

# TRADEMARKS ACT

**NN 14/2019, in force from February 15, 2019**

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Zagreb, March 2019



# TRADEMARKS ACT

## **PART ONE BASIC PROVISIONS**

### Subject-matter

#### Article 1

This Act shall govern the system of trademarks protection in the Republic of Croatia which are the subject of a registration or an application for the registration of an individual, guarantee or collective trademark for specific goods and services filed with the State Intellectual Property Office (hereinafter: "the Office"), or the subject of a registration or an application for the registration of such trademark having effect in the Republic of Croatia.

### Harmonisation with legislation of the European Union

#### Article 2

(1) The following Directives shall be transposed by this Act into the national laws of the Republic of Croatia:

- Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ L 157, 30.4.2004);

- Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (OJ L 336, 23.12.2015).

(2) This Act shall provide for prerequisites for the enforcement of the following act of the European Union:

- Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark (codification) (OJ L 154, 16.6.2017).

### Subsidiary application of other regulations

#### Article 3

(1) In civil protection procedures, provisions of the general regulation governing the civil procedure shall apply accordingly, unless provided otherwise by this Act.

(2) In procedures of setting provisional measures, provisions of the general regulation governing the enforcement procedure shall apply accordingly, unless provided otherwise by this Act.

(3) Provisions of general regulations governing ownership relations shall apply accordingly to the rights from trademark with obligatory legal effects and to the damages incurred by trademark infringement, unless provided otherwise by this Act.

(4) Provisions of general regulations governing ownership relations shall apply accordingly to the rights from trademark with legal ownership effects, unless provided otherwise by this Act.

## Definitions

### Article 4

In terms of this Act, the following definitions apply:

- "register" means an official collection of the data on trademark registrations kept by the Office containing the data to be entered as required or permitted by this Act, regardless of the storage media;

- "official gazette of the Office" means the gazette periodically publishing the data on applications and registered rights as laid down in the procedures under responsibility of the Office, as well as other official information;

- "Paris Convention" means the Paris Convention for the Protection of Industrial Property (1883) and its revisions and amendments;

- "Paris Union" means the union of contracting parties to which the Paris Convention (1883) and its revisions and amendments apply;

- "Convention on International Exhibitions" means the Convention on International Exhibitions (1928 and its revisions);

- "Madrid Agreement" means the Madrid Agreement on International Trademark Registration (1891) and its amendments;

- "Madrid Protocol" means the Protocol Relating to the Madrid Agreement on International Trademark Registration (1989) and its amendments;

- "Madrid Regulations" means the Common Regulations with the Madrid Agreement on International Trademark Registration and the Protocol Relating to the Madrid Agreement and its amendments;

- "International Bureau" means the International Bureau of the World Intellectual Property Organization;

- "Nice Classification" means the classification laid down by the Nice Agreement on International Classification of Goods and Services for Trademark Registration, signed in Nice on 15 June 1957, its revised and amended version;

- "international register" means the official collection of the data on international registration, kept by the International Bureau, containing the data to be entered as required or permitted by the Madrid Agreement, the Madrid Protocol and the Madrid Regulations, regardless of the storage media;

- "official gazette of the International Bureau" means the official gazette of the International Bureau of the World Intellectual Property Organization publishing relevant data and notices on international trademark registrations;

- "Regulation on the European Union Trademark" means the EU Regulation No. 2017/1001 of 14 June 2017 on the European Union trademark and its amendments;

- "European Union trademark" means the trademark as defined in Article 1 paragraph 1 of the Regulation on

the European Union Trademark;

- "application of the European Union trademark" means the application for registration of the European Union trademark filed in accordance with the provisions of the Regulation on the European Union Trademark;

- "court" means the commercial court with territorial jurisdiction competent for the protection of industrial property, copyright and related rights and other intellectual property rights, as well as the court deciding on appeals against judgements by commercial courts in accordance with the regulations on the organisation, scope and jurisdiction of the courts.

#### Gender meaning of terms

##### Article 5

The terms used in this Act and regulations to be passed on its basis, having gender meaning, relate equally to males and females.

## **PART TWO** **SIGNS OF WHICH A TRADEMARK MAY CONSIST,** **ACQUISITION, USE OF A TRADEMARK,** **TRADEMARK AS AN OBJECT OF PROPERTY**

### **CHAPTER I** **SIGNS OF WHICH A TRADEMARK MAY CONSIST** **AND** **ACQUISITION OF A TRADEMARK**

#### Signs of which a trademark may consist

##### Article 6

A trademark may consist of any signs, particularly words, including personal names, or designs, letters, numerals, colours, the shape of goods or of their packaging, or sounds, provided that such signs are capable of:

1. distinguishing the goods or services of one undertaking from goods or services of another undertaking  
and
2. being represented in the register in the way that enables competent authorities and the public to determine a precise and clear subject-matter of protection provided by the trademark to a holder of the trademark.

Persons who may be holders of a trademark

##### Article 7

(1) Any natural or legal person may be a holder of a trademark.

(2) Foreign natural and legal persons in the Republic of Croatia shall enjoy the same rights as are enjoyed by resident natural and legal persons, if it results from the international treaties or from the principle of reciprocity.

(3) The person claiming reciprocity is to present evidence for the existence of reciprocity.

#### Acquisition of a trademark

##### Article 8

In the Republic of Croatia, a trademark shall be acquired by registration.

#### Absolute grounds for refusal

##### Article 9

(1) The following shall not be registered:

1. signs which do not conform to the requirements of Article 6 of this Act;

2. trademarks which are devoid of any distinctive character;

3. trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or to designate other characteristics of the goods or services;

4. trademarks which consist exclusively of signs or indications which have become customary in the everyday language or in good faith and the established practices of the trade:

5. signs which consist exclusively of:

(a) the shape, or another characteristic, which results from the nature of the goods themselves;

(b) the shape, or another characteristic, of goods which is necessary to obtain a technical result;

(c) the shape, or another characteristic, which gives substantial value to the goods;

6. trademarks which are contrary to public policy or to accepted principles of morality;

7. trademarks which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services;

8. trademarks which have not been authorised by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention;

9. trademarks which are not covered by Article 6ter of the Paris Convention, and which include the name or abbreviation of the name, national coat of arms, emblem, flag or other official sign of the Republic of Croatia, or a part thereof, and the imitation thereof, except with the consent of the competent authority of the Republic of Croatia;

10. trademarks which are excluded from registration, pursuant to Union legislation or national law of the Republic of Croatia or to international agreements to which the Union or the Republic of Croatia is a party, providing for protection of designations of origin and geographical indications;

11. trademarks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is a party, providing for protection of traditional terms for wine;

12. trademarks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is a party, providing for protection of traditional specialities guaranteed;

13. trademarks which consist of, or reproduce

in their essential elements, an earlier plant variety denomination registered in accordance with Union legislation or national law of the Republic of Croatia, or international agreements to which the Union or the Republic of Croatia is a party, providing for protection of plant variety rights, and which are in respect of plant varieties of the same or closely related species;

14. trademarks which can be banned from using in public interest in accordance with the provisions of other legal regulations having effect in the Republic of Croatia.

(2) Grounds from paragraph (1) points 2, 3 and 4 of this Article shall not apply if the trademark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it, before the date of filing of the application for the registration.

#### Relative grounds for refusal

##### Article 10

(1) Upon opposition by the proprietor of an earlier trademark, the trademark applied for shall not be registered:

1. if it is identical with the earlier trademark and the goods or services for which registration is applied for are identical with the goods or services for which the earlier trademark is protected;

2. if because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks there exists a likelihood of confusion on the part of the public in the Republic of Croatia; the likelihood of confusion includes the likelihood of association with the earlier trademark;

3. if it is identical with or similar to the earlier trademark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Republic of Croatia, and where the use without due cause of the later trademark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark.

(2) For the purposes of paragraph 1 of this Article, "earlier trademarks" mean:

1. trademarks of the following kinds with a date of application for registration which is earlier than the date of application for registration of the contested trademark, taking account, where appropriate, of the priorities claimed in respect of those trademarks:

(a) nationally registered trademarks,

(b) trademarks registered under international arrangements which have effect in the Republic of Croatia,

(c) EU trademarks,

(d) EU trademarks registered under international arrangements which have effect in the European Union.

2. applications for the registration of trademarks referred to in point 1 subpoints (a) and (c) of this paragraph, subject to their registration,

3. trademarks which, on the date of application for

registration of the trademark, or, if priority is claimed, on the date of priority right claimed in the application, are well known in the Republic of Croatia, in the sense in which the words "well known" are used in Article 6bis of the Paris Convention.

(3) Upon opposition by the proprietor of an earlier right, a trademark shall not be registered if its use would infringe one of the following earlier rights:

1. a right to a name,

2. a right of personal portrayal,

3. a copyright,

4. industrial property rights other than those provided by this Act as a separate ground for refusal of trademark registration, provided that such rights are acquired on a date which is earlier than the date of application for registration of the trademark, taking account, where appropriate, of the priorities claimed in respect of that trademark.

(4) Upon opposition by the owner of a company entered in a court register before the date of application for registration of the trademark in respect of the opposition, taking account, where appropriate, of the priorities claimed in respect of that trademark, the trademark shall not be registered if the company or an essential part thereof is identical with, or similar to, the trademark and the goods or services which are the subject matter of business of that company are identical or similar to those for which the trademark is applied for and are being used in trade, unless the applicant had the identical or similar company at the time of filing the application for registration of a trademark.

(5) Upon opposition by the proprietor of the trademark, the trademark shall not be registered in the name of a trade agent or a representative of a trademark holder without his authorisation, unless a trade agent or a representative justifies his action.

(6) Upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trademark applied for shall not be registered where and to the extent that, pursuant to the Union legislation or national law of the Republic of Croatia providing for the protection of designations of origin or geographical indications:

1. an application for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law of the Republic of Croatia, prior to the date of application for registration of the trademark or the date of the priority claimed for the application, subject to its subsequent registration; and

2. that designation of origin or geographical indication confers the right to the person authorised under the relevant law to exercise the rights arising from it to prohibit the use of a subsequent trademark.

## **CHAPTER II**

### **EFFECTS OF A TRADEMARK**

#### Rights conferred by a trademark

##### Article 11

(1) The registration of a trademark shall confer on the proprietor exclusive rights therein.

(2) Without prejudice to the rights of the proprietor of the registered trademark acquired before the filing date or the priority date of the registered trademark, the proprietor of that trademark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign infringing the trademark right where:

1. the sign is identical with the trademark and is used in relation to goods or services which are identical with those for which the trademark is registered,

2. the sign is identical with, or similar to, the trademark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trademark is registered, if there exists a likelihood of confusion on the part of the public in the Republic of Croatia; the likelihood of confusion includes the likelihood of association between the sign and the trademark,

3. the sign is identical with, or similar to, the trademark irrespective of whether it is used in relation to goods or services which are identical with, similar to or not similar to those for which the trademark is registered, where the trademark has a reputation in the Republic of Croatia and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of such trademark.

(3) Within the meaning of paragraph (2) of this Article, the holder of the registered trademark may also prohibit the following:

1. affixing the sign to the goods or to the packaging thereof,

2. offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or providing services thereunder,

3. importing or exporting the goods under the sign,

4. using the sign as a trade or company name or part of a trade or company name;

5. using the sign on business papers and in advertising;

6. using the sign in comparative advertising in a manner that is contrary to the regulations of the European Union or the regulations of the Republic of Croatia concerning misleading and comparative advertising.

(4) Without prejudice to the rights of proprietors acquired before the filing date or the priority date of the registered trademark, the proprietor of that trademark shall also be entitled to prevent all third parties from bringing goods, in the course of trade, into the Republic of Croatia without being released for free circulation there, where such goods, including packaging, come from third countries and bear without authorisation a trademark which is identical with the

trademark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trademark. The entitlement of the proprietor of a trademark shall lapse if, during the proceedings to determine whether the registered trademark has been infringed, initiated in accordance with the regulations of the European Union concerning customs enforcement of intellectual property rights, evidence is provided by the declarant or the holder of the goods that the proprietor of the registered trademark is not entitled to prohibit the placing of the goods on the market in the country of final destination.

#### Right to prohibit preparatory acts in relation to the use of packaging or other means

##### Article 12

Where the risk exists that the packaging, labels, tags, security or authenticity features or devices or any other means to which the mark is affixed could be used in relation to goods or services and such use would constitute an infringement of the rights of the proprietor of an EU trademark under Article 11 paragraphs (2) and (3) of this Act, the proprietor of that trademark shall have the right to prohibit the following acts if carried out in the course of trade:

1. affixing a sign identical with, or similar to, the trademark on packaging, labels, tags, security or authenticity features or devices or any other means to which the trademark may be affixed;

2. offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices or any other means to which the trademark is affixed.

#### Date from which rights against third parties prevail

##### Article 13

1. The rights conferred by a trademark shall prevail against third parties from the date of publication of the registration of the trademark.

2. Reasonable compensation may be claimed in respect of acts occurring after the date of publication of a trademark application, where those acts would, after publication of the registration of the trademark, be prohibited by virtue of that publication.

3. A court seized of a case shall not decide upon the merits of that case until the registration has been published.

#### Reproduction of a trademark in dictionaries

##### Article 14

If the reproduction of a trademark in a dictionary, encyclopaedia or similar publications, in printed or electronic form, gives the impression that the trademark constitutes the generic name of the goods or services for which it is registered, the publisher of the work shall, at the request of the holder of the trademark, ensure that the reproduction of the trademark, at the latest in the next edition of the publication, is accompanied by

an indication that it is a registered trademark.

Prohibition of the use of a trademark registered in the name of an agent or a representative

#### Article 15

(1) Where a trademark is registered in the name of the trade agent or a representative of a person who is the proprietor of that trademark, without the proprietor's authorisation, the proprietor shall be entitled to one or both of the following:

1. oppose the use of his mark by his agent or representative;
2. request that the trademark is transferred on his behalf.

(2) The provision as referred to in paragraph (1) of this Article shall not apply if the agent or representative justifies his action.

Limitation of the effects of a trademark

#### Article 16

(1) A trademark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

1. the name or address of the third party, where that third party is a natural person;
2. signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or services;

3. the trademark for the purpose of identifying or referring to goods or services as those of the proprietor of that trademark, in particular, where the use of that trademark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.

(2) Paragraph (1) of this Article shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

(3) A trademark shall not entitle the holder of the trademark to request that a third party is prohibited from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognised by the laws of the Republic of Croatia and it is exercised within the limits of the territory in which it is recognised.

Exhaustion of the rights conferred by a trademark

#### Article 17

(1) A trademark shall not entitle the proprietor to prohibit a third party from using it in relation to goods which have been put on the market in the territory of an European Union Member State or of parties to the European Economic Area under that trademark by the proprietor himself or with his consent.

(2) Paragraph (1) of this Article shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods,

especially where the condition of the goods is changed or impaired after they have been put on the market.

Intervening right of the proprietor of a later registered trademark as a defence in infringement proceedings

#### Article 18

(1) In infringement proceedings, the proprietor of a trademark shall not be entitled to prohibit the use of a later registered trademark where that later trademark would not be declared invalid pursuant to Article 66 paragraph (3), Article 67 or Article 68 paragraphs (1) and (2) of this Act.

(2) In infringement proceedings, the proprietor of the trademark shall not be entitled to prohibit the use of a later registered EU trademark where that later registered trademark would not be declared invalid pursuant to Article 60 paragraph (1), (3) or (4), Article 61 paragraph (1) or (2) or Article 64 paragraph (2) of the EU Trademark Regulation.

