

Lithuania

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1. Legal framework

National

Trademarks in Lithuania are regulated by the Law on Trademarks (October 10 2000). This law was recently amended to meet the requirements of the EU Trademark Directive (89/104/EEC). As Lithuania is an EU member state, all applicable EU regulations and directives concerning the regulation of trademarks are in force.

Other applicable legal acts are:

- the Regulations for the Registration of Trademarks, approved by the director of the State Patent Bureau; and
- the Regulations for Appeal and Opposition Examination, approved by the director of the bureau.

International

Lithuania is a party to the following international conventions and agreements:

- the Convention Establishing the World Intellectual Property Organization;
- the Protocol to the Madrid Agreement Concerning the International Registration of Marks;
- the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks; and
- the Paris Convention for the Protection of Industrial Property through the Trademark Law Treaty and the Agreement on Trade-Related Aspects of Intellectual Property Rights.

2. Unregistered trademarks

The law applies to trademarks that are recognized as well known in Lithuania. A well-known trademark can be recognized as such through judicial procedures by the Vilnius

District Court. Only an interested person can bring such a procedure. When issuing a decision to recognize a trademark as well known, the court designates a date from which the trademark is held to be a well-known trademark.

Undertakings may not use, without authorization, a mark identical or similar to a registered or unregistered well-known trademark or an unregistered trademark with distinguishing features, if this use causes or may cause confusion as to the activities of the undertaking or if it seeks to take advantage of the reputation of the mark owner.

3. Registered trademarks

Ownership

Any legal or natural person, group of persons or association can apply for and own a trademark. The application can be filed by the applicant or by a representative on behalf of the applicant.

Some limits are imposed on foreign natural and legal persons who are not permanent residents of, or do not have a branch office or representative office in, Lithuania or another EU member state. Such persons must file an application and perform all actions relating to the registration of a trademark through a Lithuanian patent attorney.

Scope of protection

Protected: A mark can be protected only if it is:

- capable of distinguishing the goods or services of one party from those of others; and
- capable of being represented graphically.

A legally protected trademark may consist of words, personal names, artistic pseudonyms, company names, slogans, letters, numerals, drawings, emblems and other signs, which are listed in Article 5 of the law.

A colour itself can be protected as a trademark only if it has acquired secondary meaning. Secondary meaning is considered to be acquired if the applicant can prove that a customer understands the colour to be an attribute of the goods bearing that colour.

According to the Regulations for the Registration of Trademarks, smells and sounds can be protected as trademarks only if they can be depicted graphically.

Not protected: There are 12 absolute grounds for refusal of an application to register a trademark in Lithuania. For example, a trademark will not be recognized as such and registration will be refused if:

- the sign is devoid of any distinctive character;
- the sign has become customary within the language or in the good-faith and well-established practices of the trade;
- the sign is of high symbolic value (particularly religious symbols); or
- the sign is contrary to accepted principles of morality or public policy, including social ethics and humanitarian principles.

In addition, an application for registration will be refused if the trademark is identical or similar to an earlier mark and is used for identical or similar goods and/or services, thus creating likelihood of confusion on the part of the public.

Grounds for the invalidation of a registration include that:

- the trademark is identical to an earlier trademark and the goods and/or services for which the trademark is registered are identical to the goods and/or services for which the earlier trademark is registered;
- the trademark is identical or similar to a trademark recognized as well known in Lithuania; or
- the trademark is similar or identical to the business name of a legal person or creates

the likelihood of confusion with the business name of a legal person.

The complete list of relative grounds for invalidation can be found in Article 7 of the law.

The bureau does not carry out an examination to determine whether an applied-for mark is identical or similar to already-registered trademarks.

4. Procedures

Examination

Any person who is entitled to and wishes to register a trademark must file an application with the bureau. The application must be completed in Lithuanian and contain information including:

- a request for the registration of the trademark and issuance of the trademark certificate;
- a document certifying payment of the fixed fee; and
- a power of attorney if the application is filed by an authorized person. The application will be accepted without a power of attorney, but this must be provided no later than three months after the filing of the application.

Within one month of receipt of the application the bureau carries out a formal inspection of the application documents to ensure that:

- all the compulsory documents have been filed;
- the documents comply with the requirements of law and other legal provisions; and
- the goods and/or services for which registration is requested comply with the requirements of the Nice Classification.

If deficiencies are found in the application documents, the applicant is required to remedy these deficiencies within three months of notification. If it fails to do so, the bureau will reject the registration and inform the applicant of the rejection in writing. The term to supply

additional information may be extended once, but by no more than two months from the expiration of the initial time limit.

After examination of the application, the bureau examines the mark to ensure that there are no absolute grounds for refusal of registration or invalidation of a trademark.

If the bureau decides not to register a trademark, the applicant has the right to request, within three months of receipt of the decision, that the bureau re-examine the application. If the holder of an international registration opposes the bureau's decision to refuse registration, it may request re-examination within five months of receipt of the decision.

If the applicant is not satisfied with the bureau's second decision, it has the right to file an appeal with the Appeals Division of the bureau. If the applicant objects to the decision of the Appeals Division, it can appeal the decision to the Vilnius District Court.

Opposition

Any interested person may file a justified written opposition to the registration of a trademark with the Appeals Division of the bureau if absolute grounds for refusal of registration or invalidation of a trademark or relative grounds for invalidation of the registration exist. The opposition must be filed within three months of publication of the registered trademark. The owner, or the representative of the owner, of the opposed trademark must file a reply to the opposition within three months of receipt of the opposition. This time limit cannot be extended. If the opposition is filed by a representative of the trademark owner, that representative must present its power of attorney alongside the opposition.

