

Country correspondents

The Country correspondents section of *World Trademark Review* is a feature in which leading firms from countries across the globe take a detailed look at a specific topic affecting trademark owners

Trademark prosecution and registration strategies

In this issue the correspondents consider key trademark prosecution and registration strategies in their respective jurisdictions

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Norway

Despite not being part of the European Union, Norway's registration procedures are, for the most part, aligned with those in place across Europe. However, there are some differences so rights holders must plan their filing strategies with care

Protection in Norway

Trademarks may be registered within individual countries across the whole of the European Union by means of a Community trademark (CTM) or as an international trademark registration. Norway is not a member of the European Union. Consequently, a CTM has no effect in Norway and foreign applicants wanting to obtain trademark protection in Norway must file a separate application with the Norwegian Industrial Property Office (NIPO) or designate Norway in an international trademark registration.

However, registration practices in Norway do generally comply with those in place in the rest of Europe, as Norway is a member of the European Economic Area (EEA) and obliged to harmonize its trademark laws with the Trademarks Directive (2008/95/EC), ensuring the homogeneity of the internal market. Foreign applicants should, therefore, to a great extent, meet with the same substantive trademark law in Norway as elsewhere in Europe and can use the same kind of arguments before NIPO as before the Office for Harmonization in the Internal Market (OHIM) and/or national IP offices in EU countries.

Norway and EU law

Decisions from the European Court of Justice (ECJ) regarding the interpretation of the Trademarks Directive carry considerable weight in proceedings before a Norwegian court. Decisions from EU organs, including the Court of First Instance (CFI) and OHIM, on issues relating to the Community Trademark Regulation (40/94) should also be taken into account by Norwegian courts to the extent they are relevant for the interpretation of the Trademarks Directive. This was confirmed by the Supreme Court in its *God Morgon* decision (Case HR-2001-01049). The case concerned whether the expression GOD MORGON (meaning 'good

morning') could be registered as a trademark for orange juice. The Supreme Court carried out an extensive examination of the relevant decisions from EU bodies and concluded, contrary to NIPO's Board of Appeal, that the expression GOD MORGON was distinctive for orange juice. It therefore accepted the mark for registration.

The Supreme Court also attached great importance to EU law in a recent case between two insurance companies concerning the right to use a red and white lifebuoy as a trademark (Case HR-2006-01978). The Supreme Court found that mere knowledge of prior use did not necessarily mean that the applicant had registered its own marks in bad faith. The Supreme Court held that the Norwegian Trademark Act had to be construed in accordance with established EU law with regard to bad-faith registration under both the Community Trademark Regulation and the Trademarks Directive. In doing so, the Supreme Court deviated from its previous case law.

NIPO will also attach weight to decisions from the ECJ and the CFI when it exercises its discretion in each individual case according to law and principles laid down by case law. Thus, registration practice will to a large extent be in conformity with EU law, but there may be delays in implementation.

Requirements for protection

Trademark protection is obtained in Norway by registration or through use. Under the Trademark Act, to obtain protection through use, the trademark must be "well known within the circle of trade concerned in this country as a distinctive sign for someone's goods". To be eligible for registration in Norway, the mark must, in accordance with the Trademarks Directive, consist of graphical signs that are capable of distinguishing goods or services. These signs can be words or combinations of words, including slogans, names, figures and pictures, letters and numerals, the shape of the goods, their get-up and their packaging (three-dimensional signs). The mark can also be a collective mark – a mark that is capable of distinguishing the goods or services of members and associations.

Unless the mark has acquired distinctive meaning through prior use, it cannot consist exclusively of the characteristics, or designate the nature, quality or geographical origin, of the goods or services applied for.

When assessing applications for three-dimensional signs, for instance, Norwegian courts and NIPO will attach weight to established case law from the ECJ. Thus, three-dimensional trademarks should be made up of shapes which are very different from the standard shapes used in the relevant industry, in order to be eligible for registration in Norway. Purely functional designs cannot be protected

Prosecution strategies – first steps

A trademark registration in Norway may be filed through a separate national registration or through an international registration via the Madrid Protocol. In 2007, 3,286 national registrations were filed by foreign entities directly with NIPO against 3,326 by nationals and 9,391 through the Madrid Protocol.