(3) Where the proprietor of the trademark is not entitled to prohibit the use of a later registered trademark pursuant to paragraph (1) and (2) of this Article, the proprietor of that later registered trademark shall not be entitled to prohibit the use of that earlier trademark in infringement proceedings, even though that right may no longer be invoked against the later trademark.

### **CHAPTER III USE OF A TRADEMARK AND CONSEQUENCES OF NON-USE**

Use of a trademark

#### Article 19

(1) A proprietor of a trademark shall be entitled to use a trademark in relation to the goods or services for which it is registered. If invoking or maintaining the rights from the registered trademark depend on the use of the trademark, such trademark shall have been put to genuine use by the holder of the trademark in the territory of the Republic of Croatia, unless there are proper reasons for non-use.

(2) The following shall also constitute use within the meaning of paragraph (1) of this Article:

1. use of the trademark in a form differing in elements which do not alter the distinctive character of the trademark in respect of the form in which it was registered, regardless of whether or not the trademark in the form as used is also registered in the name of the proprietor;

2. affixing of the trademark to goods or to the packaging thereof solely for export purposes.

(3) Use of the trademark with the consent of the proprietor shall be deemed to constitute use by the proprietor.

## Consequences of non-use of a trademark

### Article 20

If, within a continuous period of five years following the date of registration, the proprietor has not put his trademark to genuine use in the Republic of Croatia in relation to the goods or services for which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trademark shall be subject to limitations and sanctions as referred to in Article 21, Article 47 paragraph (1), (3) and (6), Article 61 paragraph (2) and Article 66 paragraph (1), (3) and (6) of this Act, unless there are justified reasons for non-use.

### Non-use as a method of defence in infringement proceedings

### Article 21

The proprietor of a trademark shall have the right to request the use of a sign to be prohibited only to the extent in which the proprietor's rights at the time of bringing the action on grounds of infringements are not subject to the possibility of revocation in accordance with Article 61 of this Act. If a defendant requests it, the proprietor of a trademark shall provide evidence that during an uninterrupted period of five years before the date of bringing the action such trademark has been put to genuine use as provided by Article 19 of this Act in relation to the goods or services for which it is registered and which are given as justification for the action, or there are justified reasons for non-use, provided that the procedure of trademark registration was completed at least five years before the date of bringing the action.

## **CHAPTER IV TRADEMARKS AS OBJECTS OF PROPERTY**

### Transfer

### Article 22

(1) A trademark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered.

(2) A transfer of the whole of the undertaking shall include the transfer of the trademark except where, in accordance with the law governing the transfer, there is agreement to the contrary or circumstances clearly dictate otherwise. This provision shall apply to the contractual obligation to transfer the undertaking.

(3) Without prejudice to paragraph (2) of this Article, an assignment of the trademark shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgment; otherwise it shall be void.

(4) In case of transferring the trademark in relation to only part of the goods or services for which it is registered, the registration shall be separated in accordance with the provisions as referred to in Article 59 of this Act.

## Entering of transfer in the Register

### Article 23

(1) On request of the holder or the acquirer of a trademark or, depending on a case, upon notification by a competent court or a notary public, the transfer of a trademark shall be entered in the Register, if the Office receives any of the following evidence:

1. a certified copy of the agreement on the transfer of a trademark or a court decision on the transfer or inheritance of a trademark, or a decision by a notary public on the inheritance of a trademark;

2. a certified excerpt of the agreement or a decision as referred to in point 1 of this paragraph;

3. an original certificate of the transfer of a trademark signed by the holder and the acquirer of rights;

4. an original court decision on the transfer or inheritance of a trademark, or a decision by a notary public on the inheritance of a trademark.

(2) The entry of the transfer as referred to in paragraph (1) of this Article shall be cancelled or modified on request of the holder or the acquirer of rights or, depending on a case, upon notification by a competent court or a public notary.

### Transfer of a trademark registered in the name of an agent

### Article 24

(1) Where a trademark is registered in the name of the agent or representative of a person who is the proprietor of that trademark, without the proprietor's authorisation, the latter shall be entitled to demand the assignment of the trademark in his favour, unless such agent or representative justifies his action.

(2) The Office shall enter in the Register the transfer of the trademark based on a final decision by the Office that justified the proposal to declare the trademark invalid in accordance with Article 65 paragraph (1) point 4 of this Act

### Entering of rights in rem in the Register

### Article 25

(1) A trademark may, independently of the undertaking, be given as security or be the subject of rights in rem.

(2) At the request of one of the parties, the rights referred to in paragraph (1) of this Article or the transfer of those rights shall be entered in the Register.

(3) An entry in the Register effected pursuant to paragraph (2) of this Article shall be cancelled or modified at the request of one of the parties.

### Entering levy of execution in the Register

### Article 26

(1) A trademark may be levied in execution by competent authorities pursuant to legal regulations of the Republic of Croatia.

(2) On request of one of the parties or a competent



authority that carries out the procedure for levy of execution, the initiation of the procedure for levy of execution shall be entered in the Register based on evidence of initiated procedure for levy of execution.

(3) An entry in the Register effected pursuant to paragraph (2) of this Article shall be cancelled or modified at the request of one of the parties or a competent authority that carries out the procedure for levy of execution.

#### Entering insolvency and pre-insolvency in the Register

##### Article 27

(1) The information about initiating proceedings of insolvency or pre-insolvency shall be registered pursuant to special regulations, based on the notification by a competent authority or at the request of an insolvency administrator.

(2) Entry into the register as referred to in paragraph (1) of this Article shall be cancelled or modified on request of a competent authority that carries out the procedure of insolvency or pre-insolvency.

#### Licensing

##### Article 28

(1) A trademark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the territory of the Republic of Croatia.

(2) A licence may be exclusive or non-exclusive.

(3) The proprietor of a trademark may invoke the rights conferred by that trademark against a licensee who contravenes any provision in his licensing contract with regard to:

1. its duration;
2. the form covered by the registration in which the trademark may be used;
3. the scope of the goods or services for which the licence is granted;
4. the territory in which the trademark may be affixed;
5. the quality of the goods manufactured or of the services provided by the licensee.

#### Entering licences in the Register

##### Article 29

(1) On request of one of the parties the grant or transfer of a licence in respect of a trademark shall be entered in the Register if the Office receives any of the following pieces of evidence:

1. a certified excerpt of a licensing agreement or, as the case may be, of transfer of a registered licence indicating the parties to it and the rights to be licensed, or the rights conferred from the registered licence to be transferred;
2. an original certificate of granting or transferring the licence signed by a grantee and a licensee.

(2) An entry in the Register effected pursuant to paragraph (1) of this Article shall be cancelled or modified at the request of one of the parties.

#### Procedure for entering, cancelling or modifying the rights in the Register

##### Article 30

(1) Where an application for registration or, as the case may be, cancellation or modification in the Register meets the requirements provided by Articles 22 to 29 of this Act and contains information and attachments provided by the Trademark Regulations passed by the Director General of the Office (hereinafter referred to as: the Regulations), the Office shall enter such change in the Register.

(2) An entry of a change as referred to in paragraph (1) of this Article shall be published in the official gazette of the Office, and shall have effect vis-à-vis third parties after entry in the Register.

(3) Where an application for registration, cancellation or modification in the Register does not meet the requirements provided by Articles 22 to 29 of this Act or does not contain information and attachments provided by the Regulations in respect with entering such modifications, the Office shall order the person who filed the request by a conclusion to remedy the deficiencies of the request or to file the relevant evidence within 30 days counting from the day of receipt of the conclusion.

(4) On request, the time limit laid down in paragraph (3) of this Article may be extended for not more than 30 days.

(5) Where the conclusion referred to in paragraph (3) of this Article is not complied with within the prescribed time limit, the Office shall reject the request by a decision.

(6) The application for registration, cancellation or modification in the Register pursuant to Articles 22 to 29 of this Act shall contain information and attachments as provided by the Regulations.

#### The application for a trademark as an object of property

##### Article 31

Articles 22 and 23 and Article 25 to 30 of this Act shall apply to applications for registration of a trademark.

### **PART THREE APPLICATION FOR REGISTRATION OF A TRADEMARK**

#### **CHAPTER I FILING AND CONDITIONS OF FILING AN APPLICATION**

##### Filing of an application

##### Article 32

(1) An application for registration of a trademark

shall be filed with the Office.

(2) An applicant cannot, by one application, request registration of more than one sign for which trademark protection is sought.

Conditions which an application must comply with

#### Article 33

(1) An application for the registration of a trademark shall contain:

1. a request for the registration of a trademark,
2. information identifying the applicant,
3. a list of the goods or services for which the registration is requested,
4. a representation of the mark, which satisfies the requirements set out in Article 6 point 2 of this Act.

(2) An application for the registration of a trademark shall be considered to have been filed if it complies with the requirements set out in paragraph (1) of this Article.

(3) Information and attachments to the application for registration of a trademark shall be provided by the Regulations.

Date of filing of an application

#### Article 34

The date of filing of a trademark application shall be the date on which the documents containing the information specified in Article 33 paragraph (1) of this Act are filed with the Office by the applicant.

Designation and classification of goods and services

#### Article 35

(1) Goods and services in relation to which an application for registration of a trademark is filed shall be classified in conformity with the system of the Nice Classification.

(2) The goods and services for which the protection of the trademark is sought shall be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought.

(3) For the purposes of paragraph (2) of this Article, the general indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision set out in this Article.

(4) The use of general terms, including the general indications of the class headings of the Nice Classification, shall be interpreted as including all the goods or services clearly covered by the literal meaning of the indication or term.

(5) Goods and services that are not clearly covered by the literal meaning of general terms or indications of the class headings of the Nice Classification shall not be regarded as included in the application for trademark registration or, as the case may be, in the registered trademark.

(6) Where the applicant requests registration for

more than one class, the applicant shall group the goods and services according to the classes of the Nice Classification, each group being preceded by the number of the class to which that group of goods or services belongs, and shall present them in the order of the classes.

(7) Goods and services shall not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification. Goods and services shall not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

## **CHAPTER II CLAIMING PRIORITY**

Priority right

#### Article 36

(1) The right of priority shall have the effect that the date of priority shall count as the date of filing of the trademark application as referred to in Article 34 of this Act for the purposes of establishing which rights take precedence.

(2) Every filing that is equivalent to a regular national filing or under multilateral agreements shall be recognised as giving rise to a right of priority.

International priority right

#### Article 37

(1) An applicant for national registration of a trademark who has duly filed an application for a trademark for the first time in or in respect of any State party to the Paris Convention or to the Agreement establishing the World Trade Organisation, or his successors in title, may invoke, for the purpose of filing a national trademark application for the same trademark in respect of goods or services which are identical with or contained within those for which the application has been filed, a right of priority, provided that the application in the Republic of Croatia is filed within six months from the date of filing of the first application.

(2) Where an international priority right is claimed, the application shall include the date, number and country of the previous application and goods or service in respect of which priority right is claimed.

(3) The applicant invoking the priority right shall attach to such request a true copy of the first application and its translation into Croatian not later than within three months from the date of filing a priority claim.

Exhibition priority right

#### Article 38

(1) The applicant for national registration of a trademark who has displayed the goods or services designated by a specific sign at an official or officially recognised international exhibition falling within the terms of the Convention relating to international exhibitions filed for national registration of a trademark

in the Republic of Croatia, may claim a right of priority within a period of six months of the date of the first display of the goods or services under the mark applied for within the meaning of Article 36 of this Act.

(2) Where exhibition priority right is claimed, the application shall include the name and the venue of an international exhibition, its opening and closing dates and the date of the first display of the goods or services specified in the application, if different from the opening date of such exhibition.

(3) The applicant invoking the exhibition priority right shall attach to such request a certificate issued by a competent authority at the exhibition certifying that the trademark is used for the goods or services included in the application and its translation into Croatian not later than within three months from the date of filing the application as evidence of the display of goods or services under the mark applied for.

## **PART FOUR TRADEMARK REGISTRATION PROCEDURE**

### **CHAPTER I EXAMINATION AND PUBLICATION OF APPLICATIONS**

#### Examination of the conditions of filing

##### Article 39

The Office shall examine whether the national trademark application satisfies the conditions laid down by this Act in relation to:

1. establishing a date of filing in accordance with Article 34 of this Act;
2. the information and attachments to be included in the attachment in accordance with Article 33 paragraph 3 of this Act.

#### Remedying the deficiencies of the application

##### Article 40

(1) Where the application does not satisfy the conditions set out in Article 35 or Article 39 of this Act, the Office shall order the applicant by conclusion to remedy the deficiencies within 30 days upon receipt of the conclusion.

(2) If the applicant complies with the conclusion referred to in paragraph (1) of this Article to remedy the deficiencies in relation to satisfying the conditions referred to in Article 39 point 1 of this Act, the date on which the deficiencies established are remedied shall be considered to be the date of filing of the application.

(3) If the applicant complies with the conclusion referred to in paragraph (1) of this Article to remedy the deficiencies in relation to satisfying the conditions referred to in Article 35 or Article 39 point 2 of this Act, the application shall be considered to be correct from the date of its filing.

(4) On request of the applicant, the time limit laid down in paragraph (1) of this Article may be extended for not more than 30 days.

(5) Failure to satisfy the requirements concerning the claim to priority referred to in Article 37 or Article 38 of this Act shall result in loss of the right of priority for the application.

#### Rejection of the application

##### Article 41

If the applicant for national registration of a trademark does not comply with the conclusion referred to in Article 40 of this Act and does not remedy the application deficiencies established within the prescribed time limit, the application shall be refused by a decision.

#### Examination as to absolute grounds for refusal

##### Article 42

(1) If it is established that any of the absolute grounds for the refusal of a trademark registration according to Article 9, paragraph (1) of this Act exists, the Office shall notify the applicant for the registration of a trademark in writing of the grounds for refusal and shall invite him to file observations within 60 days upon receipt of such notification and to submit evidence on the possible new facts that might influence the final decision.

(2) On request of the applicant, the time limit referred to in paragraph (1) of this Article may be extended for not more than 60 days.

(3) If the applicant for the registration of a trademark fails to file within the prescribed time limit his observations on the notification of the grounds for refusal of the registration in respect of all the goods or services for which the registration has been applied for, or fails to challenge the grounds for such refusal, a decision on the total refusal of the registration shall be issued.

(4) If the applicant for the registration of a trademark fails to file within the prescribed time limit his observations on the notification of the refusal of the registration of a trademark as regards a part of the goods or services, or if in the course of the procedure concerning the observations on the notification of the grounds for refusal of the registration in respect of all the goods or services for which registration has been applied for, it has been found that a sign does not comply with the requirements for registration in respect of only a part of the goods or services for which the registration has been applied for, a partial decision on the refusal of the registration shall be issued.

#### Publication of the application

##### Article 43

(1) If the requirements for the application to comply with are fulfilled and if there are no absolute grounds for refusal of the registration under Article 9 of this Act, the application data shall be published in the official gazette of the Office.

(2) Where the registration of a trademark is partially refused in accordance with Article 42 paragraph (4) of

this Act, the application data relating to a part of the goods or services for which the registration applied for may be granted shall be published after this partial decision becomes final.

(3) The application data to be published in the official gazette of the Office shall be prescribed by the Regulations.

## **CHAPTER II OBSERVATIONS BY THIRD PARTIES AND OPPOSITION**

### Observations by third parties

#### Article 44

(1) Any natural or legal person and any group or body representing manufacturers, providers of services, traders or consumers, may submit to the Office written observations, explaining on which grounds referred to in Article 9 of this Act the trademark should not be registered ex officio in relation to a part or all of the goods or services under such trademark.

(2) Persons, groups or bodies as referred to in paragraph (1) of this Article shall not be considered parties to the proceedings.

