

**STATE INTELLECTUAL PROPERTY OFFICE OF THE  
REPUBLIC OF CROATIA**

**TRADEMARK EXAMINATION GUIDELINES**



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## CHAPTER I

### INTRODUCTION AND LEGAL FRAMEWORK

#### 1.1 Introduction

The purpose of the Trademarks Examination Guidelines is to provide support to trademark examiners and other users of the intellectual property system in interpreting the Trademarks Act and the implementing regulations.

Every Chapter contains instructions for examiners concerning what actions are to be taken. However, the application of the Guidelines should not be followed blindly. Each case or trademark application, respectively, must be considered on its own merits, taking into account all the relevant factors and in particular, the goods or services, which are the subject matter of the trademark application.

Although the Guidelines are to be applied consistently, they do not cover all the possible situations. Consideration of particular cases by the Office or judicial practice is expected to lead to the development of the Office's practice. The Guidelines will consequently be revised or updated.

The examiner shall issue a decision on the grant or preliminary refusal of a trademark application in compliance with decisions issued by the European Court of Justice (hereinafter: ECJ). He shall also take into account decisions issued by the EU General Court (hereinafter: GC), the European Union Intellectual Property Office (hereinafter: EUIPO) and other national Offices, but such decisions shall not be crucial for a decision on the registration of a trademark. The Guidelines are citing relevant judgments, and indicating several registered or refused trademarks based on decisions issued by the State Intellectual Property Office, the EUIPO, the ECJ and the GC.

#### 1.2 Legal Framework

In the territory of the Republic of Croatia the acquisition and protection of rights under trademark is provided under the Trademarks Act (OG 173/2003, 76/2007, 30/2009, 49/2011) and Trademark Regulations (OG 117/2007, 66/2011, 125/2013).

Trademark granting are administrative proceedings carried out by the State Intellectual Property Office of the Republic of Croatia (SIPO). The Act on General Administrative Procedure (OG 47/2009) (hereinafter: AGAP) shall apply to any procedural matters not regulated under the Trademarks Act and Trademark Regulations.

The administrative fees in the field of intellectual property rights are prescribed under the Law on the Administrative Fees in the Field of Intellectual Property Rights (OG 64/2000, 160/2004, 62/2008, 30/2009, 49/2011). Special charges and costs arising from the supply of information services of SIPO are laid down under the Regulation on Special Charges and Charges for Information Services Provided by SIPO (OG 109/2011, 96/2013).

Representation in the field of intellectual property rights is regulated under the Act on Representation in the Area of Intellectual Property Rights (OG 54/2005, 49/2011, 54/2013) (hereinafter: the Act on Representation).

The Republic of Croatia is a party to the Madrid Agreement Concerning the International Registration of Marks (Official Gazette – International Agreements No. 12/2008) and the Madrid Protocol relating to the Madrid Agreement Concerning the International Registration of Marks (Official Gazette – International Agreements Nos. 13/2003, 18/2003, 12/2008) enabling filing of requests for the international registration of trademarks through WIPO (World Intellectual

Property Organization), on the basis of the application/registration of a trademark in the Republic of Croatia and filing of requests for extension of the protection to the Republic of Croatia of internationally registered trademarks. The proceedings related to forwarding of applications for the international registration are not covered under these Guidelines and shall be introduced subsequently. Requests for the extension of protection of international registrations to the Republic of Croatia shall be examined in relation to the absolute and relative grounds for refusal, in the same way as trademarks applied for in the national procedure.

## CHAPTER II

### RECEIPT OF APPLICATIONS AND FORMALITIES EXAMINATION

#### 2.1 Receipt of Application

An application for the registration of a trademark shall be filed to the State Intellectual Property Office (hereinafter: the Office).

An applicant may, by filing one application request registration of one sign only for which trademark protection is sought. (Article 14 of the Trademarks Act, hereinafter: the Act).

An application may be filed by personal delivery directly with the Receiving Office or sent to it by post or facsimile or by an e-mail via the web site: e-Application.

Where the application is filed directly or sent by facsimile, the date on which the Office has received such an application, shall be considered as its filing date, provided its compliance with the basic requirements have been established (see paragraph 2.2.1). If the Office questions the completeness or authenticity of an application filed by facsimile, the applicant shall be ordered by a conclusion to communicate to it the original of the application within 30 days from the receipt of the conclusion (Article 34 of the Trademark Regulations, hereinafter: the Regulations).

