

DRAFT OF THE TRADE MARK LAW

Part One GENERAL PROVISIONS

The Concept of a Trade Mark

Article 1

- (1) A trade or a service mark (hereinafter: a trade mark) shall protect a sign which may be represented graphically and which is capable of distinguishing the goods or

in the Republic of Croatia, if it results from international treaties or conventions or from the application of the principle of reciprocity.

- (2) The existence of reciprocity shall be presumed until proved to the contrary.

Protection Requirements - Absolute Grounds for Exclusion

Article 5

- (1) A trade mark shall not protect a sign:

1. which is contrary to the public order or morality;
2. which is not capable of being represented graphically;
3. which is not capable, due to its overall representation, of distinguishing the goods or services in the course of trade;
4. which consists exclusively of signs or indications serving in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of services, or some other characteristics of the goods or services;
5. which consists exclusively of signs or indications which are customary in the current or professional language or established practices of the trade;
6. which represents exclusively the shape resulting from the kind of the goods, or the shape of goods necessary to obtain a specific technical result, or the shape giving a substantial value to the goods;
7. which may, by its representation, deceive the public particularly as to geographical origin, nature, quality or any other characteristic of the goods or services.
8. which contains a national coat of arms or other public arms, a flag or an emblem, the name or abbreviated name of a country or international organization and imitations thereof, unless the consent of the competent authority of such a country or organization has been given.

- (2) The signs specified in subparagraphs 3, 4 and 5 of paragraph (1) of this Article may be protected by trade marks if the applicant proves that the sign has acquired distinctive character in relation to his goods or services and that he has started to use it at least two years prior to the filing of the application.

Protection Requirements - Relative Grounds for Exclusion

Article 6

- (1) A trade mark may not protect a sign:

1. which is identical with the earlier trade mark designating the same kind of the goods or services;
2. which is identical with or similar to the earlier trade mark designating the same or

including the likelihood of association by the public of the sign applied for with the earlier trade mark.

(2) The expression "earlier trade marks" shall comprise:

1. trade marks enjoying priority right referred to in Articles 11, 12 and 13;
2. internationally registered trade marks with the effect in the Republic of Croatia;
3. trade marks which are, at the time of filing a trade mark application for a sign referred to in paragraph (1), well known in the Republic of Croatia within the meaning of Article 6.bis of the Paris Convention for the Protection of Industrial Property (hereinafter: the Paris Convention), applying mutatis mutandis on services;

The knowledge of a trade mark within the meaning of paragraph (2), subparagraph 3 of this Article shall also include the knowledge of a trade mark in a relevant public sector, acquired as a result of the promotion thereof.

- (3) A trade mark shall not protect a sign which infringes earlier acquired rights of the owners referred to in Article 21, paragraph (1), subparagraphs 2 - 5.
- (4) A trade mark shall not protect a sign which is identical with or similar to a trade mark the validity of which has expired according to Article 37, paragraph (1), subparagraph 1 of this Law, if a trade mark application is filed before the expiration

Filing of the Application

Article 8

- (1) The procedure for the grant of a trade mark shall be initiated by filing a trade mark application.
- (2) A separate application shall be filed for each sign applying for a trade mark protection.

The Content of an Application (Minimum Requirements)

Article 9

- (1) A trade mark application shall contain:
 1. a request for the grant of a trade mark;
 2. the name and surname or the trade name of the applicant, the residence address and the place of his employment if the applicant is a natural person, or the address of the business seat if the applicant is a legal entity;
 3. a representation of the sign applied for a trade mark protection; if a three-dimensional sign is applied for, the representation of its outer surface; if a sign is written in any characters other than the Latin, its transliteration into the Latin characters;
 4. a list of the goods or services the protection is applied for, provided that such list contains appropriate classification symbols of classes in compliance with the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter: the International Classification).
- (2) An application shall be considered to be filed if it complies with the minimum requirements referred to in paragraph (1) of this Article.
- (3) All other elements of the application and the attachments thereto shall be filed in the way and in the number of copies

Filing Priority

Article 11

If the trade mark application is filed in compliance with Article 9, paragraph (1), the applicant shall acquire the right of priority on the basis of the application filing date over

Examination of the Correctness of the Application

Article 14

- (1) The process of the examination of the correctness of the application includes the examination of all formal and legal requirements prescribed by this Law and the Regulations.
- (2) The trade mark application shall be correct if:
 1. a separate application has been filed within the meaning of Article 8, paragraph (2) of this Law;
 2. a prescribed application fee within the meaning of Article 10 of this Law has been paid and the evidence of a payment of a fee has been attached thereto;
 3. it has been drawn up in a way to contain all necessary elements and attachments within the meaning of Article 9, paragraphs (1) and (3) of this Law;
 4. an orderly power of attorney is attached thereto, if the application is filed through an agent.

