

**The Methodology Applied by the Intellectual Property Office to the  
Procedure Relating to the Registration of Trade Marks and the  
Procedures Based on Registered Trade Marks**

**INTELLECTUAL PROPERTY OFFICE**

**REPUBLIC OF SERBIA**

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## Table of contents

CHAPTER I: INTRODUCTION.....	7
CHAPTER II: LEGAL REGULATIONS.....	7
CHAPTER III: THE CONCEPT AND FUNCTION OF A TRADE MARK AND TRADE MARK TYPES.....	9
1. The concept and function of a trade mark.....	9
2. The subject of protection .....	9
3. The contents and the scope of rights .....	9
4. Types of trade marks .....	10
Individual trade marks .....	10
Collective trade marks .....	10
Certification trade marks .....	10
5. Acquiring a trade mark and its validity .....	10
CHAPTER IV: REGISTERS .....	11
1. The Register of Trade Mark Applications .....	11
2. The Register of Trade Marks .....	11
CHAPTER V: PROCEDURE OF THE REGISTRATION AND PROTECTION OF TRADE MARKS (OUTLINE OF PROCEDURE) .....	12
1. General rules of procedure.....	12
2. Party to the proceeding .....	13
Pleading on behalf of a party .....	13
The principle of hearing a party .....	14
3. Communication between the Office and the parties .....	14
3.1 Submissions filed by the parties to a proceeding, to the intellectual property Office .....	14
3.2. Acts issued by the Office during the course of a proceeding.....	15
Examination report .....	15
Procedural order .....	15
Decision .....	16
4. Service of process .....	16
Proof of service – service receipt .....	16
Change of domicile and/or residence, or of the principal place of business .....	17
Service of process in the event of absence of a service receipt .....	17
Mistakes in service of process .....	17
5. Time limits .....	17
6. Extension of the time limit .....	18
7. Restitutio in integrum .....	19
CHAPTER VI: PROCEDURE FOR TRADE MARK REGISTRATION .....	20
1. Initiating a proceeding for trade mark registration .....	20
Filing and receipt of a trade mark application.....	20
According of a filing date for an application .....	20
1.2.a) Indication about requesting the trade mark registration.....	21
1.2.b) Details about the applicant .....	21
1.2.c) The representation of the mark .....	21
1.2.d) The list of goods and services .....	21
2. Examination of formal requirements for trademark registration .....	22
3. Examination of material conditions for trade mark registration .....	22
4. Abandonment of a trade mark application .....	23
5. Trade mark registration and its recordation in the Register of Trade Marks .....	23

CHAPTER VII: EXAMINATION OF FORMAL REQUIREMENTS FOR TRADE MARK REGISTRATION .....	24
1. The order of examining applications .....	24
2. The contents of a trade mark application .....	25
3. The applicant .....	27
4. The representative .....	28
5. Signature .....	29
6. Representation of the mark claimed .....	29
7. List of goods and services .....	30
8. Transliteration of the mark .....	33
9. Application fee .....	33
CHAPTER VIII: RIGHT OF PRIORITY .....	33
1. General right of priority .....	33
2. Internationaonal righe of priority .....	33
3. Exhibition priority .....	35
CHAPTER IX: EXAMINATION OF MATERIAL REQUIREMENTS FOR THE REGISTRATION OF A TRADE MARK .....	35
1. Basic principles .....	35
2. Relative and absolute grounds for refusal .....	37
Relative grounds for refusal .....	37
Absolute grounds for refusal .....	37
3. Preliminary examination of the list of goods and services .....	37
4. Complaint by a third party .....	38
CHAPTER X: RELATIVE GROUNDS FOR REFUSAL .....	38
1. Identicalness and similarity .....	38
Identicalness .....	38
Similarity .....	39
The basic rules of procedure applied by the Office .....	39
Identicalness or similarity of goods and services .....	40
a) The nature of a product .....	41
b) The intended purpose of a product .....	42
c) Complementariness and competitiveness .....	42
d) The usual sale outlet .....	43
e) Relevant public (actual or potentila purchasers) .....	43
Basic rules for estimating the degree of similarity between marks .....	43
Similarity of verbal marks .....	45
General characteristics of verbal marks .....	45
Criteria for assessing similarity of verbal marks .....	45
a) Visual .....	45
b) Auditory .....	45
c) Semantic .....	45
The basic rules for examining the similarty of verbal marks .....	45
Similarity of figurative marks .....	46
Similarity of compound marks .....	46
Similarity between verbal and figurative marks .....	48
Estimating the likelihood of confusion in trade .....	48
2. Well-known marks .....	49
3. Famous trade marks .....	49
The concept of famous trade marks and its background .....	49
The relevant sector of the public .....	51.
Promotion of a trade mark .....	51
4. Concent of the owner of the conflicting trade mark .....	51
5. Infringement of copyright or industrial property rights .....	52
CHAPTER XI: ABSOLUTE GROUNDS FOR REFUSAL .....	53
1. General rules of procedure of the Office .....	53
2. Marks contrary to morality and public order .....	53
3. Non-distinctive marks .....	54

3.1. Distictiveness of a mark .....	54
3.2. Categories of non-distinctive marks .....	55
3.2.1. Generic indications .....	55
3.2.2. Marks consisting of a sigle colour .....	56
3.2.3. Marks which have lost their distictiveness (“diluted marks”).....	57
3.3. The procedure applied by the Intellectual Property Office .....	57
4. Three-dimensional marks .....	57
General requirements for the registration of 3-D marks .....	57
Examination criteria .....	58
Non-registrable 3-D marks .....	59
Registrable 3-D marks .....	59
5. Descriptive signs .....	60
The concept of descriptive signs .....	60
Criteria for establishing whether the mark descriptive .....	61
The procedure applied by the Intellectual Property Office .....	61
6. Marks customary in trade .....	62
7. Deceptive marks .....	63
7.1. Deception with regard to the type, quality, or other characteristics of the goods or services .....	63
7.1. Deception in respect of the georaphical origin of the goods or services .....	66
7.2. The procedure applied by the Intellectual Property Office .....	68
8. Official quality assurance signs .....	68
9. Flags, coat of arms and other emblems .....	68
10. National and religious symbols .....	70
11. The name or the image of a person .....	70
11.1. The name of a person.....	70
11.2. The image of a person.....	71
12. The name or the image of a deceased person and of a historical or another deceased and significant person .....	71
13. Disclaimer .....	72
13.1. The concept of a disclaimer .....	72
13.2. The purpose of a disclaimer .....	72.
13.3. Cases where it is necessary to apply a disclaimer .....	72
13.4. Requirements for applying a disclaimer .....	73
14. Acquired distinctiveness .....	74
14.1. The concept of acquired distinctiveness .....	74
14.2. Evidencing of acquired distinctiveness .....	75
CHAPTER XII: INTERNATIONAL REGISTRATION OF TRADE MARKS .....	76
1. Basic principles of international registration of trade marks .....	76
2. Determining the office of the country of origin .....	78
3. Grounds for the international registration of a trade mark .....	79
4. Requested right of priority .....	79
5. Date of the international registration .....	79
6. The request for territorial extension .....	80
7. Refusal of protection .....	80
8. The effect of the international registration in the countries specified .....	81
CHAPTER XIII: THE PROCEDURE FOR THE INTERNATIONAL REGISTRATION VIA THE INTELLECTUAL PROPERTY OFFICE .....	81
1. Grounds for the international registration of a trade mark .....	81
2. Legal capacity to file the request for the international registration of a trade mark .....	82
3. Initiating proceedings for the international registration of a trade mark .....	82
4. The procedure applied by the Office to an international trade mark application filed on the basis of a national trade mark application .....	84
International trade mark applications governed by the Madrid Arrangement .....	84
International trade mark applications governed by the Madrid Protocol .....	85
5. The procedure applied by the Office to an international trade mark application filed	

on the basis of a national trade mark .....	86
CHAPTER XIV: INVALIDATION OF TRADE MARKS .....	87
1. General provisions .....	87
2. Procedure based on the request for trade mark invalidation .....	88
3. Procedure based on the proper request .....	89
Service of process of the request for trade mark invalidation .....	89
Exchange of submissions .....	90
CHAPTER XV: REVOCATION OF A TRADE MARK .....	90
CHAPTER XVI: SPECIAL CASES OF TRADE MARK REVOCATION .....	91
1. Revocation of a trade mark on grounds of non-use .....	91
2. Revocation of a trade mark in the case when the trade mark has become the generic name of the goods or services for which it is registered .....	93
3. Revocation of a trade mark which has become deceptive .....	93
3.1. A trade mark which has become deceptive in respect of the geographical origin .....	93
3.2. A trade mark which has become deceptive in respect of the quality of the goods .....	93
4. Procedure based on the request for trade mark revocation .....	94
5. Procedure based on a proper request .....	94
Service of process of the request for trade mark revocation .....	94
Exchange of submissions .....	95
CHAPTER XVII: INSPECTION OF THE FILES AND NOTIFICATION OF THE COURSE OF THE PROCEEDING .....	96
1. General rules .....	96
2. The data contained in registers .....	96
3. The data contained in files .....	97
4. Persons entitled to inspect the data about registered trade marks and trade marks applications .....	97
The right of inspection of the data in registers .....	97
The right of inspection of files .....	98
5. Notification of the course of the proceeding .....	99
CHAPTER XVIII: SEARCH OF DATA BASE .....	99
1. The basic purpose of the search .....	99
2. Search request .....	100
Request for checking similarity or identicalness .....	100
2.2. Request for searching registered trade marks and trade mark applications in the name of a specific person .....	100
3. Procedure based on the search request .....	100
4. Search report .....	100
4.1. Contents of the search report .....	100
4.2. Contents of the extract from the data base .....	101
4.3. The legal nature and effect of the search report .....	101
CHAPTER XIX: THE PROCEDURE BASED ON THE REQUESTS FOR RECORDING ALTERATIONS .....	101
1. Legal regulations .....	101
2. Change of the name and address of the holder .....	102
Elements of the application .....	103
2.1.1. The Ž-3 Form .....	103
2.1.2. Evidence of alterations .....	103
3. Rights-related transactions .....	103
General rules .....	103
Assignment of rights .....	104
Legal grounds for assignment of rights .....	104
Filing the request .....	104
Evidence of the legal grounds for the assignment of rights .....	105
3.2.3.a) Agreement on the assignment of rights .....	105
3.2.3.b) Merger of enterprises .....	105
3.2.3.c) Assignment of rights on the basis of the law, or a court or administrative decision .....	105

Prohibition regarding making other requests .....	106
Partial assignment .....	106
Partial assignment of the rights under an application .....	106
Partial assignement of a registered trade mark .....	107
List of goods and services in the event of a partial assignment .....	107
Assignment of rights liable to create confusion in trade .....	108
Assignment of international trade mark .....	108
Recordation of a license .....	109
Filing the request .....	109
Evidence of the legal grounds for the recordation of a licence .....	109
Recordation of the licence of an international trade mark .....	109
Recordation of a pledge, franchise or another right .....	110
Notification of tax authorities .....	111
4. Division of the trade mark application and division of the registered trade mark .....	111
4.1 Division of the trade mark application .....	111
4.2. Division of the registered trade mark .....	112
5. Fees for filing a request for the recordation of alterations .....	112
5.1. Fee for filing a request for the recordation of a change of name and/or address .....	112
5.2. Fee for filing a request for the recordation of an assignment of rights, licence, pledge, franchise and other rights .....	113
5.3. Proof of the payment of the fee .....	113
6. Power of Attorney .....	113
7. Legalization of foreign documents .....	114
8. Procedure applied by the Office in respect of filing an application for the recordation of an alteration .....	115
Examination of compliance with formal requirements .....	115
Examination of compliance with substantive requirements .....	115
9. Notification of the World Intellectual Property Organisation of an alteration .....	116

## **Chapter I**

### **INTRODUCTION**

This Methodology provides a more detailed regulation of the practical aspect of the application of the provisions of the Trade Mark Law and the Regulation on the Procedure for Trade Mark Registration. It is an instruction under the competence of the Trade Mark Department and the Unit for International Trade Marks with the Intellectual Property Office, providing explanations and comments regarding the implementation of all the procedures relating to trade marks.

The Intellectual Property Office, as the competent authority, conducts the following administrative procedures relating to the registration and protection of trade marks:

- procedure based on trade mark applications;
- procedure based on international trade mark applications;
- procedure based on the request for recording alterations to and assignment of trade mark applications and registered trade marks;
- procedure based on the request for trade mark invalidation and
- procedure based on the request for trade mark revocation.

This methodology is primarily intended for the employees of the Trade Mark Department and the Unit for International Trade Marks, however it is also supposed to be of use to all the parties exercising their rights via the Intellectual Property Office.

This Methodology is not meant to be a substitute for the legal standards presented in the Trade Mark Law and the Regulation on the Procedure for Trade Mark Registration, neither can the above standards be altered by this Methodology. Its purpose is to ensure the consistency of the procedure and practice of the Intellectual Property Office regarding the registration and protection of trade marks, however, it does not anticipate all potential situations. Therefore, the Methodology is subject to indispensable amendments necessitated by practice.

## **Chapter II**

### **LEGAL REGULATIONS**

The Trade Mark Law (“Official Gazette of Serbia and Montenegro” No. 61/04) regulates the manner of acquiring and protecting the right to a mark which serves for distinguishing goods or services in trade. The purpose of this protection is to afford natural or legal persons the possibility of protecting their marks used in trade for distinguishing goods or services, in the territory of Serbia, to an extent not impinging on the rights of others.

The procedure for acquiring the right to a mark intended for distinguishing goods or services in trade, and its protection, has been regulated by the Trade Mark Law which was adopted on January 1, 2005 (“Official Gazette of Serbia and Montenegro” No.

61/04), whilst certain issues prescribed by the Trade Mark Law are regulated separately by the Regulation on the Procedure for Trade Mark Registration (“Official Gazette of Serbia and Montenegro” No. 28/05).

The procedure for trade mark registration and the protection of trade marks is an administrative procedure. The Trade Mark Law is a *lex specialis* in relation to the Law on General Administrative Procedure, and hence, the provisions of the Law on General Administrative Procedure (“Official Gazette of the SRJ” No 33/97) apply to any issues relating to the procedure for trade mark registration not specified by the Trade Mark Law.

In the procedure for the registration of trade marks, the Intellectual Property Office also acts in compliance with the rules specified in international treaties signed by the Republic of Serbia, namely:

**The Paris Convention for the Protection of Industrial Property** (Yugoslavia has been a member since February 26, 1921, published in the “Official Gazette of the SFRY” – International Treaties and Other Agreements” No. 5/74).

**The Madrid Arrangement for the International Registration of Marks** (Yugoslavia has been a member since February 26, 1921, published in the “Official Gazette of the SFRY” – International Treaties and Other Agreements” No. 2/74).

**The Protocol Relating to the Madrid Arrangement Concerning the International Registration of Marks** (Yugoslavia has been a member since February 17, 1998, published in the “Official Gazette of the SRY” – International Treaties” No. 2/97).

**The Nice Arrangement Concerning the International Classification of Products and Services for the Purposes of the Registration of Marks** (Yugoslavia has been a member since August 30, 1966, published in the “Official Gazette of the SFRY” – International Treaties and Other Agreements” No. 51/74).

**The Trade Mark Law Treaty** (Yugoslavia has been a member since September 15, 1998, published in the “Official Gazette of the SRY” – International Treaties” No. 4/98).

The fees payable to the Intellectual Property Office are subject to appropriate regulations specifying their respective amounts, namely:

**The Rates of the Federal Administrative Fees – The Law on Federal Administrative Fees and Rates** («Official Gazette of the FRY» No 81/94, 61/95, 63/96, 29/97, 12/98 and 59/98), hereinafter referred to as the Rates of the Federal Administrative Fees

**The Decision on the Reimbursement of Special Expenses of the Procedure Before the Intellectual Property Office and Expenses for Information Services provided by the Office** («Official Gazette of the FRY» No 3/06)

**Chapter III**  
**THE CONCEPT AND FUNCTION OF A TRADE MARK, AND TRADE MARK TYPES**

**1. The concept and function of a trade mark**

A trade mark represents a right providing protection for a mark used in trade for distinguishing the goods or services provided by one natural or legal person from identical or similar goods or services provided by another (Article 1 Para. 2 TL).

**2. The subject of protection**

A trade mark provides protection for a mark intended for distinguishing goods or services in trade, which can be presented graphically. A mark can consist of e.g. words, slogans, letters, numerals, pictures, drawings, colour arrangements, three-dimensional forms, a combination of such marks, as well as of musical phrases presented by musical notation (Article 4, TL). Therefore, the subject of protection provided by a trade mark may be a verbal mark, a figurative mark, as well as a compound mark (one consisting of a combination of verbal and graphic elements).

**3. The contents and the scope of rights**

Trade mark registration provides the holder of the respective trade mark with the exclusive right to use the protected mark for identifying the goods or services to which the mark applies, as well as to prohibit other persons from using the same or similar mark for identifying same or similar goods or services without an authorisation to do so, if the mark is liable to cause confusion in trade. This right includes: (1) applying the protected mark to the goods or their packaging; (2) offering the goods, trading in the goods or storing them for that purpose, or providing services under the protected mark; (3) importing or exporting goods under the protected mark; (4) using the protected mark in business documents or advertisements. An applicant is also entitled to all the rights listed, starting from the filing date of the application, and so is the holder of a well-known mark.

A trade mark holder may not prohibit other persons from using the same or another mark for designating goods or services of a different kind (the principle of a trade mark specialty). An exception to this rule are famous trade marks, whose holders may prohibit other persons from using a mark identical or similar to theirs for identifying goods or services which are not similar to those for which the trade mark is registered

(a more detailed explanation of famous trade marks is presented in Chapter X, Item 3. of this Methodology).

#### **4. Types of trade marks**

A trade mark may be an individual trade mark, a collective, or a guarantee trade mark.

A trade mark is individual also where it involves several co-holders.

##### **4.1. Collective trade marks (Article 2, Para. 2, TL)**

A collective trade mark is a trade mark of a legal person who is constituted as a form of association of producers or service providers, with the entities, members of that association being entitled to use that trade mark. Each and every user of a collective trade mark is entitled to use the trade mark only in the manner specified by the respective enactment on collective trade marks.

##### **4.2. Certification trade marks (Article 2, Para. 4, TL)**

A certification trade mark is a trade mark used by several undertakings under the supervision of the right holder of that trade mark, serving as a guarantee of quality, geographical origin, manner of production, or other common characteristics of the goods or services provided by such undertakings.

The holder of a certification trade mark must allow every undertaking to use the guarantee trade mark for goods and services having common characteristics as prescribed by the enactment certification trade marks.

#### **5. Acquiring a trade mark and its validity**

A trade mark is acquired by recordation in the Register of Trade Marks, and its validity starts running as of the date of filing the application (Article 40, TL).

The term of duration of a trade mark is 10 years, starting from the filing date of the application, and its validity may be extended by a 10-year period for an indefinite number of times subject to the payment of an appropriate fee (Art. 41, TL).

A trade mark has territorial effect, meaning that a trade mark registered for the territory of Serbia has legal effect only in the territory of Serbia and its holder may not oppose the same mark being registered for the same kind of goods in the territories of other states in the name of different trade mark holder.

## **Chapter IV REGISTERS**

The Intellectual Property Office maintains a Register of Trade Mark Applications as well as a Register of Trade Marks. The contents of these Registers are regulated by the Regulation on the Procedure for Trade Mark Registration.

### **1. The Register of Trade Mark Applications (Art. 9 of the Regulation)**

The following data is to be recorded in the Register of Applications:

- a) The Ž-number;
- b) The filing date of the application;
- c) The business name and the principal place of business of the applicant and/or the name and address of the natural person;
- d) Details about the representative if the application is submitted via a representative;
- e) Details about the joint representative, if there are several applicants;
- f) Data about the requested priority right;
- g) The mark for which protection is sought, and if protection is sought for a mark in colour – also the colour designation and the colour combination, respectively;
- h) The designation of the class numbers under which the goods or services have been classified in accordance with the International Classification of Goods and Services;
- i) Data about the outcome of the administrative procedure;
- j) The trade mark registration number;
- k) Data about alterations to the application, assignment of rights, licences, pledges, franchise, and the like; status-related changes in the applicant, licensee, franchisee, or pledgee; the limitation of the list of goods or services, and other data of significance for the legal status of the application;
- l) Data about the division of the application.

Where the application filed relates to an international trade mark registration, the details to be recorded in the Register, in addition to the ones above, are the number accorded to the application and its filing date.

### **2. The Register of Trade Marks**

The following data is to be recorded in the Register of Trade Marks:

- a) The trade mark registration number and the date of recording the right granted;
- b) The business name and the principal place of business of the applicant and/or the name and address of the natural person;
- c) The filing date of the application and the Ž-number;
- d) Data about the granted right of priority: the date of the exhibition and/or fair priority right, the date of the application which served as grounds for the

- recognition of an earlier priority right, and the name of the country where the application was filed;
- e) The representation of the trade mark;
  - f) The list of goods or services to which the protected trade mark relates;
  - g) The date of validity of the trade mark as well as the details of extension of the validity of the trade mark;
  - h) Data about alterations to the trade mark, assignment of rights, licences, pledges, franchise and the like; status-related changes in the applicant, licensee, franchisee, or pledgee; the limitation of the list of goods or services, and other data of significance for the legal status of the trade mark;
  - i) Data about the division of the trade mark;
  - j) Data about the revocation of the trade mark as well as the grounds for the revocation of the trade mark;
  - k) Data about the international trade mark registration, if the national trade mark is the grounds for the international trade mark registration.

**Chapter V**  
**PROCEDURE FOR THE REGISTRATION AND PROTECTION OF TRADE MARKS**  
**(OUTLINE PROCEDURE)**

**1. General rules of procedure**

Legal protection for trade marks is provided on the basis of the administrative procedure conducted by the Intellectual Property Office as the administrative authority having jurisdiction over intellectual property matters (Article 7, Para. 1, TL).

The scope of examination as well as the standards and criteria based on which the examination procedure is implemented must be in compliance with the applicable Trade Mark Law under which the Intellectual Property Office operates.

The process of adopting decisions must be based on uniform practice in order to ensure equal treatment for all applicants. In view of this, each examiner has to be informed about the decisions taken by other examiners, and all the examiners have to be informed about the decisions taken in the procedures based on a trade mark invalidation request or a request for trade mark revocation on grounds of non-use, as well as about the decisions rendered in administrative disputes.

Each examiner has discretionary rights in decision taking within the scope of his authority and relevant legislative provisions.

Parties and their representatives are liable to resolve the problems that may arise in the procedure applied to a trade mark application solely with the competent examiner

in charge of the respective application, or with the immediate superior of the responsible examiner.

Decisions taken in this procedure are final, and an administrative dispute may be initiated against them by filing an action directly to the Supreme Court of Serbia (Art. 7, Para. 2, TL).

Administrative procedure conducted before the Intellectual Property Office is subject to the payment of fees and reimbursement of the costs of the proceeding pursuant to special regulations on administrative fees and reimbursement of the costs of a proceeding as well as the costs of providing information services referred to in Chapter II.

## **2. Party to the proceeding**

The procedure based on a trade mark application, as well as the procedure based on an international trade mark application, and the procedure based on the request for recording alterations to and assignment of trade mark applications or registered trade marks are *ex parte* administrative procedures. The party to the proceeding is the applicant of the trade mark application, the applicant of the international trade mark application, and the holder of the registered trade mark, respectively.

The procedure based on a trade mark invalidation request and the procedure based on a trade mark revocation request are *inter partes* administrative procedures, and parties to such a proceeding are the trade mark holder and the applicant of the trade mark invalidation request, or the applicant of the request for trade mark revocation, respectively.

Any domestic or foreign natural or legal person may be party to a proceeding in respect of granting protection for a trade mark or trade mark registration.

In the procedure to register a trade mark, foreign natural and legal persons are entitled to the same rights like domestic natural or legal persons, if this derives from international treaties or the principle of reciprocity (Art. 6, TL).

### **2.1. Pleading on behalf of a party**

A domestic natural or legal person having full business capacity may perform all the acts within a proceeding by himself. A domestic natural or legal person may, if he so wishes, appoint a representative who will carry out all or any of the acts within the framework of a proceeding.

Any person having full business capacity, other than a pettifogger, may act as representative of a domestic natural or legal person (Art. 48 Para. 1 of the Law on General Administrative Procedure).

In a proceeding conducted by the Office, a foreign natural or legal person must be represented by his representative who has been registered in the Register of Representatives maintained by the competent authority, or he may be represented by a domestic legal practitioner (Art. 11, TL).

The representative performing the tasks of representation in a proceeding instituted to provide for the exercising of the right to a trade mark must have a B.A. degree in law Art. 12 Para. 2, TL).

## **2.2. The principle of hearing a party**

The principle of hearing a party is one of the basic principles of the administrative procedure. The Law on General Administrative Procedure prescribes that prior to rendering a decision, the party concerned has to be provided the possibility of submitting its statement regarding the facts and circumstances of significance for the decision pending.

This principle is also implemented in the procedures for trade mark registration and protection.

In the trade mark registration procedure, if the examiner finds that an application does not comply with the formal or substantive requirements for registering the trade mark, he must notify the applicant in writing, in the form of an examination report, informing him about the reasons why the application is objectionable, e.g. why it does not meet the formal or substantive requirements prescribed by the Trade Mark Law, inviting the applicant to submit his statement about the reasons presented, within the assigned time limit.

This rule also applies to the procedure for recording alterations and assignments of trade mark applications and registered trade marks, as well as to the procedure for declaring a trade mark invalid or declaring an international trade mark registration invalid, as well as in special cases relating to trade mark revocation.

Any statement to the examination report is subject to payment of an appropriate fee determined in Tar. No 82 of the Rates of the Federal Administrative Fees.

## **3. Communications between the Office and the parties**

### **3.1. Submissions filed to the intellectual property Office by the parties to a proceeding:**

- a) trade mark applications;
- b) different kinds of requests (relating to recording alterations or assignment of rights, recording of a licence, pledge, franchise, extension of the validity of a trade mark, and the like);

- c) requests for declaring a decision on trade mark registration or international trade mark registration invalid;
- d) requests for trade mark revocation;
- e) petitions;
- f) written communications (submissions in a broader sense).

A submission is filed either directly with the registry of the Office, or by mail. If the filing date is essential with regard to the time limit failing which the party may forfeit any one of its rights, the submission must be sent by registered mail.

The Trade Mark Law does not anticipate the possibility of filing the submissions by telegraph or telefax. Nevertheless, if the party files its submission in this manner, it is liable thereafter to file the submission with the Office registry.

Currently, there is no legal basis for filing submissions by e-mail.

## **3.2 Acts issued by the Office during the course of a proceeding**

### **3.2.1. Examination report**

An examination report is issued not only in the procedures based on trade mark application and international trade mark application, but also in the procedure relating to the request for recording alterations to and assignments of registered trade marks, and trade mark applications, respectively.

In each one of the proceedings and in each stage of a proceeding, the party thereto must be notified about the formal or material deficiencies of its application, by being issued an examination report. The examination report is to specify all the deficiencies the examiner has established in the stage of the procedure in question. Thus, in the formal examination stage, the report is to specify all the reasons why the application is considered improper. Also, in the stage of substantive examination, the examination report has to list all the reasons for which the application fails to comply with the requirements for trade mark registration (absolute and relative grounds for refusal).

The examination report is to contain an indication of the time limit assigned to the party for submitting its statement regarding the report.

### **3.2.2. Procedural order**

Procedural issues within the framework of the procedure for the registration and protection of trade marks, such as notice of payment of fees for trade mark registration and validity, as well as for extension of the time limit for submitting a statement regarding the examination report, restitutio in integrum, reviewing a proceeding, discontinuing a proceeding, and refusal of a request, are determined by a procedural order.

Procedural issues during the course of the procedure based on the request for trade mark invalidation and based on the request for trade mark revocation are also determined by a procedural order.

### **3.2.3. Decision**

All substantive issues during a proceeding are determined by a decision.

## **4. Service of process**

The Trade Mark Law does not specifically regulate service of process, and hence, this issue is subject to the Law on General Administrative Procedure. In accordance with Art. 71 of the LGAP, service of written instruments (letters, examination reports, decisions, procedural orders, trade mark certificates) as well as other official documents, is carried out, as a rule, by serving the items to the addressee. As a rule, the Office serves its written instruments by mail considering that it does not have a process server - duty officer.