(3) Observations referred to in paragraph (1) of this Article shall be submitted within three months from the date of publication of an application for the registration of a trademark.

(4) The Office shall communicate the observations referred to in paragraph (1) of this Article to the applicant for registration of a trademark, who may comment on them within 15 days upon receipt of a copy of the observations.

(5) The submission of observations referred to in paragraph (1) of this Article shall be without prejudice to the right of the Office to re-open the examination of absolute grounds for refusal referred to in Article 9 of this Act ex officio, where appropriate, at any time before registration.

### Filing an opposition

#### Article 45

(1) Within a period of three months from the date of publication of an application for the registration of a trademark, an opposition to registration of the trademark in relation to a part or all of the goods or services included in the application may be given on the grounds for refusal referred to in Article 10 of this Act:

1. by the proprietors of earlier trademarks referred to in Article 10 paragraph (2) of this Act as well as licensees authorised by the proprietors of those trademarks in respect of the grounds for opposition referred to in Article 10 paragraph (1) of this Act,

2. by the proprietors of any of the rights referred to in Article 10 paragraph (3) of this Act,

3. by the persons who have a company within the meaning of Article 10 paragraph (4) of this Act,

4. by the proprietors of earlier trademarks within the meaning of Article 10, paragraph (5) of this Act,

5. by the persons authorised under the relevant European Union legislation or the law of the Republic of Croatia providing for the protection of designations of origin or geographical indications to exercise the rights referred to in Article 10, paragraph (6) of this Act.

(2) The opponent shall prove that before the date of filing an application or, if priority right is claimed, until the date of priority right claimed in the application for registration a trademark in relation to which an opposition is filed:

- if the opposition is based on Article 10 paragraph 1 of this Act on the basis of an earlier trademark which is well known, such earlier trademark is well known in the Republic of Croatia in the sense in which the words 'well known' are used in Article 6bis of the Paris Convention;

- if the opposition is based on Article 10 paragraph 1 point 3 of this Act, an earlier trademark acquired reputation in the Republic of Croatia;

- if the opposition is based on Article 10 paragraph 4 of this Act, an earlier company is entered in the court register and that identical or similar goods or services under scope of such company's activity are being used in trade.

(3) If, on the date of publication of an application, the earlier trademark, on which the opposition is based, is subject to a pending revocation procedure or a pending procedure for a declaration that the trademark is invalid, the Office shall decide upon suspension of the opposition procedure until the decision from the earlier initiated revocation procedure or the procedure for a declaration that the trademark is invalid has become final.

(4) The time limit for filing the opposition, laid down in paragraph (1) of this Article, shall not be extended, and additions to the opposition outside of the time limit which include submissions of additional evidence and facts supporting the justification of the grounds specified in the opposition shall be accepted by the Office if it assesses them to be crucial to decide upon justification of the opposition and if the party proves that there are justified reasons for their delayed delivery taking into consideration also the stage of procedure when they were delivered.

(5) The opposition may be filed on the basis of one or several earlier rights, provided that all belong to the same holder.

(6) Information and attachments to be included in the opposition as referred to in this Article shall be prescribed by the Regulations.

### Opposition procedure

#### Article 46

(1) The Office shall examine whether the opposition is filed in compliance with the requirements referred to in Article 45 paragraphs (1) and (2) of this Act and whether it contains the information and attachments as prescribed by the Regulations within the meaning of Article 45 paragraph (6) of this Act.

(2) If the requirements set out in Article 45 paragraphs (1) and (2) of this Act are not complied

with, the Office shall reject the opposition by a decision.

(3) If the opposition does not include the information and attachments as prescribed by the Regulations within the meaning of Article 45 paragraph (6) of this Act, the Office shall order the opponent by a conclusion to correct the opposition within a period of 30 days upon receipt of the conclusion.

(4) If the opponent fails to act by the conclusion of the Office and fails to correct the opposition within the meaning of paragraph (3) of this Article, and the opposition procedure cannot be followed, the opposition shall be rejected by a decision.

(5) If the requirements set out in paragraph (1) of this Article are complied with, the Office shall notify the applicant of the opposition as filed, and shall send him a copy of the opposition, inviting him to submit his observations on the opposition within 60 days from the day of receipt of the notification.

(6) The time limit referred to in paragraph (5) of this Article shall not be extended, and additions to the opposition outside of the time limit which include submissions of additional evidence and facts supporting the justification of the grounds specified in the opposition shall be accepted by the Office if it assesses them to be crucial to decide upon justification of the opposition and if the party proves that there are justified reasons for their delayed delivery taking into consideration also the stage of procedure when they were delivered.

(7) If the applicant does not submit his observations on the opposition within the prescribed time limit referred to in paragraph (5) of this Article, the Office shall decide upon accepting the opposition and rejecting the application for registration of the trademark within the limits of the requests referred to in the opposition, in respect of all or a part of the goods or services included in the application for registration of the trademark.

(8) If the opposition is accepted by a decision referred to in paragraph (7) of this Article only in respect to a part of the goods or services included in the application, the trademark registration procedure shall be continued after such decision has become final in respect to the part of goods or services for which it is established that the requested registration can be granted or which were not subject to the opposition.

(9) If the Office considers it necessary, it may provide for oral hearings to be held in the opposition procedure.

#### Non-use as a method of defence in opposition procedures

##### Article 47

(1) If the applicant for the registration of a trademark that was subject to the opposition so explicitly requests, the holder of an earlier trademark who has filed the opposition to the registration shall furnish proof that, during the five-year period preceding the date of filing the application or the date of claiming the priority right of the trademark, the earlier trademark has been in genuine use as provided by Article 19 of this Act in respect of the goods or services for which it is registered

and which he cites as justification for his opposition, or that there are justified reasons for non-use, provided that, on such date, the earlier trademark has been registered for not less than five years.

(2) The Office shall invite the holder of an earlier trademark by a conclusion to submit his observations on the request referred to in paragraph (1) of this Article within a period of 60 days from the day of receipt of the conclusion.

(3) If the holder of an earlier trademark fails to submit his observations on the request to prove the use of the earlier trademark or if he fails to prove the use or to provide justified reasons for non-use of the earlier trademark, the opposition shall be rejected by a decision and the application procedure for trademark registration shall be continued after such decision has become final.

(4) If the holder of an earlier trademark submits his observations on the request to prove the use of the earlier trademark in the prescribed time limit, the Office shall forward a copy of such observations to the applicant for trademark registration and invite him to submit his observations within a period of 60 days from the day of receipt of the invitation.

(5) Upon expiry of the period referred to in paragraph (4) of this Article, the Office shall decide upon justification of the opposition on the basis of the facts and proof available from documents and observations delivered before.

(6) If the earlier trademark has been used in relation to a part only of the goods or services for which it is registered it shall, for the purposes of the examination of justification of the opposition, be deemed to be registered in respect only of that part of the goods or services.

#### Suspension of the opposition procedure for the purpose of attempting to make a friendly settlement

##### Article 48

(1) The applicant for the registration of a trademark and the opponent may, in a request signed by both of them and filed in the course of the examination procedure concerning the opposition, request the Office to order suspension of the procedure for the purpose of attempting to make a friendly settlement.

(2) If the request referred to in paragraph (1) of this Article is filed, the Office shall decide on suspension of the procedure and order the opposition procedure to be continued not later than within a period of 24 months from filing of the first request referred to in paragraph (1) of this Article, if the procedure has not been concluded up to the expiry of that period.

(3) If the applicant for the registration of a trademark and the opponent submit a notification to the Office within the period referred to in paragraph (2) of this Article, that disputed issues which were subject to the opposition procedure shall be settled and that the

opponent shall withdraw the opposition, the Office shall decide upon suspending the opposition procedure.

#### Deciding upon justification of the opposition

##### Article 49

(1) If it is established in the examination procedure concerning justification of the opposition that the opposition is unjustified, the Office shall decide upon rejecting the opposition and the application procedure for trademark registration shall be continued after such decision has become final.

(2) If it is established in the examination procedure concerning justification of the opposition that the opposition is justified in respect to all goods and services included in the application, the Office shall decide upon accepting the opposition and rejecting the application for trademark registration in full.

(3) If it is established in the examination procedure concerning justification of the opposition that the opposition is justified in respect to a part of goods and services included in the application, the Office shall decide upon accepting the opposition and partially rejecting the application for registration of the trademark for such goods and services; for the remaining part of goods or services included in the application, the trademark registration procedure shall be continued after such decision has become final.

### **CHAPTER III WITHDRAWAL OF THE APPLICATION AND LIMITATION OF THE LIST OF GOODS AND SERVICES**

#### **CORRECTIONS AND DIVISION OF THE APPLICATION**

Withdrawal of the application and limitation of the list of goods and services

##### Article 50

(1) The applicant for the registration of a trademark may at any time withdraw his application or limit the list of goods or services contained therein.

(2) If the application has been published, the withdrawal of the application or limitation of the list of goods or services shall be published in the official gazette of the Office.

(3) If the applicant for the registration of a trademark limits the list of goods or services which are subject to the opposition, the Office shall notify the opponent of the limitation of the list of goods or services, and shall invite him by a conclusion to state whether he insists on the opposition as filed, within a period of 15 days from the day of receipt of the conclusion.

(4) The Office shall suspend the opposition procedure by a decision and continue the application procedure for trademark registration after such decision has become final, if the opponent fails to submit observations upon invitation of the Office in the prescribed period referred to in paragraph (3) of this

Article that he insists on the opposition as filed or to notify the Office that he has withdrawn his opposition.

#### Corrections of the application

##### Article 51

(1) On request of the applicant for the registration of a trademark or ex officio, corrections of the application can be made only in cases where it is necessary to correct the name or address of the applicant, errors of wording or of copying, or to correct some other manifest oversights, provided that such corrections do not substantially alter the representation of a trademark or do not extend the list of goods or services.

(2) If the corrections do not affect the representation of a trademark or the list of goods and services and if they were made after a trademark has been published, the application for a trademark shall be published in the official gazette of the Office as altered.

#### Division of the application

##### Article 52

(1) The applicant may divide the application by submitting a declaration to the Office that some of the goods or services included in the original application will be the subject of one or more divisional applications. The goods or services in the divisional application shall not overlap with the goods or services which remain in the original application or those which are included in other divisional applications.

(2) The declaration of division shall not be admissible:

1. if, where an opposition has been entered against the original application, such a divisional application has the effect of introducing a division amongst the goods or services against which the opposition has been directed, until the decision of the opposition division has become final;

2. before the date of filing referred to in Article 34 of this Act has been accorded by the Office and during the opposition period provided for in Article 45 paragraph (1) of this Act.

(3) The division shall take effect on the date on which it is recorded in the files kept by the Office concerning the original application.

(4) The divisional application shall preserve the filing date and any priority date and seniority date of the original application.

(5) The data on divisional applications shall be entered in the register and published in the official gazette of the Office.

(6) Where the declaration of division relates to an application which has already been published pursuant to Article 43 of this Act, the divisional application shall be published.

(7) The publication of the application pursuant to paragraph (6) of this Article shall not open a new period for the filing of oppositions.

(8) Where the Office finds that the requirements laid down in this Article are not fulfilled, it shall invite

the applicant by a conclusion to remedy the deficiencies within a period of 30 days upon receipt of the conclusion.

(9) If the deficiencies referred to in paragraph (8) of this Article are not remedied in the prescribed time limit, the Office shall conclude about refusing the declaration of division.

(10) The information and attachments to be included in the declaration of division, its entry in the register and publication shall be prescribed by the Regulations.

#### **CHAPTER IV REGISTRATION OF THE TRADEMARK AND TRADEMARK CERTIFICATE**

##### **Registration of the trademark**

###### **Article 53**

(1) Where an application for registration of a trademark meets the requirements set out in this Act and where no notice of opposition has been given within the period referred to in Article 45 paragraph (1) of this Act or where any opposition entered has been finally disposed of by withdrawal, rejection or other disposition, the Office shall order the applicant by a conclusion to pay the prescribed charges for the maintenance of the valid trademark for the first ten-year period and for the publication of the trademark data within a period of 30 days from the day of receipt of the conclusion.

(2) If the charges referred to in paragraph (1) of this Article are not paid in the prescribed period, the Office shall decide upon suspending the application procedure for the registration of a trademark.

(3) If the charges referred to in paragraph (1) of this Article are paid on time, a trademark shall be entered in the Register of Trademarks and published in the official gazette of the Office and the Office shall issue the decision on trademark registration to the trademark holder.

(4) The data from the trademark registration to be published in the official gazette of the Office shall be prescribed by the Regulations.

##### **Trademark certificate**

###### **Article 54**

(1) On request of the holder of a trademark, and subject to the prior payment of the prescribed charges for the issuance of the trademark certificate, the Office shall issue the certificate to the holder of the trademark after the publication of a registered trademark in the official gazette of the Office.

(2) The data to be contained in the trademark certificate shall be prescribed by the Regulations.

#### **PART FIVE DURATION, RENEWAL, ALTERATION AND DIVISION OF TRADEMARK REGISTRATION**

##### **Duration of registration**

###### **Article 55**

(1) A trademark shall be registered for a period of ten years from the date of filing of the application.

(2) Registration may be renewed in accordance with Article 56 of this Act for further periods of ten years.

##### **Renewal of trademark registration**

###### **Article 56**

(1) Registration of the trademark shall be renewed at the request of the proprietor of the trademark or any person authorised for that on the basis of regulations or agreement, provided that the prescribed administrative fees and charges have been paid to the Office in the last year of a ten-year period of protection.

(2) The Office shall timely, at least six months before the expiry of the registration inform the proprietor of the trademark of the said expiry. Failure to give such information shall not involve the responsibility of the Office and shall not affect the expiry of the registration.

(3) The request for renewal shall be submitted within a further period of six months following the expiry of registration, provided that the double amount of the administrative fee and charges have been paid within this further period.

(4) If the payment is made in the prescribed time limit referred to in paragraph (1), or within a further period referred to in paragraph (3) of this Article, it shall be deemed to constitute a request for renewal provided that it contains all necessary indications to establish the purpose of the payment.

(5) Where the request is submitted or the charges paid in respect of only some of the goods or services for which the trademark is registered, registration shall be renewed for those goods or services only.

(6) Where the requirements referred to in this Article are fulfilled, the renewal of trademark registration shall be entered in the register and published in the official gazette of the Office; the Office shall decide upon renewing the trademark registration.

(7) Renewal of the trademark registration or, as the case may be, its termination unless renewed, shall take effect from the day following the date on which the existing registration expires.

(8) The data for the purpose of payment to be determined shall be prescribed by the Regulations.

##### **Alteration of trademark registration**

###### **Article 57**

(1) The registered trademark shall not be altered in the Register during the period of registration or on renewal thereof.

(2) Exceptionally, if the registered trademark includes the name and address of the proprietor,

any alteration thereof not substantially affecting the identity of the trademark as originally registered may be registered at the request of the proprietor.

(3) The request for alteration shall include the element of the mark to be altered and that element in its altered version.

(4) If the request for alteration of the registered trademark fulfils the requirements referred to in this Article, the Office shall enter the alteration in the Register and publish it in the official gazette of the Office with a representation of the trademark as altered and it shall take a decision on such alteration.

(5) Third parties whose rights may be affected by the alteration may challenge the registration thereof within the period of three months following publication.

(6) The provisions referred to in Articles 44 and 45 of this Act shall apply to the publication of the registration of the alteration.

#### Change of the name or address

##### Article 58

(1) At the request of the proprietor, a change of the name or address of the proprietor of the trademark which is not an alteration of the trademark pursuant to Article 57 paragraph (2) of this Act and which is not the consequence of a whole or partial transfer of the trademark shall be recorded in the Register.