Correction of the Trade Mark Application

Article 15

- (1) If the application complies with the minimum requirements within the meaning of Article 9, paragraph (1) of this Law, but is not filed in a way to contain all necessary elements and attachments in compliance with this Law and the Regulations, the Office shall invite the applicant to remedy the found deficiencies within 60 days from the day of the receipt of the invitation.
- (2) If the applicant corrects the application within the prescribed time limit, the application shall be considered to be correct as from the beginning (outset).
- (3) If the application doesn't comply with the minimum requirements within the meaning

Rejection of the Application

(4) On the reasoned request of the applicant the time limit referred to in paragraph (3) of

Article 22

(1) The Office shall examine whether the opposition is filed by the person entitled to file

Article 25

- (1) The data concerning a trade mark shall be published in the Office official gazette three months at the latest from the date of entry of the trade mark into the register.
- (2) The data to be published in the Office official gazette shall be prescribed by the Regulations.
- (3) The publication of a trade mark shall be subject to the payment of a prescribed fee relating to the publication of a trade mark in the Office official gazette.

Trade Mark Certificate

Article 26

- (1) After the entry of a trade mark into the register and after the payment of the prescribed fee for the issuance of the trade mark certificate, the Office shall provide the owner of the right with the trade mark certificate six months at the latest after the date of publication of the trade mark in the Office official gazette.
- (2) The data contained in the trade mark certificate shall be prescribed by the Regulations.

Part Three EFFECTS OF A TRADE MARK

Exclusive Rights

Article 27

- (1) The owner of a trade mark shall have the exclusive right of designating by a trade mark the goods or services it is granted for, and the exclusive right of using the trade mark for such goods or services.
- (2) The owner of a trade mark may prohibit to third persons not having his consent to use a sign which is identical with or similar to a sign for the goods or services of the

the use of such a sign in relation to those goods or services would indicate the connection between those goods or services and the owner of the protected trade mark and provided there is a likelihood that it could be detrimental for the interests of the owner of a protected trade mark.

Limitation of Rights

Article 28

- (1) The owner of a trade mark shall allow third persons to use in trade their name, surname, pseudonym, title or trade name, address of the residence, information concerning the kind, quality, quantity, purpose, value, geographical origin, the date of production of goods or of rendering of a service or any other characteristic of the goods, irrespective of the fact that those indications are identical with or similar to the trade mark, or form parts of a trade mark, but provided that they have been used in compliance with the usual trade practice and fair market competition.
- (2) The owner of a trade mark shall allow third persons to use in trade a sign which is identical with or similar to a trade mark if it is necessary for the indication or designation the intended purpose of the goods, particularly the accessories or spare parts thereof, or the kind of services which are rendered in accordance with the established practice in trade and fair market competition.

Acquiescence in the Use of a Trade Mark

Article 29

- (1) The trade mark owner shall allow the use of the later identical or similar trade mark for identical or similar goods or services for which he has been protected if he has acquiesced in this use for five years, except where the trade mark owner with the later priority right has protected the trade mark in bad faith.

Article 30

- (1) On the request of the applicant for, or the owner of a trade mark the Office shall enter into the corresponding register all changes relating to the personal name, if natural person is concerned, the trade name or the business seat or the residence of the applicant or the residence of his employment, as well as other changes occurring

- (1) A trade mark shall be the subject of rights in rem and levy of execution.
- (2) The rights referred to in paragraph (1) of this Article shall be effective against third persons only after the entry thereof into the register.

Assignment of Rights

Article 33

- (1) The trade mark applicant or the trademark owner may assign, entirely or partially, his

- (1) A trade mark shall be valid for 10 years counting from the date of filing the trade mark application.
- (2) A trade mark shall be renewed indefinite number of times and that for the periods of ten years each, provided that the applicant file to the Office a request for the extension of the validity of a trade mark and pay the corresponding fee, in the course of the last year of the ten-year period of protection or six months at the latest after the expiration of this period.
- (3) The new period of protection shall begin with the day of expiration of the previous ten-year period of protection.

