

## Trademark Regulations

*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.*

*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*

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### 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 national registration of a trademark shall be filed in writing with the Norwegian Industrial Property Office using the special application form, cf. section 17, first paragraph, first period, of the Trademarks Act.

Requirements in the Trademarks Act and these regulations regarding in writing can be met by electronic filing in accordance with section 1, fifth paragraph in the Regulations of fees etc. for the Norwegian Industrial Property Office of April 11, 2003 No. 456. Requirements of filing documents in several copies do not apply to electronic filing.

When filing electronically by fax or by other manner not in accordance with section 1, fifth paragraph of said regulations, the original must be filed within one month after the electronic filing. The document will otherwise not be deemed as filed.

#### **Section 2a**

The application with enclosures as mentioned in section 3, shall be drawn up in the Norwegian language. The following correspondence may also be in the Danish or Swedish language.

The Norwegian Industrial Property Office may always require that documents not filed in Norwegian be translated. The Norwegian Industrial Property Office may require that the translation be confirmed by a government-authorized translator or in some other manner acceptable to the Norwegian Industrial Property Office.

The Norwegian Industrial Property Office may in an individual case accept other language than mentioned in the first paragraph.

#### **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;

It shall be stated in the application form which type of mark it is applied for, for example if it is a word mark, a figurative mark, a combined mark, a three-dimensional mark or other mark in accordance with section 1 of the Trademarks Act. It shall also be stated if the mark is in colours.

If the application concerns a figurative mark, a combined mark or a three-dimensional mark, reproductions of the mark shall be submitted as enclosures to the application. If the application concerns a figurative mark or a combined mark, three clear reproductions of the mark no larger than 8,0 x 8,0 cm shall be submitted. Reproductions include photograph, drawing or other graphical representation liable for electronic recording, storage and reproduction.

If the application concerns a three-dimensional mark, the number of reproductions, all with three copies, necessary to show the full shaping of the mark, shall be submitted. If necessary, the Norwegian Industrial Property Office can require that the applicant submit a model of the mark.

If the application concerns a word mark, it will when registered, be published with the type of letter decided by the Norwegian Industrial Property Office for such publishing.

If the application concerns other type of marks, for example a sound mark, scent mark or mark consisting of colours or combinations of colours, the Norwegian Industrial Property Office may require a description of the mark and possibly a sample of the mark stored on a suitable medium. The Norwegian Industrial Property Office may give further guidelines for transmission, formats of storage, etc.

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

#### **Section 4**

#### **Section 5**

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

#### **Section 6**

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

### **Section 7**

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

### **Section 8**

The Norwegian Industrial Property 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 enclosures which shall be enclosed with the application, and the information these enclosures shall contain; and
- 5) the journal of all applications filed.

## **Chapter 3 Priority, etc.**

### **Section 9**

The applicant may claim priority as mentioned in section 18 of the Trademarks Act, if a mark is displayed in an official or officially recognized exhibition as mentioned in Treaty of November 22, 1928 No. 1 of international exhibitions.

The claim of priority must be stated in the application and be filed with the Norwegian Industrial Property Office within six months after the first display of the mark in the exhibition. Priority cannot be claimed after these points of time.

The claim of priority shall state the name of the exhibition where the mark first was displayed, in which State the exhibition was held, and the point of time for the first display of the mark in the exhibition. If the claim does not contain this information, the Norwegian Industrial Property Office shall give the applicant a time limit of one month to submit this information. The right to priority will lapse if this time limit is not met.

The Norwegian Industrial Property Office can require that anyone who claims such priority shall file evidence of priority within three months from the time of request from the Norwegian Industrial Property Office. Acceptable as evidence of priority is a statement from the management responsible for the exhibition, to the effect that the exhibition is international and of the point of time for the first display of the mark in the exhibition.

### **Section 10**

The applicant may claim priority as mentioned in section 30 of the Trademarks Act, on the basis of the first application for registration of the mark which is filed in a State party to the Paris Convention of March 20, 1883 No. 1 for the Protection of Industrial Property or the Convention establishing of the World Trade Organization of April 15, 1994 No. 18.

The claim of priority must be stated in the application and be filed with the Norwegian Industrial Property Office within six months after the filing of the first application. Priority cannot be claimed after these points of time.

The claim of priority shall state in which State the mark first was applied registered, which date the application was filed and the application number. If the claim does not contain this information, the Norwegian Industrial Property Office shall give the applicant a time limit of one month to submit this information. The right to priority will lapse if this time limit is not met.