(2) If the requirements governing the recording of a change are not fulfilled, the Office shall invite the proprietor by a conclusion to remedy such deficiencies within a period of 30 days upon receipt of the conclusion.

(3) If the deficiency is not remedied within the specified period, the Office shall reject the request for the change of name or address of the proprietor of the trademark by a decision.

(4) If the requirements referred to in this Article are fulfilled, the change shall be recorded in the Register and published in the official gazette of the Office.

(5) The provisions referred to in this Article shall also apply to a change of the name or address of the authorised representative.

(6) The provisions referred to in this Article shall also apply to applications for trademark registration.

(7) The data to be included in the request for the change of name or address shall be prescribed by the Regulations.

#### Division of the registration

##### Article 59

(1) The proprietor of the trademark may divide the registration by submitting a declaration to the Office that some of the goods or services included in the original registration will be the subject of one or more divisional registrations. The goods or services in the divisional registration shall not overlap with the goods or services which remain in the original registration or those which are included in other divisional registrations.

(2) Where an application for revocation of rights

or for a declaration of invalidity has been entered at the Office against the original registration, then the declaration of division shall not be admissible and it has the effect of introducing a request for the division amongst the goods or services against which the application for revocation of rights or for a declaration of invalidity is directed, until the decision has become final.

(3) The division of registration shall take effect on the date on which it is entered in the files kept by the Office in respect of the original registration.

(4) The divisional registration shall preserve the filing date and any priority date and seniority date of the original registration.

(5) The data on divisional registrations shall be recorded in the Register and published in the official gazette of the Office.

(6) If the Office establishes that the requirements laid down in this Article are not fulfilled, the Office shall order the applicant by a conclusion to remedy the deficiencies within a period of 60 days upon receipt of the conclusion.

(7) If the proprietor fails to remedy the deficiencies referred to in paragraph (6) of this Article within the prescribed period, the Office shall refuse the request for the division of registration by a conclusion.

(8) The data to be included in the declaration of the division of registration, its recording in the Register and publication shall be prescribed by the Regulations.

## **PART SIX SURRENDER, REVOCATION AND INVALIDITY OF A TRADEMARK**

### **CHAPTER I SURRENDER**

#### Surrender of a trademark

##### Article 60

(1) The holder of a trademark may surrender the trademark in respect of some or all of the goods or services for which it is registered by written declaration. The surrender shall have effect after it has been entered in the Register and it shall be published in the official gazette of the Office.

(2) The validity of the surrender of a trademark which is declared to the Office subsequent to the submission of an application for revocation of that trademark pursuant to Article 61 of this Act shall be conditional upon the final rejection or withdrawal of the application for revocation.

(3) Surrender shall be entered only with the agreement of the proprietor of a right relating to the trademark. If a licence has been registered, surrender shall be entered in the Register only if the proprietor of the trademark proves that he has informed the licensee of his intention to surrender.

(4) The entry of the surrender referred to in paragraph (3) of this Article shall be made and the Office shall issue a decision on the entry on expiry of the three-month period after the date on which the



proprietor satisfies the Office that he has informed the licensee of this intention to surrender, or before the expiry of that period, as soon as he proves that the licensee has given his consent.

(5) If the requirements governing surrender are not fulfilled, the Office shall communicate the deficiencies to the proprietor and invite him by a conclusion to remedy the established deficiencies within a period of 30 days upon receipt of the conclusion.

(6) If the proprietor fails to remedy the deficiencies referred to in paragraph (5) of this Article in the prescribed period, the Office shall decide upon rejecting the entry of surrender in the Register.

(7) The data to be contained in a declaration of surrender pursuant to paragraph (1) of this Article and the kind of documentation required to establish a third party's agreement pursuant to paragraph (3) of this Article shall be prescribed by the Regulations.

## **CHAPTER II**

### **REVOCATION OF A TRADEMARK**

#### **Filing a request and grounds for revocation of a trademark**

##### **Article 61**

(1) The request for revocation of a trademark may be filed with the Office by any natural or legal person for some or all of the goods or services in respect of which the contested trademark is registered.

(2) A trademark may be revoked if, within a continuous period of five years after the registration date, it has not been put to genuine use pursuant to Article 19 of this Act, and there are no justified reasons for non-use.

(3) A trademark may also be revoked if, after the date on which it was registered:

1. in consequence of acts or inactivity of the holder, it has become a common name in the trade for products or services in respect of which it is registered;

2. in consequence of the use made of it by the holder of the trademark or with his consent, in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(4) The request for revocation of a trademark shall contain the information and attachments as prescribed by the Regulations.

#### **Procedure concerning revocation**

##### **Article 62**

(1) The Office shall examine whether the request for revocation of a trademark is filed in accordance with Article 61 of this Act.

(2) If the request for revocation of a trademark is filed before the expiry of a period of five years from the registration of the trademark the revocation of which is requested, or if it is not filed on the grounds specified in Article 61 paragraphs (2) and (3) of this Act, the Office

shall reject the request by a decision.

(3) If the request for revocation of a trademark is not filed as prescribed by the Regulations, the Office shall order the person who filed the request by a conclusion to remedy the deficiencies in the request within 30 days from the day of receipt of the conclusion.

(4) If the person who filed the request for revocation of a trademark does not, within the prescribed time limit, comply with the conclusion sent by the Office within the meaning of paragraph (3) of this Article, and the request cannot be acted upon, the request shall be rejected by a decision.

(5) If the requirements set out in paragraph (1) of this Article are complied with, the Office shall notify the holder of the contested trademark of the request for revocation of the trademark as filed, and shall send him a copy of the request and invite him to submit his observations on the request within 60 days from the day of receipt of the invitation.

(6) If the holder of the contested trademark does not submit his observations on the request within the prescribed time limit, the trademark shall be revoked for those goods or services in respect of which the request was filed.

(7) If the holder of the contested trademark submits his observations on the request, the Office shall send a copy of such observations to the applicant for revocation of the trademark and invite him to submit his observations within a period of 60 days upon receipt of the invitation.

(8) If the applicant for revocation fails to submit his observations in the time limit prescribed pursuant to paragraph (7) of this Article, the Office shall make a decision on the basis of the facts available from documents and observations as delivered previously.

(9) On request, the time limits referred to in paragraphs (5) and (7) of this Article may be extended for not more than 60 days.

(10) If the Office considers it necessary, it may provide for oral hearing to be held in the revocation procedure.

#### **Deciding upon justification of the request for revocation**

##### **Article 63**

(1) After the expiry of the time limit referred to in Article 62 paragraph (7) of this Act, the Office shall examine the justification of the grounds for revocation of the trademark.

(2) In the examination procedure concerning the grounds for revocation of a trademark, the Office may invite the parties to submit additional evidence, documentation and observations within 60 days from the day of receipt of the invitation.

(3) On request, the time limit laid down in paragraph (2) of this Article may be extended for not more than 60 days.

(4) If the party in the procedure does not respond to the invitation referred to in paragraph (2) of this Article within the prescribed time limit, the Office shall make

a decision on the basis of the facts available from the previously submitted documentation.

(5) It may not be requested that a trademark be revoked where genuine use of the trademark pursuant to Article 19 of this Act has been started or resumed during the interval between expiry of the five-year period of non-use and filing of the request for revocation. However, the commencement or resumption of use within a period of three months preceding the filing of the request for revocation which began, at the earliest, on expiry of the continuous period of five years of non-use, shall be disregarded if preparations for the commencement or resumption occur only after the holder becomes aware that the request for revocation may be filed.

(6) If, in the examination procedure concerning the request for revocation of a trademark, the Office establishes that the request is unjustified, the request shall be refused by the decision to that effect.

(7) If, in the examination procedure concerning the request for revocation of a trademark, the Office establishes that the request is justified, the trademark shall be revoked by the decision for some or all of the goods or services.

(8) When a trademark is revoked, it shall be deemed that its effects ceased in the scope in which the rights of the holder of such trademark are revoked from the date of the filing of the request for revocation, or at the request of one of the parties from an earlier date when any of the grounds for revocation occurred.

(9) The revocation of a trademark shall be entered in the Register after the decision of revocation has become final and it shall be published in the official gazette of the Office.

### **CHAPTER III**

#### **TRADEMARK INVALIDITY**

##### **Procedure for declaration of trademark invalidity on absolute grounds**

###### **Article 64**

(1) The procedure for a declaration that a trademark is invalid for some or all of the goods or services in respect of which it is registered, based on the grounds referred to in Article 9 paragraph (1) of this Act, may be initiated ex officio, on request of an authorised state authority or on request of an interested person and the trademark may be declared invalid only if such grounds for invalidity exist at the time of deciding upon declaring the trademark invalid.

(2) The procedure for a declaration that a trademark is invalid may be initiated on request of an interested person and where the applicant was acting in bad faith when he filed the application for the trademark.

(3) Where the trademark has been registered in breach of the provisions of Article 9 paragraph (1) points 2, 3 and 4 of this Act, it may nevertheless not be declared invalid if the holder of such trademark proves that, in consequence of the use which has been made of

it, the trademark has acquired a distinctive character in relation to the goods or services for which it is registered before the date of filing the request for a declaration of trademark invalidity.

(4) The request for a declaration that a trademark is invalid on absolute grounds shall contain the information and attachments as prescribed by the Regulations.

##### **Procedure for declaration of trademark invalidity on relative grounds**

###### **Article 65**

(1) The procedure for a declaration that a trademark is invalid based on the grounds referred to in Article 10 of this Act for some or all of the goods or services in respect of which the contested trademark is registered may be initiated on a proposal:

1. by holders of earlier trademarks pursuant to Article 10 paragraph (2) of this Act under the conditions set out in Article 10 paragraph (1) of this Act, as well as licensees with consent of the holders of such trademarks;

2. by holders of an earlier right as referred to in Article 10 paragraph (3) of this Act;

3. by persons who have a company within the meaning of Article 10 paragraph (4) of this Act;

4. by holders of earlier trademarks within the meaning of Article 10 paragraph (5) of this Act;

5. by persons who are authorised to exercise the rights under the European Union legislation or national law of the Republic of Croatia governing the protection of a designation of origin or geographical indication as referred to in Article 10 paragraph (6) of this Act.

(2) In respect of evidence to be submitted together with a proposal for declaration that a trademark is invalid, the provisions referred to in Article 45 paragraph (2) of this Act shall apply accordingly.

(3) Where the proprietor of one of the rights referred to in Article 10 of this Act, on which the proposal for a declaration that a trademark is invalid is based, has previously applied for a declaration that a trademark is invalid, he may not submit a new proposal for a declaration of invalidity on the basis of another of the said rights which he could have invoked in support of his first proposal.

(4) A trademark may not be declared invalid where the proprietor of a right referred to in Article 10 of this Act, on which the proposal for a declaration that a trademark is invalid is based, consents expressly to the registration of the trademark before submission of such proposal.

(5) If, on the date of filing the proposal for a declaration that a trademark is invalid on the basis of an earlier trademark, the procedure concerning the request for revocation or the proposal for a declaration that such earlier trademark is invalid is pending, the Office shall decide upon suspending the procedure concerning the proposal for a declaration of trademark invalidity until the decisions from the procedures concerning revocation or declaration of trademark invalidity initiated before have become final.

(6) The proposal for a declaration of trademark

invalidity may be filed on the basis of one or more earlier rights, provided that all belong to the same holder.

(7) The proposal for a declaration of trademark invalidity on relative grounds shall contain the information and attachments as prescribed by the Regulations.

#### Non-use as a method of defence in proceedings for declaration of invalidity

##### Article 66

(1) In the proceedings for a declaration of invalidity on the basis of a registered trademark with an earlier date of filing the application or an earlier priority date, if the proprietor of the later trademark expressly requests so, the proprietor of an earlier trademark shall furnish proof that, during the period of five years preceding the date of the application for a declaration of invalidity, the earlier trademark has been put to genuine use as referred to in Article 19 of this Act in connection with the goods or services in respect of which it is registered and which the proprietor of that earlier trademark cites as justification for his application, or that there are proper reasons for non-use, provided that the earlier trademark has at the date of filing the proposal for a declaration of trademark invalidity been registered for not less than five years.

(2) The Office shall invite the holder of an earlier trademark by a conclusion to submit his observations concerning the request referred to in paragraph (1) of this Article within 60 days upon receipt of the conclusion.

(3) If the holder of an earlier trademark fails to submit his observations concerning the request to furnish proof of genuine use in the prescribed time limit or fails to prove genuine use or to provide proper reasons for non-use of the earlier trademark, the proposal for a declaration that a trademark is invalid shall be refused by a decision.

(4) If the holder of an earlier trademark submits his observations concerning the request to furnish proof of genuine use of such trademark in the prescribed time limit, the Office shall forward a copy of such observations to the holder of the contested trademark and invite him to submit his observations thereon within 60 days upon receipt of the invitation.

(5) Upon expiry of the period referred to in paragraph (4) of this Article, the Office shall decide upon justification of the proposal for a declaration of trademark invalidity on the basis of the facts available from documents and observations as previously submitted.

(6) If the earlier trademark has been used only in relation to part of the goods or services for which it is registered, it shall, for the purpose of the examination of the proposal for a declaration of trademark invalidity, be deemed to be registered in respect of that part of the goods or services only.

Absence of distinctive character or reputation of an earlier trademark that prevents the registered trademark from being declared invalid

##### Article 67

The proposal for a declaration of invalidity on the basis of an earlier trademark shall not be accepted on the date of the proposal of invalidity if it is not accepted on the date of filing the application or on the priority date of the later trademark for any of the following reasons:

1. an earlier trademark that can be declared invalid pursuant to Article 9 paragraph (1) points 2, 3 and 4 of this Act has not yet acquired distinctive character as referred to in Article 9 paragraph (2) of this Act;

2. the proposal to declare invalidity is based on Article 10 paragraph (1) point 2 of this Act, and the earlier trademark has not yet acquired sufficient distinctiveness to justify the probability of misleading the public within the meaning of Article 10 paragraph (1) point 2 of this Act;

3. the proposal to declare invalidity is based on Article 10 paragraph (1) point 3 of this Act, and the earlier trademark has not yet acquired reputation within the meaning of Article 10 paragraph (1) point 3 of this Act.

#### Limitation of declaration of invalidity in consequence of acquiescence

##### Article 68

(1) Where the proprietor of an earlier trademark referred to in Article 10 paragraph (2) of this Act has acquiesced, for a period of five successive years, in the use of a later trademark while being aware of such use, he shall no longer be entitled on the basis of the earlier trademark to apply for a declaration that the later trademark is invalid or to oppose the use of the later trademark in respect of the goods or services for which such later trademark has been used, unless registration of the later trademark was applied for in bad faith.

(2) The provision referred to in paragraph (1) of this Article shall also apply to the holders of rights referred to in Article 10 paragraphs (3) and (4) of this Act.

(3) In the cases referred to in paragraphs (1) and (2) of this Article, the proprietor of a later trademark shall not be entitled to oppose the use of the earlier right, even though that right may no longer be invoked against the later trademark.

#### Examination of the proposal for declaration of trademark invalidity

##### Article 69

(1) The Office shall examine if the proposal for a declaration of trademark invalidity is filed in compliance with the conditions referred to in Article 64 of this Act, or, as the case may be, in compliance with Article 65 of this Act.

(2) If the proposal for a declaration of trademark invalidity is not filed by an authorised person referred

to in Article 64 paragraph (1) or, as the case may be, in Article 65 paragraph (1), and if it is not filed in compliance with the provisions referred to in Article 65 paragraphs (2) and (3) of this Act, and the proposal cannot be acted upon, the Office shall reject the proposal by a decision.