As a general rule, an applicant not residing in or having its principal place of business in Norway, must have a representative domiciled in Norway who can file the application and communicate with NIPO on its behalf.

Prior to filing a national trademark application or designating Norway in an international trademark registration, it may be of interest to order a report on the likely outcome of the application in advance of filing. NIPO will provide such report within a timeframe of 24 hours to five days. This is contrary to the practice of most IP offices, which prefer not to perform an investigation before the application is filed to avoid any issues that might arise should the final decision differ. However, it should be noted that the review is not binding upon NIPO.

When drawing up a national application, an important strategic issue to take into account is the breadth of the list of goods and/or services. In Norway, it is possible to apply for goods and services exceeding the explicit range of immediate use. This may be preferable if the applicant has not yet decided what the trademark will be used for.

In principle, you can register a trademark in 45 full classes in Norway. The opportunity to file a wide list of goods and/or services differs from many other countries (including, for instance, the United States), which require the application to cover only the exact goods and services in relation to which the mark will be used. However, one should note that a mark must be put to use within five years from registration, in accordance with the directive. It is possible to limit the list of goods during the registration process but not to extend it. In any case, filing for registration in three classes may be preferable taking into account that the basic fee of Nkr2,300/€230 includes three classes. For every additional class over that, the charge is Nkr650/€75.

When NIPO receives notification from the World Intellectual Property Organization (WIPO) about an international trademark registration designating Norway, NIPO will check to see whether there are any obstacles to registration in Norway. If there are, NIPO shall within 18 months inform WIPO by giving a provisional refusal according to Rule 17 of the Madrid Regulations. If NIPO does not meet this time limit, the designation will automatically be valid in Norway.

The average registration period for a straightforward national application is between three and six months. A trademark registration from NIPO is valid for 10 years and can be renewed an unlimited number of times.

Prosecution strategies – opposition

A trademark cannot be opposed until *after* it is accepted for registration. An opposition may be filed by “anyone” within two months of the publication date of the registration. Use of the term ‘anyone’ means that the opponent is not required to have any legal interest in the opposition. In 2007, 206 oppositions were raised, 138 against national registrations and 68 against international registrations. There is no fee to file an opposition.

If an objection is put forward *before* the registration is published in the Norwegian Trademark Register (on the basis of the public registration procedure), the objection will be seen only as a protest, not an opposition. The person objecting will not be given full rights as a party or rights of appeal, nor will that person automatically receive copies of correspondence.

Oppositions must be based on the fact that the trademark registration is contrary to the conditions for registration in the Trademark Act (absolute and relative grounds). The opposition must be based on



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specific grounds, but on some occasions an extension of one month will be granted to allow the opponent to produce further documentation supporting the opposition. If the opposition does not fulfil the stated requirements, it will be rejected. However, such rejection may be appealed to NIPO's Board of Appeal. It is not possible to resume the case if the time limit for opposition is exceeded. Nevertheless, an objector exceeding the time limit may still have the opportunity to file a cancellation action before the court.

NIPO's decisions may be appealed to the Board of Appeal by the applicant or the losing party in an opposition case within two months subject to the payment of a fee (Nkr2,600/€298). The proceedings are, as a rule, written proceedings, but NIPO may decide to hold an oral hearing. An oral hearing may, for instance, be relevant if one needs to demonstrate that a mark is established by use in Norway.

Rulings made by the Board of Appeal denying or annulling a registration or upholding an annulment by NIPO may be brought before the Oslo City Court within two months of the decision. Proceedings to cancel a registered trademark must be brought before the Oslo City Court. However, if both parties agree, cancellation cases may be tried by the Board of Appeal acting as an arbitration tribunal. [WTR](#)