Where an application is filed by registered mail, the date marked on the envelope shall be considered as the filing date of the application. Where the delivery was made by regular mail, the date of its receipt by the Office shall be considered as its filing date (Article 72 paragraph 2 of the Act on General Administrative Procedure).

Where an application or subsequent documents are filed by e-mail (hereinafter: e-Application), upon establishing that the basic requirements are fulfilled, the date of an automatic verification of the applicant's advanced electronic signature shall be considered as the filing date.

After the entry of data in the Office database, the application for the registration of a trademark shall enter the phase of formalities examination, in order to establish its compliance with the legal requirements for the acquisition of the application status, grant of priority right based on the filing date, and other prescribed requirements to be complied with before submitting the application to substantive examination.

#### 2.2 Accordance of a Filing Date of an Application

##### 2.2.1 Requirements (Article 15 of the Act)

For the accordance of the filing date of an application for the registration of a trademark, the application shall contain:

1. a request for the registration of a trademark,
2. indications concerning the applicant,
3. a list of the goods or services for which the registration is requested,
4. a representation of the sign of which the registration is requested.

A request for the registration of a trademark (point 1), and indications concerning the applicant (point 2) form part of the Application for the Registration of a Trademark Form (Ž-1). A request for the registration of a trademark and indications concerning the applicant may also be



presented on the form corresponding to the contents of the Ž-1 Form. The list of the goods and services shall be filed with the application, on a separate sheet. In case of an e-Application, the list of goods services for which the registration is requested shall be created by using a **harmonised database TMclass** (ref. to paragraph 3.2).

It is not necessary that the list of the goods and services (point 3) be properly classified in order to accord a filing date. The presence of the list is the minimum requirement. Regardless of the way of filing an application, it is recommended to select TMclass terms, which provides for accuracy and order of the list of the goods and services and speeds up the registration procedure.

It is essential that a representation of the sign (point 4) be present for the accordance of a filing date. Only a description of the sign shall not be sufficient. At this point, the representation of the sign needs not to fulfill the requirements of reproduction. Changes of the sign not fulfilling the requirements of reproduction shall be possible only in terms of clearness and colour of the sign.

### 2.2.2 Remedy of Deficiencies (Article 22 of the Act)

If the formalities examiner finds that there are deficiencies related to the aforementioned requirements, the Office shall inform the applicant that the filing date of the application has not been accorded and shall order him by a conclusion to remedy the deficiencies within a period of 60 days upon receipt of the conclusion. The date of receipt of the corrected application shall be considered to be the date of accordance of the filing date or the priority right, respectively. The applicant may request that such period be extended for not more than 60 days. If the applicant fails to comply with the requirements within the given time limit, the Office shall reject the application.

### 2.3 Additional Requirements

In addition to the aforementioned requirements, the formalities examiner shall, before submitting an application to the substantive examination procedure, establish whether the application contains the following (Article 2, paragraph 1 of the Regulations):

1. a request for the registration of a trademark,
2. the name and address of the applicant,
3. the name and address of the representative, if the applicant has a representative,
4. indication of the classes of the goods or services for which registration is requested,
5. indications concerning the priority claimed, if the priority is claimed,
6. a representation of the sign of which the registration is requested,
7. an indication that the registration of the verbal sign is requested, if the registration of the verbal sign is requested,
8. an indication that the registration of the figurative sign is requested, if the registration of the figurative sign is requested,
9. an indication that the registration of the three-dimensional sign is requested, if the registration of a three-dimensional sign is requested,
10. an indication that the registration of the sign consisting of one colour or a combination of colours is requested, if the registration of the sign consisting of one colour or a combination of colours is requested,

11. an indication that the registration of other type of a sign is requested, if the registration of other type of a sign is requested,
12. an indication that the registration of the sign in colour is requested and the names of the colours claimed as distinctive features of the sign, if the registration of the sign in colour is requested,
13. a transliteration of the sign, if the sign contains elements written in characters other than Latin characters or numerals other than Arabic or Roman numerals,
14. an indication that the registration of the collective trademark is requested, if the registration of the collective trademark is requested,
15. an indication that the registration of the guarantee trademark is requested, if the registration of the guarantee trademark is requested,
16. the signature or the seal of the applicant, or the signature or the seal of his representative.