(3) If the proposal for a declaration of trademark invalidity does not contain the information and attachments as prescribed by the Regulations pursuant to Article 64 paragraph (4) of this Act, or, as the case may be, pursuant to Article 65 paragraph (7) of this Act, the Office shall order the applicant by a conclusion to remedy the deficiencies in the proposal within a period of 30 days upon receipt of the conclusion.

(4) If the applicant does not, within the prescribed time limit, comply with the conclusion sent by the Office and does not remedy the deficiencies in the proposal within the meaning of paragraph (3) of this Article, and the proposal cannot be acted upon, the Office shall reject the proposal by a decision.

(5) If the conditions to initiate the procedure concerning the proposal for a declaration of trademark invalidity are complied with, the Office shall notify the holder of the contested trademark of the initiated procedure for a declaration that the trademark is invalid, it shall send him a copy of the proposal and invite him by a conclusion to submit his observations on the proposal within 60 days from the day of receipt of the conclusion.

(6) On request, the time limit laid down in paragraphs (5) of this Article may be extended for not more than 60 days.

(7) If the holder of the contested trademark does not submit his observations on the proposal for a declaration that the trademark is invalid within the prescribed time limit, the trademark shall be declared invalid for those goods or services in respect of which the procedure was initiated.

(8) If the Office considers it necessary, it may provide for oral hearing to be held in the procedure concerning the proposal for a declaration that a trademark is invalid.

#### Deciding upon justification of the proposal for a declaration of trademark invalidity

##### Article 70

(1) If the holder of the contested trademark submits his observations within the prescribed time limit referred to in Article 69 of this Act, the Office shall examine the justification of the grounds specified in the proposal for a declaration of trademark invalidity within the limits of that proposal in respect of some or all of the goods or services for which the contested trademark is registered.

(2) In the examination procedure concerning the proposal for a declaration that a trademark is invalid, the Office may invite the parties to submit additional evidence, documentation and observations within 60 days from the day of receipt of the invitation.

(3) On request, the time limit laid down in paragraph (2) of this Article may be extended for not more than 60 days.

(4) If the party in the procedure does not respond to the invitation within the prescribed time limit, the Office

shall make a decision on the basis of the facts available from the documentation submitted earlier.

(5) If, in the examination procedure concerning the proposal for a declaration that a trademark is invalid, the Office establishes that the proposal is unjustified, the proposal shall be refused by a decision.

(6) If, in the examination procedure concerning the proposal for a declaration that a trademark is invalid, the Office establishes that the proposal is justified, the trademark shall be declared invalid in respect of some or all of the goods or services for which it is registered.

(7) Where a trademark is declared invalid, it shall be considered not to have effects from the very beginning, in the scope in which such trademark is declared invalid.

(8) The declaration that a trademark is invalid shall be entered in the Register upon decision thereon becoming final and it shall be published in the official gazette of the Office.

(9) If, in the examination procedure for justification of the proposal for a declaration that a trademark registered in the name of an agent is invalid, in which it is requested that such trademark is assigned pursuant to Article 24 paragraph (1) of this Act, it is established that the grounds for a declaration of trademark invalidity are justified, instead of declaring the trademark invalid, the Office shall decide upon assigning the trademark on behalf of the holder of the trademark and upon such decision becoming final it shall enter the transfer of the trademark in the Register.

## **PART SEVEN SPECIFIC PROVISIONS ON COLLECTIVE AND GUARANTEE TRADEMARKS**

### **CHAPTER I COLLECTIVE TRADEMARKS**

#### Definition and application of provisions

##### Article 71

(1) A collective trademark shall be a trademark which is indicated as such in the application for the registration of a trademark and is capable of distinguishing the goods or services of the members of the association which is the proprietor of the trademark from the goods or services of other undertakings.

(2) A collective trademark may be applied for by associations of manufacturers, producers, suppliers of services, or traders, which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations of all kinds, to make contracts or accomplish other legal acts, and to sue and be sued, as well as legal persons governed by public law.

(3) By way of derogation from Article 9 paragraph (1) point 3 of this Act, signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be protected as a collective trademark.

(4) A collective trademark shall not entitle the proprietor to prohibit a third party from using in the

course of trade such signs or indications referred to in paragraph (3) of this Article, provided that he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a trademark shall not be invoked against a third party who is entitled to use a geographical name.

(5) Other provisions of this Act and of the Trademark Regulations governing national applications or registrations of individual trademarks shall apply to collective trademarks unless prescribed otherwise by the provisions referred to in this Chapter of the Act.

#### Regulations governing use of a collective trademark

##### Article 72

(1) An applicant for a collective trademark shall submit to the Office regulations governing use not later than within two months of the date of filing.

(2) The regulations governing use shall specify the persons authorised to use the trademark, the conditions of membership of the association and the conditions of use of the trademark, including sanctions in case of misuse of the collective trademark or infringement of the regulations. The regulations governing use of a trademark referred to in Article 71 paragraph (3) of this Act shall authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the trademark provided that other conditions from the regulations are satisfied.

(3) If the regulations do not contain the information and conditions provided by this Article, the Office shall invite the applicant by a conclusion to remedy the established deficiencies within a period of 30 days upon receipt of the conclusion.

(4) The information to be included in the regulations on the collective trademark shall be prescribed by the Regulations.

#### Refusal of the application for a collective trademark

##### Article 73

(1) In addition to the grounds for refusal of a trademark application provided for in Articles 41 and 42 of this Act, with the exception provided for in Article 71 paragraph (3) of this Act, an application for a collective trademark shall be refused where the provisions of Articles 71 and 72 of this Act are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.

(2) An application for a collective trademark shall also be refused if the public is liable to be misled as regards the character or the significance of the trademark, in particular if it is likely to be taken to be something other than a collective trademark.

(3) An application shall not be refused if the applicant, as a result of amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.

#### Observations by third parties concerning the application for a collective trademark

##### Article 74

Observations by third parties concerning the application for a collective trademark pursuant to Article 44 of this Act may also be based on the grounds for refusal of a collective trademark provided for in Article 73 of this Act.

#### Use of a collective trademark

##### Article 75

The conditions prescribed by this Act concerning the use of trademarks in respect of collective trademarks shall be satisfied if any person authorised to use a collective trademark uses such trademark in compliance with Article 19 of this Act.

#### Amendment of the regulations governing use of a collective trademark

##### Article 76

(1) The proprietor of a collective trademark shall submit to the Office any amended regulations governing use of that trademark.

(2) The amendment shall be recorded in the Register and the information thereon published if the amended regulations satisfy the requirements of Article 72 of this Act or do not involve one of the grounds for refusal of the application referred to in Article 73 of this Act.

(3) Observations made in accordance with Article 74 of this Act may also be submitted with regard to amended regulations governing use.

(4) For the purposes of applying this Act, amendments to the regulations governing use shall take effect from the date of entry of the mention of the amendment in the Register.

#### Persons who are entitled to bring an action for infringement of a collective trademark

##### Article 77

(1) The provisions of Article 125 of this Act concerning the rights of licensees shall apply to every person who has authority to use a collective trademark.

(2) The proprietor of a collective trademark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where they have sustained damage in consequence of unauthorised use of that trademark.

#### Grounds for revocation of a collective trademark

##### Article 78

Apart from the grounds for revocation provided for in Article 61 of this Act, the rights of the proprietor of a collective trademark shall be revoked on application to the Office, or on any of the following grounds:

1. the proprietor does not take reasonable steps to prevent the trademark being used in a manner

incompatible with the conditions of use laid down in the regulations governing use, including all amendments to which have been mentioned in the Register;

2. the manner in which the trademark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in Article 73 paragraph (2) of this Act;

3. an amendment to the regulations governing use of the trademark has been mentioned in the Register in breach of the provisions of Article 72 paragraph (2) of this Act, unless the proprietor of the trademark, by further amending the regulations governing use, complies with the requirements of those provisions.

#### Grounds for invalidity of a collective trademark

##### Article 79

Apart from the grounds for invalidity provided for in this Act, with the exception of Article 71 paragraph (3) of this Act, a collective trademark which is registered in breach of the provisions of Article 73 of this Act shall be declared invalid on application to the Office, unless the proprietor of the trademark, by amending the regulations governing use, complies with the requirements of those provisions.

## **CHAPTER II GUARANTEE TRADEMARK**

#### Definition and application of the provisions

##### Article 80

(1) A guarantee trademark shall be a trademark which is described as such when the trademark is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the trademark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, from goods and services which are not so certified.

(2) Any natural or legal person, including institutions, authorities and bodies governed by public law, may apply for a guarantee trademark provided that such person does not carry on a business involving the supply of goods or services of the kind he authorises as the proprietor of the trademark referred to in paragraph (1) of this Article.

(3) Other provisions of this Act and of the Trademark Regulations governing national applications or registrations of individual trademarks shall apply to guarantee trademarks unless prescribed otherwise by the provisions referred to in this Chapter of the Act.

#### Regulations governing use of a guarantee trademark

##### Article 81

(1) An applicant for a guarantee trademark shall submit to the Office regulations governing the use of the guarantee mark not later than within two months of the date of filing.

(2) The regulations governing use shall specify

the persons authorised to use the trademark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark. Those regulations shall also specify the conditions of use of the guarantee trademark, including sanctions.

(3) If the regulations do not contain the information and conditions provided by this Article, the Office shall invite the applicant by a conclusion to remedy the established deficiencies within a period of 30 days upon receipt of the conclusion.

(4) The information to be included in the regulations on the guarantee trademark shall be prescribed by the Regulations.

#### Refusal of the application for a guarantee trademark

##### Article 82

(1) In addition to the grounds for refusal of a trademark application provided for in Articles 41 and 42 of this Act, an application for a guarantee trademark shall be refused where the provisions of Articles 80 and 81 of this Act are not satisfied, or where the regulations governing use are contrary to public policy or to accepted principles of morality.

(2) An application for a guarantee trademark shall also be refused if the public is liable to be misled as regards the character or the significance of the trademark, in particular if it is likely to be taken to be something other than a guarantee trademark.

(3) An application shall not be refused if the applicant, as a result of amendment of the regulations governing use, meets the requirements of paragraphs 1 and 2.

#### Observations by third parties concerning the application for a guarantee trademark

##### Article 83

Observations by third parties concerning the application for a guarantee trademark pursuant to Article 44 of this Act may also be based on the grounds for refusal of a guarantee trademark provided for in Article 82 of this Act.

#### Use of a guarantee trademark

##### Article 84

The conditions prescribed by this Act concerning the use of trademarks in respect of guarantee trademarks shall be satisfied if any person authorised to use a guarantee trademark uses such trademark in compliance with Article 19 of this Act.

#### Amendment of the regulations governing use of a guarantee trademark

##### Article 85

(1) The proprietor of a guarantee trademark shall submit to the Office any amended regulations governing use of that trademark.

(2) The amendment shall be recorded in the Register and the information thereon published if the amended regulations satisfy the requirements of Article 81 of this Act or do not involve one of the grounds for refusal of the application referred to in Article 82 of this Act.

(3) Observations made in accordance with Article 83 of this Act may also be submitted with regard to amended regulations governing use.

(4) For the purposes of applying this Act, amendments to the regulations governing use shall take effect from the date of entry of the mention of the amendment in the Register.

#### Transfer of a guarantee trademark

##### Article 86

By way of derogation from Article 22 of this Act, a guarantee trademark may only be transferred to a person who meets the requirements of Article 80 paragraph (2) of this Act.

#### Persons who are entitled to bring an action for infringement of a guarantee trademark

##### Article 87

(1) Only the proprietor of a guarantee trademark, or any person specifically authorised by him to that effect, shall be entitled to bring an action for infringement.

(2) The proprietor of a guarantee trademark shall be entitled to claim compensation on behalf of persons who have authority to use the mark where they have sustained damage in consequence of unauthorised use of that trademark.

#### Grounds for revocation of a guarantee trademark

##### Article 88

Apart from the grounds for revocation provided for in Article 61 of this Act, the rights of the proprietor of a guarantee trademark shall be revoked on application to the Office, or on any of the following grounds:

1. the proprietor no longer complies with the requirements set out in Article 80 paragraph (2) of this Act;

2. the proprietor does not take reasonable steps to prevent the trademark being used in a manner incompatible with the conditions of use laid down in the regulations governing use, including all amendments to which have been mentioned in the Register;

3. the manner in which the trademark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in Article 82 paragraph (2) of this Act;

4. an amendment to the regulations governing use of the trademark has been mentioned in the Register in breach of the provisions of Article 85 paragraph (2) of this Act, unless the proprietor of the trademark, by further amending the regulations governing use, complies with the requirements of those provisions.

#### Grounds for invalidity of a guarantee trademark

##### Article 89

Apart from the grounds for invalidity provided for in this Act, a guarantee trademark which is registered in breach of the provisions of Article 82 of this Act shall be declared invalid on application to the Office, unless the proprietor of the trademark, by amending the regulations governing use, complies with the requirements of those provisions.

## **PART EIGHT INTERNATIONAL REGISTRATION OF A TRADEMARK**

### **CHAPTER I GENERAL PROVISIONS**

#### Application of provisions

##### Article 90

Unless this part of the Act or the provisions of the Madrid Agreement and the Protocol Relating to the Madrid Agreement provide otherwise, this Act and the Trademark Regulations shall apply to international registrations of trademarks based on a national application for a trademark or on a trademark registered by national route, as well as international registrations of trademarks entered in the international register maintained by the International Bureau designating the Republic of Croatia.

### **CHAPTER II INTERNATIONAL REGISTRATION OF A MARK BASED ON A NATIONAL APPLICATION OR NATIONAL REGISTRATION**

#### Filing of an international application for a trademark

##### Article 91

(1) An international application pursuant to Article 3 of the Madrid Protocol based on a national trademark application or registration shall be filed with the Office.

(2) The applicant may be any holder of a national application for a trademark or a holder of a national registration of a trademark, if he is a citizen of the Republic of Croatia or has his domicile in it, or has a real and effective industrial or commercial undertaking in it.

(3) Where an international application is filed before the national registration of a trademark, the applicant for the international registration shall indicate whether the international registration is to be based on a national trademark application or registration. Where the international registration is to be based on a national registration of a trademark registered after the date of filing an international application for a trademark, the international application shall be deemed to have been received at the Office on the date of registration of the national trademark.

(4) Integral parts of and attachments to the international application shall be submitted pursuant

to the Madrid Protocol and the Trademark Regulations.

Examination of correctness of an international application for a trademark

Article 92

(1) If the international application for a trademark satisfies the conditions referred to in Article 91 of this Act, the Office shall forward the application to the International Bureau.

(2) If the international application for a trademark does not satisfy the conditions referred to in Article 91 of this Act, the Office shall order the applicant by a conclusion to remedy the deficiencies in the application within 30 days from the day of receipt of the conclusion.

(3) On request, the time limit laid down in paragraph (2) of this Article may be extended for not more than 30 days.

(4) If the applicant for the international registration of a mark does not comply with the conclusion sent by the Office, and does not remedy the found deficiencies within the prescribed time limit, and the request cannot be acted upon, the international application shall be rejected by a decision.

Recordal in the trademark register

Article 93

The date and number of an international registration based on a national trademark application or registration shall be recorded in the trademark register kept by the Office.

Notification of the invalidity of the national application or registration

Article 94

Within a period of five years of the date of the international registration, the Office shall notify the International Bureau of any facts and decisions affecting the validity of the national trademark application or the national trademark registration on which the international registration was based.

Filing of a request for territorial extension subsequent to international registration and of a request for recordal of change in the international register

Article 95

(1) A request for territorial extension made subsequent to an international registration and a request for recordal of change in the international register may be filed with the International Bureau through the intermediary of the Office when pursuant to the provisions under the Madrid Protocol the Office is competent to forward such requests to the International Bureau.

