



**CHAMBERS**  
Global Practice Guides

# Trade Marks

Norway – Law and Practice

Contributed by  
Kvale Advokatfirma DA

2018



# NORWAY

---

## LAW AND PRACTICE:

p.3

Contributed by Kvale Advokatfirma DA

The 'Law & Practice' sections provide easily accessible information on navigating the legal system when conducting business in the jurisdiction. Leading lawyers explain local law and practice at key transactional stages and for crucial aspects of doing business.

# Law and Practice

*Contributed by Kvale Advokatfirma DA*

## CONTENTS

<b>1. Types of Trade Marks &amp; Registration</b>	<b>p.6</b>		
1.1 Types of Trade Marks	p.6	2.5 Licensing Requirements or Restrictions	p.10
1.2 Trade-Mark Rights	p.6	2.6 Procedure for Licensing a Trade Mark	p.11
1.3 Standards for Registering	p.6	2.7 Registering or Recording the Licence	p.11
1.4 Trade-Mark Register	p.6	2.8 Reasons to Deny Granting a Perpetual Licence	p.11
1.5 Types of Registers	p.6	<b>3. Opposition Procedure</b>	<b>p.11</b>
1.6 Searching for Prior Trade Marks	p.6	3.1 Legal Grounds and Timeframes	p.11
1.7 Registration Requirements	p.6	3.2 Filing an Opposition	p.11
1.8 Registering a Trade Mark	p.6	3.3 Opposition Procedure	p.12
1.9 Registering Signs	p.6	<b>4. Initiating a Lawsuit</b>	<b>p.12</b>
1.10 Other Rights to Signs	p.6	4.1 Actions to Pursue Infringement	p.12
1.11 Registration Procedure	p.7	4.2 Initiating Infringement Proceedings	p.12
1.12 Use in Commerce	p.7	4.3 Declaratory Judgment Proceedings	p.12
1.13 Registration of Series Marks	p.7	4.4 Jurisdiction of Courts	p.12
1.14 Length of Registration Process	p.7	4.5 Prerequisites to Filing a Lawsuit	p.13
1.15 Grounds for Refusal	p.7	4.6 Representation for Parties	p.13
1.16 Process for Overcoming Objections	p.8	4.7 Interim or Preliminary Injunctions	p.13
1.17 Consideration of Prior Rights	p.8	4.8 Protection for Potential Defendant	p.13
1.18 Third-Party Rights	p.8	4.9 Obtaining Information and Evidence	p.13
1.19 Revoke, Change, Amend or Correct an Application	p.9	4.10 Initial Pleading Standards	p.14
1.20 Assigning an Application or Granting a Licence	p.9	4.11 Representative or Collective Actions	p.14
1.21 Remedies Against the Trade Mark Office	p.9	4.12 Restrictions on Trade-Mark Owners	p.14
1.22 Use of a Trade Mark	p.9	<b>5. Infringement</b>	<b>p.14</b>
1.23 Dividing a Trade Mark	p.9	5.1 Action for Infringement	p.14
1.24 Length of Term of Protection	p.9	5.2 Signs and Infringement	p.14
1.25 Requirements for an Exhaustion	p.9	5.3 Use of a Sign by Defendant	p.14
1.26 Participation in the Madrid System	p.9	5.4 Defences Against Infringement	p.14
1.27 Consequences for Providing Incorrect Information	p.9	5.5 Role of Experts and/or Surveys	p.14
1.28 Updating or Refreshing a Design Mark	p.10	5.6 Administrative or Criminal Offence	p.15
1.29 Denotation	p.10	5.7 Custom Seizures	p.15
<b>2. Assignment and Licensing</b>	<b>p.10</b>	<b>6. Revocation/Cancellation</b>	<b>p.15</b>
2.1 Assignment Requirements or Restrictions	p.10	6.1 Remedies and Reasons	p.15
2.2 Procedure for Assigning a Trade Mark	p.10	6.2 Trade Mark Office and Civil Courts	p.15
2.3 Registering or Recording the Assignment	p.10	6.3 Statutory Limitation or Time Period	p.15
2.4 Trade Marks and Security	p.10	6.4 Initiation of Revocation/Cancellation Proceeding	p.15
		6.5 Partial Revocation/Cancellation	p.15

# NORWAY LAW AND PRACTICE

---

*Contributed by Kvale Advokatfirma DA* **Authors:** Marie Vaale-Hallberg, Lars Trygve Jenssen, Kaia Bugge Fougner, Tarje Neergaard

6.6	Possibilities of Amendment	p.16
6.7	Revocation/Cancellation and Infringement	p.16
<b>7.</b>	<b>Trial &amp; Settlement</b>	<b>p.16</b>
7.1	Special Procedural Provisions	p.16
7.2	Determination of Cases	p.16
7.3	Possibilities of Settlement	p.16
7.4	Other Court Proceedings	p.16
<b>8.</b>	<b>Remedies</b>	<b>p.16</b>
8.1	Existing Remedies	p.16
8.2	Rights and Remedies	p.17
8.3	Different Types of Remedies	p.17
<b>9.</b>	<b>Appeal</b>	<b>p.17</b>
9.1	Special Provisions	p.17
9.2	Factual or Legal Review	p.17
9.3	Length of Appeal from Trial Court	p.17
<b>10.</b>	<b>Other Trade Mark Issues</b>	<b>p.17</b>
10.1	Recognition of Dilution	p.17
10.2	Protection of Famous Marks	p.17
10.3	Special Rules Regarding Geographic Indicators	p.17
10.4	Special Rules Relating to Surnames	p.17
<b>11.</b>	<b>Costs</b>	<b>p.18</b>
11.1	Costs Before Filing a Lawsuit	p.18
11.2	Costs Regarding an Infringement Action	p.18
11.3	Costs of Litigation	p.18
<b>12.</b>	<b>Alternative Dispute Resolution</b>	<b>p.18</b>
12.1	Common Way of Settlement	p.18
<b>13.</b>	<b>Trade Marks and Other Intellectual Property</b>	<b>p.18</b>
13.1	Protection by Copyright	p.18

*Contributed by Kvale Advokatfirma DA* **Authors:** Marie Vaale-Hallberg, Lars Trygve Jenssen, Kaia Bugge Fougner, Tarje Neergaard

**Kvale Advokatfirma DA** advises on all aspects of ownership, protection, exploitation and enforcement of trade marks in a wide range of industries. This includes particular notable strength in matters related to fast-moving consumer goods (FMCG), telecom, oil/gas, luxury goods, digitalisation/industry 4.0, online use/e-commerce, new technology, licensing, and dispute resolution. Trade-mark matters are handled in Kvale's seven-partner IP/TMT department. Advising a diverse and high-profile list of clients, the firm undertake a

comprehensive range of advice including all aspects of the life cycle of the trade marks, including, but not limited to IP strategy, national and international registrations, portfolio management services, non-use and cancellation, transfer, licensing and collaboration arrangements in relation to a wide range of industries, conflict-handling and litigation. Kvale conduct detailed M&A due diligence and have considerable experience of drafting and negotiating contracts such as global cross-licensing and co-existence agreements.