Service to parties which have named their representatives is carried out via their representatives. The representatives on the list of representatives having their post-office boxes in the Office, are served directly.

Service of process to persons abroad and to persons in the country enjoying diplomatic immunity is carried via the authority competent for foreign affairs (Art. 82, LAP).

Service of process is considered to have been accomplished properly where there is a service receipt based on which it can be ascertained that the party or its representative have received the respective written instrument.

### **4.1 Proof of service – service receipt**

A service receipt is a document confirming receipt by the addressee of a written instrument, as well as confirming service thereof by the process server. A service receipt constitutes reliable evidence of service having been accomplished. A service receipt has to be signed by both parties. The process server is liable to clearly record the date of receipt on the service receipt. The time limit starts running from the date of service i.e. from the first day following the date of service.

The representatives on the list of representatives having their post-office boxes in the Office, are served directly, on which occasion they have to sign the service receipt as proof of having been served directly.

#### **4.2 Change of domicile, or of the principal place of business**

Where a party changes its domicile or the principal place of business during the course of a proceeding conducted by the Office, it must immediately inform the Office thereof. Failing this, and if the process server cannot establish where the party has moved, the Office will issue an order instructing any future service to that party to be carried out by posting the written instrument concerned on the billboard at the Intellectual Property Office. In that case, service will be considered to have been accomplished after the lapse of an 8-day time limit as of the date of posting the written instrument on the billboard at the Office. (Art. 86, LAP).

Where the representative changes his domicile or residence during the course of the proceeding, and fails to inform the Office thereof, service of process will be carried out as if the representative had never been appointed.

#### **4.3. Service of process in the event of absence of a service receipt**

If the service receipt is missing, the accomplishment of service can also be proved by other means. In the event where the service receipt is absent from the file, and where accomplishing the service cannot be proved in any other way, service of process will be repeated. If there is no proof of service even after the second attempt, service will be carried out by posting the written instrument on the billboard of the Office in compliance with Article 86 of the LAP.

#### **4.4. Mistakes in service of process**

If a mistake is made in service of process, service of process will be considered to have been accomplished on the date established to be the date when the addressee effectively received the written instrument. If the service receipt is missing, the accomplishment of service can also be proved by other means.

### **5. Time limits**

The undertaking of the individual actions in a proceeding for the registration and protection of a trade mark is subject to appropriate time limits specified by the Trade Mark Law. All the cases in respect of which the Trade Mark Law does not specify a time limit shall be subject to the time limit prescribed by the Law on General Administrative Procedure, namely, the general provisions about time limits laid down in the Law on General Administrative Procedure (Art. 89-92, LAP).

**Statutory time limits** are those specified by the Law or another regulation.

**Official time limits** are those that have not been specified by the Law or another statute and which are determined by the officer conducting the proceeding.

The Trade Mark Law prescribes the following time limits (**statutory time limits**):

- in the procedure for according a filing date – a 30-day time limit for remedying deficiencies (Art. 18 Para. 4, LT);
- for granting international priority right – the time limit specified by the Law for filing a certificate of priority to the Office is 3-months as of the filing date of the application (Art. 20 Para. 3, LT);
- for restitutio in integrum – a 3-month time limit as of the date of receipt of the procedural order on refusal of the application or the procedural order on discontinuing (cessation) the proceeding (see Item 7.1. and 7.2.)

The Regulation on the Procedure for Trade Mark Registration specifies the following time limits (**statutory limits**):

- in the procedure for recording alterations – a 30-day time limit for submitting a statement regarding the examination report (Art. 17 Para 1, and Art. 18 Para 1 of the Regulation);
- in the procedure based on the request for the invalidation of a trade mark and for the revocation of a trade mark – a 30-day time limit for submitting a statement regarding the examination report (Art. 21 Para. 1 and Art. 25 Para. 1 of the Regulation);
- in the procedure based on an international trade mark application – a 30-day time limit for remedying formal deficiencies (Art. 37 Para. 3 of the Regulation).

All other actions within the framework of a proceeding are subject to **official time limits** determined by the officer conducting the proceeding.

## **6. Extension of the time limit for submitting a statement regarding the examination report**

The extendable time limits determined by the officer in charge of a proceeding as well as statutory time limits can be extended upon request of the person concerned filed before the lapse of the time limit, provided that there are justified reasons for the extension.

Namely, if the applicant considers that the time limit assigned for him to proceed in accordance with the examination report is inadequate, he has the possibility of requesting extension of that time limit, i.e. of requesting a new time limit for proceeding on the basis the examination report. Any extension of the time limit for presenting a statement regarding the examination report is subject to the payment of an appropriate fee determined on the basis of the period of time (the number of months) by which the time limit is to be extended pursuant to the request (Rate No. 92 of the Rates of the Federal Administrative Fees).

In his request for extension, the applicant may state the period of time by which he requests that the time limit be extended. If he fails to state the exact period of time by which he wishes the time limit to be extended, the examiner will grant him an extension of the time limit by the period of time for which the extension fee has been paid.

As a rule, the examiner will extend the time limit for presenting a statement regarding the examination report by the period of time the applicant has requested. It may happen though, that, in certain cases, the applicant requests excessive time limits for presenting his statement regarding the examination report more than once. In view of this, the examiner must grant an extension of the time limit for presenting the statement about the examination report by the period of time he considers appropriate in the respective case. In this process the examiner must take into account whether the applicant has requested several short term extensions (e.g. three times, each one by a month – altogether 3 months) or whether he has requested longer extensions several times (e.g. 3 times, 3 months each – 9 months in total).

Exceptionally, no time limit extension may be granted in a proceeding for establishing compliance with formal requirements for according a filing date for an application (Art. 18, TL).

## **7. Restitutio in integrum**

The Trade Mark Law specifically provides for the possibility of filing a request for restitutio in integrum in the following cases:

7.1. In the event of the applicant failing to remedy his application within the assigned time limit, or failing to pay the fees for its remedying, he may file a request for restitutio in integrum within a 3-month time limit as of the date of receipt of the procedural order rejecting the application (Art. 25 Para. 5, TL).

7.2. The applicant has the right to request restitutio in integrum within a 3-month time limit as of the date of receipt of the procedural order on discontinuing (**cessation**) of the proceeding, also in the event of failing to present proof of payment of the fee for the first ten years of protection, within the assigned time limit (Art. 30 Para. 3, TL).

All other cases where the Trade Mark Law does not explicitly prescribe that a party may request restitutio in integrum are subject to the provisions of the Law on General Administrative Procedure regulating restitutio in integrum (Art. 93 to 98, LAP).

Restitutio in integrum will be granted only in the event the party fails to proceed in accordance with the examination report or the procedural order within the time limit assigned for justified reasons and, hence, pursuant to the provision of Article 94 of the Law on General Administrative Procedure, the party requesting restitution in integrum is liable to justify the reasons for which it was prevented from proceeding in accordance with the examination report or the procedural order within the assigned time limit. The party is liable to submit its request for restitutio in integrum enclosed

with its statement about the examination report, i.e. the party is liable to proceed in accordance with the procedural order.

The request for restitutio in integrum is subject to the payment of an appropriate fee determined in Rate No. 91 of the Rates of the Federal Administrative Fees.

The request for restitutio in integrum will be determined by the Office by a procedural order.

## **Chapter VI**

### **PROCEDURE FOR TRADE MARK REGISTRATION**

#### **1. Initiating a proceeding for trade mark registration**

##### **1.1 Filing and receipt of a trade mark application**

A proceeding for trade mark registration is initiated on the basis of a trade mark application (application) (Art. 13 Para. 1, TL).

The application has to be filed in writing, on the official form (Form Ž1), directly or by mail (Art. 2 of the Regulation on the Procedure for Trade Mark Registration).

##### **1.2 According of a date of filing**

The date of filing of the trade mark application shall be the date on which documents containing the elements specified in Article 18, TL are filed with the Office by the applicant. Therefore, at the moment of filing an application, the application has to comply with the formal requirements specified for according a date of filing.

The duty officer in charge of receiving trade mark applications checks whether the trade mark application satisfies the requirements for according a date of filing pursuant to Article 18.

Art. 18 Para. 1 of the Trade Mark Law specifies a list of elements that an application has to include in order to be accorded a filing date, namely:

- an indication that trade mark registration is being requested;
- the name and surname and/or the business name and address of the applicant;
- the mark for which trade mark protection is sought;
- the list of goods or services to which the mark applies.

**1.2.a) Indication about requesting the registration of a trade mark (Art. 18 Para. 1 Item 1)**

The application is filed on the official trade mark application form (Ž1).

**1.2.b) Details about the applicant (Art. 18. Para. 1 Item 2)**

If the applicant is a natural person, he has to indicate his full name and surname as well as his address, and if the applicant is a legal person, it has to state the data about its business name and principal place of business. In the event of a discrepancy between the data stated in the trade mark application and those in other documents (such as, for instance, the certificate of the right of priority, details in the PoA, and the like), the relevant data will be the data in the trade mark application.

**1.2.c) The representation of the mark for which protection is sought (Art. 18 Para. 1 Item 3)**

For the purposes of according a filing date for an application, it is sufficient to submit any reproduction of the mark claimed. It is important to note that the representation of the mark at that point does not have to meet the formal requirements, which are considered separately in the formal examination procedure which is regulated separately by the provision of Article 25, TL.

**1.2.d) The list of goods and services (Article 18 Para. 1 Item 4)**

Any designation of goods and services is acceptable for according a filing date for an application including a designation not specifying the class under which the goods and services have been classified. A class heading will also be accepted in according a filing date. However, indicating solely the number of the class under the Nice Classification, without listing any goods or services will not be considered adequate for according a date of filing of a trade mark application. In any case, any list submitted is subject to further assessment in the stage of formal examination of an application, which is regulated separately by the provision of Article 25, TL.

After receiving an application, the duty officer in charge of receiving trade mark applications must check whether it complies with the requirements for according a date of filing) prescribed by the provision of Art. 18, Para. 1, TL.

If the application does not comply with the requirements referred to in Article 18, Para. 1, TL), the duty officer in charge of receiving trade mark applications will invite the applicant to remedy the deficiencies within a 30-day time limit. If the applicant complies with the requirements of the Office within the time limit assigned, a procedural order will be issued recognising the date when the applicant remedied the deficiencies noted, as the date of filing the application. If the applicant fails to remedy the deficiencies within the assigned time limit, the application will be rejected on the basis of a procedural order.

If all the requirements for according a filing date (right of priority) mentioned above have been met, i.e. after the applicant has remedied the deficiencies noted, the application is assigned a number (the Ž number) and a filing date, and is thereafter recorded in the Register of Applications and forwarded to the Trade Mark Department. As a voucher of receipt of the application, the Office will dispatch to the applicant a copy of the trade mark application bearing the application number and the date of receipt recorded.

## **2. Examination of formal requirements for trademark registration – examination of regularity**

An application is considered proper if it comprises the essential parts referred to in Art. 13, 14, and 15 of the TL, proof of payment of the application fee, and other data prescribed by Art. 3. of the Regulation on the Procedure for Trade Mark Registration.

Where the examiner finds that an application is improper, he will notify the applicant by dispatching an examination report to him specifying the irregularities noted and inviting the applicant to remedy the deficiencies within a 30-day time limit.

If the applicant fails to remedy the deficiencies in the application within the time limit assigned, or if he fails to pay the fee for remedying the deficiencies, the examiner will issue a procedural order **rejecting** the application.

## **3. Examination of material conditions for trade mark registration – substantive examination**

If an application is formally proper, the examiner will proceed with checking its compliance with the requirements for trade mark registration (Article 26, TL).

At the moment of rendering the decision on trade mark registration all the requirements for trade mark registration have to be complied with (Article 26, Para. 2, TL).

Where the examiner finds that the mark applied for does not meet the requirements for trade mark registration, he will send an examination report to the applicant inviting him to submit his statement regarding the reasons noted within a 30-day time limit (Article 27 Para. 1, TL).

If the applicant submits his statement regarding the examination report to the Office within the time limit assigned, the examiner must review the statement, and having re-examined the mark claimed, he must decide on whether the mark claimed complies with the requirements for trademark registration.

If the applicant fails to proceed in accordance with the examination report, or if he does act, but the examiner still finds that the trade mark is objectionable, a decision on refusal of the trade mark application will be rendered (Article 27 Para. 4, TL).

If the applicant fails to proceed in accordance with the examination report, or if he does proceed in accordance with it, but the examiner still maintains that the trade mark is registrable only for certain goods or services, a decision on partial granting of the trade mark application will be issued (Article 27 Para. 5, TL).

#### **4. Abandonment of a trade mark application**

An applicant may abandon his application at any time. In that case, a procedural order determining discontinuance (cessation) of the proceeding will be issued.

#### **5. Trade mark registration and its recordation in the Register of Trade Marks**

Following the completion of the examination of an application, and to the extent that the mark meets the requirements for trade mark registration, the Office will issue a procedural order inviting the applicant to pay a fee for the first 10 years of protection including the costs of publication of the trade mark. If the application complies with trade mark registration requirements only in part, the Office will issue a procedural order inviting the applicant to pay a fee for the first 10 years of protection, including the costs of publication of the trade mark, as well as specifying the goods or services in respect of which the mark complies with the requirements for trade mark registration (Article 30, TL).

The amounts of the fee for the first 10 years of protection and for a trade mark certificate are determined in Tar. No 87 of the Rates of the Federal Administrative Fees. The amounts of the costs of publication of the trade mark are determined in Tar. No 2 of the Decision on the Reimbursement of Special Expenses of the Procedure Before the Intellectual Property Office and Expenses for Information Services provided by the Office

Within the time limit assigned, the applicant is liable to submit proof of payment of the above fees to the Office, and thereafter, the right granted to him is recorded in the Register of Trade Marks, and the trade mark holder is issued a trade mark certificate. A trade mark certificate has the character of a decision in the administrative procedure (Article 31, TL).

If the applicant fails to proceed in accordance with procedural order inviting the applicant to pay a fee for the first 10 years of protection including the costs of publication of the trade mark, it shall be deemed that the applicant abandoned his application and a procedural order determining discontinuance (cessation) of the proceeding will be issued (Article 30 Para 2, TL).

## **Chapter VII**

### **EXAMINATION OF FORMAL REQUIREMENTS FOR TRADE MARK REGISTRATION**

#### **1. The order in which applications are examined**

Applications are examined in the order determined by their filing dates (Article 24 Para. 1, TL).

Exceptionally, determination of an application may be carried out as a matter of urgency in the cases listed in Article 24, Para. 2, TL:

Where judicial or inspection supervision proceedings are concerned, an application will be determined as a matter of urgency exclusively upon the request of the court or the competent authority of the market inspectorate (Article 24 Para. 2 Item 1, TL).

An application will be determined as a matter of urgency, if it is an international trade mark application subject to the Madrid Arrangement for the International Registration of Marks (Article 24 Para 2 Item 2, TL). In this case, the applicant does not have to file a special request for priority-based examination of the application.

In this case, the basis for priority-based examination is the provision of Article 1 Para. 2 of the Madrid Arrangement specifying that the basis for the international trade mark registration may only be a registered national trade mark.

An application will be determined as a matter of urgency if, pursuant to other regulations, it is necessary to provide for an urgent registration. In that case, the applicant has to file a special request for priority-based examination stating the legal regulation on the basis of which he considers that he is entitled to claiming priority-based examination (Article 24 Para. 2 Item 3, TL). This request for priority examination is subject to payment of an appropriate fee determined in Tar. No 97 of the Tarif of Federal Administrative Fees.

This provision is most frequently applied in the cases of trade mark applications relating to pharmaceuticals and pesticides. The grounds for priority-based examination of pharmaceutical products is the Law on Medicines and Medical Equipment ("Official Gazette of the RS", No. 84/04 and 85/2005 while the basis for priority-based examination of pesticide applications is the Law on the Protection of Plants (Official Gazette of the FRY" No. 24/98 and 26/98). Namely, Article 33 of the Law on Medicines and Medical Equipment specifies that medicines in the Republic of

Serbia may be traded on the bases of a licence for trading in a medicine, issued by the Agency for Medicines and Medical Equipment, and Article 34 Para. 1 of the same law specifies that a request for trading in a medicine must include the name of the medicine. Article 47 of the Law on the Protection of Plants specifies that pesticides may be traded on the basis of a licence for trading in pesticides, while Article 55 Para. 2 of that law specifies that a request for trading in a pesticides is to include the trade name of the pesticide.

In examining compliance with the requirements for priority-based determining on these grounds, one must always proceed from the definition of a medicine laid down in the Law on Medicines and Medical Equipment, and/or the definition of pesticides set out in the Law on the Protection of Plants. This is important because, in addition to pharmaceutical and veterinary preparations, Class 5 also includes other products that cannot be classified under medicines for the purpose of the above law, and in respect of which there is no reason for priority-based determination of an application. Thus, for instance, priority-based determination will not be granted for a mark which is claimed only for band-aids, bandaging materials, or materials for tooth fillings.

## **2. The contents of a trade mark application**

Article 13 Para. 2, TL, specifies that the individual parts of an application are important, namely:

- a) the request for trade mark application;
- b) the mark claimed;
- c) the list of goods or services to which the mark applies.

The contents of the request for trade mark registration are specified by Article 14 of the TL and Article 3 of the Regulation on the Procedure for Trade Mark Registration.

A trade mark registration request is to be filed in two copies and it is to include the following:

- details about the applicant (data about the business name and the principal place of business of the applicant, and/or the name and address of the natural person);
- details about the representative, if the application is filed via a representative;
- details about the joint representative, if there are several applicants;
- the representation of the mark;
- an indication as to whether an individual trade mark is concerned, or a collective one, or a guarantee trade mark, a 3-D trade mark, or a musical trade mark;
- an indication of the colour and colour combination, if a mark in colour is claimed;
- a transliteration of the mark;
- a description of the mark if the applicant wishes to provide an additional clarification of the representation of the mark and its meaning, respectfully;

- an indication of the classes where the goods or services have been classified pursuant to the Nice Arrangement Concerning the International Classification of Products and Services for the Purposes of the Registration of Marks (hereinafter referred to as the Nice Classification);
- data about the requested priority right under Articles 20 and 21, TL;
- a statement disclaiming exclusive rights in the non-distinctive parts of the mark (where necessary, see the explanation of “disclaimer”);
- data about the payment of the application fee;
- the signature and the seal of the applicant or his representative;

Article 15 of the TL specifies that, apart from the elements prescribed by Article 14, TL, the applicant of a collective trade mark i.e. of a guarantee trade mark also has to submit the respective enactment on collective trade marks, while the guarantee trademark application has to be accompanied by the enactment on guarantee trade marks.

The enactment on collective trade marks includes the following:

- details about the applicant i.e. the person authorised to represent him;
- provisions about the representation of the trade mark, and the goods or services to which the mark applies;
- provisions regarding the parties having the right to use the collective trade mark and the conditions therefore;
- provisions about the rights and obligations of the users of the collective trade mark in the event of a trade mark infringement;
- provisions about the measures and consequences in the event of non-compliance with the provisions of the enactment.

In addition to the provisions relating to collective trade marks, the enactment on guarantee trade marks also contains the following:

- provisions on the common characteristics of the goods or services guaranteed by a guarantee trade mark;
- provisions on the supervision of the use of a guarantee trade mark by its right holder;

If protection is sought for a collective trade mark or a guarantee trade mark, the applicant has to indicate that fact in the request for trade mark registration.

The examination of a collective trade mark application and/or a guarantee trade mark application is subject to the same rules applying to individual trade marks.

The applicant and/or the right holder of a collective or a guarantee trade mark is liable to submit any amendments to the enactment on collective and/or guarantee trade marks to the Intellectual Property Office.

The Office does not check the veracity of the data stated in the trade mark application (Article 3 Para. 3 of the Regulation).

Article 4 of the Regulation on the Procedure for Trade Mark Registration specifies the following to be enclosed with the request for trade mark registration:

- the representation of the trade mark;
- the list of goods or services to which the mark relates, designated and classified in accordance with the Nice Classification;
- the PoA, if the application is filed via a representative;
- the enactment on collective trade marks, if a collective trade mark is claimed, and the enactment on guarantee trade marks, respectively, if a guarantee trade mark is claimed;
- a certified transcript of the application, if the right of priority under Article 20, TL, is claimed (international priority right);
- a confirmation and/or certificate if priority right under Article 21, TL, is claimed (exhibition priority right);
- declaration by the applicant disclaiming exclusive rights to non-distinctive parts of the mark, if he deems such declaration necessary;
- proof of payment of the application fee.

An application may include a request for registering a single trade mark for one or several types of goods or services (Article 14 Para. 2, TL).

### **3. The applicant**

Article 1 Para 2, TL, specifies that a trade mark is a right providing protection for a sign used in trade for distinguishing the goods or services of one natural or legal person from the same or similar goods or services of another natural or legal person. Article 6, TL specifies that in the procedure to register a trade mark, foreign natural and legal persons are entitled to the same rights like domestic natural or legal persons, if this derives from international treaties or the principle of reciprocity. On the basis of the above, the applicant may either be domestic or foreign natural or a legal person.

The applicant of a trade mark application may not be the representative office of a foreign legal person in Serbia considering that the Law on Foreign Trade specifies that representative offices do not have the status of a legal person.

The applicant has to state his name and address.

Where the applicant is a natural person, he has to state his full name and surname, as well as his address. If the applicant is a legal person, it has to state the details about its business name and principal place of business.

The applicant has to state only one address, but if he lists several of them, the one first mentioned will be considered as the address designated for service of process unless the applicant expressly designates an addresses which is to be considered as his address for service. Failure to state the details regarding telephone and fax numbers, as well as e-mail, will not be considered as a formal deficiency.

Likewise, the applicant, if a natural person, must indicate the name of the state whose national he is, and in the case of a legal person, the state where it has its principal place of business.

An application may be filed by more than one person, even in the case where they do not have a joint undertaking. Where more than one applicant is concerned, the application is to include details about the applicants' business names and their principal places of business, and/or the names and addresses of the individual applicants. If the co-applicants have not appointed their joint representative, the application will be considered proper, and service of process will be carried out to the first one of them listed in the application, and if service to the first applicant cannot be accomplished, it will be carried out to the second one listed in the application.

#### **4. The representative**

In accordance with Article 11, TL, a foreign natural or legal person involved in a proceeding before the Office has to be represented by a representative registered in the Register of Representatives maintained by Intellectual Property Office, or by a domestic legal practitioner. Article 12 Para. 2, TL expressly specifies that the representative performing the tasks of representation in a proceeding instituted to provide for the exercising of the right to a trade mark, must have a B.A. degree in law.

If an application is filed via a representative, the applicant also has to attach his original PoA for representation, to the application. If one applicant files two or several applications, he may submit the original of the general PoA with one application, stating in every subsequent application where the original of the general PoA has been attached.

Where an application has been filed by a foreign legal or natural person without a representative, the examiner is liable to invite the applicant to appoint a representative who is to be a domestic legal practitioner.

The Office may submit a list of representatives to an applicant as well as to any person concerned, however, it may not recommend any of the persons from the list.

During the course of a proceeding based on a trade mark application, the representative may be replaced. The rule that any subsequent PoA supersedes the previous one applies to that situation, without the need for the applicant to expressly withdraw the former PoA.

The representative office of a foreign legal person does not have the right to represent that legal person in a proceeding instituted to provide for the exercising of the rights under the Trade Mark Law. Thus, if a foreign legal person, being the applicant, appoints its representative office in Serbia as its representative, it will be deemed that it has no representative, and consequently, the examiner will have to invite the applicant, in the sense of Articles 11 and 12, TL, to appoint a representative from the list of representatives which is to be forwarded to him.

## **5. Signature**

An application has to be signed by the applicant, and/or the joint representative, if there are several applicants, or by the applicant's representative. If the applicant is a legal person, the application has to bear the seal of that legal person. No notarisation or legalisation of the signature is required for filing an application.

## **6. Representation of the mark claimed**

If protection is sought only for a mark consisting of words, letters, or numerals written in standard fonts, or combinations thereof without any graphical elements, the mark will be considered to be verbal, and in that case, it will be sufficient for that verbalism to be written by computer or typewriter in the appropriate space in the trade mark application form (Article 5 Para. 1 of the Regulation).

A musical mark has to be presented by means of musical notation.

If protection is sought for a mark containing figurative elements (drawings, pictures, and the like) or if a verbal mark is concerned presented in a special graphism (logo), its representation has to be clear and rendered on good-quality paper as well as suitable for reproduction, and in that case, the application is to be filed with three copies of the representation of the mark attached to it. One copy of the trade mark must be inserted by a computer, or pasted to the appropriate space in the trade mark application form, while the other two are to be enclosed (Article 14 Para. 3, TL and Article 5 Para. 3 of the Regulation).

The representation of the mark has to be produced in such a way as to make it possible to fit it into a square whose side is 80 mm long, the distance between the two most extreme points (horizontally, vertically, or diameter-wise) being not less than 15 mm (Article 5 Para. 4 of the Regulation).

No essential modification may be subsequently made to the representation of the mark in the application (Article 23 Para. 1, TL).

Presenting a word mark by using another standard font is not considered to be a modification of the original word mark. However, if the modification consists of presenting the word by using a special logo which makes the mark significantly different in relation to the one originally applied for, such modification will not be

allowed. The examiner has to assess, in each individual case, whether the manner of presenting the words of a mark is such that the mark concerned is significantly different from the one originally applied for.

In the event the submitted representation of a mark is in colour, and the trade mark application does not specify the colour, or, if the indication of the colour specifies: “black and white”, the examiner will issue an examination report to the applicant inviting him to provide a specification of the colours claimed corresponding to the colours in the representation of the mark submitted. In the event the representations of the mark in the application and in the submission are rendered in the black and white technique, and the applicant specifies the following in his trade mark application: “in a combination of all colours”, such a trade mark will be treated as being black and white. In the event there is a discrepancy between the colours listed in the trade mark application, and those in the representation of the mark submitted, the mark submitted will be considered to be in the colour combination presented in the representation of the mark submitted, and no alterations may be subsequently made to such a mark. This is determined by Article 23 Item 1, TL, which specifies that no subsequent alterations may be made to the representation of a mark in the application.

If an application is filed for granting protection for a musical mark the duration of which exceeds the length that fits into the dimensions of the square-shaped frame of the form, two copies of the musical mark are to be enclosed with the application, presented in musical notation written on musical notation paper (Article 5 Para. 6 of the Regulation).

## **7. List of goods and services**

The goods and services must be designated and classified according to the classes specified in the Nice Classification (Article 14 Para. 6, TL).

The goods or services must be grouped according to the Nice classification, each group preceded by the number of the class to which the goods or services belong and presented in the order of the classification. (Article 6 of the Regulation).

The list of goods or services is to be appended to the application in two identical copies, and the list is to be edited by computer or typewriter on quality paper.

The procedure based on a trade mark application applies the latest applicable version of the Nice Classification of Goods and Services (9<sup>th</sup> edition of the Nice Classification). On the basis of this edition of the Nice Classification, the services previously classified under Class 42, have been divided into three new classes, namely: 43, 44, and 45.

The list of goods and services must be formulated in a manner clearly identifying the nature of the goods or services and making it possible for each specific type of goods or services to be classified in only one class of the Nice Classification.

The indications of goods and services appearing in the List of Classes are general indications relating to the field to which the goods or services in principle belong. The applicant may request protection either for the goods or services defined in general terms or for the goods or services specified and belonging to a specific field. In each individual case, the examiner has to assess whether the list of goods and services is clearly formulated. Thus, as a rule, the examiner will accept as proper the list using the definitions and terms from the Class Headings. For instance, in Class 25, the applicant may request protection either for clothing, footwear or headgear, which is the heading of the stated class, or for precisely listed individual goods in this group (e.g. trousers, skirts, waistcoats, slippers, sports shoes, sneakers, hats, caps). However, the designation in class 42 “Services not belonging to the other classes” or a list defined as e.g. “all goods under Class 03” will not be acceptable. A list of goods will be considered improper if it indicates the production of certain goods. For instance, the following specification is considered improper: “Class 09: Production of electrical appliances”, while the following would be considered correct: “Class 09: Electrical appliances”.