The applicant may specify these indications on the Form established by the Office (Ž-1), or on the form corresponding to the contents of the Ž-1 Form.

In addition to the abovementioned, the applicant shall also file: (Article 2, paragraph 3 of the Regulations)

1. a list of the goods or services for which the registration is requested;
2. evidence of the priority right, if the priority is claimed;
3. a contract on a collective or guarantee trademark, if the registration of the collective or guarantee trademark is requested;
4. evidence of the payment of the prescribed fee and procedural charges.

In the application for the registration of a trademark, the applicant may also indicate a description of a sign and its translation into Croatian.

### 2.3.1 Applicant (Article 3 of the Act)

Any natural or legal person may be the applicant for the registration of a trademark. A special attention has to be paid to whether the applicant has legal capacity (for example, where the state administration bodies file an application, the applicant has to be the Republic of Croatia). One of the organizational forms not having legal capacity is a family farm, and in that case, the applicant may only be a natural person, namely the owner of a family farm. If the applicant is e.g. "M.BIZ" firm, i.e. the type of the company that cannot be obviously established (e.g. joint stock company, limited partnership, etc), the examiner shall establish that the firm is not one of the companies (in accordance with Article 13 paragraph 2 of the Companies Act, OG 111/93, 34/99, 121/99, 52/00, 118/03, 107/07, 146/08, 137/09, 152/11, 111/12, 144/12, 68/13) and shall invite the applicant to file evidence of its legal capacity. If the applicant fails to file necessary evidence, the application shall be rejected. If the applicant is a foreign legal person, and the examiner doubts its legal capacity, he shall invite the applicant to file evidence of its legal capacity, in accordance with the law applicable by the State of its origin.

If foreign persons are concerned (legal and natural persons) not having a principal place of business or a domicile or a habitual residence, in territory of the Republic of Croatia, they shall, under the Act, enjoy the same rights as are enjoyed by the Croatian nationals, if it results from the international treaties binding the Republic of Croatia or from the application of the principle of

reciprocity, provided that they have a representative (see paragraph 2.3.2).

An application may be filed by several applicants, irrespective of whether they are natural or legal persons, and, in such a case, they shall be co-holders of a trademark. When establishing compliance with the requirements in respect of one of the applicants, the same criteria shall be applied in respect of all the applicants (e.g. if the exemption from payment of the administrative fees and procedural charges has been requested, all of the applicants shall comply with the requirements for the exemption. The exemption for payment shall not apply to only one of the applicants.

#### 2.3.1.1 Applicant's Name and Address (Article 32 of the Regulations)

If the applicant is a natural person, he has to indicate his given name and family name, street, house number, postal code, place and the State in which he has its domicile. Legal persons have to indicate the firm or the name, street, house number, postal code, place and the State in which they have a real and effective industrial or commercial principle place of business.

Where several applicants are indicated, they may designate a common representative to receive communications. If a common representative is not indicated, only the address mentioned first (or the applicant mentioned first) in the application shall be taken into account for communications, except where another address is indicated as address for correspondence. The same shall apply where several addresses are indicated, i.e. the address mentioned first shall be taken into account, except where address for correspondence is indicated.

Additional contact indications such as a telephone number, a facsimile number, or an e-mail address are not required, but may be indicated to facilitate communication.

#### 2.3.2 Representative

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 shall appoint a representative to represent them in all the procedures before the Office. The Act on Representation in the Area of Industrial Property Rights (OG 54/2005, 49/2011, 54/2013) shall apply.

If the application in such a case is filed without indication of a representative, the Office shall invite the applicant to appoint a representative. Failing this, the application (request) shall be rejected pursuant to the Act on Representation.

Natural or legal persons having a domicile or a real and effective industrial or commercial principle place of business in the Republic of Croatia are not required to appoint a representative, but they may do so.

***The Office does not give advice concerning the choice of representative, but it will furnish the applicant, upon request, a list of all the representatives registered by the Office.***

##### 2.3.2.1 Representative's Name and Address (Article 32 paragraphs 2 and 4 of the Regulations)

If the representative is a natural person, his given name and family name, street, house number, postal code, place and the State in which he has a domicile, have to be indicated. For legal persons, the firm, street, house number, postal code and place have to be indicated.

If several addresses of the representative are indicated, the address mentioned first shall be taken into account, except where address for correspondence is indicated.