### Authors



**Marie Vaale-Hallberg** is one of Kvale's specialised IP partners, working with trade mark and marketing law matters in particular. She works with major international and national brands, both with enforcement and prosecution as well as undertaking contractual work. Marie has a strong commercial focus and offers detailed insight into the Norwegian retail market, and she stands out for her particular knowledge of regulatory law within the food and beverages sector; Marie is a member of Food Lawyers Network. She has broad IP judicial practice, involving research and development agreements, protection and enforcement of trade marks, patents and designs, IP strategies and marketing law. She is frequently invited to lecture on IP and other legal subjects in Norway and abroad.



**Lars Trygve Jenssen** started Kvale's IP department in 2004 and has played a central role in building it into today's highly regarded practice. A partner at the firm, he is a highly experienced intellectual property lawyer and trusted adviser, particularly within the fields of trade marks, copyright, IT/digitalisation and licensing. Lars actively leads trade-mark work for a range of top-tier clients such as Telia, L'Occitane, Land Rover Jaguar, Dixons Phonehouse and The Norwegian National Museum. He also has considerable experience with corporate law and M&A, often advising companies in the IP/TMT sectors.



**Kaia Bugge Fougner** is a senior lawyer who has specialised in intellectual property law and marketing law for over ten years. She has a broad marketing and IP law practice, including copyright, protection and enforcement of trade marks and design rights, the development of IP strategies and drafting different types of contracts. Kaia has extensive trade-mark experience from working not only for different law firms, but also for the Norwegian Board of Appeal for Industrial Property Rights (KFIR); she worked in KFIR as a trade-mark expert, making decisions concerning trade marks and company names. Kaia has also worked several years as an in-house lawyer for a multinational corporation, taking care of all Norwegian legal issues, including in particular contract, trade-mark and marketing matters. Kaia speaks regularly at conferences and seminars, has served as an external examiner at the University of Oslo and the University of Bergen, and is the author of several publications.



**Tarje Neergaard** joined Kvale as an associate in 2017. He specialises in intellectual property law and data protection law. Although his key focus is trade-mark matters, he also shows a keen interest in patent infringement cases, as well as in preparing compliance standards and contracts regulating the rights of commercial actors to intellectual property. He is a member of the Norwegian Bar Association. Prior to joining the firm, he was situated at the Fridtjof Nansen Institute working on a book project based on his Master's thesis entitled Human Genetic Resources as Property.

## 1. Types of Trade Marks & Registration

### 1.1 Types of Trade Marks

The Norwegian Trademarks Act of 26 March 2010, in principle, gives protection to all signs capable of distinguishing an entity's goods or services from others, such as words (including slogans), numbers, figures and images, trade dress and packaging.

The Norwegian Trademark Act establishes that "collective trade marks" may be protected, that is, trade marks pertaining to a society or organisation to be used by its members. A sub-category of the "collective trade mark" is the so-called guarantee or certification mark, which is used by agencies, foundations, companies or other associations to demonstrate that certain standards or controls to which the marks relate are met (see section 1, first and second para and section 2, first para).

### 1.2 Trade-Mark Rights

The Norwegian Trademark Act establishes the so-called "two-track" system by which protection can be obtained by registration and/or by use.

Applications are sent to the Norwegian Industrial Property Office ("NIPO") and can be either national or international, asserting the Madrid System.

A trade mark is established by use when and for as long as it is well known in the circle of trade in Norway for the relevant goods and/or services as someone's sign. Obtaining exclusivity without registration is more time- and cost-efficient, but less predictable in terms of protection. In addition, the latter type only provides protection in the geographical area where the trade mark is used or branded, etc. One would therefore be advised to register the trade mark.

Both types of protection have their legal basis in section 3.

### 1.3 Standards for Registering

The legal requirements for registering different types of marks are the same.

### 1.4 Trade-Mark Register

Norway has a trade-mark register, which is publicly available.

The NIPO is established as the governing body responsible for registering all registrable industrial rights, including trade marks. Every national and international trade-mark application that designates Norway may be found online in the NIPO's database. Applications leading to registrations are registered by the NIPO in the Norwegian Trademark Register ("det norske varemerkeregisteret") and then published in the Norwegian Official Trademarks Gazette ("Norske varemerkettidende") (see section 22, first para).

### 1.5 Types of Registers

The Norwegian legal system does not operate with different types of registers, eg, principal and supplemental registers.

### 1.6 Searching for Prior Trade Marks

Although there is no legal requirement to do so, performing a search in the NIPO's registers as well as checking whether there are confusingly similar or identical brands in use is recommended and considered normal practice.

### 1.7 Registration Requirements

A trade mark may be registered if it is capable of being represented graphically, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Marks that merely state the nature or specific properties of the goods or services are not eligible for trade-mark registration; descriptive marks, such as "rye bread" for bread or "dark chocolate" for chocolate, are therefore ineligible for registration (see section 2, cf. section 14).

### 1.8 Registering a Trade Mark

An exclusive right to a trade mark may be acquired by any natural or legal person as a distinctive sign for goods or services in an industrial or commercial undertaking. This applies to both registered and unregistered trade marks (see section 1, first and second para).

### 1.9 Registering Signs

Any sign capable of distinguishing the goods or services of one undertaking from those of another may constitute a trade mark. The term "sign" shall be interpreted widely, thus including numerals, figures, pictures, the shape or get-up of the goods, the packaging, words and combinations of words, sounds, colours and scents, insofar as the sign may be graphically presented. Sounds, colours and scents are therefore not ineligible for trade-mark protection per se, but the requirement related to graphical presentation will, in many cases, constitute an obstacle. A relevant example to this end is the decision by the Norwegian Supreme Court (HR-2017-2356-A) that addressed whether a colour could be established as a trade mark by use. The Supreme Court confirmed that a colour may constitute a mark, as it may be graphically presented. However, the condition to establish the trade mark by use was not met, as the producer of the pharmaceutical had used several different nuances of the colour, which suggested that the incorporation of the nuance as a trade mark was undeliberate (see sections 2 and 14 of the Trademark Act).

### 1.10 Other Rights to Signs

Norwegian legislation recognises other rights to signs or source-identifiers besides trade marks, such as rights to company names, trade names and domain names.

The rights to company names and secondary trade names are outlined in the Company Name Register Act. Any company name that is not identical to another company name already registered or in the process of being registered may be registered at the Brønnøysund Register Centre (“Brønnøysund registeret”). In order for the company name to be protected against confusingly similar trade marks, it must meet the same requirements of distinctiveness as trade marks. Additional legal protection may be provided by the Marketing Control Act and the posed requirement of “good business practice” in businesses’ transactions with one another (see section 1, cf section 8).

The rights to secondary trade names are established by use, which is considered to be when and for as long as it is well-known as someone’s trade name in the circle of trade in Norway for the relevant goods and services (see the Company Name Register Act section 1-1, third para).

There are currently no Norwegian laws that regulate rights to domain names specifically. Domain names under the domain “.no” are registered at the Norwegian service for registration of internet domain names (“Norid”) in accordance with Norid’s guidelines. According to appendix H of said guidelines, the rights-holder of a trade mark or a company name may, in the event of conflict, demand that Norid deletes or transfers conflicting domain names under the domain “.no”.

Applications for company names, domain names and trade names must be filed separately as the governing bodies have different areas of competence and expertise in terms of registration.

### **1.11 Registration Procedure**

Trade-mark applications may be filed online via the public service centre “altinn.no”, or via paper application. If the trade-mark application is to be filed online, the applicant must have a Norwegian national identity number. All trade-mark applications will be received and processed by the NIPO.

