Serbia

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Legal framework

National

The fundamental legislation governing trademarks is the Trademark Act, which came into force on December 24 2009, amended January 30 2013. Detailed procedures for filing trademark applications are set out in Decree 43/10, which was issued on July 3 2010. Trademark infringement as a form of unfair competition is regulated by the Trade Act, which came into force on January 1 2011, amended January 30 2013. The Customs Act 2010, amended November 30 2012, and the Act on Special Powers for the Efficient Protection of Intellectual Property 2006 regulate the treatment of pirated and counterfeit goods.

International

Serbia is a member of:

- the Paris Convention for the Protection of Industrial Property (1883);
- the Madrid Agreement on the International Registration of Marks (1891), as well as the Madrid Protocol (1989);
- the Nice Agreement on the International Classification of Goods and Services (1957);
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (1973);
- the Nairobi Treaty on the Protection of the Olympic Symbol (1981);
- the Trademark Law Treaty (1994);
- the Singapore Treaty on the Law of Trademarks (2006); and
- the Hague Convention Abolishing the Requirements of Legalisation for Foreign Public Documents – Apostille (1965).

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Unregistered marks

Protection

The Trademark Act bars registration of a mark that is identical or similar to a mark “known in Serbia within the meaning of Article 6*bis* of the Paris Convention”.

The Trade Act prescribes protection for packaging, trade dress and other unregistered marks with its provisions on unfair competition.

Use requirements

The law requires the use to be serious. In establishing seriousness, the Intellectual Property Office (IPO) and courts will generally consider:

- the level of sales;
- the intensity of advertising; and
- the period of use.

It is also necessary that the goods or services be continuously available and easily accessibile to a large number of average consumers, in order to qualify. The IPO stated that normal use is not sufficient: to establish an unregistered right, the sales must exceed customary or usual levels, while the advertising must be more aggressive than the relevant industry standard. As for the period of use, it is generally held that five years is the required minimum, analogous to the legally prescribed five-year period of non-use that makes a trademark vulnerable to cancellation.

Registered marks

Ownership

All natural and legal persons may apply for and own a mark. Foreign persons may apply for registration only through a representative – a trademark agent registered with the IPO in Belgrade – or through a local lawyer.

Power of attorney

The power of attorney given to the representative should be simply signed by the owner (in the case of a natural person) or an authorised officer (in the case of a legal entity). Notarisation and/or legalisation is not required. The power of attorney may be filed late, upon payment of an additional fee.

Scope of protection

Protection extend to marks that may be represented graphically, including words, slogans, numbers, depictions, drawings, colour schemes, three-dimensional (3D) marks, a combination of those marks, as well as musical phrases represented by musical notation.

A mark that contains the image or name of a natural person may be protected only with that person’s permission or, if that person is deceased, with the permission of his or her parents, spouse and children. If the person is of historical or other importance, permission must be obtained from the competent authority and from the spouse and relatives up to the third degree of kinship.

A trademark may be protected as an individual mark, a collective mark or a certification mark.

Divisional applications and disclaimers are allowed.

Seals, stamps and official marks for the marking of precious metals are specifically excluded from the scope of protection.

In addition, a mark cannot be protected if:

- it cannot be graphically represented;
- it is contrary to public policy or to accepted principles of morality;
- its general appearance does not enable the

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goods or services to be distinguished in the market;
- it exclusively represents a 3D shape that is determined by the nature of the goods, is necessary to obtain a given technical result or essentially affects the value of the goods;
- it exclusively designates the type, purpose, time of production or service, quality, price, quantity or geographical origin of the goods or services;
- it has become customary for designating a given type of goods or services;
- it could cause confusion and mislead the relevant public with regard to the geographical origin, type, quality or other characteristics of the goods or services concerned;
- it contains official marks or hallmarks of quality control or warranties, or imitations thereof;
- it is identical to a protected mark belonging to another person and used for the same type of goods or services;
- it is identical to an earlier protected mark belonging to another person for a similar type of goods or services, or it is similar to an earlier protected mark belonging to another person for identical or similar goods or services, if such identity or similarity is likely to cause confusion in the relevant part of the public, including the likelihood of association of that mark with the earlier protected mark;
- it is identical or similar to a mark for identical or similar goods or services known in Serbia within the meaning of Article 6*bis* of the Paris Convention;
- it represents a reproduction, imitation, translation or transliteration, in whole or in distinctive part, of a protected mark that is undoubtedly considered well known in Serbia, if its use would represent unfair competition or would affect the distinctive character or reputation of the famous mark;
- it infringes a copyright or industrial property right;
- it consists of a state or other public coat of arms, flag or other emblem, name or abbreviation of the name of a country or an international organisation, or imitations thereof, unless the competent authority of the country or organisation concerned has given its authorisation; or
- it represents or imitates a national or religious symbol.

Marks that fail to meet some of these requirements may be registered if the applicant can proves that the mark has, through serious use, become capable of distinguishing goods (ie, services in the market).

No essential modifications of the appearance of the mark or broadening of the specification is allowed after filing.