The Norwegian Industrial Property Office can require that anyone who claims such priority shall file evidence of priority within three months from the time of request from the Norwegian Industrial Property Office. Evidence of priority shall contain information as mentioned in the

third paragraph, the applicant's name, a copy of the application and be confirmed by the authority of registration which the first application was filed with.

The right to claim priority according to this section applies correspondingly to application filed with a regional authority of registration for State party to the conventions mentioned in the first paragraph.

### **Section 11**

On the conditions referred to in the Paris Convention, Article 6 quinquies, 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.

Request for registration of this kind must be stated in the application and filed with the Norwegian Industrial Property Office. Request filed after this point of time will not be granted.

Request for registration "telle quelle" shall state in which State the mark is registered, the point of time for filing and the registration number. If the request does not contain this information, the Norwegian Industrial Property Office shall give the applicant a time limit of one month to submit this information. The right to request registration "telle quelle" will lapse if this time limit is not met.

Evidence for registration of the mark in a foreign State shall be filed within three months from the time of request from the Norwegian Industrial Property Office. A copy of the letter of registration or an authorized extract of the Register is acceptable as evidence.

### **Section 12**

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 Norwegian Industrial Property 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.

#### **Section 12a**

Claim of priority based on transformation of an international registration ceased wholly or in part due to lapse of the basic national application or registration according to section 57, first paragraph in the Trademarks Act, must be stated in the application for registration of the mark in this country, and be filed with the Norwegian Industrial Property Office within three months after the recording in the International Bureau of that the international registration has ceased wholly or in part, cf. the Madrid Protocol Article 9 quinquies. If the claim of transformation is not stated in the application, it cannot at a later point of time be claimed.

#### **Section 12b**

Claim of priority based on transformation of an international registration ceased due to denunciation of the Madrid Protocol according to section 57, second paragraph in the Trademarks Act, must be stated in the application for registration of the mark in this country, and be filed with the Norwegian Industrial Property Office within two years from the time denunciation became effective, cf. the Madrid Protocol Article 15. If the claim of transformation is not stated in the application, it cannot at a later point of time be claimed.

The claim shall specifically refer to the international registration which wholly or in part has ceased, and which the claim of transformation is based upon.

### **Section 13**

The applicant may request in writing that the Norwegian Industrial Property Office divide the application into two or more new applications. The request shall contain details with respect 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 stipulated fee shall be paid 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 Norwegian Industrial Property Office otherwise finds that a division will result in doubt as to the scope of one of the applications.

### **Section 16**

If the Norwegian Industrial Property 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, and the single goods retain their original priority.

### **Section 17**

Documents filed in the original application up to the division has been accomplished, shall be deemed as documents in the new application.

## Chapter 5 Exceptions from Legal Protection

### **Section 18**

If the Norwegian Industrial Property 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 Norwegian Industrial Property 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 duplicate 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,
  - 3) a statement of the grounds on which the opponent believes the registration must be cancelled,
- and

4) which goods the opposition concerns, alternatively which goods are not concerned by the opposition, if the registration only is claimed cancelled in part.

In special cases as referred to in section 21, first paragraph, third period of the Trademarks Act, the Norwegian Industrial Property 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 19a**

The publishing of an opposition being filed with the Norwegian Industrial Property Office, cf. section 21, fourth paragraph of the Trademarks Act, shall contain details with respect to:

- 1) the number of the registration,
- 2) in which number of the Norwegian Trademark Gazette the registration was published,
- 3) the holder's name or business name and address, and
- 4) the opponent's name or business name and address.

#### **Section 20**

The Norwegian Industrial Property 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 Norwegian Industrial Property 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 Norwegian Industrial Property Office does not find it obvious that the opposition shall be rejected pursuant to section 21a, second paragraph, of the Trademarks Act, the Norwegian Industrial Property Office shall send one copy 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 Norwegian Industrial Property Office shall decide whether further correspondence between the parties is necessary.

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

#### **Section 23**

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

#### **Section 23a**

The publishing of the final decision of an opposition, cf. section 21a, third paragraph of the Trademarks Act, shall contain details with respect to:

- 1) the number of the registration,
- 2) in which number of the Norwegian Trademark Gazette the registration and the opposition were published,
- 3) the holder's name or business name and address,
- 4) the decision, and
- 5) where partial cancellation, the publishing of the new list of goods.

An opposition cannot be filed for a decision of partial cancellation.

### **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 Norwegian Industrial Property 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 a 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 Norwegian Industrial Property 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 Norwegian Industrial Property 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 Norwegian Industrial Property Office. The Norwegian Industrial Property 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 Norwegian Industrial Property 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 fulfil the requirements of section 47 of the Trademarks Act and Regulations under the Madrid Protocol (Madrid Regulations), Rule 9(4) and 5(b)(i) to (iv) and (f).