The application must include the name and address of the applicant, a representation of the trade mark, and a list of the goods or services in respect of which the registration is requested; hence, multi-class applications are allowed (see section 12, second para).

There is an application fee when applying for a trade mark, and the NIPO will send an invoice to the applicant for the fee, which is currently NOK2,900 (approximately EUR300) and covers registration for up to three classes. Each extra class incurs an additional fee, currently at the rate of NOK750 (approximately EUR80). The same system applies to collective marks, but the rates are higher.

If the payable fee is not paid in due time, the applicant may risk dismissal of the application or registration (see section 12, third para).

During the case proceedings, the NIPO will examine whether there are any obstacles to the registration. Should such obstacles be observed, the applicant will be informed within three to six months of the filing of the application. The letter received by the applicant from the NIPO constitutes a so-called written opinion, whereinafter the applicant shall be given the possibility to respond in writing or during oral proceedings if requested (see section 23).

If the trade mark is not approved for registration, the applicant may choose to pursue the decision at the Norwegian Board of Appeal for Industrial Property Rights (“KFIR”). Such action must be made no later than two months after the NIPO’s decision. See section 49.

Should the KFIR uphold the NIPO’s decision, the applicant may pursue the matter in court (see section 52).

### **1.12 Use in Commerce**

There are no formal requirements under Norwegian law for an application to demonstrate or document use in commerce of a trade mark. If the trade mark lacks distinctiveness, however, the NIPO may require the applicant to provide documentation proving acquired distinctiveness through use.

### **1.13 Registration of Series Marks**

The Norwegian system does not allow the registration of series marks. If the applicant wishes to register multiple trade marks at the same time, they must do so by filing several applications, ie, one for each trade mark. The same applies if the applicant wishes to register multiple variations of the same mark.

### **1.14 Length of Registration Process**

Assuming the application does not contain errors or deficiencies, and that the NIPO finds no obstacles in terms of being able to register the trade mark, registration will normally occur within three to six months from the time of filing.

The applicant does not need representation during the application and registration procedure. Should the applicant choose to seek representation, as would be advised, such representation for a single word mark in one class would cost the applicant approximately NOK6,000 (approximately EUR600), but the prices vary considerably.

### **1.15 Grounds for Refusal**

According to section 14, a trade mark cannot be registered if it exclusively or with only insignificant changes or additions consists of signs or indications that:



*Contributed by Kvale Advokatfirma DA* **Authors:** Marie Vaale-Hallberg, Lars Trygve Jenssen, Kaia Bugge Fougner, Tarje Neergaard

- indicate the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, the time of production of the goods or the rendering of the services or other characteristics of the goods or services; or
- constitute customary designations for the goods or services according to normal linguistic usage or loyal, established business practice.

Section 15 states that a mark cannot be registered if it:

- is contrary to law or public order, or liable to cause offence;
- is liable to deceive, for example in respect of the nature, quality or geographical origin of the goods or services;
- contains unauthorised escutcheons or other signs covered by Section 165, letter b and Section 166 of the Norwegian Penal Code, or a national flag or anything that is liable to be understood as a sign or flag; or
- for wine and spirits, consists of or contains anything that is liable to be understood as a geographical indication of origin, unless the geographical origin of the goods is in accordance with the indication.

Section 16 states that a mark cannot be registered in the following circumstances, without the consent of the relevant owner:

- use of the trade mark would infringe the right of another in this country to a trade mark or business name or another business sign;
- the trade mark is liable to be confused with a trade mark, business name or other business sign that someone else started to use before the applicant as a distinctive sign for goods or services and is still using, and the applicant was aware of this use when the application for registration was filed, in such a way that the filing shall be considered to have taken place in conflict with honest practices in industrial or commercial matters;
- the trade mark contains something that is liable to be perceived as another person's name, stage name or portrait, unless it obviously refers to a person who is long dead;
- the trade mark contains something that is liable to be perceived as the distinctive title of another's protected creative or intellectual work, or infringes another's right in Norway to a creative or intellectual work or photography or design; or
- the trade mark infringes another's right in Norway to a designation protected in regulations pursuant to Act No 6 of 17 June 1932 on Quality Control of Agricultural Goods, etc. or Act No 124 of 19 December 2003 on Food Production and Food Safety, etc.

These are regarded as absolute grounds for refusal.

### 1.16 Process for Overcoming Objections

The NIPO will send a letter to the applicant within three to six months (written opinion) concerning either the approval of an application for registration or an assessment of the obstacles hindering approval. In the written reply or during the oral proceedings, the applicant can claim acquired distinctiveness through use, etc. Additional letters may be exchanged thereafter until the NIPO finds that the application is ready for a final assessment.

In the event of an older registration that constitutes a hindrance for registration but has not been in use during the preceding five years, the applicant may initiate a cancellation process. Pending the outcome of the cancellation process, the NIPO will normally place the application process on hold (see section 37).

Another way to overcome a registration obstacle due to an older mark is to provide a confirmation from the older right-holder that the trade marks may co-exist (see section 16).

### 1.17 Consideration of Prior Rights

The NIPO shall ensure that there are no registered trade marks or applications for registration that constitute obstacles to the registration of the trade mark being applied for, but does not examine whether there are other obstacles that may prevent registration, unless it has been made aware of these obstacles. Potential obstacles that are not examined on the NIPO's own initiative are, inter alia, company names, trade names, unregistered trade marks, other persons' names, stage names, portraits, titles of protected creative or intellectual work, photographs, designs or protected designations (see section 20).

### 1.18 Third-Party Rights

Third parties have the right to participate during the registration process by filing protests prior to the registration. There is no requirement for any sort of commercial interest when protesting a trade-mark application. A protest will typically be filed by a third party who disapproves of the potential registration of a descriptive word that should be non-exclusive and available to everyone, or by a third party holding the rights to a trade mark that is liable to be confused with a trade mark that is subject to registration.

If a third party wishes to protest prior to the registration of the application for a trade mark, they should file an informal written protest to the NIPO, including the grounds for the protest. Informal protests do not grant the third party the rights of a party to a case, as they lack a formal legal basis in Norwegian legislation. However, there is nothing to hinder the NIPO taking the protest into consideration (for the formal opposition procedure, see below).



**1.19 Revoke, Change, Amend or Correct an Application**

The application for a trade mark can always be revoked by the applicant. As long as the overall impression of the trade mark stays the same, insignificant/insubstantial changes may be made to a trade mark for which an application has been filed for registration (see section 13, first para).

Furthermore, and according to section 13, second para, the applicant may also choose to limit the list of goods or services for which application is made for registration of a trade mark, thus allowing the applicant to revoke an application in part if they so choose.

**1.20 Assigning an Application or Granting a Licence**

Norwegian legislation does not restrict either transferral of rights or licensing during the application process; parties are free to enter into such agreements if they so desire.

**1.21 Remedies Against the Trade Mark Office**

If the registration of a trade mark has been denied by the NIPO, the applicant may choose to pursue the decision at the KFIR. Such action must be made no later than two months after the NIPO's decision (see section 49, first para and section 50, first para).

Should the KFIR uphold the decision of the NIPO, the applicant may pursue the matter in court (see section 52).

**1.22 Use of a Trade Mark**

There is no requirement in the Norwegian legal system for an applicant to make use of its mark in commerce before the registration is issued.

**1.23 Dividing a Trade Mark**

An applicant may request that the application is divided into two or more applications. A split is particularly relevant when it is not possible to register the application for certain goods on the list, etc (see section 82 and the appurtenant regulation sections 17 ff).