Procedures

Examination

First, the IPO examines the trademark application for formal irregularities. These may be remedied within an extendable deadline of 30 days. Failure to do this will lead to the application's rejection, which may be appealed.

Second, the IPO examines whether the mark meets the legal requirements for protection (absolute and relative grounds). Irregularities may be remedied within an extendable deadline of 30 days. Failure to do this will lead to the application's rejection, which may be appealed.

The examination procedure may result in the application's full or partial acceptance, or rejection. The applicant may challenge

the latter by filing an appeal before the Administrative Commission within 15 days. The commission may accept the appeal and return the application to the IPO for further examination or reject the appeal. The applicant can contest the commission's decision before the Administrative Court within 30 days. The court's decision is final.

Opposition

No opposition procedure is prescribed by law. However, the Trademark Act allows written opinions to be filed by any interested party, informing the IPO of the reasons why an application does not satisfy the grounds for protection, which the IPO will take into consideration during examination.

Registration

Once the examination has been concluded and the application has been accepted, the applicant is invited to pay the publication fee, the fee for the first 10 years of protection and the issue fee. Upon receipt of proof of payment, the IPO will enter the mark in the Trademark Register and issue the trademark certificate. Once registered, a trademark is valid for 10 years from the application's filing date and may be renewed for successive 10-year periods upon payment of the relevant renewal fees.

Removal from register

Cancellation/surrender: A trademark will expire once the period for which maintenance tax has been paid has elapsed. The rights holder may file a surrender claim at any time; the trademark's validity will cease on the day after the surrender claim is filed.

Revocation: A trademark that has not been used without good cause for a period of five consecutive years (from the date of registration or the date of last use) becomes revocable at the request of an interested party. The burden of proof of use rests with the rights holder.

The advertising of goods or services that are not available in the market does not constitute use. Neither does the payment of maintenance tax or the execution of assignment, licence or similar agreements. Good cause for non-use must be independent of, and contrary to, the owner's will (eg, prohibition against import).

Invalidation: If a mark did not fulfil all legal requirements at the time of registration, it may be invalidated – in whole or in part. Invalidation proceedings may be initiated for as long as a mark is valid by the public prosecutor or an interested party.

Termination: At the request of an interested party, the IPO may issue a decision to terminate a trademark registration where the mark:

- has become a generic term;
- has become capable of causing confusion in commerce as to the geographical origin, type, quality or other characteristics of the goods or services for which it is registered; or
- has become contrary to morals or public order.

The right to use a collective trademark or a warranty trademark may also be terminated if the collective mark or warranty mark is used contrary to the guidelines of use submitted with the application.

Timeframe

The approximate timeframes for actions at the registry are as follows:

- Applications against which no objections on absolute or relative grounds are cited by the examiner take between eight and 10 months from filing to registration.
- Applications for international registrations with the World Intellectual Property Organisation take approximately three months from the date of filing requests for international registration with the IPO.
- Expedited examination is possible in the following cases: initiated action before the court, market inspectorate or customs, or if urgent registration is required because of other regulations, such as obtaining marketing authorisation for pharmaceuticals. In these cases, registration takes between 30 and 60 days.
- A recordal of renewal takes between 15 and 30 days from the date of filing the request, provided that all documents are in order.
- A recordal of merger takes between 15 and 30 days from the date of filing the request, provided that all documents are in order.
- A recordal of change of name takes between 15 and 30 days from the date

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of filing the request, provided that all documents are in order.

Searches

Searches conducted at the IPO will encompass all marks registered and in force since the establishment of the IPO, as well as all trademark applications filed before the date of the search. Search results include trademarks that have recently lapsed, but that could be relevant.

Search results encompass identical and similar earlier marks, with the basic fee covering a search in up to three classes.

Searches for slogans, devices, non-traditional graphic marks and trade names are available, as well as searches by company name.

Enforcement

Complexity

Registered rights may be enforced by several actions:

- trademark infringement action;
- unfair competition action;
- customs action;
- market inspectorate action; and
- copyright action.

Unregistered rights may not be enforced by customs or market inspectorate actions.

Trademark infringement: In trademark infringement proceedings the court may be petitioned to:

- establish the infringement;
- order the infringer to cease and desist;
- order the destruction or alteration of the infringing goods;
- adjudicate damages, including triple punitive damages;
- order publication of the judgment, in whole or in part, in selected media; and/or
- order the provision of information about third parties involved in the infringement.

By law, trademark infringement proceedings are considered urgent. The petition must be filed within three years of the date on which the petitioner learned of the infringement and the infringer, but no later than five years after the first infringement was committed. At the petitioner's request, the court may issue an injunction ordering the infringing goods and/or the means for their production to be impounded. If the infringing mark is identical to the petitioner's mark, the court must issue an injunction. At the request of the alleged infringer, the court may order the petitioner to deposit an amount to be paid to the alleged infringer should the petition fail.

Unfair competition: In unfair competition proceedings the court may order the infringer to cease and desist, and may adjudicate damages to the petitioner.