If the owner fails to reply to the opposition, this will be treated as a refusal to participate in the examination of the opposition and will not

prevent the Appeals Division from examining the opposition in the absence of the trademark owner or its representative.

The trademark owner, applicant or interested person, or its representative, has the right to participate in the appeal or opposition proceedings at the Appeals Division. Such proceedings are oral and public. There is a two-week time limit before such proceedings for both parties to present evidence to support their positions.

A decision issued by the Appeals Division may be appealed to the Vilnius District Court within six months of the date of the decision.

Registration

Once it has been established that there are no absolute grounds for refusal or invalidation, the bureau approves the decision to register the mark. The owner is obliged to pay the fixed fee for registration and publication of the trademark within three months of receipt of the decision to register the mark. If the fee is not paid, the application is deemed to have been withdrawn. The time limit for fee payment may be extended once, but by no more than two months from the expiration of the initial time limit.

After receiving payment, the trademark is registered in the Register of Trademarks. In addition, registered trademarks are published in the *Official Bulletin* of the bureau.

The owner of the registered trademark receives a certificate of registration of the trademark. This certificate is a legal document which certifies the exclusive rights of the owner to the registered trademark.

The owner of a registered trademark has an exclusive right to prevent all unauthorized third parties from using in the course of trade any sign that is identical to its registered trademark where, because it is identical or similar to the registered

trademark for identical or similar goods and/or services, there exists a likelihood of confusion on the part of the public. The owner is also entitled to prevent third parties affixing the sign to goods or the packaging of goods, importing or exporting goods under that sign or using the sign on business stationery or in advertising.

The scope of protection of a trademark is limited to those goods and/or services that are listed on the certificate of registration of the trademark. If the owner of the trademark wishes to expand the list of goods and/or services, it must file a new application. If the trademark undergoes essential modifications, a new application is required.

A trademark registration lasts for 10 years from the date of filing of the application. For an additional fee, the registration may be renewed for a further 10-year period for all or only some of the goods and/or services for which it has been registered. The application for renewal must be filed in the 12 months before the trademark registration expires.

Removal from register

A registered trademark may be removed from the register if:

- the Appeals Division of the bureau declares the registration invalid;
- a court declares the registration invalid or revoked;
- the registration is not renewed; or
- the owner of the trademark requests its removal.

Invalidation: At the request of an interested party, the registration of a trademark may be invalidated by the court where absolute grounds for refusal of registration or invalidation, or relative grounds for invalidation, exist. However, if the owner of an earlier registered trademark has knowingly tolerated, for a period of five years, the use of a later trademark that was the subject of a good-faith application, invalidation or revocation of the later trademark will be

refused (unless the coexistence of the two trademarks is likely to mislead the public or contravene public order).

Revocation: Any interested party may request the court to revoke a trademark registration if, since registration, the mark has become common as a result of:

- the owner's treatment of the mark as a common name;
- the owner's inactivity; or
- such treatment of the trademark by others.

In addition, a trademark can be revoked if, as a result of its use by its owner, it is likely to mislead the public as to the nature, quality or geographical origin of the goods and/or services for which it is registered.

The registration may further be revoked if the owner has not used or expressed a serious intention to use the trademark within five years of receipt of the registration certificate or if the mark has not been used continuously for five years. The trademark is deemed to be in use if it is used by the owner itself or by any person with the consent of the owner.

In case of revocation or invalidation of a trademark, its registration certificate is also declared invalid.

5. Enforcement

The law sets out a list of rights that can be enforced by the owner, its representative or the holder of an exclusive licence to use the trademark before the courts. For example, such rights may relate to:

- the recognition of rights;
- an injunction to terminate all actions that infringe or may infringe the rights to the trademark;

- the reimbursement of losses or damage (including moral damage) caused to the proprietor of the trademark; and
- the re-establishment of the situation that existed before the infringement.

If there is foreseeable damage, and upon a relevant request by the owner or its representative or exclusive licence holder, the court may order the infringer to provide compensation for potential damages.

In addition, the court has the right to request information or evidence relating to the possible infringement of the owner's rights from all parties participating in the case.

6. Ownership changes – legalization requirements

The owner of a registered trademark can transfer its rights completely or partially to another party by agreement.

A transfer of rights should be recorded in the register at the request of one of the parties to the agreement. The register will be amended upon submission of:

- a request to record the transfer;
- a document certifying the transfer; and
- a document certifying payment of the relevant fee and the power of attorney (if necessary).

However, if information relating to the transfer is not entered in the register, the transfer is invalid.

Licences for the marking of goods and/or services with a registered trademark can also be issued. Licence agreements can be exclusive or non-exclusive, and the scope of the agreement can vary from all to only some of the goods and/or services for which the mark is registered.

Since a licensing agreement will affect third parties only after its entry in the register, the contract parties must submit certain information on the licensing agreement to the bureau. Along with the request to record the licensing information, the following documents must be submitted:

- a document certifying the conclusion of the licensing agreement signed by both parties or a notarized extract from the licensing agreement;
- a document certifying payment of the fixed fee; and
- the power of attorney issued to a representative (where appropriate).

7. Areas of overlap with related rights

In some areas trademarks for goods and/or services in Lithuania overlap with other rights. For example, a trademark can be protected from registration as a design. Article 10 of the Law on Designs provides that this constitutes grounds for the refusal of design registration. In such cases the trademark owner is entitled to seek invalidation of the design registration.

In addition, the names of periodical publications and domain names can be registered as trademarks.

8. Online issues

The use and protection of trademarks on the Internet are not yet regulated by law in Lithuania. However, a domain name can be registered as a trademark. Since in Lithuania a domain name is treated as indicating a location on the Internet, but is not automatically a trademark, the trademark registration of a domain name that is identical to an earlier trademark can cause invalidation and revocation of the domain name registration.