

TRADEMARK REGULATIONS

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Royal Decree of March 29, 1996

pursuant to Act No. 4 of March 3, 1961 concerning Trademarks, sections 16, 17, 18, 29, 30, 31, 47, 50, 52, 59 and 62 and Act No. 5 of March 3, 1961 concerning Collective Marks, sections 2 and 8.

Amended by Royal Decree of December 20, 1996

pursuant to the Trademarks Act, sections 29 and 62 and the Collective Marks Act, section 8.

Presented by the Norwegian Ministry of Justice ¹

Chapter 1. Introduction ➡

Section 1

The provisions in these regulations with respect to trademarks apply also to collective marks where nothing to the contrary is stated or is evident from the context. The provisions with respect to goods apply also to services where nothing to the contrary is stated or is evident from the context.

Chapter 2. Filing National Trademark Applications, etc. ➡

Section 2

Application for registration of a trademark shall be filed in writing with the Norwegian Patent Office, cf. section 17, first paragraph, first period, of the Trademarks Act.

The application shall be drawn up in the Norwegian language unless the Patent Office in individual cases accepts that the application is wholly or partly in another language. The Patent Office may require that appendices which are not in Norwegian be accompanied by a translation into Norwegian. Certification of the translation by a government-authorized translator or in some other manner acceptable to the Patent Office may be required.

Section 3

The application shall be signed by the applicant or his representative and contain:

- 1) a reproduction of the trademark;
- 2) the applicant's business name or name, and also the name of his representative, if any;
- 3) a list of the goods and the respective classes of goods in respect of which registration of the mark is sought;

If the applicant wishes the mark to be perceived as a word mark in standard letters or as a three-dimensional mark (product get-up or the like), this must be stated in the application.

If the application concerns a letter mark, or number mark or a word mark of a characteristic shape or a device mark, illustrations of the mark shall be submitted as appendices to the application.

In an application for the registration of a collective mark, the provisions stipulated for the use of the mark must be enclosed as appendices.

Section 4

Section 5

Registration may not be applied for more than one trademark in one and the same application.

Section 6

The Patent Office shall allocate all applications filed, cf. section 17, second paragraph of the Trademarks Act, an application number.

Section 7

The Patent Office shall keep a journal of all applications filed. The journal shall be available to the public.

Section 8

The Patent Office may provide further provisions with respect to:

- 1) classification of goods into classes of goods;
- 2) the application and the information it shall contain;

3) the obligation of the person acting as representative to enclose with the application confirmation of his representation of the applicant;

4) other appendices which shall be enclosed with the application, and the information

these appendices shall contain; and

5) the journal of all applications filed.

Chapter 3. Priority, etc. ➔

Section 9

The provisions concerning exhibition priority in section 18, first paragraph of the Trademarks Act apply correspondingly in the case of international exhibitions held in a State which has acceded to the Paris Convention for the Protection of Industrial Property or the Agreement establishing the World Trade Organization.

The claim of exhibition priority from an international exhibition in this country or from an international exhibition as mentioned in the first paragraph, shall be included in the application for registration of a trademark, or shall be filed in writing with the Patent Office no later than within in two months after the filing date of the application. This claim shall be accompanied by information with respect to:

1) the international exhibition at which the trademark was first used for the goods displayed; and

2) the date of the opening of the exhibition and of the first display of the goods at the exhibition.

Anyone who wishes to claim exhibition priority shall file evidence of priority within two months after the claim thereof has been submitted to the Patent Office. Acceptable as evidence of priority is a statement from the management responsible for the exhibition to the effect that the exhibition is international, provided the statement also contains particulars with regard to the date of the opening of the exhibition and of the first display of the goods at the exhibition.

The applicant's right to exhibition priority lapses if the conditions in the second and third paragraphs are not fulfilled.

Section 10

Application priority as mentioned in section 30, first paragraph, of the Trademarks Act, may be claimed pursuant to the Paris Convention, Article 4, on the basis of the first application for registration of the mark which is filed in a State party to the Paris Convention for the Protection of Industrial Property or the Convention establishing of the World Trade Organization, provided that an application for registration of the mark is filed in Norway within six months after the filing of the first application.

The claim of application priority shall be included in the application or filed in writing with the

Patent Office no later than within two months after the application for registration of the trademark has been filed in Norway. The claim shall be accompanied by information with respect to

- 1) the State in which registration of the mark was first sought;
- 2) the filing date of the first application; and
- 3) the application number of this application, if known.