##### 2.3.2.2 Power of Attorney

Representatives shall submit their power of attorney. A power of attorney may refer to one or

more applications or registrations (the so called special power of attorney), or to all the existing and future applications or registrations (the so called general power of attorney). The power of attorney may be limited to specific actions, which the representative is authorised to take in the procedure pending before the Office (Article 7 of the Act on Representation).

Where a person refers to himself in a submission filed with the Office as a representative, and the Office does not have the power of attorney appointing him as a representative, the Office shall ask such person, and also the party concerned, if the Croatian applicant is concerned, to provide the power of attorney within a period of 2 months (in compliance with the Act on Representation). If the person fails to submit the required power of attorney to the Office within the said period, the Office shall reject the submission concerned by a decision. ***A two-month period for filing a power of attorney may not be extended.***

If the person submitting the power of attorney or the person referring to himself as a representative fails to comply with the mentioned invitations, it shall be considered that a representative has not been appointed, and the application shall be rejected, unless the applicant, who is a Croatian resident, pursues the case by himself.

A representative shall be considered appointed until the grantor (the applicant) recalls its power of attorney. Pursuant to the Act on Representation, if several general powers of attorney are issued by the same grantor, the most recently issued power of attorney shall prevail, i.e. two general representatives of the same grantor may not practice simultaneously.

### 2.3.3 Indication and List of the Goods and Services (Article 2, paragraphs 1 and 2, and Article 10, paragraph 1 of the Regulations)

The classes of the goods and/or services for which the registration is requested shall be indicated on the application form. In addition to the mentioned indication, the applicant shall also file a list of the goods and/or services on which the goods and/or services shall be precisely indicated and grouped in conformity with the classes of the International Classification of Goods and Services established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter: the Nice Classification, see abbreviated version of the 10<sup>th</sup> edition). Each class shall be marked by the number of the class of the Nice Classification. The applicant shall, whenever possible, use the terms and expressions appearing in the Alphabetical List of Goods and Services of the Nice Classification.

***The requirements concerning the list of the goods and services are defined in more detail in Chapter III – Classification.***

### 2.3.4 Priority Right

The applicant may claim union priority right, or exposition priority right, which shall be indicated in the application form, and shall furnish evidence of the priority right. Unless the priority right requirements are met (as provided under 2.3.4.1 and 2.3.4.2), the date of filing the application with the Office shall be considered as the priority date, and the Office will proceed with the application.

#### 2.3.4.1 Union Priority Right (Article 18 of the Act)

The applicant may claim priority right if he has filed for the first time an application for the same trademark in a Member State of the Paris Convention for the Protection of Industrial Property (the States having acceded to this Convention constitute the so called Paris Union), or in a Member State of the World Trade Organisation (hereinafter: WTO). In such a case, the application shall be filed in the Republic of Croatia within six months from the date of the first filing.

The applicant shall indicate in the application the relevant data on the application he is invoking - State, date and number of the application, and shall furnish a true copy of the first application certified by the competent authority of the Member State of the Paris Union or the Member State of the WTO not later than within three months from the date of filing a priority claim, and the translation of the first application into Croatian.

The Office shall not accept an uncertified true copy of the first application, a true copy received by facsimile, or a printout from the Internet, as evidence of the right of priority. Exceptionally, the Office shall accept a printout from the web site of EUIPO of a certified true copy of the first application filed for the registration of a CTM trademark (a Community trademark) as evidence of the right of priority.

The indications contained in the first application shall be identical with the indications contained in the application filed in the Republic of Croatia. The Office shall examine whether the signs contained in both applications are identical, whether the lists of goods and/or services contained in both applications are identical, or whether the list contained in the application filed in the Republic of Croatia is contained in the first application.

With establishing the priority right, trademarks must be the same in the strictest possible sense, and the examiner shall point out to any difference in the appearance of trademarks. Therefore, regardless of technological differences or requests for colour indication, a trademark registered in black-and-white shall not be considered identical with the same trademark in a specific colour, taking into consideration priority right claims. Nevertheless, if the differences in colour are so insignificant for an average consumer to notice them, trademarks shall be considered identical (for details refer to the Common Communication on the Common Practice of the Scope of Protection of Black and White Marks of the European Trade Mark and Design Network).