**1.24 Length of Term of Protection**

The protection provided by registration is ten years from the application date and, insofar as the trade-mark owner has requested a renewal, ten years from the expiry of the previous period. There are no limitations on how many times a trade mark can be renewed.

The request for renewal must be filed in writing no earlier than one year before and no later than six months after the expiry of the registration period (see sections 32 and 33).

**1.25 Requirements for an Exhaustion**

In Norway, and in accordance with 2008/95/EC, a trade-mark right is exhausted when the trade-mark owner – or another party with the owner's consent – has consented to put goods under a certain trade mark on the market within the EU/EEA. Consequently, a trade-mark owner cannot prevent parallel import of its goods from a country within the EU/EEA if they have already consented to put their goods under a certain trade mark on that market. This does not apply, however, if the owner of the trade mark has legitimate reasons to oppose further commercialisation of the goods, for example if the condition of the goods has changed or been impaired after they were put on the market; in the latter situation, re-packaging may therefore be prohibited (see the Trademarks Act section 6). As Norway is part of the EEA Agreement, however, the re-packaging of products – which may be a prerequisite to meet different national requirements, as is often the case for pharmaceuticals – cannot be prohibited if it is necessary to obtain effective access to the relevant market.

**1.26 Participation in the Madrid System**

An applicant that aims to obtain an international trade-mark registration can assert the Madrid System, to which Norway is party, by applying to the NIPO and designating the respective countries in the application.

In order to be eligible to file an international application, the applicant must have filed for or previously been granted registration of a trade mark in Norway. The applicant must also be either a Norwegian citizen, domiciled in Norway, or operating an industrial or commercial establishment in Norway.

The application shall be filed in English and include the following information:

- the name and address of the applicant;
- the numbers and dates of the Norwegian trade-mark registrations or applications on which the international registration is to be based;
- a representation of the trade mark;
- a list of the goods or services for which the trade mark is to be registered; and
- a list of the designated countries or international organisations for which registration is requested (see sections 66 and 67 of the Trademarks Act).

**1.27 Consequences for Providing Incorrect Information**

The NIPO will notify an applicant if they provide the NIPO with incorrect or insufficient information that hinders the registration of an applied trade mark. The applicant shall be given a reasonable time limit to respond and, if possible, remedy the deficiencies.

*Contributed by Kvale Advokatfirma DA* **Authors:** Marie Vaale-Hallberg, Lars Trygve Jenssen, Kaia Bugge Fougner, Tarje Neergaard

The NIPO may cancel the registration in part or in full if a person has filed an opposition in accordance with section 26, or if a party with a legal interest has required an administrative review in accordance with section 40. The grounds for filing an opposition or requesting a revocation/cancellation will typically be if the application and/or registration builds on incorrect information.

The NIPO may also cancel the registration on its own initiative, but only if the registration of a trade mark, a renewal or the alteration of a registration has taken place by obvious mistake (see section 45, first para).

Wrongful acts, such as forgery of a trade-mark owner's consent, etc, may be reported to the authorities, whereinafter the applicant may be subject to criminal liability.

### 1.28 Updating or Refreshing a Design Mark

As is the case for other trade marks, design marks are eligible for updates or refreshments, as long as the overall impression stays the same. Insignificant/insubstantial changes are therefore allowed without having to file a new application for registration (see section 13, first para).

### 1.29 Denotation

Symbols denoting that a mark is registered have no legal status in Norway, although many trade-mark holders have chosen to use these symbols on the Norwegian market for practical purposes, eg, if multinational packages are used, or for protective purposes.

## 2. Assignment and Licensing

### 2.1 Assignment Requirements or Restrictions

Trade marks, trade names and company names may be transferred under the basic principles of Norwegian contract law, either alone or together with the company to which the trade mark is registered. If a company changes ownership, its trade marks and trade names are transferred alongside the company, unless otherwise agreed (see sections 53, first and second para of the Trademarks Act and 4-3 of the Company Name Register Act). International trade-mark registrations can also be assigned. Unlike the assignment of a right to a national trade-mark registration, assignment of a right to an international trade-mark registration requires notification to the International Bureau (see section 72, fourth para of the Trademarks Act).

Company names may be transferred alongside the company's operations or substantial parts of the operations. If the company or a substantial part of the company is transferred, the right to the company name will be transferred to the new owner, unless otherwise agreed. If the company holds the name of the transferee, the right to the company name

will only be transferred alongside the company if there is an explicit agreement between the parties (see section 4-1 of the Company Name Register Act).

### 2.2 Procedure for Assigning a Trade Mark

No standard procedures apply to the assignment of a trade mark, so an assignment may, in principle, be completed in both oral and written form. Should the parties wish for the assignment to be registered by the NIPO and taken into the Norwegian Trademark Register, which is the preferred alternative, the assignment must be done in writing and under-signed by both parties.

### 2.3 Registering or Recording the Assignment

The parties may agree to register the assignment of a registered trade mark in the trade-mark register, but there is no obligation to do so, unless one of the parties requests such recording (see section 56, second para).

The new owner carries the burden of proof as to whether the assignment/transfer has actually taken place. The person that is registered as the owner will, at any time, carry the risk in case of legal proceedings concerning the trade mark, eg related to a trade-mark infringement claim (see section 56, first para).

### 2.4 Trade Marks and Security

A trade mark can constitute a non-possessory security interest for a debt, a distraint to cover a debt past due or, in the event of bankruptcy, part of the satisfaction of a claim.

In order for a trade mark to constitute a security interest, a non-possessory mortgage must be created. To obtain legal protection, the action must be registered on either of the parties' section sheets in the Movables register (see sections 3-4 and 3-6 of the Mortgage Act).

If a creditor obtains a security interest created by distraint levied by the seizure authorities, the creditor must be entered on the distrainees' sheet in the movable register in order to obtain legal protection for the security interest (see section 5-9 of the Mortgage Act).

If a creditor wishes to seek satisfaction in a trade mark in the event of a bankruptcy, the trade mark in question must belong to the debtor and have a financial value, ie, be eligible to be converted into money (see section 2-2 of the Satisfaction of Claims Act).

### 2.5 Licensing Requirements or Restrictions

It is possible to license a trade mark in the Norwegian legal system. A licence may be assigned from A to B as a consequence of the trade-mark owner's right of freedom to contract with another party, ie a licensee/contracting party. As part of the contract, the contracting party may use the trade

mark in an industrial or commercial setting but may not license their right further, unless this has been agreed upon by the parties to the licence agreement (see section 54 of the Trademarks Act).

Registration and approval from the NIPO is not an absolute requirement but, if requested by either of the parties, the assignment of the registered trade mark shall be entered in the register and published in the same manner as applied to assignments (see section 56, second para).

The contracting parties may regulate the use of the trade mark (licence) via the licence agreement. The trade-mark owner may invoke certain actions if the licensee fails to comply with the following provisions of the licence agreement:

- the duration of the licence;
- the form in which the trade mark may be used, and the goods or services for which it may be used;
- the geographical territory in which the trade mark may be used; or

the quality of the goods or services for which the trade mark may be used (see section 54, second para).

Although the Trademarks Act does not explicitly regulate different types of licence agreements, it is stressed in the preliminary works that 2008/95/EC (“Directive”) applies in a Norwegian context. Thus, a licence may be exclusive and/or non-exclusive, cf Article 8 of the Directive.