Use of a Trade Mark

Article 36

- (1) A trade mark owner shall, to maintain his rights, use a trade mark for the goods or services for which it is granted, unless serious reasons exist for its non-use, particularly the import restrictions or any other government requirements in respect of the goods or services for which a trade mark is granted.
- (2) The use of a trade mark in the slightly changed form not changing the distinctive

legal capacity of a trade mark owner or on the day of his death, unless the right has been transferred to another owner;

(2) With regard to the case referred to in

For the acquisition of a collective trade mark it shall not be necessary that the business association have its own manufacturing or service trade company in, or outside, the Republic of Croatia.

Contract on a Collective Mark

Article 41

A contract on a collective mark shall be filed with a request for the grant of a collective mark and shall contain the name and the business seat of the business association, a list of persons authorized to use a collective mark, conditions determining such use and provisions relating to the infringement of rights in the event of the misuse of a collective mark or of the breach of the provisions of a contract.

Changes

Article 42

- (1) On the request of the applicant or of the owner of a collective mark, the Office shall enter into the register any changes relating to the structure of the members or partners of the business association and any amendments of the contract regulating the use of a collective mark.
- (2) The rights arising from a collective mark shall not be transferable and shall not be the subject of the license, the compulsory execution or the lien.
- (3) All requests for the entry of changes occurred in connection with a collective mark shall be subject to the payment of preseUym

- (1) All actions in the procedure of the acquisition and maintenance of a trade mark shall be subject to the payment of fees in the amount fixed by a special tariff (hereinafter:

- (1) Foreign natural or legal persons not having residence or business seat in the territory of the Republic of Croatia shall appoint an authorized agent having residence in the Republic of Croatia.
- (2) General principles of representation and special conditions under which foreign natural or legal persons may exercise rights arising from this Law in the procedure before courts and administration bodies through authorized agents, shall be specified in special laws.

Article 51

- (1) On the request of the complainant the court may order the destruction of articles unlawfully designated by a trade mark, being in the possession of a defendant.
- (2) The court shall decide whether the articles unlawfully designated by a trade mark will be destroyed, made unrecognizable or will be used in any other way.

Limitation (Lapse) of an Action

Article 52

An action for the infringement of a trade mark may be instituted within three years after learning about the infringement and the infringer, and five years at the latest after the commitment of the infringement.

Provisional measures

Article 53

- (1) If the owner of a trade mark makes it likely that his right has been infringed or that there is a likelihood of infringement which might cause the irreparable harm, may require from the court:
 1. to order provisional measures concerning the prohibition of acts infringing the rights of the owner of a trade mark;
 2. provisional seizure of articles unlawfully designated by a trade mark or the exclusion thereof from circulation;
 3. measures concerning the assurance of evidence concerning articles unlawfully designated by a trade mark and measures for preserving the existing situation.
- (2) The owner of a trade mark may require the ordering of provisional measures even before the institution of an action, provided that he institutes an action within 15 days counting from the filing date of the request for ordering a provisional measure.
- (3) An appeal against the decision ordering a provisional measure shall not postpone the execution thereof.

Compensation for Damages

Article 54

- 1) The court may order to the trade mark owner the compensation for damages if it has been proven that the required measures referred to in Article 53, paragraph (1) of this Law are unjustified.
- 2) The court may order to the trade mark owner to deposit an appropriate amount of money as a security for the person the provisional measure has been ordered against.

Part Nine
PENAL AND CRIMINAL PROVISIONS

Criminal Acts

Article 55

- (1) Whoever uses, reproduces or imitates, offers, affixes to products or the packaging thereof, imports, exports a trade mark of another without authorization or uses a trade mark of another when rendering services, shall be punished for a criminal act by a fine or imprisonment up to three years.
- (2) Whoever stocks products knowing that they are unlawfully designated by a trade mark of another, aware thereof sells such products or renders services under service mark of another, or supplies himself or others with products designated by a trade mark of another shall be punished by a fine or imprisonment referred to in paragraph (1) of this Article.
- (3) If the commitment of a criminal act refe

- (5) A natural person shall be punished for offenses referred to in paragraphs (1) and (2) of this Article committed for the purpose of acquiring financial gain by a fine of 20 000,00 kunas.

Part Ten
TRANSITIONAL AND FINAL PROVISIONS

Pending Procedures

Article 57

Trade mark granting procedures pending on the day of application of this Law shall be continued under the provisions of this Law.

Termination of the Effect of Other Provisions

Article 58

With the day of application of this Law, the Industrial Property Law (Official Gazette of the Republic of Croatia, No 53/91, 19/92 and 26/93) in part concerning trade marks and the Law Governing Administrative Fees (Official Gazette of the Republic of Croatia No. 59/96) in part concerning trade marks shall cease to be in effect.

Time Limit for the Enactment of the Regulations

Article 59