If the application number referred to in item 3 is not known when the claim of application priority is filed, information with respect to the number must be submitted to the Patent Office as soon as the applicant becomes cognizant thereof.

Anyone claiming application priority shall file evidence of priority within two months after receiving a request therefore from the Patent Office. Acceptable as evidence of priority is a copy of the first application which has been filed in the State concerned, provided that the registration authorities in that State have furnished the copy with

- 1) confirmation that the copy is in conformity with the application first filed in the state in question; and
- 2) confirmation of the filing date of the application in the state concerned.

The applicant's right to application priority lapses if the conditions in the second and third paragraphs are not fulfilled.

Section 11

On the conditions referred to in the Paris Convention, Article 6quinquies, the applicant may request that a trademark be registered in this country in the same manner as the mark has been registered in a foreign State party to the Paris Convention on the Protection of Industrial Property or the Agreement establishing the World Trade Organization ("telle-quelle" registration), cf. section 29 of the Trademarks Act. Requests for registration of this kind must be included in the application or submitted in writing to the Patent Office within two months after the application for registration of the trademark has been filed with the Patent Office. Evidence of registration of the mark in the foreign State shall be enclosed with the request. Acceptable as evidence is a copy of the certificate of registration in the foreign state, provided that the correctness of the copy has been certified by the registration authorities of the State concerned.

Section 12

A claim of priority pursuant to section 57 of the Trademarks Act must be included in the application for registration of the trademark in this country or submitted in writing to the Patent Office no later than two months after the filing date of the application. In the request reference shall be made to the international registration which has ceased.

Chapter 4. Division of Applications ➔

Section 13

The applicant may request in writing that the Patent Office should divide the application into two or more new applications. The request shall contain details as to which goods and respective classes of goods each of the new applications shall cover. The applicant shall state in the request which of the new applications shall be considered as a pursuance of the original application.

The request shall be accompanied by a new application fee for each new application which is not considered to be a pursuance of the original application.

Section 14

After the division, none of the applications may cover goods which were not covered by the original application prior to the division. After division, the applications may not cover the same goods.

Section 15

The request for division shall be refused if the conditions in sections 13 and 14 are not fulfilled, or if the Patent Office otherwise finds that a division will result in doubt as to the scope of one of the applications.

Section 16

If the Patent Office finds no obstacle to granting the applicant's request for division, the request shall be granted.

The application considered as a pursuance of the original application, cf. section 13, retains the application number allocated to the original application. New applications, not considered to be a pursuance of the original application, shall each be allocated their own new application number.

The new applications retain the priority of the original application.

Section 17

The Patent Office may provide detailed provisions with respect to the extent to which the applicant shall file a copy of documents which previously have been filed as a part of or appendix to the original application.

Chapter 5. Exceptions from Legal Protection ➔

Section 18

If the Patent Office finds that on registration of a trademark it should be stated explicitly in a disclaimer that a part of the mark shall be excepted from legal protection, cf. section 15, second paragraph, of the Trademarks Act, the applicant shall be notified of the wording of the disclaimer and granted a time limit in which to submit his observations.

If the applicant is opposed to such a disclaimer, the Patent Office may refuse the application for registration of the trademark.

Chapter 6. Oppositions ➔

Section 19

A notice of opposition pursuant to section 21 of the Trademarks Act shall be filed in writing in triplicate and shall contain details with respect to:

- 1) the opponent's name and address, and also the name and address of the representative, if any;
- 2) the number of the registration to which an opposition is lodged, and
- 3) a statement of the grounds on which the opponent believes the registration must be cancelled.

In special cases as referred to in section 21, first paragraph, third period, of the Trademarks Act, the Patent Office may grant the opponent an additional time limit of up to one month in which to file additional documentation in support of the opposition.

Section 20

The Patent Office may provide detailed provisions with respect to the obligation of anyone acting as representative to enclose with the opposition confirmation of their representation of the opponent.

Section 21

The Patent Office shall reject the opposition if the conditions stipulated in or pursuant to section 19, first paragraph, and section 20 are not fulfilled.

Section 22

If the Patent Office does not find it obvious that the opposition shall be rejected pursuant to section 21a, second paragraph, of the Trademarks Act, the Patent Office shall send two copies of the opposition to the holder of the registration with an invitation to file observations in reply within a fixed period.

If the holder responds, the Patent Office shall decide whether further correspondence between the parties is necessary.