There is generally nothing to prevent the parties agreeing upon the terms and conditions regulating the licence agreement, as they consider appropriate, but competition law may be asserted if the agreement aims to prevent, restrict or distort competition, eg, by fixed pricing or market-sharing. The parties to the licence agreement would therefore be advised to consider the principles relating to competition law before preparing and carrying out the agreement (see section 10 of the Competition Act).

## **2.6 Procedure for Licensing a Trade Mark**

The contracting parties – ie, the owner and the licensee – will establish the rules and principles relating to the use of the trade mark in the licence agreement. The contract shall be in writing if any of the parties requires it to be so, although such requirement only applies if the licence is to be registered in the trade-mark register.

The rules and principles carried out in the agreement are subject to revision under the applicable principles in Norwegian contract law.

## **2.7 Registering or Recording the Licence**

Norwegian legislation does not require registration of the licence agreement at the NIPO, but registration is possible.

However, insofar as the licence agreement has not been registered, the trade-mark owner will always run the risk of legal proceedings concerning the trade mark, as well as receiving any notifications relating to the trade mark from the NIPO (see section 56).

## **2.8 Reasons to Deny Granting a Perpetual Licence**

It is possible to grant a perpetual licence in the Norwegian legal system. The trade mark must be renewed every ten years, but there are no limitations on how many times it can be renewed.

# **3. Opposition Procedure**

## **3.1 Legal Grounds and Timeframes**

The registration of a trade mark can be opposed by a third party if it:

- lacks distinctiveness as a sign for the relevant goods or services, or is incapable of being represented graphically;
- conflicts with public interests;
- conflicts with existing rights, without the consent of the rights-holder; or
- has been registered with the wrong person (see the Trademarks Act sections 14, 15, 16 and 21).

The opposition must be filed no later than three months after the day of publication in the Norwegian Official Trademarks Gazette (see section 26, first para).

## **3.2 Filing an Opposition**

Anyone may file an opposition to the registration of a trade mark. In accordance with section 26 of the Trademarks Act, an opposition shall be filed in writing and include the following information:

- the name and address of the person filing the opposition;
- a specification of the registration to which the opposition applies;
- the grounds on which the opposition is based; and
- necessary documentation of circumstances invoked in support of the opposition.

The opponent does not need to be represented by an attorney, but it is advisable in most cases and particularly when the opposition relates to the material requirements set out in the Trademark Act, such as distinctiveness and graphical reproduction.



*Contributed by Kvale Advokatfirma DA* **Authors:** Marie Vaale-Hallberg, Lars Trygve Jenssen, Kaia Bugge Fougner, Tarje Neergaard

Depending on the complexity of the case, average office fees and attorney fees may be in the range of NOK5,000-15,000 in less complex cases, and between NOK50,000 and NOK100,000 in more complex cases.

### 3.3 Opposition Procedure

Official objections may be filed no later than three months after the trade mark has been approved for registration and published in the Norwegian Official Trademark Gazette (see section 26).

As soon as possible after the opposition procedure has commenced, the applicant shall receive a notice from the NIPO explaining why the registration has been opposed by the third party. The applicant will then be given the opportunity to contradict the grounds on which the opposition is based. The NIPO shall only consider factors invoked in the opposition procedure (see section 27). Once the NIPO has sufficient information available, it shall make a decision on the matter within two months.

If the NIPO finds that the trade mark was registered in contravention of sections 14, 15 and 16, and the obstacles to register the trade mark still exist, the registration of the trademark shall be cancelled in full or in part. If there are no obstacles to registering the trade mark, however, or if such obstacles no longer exist, the opposition shall be dismissed. The owner and the opponent shall then receive a notification from the NIPO regarding the outcome of the opposition case (see section 29).

The decision in an opposition case may be appealed to the KFIR. The appeal must be sent within two months of the NIPO's decision, and may take six to twelve months for the KFIR to make a final decision (see section 49, second para, and section 50, first para).

The outcome shall be recorded in the Trademark Register (not to be confused with the Norwegian Official Trademarks Gazette) and a notice thereof published (see section 29 of the Trademarks Act).

## 4. Initiating a Lawsuit

### 4.1 Actions to Pursue Infringement

The owner of a registered or unregistered trade mark may initiate legal proceedings if another party has infringed, aided and abetted thereto, or given grounds to fear that they will infringe the owner's rights pursuant to the Trademarks Act. Prior to the proceedings, the owner of a trade mark will typically send a cease-and-desist letter to the alleged infringer, and may initiate legal proceedings if the alleged infringer disregards the warning letter. Legal proceedings will typically be initiated by filing a request for a preliminary injunc-

tion, followed by a writ of summons initiating the main case. In the writ of summons, the trade-mark owner may request that the court establishes a prohibition against the aforementioned acts, including recalling/removing the goods from commercial channels, destroying or handing over the goods to the trade-mark owner, and/or claiming compensation and damages for the (potential) infringing act.

### 4.2 Initiating Infringement Proceedings

Infringement proceedings are initiated before a district court in the first instance, but the Norwegian legal system distinguishes between registered and unregistered trademarks in terms of in which district court the proceedings shall be brought.

The Oslo District Court is the mandatory legal venue in the first instance for registered trade marks, while unregistered trade marks follow the rules of ordinary venue. An action concerning the latter may therefore be filed with the district court of the ordinary venue of the defendant, or with the district court where the business enterprise's head office is located according to the Register of Business Enterprises (see section 62 of the Trademarks Act and section 4-4, first and third para of the Dispute Act).

### 4.3 Declaratory Judgment Proceedings

A party with a legal interest may initiate legal proceedings concerning, inter alia, a declaratory judgement. This requirement will be met as soon as an infringement is alleged. The same action may also be taken as a counter claim in an already existing infringement case.

### 4.4 Jurisdiction of Courts

If the decision from the NIPO has been brought before the KFIR pursuant to an appeal, and the KFIR has handed down a decision, the decision may be appealed to the Oslo District Court (see section 52 of the Trademarks Act). The Oslo District Court is also the mandatory legal venue of first instance for any actions concerning invalidity, deletion or infringement of a registered trade mark, as well as for cases concerning applicants and trade-mark owners who are not domiciled in Norway (see section 62).

All cases decided by the Oslo District Court shall have mandatory legal venue at the Borgarting Court of Appeal in Oslo.

The rules of ordinary venue apply for trade-mark cases that are not subject to section 62. The Norwegian Supreme Court shall have the final say in any and all cases, subject to the case being admitted by the Supreme Court's Appeals Committee. The Committee considers if the appeal concerns issues whose significance extends beyond the scope of the current case, or if it is important for other reasons that the case is determined by the Supreme Court (see section 30-4, first para of the Dispute Act).

#### 4.5 Prerequisites to Filing a Lawsuit

It is required to send a notice including information about the claim and the basis for the claim, among other details (see sections 5-2, first para and 1-3 of the Dispute Act). However, the consequence of not sending such a notice is limited to considerations concerning costs, which may be reduced or not awarded if a notice has not been sent.

It is common practice to send a cease-and-desist letter, which is typically made out so that it fulfils the requirements of section 5-2.

#### 4.6 Representation for Parties

The parties in trade-mark litigation are not obliged to have a lawyer, although the court may order that the party be represented by counsel if said party is unable to present the case in a comprehensible manner (see sections 3-1 and 3-2 of the Dispute Act).