If the goods or services cannot be classified in accordance with the above List of Classes or in accordance with the explanations attached to the respective class, the following recommendations and criteria must be applied:

#### Goods

- (a) Finished products are classified, in principle, according to their function or purpose; if that criterion is not provided for in the List of Classes, finished products are classified by analogy with other comparable finished products contained in the Alphabetical List. If none is found, other subsidiary criteria such as the material of which the goods are made or the mode of operation should be applied.
- (b) Finished products which are multipurpose composite objects, for instance clocks incorporating radios, may at the request of the applicant be classified in all the classes that correspond to each of their functions or intended purposes. If those criteria are not provided in the List of Classes, then other criteria indicated in (a) should be applied.
- (c) Raw materials, unworked or semi-worked, are classified, in principle, according to the material of which they consist.
- (d) Goods intended to form part of another product are, in principle, classified in the same class as that product only in cases where the same type of goods cannot normally be used for another purpose. In all other cases (a) applies.
- (e) Where goods, whether finished or not, are classified according to the material of which they are made and where they are made of different materials, such goods are in principle classified according to the material which predominates.

- (f) Cases adapted to the product they are intended to contain (e.g. violin cases) are classified, in principle, in the same class as the product.

## Services

- (a) Services are classified, in principle, according to the branches of activity specified in the Headings of the service classes and their explanatory notes or, otherwise, by analogy with other comparable services contained in the Alphabetical List.
- (b) Rental services are classified, in principle, in the same classes as the service provided by means of the rented objects (e.g. rental of telephones is Class 38).
- (c) Services that cannot be classified according to the above criteria are classified, in principle, in Class 42.
- (d) The activity of retail trade in goods, as such, is not a service. However, in accordance with the view specified in the decision adopted by the OHIM (EU Trade Mark Office) Board of Appeal R 46/1998-2 of December 17, 1999, if trade mark registration is requested for retail trade services, a comprehensible description of the service is required, including reference to the field within the framework of which the service is provided. For instance, the following designation of services will be correct: "Retail trade services in the field of sports items". In the absence of such a clarification it would be difficult, if not even impossible to determine the scope of protection to be granted for a trade mark.

No subsequent extension of the list of goods or services is allowed (Article 23 Para. 1, TL). However, the list may be narrowed down.

Where the examiner deems that the list of goods and services requires editing, he will inform the applicant thereof by issuing an examination report to him.

Adding new classes as a result of editing the list of goods and services will not be considered as extending the list. For instance, if the applicant has classified certain goods or a service under the wrong class, and has thereafter edited the list of goods and services by classifying them under the right class, this will not be considered as extending the list. For instance, an applicant may list beer, wine and tobacco in Class 33. However, the correct way of classifying the goods would be as follows: Class 32 beer; Class 33 wine; Class 34 tobacco. Even though the latter version of the list of goods contains three classes instead of one, as given originally, the list will not be considered to have been extended.

Narrowing down a list of goods and services means providing a precise specification. For instance, tobacco products may be specified, i.e. limited down to cigarettes, and in the case of clothing listed under Class 25, it can be limited, i.e. a precise specification can be given by indicating: suits, jackets, skirts, trousers.

Adding a new type of goods or services instead of those originally stated within the framework of the same class will not be treated as providing a precise specification, but rather as extending the list. (For instance, cigarettes – instead of tobacco, jackets – instead of suits).

If the list of goods and services filed by the applicant does not include all the classes specified in the the request for trade mark application, the list enclosed with the request for trade mark registration will be accepted and no subsequent extension of that list is allowed.

### **8. Transliteration of a mark (Art. 7 of the Regulation)**

If a mark or a part of a mark comprises letters not presented in the Latin or Cyrillic scripts, or if it comprises numerals which are not Arabic or Roman, a transliteration of that mark or its respective part is to be presented in the appropriate space in the application, rendered in Latin or Cyrillic script or Arabic or Roman numerals, respectively.

### **9. Application fee**

A trade mark application is to be filed together with a receipt of the payment of a fee in the amount specified by special regulations governing administrative fees and reimbursement of the costs of a proceeding as well as the costs of providing information services. (Rate No. 81, The Rates of the Federal Administrative Fees).

## **Chapter VIII RIGHT OF PRIORITY**

### **1. General right of priority (Article 19, TL)**

The right of priority is determined by the filing date of the application (Article 19, TL). Namely, the applicant has a priority right from the filing date of his application in relation to other persons whose applications for the same or similar mark used for identifying the same or similar goods or services, were filed after his own.

### **2. International right of priority (Article 20, TL)**

An applicant who has filed a trade mark application may claim special priority from the filing date of an earlier, proper trade mark application he filed in another member state of the Paris Union or the World Trade Organisation. He will be granted this priority right provided that he files an application in Serbia for the same mark and same goods within a term of 6 months from the date of filing the application in the former country. In this case, the trade mark application has to specify the filing date, the application number and the country in relation to which the application was filed.

Within 3 months from the filing date of a trade mark application in Serbia which constitutes grounds for its applicant to claim an international right of priority, the applicant has to file a certified transcript of such application to the Office, as well as a translation thereof into the Serbian language, certified by a sworn-in interpreter.

An application which complies with the requirements of regularity pursuant to the national legislation of a member state of the Paris Union or the World Trade Organisation, irrespective of the subsequent legal outcome of that application, shall be considered proper under Article 20 Para. 1, TL, and serving as grounds for the applicant's international priority claim. (Article 20 Para. 2, TL).

International priority right will be granted provided that a trade mark application filed in Serbia refers to the identical goods or services in respect of which an earlier application invoked by the applicant was filed. In this context, the following situations are possible:

- a) The list of goods or services which are the subject of a trade mark application filed in Serbia, may be narrower than the list of goods or services which are the subject of an earlier application filed and invoked by the applicant, but fully embraced by that earlier application. In that case, priority right will be granted for all the goods or services stated.
- b) The list of goods or services which are the subject of a trade mark application filed in Serbia, may be broader than the list of goods or services which are the subject of an earlier application filed and invoked by the applicant. In that case, priority right will be granted only for the goods or services included in the earlier application invoked by the applicant. For instance, a trade mark application is filed for the goods and services under Classes 05, 09, 16, and 35, and the earlier application invoked by the applicant refers to the goods under Class 05. In that case, priority right will be conferred only in respect of the goods under Class 05, provided that the same goods under Class 05 are concerned, while the goods or services under the other classes (05, 16, and 35) will be subject to the general priority right valid from the filing date of the application with the Intellectual Property Office. Likewise, a trade mark application may be filed, for instance, for the goods under Class 05 (pharmaceutical preparations, dietary substances, herbicides, fungicides), while the earlier application invoked by the applicant refers to the goods under Class 05 (dietary substances). In such a case, priority right will be granted for a part of the goods under Class 05 (dietary substances), while the other goods under Class 05 (pharmaceutical preparations, herbicides, fungicides) will be

granted priority right as of the date of filing the application with the Intellectual Property Office).

If the applicant claims an international priority right also for the goods or services not embraced by the earlier application invoked by him, international priority right will always be granted only for the goods identical to the goods or services included in the earlier application invoked by him, or to the goods or services stated in the list of goods or services referred to by the earlier application invoked by him, while priority right for other goods or services will be granted from the date of filing the application with the Intellectual Property Office.

However, if there is an obvious and clear discrepancy between the goods or services applied for and the goods or services in the earlier application invoked by the applicant, the examiner must notify the applicant by sending him an examination report and inviting him to adjust the list of goods applied for, to the list of goods in the earlier application invoked by the applicant. This adjustment is possible only in order to, eventually, make a precise specification, provided that the original list of goods or services is thereby not extended.

### **3. Exhibition priority (Art. 21, TL)**

An applicant who, within three months prior to filing his application, used a certain mark for designating his goods or services at an exhibition or fair of an international character in Serbia and Montenegro or another member state of the Paris Union or the World Trade Organisation, may request, in his application, that he be granted priority right from the date of the first use of the said mark.

In that case, the applicant is to file his application enclosed with a certificate issued by the competent authority of a member state of the Paris Union or the World Trade Organisation, stating that the exhibition or fair concerned are of an international character, indicating the type of exhibition or fair, the venue, the date of opening and closing of the exhibition or fair, and the date of the first use of the mark for which protection is sought.

The certificate stating that an exhibition or a fair held in Serbia are officially recognised as international, is issued by the Chamber of Commerce of Serbia.

## **Chapter IX**

### **EXAMINATION OF MATERIAL REQUIREMENTS FOR THE REGISTRATION OF A TRADEMARK**

#### **(Substantive Examination)**

### **1. Basic principles**

Each application must be considered on its own merits, taking into account its own particular circumstances and having particular regard to the trade mark and the goods or services which are the subject of the application. The examiner has to bear in mind the nature of the trade concerned, the manner in which the goods or services are provided and the relevant public, for example whether they are specialised or the general public. At the same time there must be consistency in decision making so that all applicants are treated equally. Examiners have the responsibility to keep up to date with decisions by their colleagues, particularly by the Boards of Appeal and by the Court of First Instance and the European Court of Justice.

**In the procedure of examination of substantive requirements for the recognition of a trade mark, the applicant must be notified about all the reasons why his application does not comply with the requirements for trade mark registration.**

Namely, it may happen that a mark does not comply with the requirements for trade mark registration on several grounds. In this case, the examination report prepared by the examiner is to state all the reasons because of which the mark concerned does not comply with the registration requirements. This is necessary because certain reasons can be eliminated during the course of the proceeding (e.g. obtaining the necessary approvals, editing of the list of goods, obtaining approval from the holder of the conflicting trade mark, and the like), while other reasons for denial of protection cannot be eliminated (e.g. an applicant may obtain approval from the owner of the conflicting trade mark, but the trade mark is deceptive in respect of the goods or services in the sense of Item 6; the applicant may edit his list of goods in such a way as to eliminate the deceptive character of the trade mark in relation to a part of the goods, however, the trade mark is still ineligible because of its descriptive character in respect of the other goods or services, in the sense of Item 4).

This rule of procedure derives from and is based on the general principle of the administrative procedure – the principle of efficiency - which ensures and provides for legal security. Namely, in the substantive examination stage, the applicant is notified about all the reasons making his mark non-registrable, and he is given the possibility of taking the necessary steps for eliminating the deficiencies. Conversely, if the applicant was not immediately notified of all the reasons why his mark is non-registrable, he would find himself in a situation where he would never know whether further reasons for refusing registration might be identified after he has remedied the deficiencies specified by the examiner in his examination report, (e.g. in the event of similarity being established, the applicant may obtain approval from the holder of the conflicting trade mark, whereby that obstacle would be eliminated, however, following this, the examiner might notify him that his mark is deceptive in respect of the goods or services).

Deviations from this rule are allowed only as an exception. Namely, it may happen that for technical reasons (inaccessibility of data in the International Data Base – ROMARIN - relating to registered trade marks, or inaccessibility of data in the domestic data base, or data not being updated) the search procedure may be incomplete, and consequently, the examiner may establish, during the course of the proceeding, that there is a similarity between the mark claimed and an earlier registered trade mark. In this case, the examiner will issue an examination report to

the applicant informing him about the subsequently identified reasons because of which the mark claimed does not comply with trade mark registration requirements.

If the mark claimed consists of a foreign word, the examiner must consult standard dictionaries in order to identify its meaning in the Serbian language. Translation will not involve all foreign words, but only those whose meaning is familiar to the public concerned in Serbia.

**Each trade mark application file must contain a report on the search.** Namely, in the procedure of substantive examination the examiner will prepare an report on the search in which he must indicate weather the trade mark application comply or it does not comply with the requirements for trade mark registration. Where the examiner finds that the trade mark application does not meet the requirements for trade mark registration, in the report on the search all the rasons must be indicated. The report on the search has to be signed by the competent examiner and/or by the immediate superior of the responsible examiner.

## **2. Relative and absolute grounds for refusal**

The grounds for denying trade mark registration are listed in the provision of Article 5, TL, and they may be divided into absolute and relative grounds for refusal of protection.

**2.1. Relative grounds for refusal** are those based on a collision between the mark claimed and the prior trade mark, or another intellectual property right of a third party. The Office examines these grounds *ex officio*. Relative grounds for denying trade mark protection are specified in the provisions of Article 5, Para. 1, Items 8,9, 10 and 11, TL.

**2.2. Absolute grounds for refusal** relate to the ineligibility of a mark for trade mark registration. In the procedure of examination of an application, certain absolute grounds may not be overcome at all, while others may be overcome by submitting appropriate arguments or evidence. Absolute grounds for refusal are specified in the provisions of Article 5 Para. 1 Items 1,2,3,4,5,6,7,13, Para. 2, Para. 3, Para. 4, Para. 5, Para. 6, and Para. 7, TL.

## **3. Preliminary examination of the list of goods and services**

- a) In examining similarity between the mark applied for and an earlier registered trade mark, the preliminary issue is the identicalness or similarity of the goods or services to which the marks apply;
- b) In examining the eligibility of the mark claimed (absolute grounds for refusal), examination is conducted with regard to the degree to which the goods and services covered by the mark claimed are adjusted to the meaning of the mark itself.

#### **4. Complaint by a third party**

In every stage of this procedure, any third party concerned may file a complaint to the trade mark registration, invoking either relative or absolute grounds for the refusal of protection. This complaint does not have a binding effect for the examiner, and is only an indication of potential reasons for refusal, which the examiner has to take into account in examining the application. Since the applicant is not a party to the proceeding, the examiner will not send him any notifications about his decision.

### **Chapter X RELATIVE GROUNDS FOR REFUSAL**

Relative grounds for the refusal of protection are those based on a collision between the mark applied for and an earlier registered trade mark or another intellectual property right of a third party.

The Trade Mark Law prescribes the following relative grounds for refusal of protection:

- collision with another person's identical mark registered earlier for the same or similar type of goods or services (Art. 5 Para. 1 Item 8, TL);
- collision with another person's similar mark registered earlier for the same or similar type of goods or services (Art. 5 Para. 1, item 9, TL);
- collision with an identical or similar mark which is a well-known mark for the same or similar type of goods or services (Art. 5 Para. 1, Item 10, TL);
- collision with a famous trade mark (Article 5 Para. 1, Item 11, TL);
- collision with copyright or another industrial property right (Art. 5 Para. 1, Item 12, TL).

#### **1. Identicalness and similarity:**

##### **1.1. Registration may not be granted for a mark which is identical to another person's mark protected for the same or similar type of goods or services (Article 5 Para. 1 Item 8, TL).**

Pursuant to the above provision, a mark applied for will not be registrable if it is identical to a trade mark registered earlier and whose seniority implies priority, provided that two conditions have been satisfied cumulatively:

- that the marks compared are identical;
- that the marks compared refer to the same or similar type of goods.

For the purpose of the above provision, identical marks are those which are the same in all their elements. Thus, marks comprising identical verbalisms presented in different type face will not be considered identical, and neither will they be identical if one is written out in capitals and the other one in lower case, or where one is written in capitals or in lower case, while the other one only begins with a capital.

**1.2. Registration may not be granted for a mark which is similar to another person's protected mark used to identify the same or similar type of goods or services, if that similarity is likely to cause confusion in trade and mislead the relevant public (Article 5 Para. 1 Item 9, TL).**

Pursuant to the above provision, a mark applied for will not be registrable if it is similar to a trade mark registered earlier, whose seniority implies priority, provided that three conditions are satisfied cumulatively:

- that the marks compared are similar;
- that the marks compared refer to the same or a similar type of goods and
- that the degree of similarity is such that there is a likelihood of confusion in trade.

**1.3. The basic rules of procedure applied by the Office**

When checking for similarity or identicalness, it is necessary to search the domestic data base relating to nationally registered trade marks or trade marks applied for, as well as the international data base (ROMARIN).

In the event the examination procedure turns out evidence that a mark applied for is identical or similar to a pending earlier trade mark application, the decision based on that earlier application will be a preliminary issue in the sense of the Law on General Administrative Procedure, and the examiner must render a decision on the prior preliminary issue before taking further decisions in the process.

In every individual case, the first thing that needs to be established is whether the products and services covered by the mark claimed and the conflicting trade mark, are similar or identical. In the case of identicalness or similarity of the products and services, an examination of the marks themselves has to be carried out. Conversely, if there is no identicalness or similarity between the goods and services compared, there can be no discussion about any identicalness or similarity of the marks.

When checking for similarity of figurative signs and compound signs containing graphism, the search of graphism, the examiner will consult the Vienna Classification System.

In the event of a collision between the mark claimed and a similar trade mark registered earlier, after establishing the existence of similarity between the goods and services and similarity between the trade marks, the examiner will make an assessment about whether the degree of similarity is such that there is a likelihood of confusion in trade.

### **1.3.1. Identicalness or similarity of goods and services**

In examining goods and services, the examiner must judge their identicalness or similarity exclusively on the basis of the formulations given in the lists of goods or services which are the subject of the mark applied for and the conflicting trade mark. The actual or the potential manner of use or the intended purpose of the goods, are not of significance for this examination. For example, the applicant has filed a trademark application for pharmaceuticals intended for human use, and he actually produces or intends to produce veterinary preparations.

In examining similarity of the services under Classes 43, 44, and 45, it is also necessary to make a search in respect of the services under Class 42. Namely, the lists of goods and services for trade marks registered for services under Class 42 pursuant to the formerly applicable edition of the Nice Classification have not been reclassified in respect of the services under Class 42, in the majority of cases, and in such cases, Class 42 also includes certain services classified under Classes 43, 44, and 45 pursuant to the current 8<sup>th</sup> edition of the Nice Classification,.

A grammatical interpretation of the wording of the list of goods and services is often required to determine the scope of the goods and services to be considered. This is especially the case where terms such as “in particular”, “namely”, or equivalents are used in order to show the relationship of an individual product with a broader category. The term “in particular” (or “for example”, “such as”, or other equivalent) indicates that the specific products are only examples of items included in the category, and that protection is not restricted to them. On the other hand, the term “namely” (or “exclusively” or other equivalent) is exclusive and restricts the scope of the registration only to the specifically listed goods and services.

The function of the International Classification of Goods and Services is an administrative-technical one, i.e. it serves for facilitating search. The way it is designed ensures that similar principles are used in classifying goods and services into appropriate classes, but the fact that certain goods or services belong to the same class of the international classification is not always sufficient in itself for the goods or services to be considered similar. Thus, it is possible for certain goods or services, which are essentially the same or essentially similar, to be classified in different classes. However, there are cases where goods or services which are completely different in terms of type, are classified under the same class (e.g. infant food and fungicides are classified in the same Class 5).

Because of this, in examining the similarity of goods or services, it is necessary to also act in line with the following criteria:

- the nature of the goods and services;
- the intended purpose of the goods and services;
- the manner of use;
- substitutability of the goods and services;
- the distributive channels;
- the actual or potential purchasers (the relevant public);
- the usual origin of the goods and services in terms of their place of manufacture;
- the usual sale and service outlets.

***a) The nature of a product***

In establishing the type of certain goods or of a service, one must bear in mind that where the concept of a type has a broader definition, it does not automatically mean that the products belonging to it are considered similar. Thus, for instance, even though cookies and meat belong to food products, they are not similar. Likewise, bicycles and automobiles will not be considered similar even though they belong to the broader category of vehicles.

When the definition of a type of product is sufficiently specified, similar products may be concerned. For instance, all alcoholic beverages are considered to be similar (brandy, vodka, vinyak). The same rule applies also to non-alcoholic beverages (fruit juices, mineral water and the like).

The nature of the goods is determined by their composition, the manner in which the product functions, the aggregate state of the goods, the appearance (design), the value and the like.

The composition is not decisive in establishing whether the goods are similar or not because the same product may be manufactured from different materials. However, in the case of products where the material constitutes the essence of the goods, or if it constitutes a very significant feature thereof, this criterion will be relevant for establishing whether the goods are similar. For instance, products made of rare or precious metals (gold, silver) are considered mutually similar.

The manner in which certain products function (mechanical functioning, functioning based on a motor or without it, optical, biological or chemical functioning) are also indicators of their similarity. For instance, machines and mechanical tools are not similar to manual tools. On the other hand, magnetic tapes and magnetic semi-conductors are similar because of the manner of their functioning.

Certain products are considered dissimilar because of their different aggregate states. For instance, even though chocolate and juices are food products intended for human diet, they are different products.

***b) The intended purpose of a product***

The intended purpose is the most significant criterion for establishing whether goods are similar. The intended purpose of the goods has to be understood in a narrow sense – meaning the purpose characteristic of a certain good, irrespective of the fact that goods can also have other purposes.

Examples of goods which are similar in terms of their intended purpose are: veterinary medicines and nutritional additives for fodder. Namely, both cases concern products whose purpose is maintaining or improving the health of animals.

If one of the products of the same kind has a very specific purpose, the products will be considered dissimilar. For instance, special software integrated with a dialysis apparatus as opposed to multimedia software.

Where there is a difference in terms of the nature of the goods, and similarity in terms of their intended purpose, the goods concerned will be considered similar. For instance, different pharmaceutical substances and plasters will be considered similar. Namely, the nature of these products is significantly disparate, but their intended purpose is the same – they serve for providing medical treatment for people. Likewise, footwear and clothing will be considered similar. These products are similar because of their intended purpose, even though they are of a different nature.

***c) Complementariness and competitiveness***

Goods are complementary if there is a close functional relationship between them in terms of one not being usable without the other, or if one product has significance in the utilisation of the other one. As a rule, complementary products will be considered similar. For instance, paper and pencils are similar, and so are watches and watch boxes, cigarettes and smoking kits, hardware and software, neckties and shirts.

The factor of complementariness will be of special significance where products differ in terms of their nature and intended purpose and when they are not mutually competitive. The fact that such products are complementary may be sufficient for establishing their similarity. Apart from this, in the case of such products, their distributive channels are also the same. For instance, hardware and software are different in every respect and their intended purpose is specific, but the fact that both are necessary for executing a unique function, the operation of a computer, makes them similar.

However, if complementariness is indirect, i.e. if the consumer has not created a direct relationship between such products in his mind, they will be considered different. For instance, an electrical cable and software are not considered to be similar products, but both of them contribute to the functioning of a computer.

Bottles for beverages, soft drinks and liquors are not considered similar products, and neither are manicure kits or cosmetic products.

Complementariness can be identified also in making comparison between goods and services. Namely, it is common for certain enterprises to offer maintenance for the goods they sell. This is the case in maintenance services, which are complementary with respective goods (automotive service shops and automobiles).

Goods are considered competitive where they are intended for the same circle of consumers who can make a choice among them because of their same use. In such cases, goods are considered substitutable. In this context, jewellery made of gold and bijouterie are considered similar goods.

#### ***d) The usual sale outlet***

If goods are usually sold at the same sale outlets, there is a justified reason to believe that the products concerned are similar. Nevertheless, large supermarkets sell goods of almost any kind and that is why, in determining similarity of the majority of consumer products, the criterion of the point of sale will not be decisive. However, if goods sold in specialised stores are concerned, such as for instance, fungicides and preparations for the protection of plants which are sold in herbal pharmacies, this criterion will be crucial. Despite the fact that products for different kinds of use are concerned, the fact that they have the same sale channels, and that consumers can find them in the same specialised stores, can lead consumers to conclude that the goods originate from the same producer.

#### ***e) Relevant public (actual or potential purchasers)***

Defining the concept of relevant public and the average consumer of a certain product may be of significance in establishing whether the goods concerned are similar. The fact that certain goods can serve the same group of consumers does not automatically mean that the same type of goods is concerned. For instance, suitcases and boxes for drawing kits are not considered the same even though they can serve the same group of consumers, because they are intended for satisfying their different needs and can be used on different occasions. Likewise, contraceptive pills for women and prostate drugs, even though classified in Class 05, are considered similar because they are intended for different circles of consumers. However, fish hooks which are classified in Class 28 and harpoons for fishing classified in Class 8 shall be concerned the same despite the fact that they are classified in different classes of the Nice Classification.

### 1.3.2. Basic rules for estimating the degree of similarity between marks

In estimating the degree of similarity between marks, the examiner has to take into account the degree of their distinctiveness. The more distinctive a senior trade mark, the greater the likelihood of confusion in trade. This means that trade marks with a high degree of distinctiveness, either *per se*, or because of having acquired distinctiveness in the market, are entitled to broader protection than signs having a lesser power of identification. Considering that the basic condition for the registrability of a mark is that it is eligible for distinguishing goods or services in trade, determining the degree of distinctiveness of a mark always has to involve a comprehensive assessment of the degree of eligibility of the mark for identifying the respective goods or services as the goods or services of a certain producer, and for making them distinguishable from the goods and services of other enterprises.

Marks are compared in terms of their auditory, visual and semantic features. As soon as similarity is established in terms of one of these criteria, marks will be considered similar, but if there is a difference in their meanings, these marks will, as a rule, not be considered similar.

In the case of compound marks, i.e. those composed of verbalisms and graphisms, it is first necessary to establish which part of the mark is distinctive, and which one is non-distinctive, because only distinctive elements of a mark are subject to comparison.

Compound marks, must be considered in their overall representation, taking into the similarity of the distinctive elements, while non-distinctive elements are not subject to comparison. This is due to the fact that only distinctive elements of a mark have the function of distinguishing goods or services in trade, and the holder can be granted the exclusive right of use thereof, as well as the right to prohibit other persons from unauthorised use of the same or similar mark or its distinctive element for identifying the same or similar goods. On the other hand, nobody may acquire the exclusive right of use in respect of the elements of the mark which are not eligible for distinguishing goods or services in trade, and other persons may not be barred from using these elements in their mark. Reference is being made here to designations whose function is to identify more closely the type of goods or service concerned, as well as their use, quality, quantity, mass, time and manner of production, and the like. These designations are, by their very nature, of a generic character and nobody may claim monopoly over them because they have to remain available in trade for free use by all other producers of the same or similar goods, or suppliers of the same or similar services, for the purpose of designating either the type or the other listed characteristics of their products or services.

Non-distinctive elements may not be considered separately from the entity of the mark applied for, or the registered trade mark, and, *per se*, they are not subject to comparison, but they always have to be observed and analysed in the context of the overall representation of the mark claimed or trade mark registered.

Marks will be considered similar if a non-distinctive part (for instance, common prefixes and suffixes, the generic name of the product, the name of the producer, etc.), is added to the same or similar distinctive element of the mark. In each individual case it is necessary to consider the arrangement of its distinctive and non-distinctive elements, as well as of the use of the same or similar type of font, the same or similar combination of colours, and like.

The degree of distinction between trade marks must be higher if the products or services they apply to have a higher degree of similarity (i.e. if they are related in the economic sense).

### **Similarity of verbal marks**

#### **General characteristics of verbal marks**

- a) Verbal marks are characterised primarily by their vocal structure which also determines manner of their pronunciation.
- b) If a verbal mark has no meaning (does not exist in dictionaries) it is a fanciful term.

#### **Criteria for assessing similarity of verbal marks**

- a) Visual

The application of the visual criterion implies comparing the marks on the basis of their representation (word length, number of syllables, position of the consonants, arrangement of the letters, the number of same letters with the same arrangement).

- b) Auditory

The application of the auditory criterion implies comparing the signs on the basis of their phonetic characteristics which depend on the number and arrangement of the consonants, the accentuation, and the sonority of certain vocals.

- c) Semantic

The application of the semantic criterion means comparing the marks on the basis of their meanings.

#### **1.4.3. Basic rules for examining the similarity of verbal marks**

- a) In each individual case it is necessary to establish whether the word has a meaning or whether it is a fanciful term. The rule is that two marks which are

mutually similar in terms of their auditory and visual features, but having different meanings, are considered different.

- b) Visual and auditory criteria are used in comparing fanciful concepts – words without a meaning.
- c) The usual prefixes and suffixes (e.g. PRE, PRO) which are used in the names of certain types of goods (e.g. in pharmaceutical products) are not distinctive parts of a mark, and hence, they are not compared.
- d) Particular attention has to be paid to the number and arrangement of the letters, syllables and vocals, their accentuation, and especially the number and arrangement of the vowels and the number of the same letters, the number of letters with the same arrangement, because all of these circumstances are an essential characteristic of the mark, in both the visual and the phonetic sense.
- e) The estimate of similarity of verbal marks implies also using linguistic rules relating to the equivalents of certain letters (e.g. I- Y), diphthongs and triphthongs in terms of their full transliteration and pronunciation.

### **Similarity of figurative marks**

Figurative marks can consist of ornaments (combinations of geometric pictures), the picture of one or several objects, as well as of a combination of ornaments and pictures of objects.