The response and any subsequent communications shall be filed in triplicate.

Section 23

The opposition proceedings may in cases referred to in section 21, fifth paragraph, of the Trademarks Act only be continued if the Patent Office notifies the holder of the registration thereof within two weeks after the Patent Office received notice of withdrawal of the opposition.

Chapter 7. Alterations and Expunction from the Trademark Register ➡

Section 24

An application for alteration of a registered trademark pursuant to section 24 of the Trademarks Act shall be submitted in writing and contain:

- 1) the name and address of the holder, and also the name and address of his representative, if any;
- 2) the registration number of the trademark it is sought to alter;
- 3) the alteration of the trademark which it is desired to have effected; and
- 4) a reproduction of the mark in its changed form.

The application shall be signed by the holder or his representative.

Section 25

A request from the holder for the expunction of a trademark from the Register, cf. section 27, second paragraph, of the Trademarks Act, shall be filed in writing with the Patent Office and shall state the number of the registration which it is desired to have expunged. The request shall be signed by the holder himself or by an representative to whom the applicant has given a special power of attorney to apply for expunction.

Section 26

The holder may request a limitation of the list of goods in respect of which the mark is registered. The request shall be filed in writing with the Patent Office and shall state the registration number and the goods the holder no longer wishes the registration to cover. Section 25, second paragraph, applies correspondingly.

Section 27

A request for expunction of the registration of a trademark pursuant to section 26 of the Trademarks Act shall be submitted in writing to the Patent Office and shall state the registration number of the trademark. The request should provide as to the circumstances on which the request is based.

Section 28

Requests pursuant to section 33 of the Trademarks Act with respect to recordals in the Trademark Register of the transfer of a registered trademark shall be submitted in writing to the Patent Office. The Patent Office may issue regulations stipulating further provisions with respect to the formulation and content of the request and also a request for evidence that the transfer has taken place.

If a recordal is made as referred to in the first paragraph, notice thereof shall be published.

Section 29

Section 28 applies correspondingly to requests for recordals in the Trademark Register:

- 1) regarding license for a registered trademark, cf. section 34 of the Trademarks Act;
- 2) regarding change of name of the registration holder or licensee; and
- 3) regarding change of representative.

Chapter 8. Applications for International Trademark Registrations ➔

Section 30

Applications for international registration of a trademark on the basis of a Norwegian trademark application (basic application) or a Norwegian trademark registration (basic registration), cf. section 46 of the Trademarks Act, shall be filed with the Patent Office.

Section 31

The application shall be drawn up in the English language and shall be filed in writing in one copy using the International Bureau's application form. The form shall be completed in type. The list of goods shall be in English.

Moreover, the application shall fulfill the requirements of section 47 of the Trademarks Act and Regulations under the Madrid Protocol (Madrid Regulations), Rule 9(4) and 6(a) (i) to (vi) and (d).

Section 32

The application may be based on several registrations or applications if the mark is the same, the applicant is the same and all the goods listed in the application are covered by the list of goods in one or more of the basic applications or basic registrations.

Section 33

Section 34

If the Patent Office, after processing the application pursuant to section 48 of the Trademarks Act, accepts the application, the Patent Offices shall proceed with the application to the International Bureau as prescribed in the Madrid Protocol and the Madrid Regulations.

In the case of basic registrations, it shall be recorded in the Trademark Register that the registration is the basis for an international registration application. In the case of basic applications, it shall be recorded in the journal referred to in section 7 that the application is the basis of an application for international registration.

Section 35

In addition, the Patent Office shall furnish the International Bureau with the information that the Norwegian trademark authorities are obliged to provide pursuant to the Madrid Protocol and the Madrid Regulations.

Chapter 9. Designation of Norway in International Trademark Registrations ➔

Section 36

Section 37

If the Patent Office receives notification from the International Bureau that the holder of an international registration of a trademark which is not based on a Norwegian registration or application has requested that the international registration of the mark shall also be valid in Norway (has designated Norway), the Patent Office shall check to see whether there is any obstacle to the registration which may apply in Norway. Information with respect to the designation must be entered in the journal referred to in section 7.

If there is any obstacle to the registration being valid wholly or in part in Norway, the Patent Office shall at the latest within 18 months, reckoned from the dispatch of the notification of the designation of Norway from the International Bureau, inform the Bureau as prescribed in the Madrid Protocol and the Madrid Regulations of the decision that the registration wholly or in part shall not be valid in Norway.