#### 4.7 Interim or Preliminary Injunctions

The trade-mark owner and/or licensee, depending on the licence agreement, may seek a preliminary injunction by filing a motion to the alleged infringer's ordinary venue. As trade-mark matters usually follow the Trademark Act's special provisions for legal venue, which establish the Oslo District Court as the mandatory legal venue, the ordinary rules of legal venue represent an exception from the provisions normally applied in trade-mark matters. If the defendant files a counterclaim prior to the preliminary injunction proceedings (eg, by claiming that the trade mark is invalid), the request for a preliminary injunction will normally constitute part of the main case proceeded before the Oslo District Court (for the special provisions for legal venue, see pt. 4.4.)

In order to obtain a preliminary injunction, the owner/licensee must first substantiate a claim by proving, on a balance of probabilities, that the plaintiff will prevail with the claim in a regular main case. Secondly, the plaintiff must substantiate the grounds for an injunction either by demonstrating that the defendant's conduct has made it necessary to secure the claim provisionally because the action or execution of the claim stands at risk of being considerably impeded, or by substantiating the need for a temporary arrangement in order to avert considerable future loss or inconvenience. The first option is considered to be the most practical in infringement cases.

When filing a motion for a preliminary injunction, the plaintiff may request that the court makes an *ex parte* decision, wherein the plaintiff must explain the reasons the case should be decided immediately. If the court finds these grounds present, it will give a decision *ex parte* and with due haste. If the court decides to grant the preliminary injunction *ex parte*, the defendant may demand a subsequent oral hearing to attempt to reverse the decision. Before the oral

hearing, the Court will arrange for written pleadings to be exchanged between the parties.

If an *ex parte* decision has not been requested, or if the court does not decide to grant such request, the court will arrange for written pleadings to be exchanged between the parties and summon them to an oral hearing, normally within two to three weeks. After the oral hearing, the court will grant or deny the request in due course (see chapters 32 and 34 of the Dispute Act).

The decision may be appealed to a court of appeal, subject to the ordinary rules of legal venue. As a main rule, the court of appeal will undertake written case handling only, unless an oral hearing is required to ensure sound and fair legal proceedings (see section 29-15 of the Dispute Act). In trade-mark matters, as in most others, the main rule of written proceedings is normally applied in the appeal court.

#### 4.8 Protection for Potential Defendant

In addition to disputing and/or making counterclaims concerning both the likelihood of the plaintiff's stated claim and the stated reason for an injunction, a defendant may – as a final defence – claim that an injunction is disproportionate. The defendant may also demand that the plaintiff provides security as a prerequisite for an injunction.

Administrative reviews cannot be initiated if a counterclaim concerning invalidity and non-infringement has been brought but not yet finally decided. If the counterclaim is brought after the NIPO has initiated the administrative review, the NIPO shall await further procedure on the matter until the legal proceedings have been finally decided.

If the defendant has filed an application for an administrative review, they may not, however, bring a counterclaim to the court, nor may a defendant who has previously brought a counterclaim to court file an application for an administrative review if the application concerns the same matter. The defendant must therefore choose which of the processes is most suitable to safeguard their interests (see section 41 of the Trademarks Act).

#### 4.9 Obtaining Information and Evidence

There are legal rules and mechanisms in the Norwegian legal system concerning disclosure and discovery.

If a party gives notice of a claim or contests a notified claim, the party shall provide information about important documents and evidence which they cannot expect the opposite party to be familiar with. The parties also have a duty of truth and disclosure, as well as a duty to testify and give evidence during the procedure before the court.

*Contributed by Kvale Advokatfirma DA* **Authors:** Marie Vaale-Hallberg, Lars Trygve Jenssen, Kaia Bugge Fougner, Tarje Neergaard

The duty to give evidence before proceedings have been initiated and during the proceedings applies irrespective of which of the parties the evidence favours (see the Dispute Act sections 5-3, first para, 21-4 and 21-5).

Any one person, including third parties, who has factual information of relevance to the trade-mark matter shall attend as a witness at a court hearing following a summons (see section 24-1).

Section 28 A-1, first para, is particularly relevant to trade-mark matters: when there is reasonable cause to believe that infringement has been made and the owner of the trade mark has petitioned the court, the court may instruct the alleged infringer to inform of the source of origin and the supply network for the goods and services to which the infringement relates. Such information may also be required from a party who has aided and abetted, been in possession of an infringing good or used/performed an infringing service as part of a business activity, who has been pointed out by anyone of the aforementioned parties, or who has made preparations to conduct an infringing activity.

#### 4.10 Initial Pleading Standards

An action concerning trade-mark proceedings is started by submitting a writ of summons to the court, including the claim that is being made, the outcome the trade-mark owner is requesting by way of judgment, the factual and legal grounds upon which the claim is based, and the evidence that will be presented. Once filed, the court will set a date for the defendant to reply, and will thereafter set deadlines for further pleadings, until a final date for a final pleading is set, which is normally three weeks before the oral hearing.

#### 4.11 Representative or Collective Actions

The Norwegian legal system does allow for both representative and collective actions, although they are uncommon in relation to trade marks. In order to bring a collective action, several parties must have claims or obligations whose factual or legal basis is identical or substantially similar and can be heard by a court with the same composition and substantially pursuant to the same procedural rules. In addition, the class procedure must be the most appropriate way of dealing with the claims and enable the nomination of a class representative. It is difficult to imagine a situation where this is done.

Another potential approach is the joinder of claims and actions, or the consolidation of cases, which enables two or more parties to act as claimants in one single action or to join the hearing of the separate cases insofar as certain requirements are met (see sections 15-2, second para, and 15-6 of the Dispute Act).

#### 4.12 Restrictions on Trade-Mark Owners

There are no rules in Norwegian trade-mark law concerning restrictions on the trade-mark owner asserting their rights against others.

### 5. Infringement

#### 5.1 Action for Infringement

An infringement action can be filed by any party with a legal interest, which essentially excludes any party who is not the owner of or a licensee to the trade mark (or a representative of either). As the right of action is regulated by the freedom of contract between the contracting parties, the owner may preclude the licensee's possibility of bringing legal proceedings concerning trade-mark infringement (see section 63 first para of the Trademark Act).

For legal actions against infringements of an unregistered trade mark, the owner or licensee must rely on proving that the trade mark has been established through use when bringing an action to court. If and when it is finally registered, a pending trade mark will have priority from the priority date, and all claims for infringement and damages will be effective from such date.

#### 5.2 Signs and Infringement

In order to succeed on a claim for trade-mark infringement, the plaintiff must demonstrate that it owns a valid mark and that the defendant has used the mark or a similar mark in commerce in a manner that is likely to confuse consumers as to the origin or sponsorship of the goods or services offered in connection with the mark. The main issues in considering the likelihood of confusion are the similarities of the marks (strength of trade-mark elements key) and the proximity or similarities of the goods and services in question.

#### 5.3 Use of a Sign by Defendant

An infringement requires use as a mark.

#### 5.4 Defences Against Infringement

The primary defences are lack of danger of confusion, ie, lack of trade-mark similarity and goods and services similarity.

The alleged infringer may also make an invalidity objection, claiming that the trade mark is not valid due to lack of priority or distinctiveness, or that it has been subject to non-use or has been used by the owner in bad faith. Parody, satire, etc, are also possible, if such factors are present.

