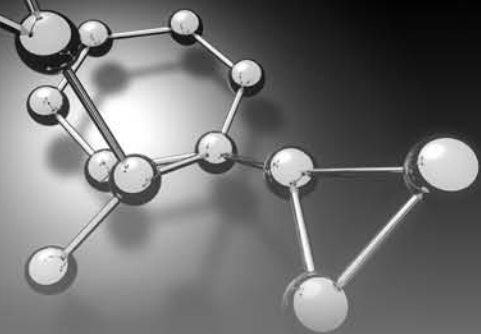




MJB

MIKIJELJ JANKOVIC & BOGDANOVIC

MJB was established as a law office in 1985. The largest part of the practice is devoted to intellectual property. Members of the firm are licensed to represent clients before the Office for Protection of Intellectual Property in Belgrade and have considerable experience in handling patent and trademark infringement cases. Equal attention is paid to copyright law. In cooperation with its local correspondents, MJB actively handles IP cases throughout the region – in Slovenia, Croatia, Bosnia and Herzegovina, Montenegro, Kosovo and Macedonia.

According to the Legal 500 2008 Report on Serbia:

“The reputation of Mikijelj Jankovic & Bogdanovic as a leading IP advisor is confirmed by satisfied clients, who continue to provide excellent feedback on the quality of the lawyers and turn-around times at this ‘practical’ and ‘proactive’ firm. Clients such as Nestlé, Coca-Cola, Burberry and Ford entrust their IP matters to the team.”

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1. Legal framework

National

The fundamental legislation governing trademarks is the Trademark Act, which came into force on January 1 2005. More detailed procedures for filing and prosecuting trademark applications are contained in the new Decree on Trademark Examination Procedure (28/05) issued on July 8 2005. Trademark infringement as a form of unfair competition is regulated by the Trade Acts 1993 to 2002, while the Customs Act 2003 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 (1959);
- the Trademark Law Treaty (1994); and
- the Hague Convention Abolishing the Requirements of Legalization for Foreign Public Documents – Apostille (1965).

2. Unregistered marks

Protection

Article 5(1) of the Trademark Act, implementing the protection provided to unregistered marks by the Paris Convention, bars registration of a mark that is identical or similar to a mark “known in Serbia and Montenegro within the meaning of Article 6bis of the Paris Convention”.

Article 5(2) of the Trademark Act allows for the registration of a mark that does not meet some of the prescribed registration requirements, provided that the applicant proves that the mark “has, through serious use, become suitable for distinguishing goods or services in the market”.

Article 23(7) of the Trade Act offers the same protection from unfair competition to

all marks, regardless of whether they are registered.

Use requirements

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

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

“Continuous availability” of goods or services and their “easy accessibility to a large number of average consumers” are required. In one of its rulings 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.

3. 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 who is registered with the IPO in Belgrade or through a local lawyer.

Power of attorney

The power of attorney given to the representative should simply be signed by the owner (if the owner is a natural person) or by an authorized officer of the owner (if the owner is a legal person). If the power of attorney is not enclosed when the application is filed, the IPO shall, upon formal examination, order the applicant to submit it within 30 days. In such case, an additional tax for late filing must be paid.

Scope of protection

Protected: Words, devices (two and three-dimensional), colours and music are protectable as trademarks.

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 or children. If the person is of historical importance, permission must be obtained from the Ministry of Culture.

Not protected: Seals, stamps and official marks for the marking of precious metals and measures, or for similar purposes, are not protectable.

In addition, a mark cannot be protected if:

- it is contrary to law or public morality;
- its general appearance does not enable the goods or services to be distinguished in the market;
- it exclusively represents a shape determined by the nature of the goods or a shape indispensable to obtain a given technical result;
- it exclusively designates the type, purpose, time or method of production, quality, price, quantity, weight or geographical origin of the goods or services;
- it is customary for designating a given type of goods or services;
- it is liable, because of its appearance or content, to create confusion in economic activities with regard to the origin, type or other characteristics of the goods or services;
- it contains official signs or hallmarks of quality control, or warranties or imitations thereof;
- it is identical to a protected mark belonging to another person and used for identical or similar goods or services;
- it is similar to a protected mark belonging to another person and used for identical or similar goods or services, if such similarity may lead to confusion in the market and mislead the public;
- it is identical or similar to a mark known in Serbia within the meaning of Article 6 *bis* of the Paris Convention for identical or similar goods or services;
- it represents a reproduction, imitation, translation or transliteration, in whole or in part, of a protected mark that is undoubtedly known in Serbia as a well-known mark, if its use would represent unfair competition or would affect the

distinctive character or reputation of the well-known mark;

- it infringes, by its appearance or content, a copyright or an industrial property right;
- it contains, without proper authorization, armorial bearings, flags or other emblems of the state or another public law entity, the name or abbreviation of the name of a country or an international organization, or imitations thereof; or
- it represents or imitates a national or religious symbol.

4. Procedures

Searches

The following searches are available at the IPO prior to filing a trademark application:

- all marks registered since the establishment of the IPO;
- identical marks and similar marks;
- search per class or for all classes;
- trade names and slogans; and
- traditional and non-traditional graphic marks.

Examination

First, the IPO examines the trademark application for formal irregularities (including non-payment of fees). If any are found, the IPO will establish a deadline (extendable upon payment of a fee) by which the applicant must remedy them. If the applicant fails to do so, the application will be rejected, although the applicant is entitled to initiate proceedings to reactivate the application within three months of rejection.

Second, the IPO examines whether the mark meets the legal requirements for protection and whether any of the legal obstacles are present (see section 3 above). No essential modifications of the mark or specification are allowed during the examination procedure. The IPO may require the applicant to file a disclaimer regarding certain elements of the mark. It may also, at the applicant's request, allow one or more divisional applications.