(2) Integral parts of and attachments to the request for territorial extension or to the request for recordal of change in the international register shall be submitted pursuant to the Madrid Protocol and the Trademark

Regulations.

(3) If the request for territorial extension or the request for recordal of change in the international register complies with the requirements set out in paragraph (2) of this Article, the Office shall forward the request to the International Bureau.

(4) Where the request for territorial extension or the request for recordal of change in the international register is not filed in accordance with the requirements referred to in paragraph (2) of this Article, the Office shall order the applicant by a conclusion to remedy the deficiencies within 30 days upon receipt of the conclusion.

(5) On request, the time limit laid down in paragraph (2) of this Article may be extended for not more than 30 days.

(6) If the applicant does not act as ordered by the Office in the conclusion and does not remedy the deficiencies in the prescribed time limit, and the request cannot be acted upon, the request shall be refused by a decision.

International fees

Article 96

Any fees payable to the International Bureau under the Madrid protocol shall be paid direct to the International Bureau.

**CHAPTER III  
INTERNATIONAL REGISTRATIONS DESIGNATING  
THE REPUBLIC OF CROATIA**

Effects of international registrations designating the Republic of Croatia

Article 97

(1) An international registration designating the Republic of Croatia shall, from the date of its registration pursuant to Article 3 paragraph (4) of the Madrid Protocol or from the date of the subsequent designation of the Republic of Croatia pursuant to Article 3ter paragraph (2) of the Madrid Protocol, have the same effect as an application for a national trademark.

(2) If no refusal has been notified by the Office to the International Bureau in accordance with Article 5 paragraphs (1) and (2) of the Madrid Protocol or if any such refusal has been withdrawn, the international registration of a trademark shall, from the date referred to in paragraph (1), have the same effect as the registration of a trademark as a national trademark.

Examination as to absolute grounds for refusal and correctness of classification of goods and services under an international registration

Article 98

(1) International registrations designating the Republic of Croatia shall be subject to examination by the Office as to absolute grounds for refusal and to the correctness of classification of goods and services in



the same way as applications for national trademarks.

(2) Where an international registration designating the Republic of Croatia is found to be ineligible for protection pursuant to paragraph (1) of this Article for all or any part of the goods and services for which it has been registered by the International Bureau, the Office shall issue an ex officio provisional notification of refusal to the International Bureau, in accordance with Article 5 paragraphs (1) and (2) of the Madrid Protocol.

(3) The notification of provisional refusal shall state the reasons and the scope on which it is based, and shall invite the holder of the international registration to submit his observations on the grounds for refusal within four months from the date of the Office's issuing the notification of provisional refusal, exclusively through a professional representative.

(4) On request of the holder of the international registration through a professional representative, the time limit referred to in paragraph (3) of this Article may be extended for not more than 60 days.

(5) Where the holder of the international registration fails to submit his observations on the notification of provisional refusal in the prescribed time limit, or where in the procedure concerning the observations on such notification the international registration is found to be ineligible for protection in the Republic of Croatia, the Office shall decide upon refusing the protection, as the case may be, for all or part of the goods or services under the international registration.

(6) Where the holder of the international registration submits his observations on the notification of provisional refusal in the prescribed time limit, and where in the procedure concerning the observations on such notification the international registration is found to be eligible for protection in the Republic of Croatia for all of the goods or services, the Office shall decide upon granting the protection under the international registration provided that no opposition to such international registration has been filed.

#### Collective and guarantee trademarks of international registrations

##### Article 99

The holder of the international registration of a collective or a guarantee trademark shall submit the regulations governing the use of the collective or guarantee trademark, as provided for in Article 72 paragraph (2) of this Act, or Article 81 paragraph (2) of this Act, directly to the Office within four months of the date on which the International Bureau notifies the international registration to the Office.

#### Opposition to the international registration of a mark

##### Article 100

(1) In the procedure concerning the opposition to an international registration of a mark, the publication of the national application shall be replaced by the publication of the international registration of mark pursuant to Article 3 paragraph (4) of the Madrid Protocol, or the

publication of a subsequent designation of the Republic of Croatia in the international registration of mark pursuant to Article 3ter paragraph (2) of the Madrid Protocol.

(2) The time limit for filing the opposition to an international registration of a mark shall run from the first day of the month following the month indicated on the edition of the official gazette of the International Bureau in which such international registration has been published.

(3) The information and attachments to be included in the opposition referred to in this Article shall be prescribed by the Regulations.

#### Opposition proceedings concerning international registration

##### Article 101

(1) Where the requirements for filing an opposition to the international registration of a trademark as provided for by this Act are satisfied, the Office shall issue a provisional notification of refusal to the International Bureau pursuant to Article 5 paragraphs (1) and (2) of the Madrid Protocol.

(2) The notification of provisional refusal shall state the reasons and the scope of refusal on which it is based, and the invitation to the holder of the international registration to appoint a representative, who shall submit his power of attorney to the Office within four months from the day on which the Office issues the notification of provisional refusal.

(3) Where the requirements referred to in paragraph (2) of this Article are satisfied, the Office shall issue a copy of the opposition through a professional representative to the holder of the international registration of a trademark and shall invite him to submit his observations thereon within 60 days upon receipt of the opposition.

(4) The time limits referred to in paragraphs (2) and (3) of this Article may not be extended.

(5) Where the holder of the international registration fails to act as referred to in paragraphs (2) or (3) of this Article in the prescribed time limits, the Office shall decide upon accepting the opposition to the international registration of a trademark within the limits of the request mentioned in the opposition.

#### Statement of granting or refusing protection of an international registration of a trademark

##### Article 102

(1) The Office shall issue a statement to the International Bureau granting protection of an international registration of a trademark in the Republic of Croatia in respect to all or part of the goods or services if no grounds for refusal of the international registration of a trademark are found in the examination proceedings in relation to absolute grounds for refusal and correctness of classification of the goods or services, or, where applicable, in the opposition proceedings concerning the international registration of a trademark, or if such

proceedings have become final by granting protection to all or part of the goods or services.

(2) The Office shall issue a statement to the International Bureau refusing protection of an international registration of a trademark if the examination proceedings in relation to absolute grounds for refusal and correctness of classification of the goods or services, or, where applicable, the opposition proceedings concerning the international registration of a trademark have become final by refusing protection to all of the goods or services.

#### Conversion (transformation) of an international registration of a trademark into a national trademark application

##### Article 103

(1) Where the request of the holder of an international registration of a trademark for conversion of the international registration into a national trademark application fulfils all the requirements laid down under Article 9quinquies of the Madrid Protocol for such conversion (transformation), and on or before the day of cancellation of an international registration from the International Register such trademark enjoys protection in the Republic of Croatia, such trademark shall be entered in the trademark register kept by the Office pursuant to this Act, subject to the prior payment of the charges for the maintenance of the trademark for the first ten-year period and the publication of the trademark data.

(2) Where the request of the holder of an international registration of a trademark for conversion of the international registration into a national trademark application fulfils all the requirements laid down under Article 9quinquies of the Madrid Protocol for such conversion (transformation), and on or before the day of cancellation of an international registration from the International Register such trademark has been subject to the examination proceedings for granting protection in the Republic of Croatia, such proceedings shall be deemed an integral part of the national trademark application procedure pursuant to the provisions of this Act.

(3) The date of the international registration of the trademark, which is the basis for conversion (transformation), shall be taken as the date of the national trademark application, resulting from the request for conversion (transformation), carried out in accordance with Article (3) paragraph (4) of the Madrid Protocol or, where applicable, from the date of subsequent designation of the Republic of Croatia pursuant to Article 3ter paragraph (2) of the Madrid Protocol.

(4) The information and attachments to be included in the request for conversion of the international registration into national trademark application shall be prescribed by the Regulations.

#### Declaration that an international registration of a trademark is invalid and revocation of an international registration of a trademark

##### Article 104

(1) In the procedures concerning the proposal for a declaration that an international registration of a trademark is invalid and the request for revocation of an international registration of a trademark, the Office shall notify the holder of the international registration of a trademark of the proposal or request and order him by conclusion to appoint a representative who, within 60 days from the date of receipt of the conclusion, has to file with the Office a power of attorney.

(2) The time limit referred to in paragraph (1) of this Article may not be extended.

(3) Where the requirements referred to in paragraph (1) of this Article are satisfied, the Office shall send through a professional representative a copy of the proposal or request to the holder of the international registration of a trademark and invites him to submit his observations thereon within 60 days from the day of receipt of such copy.

(4) On request, the time limit laid down in paragraph (3) of this Article may be extended for not more than 60 days.

(5) Where the holder of the international registration fails to act as referred to in paragraphs (1) or (3) of this Article in the prescribed time limits, the Office shall decide upon accepting the proposal for a declaration that an international registration of a trademark is invalid or the request for revocation of an international registration of a trademark within the limits of the proposal or request as submitted.

(6) If in the proceedings concerning the proposal for a declaration that an international registration of a trademark is invalid or the request for revocation of an international registration of a trademark it was decided upon declaring such trademark invalid or revoking a trademark for all or part of the goods or services, the Office shall notify the International Bureau of a declaration that an international registration of a trademark is invalid or of revocation of an international registration of a trademark in the Republic of Croatia in respect of all or part of the goods or services upon such decision becoming final.

#### Use of an international registration of a trademark

##### Article 105

(1) For the purpose of furnishing proof in the opposition proceedings, the procedure concerning the proposal for a declaration of trademark invalidity and the procedure concerning the request for revocation of a trademark, that an international registration of a trademark has been used, in order to establish the date as from which the trademark which is the subject of an international registration designating the Republic of Croatia shall be put to genuine use in the territory of the Republic of Croatia, it shall be the date when the statement of the Office on granting protection of an

international registration of a trademark in the Republic of Croatia referred to in Article 102 paragraph (1) of this Act was published in the official gazette of the International Bureau.

(2) If upon expiry of a one-year period from the date of notification by the International Bureau of the request to extend protection of an international registration to the territory of the Republic of Croatia the Office has not notified the International Bureau of a temporary refusal of the protection or of a statement on granting protection of an international registration of a trademark, the first day following the date of expiry of such one-year period shall be taken as the date established for such trademark to be put to genuine use.

Replacement of a national registered trademark by an international registration of a trademark

#### Article 106

(1) If the conditions referred to in Article 4bis paragraph (1) of the Madrid Protocol are complied with, upon request of the holder of a national trademark registration and also the holder of an identical international trademark registration granting protection in the Republic of Croatia the Office shall enter a notice in the Register that a trademark registered by national route is deemed to have been replaced by an identical international trademark registration.

(2) If the request referred to in paragraph (1) of this Article is fulfilled, the Office shall notice the International Bureau of the record of replacement.

(3) The information and attachments to be included in the request for recording replacement of a national trademark registration by an international trademark registration shall be prescribed by the Regulations.

### **PART NINE EUROPEAN UNION TRADEMARKS**

Extension of effects of the European Union trademark

#### Article 107

The effects of applications for a European Union trademark filed and European Union trademarks acquired before 1 July 2013 shall extend to the territory of the Republic of Croatia with such date.

A European Union trademark as an earlier trademark

#### Article 108

(1) Within the meaning of Article 10 paragraph (2) of this Act, a European Union trademark applied for before 1 July 2013 shall be an earlier trademark in relation to national trademark applications filed after such date, as well as national trademarks based on such applications and international trademark registrations with the date of registration for the Republic of Croatia after 1 July 2013.

(2) Within the meaning of Article 10 paragraph (1) point 3 of this Act, an earlier European Union trademark having reputation in the European Union shall be taken into consideration in accordance with the provisions

of Article 8 paragraph (5) of the Regulation on the European Union Trademark.

(3) A national trademark or an international trademark registration having effect in the Republic of Croatia shall be deemed an earlier trademark within the meaning of Article 10 paragraph (2) of this Act even when waived or let expire by the holder, if seniority claim was filed for a European Union trademark in accordance with Article 39 or, where appropriate, Article 40 of the Regulation on the European Union Trademark.

(4) Within the meaning of Article 47 paragraph (1) of this Act, an earlier European Union trademark will represent no impediment to register a national trademark, or to extend effect of an international trademark registration in the Republic of Croatia, if such earlier European Union trademark does not comply with the conditions of use provided for in Article 18 of the Regulation on the European Union Trademark.

(5) Within the meaning of Article 66 paragraph (1) of this Act, a national trademark, or an international trademark registration having effect in the Republic of Croatia may not be declared invalid for the reason of being in conflict with an earlier European Union trademark, if such earlier European Union trademark fails to fulfil the conditions of use provided for in Article 18 of the Regulation on the European Union Trademark.

Conversion of a European Union trademark application and a European Union trademark into a national trademark application

#### Article 109

(1) Upon a request for conversion of a European Union trademark application, or a European Union trademark, respectively, into a national trademark application, filed pursuant to the provision of Article 139 of the Regulation on the European Union Trademark and submitted to the Office by the European Union Intellectual Property Office pursuant to the provision of Article 140 of the Regulation on the European Union Trademark, the Office shall carry out the procedure for registration of a national trademark in accordance with the provisions of this Act.

(2) The Office shall notify the holder of the application or of the registered European Union trademark about the receipt of conversion request referred to in paragraph (1) of this Article and shall order him by a conclusion, where appropriate, to appoint a representative who shall submit a power of attorney to the Office and a translation of the European Union trademark application into Croatian, within a period of 60 days upon receipt of the conclusion.

(3) If the holder of the application or of the registered European Union trademark fails to act by the conclusion referred to in paragraph (2) of this Article within a prescribed period, requested conversion shall be rejected by a decision.

(4) If the conditions referred to in paragraph (2) of this Article are fulfilled, and it was requested to convert a registered European Union trademark into a national trademark application, such trademark shall be entered

in the Register kept by the Office, provided that the charges for trademark maintenance in the value during the first ten-year period and for publication of trademark information have been paid in accordance with the provisions of this Act and other regulations.

(5) If the conditions referred to in paragraph (2) of this Article are fulfilled, and it was requested to convert an application of the European Union trademark into a national trademark application, the Office shall carry out procedure for a national trademark registration, provided that administrative fees and charges have been paid in accordance with the provisions of this Act and other regulations.

(6) The date of filing, the date of priority and seniority shall be determined pursuant to the provision of Article 139, paragraph (3) of the Regulation on the European Union Trademark.

#### Seniority

##### Article 110

(1) If seniority is claimed for a European Union trademark pursuant to Article 39 or, where appropriate, Article 40 of the Regulation on the European Union Trademark, in respect of a national trademark registration or an international trademark registration having effect in the Republic of Croatia, and which is waived or let expire by the holder, invalidity or revocation of the trademark that represents the basis of the seniority claim can be established subsequently in accordance with the provisions of this Act provided that invalidity or revocation could have been declared at the moment when the trademark was waived or let expire. In that case, seniority ceases to take its effects.

(2) An indication shall be entered in the Register that seniority is claimed for a European Union trademark in respect of a trademark registered via national route, as well as an indication that seniority ceased to take effects.

#### Prohibition of use of a European Union trademark

##### Article 111

The holder of a national trademark registration filed before 1 July 2013 or the holder of an international registration with a date of an international registration for the territory of the Republic of Croatia before 1 July 2013 may institute a legal action, claiming prohibition of the use in the Republic of Croatia of the European Union trademark, the effect of which is, in accordance with Article 107 of this Act, extended to the territory of the Republic of Croatia. The plaintiff shall prove that the use of a European Union trademark conflicts with his trademark for one of the reasons provided for by Article 11 paragraph (2) of this Act.