#### 5.5 Role of Experts and/or Surveys

Expert witnesses may be appointed by a party or by the court (see section 25-2 of the Dispute Act). In the Norwegian legal system, the courts shall determine the case based on a free evaluation of evidence, so the weight of the expert opinion



will depend on credibility, etc, as proven before the court, but it can be important.

Surveys are increasingly used to document claims in trade-mark matters, and will either substantiate that the mark has acquired distinctiveness through use or that the mark is well known. Although surveys shall be taken into consideration by the courts, there is some scepticism regarding the importance attached to them. The weight of the survey will, among other things, depend on how the questions of the survey are formulated.

### 5.6 Administrative or Criminal Offence

Serious trade-mark infringements, primarily counterfeiting, can constitute a criminal offence subject to imprisonment. If an infringer is to be sentenced to imprisonment, the proceedings must be public, ie, pursued by the prosecution authority. If the prosecution authority withdraws the case or decides not to pursue, the proceedings may be subject to private prosecution. As far as is known, the Norwegian courts' authority to penalise with imprisonment has not been used.

### 5.7 Custom Seizures

The Norwegian legal system provides for customs seizure of counterfeits and parallel imports. Relevant provisions are found under the Norwegian Act on Customs Duties and Movement of Goods (Customs Act), where it is stated that the customs authorities may – notwithstanding the duty of confidentiality – notify the trade-mark owner in cases of reasoned suspicion that imported or exported goods that are subject to control by the customs authorities will constitute a violation of a trade-mark right. The customs authorities are allowed to detain the goods for up to ten business days from the date the notice was given (see section 15-1). The above-mentioned rule does not apply to private import and/or export.

Furthermore, provided that the general requirements to request a temporary injunction under the Dispute Act are fulfilled, the court may order a temporary injunction against the recipient and decide that the customs authorities shall detain the goods as long as the import or export of the goods constitutes an infringement of the trade mark. The court may also make such an order if the proprietor of the goods is unknown. According to the Customs Act, the courts shall notify the customs authorities of any preliminary order.

## 6. Revocation/Cancellation

### 6.1 Remedies and Reasons

There are numerous grounds to revoke/cancel the registration of a trade mark in Norway, eg if the general conditions of registration are not met or if the trade mark conflicts with public interests or, where no consent has been given, with

the rights of others. The trade mark may also be revoked/cancelled if it has become contrary to public order or is liable to cause offence, if it has become the general designation due to the owner's passivity, if it has become liable to deceive in respect of the kind, quality or geographical origin, if it has not been in actual use for five years after the registration, or if the use of the trade mark has been discontinued for five years.

Exemptions may, however, apply (see sections 35, 36 and 37).

In addition, if a registration of a trade mark, a renewal or an alteration of a registration has taken place by obvious mistake, the NIPO may cancel the registration in part or in full on its own initiative (see section 45, first para).

### 6.2 Trade Mark Office and Civil Courts

A revocation/cancellation action can be brought before the NIPO with a request for an administrative review under sections 35, 36 and 37. Such request may be made by anyone with a legal interest when the opposition time limit has expired and any opposition cases have been settled with a final decision (see sections 39 and 40).

A revocation/cancellation action can also be brought before the court, although only a party with a legal interest – ie, a trade-mark owner or licensee (or representative) – may bring such action. Should the owner or the licensee choose to bring a legal action, a notification shall be given to the NIPO and by registered post to each licensee with an address entered into the Trademark Register (see sections 63 and 64).

### 6.3 Statutory Limitation or Time Period

There is no statutory limitation or time period within which to file revocation/cancellation actions.

### 6.4 Initiation of Revocation/Cancellation Proceeding

Anyone with a legal interest can bring a revocation/cancellation action before the NIPO (see section 39). The request must be filed in writing and include the name and address of the requisitioner, the relevant trade-mark registration, the grounds on which the request is based, and necessary documentation supporting the request.

### 6.5 Partial Revocation/Cancellation

A trade-mark registration can be revoked/cancelled in part. If the basis for invalidity or deletion only applies to some of the goods or services for which the trade mark is registered, the registration shall be invalidated or deleted with effect only for these goods or services. This will typically be the case if the owner is able to prove use in only some of the registered categories (see section 38).

### 6.6 Possibilities of Amendment

The owner of a trade mark may request that the NIPO make alterations to a registered trade mark, normally on the condition that the pursuer retracts the revocation/cancellation proceedings. However, alterations may only be made if they are insignificant and do not affect the overall impression of the trade mark (see section 34).

Depending on the proceedings, the trade mark will either remain in its original form or be subject to revocation in part or in full.

### 6.7 Revocation/Cancellation and Infringement

An infringement action is often met with an invalidity and cancellation/revocation claim, in which case the matters are heard and decided by the same court.

## 7. Trial & Settlement

### 7.1 Special Procedural Provisions

The Oslo District Court is the mandatory legal venue for any trade mark cases related to actions concerning a review of a decision made by the KFIR, actions concerning invalidity or deletion of a trade-mark registration pursuant to sections 35, 36 and 37, and civil actions concerning infringements of a registered trademark. Legal actions concerning unregistered trade marks are subject to the ordinary rules of legal venue contained in the Dispute Act.

Cases concerning a request for a preliminary injunction follow the ordinary rules of venue. An action may therefore be filed with the district court of the ordinary venue of the defendant, or with the district court where the business enterprise's head office is located, according to the Register of Business Enterprises (see the Norwegian Dispute Act section 4-4, first and third para). As a request for a preliminary injunction is often followed by a non-infringement counterclaim, thus combining the cases and making the Oslo District Court the mandatory venue, it is primarily the Oslo District Court that deals with cases concerning requests for preliminary injunctions.

### 7.2 Determination of Cases

Trade-mark cases brought before the Oslo District Court are determined by a legal judge who specialises in trade-mark proceedings. If requested by one of the parties or if the court deems it necessary, the court shall sit with two expert lay judges, who may be appointed by the court upon its own initiative or upon the request of the parties. Expert lay judge with legal expertise, however, may only be appointed if nominated by both parties (see section 9-12, first to third para).

### 7.3 Possibilities of Settlement

The parties can choose to settle at any time until the judgment has been given. It is quite common to settle during court-sponsored mediation prior to the oral hearing in the court of first instance. If prudent, the judge will also remind and encourage the parties to discuss potential settlements during the main hearing.

### 7.4 Other Court Proceedings

Proceedings may be stayed by both the NIPO and the courts. If a legal action concerning invalidity or deletion of a registration of a trade mark is brought to court before a final decision has been made in a matter concerning an administrative review, the NIPO shall await further procedure. The procedure shall be postponed until the legal proceedings have been decided with legally binding effect. Please be advised that this only applies if the request for an administrative review was made by a party other than the trade-mark owner. The party who has requested an administrative review cannot, however, bring an action concerning invalidity or deletion to court while the case is currently subject to an administrative review by the NIPO. If the party has previously brought legal actions concerning invalidity or deletion to court, such a request cannot be made (see section 41).

In addition, the court may stay the proceedings in a case upon the request of a party if the outcome is fully or partly dependent on a legal issue that will be bindingly resolved in another case (see the Dispute Act section 16-18, first para).