Customs action: A customs action empowers Customs to detain goods that infringe IP rights or that belong to unauthorised importers, exporters or holders. The proceedings may be initiated either *ex officio* by Customs itself or by the rights holder. The rights holder must initiate judicial proceedings to establish infringement within 10 working days (extendable to 20) of notification of the customs action only if the unauthorised importer, exporter or holder files an objection with the Customs Office regarding the seizure. If no objection is filed, the rights holder can request the destruction of the seized goods.

Market Inspectorate action: This action empowers the Market Inspectorate to seize

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infringing goods from bulk and retail traders. The proceedings may be initiated either *ex officio* by the inspectorate or by the rights holder. The rights holder must initiate judicial proceedings to establish infringement within 15 days (extendable to 30) of notification of the seizure only if the infringer filed an objection with the Trade Inspectorate. If the infringing goods are medicaments, the proceedings will be conducted by the Ministry of Health' Sanitary Inspectorate.

Copyright infringement: In copyright infringement proceedings the court may prohibit the use of the infringing mark and adjudicate damages. An additional protection against copyright infringement is criminal prosecution of the person that created the infringing mark.

If another person has applied for or registered an identical mark for identical or similar goods or services, the owner of the original well-known mark may petition the court to order the transfer of such application or registration to it. The petition must be filed within five years of registration of the infringing mark. However, it will not succeed if the alleged infringer can prove use of its mark that pre-dates the petitioner's.

Timeframe
Depending on their complexity and other factors, judicial procedures may take between six months and two years to complete at first instance. All judgments brought at first instance are subject to appeal; appellate proceedings usually take about one year to complete. Customs and inspectorate actions have immediate effect, pending judicial proceedings.

Specialised courts
There are no specialised trademark or IP courts in Serbia. Higher and commercial courts are authorised to hear cases of trademark infringement.

Damages
If the infringement was intentional, the plaintiff may request compensation amounting to up to three times the licence fee that it would have charged for use of the mark, instead of compensation for pecuniary damage.

Ownership changes and rights transfer
The IPO practice is in keeping with Article 11 of the Trademark Law Treaty. A change of name or address will be effected on the basis of a request filed by the owner, the only requirement being a fresh power of attorney showing the new particulars.

In the event of a transfer of rights arising from an assignment or merger, the original contract, signed by both parties, or a copy certified by apostille or legalised (if the country is not a signatory of the Apostille Convention), must be submitted.

Bilingual short-form confirmatory deeds for recordal of assignment or merger, signed by both parties, are accepted. They need not be notarised or certified by apostille/legalised, provided that the originally signed document is submitted.

A registered trademark and/or trademark application may be the subject of a licence agreement. The contract must be made in writing and can be entered into the appropriate register at the request of the contracting parties. The contract shall not have legal effect with regard to third parties unless it is entered in the appropriate register. In order to register a licence,

it is necessary to submit the original contract, signed by both parties, or a copy certified by apostille or legalised (if the country is not a signatory of the Apostille Convention), to the IPO.

Bilingual short-form confirmatory deeds for recordal of licence, signed by both parties, are accepted. They need not be notarised or certified by apostille/legalised, provided that the originally signed document is submitted.

If the documents were executed in a foreign language, a certified translation must be submitted to the IPO. There is no time limit for filing a request for recordal of ownership change/licence.

Use by a licensee is considered as use by the owner for the purposes of meeting the use requirement.

Related rights

A mark will enjoy copyright protection only if it represents an original creation of its author within the meaning of the Copyright Act (ie, if it satisfies the requirement of artistic merit). This applies not only to devices and logos, but also to word marks, especially slogans and jingles. A mark that represents an original creation enjoys copyright protection by law, from the moment of its creation.

Online issues

The Trademark Act does not regulate the online use of registered or unregistered marks. Under the rules on domain names in the top-level country-code '.rs', if a third party has registered a '.rs' domain name that is identical or substantially similar to a trademark, there may be cause to terminate this registration or transfer the domain name to the rights holder. WTR

Examination/registration		
Representative requires a power of attorney when filing? Legalised/notarised?	**Examination for relative grounds for refusal based on earlier rights?**	**Non-traditional marks registrable?**
Yes/No ✓ / ✗	Yes ✓	3D; colours; sounds. ✓

Unregistered rights	
Protection for unregistered rights?	**Specific/increased protection for well-known marks?**
Yes ✓	Yes ✓

Opposition
Can a registration be removed for non-use? Term and start date?
No ✗

Removal from register		
Can a registration be removed for non-use? Term and start date?	**Are proceedings available to remove a mark that has become generic?**	**Are proceedings available to remove a mark that was incorrectly registered?**
Yes: five years' non-use from the date of registration or last use. ✓	Yes ✓	Yes ✓

Enforcement		
Specialist IP/trademark court?	**Punitive damages available?**	**Interim injunctions available? Time limit?**
No ✗	Yes ✓	Yes ✓

Ownership changes
Mandatory registration for assignment/licensing documents?
No/No ✗ / ✗

Online issues	
National anti-cybersquatting provisions?	**National alternative dispute resolution policy (DRP) for local ccTLD available?**
Yes ✓	Yes ✓

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