Marks comprising ornaments can be mutually similar only if they are similar in their overall representation, while marks comprising the pictures of objects can be similar even if they consist of pictures of different objects which produce the same impression on the consumer, because what is concerned in such a case is similarity of motives. For instance, the picture of a puma and the picture of a cheetah are similar because they create a similar impression in the mind of the consumer, so when they relate to same or similar products, there is a likelihood of confusion in trade.

In figurative marks, just like in the case of verbal marks, it is necessary to take into account the parts of the picture having a greater identifying power than those which are non-distinctive, or which are less distinctive. Examples of non-distinctive parts of graphic trade marks or of parts having a poor identifying power are: the picture of a sour cherry for sweets with the taste of sour cherry, the picture of a coconut for coconut chocolate, the picture of a pepper for spice pepper, the picture of vegetables for food additives based on vegetables, the picture of a female leg for stockings, etc. As a rule, in estimating the similarity of conflicting trade marks, these parts of the mark are neglected.

If the above mentioned pictures are the only parts of a mark, they can be registered provided that there is no senior, identical trade mark, or a similar registered trade mark for the same or similar goods. In any case, the identifying power of such a trade mark is low and this has to be borne in mind when estimating similarity.

### **Similarity of compound marks**

Compound marks are those consisting of words and pictures. These marks can be similar to verbal and graphical marks as well as to compound marks.

In every specific case, the first thing to be established is, which element of the mark is distinctive. The following combinations of graphic and verbal elements are possible:

- distinctive verbalism and non-distinctive graphism;
- distinctive graphism and non-distinctive verbalism;
- distinctive graphism and distinctive verbalism.

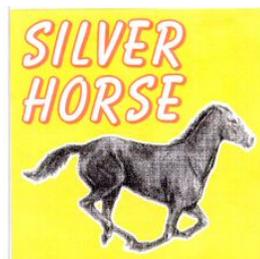
A compound mark will be similar to a verbal mark if their distinctive verbal parts are similar in accordance with one of the criteria applied to establishing similarity of verbal marks. A non-distinctive graphism added to the same or similar distinctive verbalism cannot make the mark different in relation to a conflicting mark. Likewise, adding the name of a business does not make such a mark different and eligible for protection.

A compound mark is similar to a graphic mark if its distinctive graphic parts are similar. A non-distinctive verbalism added to the same or similar distinctive graphism does not make such a mark different and registrable.

If both of the marks observed consist of a similar distinctive graphism and distinctive verbalism, similarity is estimated on the basis of the overall impression they leave on the relevant public. In estimating the overall impression, the examiner must pay particular attention to the combination of colours as well as the arrangement of the distinctive elements used in the mark.

It is possible for two marks to consist of distinctive verbalisms semantically expressing opposite or analogous ideas. Such marks will be considered similar, because if they refer the same or similar goods, exactly that opposition or analogy of ideas may create the wrong impression in the relevant public leading it to believe that the product comes from the same producer, or that there is some sort of business relationship between different producers.

**BLACK HORSE**

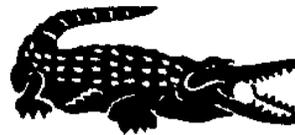


This is a case where an analogy of ideas is concerned, expressed through the combination of the same distinctive word – the noun HORSE, and the adjectives having opposite meanings (BLACK and SILVER), which, when placed in conjunction with the horse graphism (the black and the silver one), and in reference to the goods to which these marks relate (electric batteries), associate with their power (“horse power”).

### **1.7. Similarity between verbal and figurative marks**

In comparing verbal and graphic marks, the examiner must proceed from the rule that two marks will be considered similar in the event where the meaning of the word is identical to the meaning of the picture. Thus, for instance, it has been established that the following marks are similar:

#### **CROCODILE**



### **1.8. Estimating the likelihood of confusion in trade**

After establishing the existence of identicalness or similarity between the goods and services concerned, and the existence of similarity between the marks, the examiner will proceed by estimating whether there is a likelihood of confusion in trade. It is important to note, here, that no confusion need to have arisen for similarity to be present, and it is sufficient if there is a likelihood of confusion in trade and of deceiving the relevant public (EU Regulation No. 40/94 from 1993 regarding the European Union Trade Mark). The likelihood of confusion is present in the following cases: where the relevant public confuses the marks themselves, i.e. where the mark are similar to such a degree that differentiating between them is impossible or difficult; where the relevant public considers that one mark is a modification of the other, on the basis of certain common features of the trade marks observed, wrongly deducing from this that the goods or services designated by the marks originate from the same person, or that the persons using the marks are associated in a form of business..

The estimate of similarity according to the criterion of likelihood of confusion is made on the grounds of similarity, which is established on the basis of the reactions of the relevant public. Furthermore, the examiner always has to take into account the part of the relevant public for which the goods, indicated by the mark analysed, are intended. Namely, where a specific type of goods intended for specialists in a certain field is

concerned (e.g. certain special types of technical goods in Class 09 or other goods not belonging to consumer goods) it will be considered that there is a lesser likelihood of confusion in trade, because the consumer is more alert purchasing this type of goods. On the other hand, where consumer goods intended for the public at large are concerned, there is a greater likelihood of confusion because in purchasing such goods the consumer is less alert.

## **2. Well-known marks**

**Registration may not be granted for a mark which is identical or similar to, or which identifies the same or similar type of goods like, a mark which is well-known in Serbia and Montenegro in the sense of Article 6bis of the Paris Convention on the Protection of Industrial Property (Art. 5 Para. 1 Item 10, TL)**

This refers to a collision between the mark applied for and the trade mark of a non-registered mark which is well-known in Serbia in the sense of Article 6bis of the Paris Convention. The Office will not make any estimates as to whether a certain mark is well-known in Serbia in the sense of article 6bis of the Paris Convention. This is expressly prescribed by the provision of Article 26 Para. 3, TL.

## **3. Famous trade marks**

**Registration may not be granted to a mark which, irrespective of the goods or services to which it relates, constitutes a reproduction, imitation, translation, or transliteration of a registered mark, or of an essential part thereof, which is undoubtedly well-known among the relevant public in Serbia and Montenegro as a highly reputed mark (a famous trade mark) and which is used by another party for identifying its goods or services, if the use of such a mark would provide undue advantage on the grounds of the reputation acquired by the famous trade mark or if its distinctive character or reputation would thereby be impaired (Art. 5 Para. 1 Item 11, TL).**

In establishing whether a mark is a famous trade mark in accordance with the provision of Article 5 Para. 1 Item 11, the examiner will take into account the knowledge of the mark on the part of the relevant part of the public, including the knowledge of the mark the public has gained through the promotion thereof. The relevant part of the public implies the actual and potential users of the goods or services identified by that mark, as well as the parties involved in the distribution channels for the goods or services concerned. (Art. 5 Para. 4, TL).

### **3.1. The concept of a famous trade mark and the background of this trade mark category**

Article 16(3) of the TRIPS (Agreement on Trade-Related Aspects of Intellectual Property Rights) specifies the legal grounds for the protection of famous trade marks

in respect of non-competitive goods or services, provided that the mark concerned is protected by a trade mark. A new trade mark category has thus been introduced – famous trade marks entitled to extended protection, i.e. protection for all products and services, and not only those for which they are registered.

The need for special legal protection of famous marks derives from the doctrine of dilution of a trade mark. Pursuant to this doctrine, the purpose of protection provided for a famous trade mark is to ensure its unique status in trade by protecting its unique identifying power, regardless of the products or services whose identification it is used for. In essence, the legal instruments applied to trade mark dilution prevent the erosion of the unique and exclusive connection between the trade mark and the goods or services for which it is used. In its essence, dilution is a type of infringement of a famous trade mark which is not likely to create confusion, however, which, as a result of unauthorised use of the trade mark by a third party, subtracts from the glamour of the representation of the trade mark or impairs its distinctive character.

The risk of dilution is present only in the event of use of mutually substitutable trade marks on non-identical products, and it may be a subject to be considered in the event of identifying identical products by means of trade marks which are not mutually substitutable.

The following has to be established in each individual case:

- whether there is a similarity between the mark applied for and the conflicting trade mark to the effect that the mark applied for constitutes a reproduction, imitation, translation, or transliteration of the trade mark registered earlier or its essential part;
- whether the conflicting trade mark is known to the relevant public in Serbia as a mark having a high reputation (a famous trade mark);
- whether the use of such a mark would provide undue advantage on the grounds of the reputation acquired by the famous trade mark or whether it would impair its distinctive character.

In the process of establishing whether a trade mark is famous or not, the examiner will proceed from the following criteria laid down in the WIPO Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks:

- the degree of renown or distinction of the trade mark in the relevant sector of the public;
- the duration, scope, and the geographical area of use of the trade mark;
- the duration, scope and the geographical area of promotion of the trade mark, including advertising and displaying the mark at fairs or exhibitions of goods or services to which the mark relates;
- the term of duration and the geographical area of the registration and/or trade mark application;

- successful outcome of the proceedings instituted to provide for the exercising of protection, and particularly the extent to which a mark has been recognised by the competent authorities as a highly reputed one.
- the value associated with the mark.

All the above listed factors are basic guidelines intended for providing assistance in estimating the degree of renown of a mark, but the final estimate will always depend on the merits of each case, *per se*. Thus, in certain cases all of these factors may be relevant, while in other cases it may happen that the decision is based on certain additional factors not been listed here. Such additional factors may be relevant either *per se*, or in combination with one or several factors listed above.

Article 5, Para. 4, TL, prescribes that in establishing whether a trade mark is famous it is necessary to take into account the knowledge of the relevant sector of the public of the mark, including knowledge gained on the basis of the promotion of the mark.

In the sense of the provisions of the WIPO Joint Recommendations Concerning Provisions on the Protection of Well-Known Marks, (Article 2(3) (a) (i)), using the mark in Serbia will not necessarily be required as a condition for establishing whether the mark is well-known and famous. However, the use of the mark in other countries, and particularly in the territories where the same language or languages are used, and in the territories covered by same media (television or printed media) or in the territories having close commercial ties, may be relevant in determining the degree of knowledge of the mark in Serbia. Also, in each specific case, it is necessary to take into account the usual movement of the population between these regions (migrations, tourist trips, trade in goods and the like), as well as their media coverage, i.e. the accessibility of information by means of printed media (journals) as well as by electronic media (Internet, cable and satellite TV), which is a significant factor contributing to the familiarity of the relevant sector of the public with the mark.

### **3.2. The relevant sector of the public is deemed to be following:**

- Real and potential purchasers of the type of goods or services to which a mark relates.
- Persons included in the distributive channels for the type of goods or services to which a mark applies. Distributive channels may differ among themselves, depending on the nature of the goods and services. Certain goods are sold in supermarkets and they are easily accessible to consumers, while other goods are distributed exclusively via authorised dealers. This means, for instance, that an opinion poll among consumers who go shopping exclusively in supermarkets could not necessarily be a good indication for establishing the relevant sector of the public in relation to the mark used exclusively in respect of the goods sold by mail-order buying.

### **3.3. Promotion of a trade mark**

Although the promotion of a mark can be considered as using a trade mark, what is concerned here is a special criterion introduced exactly for the purpose of avoiding

potential differences regarding the interpretation of whether the promotion of a mark can be considered use of the mark. For instance, advertising in printed or electronic media (including the Internet) is a form of promotion.

#### **4. Consent of the owner of a conflicting trade mark**

In the event where a mark applied for is refused protection on grounds of its identicalness to, or similarity with an earlier registered trade mark, the applicant has the possibility of asking for the consent of the owner of the conflicting trade mark. The consent must be explicit, it has to be issued by the holder of the conflicting mark, and it is to clearly specify that it refers to the goods in respect of which the mark concerned is claimed.

The examiner does not have to accept the consent of the conflicting trade mark holder, and he must estimate it in the light of all the circumstances of the specific case, bearing in mind the degree of similarity of the mark applied for and the conflicting trade mark, the similarity of the goods or services to which they relate, as well as the likelihood of confusion in trade. Namely, one must always bear in mind that, in addition to protecting the interests of the owner of the earlier trade mark, the purpose of refusing registration of a mark which is essentially similar or identical to the earlier registered trade mark, is to protect the public interest, i.e. the interest of the consumers, who may be misled even when the owner of the earlier trade mark has given his consent.

#### **5. Infringement of copyright or industrial property rights**

**Registration may not be granted for a mark whose appearance or contents infringe on copyright or industrial property rights (Article 5 Para. 1 Item 12, TL).**

On this ground, registration will not be granted for a mark containing a graphic or a verbal element representing a work of authorship, because this would violate the copyright belonging to the person who has created the work. Thus, for instance, a mark containing a graphic element constituting a reproduction of a work of art will not be eligible for registration. Likewise, a mark comprising a verbalism which is the title of a literary work, will not be eligible for registration, because the title of the literary work is covered by copyright for the literary work identified by it, and so the copyright for the literary work also includes its title.

Example: it has been established that the mark ‘BALKAN EKSPRES BEND’ applied for in respect of the services in Class 41 (entertainment, culture activities, services intended for entertaining other parties) is not eligible for registration because ‘BALKAN EKSPRES BEND’ is the name of a well-known domestic motion picture.

On this ground, registration will not be granted neither for a mark whose appearance or contents infringe other industrial property rights such as patents, designs and geographical indications. Thus, for instance, one of the most frequent cases of

infringement of an industrial property right by a mark applied for, is using a geographical indication which is registered as the geographical indication of origin, while the applicant is not registered as the authorized user of such a geographical indication of origin.

## **Chapter XI**

### **ABSOLUTE GROUNDS FOR REFUSAL**

#### **1. General rules of procedure of the Office**

Absolute grounds for refusal are grounds relating to the ineligibility of a mark for trade mark registration.

The subject of trade mark protection is defined in the provision of Article 4, TL, which specifies that a trade mark provides protection for a mark intended for distinguishing goods or services in trade, which mark can be represented graphically. In view of this, in the procedure of examination of a mark applied for, it is first necessary to establish whether the mark filed for registration, is eligible for distinguishing the goods or services of one party from those of another.

In the procedure of the examination of eligibility, each mark has to be observed taking into account its overall appearance as well as observing it in relation to the goods or services for which protection is being sought. In the procedure of examination of the eligibility of a mark applied for, the examiner must use all the means available in order to gain the fullest possible knowledge of the concept which is the subject of the trade mark application. This means that he can obtain information about a certain concept by referring to dictionaries, professional literature, encyclopaedias, the Internet, as well as by consulting experts in the respective field. Each bit of knowledge acquired in this manner must also be accessible to other examiners either by being included in the methodology, or otherwise.

#### **2. Marks contrary to morality and public order**

##### **Registration may not be granted for a mark contrary to morality and public order (Art. 5 Para. 1, TL)**

Marks contrary to morality are those offending national, religious and other feelings. This can be expressed by words (e.g. offensive swear words, or inappropriate use of the names of distinguished personalities or saints) or by graphisms (inappropriate use of the images of distinguished personalities or saints, and the like).

Marks contrary to public order are those offending the imperative provisions of other laws. This ground is applied in the case where the applicant is at the same time the owner of an identical earlier trade mark relating to the same goods or services. In this case, the application shall be refused because of the existence of an identical earlier trade mark of the same person relating to the same goods or services. Namely, it is considered that filing a trade mark application for an identical mark and for identical goods or services by one same person, constitutes a violation of the imperative provisions of the Law on Trade (Art. 22 Para 1 of the Law on Trade – “Official Gazette of the FRY” No. 29/96). This provision prescribes that any act by a trader which is contrary to good business practices and business morality and which causes or may cause damage to another trader, another legal person or purchaser or consumer, is considered to be unfair competition. Namely, proceeding from the general legal rule, one same person may not have two rights with the same contents relating to the same subject of protection. Oppositely, granting protection to the same person for another identical mark serving for identifying identical goods, would create conditions for unfair conduct in trade. For instance: assigning an exclusive licence for one trade mark and reserving all the rights in the other trade mark, or assigning an exclusive licence to different persons.

The condition for applying this rule is that the case involves identical marks of the same holder, applying to the same goods. In this context, no identicalness of the goods will be considered to exist if one mark refers to the same **type** of goods specified (e.g. pharmaceuticals and pharmaceuticals intended for treating diabetes will not be considered identical).

### **3. Non-distinctive marks**

**Registration may not be granted for a mark which, in terms of its total design, is not eligible for distinguishing goods or services in trade. (Article 5 Para. 1 item 2, TL)**

#### **3.1. Distinctiveness of a mark**

Distinctiveness of a mark implies its identifying power, i.e. the eligibility of the mark for distinguishing goods or services in trade in the sense of Article 4, TL. This means that it will not be sufficient for a mark to be presented graphically, i.e. to consist of words, slogans, drawings, colour arrangements and the like, and it will be necessary for the relevant public to perceive it as a mark by which they distinguish and memorise the respective goods or services identified by it.

The following marks will be considered as distinctive:

- Invented or fanciful marks – These are marks consisting of words and/or graphisms not having a meaning (dictionary meaning), which are inherently distinctive (e.g. KODAK);
- Marks consisting of words and/or graphisms which, *per se*, have a meaning (dictionary meaning), however, one which is not connected in any way with

the goods, or services to which they relate (arbitrary marks). E.G. APPLE or the drawing of an apple for designating computers.

- Marks consisting of words and/or graphisms pointing indirectly to the type, quality or other characteristics of the product or services to which they relate, however, not directly describing either the type, the quality or other characteristics of such products or services (suggestive marks). Such marks require a certain degree of imagination by the consumer, i.e. mental connection between the meaning and the content of the mark on the one hand, and the goods and the services to which they relate, on the other.

Marks which do not meet the requirement of distinctiveness are not registrable. Exceptionally, a mark which is not distinctive may, in certain cases and under precisely prescribed conditions, become distinctive. This is the case of acquired distinction of a mark, which is explained in detail in Chapter XI, Item 14 of this Methodology.

The basic criteria in the proceeding for determining the distinctiveness of a mark is whether it is perceived by the relevant public as a distinguishing mark, i.e. whether they recognise and memorise the goods of a certain producer by it, or whether they know that the goods designated by it originate from a specific producer.

### **3.2. The category of non-distinctive marks includes:**

#### **3.2.1. Generic indications, i.e. indications having a general meaning**

Generic indications are words, numerals, letters, and drawings representing the general concept of a product or services in relation to which they are used. Generic indications do not have the function of a trade mark, because they are ineligible for distinguishing goods or services in trade, by their very nature. These are the indications that the relevant public recognises as distinguishing marks.

Presenting generic words, numerals or letters by using the usual type of script, will not be considered distinctive.

Marks consisting of a single digit number, or a single letter will be considered non-distinctive if they do not contain any additional distinctive elements, or if no special distinctive graphic stylistic design of the mark is involved.

Simple drawings, such as a circle, a dot, or a line, will be considered non-distinctive, if they do not have any other distinctive element.

Simple 3-D object shapes (bottle, cube, sphere) will be considered non-distinctive if they are devoid of additional distinctive elements, such as, for instance, verbalisms, graphisms or a combination of colours.

A generic word with a non-distinctive (generic) graphism will be considered non-distinctive.

Coined words consisting of non-distinctive generic words will not be considered distinctive as a whole.

If a mark consists of a generic word and a distinctive graphism, it will be considered distinctive as a whole.

If a mark consists of a combination of several elements which, *per se*, do not have distinctive characteristics, the mark could be considered to have a distinctive character if such a combination is distinctive in terms of its overall representation.

Words, numerals, letters, or drawings which are non-distinctive *per se*, will be considered distinctive if they are presented in a specific manner which makes them distinctive in that specific case.

### **3.2.2. Marks consisting of a single colour**

Trade mark registration may not be granted for a mark consisting solely of a colour, unless a combination of colours having a specific form is concerned. Namely, the colour is only an additional element of the mark which has a certain form constituted either by a figurative element, a compound drawing, or a shape.

While compound marks in colour can satisfy the condition of distinctiveness and serve for distinguishing the goods and services of one person from those of another, a mark consisting of nothing but a colour, as a rule, does not have the appropriate distinctive features, because the relevant public usually does not perceive a colour as a trade mark.

The basic precondition for granting trade mark registration is for the colour or a combination of colours to have an appropriate identifying power, i.e. the power of distinguishing goods and services in trade. Because of this, each individual case requires to be examined in terms of establishing whether or not the relevant public perceives the colour as a distinguishing mark, i.e. whether or not they distinguish the goods to which the colour relates by means of that colour.

Distinctiveness sufficient for registration may be inherent, i.e. a combination of colours may be distinctive *per se*, or it may be acquired through use. A single colour will usually be without distinctive characteristics, except for the case where distinctiveness has been acquired through earlier use.

In the case of a mark consisting of a single colour, the applicant has to prove that the colour is not functional or generic, for instance, that it does not have to remain available for identifying the goods or services for which protection is sought.

Marks consisting of a figurative element presented in colour are, as a rule, eligible for registration, provided that they do not involve a basic geometrical form which would be considered generic (e.g. a circle, a triangle, and the like)

In the event of establishing the non-distinctiveness of a mark, the examiner must inform the applicant, by dispatching him an examination report, that the mark applied for is not eligible for registration.

### **3.2.3. Marks which have lost their distinctiveness (“diluted marks”)**

The marks concerned here are those which are an integral part of a large number of already trade marks registered in the name of different trade mark holders for the same or similar type of goods or services. Those marks have lost their distinctiveness and they may not be protected by a trade mark on their own merits but solely, by adding another distinctive element.

### **3.3. The procedure applied by the Intellectual Property Office**

In the case of a non-distinctive mark, the applicant, mainly, does not have the possibility of eliminating this deficiency, because any addition of a distinctive element would be considered as an essential modification of the mark in the sense of Article 23, TL. An exception to this is the case where the applicant proves acquired distinctiveness by presenting appropriate evidence. Namely, a mark which is non-distinctive *per se*, will be granted registration if the applicant proves that his mark has become eligible for distinguishing the goods and services to which it applies in trade, through serious use (Article 5, Para. 2, TL).

## **4. Three-dimensional marks**

**Registration may not be granted for a mark representing exclusively a form determined by the nature of the goods or a shape of the goods dictated by the desired technical result (Article 5 Para. 2 Item 3)**

This provision excludes the registrability of a certain type of 3-D marks.

### **4.1. General requirements for the registration of 3-D marks**

In general, 3-D marks can be registered if they meet the requirement of distinctiveness. Hence, the registrability of 3-D marks, just like in the case of other marks, must always be established by proceeding from the general rules of eligibility, taking into account the goods for which the protection is sought.

Where examination of a 3-D trade mark application is concerned, it is first necessary to examine its distinctiveness and functionality.

Just like in the case of all other trade marks, distinctiveness is the basic precondition for the registration of a 3-D trade mark. Distinctiveness may be inherent, meaning that a specific shape is in itself distinctive in relation to the goods or services for which protection is sought, and that the public can recognise it immediately as well as perceive it as a sign of distinction. On the other hand, distinctiveness can be acquired through use.

The specificity of 3-D marks is reflected in the fact that the possible forms of packaging are most often limited to simple geometrical objects for practical reasons, because they occupy less space and facilitate packaging and storage of goods. Such forms have a functional character and use value, and in view of this they have to remain freely available for all producers, without anybody being entitled to acquiring monopoly over such forms, and 3-D marks where such functional character is prevalent, do not have distinctive characteristics. In view of this, it is necessary to establish in each specific case where a 3-D shape is claimed, whether or not the shape is characterised by the use value i.e. the functional character in respect of the goods to which it applies. Namely, the presence of the use value and the functional character of a mark claimed, does not automatically preclude that kind of protection, while invoking functionality as grounds for refusal of registration is possible in the event the shape has no other elements except for functional ones.

If it is established during examination procedure that a 3-D mark does not meet the requirements for registration on grounds of non-distinctiveness or because it is predominated by its functional character, the applicant may submit his statement and evidence in order to prove that the requirements for granting registration have been met. Where the examiner has established that a mark which is not inherently distinctive has acquired distinctiveness, the registration of such a mark provides the same scope of protection like in the case where the mark is found to be inherently distinctive.

Consequently, the examiner will refuse the registration of a 3-D mark consisting exclusively of standard or ordinary packaging (bottles, boxes, and the like) or of a standard or ordinary shape of the product for which protection is sought. Where a 3-D mark includes other elements as well, such as words or figurative elements, or colour, and where such other elements by themselves or in combination with the 3-D shape make the mark distinctive and eligible for protection, the examiner will not reject the application.

#### **4.2. Examination criteria**

Each specific case needs to be checked for the following:

- a) Which function of the 3-D shape is prevalent – its identifying and distinguishing functions or its use function. Consequently, the requirements for trade mark registration will be met if the 3-D shape primarily has an identifying function, and only as a secondary feature, if it has a use value (e.g. if it serves for obtaining a technical result – storage and transport of goods).

- b) Whether the specific 3-D shape is commonplace or whether it is necessary in trade as packaging for the goods applied for. Therefore, a 3-D shape which is not commonplace in trade for the goods to which it relates, will be found to be eligible and distinctive.
- c) Whether the 3-D shape concerned is the usual shape of the goods which are the subject of the application.
- d) Whether the geometric form concerned has a functional value (whether it facilitates transport or the storage of goods).
- e) Whether a simple or a complex geometric shape is concerned (sphere, cylinder, cube).
- f) The mark will be examined by taking into account its total design consisting of the shape, colour, figurative and verbal elements.
- g) The duration and the scope of use of the mark applied for, in the case of a mark not being distinctive *per se*.

#### **4.3. Non-registrable 3-D marks**

- Registration may not be granted for a mark representing exclusively a standard or ordinary packaging of goods (bottle, box, and the like) to which the mark applied for relates, or a standard (ordinary) shape of the goods to which the application relates.
- Registration will not be granted for a mark representing a shape deriving from the very nature of the goods. Consequently, a 3-D trade mark may not be used for claiming the packaging as goods, however it may be used for claiming the goods packaged inside such a packaging. For instance, trade mark registration may not be granted for a 3-D shape of a bottle as goods, because the shape of the bottle derives from its very nature and function. However, if the condition of distinctiveness has been satisfied, a 3-D bottle shape will be eligible for trade mark registration in respect of the beverage bottled therein. Namely, liquids can take any shape, i.e. the shape of a liquid is determined by the shape of the packaging, and hence, the form of the packaging for a liquid does not derive from the nature of the product itself – the liquid (juice, water, liquors, and other liquids).
- Registration will not be granted for a mark representing the shape of a product, if such shape is indispensable for obtaining the required technical result. For instance, while the pins in an electric plug are necessary for the plug to work, the overall shape of the plug is not determined by this technical requirement.
- If the use and functional values of a 3-D shape for which protection is sought is prevalent in relation to its identifying function (the view of the European Court of Justice) such a mark will not be registrable.

#### **4.4. Registrable 3-D marks**

A 3-D mark will be granted registration in the following cases:

- In the case where the mark applied for has a dominant identifying function or if its functionality is not decisive, respectively. Thus, for instance, a mark will be considered to have a dominant identifying function if it is established that the shape applied for does not facilitate the transport and packaging of the goods (for instance, hexagonal-shaped chocolate – TOBLERONE)
- If the mark also comprises other elements (verbal or graphic ones, or colour or a colour combination) and where other elements by themselves or in combination with the 3-D shape, make that mark distinctive and eligible for registration (combined 3-D trade mark).
- In the case where the mark applied for has become distinctive through its prolonged use among the relevant public in respect of the goods to which it relates, provided that the applicant has submitted evidence substantiating this (invoices specifying the quantity of the products sold, advertising material and the like).

## 5. Descriptive signs

**Registration may not be granted for a mark identifying exclusively the type of goods, or services, their use, the time or the manner of their production, quality, price, quantity, mass or geographical origin (Article 5 Para. 1 Item 4).**

### 5.1. The concept of descriptive signs

The marks referred to here are those having a descriptive character, i.e. those containing exclusively a direct statement regarding the type or other characteristics of the product or services (quality, use, time or manner of production, price, quantity, mass and geographical origin).

These marks are devoid of distinctive features, because they describe goods or services rather than individualising them. They comprise exclusively data about goods or services which have to be left available for producers for them to be able to indicate, directly and clearly, the type of their products or services as well as certain characteristics thereof, thus informing the customers about the products. These marks are excluded from registration because no monopoly can be established over them in favour of any individual, as this would practically mean establishing monopoly over information regarding the type and characteristics of goods, the consequence of which would be excluding the right of other producers to use the same mark in describing the type and characteristics of their products.