### **Section 32**

The application for international registration 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 Norwegian Industrial Property Office, after processing the application pursuant to section 48 of the Trademarks Act, accepts the application, the Norwegian Industrial Property 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 34a**

If an application or registration which wholly or in part is the basis for an international registration, which wholly or in part ceases, and the cessation is due to actions made before the expiration of the five year dependency period according to the Madrid Protocol Article 6(3), the international registration will cease accordingly.

### **Section 35**

In addition, the Norwegian Industrial Property 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**

When the Norwegian Industrial Property Office receives notification from the International Bureau that the holder of an international registration of a trademark requests that the registration wholly or in part shall be valid in Norway, the Norwegian Industrial Property Office shall check to see whether there are any obstacles to hinder this.

If there are any obstacles to the registration being valid wholly or in part in Norway, the Norwegian Industrial Property Office shall within 18 months, inform the Bureau by giving a provisional refusal according to Rule 17 in the Madrid Regulations. If the Norwegian Industrial Property Office does not meet this time limit, the designation of Norway will automatically be valid in Norway. The time limit mentioned in this paragraph is calculated from the day the notification of the designation of Norway sent from the International Bureau, alternatively from a later date if notification of corrections in the earlier designation was sent. Rule 4 in the Madrid Regulations applies correspondingly for calculations of the 18- months time limit.

The provisional refusal according to the second paragraph, shall inform that the holder of the international registration can request a review of the question of the international registration wholly or in part being valid in Norway. The holder shall be granted an equitable time limit in which to request this and to refute or remedy the obstacle

Sections 19 and 60 in the Trademarks Act and section 53 of these regulations shall apply correspondingly. Regarding the obligation of the holder to have a 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 Norwegian Industrial Property 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 a designation of Norway in an international registration being valid in Norway, sections 21, 21a and 52, first paragraph, of the Trademarks Act, and Chapter 6 herein, shall apply correspondingly, with the adjustments resulting from the following second and third paragraphs.

If an opposition is withdrawn, the opposition proceedings may only continue if there are special reasons therefore. It is further a requirement that notification of a provisional refusal stating that the registration shall not be valid in Norway can be given to the International Bureau within the 18-months time limit referred to in section 37, second paragraph.

After the expiration of the 18-months time limit, 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 a 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 Norwegian Industrial Property 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, fifth paragraph, and in section 39, fourth paragraph, and also on appeal to the Board of Appeals.

#### **Section 41**

The Norwegian Industrial Property 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**

### **Chapter 11 Miscellaneous Provisions**

#### **Section 53**

The applicant or his representative may in writing request an oral hearing with an examiner with authorization to make decisions appointed by the Norwegian Industrial Property Office, with the purpose of reaching a final clarification of disputes in a case before the Norwegian Industrial Property Office. Further guidelines will be given by the Norwegian Industrial Property Office.

#### **Section 54**

Documents concerning trademark registrations, including documents in cases of opposition and appeal, shall be in Norwegian, Danish or Swedish. The provisions in section 2a, second and third paragraph, shall apply correspondingly.

#### **Section 55**

Time limits shall be calculated from the day the notification was sent from the Norwegian Industrial Property Office.

If the notification from the Norwegian Industrial Property Office does not state a specific date for expiration, the time limit will expiry on the day of the month that by it's number correspond to the day of the beginning of the time limit. If no such corresponding number exists in that particular month, the last day of the month shall be the last day of the time limit. If the time limit expires on a Saturday, holiday or on a day that according to the legislation is equal to a holiday, the time limit is prolonged to the next working day.

Second paragraph applies correspondingly for calculating other time limits according to the Trademarks Act and these regulations, as long as not stated otherwise in the Madrid Protocol and the Madrid Regulations.

The time limit is two months, if not otherwise stated in the Trademarks Act, these regulations or by the Norwegian Industrial Property Office in an individual case.

A document is deemed as filed with the Norwegian Industrial Property Office on the point of time when the document is received in the Norwegian Industrial Property Office, see section 1 in the Regulations of April 11, 2003 No. 456 of fees to the Norwegian Industrial Property Office.

#### **Section 56**

The Norwegian Industrial Property Office may issue regulations stipulating further provisions with regards 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 57**

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 Norwegian Industrial Property 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 Norwegian Industrial Property Office. Provisions laid down by the Norwegian Industrial Property 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 Norwegian Industrial Property 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.