#### Protection of a European Union trademark against infringement

##### Article 112

The Regulation on the European Union Trademark and accordingly the provisions of this Act governing

protection of a national trademark in case of infringement shall apply to protection of a European Union trademark in the Republic of Croatia in case of infringement.

#### The court competent for a European Union trademark

##### Article 113

(1) In the Republic of Croatia, the Commercial Court in Zagreb shall be the European Union Trademark Court competent for first instance decisions, within the meaning of the Regulation on the European Union Trademark.

(2) In the Republic of Croatia, the High Commercial Court shall be the European Union Trademark Court competent for second instance decisions, within the meaning of the Regulation on the European Union Trademark.

### **PART TEN**

### **COMMON PROVISIONS RELATING TO THE PROCEDURE BEFORE THE OFFICE**

#### Competence of the Office

##### Article 114

(1) The Office shall carry out administrative procedures for trademark registration, for declaration of trademark invalidity, for trademark revocation; it shall perform other administrative and professional tasks in respect of trademark protection.

(2) The decisions passed by the Office cannot be appealed, but an administrative dispute may be instituted before the Administrative Court in Zagreb.

(3) The procedure referred to in paragraph (2) of this Article is urgent.

#### Initiation of a procedure

##### Article 115

The requests for initiation of administrative procedures under competence of the Office shall include information prescribed by the Regulations.

#### Continued processing

##### Article 116

(1) If the applicant for a trademark registration or the holder of a trademark has failed to comply with an act in a procedure before the Office within a time limit, and that failure has the direct consequence of causing the loss of rights conferred by the trademark application or a trademark, he may file a request for the continued processing with respect to the trademark application or a trademark. The Office shall authorise the continued processing provided that the applicant:

1. files a request for the continued processing and performs all the omitted acts within the prescribed time limit, referred to in paragraph (2) of this Article, and

2. pays the administrative fee and charges for filing a request for continued processing.

(2) A request for the continued processing may be filed within two months from the day on which he learned about the legal consequences referred to in paragraph (1) of this Article.

(3) If the omitted acts have not been performed within the time limit referred to in paragraph (2) of this Article, a request for the continued processing shall be rejected by a decision.

(4) A request for the continued processing shall not be filed, if failure to comply with concerns the time limit:

1. referred to in paragraph (2) of this Article,
2. referred to in Article 37 paragraph (1) of this Act and Article 38 paragraph (1) of this Act,
3. referred to in Article 40 paragraphs (1) and (4) of this Act,
4. referred to in Article 56 paragraph (3) of this Act,
5. for initiating an administrative dispute referred to in Article 114 paragraph (2) of this Act,
6. for filing a request for restitution in integrum pursuant to the provisions of the Act on General Administrative Proceedings,
7. for all the acts in the procedures before the Office involving several parties.

(5) If the Office complies with the requirement referred to in paragraph (1) of this Article, the consequences of having failed to comply with a time limit shall be deemed not to have occurred, and all the decisions issued by the Office concerning the failure shall be revoked.

## Administrative fees and charges

### Article 117

The procedures prescribed by this Act shall be subject to the payment of administrative fees and charges in compliance with the special provisions.

## Certificate of priority right

### Article 118

On request of the applicant for the registration of a trademark or the holder of a trademark, and after the prescribed administrative fee and charges have been paid, the Office shall issue a certificate of priority right.

## Trademark register

### Article 119

(1) The Office shall keep the trademark register, which contains the entries in relation to national trademark applications and registrations:

1. the date of filing the application;
2. the file number of the application;
3. the date of the publication of the application;
4. the name and address of the applicant;
5. the name and business address of the representative;
6. the representation of the trademark, with indications as to its nature; and, where applicable, a description of the trademark;
7. an indication of the goods and services by their

names;

8. particulars of claims of priority pursuant to Article 37 of this Act;

9. particulars of claims of exhibition priority pursuant to Article 38 of this Act;

10. particulars of claims of seniority of a registered national trademark as referred to in Article 110 paragraph (2) of this Act;

11. a statement that the mark has become distinctive in consequence of the use which has been made of it pursuant to Article 9 paragraph (2) of this Act;

12. an indication that the trademark is a collective trademark;

13. an indication that the trademark is a guarantee trademark;

14. the date of registration of the trademark in the Register and the registration number;

15. particulars of an international trademark registration designating the Republic of Croatia that is transformed into a national application pursuant to Article 103 of this Act,

16. particulars of a European Union trademark application or registration that is transformed into a national application pursuant to Article 109 of this Act.

(2) The Register shall also contain the following entries, each accompanied by the date of recording of such entry:

1. changes in the name, address or nationality of the proprietor of a national trademark or a change in the State in which he is domiciled or has his seat or establishment;

2. changes in the name or business address of the representative;

3. where a new representative is appointed, the name and business address of that representative;

4. amendments and alterations of the trademark, pursuant to Articles 57 and 58 of this Act and corrections of errors,

5. notice of amendments to the regulations governing the use of the collective trademark, or the guarantee trademark pursuant to Article 76 of this Act, or Article 85 of this Act;

6. total or partial transfers pursuant to Article 22 of this Act;

7. creation or transfer of a right in rem pursuant to Article 25 of this Act;

8. levy of execution pursuant to Article 26 and insolvency or pre-insolvency proceedings pursuant to Article 27 of this Act;

9. the grant or transfer of a licence pursuant to Article 29 of this Act and, where applicable, the type of licence;

10. renewal of a registration pursuant to Article 56 of this Act, the date from which it takes effect and any limitations pursuant to Article 56 paragraph (6) of this Act;

11. the expiry of a registration pursuant to Article 56 of this Act;

12. declarations of withdrawal or surrender by the proprietor of the trademark pursuant to Articles 50 and 60 of this Act respectively;

13. the date of submission and the particulars of an opposition pursuant to Article 45, of a request for revocation pursuant to Article 61 or a proposal for declaration of invalidity pursuant to Articles 64 and 65 respectively or the date of submitting a claim pursuant to Article 114 paragraph (2) of this Act;

14. the date and content of a decision on an opposition pursuant to Article 50, on a request for revocation pursuant to Article 63 or a proposal for declaration of invalidity pursuant to Article 70 or a judgement on the claim pursuant to Article 114 paragraph (2) of this Act;

15. the receipt of a request for conversion of a European Union trademark application or registration into a national trademark application pursuant to Article 109 paragraph (1) of this Act;

16. the cancellation of the representative recorded pursuant to paragraph (1) point 5 of this Article;

17. the modification to or cancellation from the Register of the items referred to in points 7, 8 and 9 of this paragraph;

18. the replacement of a trademark registered via national route by an international registration pursuant to Article 106 of this Act;

19. the date and number of an international registration based on the national trademark application or registration pursuant to Article 93 of this Act;

20. the division of an application pursuant to Article 52 and the division of a registration pursuant to Article 59 of this Act, together with the items referred to in paragraph (2) of this Article in respect of the divisional registration, as well as the list of goods and services of the original registration as amended;

21. the cancellation of an entry in the Register or a publication of a trademark application or registration in order to eliminate errors and manifest oversights pursuant to Article 121 of this Act;

22. notice of amendments to the regulations governing the use of the collective trademark, or the guarantee trademark pursuant to Article 76 of this Act, or Article 85 of this Act.

(3) The proprietor of a national trademark shall be notified of any change in the Register.

(4) Any person shall be entitled to inspect the trademark register.

(5) On request of any interested person, and after the prescribed administrative fee and charges have been paid, the Office shall issue the extract and the printout from the trademark register.

(6) The processing of the data concerning the entries set out in paragraphs (1) and (2) of this Article, including any personal data, shall take place for the purposes of:

1. administering the applications and/or registrations as described in this Act and the Trademark Regulations;

2. maintaining a public register for inspection by, and the information of, public authorities and economic operators, in order to enable them to exercise the rights conferred on them by this Act and be informed about the existence of prior rights belonging to third parties;

3. producing reports and statistics enabling the

Office to optimise its operations and improve the functioning of the system.

(7) All the data, including personal data, concerning the entries in paragraphs (1) and (2) of this Article shall be considered to be of public interest and may be accessed by any third party. For reasons of legal certainty, the entries in the Register shall be kept for an indefinite period of time.

## Confidential information

### Article 120

(1) Where in the proceedings before the Office the party provides evidence that contains trade secrets and confidential information and marks them so, the Office may take necessary measures upon request of the party in order to protect trade secrets and confidential information, among other things:

- determine that the documents containing this information cannot be copied but only inspected at the Office;

- withhold the documents containing this information from inspection, unless the inspection is justified by overriding, legitimate interests of the party seeking inspection;

- determine that the documents containing this information are closed in a separate envelope that may be opened only at the Office; in this case, they will be closed in a separate envelope again with an indication that the documents were inspected, when and by whom.

(2) Before making the documents containing trade secrets and confidential information available for inspection, the Office shall warn the persons entitled to inspect the file and the documents containing this information of confidentiality obligation. The persons who inspected the file shall sign a statement of being made acquainted with confidentiality obligation.

## Correction of errors and manifest oversights

### Article 121

(1) Where the entry in the register of a trademark or the publication of an application or a registration of a trademark or the Office's decision contains a manifest error attributable to the Office, the Office shall correct the error ex officio or on request of the party.

(2) The Office shall issue a decision on cancelling the previous entry in the Register or the previous publication, or on issuing a new decision to correct such error in the previous decision and it shall publish the correction of information wrongly published.

(3) A request for the correction of errors referred to in paragraph (1) of this Article shall not be subject to payment of any administrative fee or charges.

## Search

### Article 122

On the request of any interested person, the Office shall carry out identity and similarity searches of applied for and registered trademarks having effect in the

Representation before the Office

Article 123

(1) Natural or legal persons not having a domicile or a real and effective industrial or commercial principle place of business in the Republic of Croatia may exercise rights arising from this Act in the procedures before the Office only through authorised representatives.

(2) General principles of representation and special conditions under which the persons specified in paragraph (1) of this Article may exercise rights arising from this Act shall be regulated by special regulations.

Deciding on costs of the parties in proceedings with two or more parties

Article 124

(1) In the proceedings initiated before the Office with participation of two or more parties with conflicting interests, any party, if incurred the costs, shall bear his costs in case of completing the proceedings:

1. by rejecting the party's request to initiate proceedings;

2. by suspending the proceedings due to the party's withdrawing from the proceedings initiated or due to amicable settlement of a dispute between the parties or due to the fact that legal presumptions for the proceedings to be conducted have ceased to exist during the proceedings;

3. by partial adopting the party's requests.

(2) If two-party or multiparty proceedings referred to in paragraph (1) of this Article are completed by a decision on full adoption or a decision on full rejection of the party's requests, the procedural costs shall be borne by the losing party.

(3) Procedural costs shall be decided upon by a decision on completing the proceedings.

**PART ELEVEN  
CIVIL PROTECTION**

Persons entitled to claim the protection of rights

Article 125

(1) Apart from a trademark holder, the protection of the rights under this Act may be claimed by a holder of the license to the extent that he is authorised for that purpose on the basis of a legal transaction or law.

(2) Independent of the provisions under a licence agreement, the licensee may bring proceedings for trademark infringement only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the trademark, after formal notice, does not himself bring infringement proceedings within an appropriate period.

(3) A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor of the trademark.

Article 126

(1) The holder of a trademark may institute a legal action against any person who has infringed a trademark by performing without authorisation any of the acts referred to in Article 11 of this Act, claiming establishment of the infringement, termination of the infringement, or prohibition of such and similar future infringements.

(2) The holder of a trademark may institute a legal action against any person who has by performing an act without authorisation caused a serious threat that his trademark might be infringed, claiming desistance from the act concerned and prohibition of the infringement of the trademark.

(3) The claims referred to in paragraphs (1) and (2) of this Article may also be made against a mediator who renders services used by a third party in the acts infringing a trademark or threatening to infringe it.

(4) If when importing the goods infringing a trademark the sender operates in trade, regardless if it is a matter of goods intended for commercial purposes or for personal use of a recipient, the proprietor of a trademark shall be entitled to bring action against the declarant and/or the recipient of the goods claiming establishment of trademark infringement, so that the goods may be destroyed under customs supervision in accordance with the regulations of the European Union on customs enforcement of intellectual property rights. The establishment of trademark infringement pursuant to this Article shall not affect liability of the declarant or the proprietor of goods for trademark infringement.

Claim for seizure and destruction of infringing goods

Article 127

(1) The holder of a trademark may institute a legal action against any person who has infringed a trademark by performing without authorisation any of the acts referred to in Article 11 of this Act, claiming that the court determines for the goods marked as infringing the trademark, or material and resources used to make and produce such goods, be withdrawn from the market, completely removed from the market or destroyed.

(2) The court shall order the measures referred to in paragraph (1) of this Article at the expense of the infringer, unless there are special reasons for not deciding so.

(3) Ordering the measures referred to in paragraph (2) of this Article shall not affect the right of the trademark holder to the damages incurred by trademark infringement.

(4) When ordering the measures referred to in paragraph (1) of this Article, the court shall take due care that they are proportionate to the nature and seriousness of the infringement.

Claim for damages, usual compensation and unfair profits

Article 128

(1) The holder of a trademark may take a legal action against any person who has caused him damage by performing without authorisation any of the acts referred to in Article 11 of this Act, claiming damages pursuant to the general rules and the rules pursuant to this Act.

(2) The holder of a trademark may take a legal action against any person who has infringed a trademark by performing without authorisation any of the acts referred to in Article 11 of this Act, without having basis for it in any legal transaction, court decision or the law, and has benefited from it, claiming the recovery or compensation of such benefits pursuant to the general rules on unjust enrichment.

(3) The claims referred to in paragraphs (1) and (2) of this Article shall not be mutually excluding.

(4) When determining the amount of compensation, the court shall consider all of the corresponding factors, such as negative economic consequences, including lost benefit, suffered by the injured person, any unfair profit gained by the infringer and, when deemed appropriate, elements that are not economic factors, such as non-material damage incurred to the trademark holder by performing an infringing action referred to in Article 11 of this Act.

(5) Instead of determining the amount of compensation referred to in paragraph (4) of this Article, the court may, when deemed appropriate, determine the amount of compensation against the infringer equal to the one that might be claimed if the infringer requested authorisation to use the trademark.

Claim for publication of the judgement

Article 129

(1) The holder of a trademark may claim that the final judgment even partially upholding the claim for protection of the trademark in the case of infringement is published in the means of public communication at the expense of the defendant.

(2) The court shall decide, within the limits of the claim, on the means of public communication in which the judgment shall be published, and whether it shall be published entirely or partially.

(3) If the court decides that only a part of the judgment shall be published, it shall order, within the limits of the claim, that the dispositive part of it and the part of the judgment specifying the infringement concerned and the person, having committed it, is published.

Claim for provision of information

Article 130

(1) The holder of a trademark who has instituted civil proceedings for the protection of the trademark against

infringement may claim the provision of information on the origin and distribution channels of the goods or services infringing his trademark.

(2) The claim referred to in paragraph (1) of this Article may be made against a person who has been sued in the civil proceedings referred to in paragraph (1) of this Article as a separate claim or a manifest request emphasised in a gradual legal claim.

(3) The claim referred to in paragraph (1) of this Article may be also made against:

- a person who is within his economic activities in possession of the goods suspected of infringing a trademark;

- a person who uses, within his economic activities, services suspected of infringing a trademark;

- a person who provide, within their economic activities, services used in the activities suspected of infringing a trademark; or

- a person who is indicated by any of the persons referred to in paragraph (2) of this Article, or subpoints 1 to 3 of this paragraph as being involved in the manufacture or distribution of the goods or the provision of the services suspected of infringing a trademark.

