Norwegian Trademarks Act Section 14 first paragraph, No. 6, states that a trademark may not be liable to be confused with the name or business name of another person or with a trademark registered for another person in accordance with an application filed earlier, or which was established by use for another person at the time when the application for registration was filed. A trademark registered for another person includes national and international trademark registrations (Section 14, first paragraph, No. 8).

The Office does not ex officio search the Business Name Register.

The Office will perform an overall assessment of the earlier protected trademark and the trademark application in question, taking into account the similarity between the goods and services of both marks and the similarity between the signs.

### Example

The word mark **NORDIC COOL** was refused because of a prior trademark registration for the word mark **COOL**. Both marks were for identical services in the classes 35 and 41.

### Example

The combination mark **DAVID BITTON BUFFALO** was refused because of a prior trademark registration for the combination mark **BUFFALO**. Both marks were for identical goods in the classes 14, 18 and 25.



### Example

The combination mark **MAGISK KRAFT** (figurative + text element) was not considered to be confusingly similar with the prior trademark registration word mark **KRAFT**. **MAGISK** meaning “magic” in English and **KRAFT** meaning “force” or “power” in English. Both marks were for identical goods in the classes 29-31.



### Example

The following combination marks **TAPAS** were not seen as likely to be confused with prior registration combination mark **TAPAS**, both for identical goods in class 29 (pickles and olives) as **TAPAS** was seen as descriptive for the goods concerned.



## 1.9 Bad faith...

The Trademarks Act Section 14, first paragraph, No. 7, states that a trademark may not be registered if it is liable to be confused with a trademark which someone else has started to use before the applicant, and the applicant was aware of this use when he filed his application for registration.

This subparagraph will only be applicable during the opposition phase, as the Office does not examine for bad faith ex officio.

For the grounds of refusal mentioned in 1.7 to 1.9 above, a registration is possible if the holder of the prior right gives his consent to the registration.

### **1.10 Geographical indications...**

The Norwegian Trademarks Act Section 14, third paragraph, states that trademarks which consist of or contain geographical indications with respect to wine or spirits may not be registered for wine and spirits, unless the product has the geographical origin the indication indicates.

In order for a trademark consisting of for example the word “Champagne” to be registered, the holder must come from the Champagne region and the list of goods must specify that it concerns “wine originating from the Champagne, France”.

#### **Example**

Bismarck Premium Brands GmbH, Germany, has applied for the word mark **MISS TEQUILA** for “alcoholic beverages, namely tequila” in class 33. This mark is refused because the trademark consist of a geographical indication with respect to wine or spirits. Per February 2009, the case is still pending.