## 8. Remedies

### 8.1 Existing Remedies

Compensation and damages for direct and indirect infringement of a registered or unregistered trade mark shall be determined on the basis of one of the following options, whichever is most favourable for the trade-mark owner:

- compensation corresponding to a reasonable licence fee for the use, as well as damages for any loss resulting from the infringement that would not have arisen in connection with licensing;
- damages for any loss resulting from the infringement; or
- compensation corresponding to the gain obtained by the infringer through the infringement (see section 58, first para).

In the event of wilful or gross negligent infringement, the infringer shall instead pay compensation corresponding to double a reasonable licence, if demanded by the rights-holder. In the event of infringement committed in good faith, the compensation shall correspond to a reasonable licence fee (see section 58, second and fourth para). Please be advised that the liability mentioned here may be reduced pursuant

to the Act on Compensatory Damages if there are significant reasons to suggest such a reduction.

In addition, should a party be successful in an action against the infringer, said party is entitled to full compensation for their legal costs from the opposite party. Similar to the principle established in the Act on Compensatory Damages, the opposite party may be exempted from liability for legal costs in full or in part if the court finds significant reasons to do so (see the Dispute Act section 20-2, first and third para).

### 8.2 Rights and Remedies

Should the defendant prevail, he or she will be entitled to full compensation for legal costs from the opposite party, although the plaintiff's liability for legal costs may be exempted in whole or in part if the court finds significant reasons to do so (see section 20-2, first and third para). As the Court awards compensation for legal costs based on rough calculations, the awarded costs may not be enough to cover the actual legal costs.

In addition, in accordance with the alleged infringer's claim, the court will hand down a declaratory judgment stating that the prevailing defendant may continue the prior alleged infringing activity.

### 8.3 Different Types of Remedies

The remedies for trade marks are the same, regardless of the type and classification of the trade mark.

## 9. Appeal

### 9.1 Special Provisions

There are no special provisions concerning the appellate procedure for trade-mark proceedings.

### 9.2 Factual or Legal Review

The appeal will give rise to a new trial in which the case is heard again in full. New arguments and new evidence are allowed.

### 9.3 Length of Appeal from Trial Court

An appeal from a trial court decision will normally take one to two years to be decided.

## 10. Other Trade Mark Issues

### 10.1 Recognition of Dilution

The legal standard in Norway is that a trade-mark registration cannot be opposed or subject to legal proceedings concerning degeneration if the trade mark has not yet become fully degenerated. It is, however, possible to oppose a trade-mark registration or to prevent use of a trade mark in a law-

suit if the trade mark has become fully degenerated, ie that the trade mark has become the general designation in the relevant market for goods or services of the type for which it is registered (see section 36 litra b of the Trademarks Act).

### 10.2 Protection of Famous Marks

The Norwegian Trademarks Act does protect "famous marks", referred to in the Trademarks Act as "well-known" marks. According to section 4, an identical or similar trade mark that – through use – "takes unfair advantage of, or is detrimental to, the distinctive character or repute (goodwill) of the well-known trade mark", cannot be registered without the consent of the owner of the well-known mark, provided that the trade mark is also well known in Norway.

In addition, the Trademarks Act, as opposed to the Paris Convention Article 6bis, provides protection against the use of a trade mark "for similar or any other goods or services". Article 6 bis of the Paris Convention, on the other hand, only provides protection for "identical or similar goods".

Moreover, while Article 6 bis of the Paris Convention requires that the trade mark is "liable to cause confusion", section 4, second para of the Trademarks Act only refers to the "unfair advantage" obtained by the use of the trade mark, inter alia if the use of the trade mark constitutes a risk of it being associated (but not confused) with the well-known mark. The concept of "free riding" has therefore been satisfactorily addressed in the Norwegian legislation.

### 10.3 Special Rules Regarding Geographic Indicators

A trade mark cannot be registered if it:

- exclusively, or with only insignificant changes or additions, consists of signs or indications that indicate the geographical origin of the goods or services; or
- is liable to deceive in respect of the geographical origin of the goods or services (see sections 14, second and third para and 15 first para, litra b).

It is not permissible to register a trade mark that consists of or contains anything that is liable to be understood as a geographical indication of origin for wine and spirits, unless the geographical origin of the goods is in accordance with the indication (see section 15).

### 10.4 Special Rules Relating to Surnames

The trade-mark protection enjoyed by the owner does not include the right to prohibit a third party from using its own name in the course of trade, insofar as this does not in itself represent a breach of good business practice (see section 5, second para).



## 11. Costs

### 11.1 Costs Before Filing a Lawsuit

The costs that typically arise before filing a lawsuit are lawyer fees related to the time spent when considering the matter, writing cease-and-desist letters, etc.

### 11.2 Costs Regarding an Infringement Action

Costs for bringing an infringement action to conclusion in the first instance will depend on the complexity of the case – ie, the length of the case, the need to bring in expert opinions, etc. Typically, a case can be heard in one to three court days and would accrue costs of approximately NOK300,000 to NOK1 million, ex VAT.

### 11.3 Costs of Litigation

The party who is successful in an action is entitled to full compensation for his or her legal costs from the opposite party. This includes, as a legal starting point, court fees paid, the other party's costs for representatives and expert judges, presentation of evidence which is not deemed unnecessary or disproportionate, and the expenses of the party for traveling to the court hearing. In cases where the outcome of the case was uncertain or where the successful party has rejected a reasonable offer of settlement, the court may exempt the opposite party from liability for legal costs, in whole or in full, if it finds significant reasons to do so, such as cost efficiency (see sections 10-5, first para and 20-2, first and third para).

#### Kvale Advokatfirma DA

Haakon VII's Gate 10  
0161 Oslo  
P.O. Box 1752 Vik  
0122 Oslo

Tel: +47 22 47 97 00  
Fax: +47 21 05 85 85  
Email: [post@kvale.no](mailto:post@kvale.no)  
Web: [www.kvale.no](http://www.kvale.no)



## 12. Alternative Dispute Resolution

### 12.1 Common Way of Settlement

The parties are encouraged to attempt to reach an amicable settlement out of court, and shall therefore investigate whether there is a possibility to settle the dispute before an action is brought. The parties may make use of out-of-court mechanisms such as arbitration and judicial mediation. As the Norwegian Dispute Act aims to resolve disputes outside court, court-sponsored mediation is provided prior to the main hearing in the first instance. Judicial mediation is therefore the main rule, unless the parties refuse or have agreed otherwise. Other forms of ADR are uncommon, and arbitration is rarely used. Conciliation before a conciliation board is exempted for cases concerning trade marks.

## 13. Trade Marks and Other Intellectual Property

### 13.1 Protection by Copyright

It is possible for a trade-mark owner to accumulate the protection enjoyed by the principles related to the protection of trade marks with principles related to the protection provided by a copyright, insofar as the intellectual work fulfils the requirements set out in the Copyright Act. There are, however, nuances to this matter, as underscored by joined cases 16/00148, 16/00149, 16/00150, 16/00151, 16/00153 and 16/00154.

In the aforementioned case, the KFIR addressed whether it is possible to protect an expired copyright with a trade-mark right. The KFIR found, in short, that the municipal's systematic attempt to register all the creations in the Vigeland museum and park as trade marks would represent a breach of public order and the considerations that substantiate the need for limitations in the protection of a copyright. The trade marks could therefore not be registered. The arguments presented by the KFIR suggest that the Board would have come to the same conclusion regardless – ie, that it is not possible to protect either an expired or existent copyright with a trade-mark right.

Whether cumulative or subsequent protection via trade-mark registration is possible must therefore be considered and decided on a case-by-case basis.