Examples:

Type of goods: “wine” for wine, “popcorn” for popcorn

Quality: “premium”, “light” for soft cigarettes

Quantity: numerals, either in words or numerals indicating quantity

Use: “baby” for infant food, “for the kitchen” for cleaning agents

Price: “cheapest”

Geographical origin: the name of the place, locality, region or state where the goods indicated are sold or where the services indicated are provided (e.g. “Livanjski cheese”, “Leskovacki” for meat and meat products).

Time of production: “fresh each day” for fruit and vegetables

Time of providing the service: “24 hour banking”

Other characteristics:

## **5.2. Criteria for establishing whether the mark which is the subject of examination is descriptive**

A mark will be considered descriptive in the following cases:

- if there is a clear and direct relationship between the mark and the type of goods or services or their other characteristics;
- if, in the perception of an average consumer, that specific term represents a description of the type of goods or services or their other characteristics;
- if it is indispensable for a mark, which is the subject of a trade mark application, to remain available for identifying the type, quality, use, price, quantity, mass and geographical origin of products.

## **5.3. The procedure applied by the Intellectual Property Office**

The provision of Article 5 Para. 1 Item 4, TL, specifies that a mark will be considered descriptive if it consists **exclusively** of the element or elements serving for identifying the type of goods or services, their use, the time or manner of their production, quality, price, quantity, mass and geographical origin. This means that adding a distinctive element, either of a verbal or graphic kind, would make this mark distinctive in its total design, with the need to estimate the distinctiveness of that element in every specific case.

In every specific case, a mark must be examined on the basis of its total design. A mark will be considered descriptive if, in its entirety, it describes the type, use, time or manner of production, quality, price, quantity, mass and geographical origin of the goods or services.

For instance, the mark consisting of the verbalism **HEALTHY WATER** is of a descriptive character in relation to the goods in Class 32 (mineral and soda water). This mark describes the type of goods (water) and its quality (healthy).

Where marks comprising exclusively verbalisms are concerned, it will be considered that minor modifications to the font type used in presenting the word (for instance, Italics), will not lend the mark appropriate distinction. A mark may consist of a word which is descriptive *per se*, but which is presented in a specific manner, either in a specific font or a specific colour combination. In view of this, in each individual case, the examiner must estimate, whether the manner of stylization of the word itself has appropriate distinctive features.



The mark True Value can be considered to be a laudatory term, because it indicates to the purchasers that by purchasing the products indicated by this mark, they get true value for the price they pay. Nevertheless, this mark may be registered as a trade mark because it has a distinctive graphic solution constituted by the special type of letters and combination of the white colour of the letters and the black background on top of which the verbalism is written.

A verbal mark having a descriptive character, however, presented with a deliberate spelling mistake, will not be considered distinctive. For instance, a mark misspelled such as in the case of “popkorn” instead of the correct spelling: “popcorn”, will be objectionable.

Coined words consisting of two descriptive words, are not considered distinctive as a whole. Namely, joining two non-distinctive words does not make the coined word distinctive, because the individual non-distinctive words making up the coined word have their own meanings, and the coined word itself, when pronounced, is always divided into two non-distinctive words and could never be pronounced as a single word.

For instance the mark **OSTEOPROTECT** is not eligible for registration for the goods in Class 05 (pharmaceuticals and veterinary products, dietary products for medical use, dietary substances for medical use, intended for the protection of bones and treating of bone diseases).

In respect of trade marks intended for identifying medicines and medical equipment, a mark consisting exclusively of the name of the chemical substance from which the medicine is produced will be non-eligible for registration, and so will be the mark deviating only slightly from the generic name of the chemical substance. The recommendation of the World Health Organisation is for the mark to be distinguishable from the generic name by at least three letters. In examining the eligibility of the marks identifying pharmaceuticals, the examiner must make an inspection of the register of generic non-proprietary names (INN - International Non-Proprietary Names).

A check must always be made for the eligibility of a mark in terms of Article 5 Para. 1 Item 4, TL, in relation to the goods or services applied for. Namely, a mark may be descriptive in relation to the specific type of goods, however, such a mark may be eligible for registration in relation to another type of goods, because it is considered a fanciful term in relation to them. For example: the mark DIESEL would be of a descriptive character for diesel motor fuel in Class 04, however, it is also of a fanciful character in relation to the goods in Class 25 comprising clothing.

## **6. Marks customary in trade**

**Registration may not be granted for a mark commonly used for identifying a certain type of goods or services (Art. 5 Para. 1 Item 5, TL).**

A trade mark may not consist exclusively of marks or designations that have become common in everyday discourse or in good business practices in the branch of trade to which a trade mark relates. Even though there is a certain overlapping with the former article, this case refers to verbal or graphic elements which do not designate the type, quality, use and other characteristics of the goods or services, but to elements commonly used in relevant business circles and in certain fields of trade in connection with the specific goods or services. Examples of such marks are the words NET and NETWORK for computers; the letter “L” for schools providing driving lessons; CASH AND CARRY, for a certain method of purchasing goods; a bunch of grapes or grapevine for wine.

This category of marks also includes those registered at an earlier point in time and which were eligible for registration at the moment of their registration, however, which have become common over time, in identifying a certain type of goods or services, thus, practically becoming synonymous of such goods or services at the same time as becoming a part of the colloquial language.

Examples: IMMALIN, KALADONT, GRISSINI, MAGNETOHPONE, GESTETNER

Exceptionally, these marks will also be granted registration if the applicant proves that his mark has become eligible, through serious use, for distinguishing the goods and services in trade to which it applies (Article 5 Para. 2, TL).

## **7. Deceptive marks**

**Registration may not be granted for a mark which is likely to create confusion in trade by its representation or content, with regard to the origin, type, quality or other characteristics of the goods or services (Article 5 Para. 1 Item 6, TL).**

The above provision excludes registration of deceptive marks. A mark may be deceptive, or it may contain certain deceptive elements, such as different indications providing a closer description of the type, origin, quality, or another characteristic of the goods, which, in the case concerned, do not correspond to the real type, quality, origin or another characteristic of the goods to which the mark claimed relates.

In order to be able to establish whether a certain term (concept) is deceptive, the first thing the examiner has to identify is the meaning of the term (concept) in relation to the goods or services to which it relates and to establish whether that designation constitutes a wrong indication of the characteristics of such goods or services.

Furthermore, the examiner has to estimate whether the mark concerned is likely to cause confusion in trade in relation to the goods and services it is claimed for.

### **7.1. Deception with regard to the type, quality, or other characteristics of the goods or services**

In each individual case, the examiner has to establish, whether the relevant circles of consumers will be deceived in respect of the type and characteristics of the goods or services. Consumers will be deceived in the case where the total design or content of the mark produces a wrong perception in their minds as to the type, quality, origin or other characteristics of the goods or services. Consequently, confusion may arise in the market, because, when making a purchase, the relevant public is prompted to decide in favour of a certain item, which, in terms of its nature, origin, quality or other characteristics does not correspond to the one desired.

The relevant public is understood to mean the current and potential purchasers of the products and/or users of the services covered by the mark claimed.

The following has to be established in each individual case:

- a) whether the mark applied for indicates, by its total design or content, that the products it refers to are made of a special material or that they are of a special quality, in which case the material or the quality may have a significant impact on the purchaser's decision;
- b) whether relevant circles of consumers could come to the conclusion, based on the representation and the content of the mark, that the goods applied for are of a special material and/or that they are of a special quality, and
- c) whether the material and/or quality in the case concerned, are a significant factor making the purchaser decide in favour of purchasing the goods concerned.

A mark will be considered deceptive in respect of the type of goods where the relevant public in trade, when making a purchase, expects to be purchasing exactly the goods designated on the mark. In other words, each individual case requires that the examiner establish the connection between the mark and the goods to which it relates. Namely, the lesser the connection between the mark and the specific type of goods to which it relates, the more will the mark have a fanciful character and, as such, satisfying the conditions for registration. For instance, the mark PANRICO DONUTS will be deceptive in terms of the type of the goods if it is used to indicate different types of baker's products other than doughnuts. On the other hand, this mark will be registrable for the goods in Class 16 (publications, printed matter, stationery, and the like) because none of the purchasers will realistically believe that they are buying doughnuts in a situation where they are actually purchasing a note book or a pencil identified as PANRICO DONUTS. In this sense, this mark will be considered fanciful for goods which, by their nature, are completely dissociated from doughnuts as a type of baker's product.

A mark may be deceptive in the event where, by its very meaning, it indicates the type, quality or another characteristic of the goods which does not correspond to the real and effective type, quality or another characteristic of the goods. For example, OSTEOPROTECT is deceptive in the case of goods not intended for treating bone diseases.

Likewise, a mark will be deceptive also where it contains designations which are a wrong indication of the type, quality or another characteristic of the goods, and one which does not correspond to the real and effective type, quality or another characteristic of the goods. For example, a mark containing the designation “milk” in addition to a distinctive verbalism, would be deceptive for products not made from milk, and a mark comprising the indication “coffee” would be deceptive for coffee substitutes.

In the event of a discrepancy between the list of goods and the representation and contents of the mark, the examiner must issue an examination report inviting the applicant to adjust the list of goods to the representation or the content of the mark. This adjustment may be made by the applicant limiting his list of goods or services. In this case just like in other ones, the applicable rule is that the list of goods may not be extended (Article 23 Para. 1, TL).

Examples:

The mark SHEER SILK which includes a graphic design relating to the goods in Class 25 (cotton clothing), would be deceptive, because the word SILK indicates that what is concerned is silk clothing, whereas the mark is claimed for cotton clothing. The examiner has to take into account that the composition of the fabric from which the clothing is produced is of great importance for the purchasers of this type of goods. In this case, the applicant could limit the list of goods to silk clothing, because this would be considered as a significant alteration of the list goods. However, if the same mark was claimed under Class 25 for clothing, the applicant could properly edit the list of goods in such a way as to make it refer to silk clothing, because this would not involve an alteration of the list but a precise specification thereof.

A mark comprising the word GOLD would be deceptive for metal products not containing gold.

A special category of deceptive marks are those containing the indication of a certain special quality of the goods – laudatory marks (e.g. “extra quality”) which cannot be checked. Namely, the Intellectual Property Office is not a body authorised for establishing the quality of goods, and consequently, such a meaning is considered deceptive, because it may be used by its owner also for marking products which are not of a superior quality. If the mark in itself contains the designation 100% including a closer indication of the composition (for instance, 100% cotton), the applicant must be invited on the basis of an examination report, to remove the indication from the representation of the mark. Considering that an element not representing the

distinctive part of the mark is concerned, the applicant may eliminate this reason for objection by removing such an indication from the design of the mark.

Particular attention has to be paid to slogans which can also be the subject of protection. Namely, a slogan is a short, succinct idea expressing an entire concept and most frequently conveying a propaganda message. As a rule, slogans have a laudatory character because their basic purpose is advertisement. As a rule, slogans are eligible for protection if they indirectly point, by their laudatory significance, to certain characteristics and qualities of the goods or services to which they relate, i.e. if they have a metaphoric meaning (e.g. “Life tastes good”, “You get in, you get out, and you’ve got it”, “International, but our own”). On the other hand, simple slogans, whose meaning directly indicates a specific quality of the goods or services, will not be registrable in full (e.g. “Our prices are the best”).

A special category of deceptive marks are those comprising an indication of a diploma, a medal or a year, because, in this manner they point to a special quality which is important for such an indication. In this case, registration of the mark may be granted provided that the applicant submits evidence of the right to use the indicated medal, diploma or year.

Where a mark applied for comprises an indication of a certain year, and where a trade mark has already been registered in the name of the same person, comprising the indication of that same year, the examiner will have to inspect the file and establish whether there is any evidence of the right to use that year. If this evidence already exists, it won’t be necessary for the applicant to re-submit the evidence about its use if the same state of facts is concerned, which the examiner is liable to estimate in each individual case (e.g. if the year indicated designates the year of the establishment of the company, or if it designates the year of the start up of the production of the goods for which protection is sought). Likewise, evidence will not be required for proving the right to use the year if a notorious fact is concerned, which does not have to be proved, or if the examiner is able to establish with certainty, on the basis of an inspection of the relevant literature (encyclopaedia and other publications) or by searching the Internet, that the use of the year in the mark claimed is justified.

An exception to this rule is the indication of the year of bottling on labels designating wines. In this case, the Office will not request proof of the right to use the year, because what is concerned here is an indication which, in this type of product, falls under the category of common designations not considered to be a distinctive part of the mark (such as e.g. the indication of quantity, volume, and the like).

## **7.2. Deception in respect of the geographical origin of the goods or services (geographical origin)**

A mark consisting of or comprising the name of a place or another geographical name which has a special reputation in respect of the goods or services to which the mark claimed refers, will be considered deceptive if the goods it refers to do not originate from that geographical area.

For the relevant public, a geographical designation which is the subject of a trade mark application may either have a primary or a secondary meaning in relation to the goods or services to which the mark applies.

**Primary meaning** is present where there is awareness among the relevant public, of a direct connection between the geographical name and the goods or services the mark refers to, as a result of which the public effectively expect the goods or the services to originate from that specific geographical locality. This is the meaning that the relevant public associates with geographical areas being highly reputed among them with regard to the type of goods or services to which the mark claimed applies, in which context they associate such areas with their perception of the special quality of the goods or services concerned as being conditioned by the natural characteristics of that region or by the traditional human knowledge and skills in the production of the goods or in providing the services in that area.

Examples: BAHIA for cigarettes, because the Bahia Region in Brazil is well known for the production of cigars, cigarettes and tobacco products in general; SHEFFIELD for fabrics, because the area of Sheffield in England is well known for its production of fabrics; MILANO for clothing, because Milan is a city in Italy, and Italy is well known for its clothing items; SCOTLAND for whisky, because Scotch whisky is famous worldwide by its high quality.

The use of such geographical names in trade will have a deceptive character where the applicant does not come from the indicated geographical area. Namely, the relevant public will be deceived in respect of the real origin of the products or services, because the indicated geographical origin will create a wrong impression in their minds about the products or services being of a special quality. Concurrently, the applicant will acquire undue advantage by using a geographical name which enjoys special reputation with regard to the said goods or services.

**Secondary meaning** is present where the geographical name, which is the subject of the trade mark application, is not specially renowned or reputed among the relevant public with regard to the products or services to which it relates, but where it primarily has a symbolic, associative or metaphorical meaning, such as, for instance, an association with adventure, exoticism, luxury. Such names are treated as fanciful terms and they may be granted registration.

This meaning is found mainly in two categories of geographical names:

- the names of unpopulated areas or areas where there is no possibility of any kind of production activity because of the natural characteristics of such areas, such as the names of deserts (e.g. Sahara, Kalahari), mountain tops (Mont Blanc, the Himalayas), rivers, etc.
- the names of populated areas and places or narrower localities not known to the relevant public by the production of the specific type of goods to which the mark applies (e.g. Kent and Wells for cigarettes).

Where a mark claimed consists of, or comprises a geographical name, in each individual case it is necessary to ascertain whether such a name has a primary or a secondary meaning for the relevant public in relation to the goods or services to which the mark refers. In view of this, it is necessary to proceed from the following parameters:

- whether the relevant public usually associates the geographical indication concerned with their idea about the origin of the goods or services designated by such a geographical indication and whether they perceive it as indicating the origin of the goods or services;
- whether there is a developed production in the specific geographical locality of the type of goods for which protection is sought or, whether there is a possibility for developing the production or trade in the products being the subject of the application, in the future;
- whether the specific geographical locality is well known for the production of the goods or for providing the services for which protection is sought;
- whether the geographical locality concerned is reputed among the relevant public in connection with the goods or services to which it relates;
- whether, in view of the reputation of a specific geographical indication, the applicant can acquire undue advantage by using the indication in trading in the goods or services.

### **7.3. The procedure applied by the Intellectual Property Office**

In the event where it has been established that a mark claimed is deceptive in respect of the geographical origin because of creating a realistic expectation among the relevant public that the goods originate from a specific locality, and the goods have not been specified as such, the examiner must invite the applicant to precisely specify his list of goods so as to adjust it with the geographical indications in the mark.

If the trade mark is for wine or spirits consisting of or containing a geographical identification for wines or spirits, and the wines or spirits in the application could be from a different source, the examiner must object. The applicant must be suggested the possibility of limiting the list of wines or spirits in the application to comply with this requirement.

## **8. Official quality assurance signs**

**Registration may not be granted for a mark containing official signs or hallmarks designating quality control or quality assurance, or for marks which are an imitation thereof (Art. 5 Para. 1 Item 7, TL).**

Examples: ISO – a mark designating standard; green apple, a designation of quality for healthy food

## 9. Flags, coat of arms and other emblems

**Registration may not be granted for a mark containing a national coat-of-arms or another public coat-of-arms, flag or symbol, name or abbreviation of the name of a country or of an international organisation, nor may it be granted for an imitation of any of the above, unless by approval of the competent authority of the respective country or organisation (Art. 5 Para. 1 Item 13, TL).**

This provision excludes registration for marks comprising

- A national coat-of-arms or another public coat-of-arms of a country or an international organisation. This also includes public coats-of-arms of cities (e.g. the coats-of-arms of the City of Belgrade, Novi Sad, etc.);
- The flag or symbol of a country or an international organisation (e.g. the emblem of the Red Cross and the Red Crescent, the emblem of the European Union, the emblem of NATO);
- The name or abbreviation of the name of a country or international organisation (e.g. the codes US for the United States for America, GB for Great Britain, FR for France).

Protection will also not be granted for marks imitating the above official marks or emblems. Any mark that may be perceived by the relevant public as exactly that specific symbol, will be considered as an imitation thereof.

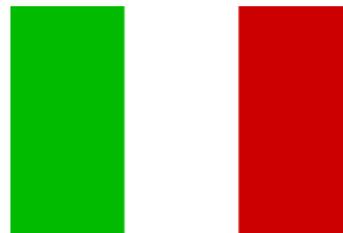
In any individual case, the mark must be considered on the basis of its total design. Namely, if a mark contains an element constituted by a colour combination, the mark will not automatically be construed as imitating a flag. The latter will be the case only where this stylisation of colours is presented in a form (graphic design) making it obvious that it represents a flag.

Examples: red, white, green (horizontally)



Hungarian flag

green, white, red (vertically)



Italian flag

In this specific case, the graphic element in the mark presented in a three colour combination (orange, white, green) will not in every case be considered an imitation of the national flag of either Hungary or Italy. Namely, the colour arrangements of the state flags of each and every country are precisely determined by the appropriate

regulations of each country. Thus, two countries may have flags consisting of the same colours, but arranged in a different manner (see the example of the Hungarian and the Italian flags). Hence, the graphic design of a mark will be considered as an imitation of one of these flags if that graphic design is presented in the form of a flag (a rectangle or a flying banner) in the exact colour combination and in the exact arrangement and sequence as presented on either of the flags (e.g. orange, white and green arranged horizontally – Hungarian flag, or green, white and orange, arranged vertically – Italian flag). On the other hand, the graphic design consisting of a combination of red, white and green arranged one next to the other, horizontally, like in the Hungarian flag, but depicting the content of a toothpaste when its content is pressed out of the tube, will not be considered an imitation of the flag. Likewise, imitation in the sense of Item 13, TL will not be considered to apply in the case where a mark includes a figurative element (e.g. a circle, a triangle, and the like) which in itself contains a combination of certain colours arranged in the manner and sequence characteristic of a country's national flag. Namely, the applicant may use such an element in his mark to indicate the origin of the products or services designated in that manner, unless such an indication is deceptive.

Where symbols of international organisations are concerned, or country codes (e.g. US, FR, GB and the like) the use of such a combination of letters will not automatically and in every case be considered an imitation of the official code of a country. Imitation will be found only where it is clearly evident from the total design of a mark, i.e. the context where such a combination of letters is used in the mark, that a country code is concerned, which must be estimated in every specific case.

## **10. National and religious symbols**

**Registration may not be granted for a mark representing or imitating a national or religious symbol (Article 5 Para. 1 Item 14, TL).**

The reason for refusing the grant of protection for marks representing or imitating national or religious symbols is that national and religious symbols are part of the national, and sometimes also world cultural heritage, and for this reason no one may have monopoly over them. Another significant reason is the fact that, by their very nature, trade marks have a material i.e. economic function, which is contrary to the nature of national and/or religious symbols, and so, it is necessary to prevent the latter from being used for commercial purposes.

Examples: The Cross, The White Angel, The Mother of God, Jesus Christ

## **11. Name or image of a person**

**A mark which comprises the image or the name of a person may be protected only by approval of the person concerned (Art. 5 Para 5, TL).**

### **11.1. Name of a person**

In the event a mark comprises the name of a person, this provision applies only in the case where the mark contains the name of a real person. For the purpose of the above provision, the name of a person is understood to mean a personal name consisting of the given name and the surname of a person, because this is the only way of establishing the identity of a real person. In that case, the examiner will issue an examination result to the applicant inviting him to submit a statement based on which the person, whose name is used in the mark, has consented to having his personal name used. If the applicant states in his reply that it is a fanciful name, the mark claimed will be considered to comply with the requirements for trade mark registration.

It is a very frequent case in practice for producers of certain products, most often cosmetics, lingerie, stockings, confectionery, and the like, to use female names (e.g. Marina, Ana, Kristina, and the like) for marking their products. In such cases it is impossible to establish the identity of the person whose name is used in the mark, and in such cases consent cannot be requested from persons whose identity is not known. Consequently, such names will be considered fanciful names.

This provision applies also in the case of using only surnames, if the surname concerned is that of a well-known and/or public personality (e.g. GORBATSCHOV). In such a case, the examiner will be liable to instruct the applicant to submit the consent issued by that person. Likewise, consent will be required also in the event of using pseudonyms, nicknames, or signatures of persons who are familiar to the public at large by that nickname.

## **11.2. Image of a person**

Where a mark comprises the image of a person, this provision applies in the case where a clearly represented image is concerned, which can be assumed to be the image of a specific person. In this case, the examiner is liable to issue an examination report to the applicant instructing him to submit the consent of the person whose image is represented in the mark. If the applicant states in his reply that the image concerned is a fanciful one (e.g. an image designed by computer), the mark claimed will be considered to comply with the requirements for trade mark registration. No consent will be required in the case where it is evident that the image concerned is that of a fanciful person. This also applies to the case where a mark contains a graphical stylisation of a figure or silhouette of a fanciful person.

## **12. Name or image of a deceased person or of a historical or another significant person (Article 5 Para. 6 and 7. TL)**

A mark comprising the image or the name of a deceased person, may be registered only by consent of the parents, the marital partner or the children of the deceased (the consent must be issued by all of the above persons), while a mark comprising the image or the name of a historical or another deceased person may be registered with

the permission of the competent authority and the consent of his relatives up to the third degree of kinship.

Where a mark comprises the image or the name of a deceased person, the same rules apply like in the case of a mark containing the image or the name of a person.

### **13. Disclaimer**

Article 27 Para. 3 prescribes that if the mark contains an element which is not eligible for distinguishing goods or services in trade, and if the inclusion of that element in the mark is likely to raise suspicions as to the scope of protection, the competent authority may request the applicant to submit a written statement within the time limit assigned, stating that he disclaims any exclusive rights in that element.

#### **13.1. The concept of a disclaimer**

Disclaimer is a statement by the trade mark applicant specifying that he disclaims any exclusive right to any individual non-distinctive elements of the mark. A disclaimer is possible only on the basis of an exclusive agreement or statement by the party, in written form.

A disclaimer is issued in the form of the following statement: "I hereby state that I disclaim any exclusive rights in (list the element subject to the disclaimer) other than the mark as an integral whole."

#### **13.2. The purpose of a disclaimer**

The basic purpose of a disclaimer is to present a statement specifying that no exclusive right is claimed in an essential element of the mark *per se* other than the mark as an integral whole. The purpose of a disclaimer is to prevent eventually creating confusion in terms of the trade mark holder having exclusive monopoly over a certain element of the mark which is significant, but which, in itself, is not eligible for trade mark protection (as a result of being generic, descriptive). Hence, a disclaimer must be requested only in the cases where there is a justified suspicion that the party, the judge, or another person interpreting the decision issued by the Office, might believe that the trade mark holder has a large scope of rights than actually granted to him.

#### **13.3. Cases where disclaimer may be required**

A disclaimer may be required with regard to the following elements of the mark:

a) generic terms;

- b) descriptive elements in a compound mark;
- c) elements not having the function of a trade mark.

A disclaimer is to be filed with regard to each descriptive or generic element of the mark, individually.

#### **13.4. Requirements for applying a disclaimer**

A disclaimer will not be used automatically in any case where the mark contains an element which is not eligible for trade mark protection. In order to have grounds for applying a disclaimer, the following conditions have to be satisfied:

- a) that an essential element of the mark is concerned;
- b) that this element of the mark is likely to cause suspicion as to the scope of trade mark protection.

A disclaimer is acceptable only in the case where the mark is distinctive as a whole, i.e. a disclaimer will be possible only where the mark, in addition to comprising the non-distinctive element also includes an additional element which makes the mark distinctive in its overall design. This means that a disclaimer may not be filed regarding an element of the mark which is, at the same time, the only element of the mark. For instance, a disclaimer will not be acceptable with regard to the word WATER in a mark which consists exclusively from the word WATER and which is claimed for water.

Examples: (Kalodont, Riesling)

In the cases where it is evident that the applicant does not have monopoly rights, a disclaimer need not be requested. For instance, if a mark consists of an original graphic design and the word “bread”, and it has been claimed for bread (Class 30), no disclaimers will be necessary because it is evident that nobody will believe that the applicant has acquired the exclusive right to the word “bread”, by recognising such a trade mark.

A disclaimer need not be requested for common words, prepositions, articles and the like (e.g. “product”, “in”, “and”, “a”, “company”, “Ltd”, “d.o.o.”)

A disclaimer may not be recognised in respect of the elements of the mark which are not eligible for trade mark protection in the sense of Article 5 Para. 1 Item 6, TL (deceptive elements), because they are excluded from registration by their very nature so as not to create any confusion in trade.

A disclaimer may not be recognised in respect of a distinctive element of a mark which, by applying Article 5 Para. 1 Item 8 and/or 9, TL, is found to be identical or similar to an element protected by an earlier trade mark.

In principle, any type of a coined word has to be interpreted as an integral word, and a disclaimer should be requested only where it is obvious that an artificial construction is concerned, which should be spelled with a space between the words. Thus, a disclaimer should be requested if the coined word concerned is one which should “naturally” be spelled in the form of two or more separate words. On the other hand, where the coined words concerned are those where the consumer is not going to regard and interpret the words as separate from the whole, there is no reason for a disclaimer to be requested.

Examples:

In the case of BOOKCHOICE, the examiner must estimate whether such a word may also be presented in a manner in which the words will be written separately (which is the case above: BOOK + CHOICE), and to decide whether requesting a disclaimer is justified.

If the mark consists of the words TOFFEE and CRISP, a disclaimer has to be issued for each one separately. On the other hand, in the case of the mark JUMBO’S RED WINE, a disclaimer must be issued for the words RED WINE in their entirety, because they constitute the noun RED WINE.

A disclaimer will not be requested for the elements which are already registered in the name of the same owner and for the same goods or services, provided that a proof of acquired distinctiveness has been presented.

#### **14. Acquired distinctiveness (Article 5 Para. 2, TL)**

The mark under Article 5 Items 2, 4, and 5 may be registered if the applicant proves that the mark, having been seriously used, has become eligible for distinguishing the goods or services in trade, to which it relates (Article 5 Para. 2, TL).

##### **14.1. The concept of acquired distinctiveness**

Distinctiveness is the basic precondition for trade mark registration (Article 4, TL). If a mark is not distinctive *per se*, in certain cases it may be protected by a trade mark on the basis of a proof of acquired distinctiveness.

Pursuant to the Trade Mark Law, trade mark registration based on acquired distinctiveness is possible only in the cases anticipated by Article 5 Para. 1 Item 2 (marks which, in terms of their total design, are not eligible for distinguishing goods or services in trade), Item 4 (descriptive marks) and Item 5 (marks commonly used for designating a certain type of goods or services).