(4) The claim referred to in paragraph (1) of this Article made against any of the persons referred to in paragraph (2) of this Article shall be filed as a separate claim or a manifest request emphasised in a gradual legal action against mentioned persons as counter parties to the defendant in the civil proceedings referred to in paragraph (1) of this Article.

(5) The claim for information on the origin of the goods and distribution channels of the goods and services referred to in paragraph (1) of this Article may include among other things:

- information on the names and addresses of the producers, distributors, suppliers and other previous holders of the goods and providers of the services, respectively, as well as the intended wholesalers and retailers;

- information on the quantities produced, delivered, received or ordered, as well as the price obtained for the goods or services concerned.

(6) The person required to provide the information referred to in paragraphs (2) or (3) of this Article may refuse to provide such information on the same grounds as those allowing the refusal to present evidence as a witness pursuant to the provisions of the general regulations governing civil proceedings.

(7) If the person required to provide the information referred to in paragraphs (2) or (3) of this Article refuses to provide information without justified reasons, he shall be responsible for the damage incurred, pursuant to the provisions of the general regulations governing obligatory relations.

(8) The provisions of this Article shall be without prejudice to the provisions on the manner of use of confidential information in civil and criminal proceedings, the provisions regulating the responsibility for misuse of the right to acquire information, and the provisions regulating the processing and protection of personal



data.

### Taking of evidence in the course of the civil proceedings

#### Article 131

(1) Where a party to the civil proceedings invokes documents or other evidence determined or determinable and claims that they lie with the opposing party or a third party, or are accessible to them, the court shall invite those parties to present such documents, or evidence within a specified time limit.

(2) In the proposal to furnish evidence, the party shall make it likely that this evidence lies with the opposing party or a third party, or that they have access to it, and if the proposal is filed by a plaintiff, he shall also make it likely that his claim exists.

(3) Where the holder of a trademark as a plaintiff in a legal action claims that the infringement of a trademark has been committed on a commercial scale for the purpose of acquiring commercial or economic benefit, and has made it likely during the proceedings, and where he invokes banking, financial or similar economic documents, papers or the like evidence in the proceedings, claiming that they lie with the opposing party or are accessible to him, the court shall invite the opposing party to present such evidence within a specified time limit.

(4) Before ordering the opposing party or a third party by a decision to present evidence, the court shall invite them to submit their observations thereon.

(5) Where the party or a third party denies that the evidence lies with him or has access to it, the court may take evidence to establish such fact.

(6) The provisions of the general regulations governing civil proceedings relating to the right of refusal to present evidence as a witness shall apply mutatis mutandis to the right of the party to refuse to present evidence.

(7) When deciding on the proposal to give evidence, the court shall consider and assess interests of the party that requests taking of evidence in relation to interests of the opposing party and third parties requested to present evidence, taking into account, among other things, the interest of such parties:

1. not to disclose evidence if the related facts can be established also on the basis of other available evidence;

2. to determine evidence to the extent possible considering the circumstance of an individual case and that it be important for the proceedings;

3. that the scope and the costs incurred by taking of evidence are not so large that they are in obvious disproportion to the importance of facts intended to be established; or

4. to protect trade secrets of their own or of others.

(8) The defendant's interest to avoid the proceedings for damage or to prevent the plaintiff from winning the case shall not be a justified reason to deny furnishing of evidence to his detriment.

(9) Where taking of evidence referred to in paragraph

(3) of this Article or presenting evidence pursuant to this Article is related with certain costs incurred to a third party, the court shall invite the complainant to lodge an advance for such expenses.

(10) If the party fails to act by the court's decision ordering him to present evidence, the court shall, taking into consideration all the circumstances of the case, decide at its own discretion, on the importance of the fact that the party having the evidence refuses to comply with the court's decision ordering him to present evidence, or denies, contrary to the court's opinion, that the evidence lies with him.

(11) An appeal shall not be allowed against the decision of the court on the proposal to the parties in the proceedings to present evidence.

(12) Based on the decision ordering a third party to present evidence, the court shall, on the proposal, implement enforcement by the rules of the assurance process even before such decision becoming final.

(13) A third party shall be entitled to compensation of justified costs incurred to him related to the disclosure of evidence.

(14) A third party needs to claim the costs referred to in paragraph (13) of this Article within 15 days upon acting fully by the court's decision.

### Provisional measures due to infringement of a trademark

#### Article 132

(1) Upon the request of the holder of a trademark who makes it likely that her/his trademark has been infringed or threatened to be infringed, the court may order any provisional measure comprising the termination or prevention of the infringement, among other things:

- order the opposing party to cease or desist from, the acts infringing a trademark; the court may also issue such order against a mediator whose services are being used by a third party to infringe a trademark;

- order the seizure or turn-over of the goods suspected to be unlawfully designated by a trademark for the purpose of preventing them from being placed or circulating on the market.

(2) Upon the request of the holder of a trademark who makes it likely that his trademark has been infringed on a commercial scale in order to acquire commercial or economic benefit, and that such infringement has threatened to cause him irreparable damage, the court may, in addition to the provisional measures referred to in paragraph (1) of this Article, order also the seizure of the movable and immovable property of the opposing party, not directly related to the infringement, including the blocking of his bank accounts and other assets.

(3) For the purpose of ordering and enforcing the provisional measure referred to in paragraph (2) of this Article, the court may require from the opposing party or other relevant persons disposing with it, the communication of the banking, financial and other economic information, or the access to other relevant information and documents. The court shall ensure the

protection of confidentiality of such information, and prohibit any misuse thereof.

(4) The provisional measure referred to in paragraph (1) of this Article may be ordered without informing the opposing party thereof, if the applicant for measures makes it likely that otherwise the provisional measure would not be effective, or that irreparable damage is threatened to occur.

(5) The provisional measure referred to in paragraph (2) of this Article may be ordered without informing the opposing party thereof, if the applicant for measures makes it likely that otherwise the provisional measure would not be effective, or that, taking into consideration a very serious circumstances of the infringement, this would be necessary.

(6) If a provisional measure is ordered without informing the opposing party thereof, the court shall communicate a decision on the provisional measure to the opposing party, promptly upon its enforcement.

(7) In the decision ordering a provisional measure, the court shall specify the duration of such measure, and, if the measure has been ordered before the institution of a legal action, the period, within which the applicant for measures shall institute a legal action to justify the measure.

(8) The court shall specify the period referred to in paragraph (7) of this Article of not more than 31 calendar days from the day of communication of the decision to the applicant for measures.

(9) The provisions of this Article shall be without prejudice to the possibility to order provisional measures pursuant to other provisions of this Act, and the provisions of general regulations governing the assurance process.

#### Provisional measures comprising the preservation of evidence

##### Article 133

(1) Upon the request of the holder of a trademark who makes it likely that his trademark has been infringed or threatened to be infringed, the court may order a provisional measure comprising the preservation of evidence.

(2) By the provisional measure referred to in paragraph (1) of this Article, the court may order among other things:

- preparation of a detailed description of the goods infringing a trademark, with or without taking of samples;
- seizure of the goods made likely to infringe a trademark;
- seizure of the materials and implements used in the production and distribution of the goods made likely to infringe a trademark and seizure of the documentation relating thereto.

(3) The provisional measure referred to in this Article may be ordered even without informing the opposing party thereof, if the applicant for measures makes it likely that there is a risk of evidence being destroyed or of incurring irreparable damage.

(4) If a provisional measure is ordered without

informing the opposing party thereof, the court shall communicate a decision on the provisional measure to the opposing party, promptly upon its enforcement.

(5) In the decision ordering a provisional measure the court shall specify the duration of the measure, and, if the measure has been ordered before the institution of a legal action, the period, within which the applicant for measures shall institute a legal action to justify the measure.

(6) The court shall specify the period referred to in paragraph (5) of this Article of more than 31 calendar days from the day of communication of the decision to the applicant for measures.

(7) The provisions of this Article shall be without prejudice to the possibility of the court to order provisional measures comprising the preservation of evidence pursuant to the provisions of the general regulations governing the preservation process.

#### Financial penalty

##### Article 134

(1) The court may impose or pronounce a fine on a legal or a natural person who fails to observe any measure ordered pursuant to Articles 127, 132 and 133 of this Act.

(2) Legal persons may be imposed or pronounced the fine referred to in paragraph (1) of this Article amounting from HRK 1,000.00 up to 30,000.00.

(3) Where a fine is imposed and pronounced on a legal person, the court shall impose and pronounce the fine referred to in paragraph (1) of this Article amounting from HRK 5,000.00 up to 30,000.00 also on responsible persons in the legal person if it is established that such persons caused an offence to the legal person by an act or omission.

(4) Natural persons may be imposed or pronounced the fine referred to in paragraph (1) of this Article amounting from HRK 1,000.00 up to 30,000.00.

(5) If the person who was imposed a fine by the court pursuant to this Act fails to act as ordered, the court shall pronounce this fine on him and, if necessary, impose new fines on him and continue to pronounce them all until such person acts as ordered.

(6) If the natural person who was imposed a fine does not pay such fine within the period specified by the court's decision, such fine shall be substituted with imprisonment by the rules of the criminal law on substituting a fine with imprisonment. The sum of imprisonments substituting fines imposed on a person cannot exceed six months in total in the same proceeding.

(7) The imprisonment pronounced pursuant to the provisions of this Act shall be enforced in the manner as prescribed for the enforcement of imprisonment pronounced in criminal proceedings.

(8) The fine and the imprisonment pronounced shall be enforced by the court ex officio, and the enforcement costs shall be borne by the state budget.

(9) The fine within the meaning of the provisions referred to in this Article shall be without prejudice to

criminal liability of persons who were imposed a fine in the proceedings pursuant to this Act; however, the fine imposed pursuant to the provisions of this Act shall be included in the penalty pronounced in criminal proceedings.

(10) The court shall issue a decision on imposing a fine. The decision on imposing a fine can be appealed within three days upon receipt of the decision. The appeal to the decision on imposing a fine shall be decided by a second-instance court within eight days upon receipt of the appeal.

(11) The enforcement of the decision shall be deferred by the appeal referred to in paragraph (10) of this Article.

#### Expeditious proceedings and application of the provisions of other acts

##### Article 135

(1) Proceedings concerning trademark infringement under this Act shall be expeditious.

(2) In the procedures concerning the infringement of a trademark, the time limit for a statement of defence is eight days upon delivery of the civil action to the defendant.

(3) In the procedures concerning the infringement of a trademark, the main hearing shall be held within 30 days upon receipt of the statement of defence.

(4) The procedures concerning the infringement of a trademark before a first-instance court shall be completed within one year upon bringing a civil action.

(5) In the procedures concerning the infringement of a trademark, a second-instance court shall issue a decision on the appeal filed against a first-instance court's decision within six months upon receipt of the appeal.

(6) The decision on a provisional measure shall be issued within 30 days upon submitting a proposal to determine a provisional measure.

(7) Upon the request of the court or any of the parties to the procedure concerning the infringement of a trademark, the Office shall promptly accept a proposal for the declaration of the decision on the registration of such trademark invalid, or the request for revocation of such trademark, filed before or during the civil action and shall subject it to the expeditious proceedings. The court shall order suspension of the procedure until the decision on the proposal for the declaration of the decision on the registration of such trademark invalid has become final. The court shall, taking into consideration the circumstances of the case, decide whether it shall order the suspension of proceedings up to the final decision on the revocation of a trademark or not.

## **PART TWELVE PROVISIONS CONCERNING CONTROL AND MISDEMEANOURS**

### Control of the enforcement of the Act

#### Article 136

Inspection control of the implementation of this Act shall be carried out by inspectors and other authorised civil servants pursuant to special regulations governing competence for inspection controls in the field of intellectual property rights.

### Administrative control

#### Article 137

Administrative control of the enforcement of this Act and regulations laid down on the basis thereof shall be carried out by a ministry competent for the control of the Office's operation.

### Misdemeanour provisions

#### Article 138

(1) Any legal person shall be fined in the amount from HRK 20,000.00 up to 100,000.00 for the following acts without consent of the holder of a registered trademark:

1. if he infringes the right to a trademark in the way that he uses a sign in trade which is identical with the trademark in relation to goods and services which are identical with those for which the trademark is registered (Article 11 paragraph (2) point 1);

2. if he infringes the right to a trademark in the way that he uses a sign in trade which is identical with, or similar to, to the trademark in relation to goods and services which are identical with, or similar to, those for which the trademark is registered, if there exists a likelihood of confusion on the part of the public in the Republic of Croatia; the likelihood of confusion includes the likelihood of association between the sign and the trademark (Article 11 paragraph (2) point 2);

3. if he infringes the right to a trademark in the way that he uses a sign in trade which is identical with, or similar to, the trademark irrespective of whether it is used in relation to goods and services which are identical with, similar to or not similar to those for which the trademark is registered, where the trademark has a reputation in the Republic of Croatia and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of such trademark (Article 11 paragraph (2) point 3);

4. if he affixes the sign infringing the right to a trademark to the goods or the packaging thereof (Article 11 paragraph (3) point 1 in relation to Article 11 paragraph (2));

5. if he offers the goods designated by a sign infringing the right to a trademark, puts them on the market or stocks them for such purposes, or offers and provides services under such sign (Article 11 paragraph (3) point 2 in relation to Article 11 paragraph (2));

6. if he imports or exports the goods designated by a sign infringing the right to a trademark (Article 11 paragraph (3) point 3 in relation to Article 11 paragraph (2));

7. if he uses the sign infringing the right to a trademark as a trade or company name or part of a trade or company name (Article 11 paragraph (3) point 4 in relation to Article 11 paragraph (2));

8. if he uses the sign on business papers and in advertising (Article 11 paragraph (3) point 5 in relation to Article 11 paragraph (2));

9. if he uses the sign infringing the right to a trademark in comparative advertising in a manner that is contrary to the regulations of the European Union or the regulations of the Republic of Croatia concerning misleading and comparative advertising (Article 11 paragraph (2) point 6 in relation to Article 11 paragraph (2)).

(2) The responsible person in the legal person shall be fined for a misdemeanour referred to in paragraph (1) of this Article in the amount from HRK 5,000.00 up to 10,000.00.

(3) The natural person shall be fined for a misdemeanour referred to in paragraph (1) of this Article in the amount from HRK 2,000.00 up to 10,000.00.

(4) A natural person – a craftsman or other self-employed person, respectively, shall be fined for the misdemeanour referred to in paragraph (1) of this Article in the amount from HRK 5,000.00 to 50,000.00, where the misdemeanour has been committed in the performance of his activities as a craftsman or other self-employed person, respectively.

### **PART THIRTEEN TRANSITIONAL AND FINAL PROVISIONS**

#### Article 139

(1) The procedures which are pending on the day of this Act coming into force shall be completed in compliance with the provisions of the Trademarks Act (Official Gazette No. 173/03, 54/05, 76/07, 30/09, 49/11 and 46/18).

(2) The proposals for declaration of invalidity submitted after this Act coming into force for trademarks registered by the trademark regulations that were valid before its coming into force shall be decided upon in compliance with the provisions of the trademark regulations that were valid on the day of the trademark application.

#### Article 140

The Director General of the Office shall adopt the Trademark Regulations not later than within two months upon this Act coming into force.

#### Article 141

Until the Trademark Regulations referred to in Article 140 of this Act coming into force, the provisions of the Trademark Regulations (Official Gazette No. 117/07, 66/11, 125/13 and 43/17) shall apply.

#### Article 142

On the day of this Act coming into force, the Trademarks Act (Official Gazette No. 173/03, 54/05, 76/07, 30/09, 49/11 and 46/18) shall cease to be valid.

#### Article 143

This Act shall enter into force on the eighth day from the date of its publication in the Official Gazette.