

Submission from the Norwegian Patent Office relating to opposition procedures

Here follows an overview of the Norwegian trademark opposition system, with information on entitlement to file opposition, grounds for opposition, and how opposition-cases are examined and evaluated in the office.

1. Overview

The Norwegian Patent Office has a post-registration opposition system. This means that all formal oppositions are launched after the examination and registration.

The examination that takes place before registration and opposition, regards both absolute and relative grounds.

Anyone can file an opposition with office, and all opposition-cases are examined and evaluated in the office, by legal examiners.

We also have a system where anyone may file an *objection* at any stage before registration. These objections are not treated as formal oppositions, but merely as part of the grounds for the examiner's decision.

National applicants are given the opportunity to file a reply to such an objection, but in international cases the objection is not communicated to the International Bureau, and hence the holder of an international registration is not given the same opportunity. If an opposition is later filed, this will of course be sent to the holder and the International Bureau.

Besides the opposition procedures, anyone may also object to a trademark registration through cancellation or invalidation procedures. These procedures fall outside this orientation of the Norwegian opposition system.

Any decision resulting from the opposition procedures may be brought before the Board of Appeals, and to the courts from there.

2. Grounds for opposition

2.1. Absolute grounds

The Norwegian Trademark Act states that oppositions may be filed by anyone, and there are no restrictions as to what grounds the opposition should be based upon. That means that the opposing party may claim that the applicant's trademark doesn't comply with the definition of trademarks, that it is descriptive, generic or lacks distinctiveness, or that a three dimensional mark consists of functional elements. Oppositions may also be based on a claim that a given mark is contrary to morality or public order, that it deceives the public, or that it contains protected signs or emblems or national flags.

2.2. Relative grounds

An opposition may also be based on prior rights, both identical marks registered or applied for in respect of identical goods and services, and similar marks registered or applied for in respect of similar goods and services. For well-known marks oppositions may also be based on identical or similar marks in respect of goods and services that are *not similar* if use of the mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark.

Industrial designs and copyrights as well as names of famous people and protected surnames may also constitute relative grounds for opposition.

3 Procedural aspects

3.1 Publication and entitlement to file

In Norway, registered marks are published in our electronic weekly Gazette on the Internet. The publication date marks the beginning of the opposition period. Under the Norwegian Trademark Act any physical or legal person (company, association etc.) may file an opposition - there is no requirement for legitimate interest or likelihood of damaged interests.

3.2. Opposition period

The opposition period today is two months, but in the proposition for the new Trademark Act, which is expected to enter into force sometime in the second half of 2007, the proposed opposition period is prolonged to three months.

3.3 Arguments and evidence

There is also no requirement for evidence for the opposition to be registered at the office. It is sufficient to state the relevant grounds even if some kind of evidence is normally included. The opposition is then communicated to the applicant, who is given a three months time limit to file a reply or any counter statements along with relevant evidence. This reply is then communicated to the opposing party who is also given a three months time limit. This exchange of briefs continues until the case is adequately examined. Evidence is limited to written material (and in some cases objects or sounds). The role of the office at this stage to act as a mail-office, by sending documents from one party to the other. The office does not offer settlement talks, as they very frequently take place between the parties anyway.

It is possible for one party to have extension of time limits to reply to the other party. When the office sends a confirmation to the party requesting the extension, a copy is always sent to the other party. This way, both – or all – parties concerned are aware of any given extension of time limits.

3.4 Decisions

The decision is made, based on all the available evidence, by a board consisting of two or more legal examiners. One legal examiner will be responsible for the case, with a senior examiner or a Head of section co-signing the decision.

For oppositions based on relative grounds (by far the most frequent), the most important factors are aural, visual and conceptual similarities, similarity between the goods and services, and the use of the earlier mark.

3.5. Costs

There is no fee payable to file an opposition today. The office, unlike the courts, does not have the power to award costs to the winning party.

3.6 Final decision

There is no set time limit for the office to reach a final decision. However, once the case is adequately examined, the parties are notified that a final decision will be reached within a given time limit. The limit varies slightly with the Office's resources and caseload, but today (January 2007) it is three months. The result of the final decision is published in the Gazette within one week from the notification of the parties.

3.7 Appeal

The parties will have a two months time limit to appeal the decision to the Board of Appeals. The time limit runs from the date of the decision.

A decision by the Board of Appeals may be appealed to the courts within a two months time limit. This time limit also runs from the date of the decision.

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