A mark which does not have an exclusively descriptive character but which also has a suggestive character, will be considered to be inherently distinctive, and it may be registered without proving its acquired distinctiveness. Suggestive marks are those that the consumers do not directly associate with a certain type or nature of goods or services to which they relate, but those which require a certain mental process through which consumers associate it with the type or nature of certain goods or services.

#### **14.2. Evidencing of acquired distinctiveness**

If the applicant invokes acquired distinctiveness, he must file appropriate evidence of the mark having been seriously used, based on which it is possible to identify the place, time, scope and manner of use of the mark concerned. The reason why the evidence has to be submitted is, generally, to be able to establish that the mark has become distinctive with regard to the goods and services for which protection is sought and that its distinctiveness is the consequence of its use. In this context, a mark will be considered to have acquired distinctiveness if an adequately broad segment of the relevant public recognises it as a mark of distinction of the goods or services concerned. Consequently, it is not necessary for any direct connection between the mark and its applicant to be present.

In general, the examiner has to review the following as the criteria for accepting a claim of acquired distinctiveness by the applicant:

- data about the scope of sale (price lists, invoices);
- data about the duration of the use of the mark prior to filing the application;
- the geographical area of sale of the goods or providing of services;
- the scope of advertising (catalogues, the product packaging design, photographs etc., advertising materials);
- the degree of knowledge of the public, taking into account the relevant circles of customers (customer surveys).

In any case, the evidence must refer to the distinctiveness acquired by serious use of the mark in the territory of Serbia. However, considering that trade mark registration does not include the requirement that the goods for which protection is sought should already be involved in trade, advertising will be considered as a sufficient evidence of using the mark.

The following must particularly be taken note of:

- the evidence of use must point to a direct causal relationship between the use of the mark concerned and its acquired distinctiveness. Namely, the evidence of use must clearly show that the mark which was refused in the sense of Items 2, 4, and 5, has become distinctive as a consequence of such use;
- it is necessary to prove the use of that specific mark which is the subject of the application, and not that of a significantly different mark;
- use must refer to the goods or services to which the mark, which is the subject of application, refers to.

A mark must have already acquired distinctiveness at the moment of filing the application, and its distinctiveness must continue to exist at the time of adopting the decision on trade mark registration. Nevertheless, evidence may be submitted even after filing the application and such evidence must be taken into consideration.

The use of a mark by the applicant must be continuous in the territory of the Republic of Serbia.

During the procedure of examination and establishing the scope and the nature of use, the examiner must always bear in mind the nature of the goods or services which are the subject of the application, the manner in which the goods or services concerned are traded and the relevant public circles and especially, whether specialised circles (experts) are concerned or public at large (average consumers). In view of this, the evidence being reviewed must refer to the circle of the public for whom the goods are intended (the relevant circle of parties involved in trade). Therefore, the examiner must proceed from the list of the goods or services to which the application relates. The general rule is that products and services will be considered to be intended for the broadest circles of the public, unless they are specified as being intended, by their nature, for narrow circles of experts.

In this context, it will be considered that a mark has acquired distinctiveness, if an adequately broad part of the relevant public recognises it as a mark of distinction of the goods or services concerned.

## **Chapter XII**

### **INTERNATIONAL REGISTRATION OF TRADE MARKS**

#### **1. Basic principles of international registration of trade marks**

The basic principles of the international protection of all the rights of industrial property are laid down in the Paris Convention for the Protection of Industrial Property, while the procedure for the international registration of trade marks is particularly regulated by the Madrid Arrangement for the International Registration of Marks (hereinafter referred to as: the Madrid Arrangement) and the Protocol to the Madrid Arrangement for the International Registration of Marks (hereinafter referred to as: the Madrid Protocol).

The member countries of the Madrid Arrangement and the Madrid Protocol form a Special Union for the International Registration of Trade Marks (hereinafter referred to as: the Special Union).

The Madrid Arrangement and the Madrid Protocol provide for a system of international registration of trade marks which makes it possible for the members of each member country of the Special Union to provide protection for their trade marks in all the other member countries of the Special Union, by registering their trade marks with the International Bureau of Intellectual Property (hereinafter referred to as the International Bureau). According to the Madrid Arrangement, the applicant may

base his application only on a trade mark which has already been registered in the National Office of the country of origin (hereinafter referred to as: the national trade mark), while the Madrid Protocol specifies that the international application of a trade mark may also be based on a mark which has only been filed for registration but has not yet been registered by the National Office of the country of origin (hereinafter referred to as: the national application).

The Madrid Arrangement and the Madrid Protocol are two independent but parallel agreements. Some countries are only members of the Madrid Arrangement, some only of the Madrid Protocol, and some of both the Madrid Arrangement and the Madrid Protocol. Since certain issues are regulated in different ways by the Madrid Arrangement and the Madrid Protocol, the first thing to be established in each individual case is which of the two international agreements will be applied to the procedure of the international registration of trade marks. This is determined depending on the agreement which is binding upon the office of origin, on the one hand, and on the agreement binding upon the countries seeking international protection (hereinafter referred to as: the countries of designation). The office of the country of origin is the one through which the applicant seeks to provide international protection for his trade mark. The countries of designation are those in respect of which the applicant seeks international registration. Thus, the following situations can be possible:

- If the office of origin is the office of a country bound exclusively by the Madrid Arrangement, the countries of designation may only be the member states of the Madrid Arrangement. In that case, the international application will be subject to the provisions of the Madrid Arrangement.
- If the office of origin is the office of a country bound exclusively by the Madrid Protocol, the countries of designation may only be the member states of the Madrid Protocol. In that case, the international application will be subject to the provisions of the Madrid Protocol.
- If the office of origin is the office of a country bound by both the Madrid Arrangement and the Madrid Protocol, the country of designation may be any member state of either the Madrid Arrangement or the Madrid Protocol or any member state of both the Madrid Arrangement and the Madrid Protocol. The following rules shall apply in this case:
  - a. if all the countries of designation are members of the Madrid Arrangement, (irrespective of whether some of them are at the same time members of the Madrid Protocol), the international application will be subject exclusively to the Madrid Arrangement;
  - b. if all the countries of designation are members of only the Madrid Protocol, the international application will be subject to the Madrid Protocol;
  - c. if at least one country of designation in the international application is a member of the Madrid Arrangement (irrespective of whether or not it is at the same time a member of the Madrid Protocol), and if at least one country of designation is a member of the Madrid Protocol, the application will be subject to both the Madrid Arrangement and the Madrid Protocol.

In the case of countries which are members of both the Madrid Arrangement and the Madrid Protocol, the issue was raised as to which one of the two international

agreements would apply to the relations between these countries. This issue was legally regulated by the provision of Article 9*sexies* of the Protocol (“cause de sauvegarde” – “safeguard clause”). The mentioned provision prescribes that if the office of origin of a specific international application is the office of a country which is a member of both the Madrid Arrangement and the Madrid Protocol, such an application will be subject to the Madrid Arrangement exclusively in respect of each country specified in it which is a member of only the Madrid Arrangement, or which is a member of both the Madrid Arrangement and the Madrid Protocol, while the Madrid Protocol will be applied in relation to the countries which are members of solely the Madrid Protocol.

These international agreements stipulate that international registration of trade marks is carried out via the **national office of the country of origin** which is the signatory of the Madrid Arrangement or the Madrid Protocol. From the aspect of the office where the international trade mark application is filed, this means that it is first necessary to establish whether the office concerned is that of the applicant’s country of origin, i.e. whether the applicant has legal capacity to file his request for the international trade mark registration with that national office.

## **2. Determining the office of the country of origin**

The Arrangement and the Protocol regulate this issue in materially different ways.

Namely, in determining the country of origin, the Madrid Arrangement applies the so called “cascade system” (Art. 1 Para. 3 of the Arrangement) pursuant to which the country of origin is defined as follows:

- A member state of the Special Union where the applicant has a serious and effective industrial or commercial enterprise;
- If there is no such enterprise in a member state of the Special Union, then the country of the Special Union where he has his domicile;
- If he has no domicile in a member country of the Special Union, the country of his citizenship, if he is the citizen of a country of the Special Union.

For the purpose of the above provision, in determining which national office has jurisdiction, i.e. which office is that of the country of origin, it is necessary to strictly respect the afore mentioned sequence of requirements. This is particularly important in a situation where the applicant’s effective industrial or commercial enterprise, residence or citizenship are not in the same country. Namely, in that case the applicant will not have the possibility of choosing, at his own discretion, the office of the country of origin in any of the countries where he has either an industrial or a commercial enterprise, or his residence, or citizenship, and he will have to file his application exclusively with the office of the country where he has a serious and effective industrial or commercial enterprise. It is only in the event he does not have such an enterprise in a member state of the Special Union, that he will be able to submit the application via the office of the country where his residence is situated, and if he does not have a residence in any of the member states of the Special Union, he will be able to file his application via the office of the country where he has citizenship, if he is a citizen of a country of the Special Union.

As opposed to the Madrid Arrangement, the Madrid Protocol is more liberal in respect of determining the office of the country of origin. In the sense of the Madrid Protocol, the applicant has the possibility of choosing the office of the country of origin, at his own discretion, meaning that he may file his application either with the office of the country where he has an effective industrial or commercial enterprise, or via the office of the country where his residence is situated, or via the office of the country where he has citizenship if he is a citizen of a member state of the Special Union (Art. 2 Para. 1 Item i. of the Madrid Protocol).

### **3. Grounds for the international registration of a trade mark**

Grounds for the international registration of a trade mark may be the national trade mark registered with the office of the country of origin or a national application filed with the office of the country of origin, depending on which international agreement applies to the specific request for the international trade mark registration. In this context, the following rules apply:

- If the request for the international trade mark registration is subject to **exclusively the Madrid Arrangement**, the basis for the international registration may be exclusively the national trade mark registered by the office of the country of origin (Article 1 Para. 2 of the Madrid Arrangement).
- If the request for the international trade mark registration is subject to **exclusively the Madrid Protocol**, the basis for the international registration may either be the national trade mark, registered in the office of the country of origin or the national application filed with the office of the country of origin (Article 2 Para. 1 of the Madrid Protocol).
- If the request for the international trade mark registration is subject to **both the Madrid Arrangement and the Madrid Protocol**, the basis for the international registration may be exclusively the national trade mark registered in the office of the country of origin.

### **4. Requested right of priority**

If the international application is filed within a 6-month term from the date of filing the domestic application, the applicant is entitled to request that he be granted a right of priority for the domestic application, pursuant to Article 4 of the Paris Convention.

### **5. Date of the international registration**

The rule applied is that the international registration must bear the date of its receipt by the office of the country of origin, provided that the request for the international trade mark registration is received by the International Bureau within a 2-month term from the date of its receipt by the office of the country of origin. If the request for the international trade mark registration is not received by the International Bureau within the specified time limit, the international registration will be accorded the date of its receipt by the International Bureau.

Exceptionally, where a request for international registration is governed by the Madrid Arrangement, at the moment of its receipt by the office of origin it will be treated as premature if filed while the national trade mark registration is still pending. Namely, pursuant to the Madrid Arrangement, a request for the international registration of a trade mark may be based exclusively on an already registered national trade mark. Because of this, the office of the country of origin will have to wait for the trade mark to be registered on the basis of the initial application, while the date considered as the date of receipt by the national office, of the request for the international trade mark registration, will be the date when the national trade mark is registered and recorded in the Register of Trade Marks. It must be emphasised here, that this rule of prematureness of an international trade mark application and the rule of procedure applied by the office in such a case, applies exclusively in the cases where the application is subject to the Madrid Arrangement. Conversely, where the international trade mark application is subject to the Madrid Protocol, the basis for the international registration may be the national trade mark application, and hence, a request for the international trade mark registration can never be premature.

An international trade mark is recorded in the Register of International Trade Marks, and it is published in the official gazette of the International Bureau (WIPO Gazette).

The administrations (offices) of the countries specified in the request for the international trade mark registration are promptly notified by the International Bureau of each registered trade mark.

The international trade mark has a validity of 10 years from the date of the international registration and it may be extended for an indefinite number of times subject to the payment of the prescribed fees.

During the initial five years of the period of duration of the protection, an international trade mark depends on the legal fate of the national trade mark which served as grounds for the international registration. This means that if the effect of legal protection for a national trade mark in the country of origin ceases for any reason prescribed by the national law, its international registration is thereby revoked. However, after the lapse of a term of five years, the international registration becomes independent of the registration in the country of origin, meaning that it will remain in effect even if the national trade mark in the country of origin has been revoked.

## **6. The request for territorial extension**

After international registration, an international trade mark holder may file a request for territorial extension applying to the countries in respect of which the trade mark concerned was not originally registered. The request for territorial extension may also apply only to a part of the goods or services covered by the international trade mark registration.

As regards the applicant's legal capacity to file a request for territorial extension, it is subject to the same conditions like the international trade mark registration (Art. 1 Para. 3 of the Madrid Arrangement and Art. 2 Para. 1 Item i. of the Madrid Protocol).

## **7. Refusal of protection**

After obtaining a notification of international registration and territorial extension, each country to which such international registration or such territorial extension refers, is entitled to issue a statement within a period of 12 months (for the countries subject to the Madrid Arrangement) and a period of 18 months (for the countries subject to the Madrid Protocol) from the date of the international registration, that the protection for the trade mark concerned cannot be granted in its territory.

## **8. The effect of the international registration in the countries specified**

The recording of the trade mark in the International Register does not mean that the trade mark has automatically been recognised in all the countries specified. The point of the international registration is to reduce the procedure for the formal examination of applications. However, following the recording of the trade mark in the International Register and notification of the countries specified of the international registration, the trade mark concerned actually enters the stage of national examination of compliance with material requirements. This means that each national office will treat an international trade mark registration as an application which is subject to all the statutorily prescribed rules of inspection applying to the registrability of trade marks, prescribed by the legislation of the country concerned.

### **Chapter XIII**

## **THE PROCEDURE FOR THE INTERNATIONAL REGISTRATION OF A TRADE MARK VIA THE INTELLECTUAL PROPERTY OFFICE**

### **1. Grounds for the international registration of a trade mark**

Article 10, TL, specifies that a trade mark holder or the applicant of a trade mark application may file a request for international trade mark registration in accordance with the respective international agreement.

Serbia is a member of both the Madrid Arrangement and the Madrid Protocol.

The grounds for international trade mark registration may either be an already registered trade mark in Serbia, or a trade mark application filed with the Office, depending on which international agreement applies to the specific request for international registration. Since Serbia is a member of both the Madrid Arrangement and the Madrid Protocol, a request for the international registration will be subject to either the Madrid Arrangement or the Madrid Protocol, or both the Madrid Arrangement and the Madrid Protocol, depending on the country in respect of which the applicant seeks protection (hereinafter referred to as: the countries of designation), in accordance with the following rule:

- If the request filed by the applicant specifies only a country or countries party/parties to exclusively the Madrid Arrangement, the request for the international trade mark registration will be subject to exclusively the Madrid Arrangement. In this case, the grounds for the international registration may be exclusively a registered trade mark.
- If the request filed by the applicant specifies exclusively a country or countries party/parties the Madrid Protocol, the request for the international trade mark registration will be subject to exclusively the Madrid Protocol. In this case, the grounds for the international registration may either be the trade mark application or an already registered trade mark.
- If the request filed by the applicant specifies at least one party to the Madrid Arrangement (irrespective of whether or not the country is, at the same time, a member of the Madrid Protocol) and at least one party to the Madrid Protocol, the request will be subject to both the Madrid Arrangement and the Madrid Protocol. In this case, exclusively a registered trade mark may be the grounds for the international registration.

If a request for international registration is submitted at the time when the registration of the national trade mark is still pending, and the request is governed by the Madrid Protocol (this will be the case only where the request filed by the applicant specifies exclusively a country or countries party/parties to the Madrid Protocol), the grounds for the international registration of the trade mark is the trade mark application. In this case, the Office must promptly carry out the international registration procedure and it may not give priority, on the basis of that application, to prosecuting the national trade mark registration.

## **2. Legal capacity to file the request for the international registration of a trade mark**

The applicant of an international trade mark application filed via the Intellectual Property Office, may, as a rule, be only a local natural or legal person. Namely, in the sense of the provisions of Art. 1 Para. 3 of the Arrangement, and/or Art. 2 Para. 1 Item i. of the Protocol, the Intellectual Property Office of the Republic of Serbia is the office of the country of origin in relation to local natural or legal persons. Exceptionally, a foreign legal person will have legal capacity to file the request for the international registration of a trade mark, if it has a serious and effective industrial or commercial enterprise in Serbia. Where a foreign natural person is concerned, it will have legal capacity to file the request for the international registration of a trade mark if it has a domicile in Serbia.

## **3. Initiating proceedings for the international registration of a trade mark**

A proceeding for the international registration of a trade mark is initiated by a special request, the contents of which are prescribed by Article 33 of the Regulation on the Procedure for Trade Mark Registration.

The request for the international registration of a trade mark must contain the following data:

- data about the applicant (data about the business name and principal place of business of the applicant and/or the name and address of the natural person);
- correspondence address if any;
- data about the representative, if the application is filed via a representative;
- the application number and date and the registration number of the trade mark which serves as grounds for international registration;
- data about the requested right of priority (in accordance with Article 4 of the Paris Convention for the Protection of Industrial Property);
- the representation of the trade mark;
- a designation of the colour and colour combination if protection is sought for a mark in colour;
- an indication as to whether an individual trade mark application is concerned, or one for a collective trade mark, a guarantee trade mark, a three dimensional trade mark or a music trade mark;
- a transliteration of the trade mark;
- a translation of the mark into the French language, if the mark can be translated;
- a designation of the prior international registrations (registration number and date) relating to the same mark, if any;
- a list of the goods or services in the French language, edited in accordance with the International Classification of Goods and Services;
- a designation of the countries for which protection is sought;
- the applicant's signature and seal.

Article 34 of the Regulation on the Procedure for Trade Mark Registration specifies that an international trade mark application has to be accompanied by the following:

- the representation of the mark;
- a properly drawn up and classified list of goods or services in the French language, if it is too long to be listed in the international trade mark application;
- a Power of Attorney, if the application is filed via a representative;
- evidence of the payment of the application fee.

The representation of the mark enclosed with the international trade mark application must be fully compliant with the representation of the mark which is the subject of the domestic trade mark application, or which has been registered, in terms of both the elements it contains and the colours, if the mark is in colour. For instance, if the domestic mark is black and white, the mark which is the subject of the international application is also to be in black and white, and if the domestic trade mark is in colour, the international application must also be in colour, more precisely in the same colour and/or combination of colours.

The goods covered by the mark which is the subject of the international trade mark application have to be identical to the goods for which the mark has a national registration. The list of goods for which an international trade mark application is filed may be narrower, however it cannot be wider in relation to the list of goods specified by the national trade mark application or the national registration.

The applicant may specify separately that he disclaims protection for certain goods or services in a specific country or several of them.

The request for the international registration of a trade mark is subject to payment of an appropriate fee determined in Tar. No 81 of the Rates of the Federal Administrative Fees

#### **4. The procedure applied by the Office to an international trade mark application filed on the basis of a national trade mark application**

After receipt of an international trade mark application, the applicant must first establish whether the applicant has legal capacity to file the international trade mark application via the Intellectual Property Office (whether he is a local natural or legal person, or a foreign legal or natural person who has a serious and effective industrial or commercial enterprise or domicile in the Republic of Serbia). In the event where the international trade mark application is filed by a legal or a natural person who does not have legal capacity, such an application will be rejected.

If the applicant has legal capacity, the examiner must establish, depending on the country designated in the application concerned, which international treaty governs the application (the Madrid Arrangement or the Madrid Protocol), and consequently, he has to establish whether there are grounds in that specific case for assigning priority to the examination of the application with a view to its registration.

##### **4.1 International trade mark applications governed by the Madrid Arrangement**

Considering that, for the purpose of the Madrid Arrangement, the grounds for the international trade mark registration may only be a national trade mark registration, in this case it is necessary first of all to prosecute the procedure of trade mark registration on the basis of the national application.

This procedure is urgent, and hence, the national application will be prosecuted on a priority basis pursuant to Article 24 Para. 2 Item 2, TL, within a 3-day time limit from the date of receipt of the international trade mark application, without submitting a special request for carrying out the examination on a priority basis.

Following receipt of the international trade mark application, the examiner must establish whether the application satisfies the formalities listed in Art. 33 and 34 of the Regulation.

If the international trade mark application is not proper, the examiner will issue an examination report inviting the applicant to eliminate the deficiency within a 30-day time limit.

If the applicant fails to proceed in accordance with the examination report within the time limit assigned the international trade mark application will be rejected.

If the international trade mark application is proper in the formal sense and/or after the applicant has remedied the deficiencies in the given time limit, the examiner will check the national application in the formal sense as well as in terms of its meeting the substantive requirements for trade mark registration.

If an application satisfies all the conditions prescribed for trade mark registration, the Office will invite the applicant by issuing a procedural order to him, to effect payment of the trade mark registration fee within a 15-day time limit the registration being valid for ten years, including a fee for publishing the trade mark in the Intellectual Property Gazette. The same procedural order will invite the applicant to also pay appropriate fees in CHF for the international trade mark registration in favour of the World Intellectual Property Organisation and to submit evidence of the payment to the Office. The trade mark will be registered only after the applicant has submitted all the evidence of the payment of the above fees.

Following receipt of the proof of payment of international trade mark registration fees, the examiner will promptly forward the international trade mark registration to the International Bureau for international registration, on a special form prescribed by the Rules on the Implementation of the Madrid Arrangement and Madrid Protocol.

Even if the applicant submits proof of payment of the trade mark registration fee for a period of ten years, including the fee for trade mark publication in the Intellectual Property Gazette, but fails to submit a proof of payment of the international trade mark registration fee, the proceeding based on the international trade mark application will be discontinued, and the trade mark application will be referred back for regular procedure and will be accorded a registration number in accordance with the sequence determined by the date of filing of the domestic application.

#### **4.2. International trade mark applications governed by the Madrid Protocol**

Where the country or all the countries designated are members of the Madrid Protocol exclusively, international registration may be carried out on the basis of the trade mark application itself, and consequently, the examiner must promptly carry out the international trade mark registration procedure, without previously instituting the proceeding based on trade mark application.

For this purpose, the examiner must establish, first of all, whether the international trade mark application satisfies all the formalities listed in Art. 33 and 34 of the Regulation.

If the international trade mark application is not proper, the examiner will issue an examination report to the applicant inviting him to remedy the deficiencies within a 30-day time limit.

If the applicant fails to proceed in accordance with the examination report within the time limit assigned, the international trade mark application will be rejected.

If the international trade mark application is proper in the formal sense, or when the applicant remedies it within the time limit assigned, the examiner will invite the applicant to pay the appropriate international trade mark registration fee in CHF, in

favour of the World Intellectual Property Organisation, and to submit proof of payment to the Office.

After receipt of the proof of payment of the international trade mark registration fee, the examiner will promptly forward the international trade mark application to the International Bureau, on a special form prescribed by the Rules on the Implementation of the Madrid Arrangement and the Madrid Protocol.

#### **5. The procedure applied by the Office to an international trade mark application filed on the basis of a national trade mark**

After receipt of an international trade mark application, the examiner must establish, as a matter of priority, whether the international trade mark application satisfies all the formalities listed in Art. 33 and 34 of the Regulation.

If the international trade mark application is not proper, the examiner will issue an examination report to the applicant inviting him to remedy the deficiencies within a 30-day time limit.

If the applicant fails to act in accordance with the examination report within the time limit assigned, the international trade mark application will be rejected.

If the applicant has legal capacity, the examiner must further establish whether the international trade mark application satisfies the formalities listed in Art. 33 and 34 of the Regulation. Taking into account that the application concerned is based on an already registered trade mark, the examiner will not check whether substantive conditions have been satisfied, because they were checked prior to registering the trade mark concerned, and he will check only the compliance with the formalities (formal compliance of the application in the sense of Article 33 of the Regulation).

If the international trade mark application is not proper, the examiner will issue an examination report to the applicant inviting him to eliminate the deficiencies within a time limit of 30 days.

If the applicant fails to proceed in accordance with the examination report within the time limit assigned, the international trade mark application will be rejected.

If the international trade mark application is proper, the examiner will issue a procedural order inviting the applicant to pay the appropriate international trade mark registration fee in CHF, in favour of the World Intellectual Property Organisation, and to submit evidence thereof to the Office.

After receipt of the evidence of payment of the international trade mark registration fee, the examiner will promptly dispatch the international trade mark application to the International Bureau, on a special form specified by the Rules on the Implementation of the Madrid Arrangement and the Madrid Protocol.

**Chapter XIV**  
**INVALIDATION OF TRADE MARKS**  
**(Article 50 – 52, TL)**

**1. General provisions**

The Trade Mark law prescribes the reasons based on which an already registered trade mark may be invalidated, as well as the conditions under which a decision on trade mark registration or on international trade mark registration for Serbia may be invalidated. Likewise, the Trade Mark Law specifies who has legal capacity in this administrative procedure, and who has the right to request trade mark invalidation, respectively.

A decision on trade mark registration or international trade mark registration for Serbia may be declared invalid, as a whole or only in respect of certain goods or services, if it is established that the requirements for trade mark registration prescribed by the Trade Mark Law (Art. 50 Para. 1, TL) had not been complied with at the moment of rendering the decision.

A decision on trade mark registration or international trade mark registration for Serbia may be declared invalid for the whole duration of the protection, ex-officio, upon the request of the person concerned or the public prosecutor (Art. 51 Para. 1, TL).

If the reason for the invalidation of a trade mark is its failure to meet the requirements under Art. 5 Para. 1 Items 8, 9, 11 and 12, the request for the invalidation of a trade mark may be filed only by the holder of a senior right (the holder of an earlier identical or similar trade mark, the holder of a famous trade mark or another intellectual property right) or a person authorised by the holder (Art. 51 Para. 2, TL). However, pursuant to this provision, the request for the invalidation of a trade mark will not be granted if the holder of a senior right had known about the use of the later trade mark during five consecutive years immediately preceding the filing of the request and had been a holder in due course and not opposed to such use.

The decision on trade mark registration or the international registration of a trade mark may not be declared invalid for the reasons listed in Art. 5 Para. 1 Items 8 and 9, TL, if the earlier trade mark (the trade mark of the applicant of the request) has not been used in Serbia for identifying the goods or services for which it was registered, in the period of five years before filing the invalidation request. As a result, in that case, the applicant of the request, as the senior trade mark holder, or his legal successor, must prove that he used his trade mark in Serbia for identifying the goods

or services covered by it in the five-year period preceding the filing of the invalidation request (Art. 51 Para. 3, TL).

The following acts by the trade mark holder will be deemed trade mark use in the sense of the above provision:

- applying the trade mark to the goods or their packaging;
- offering the goods, trading in the goods and their storage for such purposes, or providing services under the trade mark;
- import or export of goods under the trade mark;
- using the trade mark in business documents or advertising.
- using the trade mark in a form which is different in certain elements, but in a way not altering the distinctive character of the mark, as well as using the trade mark on goods or packaging for goods intended exclusively for exports.

Purchase orders, bills, invoices, advertising material and the like may be evidence of a trade mark use in the sense of the above provision. In any case, the evidence must relate to the goods or services for which the trade mark has been registered.

Pursuant to the above provision, uninterrupted use within a period of five years prior to filing the request for trade mark invalidation is not a requirement, and it is sufficient to prove that the trade mark was used any time during the mentioned period of five years. Likewise, the mentioned provision does not specify the need for proving that there was a serious use in terms of the scope (quantity of the goods sold or services provided) and of the duration of the period of use of the trade mark.

## **2. Procedure based on the request for trade mark invalidation**

The procedure based on the request for trade mark invalidation is an administrative procedure and it is regulated by the Regulation on the Procedure for Trade Mark Registration.

The procedure based on the request for trade mark invalidation is initiated on the basis of a written request for declaring a trade mark invalid, filed in two copies (Art. 19 Para. 1 of the Regulation).

Article 19 Para. 2 of the Regulation prescribes that the request for declaring a trade mark invalid must include the following data:

- business name and principal place of business of the applicant, if the request is filed by a legal person or the name and address of the natural person, if the request is filed by a natural person;
- the business name and the principal place of business of the holder of the trade mark whose invalidation is requested, if the trade mark holder is a legal person, or the name and address of the natural person if the trade mark holder is a natural person;
- the registration number of the trade mark whose invalidation is requested;
- an indication about whether the request specifies the invalidation of the trade mark as a whole or only in respect of certain goods or services;
- the reasons for seeking the invalidation;
- a PoA if the proceeding is initiated via a representative;

- proof of payment of the application fee.