In the notification pursuant to the second paragraph, it shall be stated that the holder of the international registration may request a review of the question of the validity of the international registration in Norway. The holder shall be granted an equitable time limit in which to request this and to refute or remedy the obstacle. Section 19, third and fourth paragraphs of the Trademarks Act apply correspondingly. Regarding the obligation of the holder to have an representative having his residence or principal place of business in this country during the review, section 31, first paragraph, of the Trademarks Act applies correspondingly.

Section 38

If the Patent Office finds, after a review pursuant to section 37, third paragraph, that there is no obstacle to the validity of the international registration in Norway, it shall be recorded in the Trademark Register and notice of the validity of the international application in Norway shall be published. The list of goods must be recorded in the Register in English, and in the published notice mention must be made of the classes of goods to which the goods belong.

Section 39

Regarding oppositions to the validity of an international registration in Norway, in addition to section 52, first paragraph, of the Trademarks Act, the rules in sections 21 and 21a and the regulations in Chapter 6 herein apply correspondingly, with the adjustments resulting from the second and third paragraphs.

If an opposition is withdrawn, the opposition proceedings may only continue if there are special reasons therefore and notification of the decision that the registration shall not be valid in Norway moreover can be given to the International Bureau within the 18-month time limit referred to in section 37, second paragraph.

Once the 18-month time limit referred to in section 37, second paragraph, has expired, a decision that the registration shall not be valid in Norway cannot be based on grounds other than those stated in the opposition.

Regarding the obligation of the holder to have an representative having his residence or principal place of business in this country during the processing of the opposition, section 31, first paragraph of the Trademarks Act applies correspondingly.

The Patent Office shall inform the International Bureau to the extent necessary that owing to oppositions the decision that the registration shall not be valid in Norway, cf. the Madrid Protocol, Article 5(2)(c), may not be taken until after the 18-month time limit referred to in section 37, second paragraph, has expired.

Section 40

The provisions in section 31 of the Trademarks Act with respect to the obligation to have an representative having his residence or principal place of business in this country apply to international applications only to the extent stipulated in the regulation in section 37, third paragraph, fourth period, and in section 39, fourth paragraph, and also on appeal to the second instance department of the Patent Office (the Board of Appeals).

Section 41

The Patent Office shall also furnish the International Bureau with the information that the Norwegian trademark authorities are obliged to provide pursuant to the Madrid Protocol and the Madrid Regulations.

Chapter 10. Miscellaneous Provisions ➔

Section 53

The Patent Office may issue regulations stipulating further provisions with regard to

- 1) certificates of registration;
- 2) the Trademark Register;
- 3) requests for renewal of trademark registrations;
- 4) notices which shall be published pursuant to the Trademarks Act or these Regulations;
- 5) the calculation of time limits; and
- 6) the implementation of the Trademarks Act and these Regulations in other respects.

Section 54

These Regulations come into force on April 1, 1996.

From that date the following are repealed: the Regulations No. 9911 of August 4, 1961

concerning Applications for Registration, etc. of Trademarks and Collective Marks, the Prince Regent's Decree of November 19, 1971 concerning the delegation of the authority pursuant to the section 16 of Act No. 4 of March 3, 1961 concerning Trademarks to determine the classification of goods and services to the Patent Office, and Royal Decree of October 7, 1977 relating to the delegation of authority pursuant to section 43 of Act No. 3 of March 4, 1961 concerning Trademarks to determine further provisions regarding the content of applications for registration of trademarks submitted the Patent Office. Provisions laid down by the Patent Office in accordance with the Prince Regent's Decree of November 19, 1971 and Royal Decree of October 7, 1977 shall continue to be in force until the Patent Office repeals them, cf. section 8, first and second paragraphs, of these Regulations.

Applications for registration of trademarks and collective marks where the decision to lay them open to public inspection was taken prior to April 1, 1996 shall be processed to completion according to the rules of procedure that were valid until April 1, 1996.

In the case of applications filed prior to 1 April 1996, but which shall nevertheless be processed according to these Regulations,, the claims of exhibition or application priority or of "telle-quelle" registration, cf. sections 9 and 11, must be made before the mark is registered and at the latest by October 1, 1996.

1: This is a translation of the Regulations to the Norwegian Trademarks Act.

Should there be any differences between this translation and the authentic Norwegian text, the decision will be made on the basis of the authentic Norwegian text.

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