The examination procedure may result in acceptance of the application, partial acceptance or rejection. The applicant may

challenge the latter in proceedings before the Supreme Court of Serbia within 30 days. The court's decision is final.

Opposition

No opposition procedure is prescribed by law. In practice, however, the IPO will take into consideration written submissions by owners of previous registrations or applications who claim that their marks are identical or similar to the mark under examination.

Registration

Once examination is concluded and the application is accepted, the applicant is invited to pay the publication fee and the tax for the first 10 years of protection. 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 filing of the application and may be renewed for successive 10-year periods upon payment of the relevant tax.

Removal from register

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

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. In the revocation proceedings, which are conducted by the IPO, the burden of proof of use rests with the trademark owner.

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 IPO, a public prosecutor or an interested party.

Termination: The competent authority may also, at the request of an interested party, issue a decision to terminate a trademark registration where the mark:

- has become a generic term for the goods and/or services for which it is registered due to acts or omissions by the mark holder or its successor in rights;
- has become capable of causing confusion in commerce as to the origin, type, quality or other characteristics of the goods and/or services for which it is registered due to the manner of use by its holder or its successor in rights; or
- has become contrary to morals or public order.

The right to use a collective trademark and a warranty trademark may also be terminated if the collective mark or the 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 18 to 24 months from the filing date to mature to registration.
- Applications for international registrations with the World Intellectual Property Organization take approximately three months from the date of filing the requests for international registration with the IPO.
- Urgent registrations (in Class 5 of the Nice Classification only) take 30 to 90 days.
- Expedited applications, following the filing of an infringement or unfair competition action in the court or with the market inspectorate, take approximately 30 to 90 days.
- A recordal of renewal takes 30 to 45 days from the date of filing the motion.
- A recordal of merger takes 30 to 60 days from the date of filing the motion.
- A recordal of change of name takes 30 to 60 days from the date of filing the motion.

5. Enforcement

Complexity

Registered rights may be enforced by several actions:

- trademark infringement;
- unfair competition;
- 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; and/or
- order publication of the judgment, in whole or in part, in selected media.

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 not 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 the 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, available in local law since 2004, empowers Customs to detain goods that infringe IP rights or that belong to unauthorized importers, exporters or holders. The proceedings may be initiated either *ex officio* by Customs itself or by the owner of the IP

rights. The rights owner must initiate judicial proceedings to establish infringement within 15 days (extendable to 30) of commencement of the customs action.

Market Inspectorate action: This action, which has been available under national law since 2006, empowers the Market Inspectorate of the Ministry of Trade to seize infringing goods from bulk and retail traders. The proceedings may be initiated either *ex officio* by the inspectorate or by the owner of the IP rights. The rights owner must initiate judicial proceedings to establish infringement within 15 days (extendable to 30) of notification of the seizure. If the infringing goods are medicaments, the proceedings are conducted by the Sanitary Inspectorate of the Ministry of Health.

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 who created the infringing mark.

The owner of a well-known unregistered mark, in the event that another person has applied for or registered an identical mark for identical or similar goods or services, may petition the court to order the transfer of such application or registration to the petitioner. The petition must be filed within five years of registration of the infringing mark. The petition will fail if the alleged infringer proves use of its mark that pre-dates the petitioner's use of the well-known mark.

Timeframe

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

Specialized courts

There are no specialized trademark or IP courts. The Law on Regulation of Courts

provides that only district and commercial courts are authorized to hear cases of trademark infringement.

Damages

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

6. Ownership changes and rights transfers

IPO practice is in keeping with Article 11 of the Trademark Law Treaty. A simple request by the trademark holder or new owner will generally suffice to effect the ownership change. However, it is strongly recommended that proof of the legal grounds for the change be submitted with the request, as the IPO may require such proof.

If the change of ownership follows from a contract, it is recommended that the original or a notarized copy of the contract be submitted. Notarization should be affixed with an apostille.

If the change of ownership follows on from a merger, it is recommended that the original or a notarized copy of the merger certificate be submitted, affixed with an apostille.

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

- an original or certified copy of such contract;
- an original excerpt from such contract signed by the contractual parties; or
- a certified copy of those documents.

If the documents were made in a foreign language, a certified translation of the same must be submitted to the IPO. Notarization should be affixed with an apostille.

There is no time limit for filing

these documents.

Use by a licensee is always considered to be use by the owner for the purposes of meeting the use requirement.

7. 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.

8. Online issues

The Trademark Act does not regulate the online use of registered or unregistered marks. Under the new rules on '.rs' domain names, if a third party has registered a '.rs' domain name that is identical or substantially similar to a trademark, there may be cause for termination of such registration or transfer of the domain name to the trademark owner.

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Unregistered rights	
Protection for unregistered rights?	✓
Specific/increased protection for well-known marks?	✓
Examination/registration	
Representative requires a power of attorney when filing? Legalized/notarized?	✓ / ✗
Examination for relative grounds for refusal based on earlier rights?	✓
Registrable unconventional marks	3-D, colours, sounds ✓
Opposition	
Opposition procedure available? Term from publication?	✗
Removal from register	
Can a registration be removed for non-use? Term and start date?	5 years' non-use ✓
Are proceedings available to remove a mark that has become generic?	✓
Are proceedings available to remove a mark that was incorrectly registered?	✓
Enforcement	
Specialist IP/trademark court?	✗
Punitive damages available?	✓
Interim injunctions available? Time limit?	✓
Ownership changes	
Is registration mandatory for assignment/licensing documents?	✗ / ✗
Online issues	
National anti-cybersquatting provisions?	✓
National alternative dispute resolution policy (DRP) for local ccTLD available?	✓