The request for trade mark invalidation is subject to payment of an appropriate fee determined in Tar. No 94 of the Rates of the Federal Administrative Fees

Following receipt of the request for declaring a trade mark invalid, the examiner must establish whether the request satisfies formal requirements, i.e. whether it contains all the elements prescribed by Article 19 of the Regulation. If the request is not proper, the examiner will invite the applicant to remedy the deficiencies within a 30-day time limit from the date of receipt. If the applicant fails to eliminate the deficiencies, the request will be **rejected as improper**.

If the request for declaring a trade mark invalid has been filed pursuant to Article 5 Para. 1 Items 8 and 9, TL, apart from checking whether it satisfies the formal requirements and prior to an exchange of submissions, the examiner must establish whether the applicant has submitted evidence of use of the trade mark in the sense of the provision of Article 51 Para. 3, TL.

### **3. Procedure based on a proper request**

If the examiner establishes that the request is proper, he will forward it to the trade mark holder inviting him to submit his statement within a 30-day time limit from the date of receipt of the submission.

#### **3.1. Service of process of the request for trade mark invalidation**

If the subject of invalidation is a national trade mark whose holder is a domestic legal or natural person, the request is to be served directly to the trade mark holder, and if the trade mark holder is a foreign natural or legal person, service will be carried out via a representative whose details are recorded in the file.

If the subject of invalidation is an international trade mark, the examiner must previously notify the trade mark holder by a letter about the filing of the request for the invalidation of his trade mark specifying the applicant of the invalidation request. In the said letter, the examiner will invite the trade mark holder to appoint a representative, within a term of one month from the date of receipt of the letter, who is to be a local legal practitioner, enclosing a list of representatives with the letter. This notification will be served to the trade mark holder first via the representative registered in the International Register of Trade Marks (ROMARIN), if the trade mark holder has one, and if there is no evidence of the representative having been notified, the letter will be sent directly to the trade mark holder. If the trade mark holder has no representative registered in the International Register of Trade Marks (ROMARIN), the letter will be sent directly to the trade mark holder.

If, within a month from the date of service, the Office does not receive a confirmation that the trade mark holder has received the notification, the examiner must forward a request to the Ministry of Justice of the Republic of Serbia asking for legal assistance with a view to serving the notification to the trade mark holder. If the Office does not

receive a confirmation from the Ministry of Justice within three months from the date of service of the above mentioned request, confirming that the trade mark holder has received the notification, the notification will be posted on the billboard at the Office. After the lapse of 8 days from the date of posting the notification on the billboard, service of the notification will be deemed to have been duly accomplished.

### **3.2. Exchange of submissions**

After the holder of the trade mark whose invalidation is requested has submitted his statement, the examiner must immediately forward the reply to the applicant of the request, who is entitled to submit his statement within the time limit assigned.

The examiner must provide for an exchange of submissions between the applicant and the trade mark holder until he has obtained all the necessary allegations and evidence from the parties to the proceeding, based on which he can render a decision.

In a proceeding based on a trade mark invalidation request, the competent examiner may schedule a hearing to which he is to invite the applicant of the request and the trade mark holder (Art. 21 Para. 2 of the Regulation). Hearings are not mandatory. This means that the examiner must estimate on the merits of each individual case whether there is a reason for scheduling a hearing. A hearing must be held in the cases where the allegations of the parties to a proceeding and the evidence they have filed through their submissions are not sufficient for a decision to be rendered in the specific administrative matter, and where it is necessary to obtain additional evidence by hearing the parties.

After the completion of a proceeding based on the request for the declaring a trade mark invalid, the Office may issue a decision on declaring a trade mark registration decision and/or an international registration decision invalid as a whole or only in respect of certain goods or services, or it may issue a decision rejecting the request.

## **Chapter XV REVOCATION OF A TRADE MARK Article 47, TL**

As a rule, a trade mark is revoked after the lapse of the ten years for which a fee has been paid, unless its validity is extended.

As an exception to this rule, a trade mark may also be revoked prior to the lapse of the ten year period for which it has been registered, in the following cases:

- 1) if the trade mark holder relinquishes his right, the trade mark is revoked the day following the date of filing the submission regarding the relinquishment with the Office;
- 2) on the basis of a judicial ruling or the decision of the competent authority, respectively – on the date determined by that decision;
- 3) in the event of the termination of the legal person or the demise of the natural person who is the right holder, respectively, the trade mark will be revoked on the date of the termination or the demise, respectively, unless the trade mark has been assigned to the legal successors of the respective person. The termination of a legal person is evidenced by a certificate issued by the Agency for Business Registers, and the demise of a natural person is evidenced by presenting an extract from the death record.

A collective trade mark and a guarantee trade mark will be revoked also if the Office, as the competent authority, has established by examining the amendments to the enactment on collective trade marks that they no longer comply with the requirements for collective mark registration prescribed by Article 28, TL.

## **Chapter XVI**

### **SPECIAL CASES OF TRADE MARK REVOCATION**

#### **Article 53, TL**

The Trade Mark Law regulates the following situations as special cases of trade mark revocation:

- revocation of a trade mark due to non-use (Article 53, TL);
- if a mark protected by a trade mark has become the generic name of the goods or service for which it is registered as a result of an act or omission by the trade mark holder or his legal successor (Article 55 Para. 1 Item 1, TL)
- if an act protected by a trade mark, is likely to cause confusion about the origin, type, quality or other characteristics of the goods or services as a result of the manner of its use by the trade mark holder or his legal successor (Article 55 Para. 1 Item 2, TL);
- if a mark protected by a trade mark has become contrary to morality or public order (Article 55 Para. 1 Item 3, TL).

In such cases the Office may adopt a decision on the revocation of a trade mark, upon the request of the person concerned.

#### **1. Revocation of a trade mark on grounds of non-use (Article 53, TL)**

The Office may adopt a decision on revoking a trade mark, upon the request of the person concerned if the trade mark holder or the person he has authorised, has not seriously used the trade mark on the domestic market for identifying the goods or services to which the trade mark relates, for a period of five years from the date of recording the trade mark in the Register of Trade Marks and/or from the date when the trade mark was last used, without interruption, without a justified excuse for such non-use. In the proceeding based on the request for trade mark revocation on grounds

of non-use, the trade mark holder or the person he has authorised must prove that he has used the trade mark. Therefore, the burden of proof rests with the holder of the trade mark whose revocation is requested on grounds of its non-use. A trade mark may be revoked because of the non-use of all the goods or services, or only certain goods or services.

The following acts by the trade mark holder are considered trade mark use:

- placing the trade mark on the goods or their packaging;
- offering the goods, trading in the goods or their storage for such purposes, or providing services under the trade mark;
- importing or exporting goods under the trade mark;
- using the trade mark in business documents or advertising;
- using the protected mark in a form differing in certain elements, but in a way not altering the distinctive character of the trade mark, as well as using the trade mark on the goods or packaging for the goods intended exclusively for export.

For the purpose of the above provision, the term **serious use** means that the trade mark concerned is used, as a matter of fact, for identifying the goods or services for which it is registered. The trade mark holder is not liable to prove the uninterrupted use in the mentioned five-year period, however, an essential parameter in determining whether or not there has been a serious use of the trade mark is the scope of its use (the quantity of the goods sold or services provided), as well as the time frame during which the trade mark was used.

A justified excuse for non-use of a trade mark is a circumstance beyond the will of the trade mark holder (“force majeure”), which is an obstacle to using the trade mark. This may be, for instance, a decision by a state authority, a bar on imports or exports, or another prohibition relating to the goods or services which are the subject of the trade mark.

The following is not considered trade mark use:

- advertising of the trade mark without the possibility of supplying the goods or using the services covered by the trade mark;
- payment of a fee for the extension of the validity of the trade mark,
- entering into a contract on the assignment of rights, licence, pledge, franchise, and the like, *per se*, is not considered trade mark use unless accompanied by factual use in respect of the goods or services covered by the trade mark.

If a trade mark use commenced or continued after the lapse of a period of five years of non-use, however, prior to adopting the request for trade mark revocation on grounds of non-use, a decision on trade mark revocation on grounds of non-use will not be adopted. However, if it is established on the basis of the evidence submitted by the trade mark holder in a proceeding based on the request for trade mark revocation on grounds of non-use, that the commencement or continuation of the use of the trade mark took place after the trade mark holder learned that a request for the revocation of the trade mark would be filed, and if the use was initiated or continued in the period of three months prior to the adoption of the request for trade mark revocation, such evidence will not be considered relevant, and in that case a decision on trade mark revocation on grounds of non-use will be adopted.

If the commencement or the continuation of the use of a trade mark took place after the trade mark holder found out that a request would be filed for the revocation of his trade mark, and if the use was initiated or continued in the 3-month period before the adoption of the request for trade mark revocation, a decision will be adopted in this case specifying trade mark revocation on grounds of non-use (Art. 53 Para. 6, TL).

**2. Revocation of a trade mark in the event where the trade mark has become the generic name of the goods or services for which it is registered as a result of an act or omission by the trade mark holder (Article 55 Para. 1 Item 1, TL)**

This situation arises most often where several persons use or protect, in their own name, a mark which is significantly similar to a mark which was granted protection earlier in the name of another person. In this case, to the extent that the trade mark holder is not opposed to the use or registration of later trade marks, such a trade mark, after the lapse of a lengthy period of time, may become synonymous of, i.e. the generic name for the type of goods identified by it, and thus lose the distinctive features it had at the moment of registration.

**3. Revocation of a trade mark where, as a result of the manner of its use by the trade mark holder or his legal successor, it has become deceptive in respect of the origin, type, quality or other characteristics of the goods or services (Article 55 Para. 1 Item 2, TL)**

This situation is possible only where the total design or meaning of the trade mark concerned point to a certain geographical origin, type, quality or another characteristic of the goods, and when the purchasers opt for purchasing the goods identified by such a trade mark exactly for that reason.

**A trade mark which has become deceptive in respect of the geographical origin**

A trade mark may become deceptive in respect of the geographical origin only where it has so called primary meaning, i.e. if it consists of, or comprises the name of a geographical area which is highly reputed among the relevant public in connection with the type of goods which are the subject of the trade mark, in which context they associate it in their minds with the special quality imparted by the natural characteristics of the region concerned. In this case, the trade mark whose meaning points to a specific geographical area and which is registered for the goods from that specific geographical area, may become deceptive in terms of the geographical area if its holder starts using it to designate goods not coming from that geographical area. For instance, a trade mark comprising the indication SCOTLAND which is registered for whisky originating from Scotland, may become deceptive if its holder uses it to designate a whisky which is not from Scotland.

## **A trade mark which has become deceptive in respect of the quality of the goods**

In the event of a trade mark whose representation or meaning indicate that the products covered by it are made of a special material which is a significant factor for the consumers when opting for purchasing these specific goods, and if the trade mark is registered for goods made of that material, the trade mark may become deceptive if the trade mark holder uses it to identify goods not having that quality of composition. For instance, if a trade mark contains the designation SILK, thus pointing to clothing made from silk, and if it is registered for clothing made from silk, it would become deceptive if its holder started using it to indicate clothing not made from silk.

### **4. Procedure based on the request for trade mark revocation**

The request for trade mark revocation is subject to administrative procedure and it is regulated by the Regulation on the Procedure for Trade Mark Revocation.

The proceeding for trade mark revocation on grounds of non-use is initiated by a written request filed in two copies (Art. 23 Para. 1 of the Regulation).

Article 23 Para. 2 of the Regulation specifies that the request for trade mark revocation on grounds of non-use must include the following data:

- the business name and the principal place of business of the applicant of the request, if the request is filed by a legal person and/or the name and address of the natural person, if the request is filed by a natural person;
- the business name and the principal place of business of the holder of the trade mark whose revocation is requested, if the trade mark holder is a legal person, and/or the name and address of the natural person, if the trade mark holder is a natural person;
- the registration number of the trade mark whose revocation is requested;
- an indication as to whether the revocation is requested for the trade mark as a whole, or only in respect of certain goods or services;
- the reasons for which the revocation is requested;
- a PoA if the proceeding is initiated via a representative;
- proof of payment of the fee for the request.

The request for trade mark revocation is subject to payment of an appropriate fee determined in Tar. No 94 of the Rates of the Federal Administrative Fees.

After receiving a request for trade mark revocation on grounds of non-use, the examiner must establish whether the request is proper in the formal sense, i.e. whether it includes all the elements specified by Art. 23 of the Regulation. If the request is not proper, the examiner will invite the applicant of the request to remedy the deficiencies within a 30-day time limit from the date of receipt of the invitation to this effect. If the applicant of the request fails to remedy the deficiencies in the request within the time limit assigned, the request will be **rejected as improper**.

### **5. Procedure based on a proper request**

If the examiner establishes that the request is proper, he will forward it to the trade mark holder and invite him to submit his statement within a 30-day time limit from the date of receipt of the submission.

### **5.1. Service of process of the request for trade mark revocation**

If a request is filed for the revocation of a national trade mark whose holder is a domestic legal or natural person, the request will be served directly to the trade mark holder, and if the trade mark holder is a foreign legal or natural person, it will be served to him via the representative whose details are recorded in the file.

If a request for international trade mark revocation is filed, the examiner must notify the trade mark holder first of all, by a letter, informing him about the filing of the request for the revocation of his trade mark on grounds of non-use, specifying therein the applicant of the revocation request for non-use. In the letter, the examiner is to invite the trade mark holder to appoint his representative who is to be a domestic legal practitioner, within a term of one month from the date of receipt of the communication, enclosing a list of representatives with the said letter. This notification is served first of all to the trade mark holder, via the representative registered in the International Register of Trade Marks (ROMARIN), if he has one, and if there is no evidence of the representative having been notified, the communication will be sent directly to the trade mark holder. If the trade mark holder has no representative registered in the International Register of Trade Marks (ROMARIN), the communication will be sent directly to the trade mark holder.

If, within a month from the date of service, the Office does not receive a confirmation that the trade mark holder has received the notification, the examiner must forward a request to the Ministry of Justice of the Republic of Serbia asking for legal assistance with a view to serving the notification to the trade mark holder. If the Office does not receive a confirmation from the Ministry of Justice within three months from the date of service of the above mentioned request, confirming that the trade mark holder has received the notification, the notification will be posted on the billboard at the Office. After the lapse of 8 days from the date of posting the notification on the billboard, service of the notification will be deemed to have been duly accomplished.

### **5.2. Exchanging submissions**

After the submission of the statement by the holder of the trade mark whose revocation is requested on grounds of non-use, the examiner must promptly forward the statement to the applicant of the request, who is entitled to present his observation within the time limit assigned to him.

The examiner must provide for an exchange of submissions between the applicant of the request and the trade mark holder until he has obtained all the necessary allegations and evidence from the parties to the proceeding, based on which he can render a decision.

In a proceeding based on a trade mark revocation request, the examiner in charge may schedule a hearing to which he is to invite the applicant of the request and the trade mark holder (Art. 25 Para. 2 of the Regulation). Hearings are not mandatory. This

means that the examiner must estimate on the merits of each individual case, whether there is a reason for scheduling a hearing. A hearing must be held in the cases where the allegations of the parties to a proceeding and the evidence they have filed through their submissions, are not sufficient for a decision to be rendered in the specific administrative matter, and where it is necessary to obtain additional evidence by hearing the parties.

After the completion of a proceeding based on a trade mark revocation request, the Office may issue a decision revoking the trade mark as a whole or only in respect of certain goods or services, or it may render a decision rejecting the request.

In the event of adopting a decision on the revocation of a trade mark on grounds of non-use, the decision must specify the exact date of the revocation. Namely, the validity of the trade mark will terminate after the lapse of a 5-year period from the date of registration of the trade mark in the Register of Trade Marks if the trade mark has not been used, and if it has, it will terminate upon the lapse of a period of five years after its last use (Art. 54, TL).

## **Chapter XVII**

### **INSPECTION OF THE FILES AND NOTIFICATION OF THE COURSE OF A PROCEEDING**

#### **1. General rules**

The Trade Mark Law specifies the principle according to which the details contained in the registers (the Register of Applications and the Register of Trade Marks) are accessible to all the parties concerned without restrictions, while there are limitations with regard to the possibility of inspecting a file (the documents involving trade mark applications and registered trade marks), ensuing from the general provisions of the Law on General Administrative Procedure.

Access to the data about registered trade marks and marks applied for is provided in the following manner:

- by enabling inspection of the registers (Art. 8 Para. 2, TL);
- by enabling inspection of the file (Art. 8 Para. 3, TL);
- by issuing copies of the individual documents and appropriate certificates and confirmations (Art. 8 Para. 4, TL);
- by enabling inspection of the IPAS data base.

In respect of the accessibility of the data about trade marks and marks applied for, it is necessary to make a distinction between registers, on the one hand, where records are kept of the data about all the trade marks registered including trade mark applications, and files, on the other, that may relate to trade mark applications and to already registered trade marks.

#### **2. The data contained in registers**

The Intellectual Property Office maintains its Register of Trade Mark Applications (Register of Applications) and Register of Trade Marks (Art. 8 Para. 1, TL), which are official records.

Access to the data about registered trade marks and marks applied for is provided in the following manner:

**2.1. by enabling inspection of the registers**

All the parties concerned may inspect them without the payment of a special fee (Art. 8 Para. 2, TL).

**2.2. by issuing appropriate certificates and confirmations**

Any person concerned is entitled to request, in writing and subject to the payment of an appropriate fee, that he be issued a certificate of a registered trade mark, or of a trade mark application which has been filed. Likewise, any person is entitled to request, subject to the payment of a prescribed fee, that he be issued an extract from the register including all the details from the respective register regarding a registered trade mark or an extract of a trade mark application filed (Art. 8 Para. 4, TL).

The amount of the fee for certificates and confirmations is determined in Tar. No 89. of the Rates of the Federal Administrative Fees.

**3. The data contained in files**

A trade mark application file consists of the trade mark application, all later submissions by the applicant, as well as any documents produced as a result of the proceeding conducted on the basis of that application (correspondence between the applicant and the Office – examination report, procedural orders and decisions adopted during the proceeding). In addition to this, a trade mark application file includes the report on the search conducted by the examiner, as well as different official notes which cannot be entered in the data base for technical reasons. If the party concerned has filed a complaint, it is also part of the file.

In addition to the documents relating to the application, a registered trade mark file also includes all later submissions of the trade mark holder relating to the registered trade mark, such as, e.g. the request for recording alterations, licences, and the like, as well as requests for eventual trade mark invalidation or revocation, and the like.

The accessibility of the data making up the file is ensured by providing an inspection of the file by issuing copies of certain documents (Art. 8 Para. 3, TL).

**4. Persons entitled to inspect the data about registered trade marks and trade marks applied for**

Since Article 8 of the Trade Mark Law does not make a more detailed specification regarding who is deemed to be the person/party concerned, this matter is subject to the respective provisions of the Law on General Administrative Procedure.

#### **4.1. The right of inspection of the data in the register**

Considering that registers are public records, the data therein is public and accessible to everyone without restrictions.

#### **4.2. The right of inspection of a file**

Article 8 Para. 3, TL, prescribes that files relating to registered trade marks may be inspected by the parties concerned upon their oral request in the presence of a duty officer, and Article 9, TL, specifies that the Office, being the competent authority, is liable to provide for the accessibility of its trade mark documents and data to the parties concerned.

Since the Trade Mark Law does not specify more closely who is deemed to be the person/party concerned, and what is the admissible scope of inspection of a file, these issues are subject to the provision of Article 70 of the Law on General Administrative Procedure. Namely, all the issues not regulated by the Trade Mark Law are governed by the provisions of the Law on General Administrative Procedure.

In terms of the scope of the inspection of a file, the provision applicable is that of Article 70 Para. 4 of the Law on General Administrative Procedure, which expressly specifies that the following documents may neither be inspected, nor copied, or photocopied: records, official notes, official reports and draft decisions, as well as confidential documents.

Other documents making up a file are accessible to the persons concerned subject to certain restrictions. These restrictions depend on who is considered to be the person concerned in the respective case.

Article 70 Para. 2 of the Law on General Administrative Procedure specifies that any third party is entitled to inspect the documents and copy them at its own expense, as well as photocopy the individual documents provided that it demonstrates its legal interest in doing so.

For the purpose of the provision above, the following will be considered to be persons/parties concerned:

3. the applicant and/or the trade mark holder (the party to the proceeding),
4. the third party which has demonstrated the credibility of its legal interest,
5. the state authority concerned (the court, the prosecutor's office).

**A party to the proceeding** may, upon its oral or written request, inspect the file in the presence of a duty officer.

**A third party may** inspect the file, upon its oral or written request and in the presence of a duty officer, on condition that it has demonstrated the credibility of its legal interest in doing so (Art. 70 Para. 2, of the Law on General Administrative Procedure). A third party must provide a written or an oral statement of reasons for the record, regarding its legal interest in the specific case. The statement of reasons must clearly detail the stated reasons because of which the third party deems to have a legal interest in inspecting the documents of the file.

After the receipt of the written statement of reasons regarding the existence of a third party's legal interest, the duty officer must review the allegations in the statement of reasons and estimate on the merits of the case, whether the legal interest of the third party is justified. In the event the duty officer estimates that the credibility of the legal interest of the third party has not been demonstrated, and that, as such, it is not justified, he will reject the request of the third party by issuing a procedural order, against which an administrative dispute may be initiated.

Neither the party, nor any third party, nor the state authority concerned, may inspect the documents which, pursuant to the express provision of Art. 70 Para. 4, of the Law on General Administrative Procedure, may neither be inspected nor copied.

#### **5. Notification of the course of the proceeding**

The party and any third party which has demonstrated the credibility of its legal interest in the case, as well as any state authority concerned, have the right to receive notification regarding the course of the proceeding.

### **Chapter XVIII SEARCH OF THE DATA BASE**

#### **5. The basic purpose of the search**

Any person concerned has the right to request, in writing and subject to the payment of an appropriate fee, information about whether a certain mark has been registered or whether a trade mark application has been filed in respect of it in the territory of Serbia. Likewise, the persons concerned may also request information about all the marks applied for and the trade marks registered in the name of a certain person.

A search request may be filed by any person concerned, without the need for the person to prove his legal interest.

The person concerned may either be a person who has already filed a trade mark application and who only wishes to ascertain, in advance, whether his mark satisfies the conditions for trade mark registration, or any other person who, either wishes to check, prior to filing the application, whether or not there is an earlier registered trade mark or trade mark application similar or identical to his mark. The person concerned

may be any person wishing to inspect the data base relating to registered trade marks or trade mark applications.

Pursuant to Article 11, TL, a foreign natural or legal person may file a search request only via his representative who is a local national.

This search procedure is not a mandatory stage in a trade mark registration procedure and it is conducted independently of the procedure based on trade mark application.

## **6. Search request**

### **2.1. Request for checking similarity or identicalness**

If a search request refers to checking for similarity or identicalness of a certain mark used for certain goods or services, the search request includes:

1. data about the applicant of the search request;
2. the exact name of the mark and/or its representation if the mark consists of verbalisms and graphisms;
3. an indication of the class number according to the Nice Classification.

In addition to the class number based on the Nice Classification, a search request may also specify specific goods or services for which search is requested. The search request is to be filed with a proof of the payment of the search fee.

### **2.2. Request for searching registered trade marks and marks applied for in the name of a specific person**

If a search request refers to checking all claimed and/or registered trade marks in the name of a certain person, the search request must contain the following:

1. details about the applicant of the search request;
2. the exact name of the legal or natural person in respect of whom search is requested;

The search request is to be filed with a proof of the payment of the search fee.

The amount of the fee for filing a request for searching is determined in Tar. No 11 and 13 of the Decision on the Reimbursement of the Special Expenses of the Procedure Before the Intellectual Property Office and Expenses for Information Services of the Office.

## **7. Procedure based on the search request**

Proceeding on the basis of a search request, the duty officer has to conduct a search procedure involving a search of the domestic as well as the international data base (ROMARIN). In the search procedure and depending on each specific case, the examiner must provide the fullest possible information to the client regarding the marks claimed and the trade marks registered and valid in the territory of Serbia. This search is limited to checking the similarity or identicalness of the marks and it does not include checking the eligibility of any mark. A search report is issued on the basis of the search having been conducted in this manner.

## **4. Search report**

### **4.1. Contents of the search report**

The search report is an information issued by the office to the clients, regarding the facts established by the duty officer in the search procedure. This report includes all the data valid on the date of the last updating of the database.

The search report is to include extracts from the data bases relating to trade marks and trade mark applications identified in the search. If the duty officer establishes in the search procedure that there are no other previously registered trade marks or trade mark applications relating to the mark which is the subject of the search, or that there are no trade marks registered or trade mark applications filed in the name of the person in respect of whom the search has been requested, this fact is to be stated in the search report.

### **4.2. Contents of the extract from the data base**

Extracts from the data bases enclosed with the search report must include the following data:

1. the number accorded to the trade mark application and the registration number of the trade mark, if registered;
2. the application filing date and the date of registration, if the trade mark is registered;
3. data about the right of priority;
4. the date of validity of the registered trade mark;
5. details about the trade mark holder;
6. details about the representative;
7. the representation of the trade mark;
8. the list of the goods and services.

### **4.3. The legal nature and effect of the search report**

The search report does not have the character of an administrative act. No rights in an eventually filed trade mark application may either be acquired or contested by it, nor may it prejudice any decisions of the Office regarding any trade mark application.

## **Chapter XIX**

### **The methodology applied to the procedure based on the request for recording alterations**

#### **1. Legal regulations**

In the process of trade mark registration, certain alterations may be made to the trade mark applications filed, as well as to registered trade marks. This refers to the following alterations:

1. change of the name of the right holder;
2. change of the address of the right holder;
3. assignment of rights (assignment of the trade mark and of the rights under the application, respectively);
4. recordation of the license, pledge, franchise or another right under the trade mark or under the trade mark application, respectively;
5. status-related changes in the right holder, the licensee, the franchisee or the pledgee;
6. limitation of the list of goods or services and other data of significance for the legal status of the application or trade mark, respectively;
7. division of the trade mark application;
8. division of the registered trade mark.

The Trade Mark Law specifies the substantive provisions relating to the assignment of rights. These provisions regulate the assignment of rights under a trade mark application and the assignment of trade marks as well as licenses for the rights under an application or a registered trade mark (Art. 44, 45 and 46, TL).

The Regulation on the Procedure for the Trade Mark Registration regulates the procedure for the recordation of a change of the name and address of the applicant of a trade mark application or of a trade mark holder, in the appropriate registers, as well as regulating the procedure for the recordation of the assignment of rights in the appropriate registers.

For the purpose of the Trade Mark Law, the applicant is the holder of the right under the application, and the trade mark holder is the holder of the right in the trade mark, and hence, this methodology will use the term right holder in reference to both of these cases.

#### **2. Change of the name and address of the right holder**

The procedure for changing the name and address is initiated on the basis of Article 12 of the Regulation on the Procedure for the Trade Mark Registration. Change of name and address may refer to: a) a change of the name of the trade mark holder or the applicant; b) a change of the address of the trade mark holder or the applicant; c) change of the name and address of the trade mark holder or the applicant. The request for changing the name and address is to be filed on Form Ž-3, and the request is to be

enclosed with a proof of payment of the fee for the recordation of alterations. If the request is filed via a representative, the respective PoA is to be enclosed with the request.

A multiple alteration of names and addresses may be requested on the basis of a single request, i.e. a change involving several trade marks or applications by the same person, respectively (Art. 12 Para 3 of the Regulation). This means that a multiple change of names and addresses may be specified on the Ž-3 Form. If the applicant files a single copy of the Ž-3 Form requesting a multiple change of names and addresses, the Office will duplicate the Ž-3 Form in the number of copies corresponding to the number of trade marks or trade mark applications specified in the request. The original will be inserted in the file pertaining to the trade mark first listed or to the trade mark application first listed, while the copies will be inserted in the other files. Each copy is to bear an indication of the file where the original is kept.

## **2.1. Elements of the application**

### **2.1.1. The Ž-3 Form**

The request for recording a change of name and address is to be filed on the Ž-3 Form which is to include the data prescribed by Art. 12 Para 1 of the Regulation.

The request is to be filled in by typewriter or by computer.

### **2.1.2. Evidence of alterations**

The party is not liable to submit any evidence to the Office regarding the legal grounds for changing the name and/or address unless, the Office expressly requests this. The examiner is not liable to make a separate check of the data in the request, and he will request evidence of veracity of such data only as an exception, when there is a justified suspicion as to the correctness of the data presented (Art. 12 Para. 3 of the Regulation).

The issue of presentation of evidence in the procedure for the recordation of a change of name and address is regulated by Art. 10 of the Trade Mark Law Treaty. This regulation prescribes that presentation of evidence regarding the legal grounds for the change (extract from the court or commercial register), may not be requested unless there is a justified suspicion regarding the veracity of any of the data included in the request (Art. 10 Para. 4 of the Trade Mark Law Treaty).

## **3. Rights-related transactions**

### **3.1. General rules**

Rights-related transactions in the context of the Trade Mark Law implies the assignment of rights, licenses, pledges, franchise and the like, namely, Article 44, TL, prescribes that a trade mark or the right under an application, respectively, may be the

subject of an agreement on the assignment of rights, or an agreement on license, pledge, franchise and the like.

The agreement based on which the assignment of rights is made, must be drafted in writing and recorded in the appropriate register upon the request of one of the contracting parties. Therefore, the applicant of the request for recording this type of alteration may be either of the contracting parties. For instance, in the case of recording the assignment of rights, this may be the assigner or the assignee, and in the case of recording a license, the request may be filed either by the licensor or the licensee. The term appropriate register means the Register of Applications, if the request for the recordation of an assignment refers to the right under an application, or, the Register of Trade Marks, if the subject of the request for the recordation of an assignment is a registered trade mark.

An agreement specifying the assignment of rights, which has not been registered in the appropriate register (the Register of Applications, or the Register of Trade Marks) has no legal effect in relation to third parties. This means that the recordation of the assignment of rights, license, pledge, franchise and other rights in the appropriate register of the Office only has a declarative effect and not a constitutive one. This recordation has a legal effect in relation to third parties, and consequently, the agreement produces effect among the contracting parties by its very signing, independent of whether or not it has been recorded in the appropriate register of the Office.

### **3.2. Assignment of rights**

Article 45, TL, specifies that a trade mark holder or applicant may assign the trade mark or the right under an application by an agreement, having the right to do this for all the goods or services or only a part thereof. This agreement must be drafted in writing and it must contain: a designation of the contracting parties, the number of the trade mark or the application number and the amount of the fee, if stipulated.

Collective trade marks, guarantee trade marks and the right to their use may not be the subject of an agreement on assignment.

#### **3.2.1. Legal grounds for assignment of rights**

The agreement on assignment is only one of the legal grounds that may lead to an assignment of rights. Namely, pursuant to Article 11 of the Trade Mark Law Treaty which applies directly to all the issues not specifically regulated by the Trade Mark Law, legal grounds of the assignment of rights may be the following:

- a) an agreement on the assignment of rights;
- b) a merger of enterprises;
- c) the law, or judicial or administrative decisions.

#### **3.2.2. Filing the request**

The request for the recordation of an assignment of rights may be filed by either of the contracting parties i.e. either the assigner or the assignee. The request for recording an assignment of rights is submitted in writing on the official form of the Office - Ž-4, and it is to include the data prescribed by Article 13 Para. 1 of the Regulation.

The Ž-4 Form is to be filed with evidence of the legal grounds for the assignment, the respective PoA (if the request is filed via a representative), as well as a proof of the payment of the fee (Article 13 Para 2 of the Regulation).

A single request filled in on the Ž-4 Form may specify recordation of assignment relating to several trade marks or several applications, provided that the earlier right holder and the new right holder are the same in each of the trade marks or applications and that the registration numbers or the Ž-numbers are indicated on the request. If the applicant of the request submits only one copy of the Ž-4 Form requesting the recordation of several assignments of rights, the Office will duplicate the Ž-4 Form in the number of copies corresponding to the number of trade marks or trade mark applications embraced by the request. The original will be inserted in the file relating to the trade mark first listed or to the trade mark application first listed, respectively, while the copies will be inserted in the other files. Each copy is to bear an indication of the file where the original is kept.

### **3.2.3. Evidence regarding the legal grounds for the transfer of rights**

#### **3.2.3. a) Agreement on the assignment of rights**

If the legal grounds for the assignment of rights are constituted by an agreement on the assignment of rights, Article 14 Para. 1 of the Regulation prescribes that the following must be submitted as evidence of the legal grounds for the assignment of rights:

1. the original agreement on the assignment of rights signed by the contracting parties or a verified photocopy of these documents, or
2. the original extract of the agreement on the assignment of rights signed by the contracting parties or a verified photocopy of these documents, or
3. the original statement of assignment signed by the contracting parties, or a verified photocopy of these documents.

#### **3.2.3. b) Merger of enterprises**

Where the assignment of rights is the result of a merger, Article 14 Para. 2 of the Regulation specifies that the documents to be submitted as evidence of the legal grounds for the assignment are the original document issued by the competent authority certifying the merger of the enterprises (extract from the business register) or a photocopy of that document verified by the authority issuing that document or by the notary public or another competent authority.

#### **3.2.3. c) Assignment of rights on the basis of the law, or a court or administrative decision**

Where an assignment of rights is based on the law, or a court or administrative decision, Article 14 Para. 3 of the Regulation prescribes that the documents to be

presented as evidence of the legal grounds for the assignment of rights are the original or the verified photocopy of the court ruling or another document confirming that change.

**3.2.4.** If the documents under Item 3.2.3.a), b) and c) are drawn up in a foreign language, a translation thereof is to be submitted, certified by a sworn-in interpreter.

**3.2.5.** If a trade mark application or a trade mark registration is followed by several assignments of rights prior to the last assignment in respect of which registration is sought, and the assignments have not been registered in the appropriate register of the Office, the applicant of the request for the recordation of the assignment is liable to submit appropriate evidence on the basis of which it is possible to determine the legal continuity between the assignor and the assignee, in addition to presenting evidence regarding the legal grounds for the assignment.

### **3.3. Prohibition of submitting other requests**

The party shall not be liable to submit any other evidence to the Office apart from the ones above, unless there is a justified suspicion as to the veracity of any of the data contained in the request for the recordation of the assignment of rights, or any document which constitutes legal grounds for the assignment. This is expressly specified in Article 11 Para. 4 and 5 of the Trade Mark Law Treaty. This provision expressly specifies that the following may not be requested:

- submission of a certificate or extract from the business register;
- an indication that the new holder deals in business or trade activities, or submission of evidence to that effect;
- an indication that the new holder deals in activities corresponding to the goods or services to which the change of the right holder refers, or submission of evidence to that effect;
- an indication that the holder has assigned to the new holder, either as a whole or in part, his business or the respective goodwill, or submission of evidence to that effect.

### **3.4. Partial assignment**

An agreement on the assignment of rights may provide for the assignment of the right under an application, or the right in a trade mark either in relation to all products or services designated, or partially i.e. in relation to certain products or services designated (Art. 45, TL). In the case of partial assignment, the request must clearly indicate the products or services which are the subject of the assignment.

Where a request for partial assignment of rights has been filed, a decision is issued approving the assignment of rights, on the basis of which a new application bearing a new number is recorded in the Register of Trade Marks or the Register of Applications, or a new trade mark relating to the products and services assigned is recorded, bearing a new registration number.

### **3.4.1. Partial assignment of the rights under an application**

In the event of a partial assignment of the rights under an application, the decision on the assignment of rights specifies the number of the new application, the mark under the original application, as well as the goods or services remaining under the original application, and the goods or services listed in the new application.

After the completion of the recordation of the partial assignment of rights, a note is entered in the data base of the application being the subject of partial assignment, specifying that a partial assignment has been carried out, as well as entering data about: the products or services assigned, the new application number and the assignee. The details to be entered in the data base also include the new file and the number accorded to the application, while the new application retains the filing date and the right of priority of the original application.

### **3.4.2. Partial assignment of a registered trade mark**

In the case of a partial assignment of a registered trade mark, the decision on the assignment of rights is to specify the new number of the trade mark, the mark under the original registration, and the goods or services remaining in the original registration, as well as the goods or services under the new registration.

If a partial transfer of a registered trade mark is concerned, after completing the recordation of the partial assignment it is necessary to enter a note in the data base relating to the trade mark which is the subject of the partial assignment, specifying that a partial assignment has been made and entering data about: the products or services assigned, the new trade mark number and the assignee. Where a partial assignment of a registered trade mark is concerned, the data base is to include details about the new file as well as the registration number assigned to it, while the application Ž-number, as well as the date of priority and registration remain the same like those of the trade mark which is the subject of the assignment.

The “notes” box in the IPAS data base relating to this trade mark is to include data about the partial assignment indicating the registration number and the holder of the assigned trade mark. (For instance, see the following example in the data base: DUNHILL reg. No. 29030 and the newly established trade mark No. 42530).

### **3.4.3. List of goods and services in the event of a partial assignment**

Goods and services must be “divided” between the assigner and the assignee in a manner in which the total number of products and services after the assignment will be equal to the number of products and services specified in the original application or in the original trade mark. It is important to note here that in the case of partial assignment, the subject of such assignment may be exclusively the goods or services for which the trade mark is registered, i.e. those to which the trade mark application applies. No assignment may be made in respect of the goods or services for which the

trade mark is not registered or to which the application does not apply. Likewise no conversion i.e. replacement is allowed of the existing products and services by new ones.

If the applicant of the request specifies only the products which are the subject of the assignment, the Office will automatically retain the products and services not mentioned in the request for the assignment, under the old application or registration,. For instance, the list of products and services to which an application refers or which are covered by the trade mark which is the subject of an assignment, may include certain products in Classes 05, 29 and 30, while the request refers to an assignment of that application or that trade mark in respect of the products in Class 30. In this case, the Office will retain, under the old application or registration, the products under Classes 05 and 29, creating a new application or registration for the products in Class 30.

Partial assignment of a trade mark or the rights under an application is not allowed in the event where there is a similarity between the goods or services remaining under the original trade mark or original application, on the one hand, and the goods or services under the new trade mark or the new application, on the other. This view is based on the general rules of compliance with the requirements for trade mark registration, pursuant to which a mark may not be registered in the name of different holders if it refers to a similar type of goods. This rule is also based on the provision of Article 9<sup>ter</sup> Para. 1 of the Madrid Arrangement which specifies that in the event of a partial assignment of an international trade mark, any member country may refuse such an assignment if the products or services included in the part thus assigned, are similar to those for which the trade mark remains registered in favour of the assignor.

### **3.5. Assignment of rights liable to create confusion in trade**

The Office will not approve assignment of rights in the cases where this would obviously create confusion in trade as to the type, quality or the geographical origin of the products and services. The Office will approve such an assignment only if the assignee relinquishes protection for the products or services in respect of which there is confusion. The above rule is based on the provision of Article 6 quater Para. 2 of the Paris Convention which specifies that the countries of the Union are not liable to consider as valid the assignment of a trade mark whose use by the assignee would be such that the public would be deceived, particularly in respect of the origin, type or essential characteristics of the products to which the trade mark is applied.

Such a decision by the Office is possible only if the event of an assignment of the rights under an application. If an assignment of a trade mark is concerned, the assignment may not be refused even if there is a likelihood of confusion in trade.

In its Article 17, the Council Regulation No. 40/94 on the Community trade mark regulates the assignment of Community trade marks. Para. 4 of this Article prescribes that when it is obvious from the agreement on assignment that the assignment of a Community trade mark is such that it is liable to deceive the public, especially with regard to the nature, quality or the geographical origin of the goods, the Office will not record the assignment unless the legal successor (assignee) agrees to limit the list of goods and services in such a way as to eliminate confusion.

### **3.6. International trade mark assignment**

The assignment of a trade mark which has been granted international registration is made by a recordation of the transaction in the International Trade Mark Register maintained by the International Bureau for the Protection of Intellectual Property. Article 25.1) b) of the Rules on the Implementation of the Madrid Arrangement and the Madrid Protocol specifies that the request for the recordation of the assignment of an international trade mark may be filed with the International Bureau by the trade mark holder himself, or via the office of the country of the assignor or the assignee. Therefore, in accordance with the above provision, the request for the recordation of the assignment of an international trade mark may be filed with the International Bureau via the Intellectual Property Office only in the event the assignor or the assignee of that international trade mark is a natural or a legal person.

### **3.7. Recordation of a licence**

Article 46, TL, specifies that a trade mark holder or an applicant may cede the right of use of a trade mark or the right under an application in respect of all of the goods or services or only some of them. This agreement has to be drafted in writing, and is to include: the term of duration of the licence (a definite or an indefinite period of time), the scope of the licence (exclusive or non-exclusive, as well as the territory to which it applies) and the amount of the fee, if stipulated.

Collective trade marks, guarantee trade marks and the right to their use may not be the subject of a licence agreement.

#### **3.7.1. Filing the request**

The request for the recordation of a licence may be filed by either of the contracting parties, meaning either the assignor or the assignee of the licence. The request for recording a licence is to be filed in writing on the official form of the Office - Ž-5.

One single Ž-5 Form may be used for requesting the recordation of a licence referring to several trade marks or several applications, provided that the right holder and the licensee are the same in respect of each one of the trade marks and/or applications, and provided that the respective registration numbers and/or the Ž-numbers are indicated in the request (Art. 15 Para 3 of the Regulation).

The Ž-5 Form is to be filed with evidence of the legal grounds for recording the licence, a PoA (if the request is filed via a PoA) as well as a proof of the payment of the fee.

#### **3.7.2. Evidence of the legal grounds for the recordation of a licence**

The following is to be submitted as evidence of the legal grounds for the recordation of a licence:

- a) the original licence agreement, signed by the contracting parties or a verified photocopy of these documents, or
- b) the original extract from the licence agreement signed by the contracting parties or a verified photocopy of these documents.

If these documents are drafted in a foreign language, a translation thereof is to be submitted, certified by a sworn-in interpreter.

### **3.7.3. Recordation of the licence of an international trade mark**

Until April 1, 2002 there was no possibility of recording a licence in the Register of International Trade Marks, as a result of which all the applications for the recordation of licences relating to international trade marks valid in the territory of Serbia were determined by the Intellectual Property Office. However, at its 33<sup>rd</sup> Meeting, the Assembly of the Madrid Union issued a resolution specifying that as of April 1 2002, international trade mark holders must be provided the possibility of recording their licences in the Register of International Trade Marks.

The Intellectual Property Office does not maintain a Register of Intellectual Trade Marks, and hence, where trade marks having international registration for the territory of Serbia are concerned, the procedure of the recordation of licences is carried out by recording them in the International Register of Trade Marks maintained by the International Bureau for the Protection of Intellectual Property. Its article *20bis* of the Rules on the Implementation of the Madrid Arrangement and the Madrid Protocol, specifies that the request for the recordation of an international trade mark licence may be submitted to the International Bureau by the trade mark holder himself or via the office of the country of the trade mark holder or the office of the country of the assignee. Therefore, pursuant to the above provision, an application for the recordation of the assignment of an international trade mark may be filed via the Intellectual Property Office only in the case where the assignee of the international trade mark is a domestic natural or legal person.

### **3.8. Recordation of a pledge, franchise or another right**

The recordation of a pledge, franchise or another right in a trade mark or a trade mark application is subject to the provisions relating to the recordation of licences.

However, as regards the legal grounds for the recordation of a pledge, there are certain specifics conditioned by modifications of the legislation in this field. Namely, until the enactment of the Security Interest Law relating to movable property recorded in the Register ("Official Gazette of the RS" No. 57/03 and 61/05) the applicable provisions were those of the Law on Contracts and Tort (Art. 966-996) based on which lien regarding movable property was created by handing over the property instead of by claims and other rights acquired by the very signing of the agreement.

With the adoption of this Law and the establishment of the Register of Pledges maintained by the Agency for Business Registers, the requirements for registering lien have been altered in respect of movable property, as well as claims and other rights.

In reference to movable property entered in the Register, Article 4 of the Security Interest Law specifies that the pledgee acquires lien by its recordation in the Register of Pledges unless otherwise regulated by the Law. The transitional provisions of this Law (Art. 66) specify that until special regulations have been adopted which will regulate in greater detail the recordation of lien in the registers of intellectual property, lien relating to intellectual property rights is to be recorded in the Register of Pledges.

Accordingly, in order to be able to record lien regarding a trade mark or a trade mark application in the respective register of the Intellectual Property Office, apart from submitting evidence about the legal grounds for the recordation of the pledge it is also necessary to submit evidence showing that the lien has been recorded in the Register of Pledges maintained by the Agency for Business Registers.

### **3.9. Notification of tax authorities**

In the procedure for the registration of an assignment of rights, licences and franchise the Office is liable to inform the competent tax authority pursuant to Article 37 Para. 4, in reference to Article 14, Article 23 Item 2, Article 24 and Article 26 Para. 2 and 3 of the Law on Property Tax (“Official Gazette of the RS” No. 26/2001, “Official Gazette of the FRY” No. 42/2002 and “Official Gazette of the RS” No. 80/2002 and 135/2004) and to submit to it a copy of the agreement on the assignment of rights or a copy of the court ruling or another act issued by a public authority, which constitutes legal grounds in that specific case for the recordation of the assignment, including a copy of the decision by the Office on recording the assignment.

This obligation applies both in the case of an assignment against a fee, and in the case of an assignment without a fee, where the assignment of rights resulted from an agreement on assignment or from a legally binding court ruling or another act issued by a public authority. Pursuant to Article 14 Para. 4 of the Law on Property Tax, assignment without a fee is considered a gift.

The tax payer in respect of the tax on the assignment of rights against a fee, is the seller or the assigner of the rights, and the tax payer in relation to the assignment of rights without a fee is the assignee.

Both local or foreign natural or legal persons are tax payers in respect of the assignment of rights in the case of the assignment of rights, licences or franchise and industrial property rights valid in the territory of Serbia and Montenegro.

The office is liable to notify the tax administration at the municipality in whose territory the principal place of business of the tax payer is situated, of the recordation of the assignment of rights carried out.

#### **4. Division of a trade mark application and division of a registered trade mark**

##### **4.1. Division of a trade mark application**

Article 29 of the Trade Mark Law specifies that, until the moment of recordation of the trade mark in the Register of Trade Marks, a trade mark application may be divided into two or more applications, upon the request of the applicant, by dividing the list of goods or services. The application thus extracted retains the date of filing of the original application and its right of priority, and it(they) is(are) recorded in the Register of Applications.

Collective trade mark applications and/or guarantee trade mark applications may not be divided.

The procedure for dividing a trade mark application is initiated by a request for dividing the trade mark application. The request for dividing a trade mark application is filed on Ž-2 Form which is to include the details specified in Article 8 Para. 1. of the regulations on trade mark registration and is to be enclosed with two lists of the goods or services to which the divisional application applies as well as two lists of the goods remaining in the original application.

A special decision is adopted on dividing an application, specifying the number(s) of the new application(s), the mark claimed in the original application, as well as the goods or services remaining in the original application, and the goods or services listed in the divisional application(s).

##### **4.2. Division of a registered trade mark**

Article 43 of the Trade Mark Law specifies that if a trade mark is registered for several types of goods or services, it may be divided at any time into two or several registrations upon the request of the applicant, by dividing the list of goods or services. The divisional trade mark retains all the rights under the original registration.

A collective trade mark and/or a guarantee trade mark may not be divided.

The procedure for dividing a trade mark is initiated by a request for dividing the trade mark. The request for dividing a trade mark is to be filed on Form Ž-7 which is to include the details prescribed by Article 32 Para. 1. of the Regulation on the Procedure for Trade Mark Registration and which is to be enclosed with two lists of goods or services covered by the divisional trade mark and two lists of goods or services remaining in the original registration.

A special decision is adopted on dividing a trade mark, specifying the number(s) of the new trade mark(s), the mark under the original registration, as well as the goods or

services remaining in the original registration and the goods or services in the divisional registration(s).

## **5. Fee for filing a request for the recordation of alterations**

### **5.1. Fee for filing a request for the recordation of a change of name and/or address**

The amount of the fee for filing a request for the recordation of a change of name and/or address is determined in Tar. No 96 of the Rates of the Federal Administrative Fees.

The request for the recordation a change of name and/or address is to be filed by the party together with evidence of the payment of the fee (Article 12 Para. 2 Item 2 of the Regulation). The amount of the fee for one request is 450.00 dinars. If recordation of a change of name and/or address for several trade marks or applications is made based on a single request, each individual recordation of a change is subject to the payment of a fee of 450.00 dinars.

### **5.2. Fee for filing a request for the recordation of an assignment of rights, licence, pledge, franchise and other rights**

The amount of the fee for filing a request for the recordation of a change of name and/or address is determined in Tar. No 95 of the Rates of the Federal Administrative Fees.

With its request, the party is to submit proof of payment of the fee (Article 13, Para. 2, Item 3 of the Regulation). The amount of the fee for one request is 800.00 dinars. If one single request specifies the recordation of the assignment of rights or the recordation of a licence, franchise, pledge and other rights relating to several trade marks or several applications, each recordation of the assignment of rights or licence, franchise, pledge and other rights will be subject to the payment of a fee of 800.00 dinars.

### **5.3. Proof of payment of the fee**

The second copy of the pay-in slip bearing the seal of the bank, as well as the SWIFT issued by the bank are proof of payment of the fee. A pay-in slip not bearing a seal is not an acceptable proof of payment of the fee.

If the applicant of the request fails to submit proof of payment of the fee, or if the fee has been paid only partly, the Office will issue an examination report to the applicant of the request inviting him to submit proof of payment of the fee within the time limit assigned.

If the applicant of the request fails to submit proof of payment of the fee, the Office will reject the request for recording a change of name and/or address (Article 58 Para. 2 of the Law on General Administrative Procedure).

## **6. Power of Attorney**

If a request for the recordation of alterations is filed via a representative, the applicant of the request is to submit a copy of the original PoA (Article 12 Para. 2 Item 1 of the Regulation).

If the request for the recordation of alterations is filed by the representative who is recorded in the file as the actual representative in the case, it is not necessary to submit a PoA. No PoA has to be submitted either where the representative has a General PoA. In that case, it must be specified in the appropriate space in the Ž-Form that the General PoA has been deposited with the Office.

A foreign legal or natural person is to file his request via a representative who is to be a local national (Art. 11 of the Trade Mark Law). If the foreign legal or natural person files a request for the recordation of a change indirectly i.e. without the mediation of a representative, he will be invited to appoint a representative within the time limit assigned by the duty officer, and the representative is to be a local national from the list of representatives.

## **7. Legalization of foreign documents**

Where the grounds for recording an assignment of rights, licence, pledge, franchise or another right, is a foreign document, the foreign document is to be legalised.

Yugoslavia acceded to the Convention on Abolishing the Requirement of Legalization of Foreign Public Documents – the Hague Convention of October 5, 1961 (“Official Gazette of the SFRY” No. 10/62 – Appendix: International Treaties and Other Agreements). The Hague Convention was signed with a view to abolishing the requirement of legalization of foreign public documents (full legalization) and it applies to all the parties to the Convention.

For the purpose of the Hague Convention, legalisation is a formality applied by the diplomatic or consular agent of a country in whose territory the document is to be used, to confirm the authenticity of the signature. Article 2 of the Hague Convention specifies that each country party to the Convention is exempted from the requirement of legalising documents subject to this Convention, which are to be used in its territory.

Article 1 Para. 1 of the Hague Convention specifies that this Convention applies to public documents drafted in the territory of a state - party to the Convention, and intended for use in the territory of another state - party to the Convention. For the purpose of Article 1 Para. 2 of this Convention, the following are considered public documents:

- a) Documents issued by an authority or by an employee of the state judiciary, including those issued by the public prosecutor's office, the head of the clerk's office or a bailiff;
- b) Administrative documents;
- c) Documents issued or certified by a notary public;
- d) Official statements, such as statements regarding recordation in public books, certification of the correctness of dates, legalization of signatures appended to private documents;
- e) Private documents certified by a notary public or another competent authority.

The only formality which can be requested for confirming the veracity of a signature is specified in Article 4 of the Hague Convention. It refers to the application of the "Apostille". This certificate is placed on the document itself or in an addendum thereto. It may be drawn up in the official language of the authorities issuing it, however, the heading "Apostille" must be in the French language.

However, Article 3 Para. 2 of the Convention prescribes that this formality may not be requested if it has been abolished, simplified, or if such a document has been exempted from legalization pursuant to the legislation, regulations or customs applicable in the state where the document is used or pursuant to an agreement between two or more states - parties to the Convention.

The Regulation on the Procedure for Trade Mark Registration specifies that an original of the agreement on the assignment of rights or of the agreement on license, pledge, franchise or another right signed by the contracting parties or a verified photocopy of these documents, is to be submitted as legal grounds for the registration of the assignment of rights, license, pledge, franchise or another right. This means that the special regulation – the Regulation on the Procedure for Trade Mark Registration exempts from legalization the original documents filed with the Office as evidence of the legal grounds for the respective change, pursuant to the provision of Article 3 Para. 2 of the Hague Convention. In other words they are not subject to the legalisation of signatures by any state authority. On the other hand, photocopies of the above documents are not exempted from legalization in the sense of the above provision of the Hague Convention, because they have to be verified by the appropriate state authority.

**Considering the above, pursuant to the provision of Art. 3 Para 2 of the Hague Convention, the original documents filed with the Office will not be required to have an Apostille. On the other hand, the obligation of providing an Apostille remains in the case where verified photocopies of the above documents are filed with the Office.**

## **8. Procedure applied by the Office in respect of filing an application for the recordation of an alteration (Art. 17 of the Regulation)**

### **8.1. Examination of compliance with formal requirements**

If a request for the recordation of a change is not formally proper, i.e. if it does not include the data specified in Art. 12, 13 and 15 of the Regulation, the examiner in

charge will issue an examination report to the applicant of the request inviting him to edit the request within a time limit of 30 days from the date of receipt of the report.

If the applicant of the request fails to proceed in accordance with the remarks of the examiner within a 30-day time limit from the date of receipt of the examination report, the request for recording the change will be rejected on the basis of a procedural order.

## **8.2. Examination of compliance with substantive requirements**

The basic substantive preconditions for the recordation of any type of change are:

- the trade mark to which the change applies is to be valid and no abandonment of the trade mark application to which the change applies is to have taken place, and no discontinuance of the proceeding based on that application is to have taken place;
- the data in the request has to correspond to the data in the registers.

In examining the substantive requirements for the recordation of an assignment of rights or in examining a request for the recordation of a licence, pledge, franchise or another right, the examiner must establish whether the legal grounds for the recordation of the change comply with the requirements specified in Art. 44, 45 and 46, TL, and whether there is compliance with the requirements specified in Art. 14 and 16 of the Regulation regarding the legal grounds for the change. It is important to note that in this procedure, the examiner assesses the legal validity of the document *per se*, constituting legal grounds for the recordation of the assignment of the rights, or of the licence, pledge, franchise or another right. Namely, the Office, as the administrative authority, is not competent for assessing the legal validity of the agreement itself or of another document constituting legal grounds, because their legal validity may be assessed and eventually contested only within the framework of judicial proceedings.

If a request for the recordation of a change does not meet the substantive requirements, the examiner will issue an examination report to the applicant of the request inviting him to submit his statement regarding the reasons for which the alteration may not be recorded, within a 30-day time limit from the date of receipt of the examination report.

## **9. Notification of the World Intellectual Property Organisation of an alteration**

In the event of an alteration of the name and/or address in the case of a registered trade mark which served as grounds for the international registration of that trade mark, the Intellectual Property Office must notify thereof the World Intellectual Property Organisation.

If a domestic trade mark application or a domestic trade mark, which served as grounds for an international trade mark registration, ceases to produce legal effect within a term of 5 years as of the date of the international registration as a result of revocation, owner's waiving of further protection for the trade mark or abandonment of the application, or, if the validity of the trade mark ceases before the lapse of 10

years for reasons prescribed by the Trade mark Law, the Office must notify the International Bureau of that fact. Namely, in the period of 5 years from the date of the international registration of a trade mark, the international trade mark depends on the legal destiny of the national trade mark or the national application serving as grounds for its registration. Consequently, if the domestic trade mark or the domestic application ceases to produce legal effect within that period of time, the international trade mark will also cease to produce legal effect.