In addition to the above mentioned, with the protection of 3D signs, 6 representations of the sign can be enclosed to the application (Article 5 paragraph 2 of the Regulations); in this case, all the representations enclosed shall be identical or contained in the first application. It should be mentioned that all representations of the sign enclosed to the application serve solely for the purpose of clearly showing three-dimensionality of the sign presented in the space provided for that purpose on the application form.

The Office shall also examine whether the applicant of both applications is the same. If such requirements have been complied with, the Office shall grant the union priority right.

The applicant may also claim **partial** priority right, i.e. priority for part of the goods and/or services contained in the first application, which are identical with those contained in the application filed in the Republic of Croatia, or for part of the goods and/or services contained in the application filed in the Republic of Croatia, if they are contained in the first application. Priority for the rest of the goods and/or services shall be the date of filing of the application with the Office.

The applicant may also claim multiple priorities, i.e. priority for the goods and/or services contained in the application filed in the Republic of Croatia, if the goods and/or services are contained in several different earlier applications filed in any of the Member States of the Paris Union or a Member State of the WTO.

#### 2.3.4.2 Exposition Priority Right (Article 19 of the Act)

The applicant may claim priority right if he has displayed the goods or services designated by a specific sign at an official or officially recognized international exhibition in the Republic of Croatia, in any of the Member States of the Paris Union or in any of the Member States of the WTO. In such a case the application shall be filed in the Republic of Croatia within six months as from that date.

The applicant shall, in addition to the application he is filing with the Office, submit a certificate issued by the competent authority of the Member State of the Paris Union or the Member State of the WTO indicating the type of the exhibition, the venue thereof, its opening and closing dates and the first day of the exhibition of the goods or services specified in the application, as well as the fact that the goods or services, designated by a sign for which the priority is claimed have been displayed at that exhibition.

### 2.3.5 Indication and Representation of a Sign

The applicant shall indicate whether a verbal, a figurative, a three-dimensional sign, a sign consisting of one colour or a combination of colours or other type of a sign is concerned in the space provided for that purpose on the application form (Article 2 paragraph 1 of the Regulations).

#### 2.3.5.1 Verbal Sign (Article 3 of the Regulations)

A sign that consists only of letters, numerals, punctuation marks, and other special signs that are standard key of the Qwerty keyboard or their combinations and a sign that is not in any special graphic presentation or colour shall be considered to be a verbal sign. A verbal sign shall be machine typed or printed on the application form within the space provided for that purpose.

Accordingly, a sign shall be considered to be a verbal sign even if part of it is formed by punctuation marks (e.g. ?, !), symbols such as parentheses, quotation marks etc., as well as other characters contained in the keyboard, and even if such symbols may change its pronunciation and meaning (e.g. @, €, \$). If part of a sign is intended to be bold or put into bigger font size, it shall be considered to be a figurative sign. Signs written in the characters other than Latin characters shall be considered figurative signs (e.g. Chinese characters will be figurative signs), even if transliterated.

#### 2.3.5.2 Figurative Sign (Article 4 of the Regulations)

If the application requests registration of a sign which consists of a certain visual expression, and it is not stated that the registration is requested for any other type of signs, the sign shall be considered to be a figurative sign. A sign consisting only of numerals, letters etc., which, as such, could also be a verbal sign, but where the protection is sought for particular additional element (bold, italic, another font, writing of parts of the sign in two rows and the like), it is also a figurative sign. A figurative sign shall be represented on the application form within the space provided for that purpose. If the registration of a sign in colour is requested, the application shall contain a representation of the sign in colour, and indication of the colours for which protection is requested.

#### 2.3.5.3 Three-dimensional Sign (Article 5 of the Regulations)

A three-dimensional sign shall be represented on the application form within the space provided for that purpose. If the applicant requests the registration of a three-dimensional sign the application shall be accompanied by a photograph or a drawing of a representation of a sign; the application may be accompanied by **not more than six** different views of a representation of a sign from different perspectives, the representations being of the same sign. The representation of a three-dimensional sign shall clearly show its three-dimensional character. Where a three-dimensional sign is represented by a drawing, the reproduction shall be executed in uniformly black and clearly defined lines without blurs. The drawing may contain hatchings and shadings to represent more completely three-dimensional details.

A three-dimensional sign may include a verbal part as part of the sign. However, when the verbal part of a sign is put below the three-dimensional sign, the sign is not a three-dimensional sign, but figurative.

#### 2.3.5.4 Signs Consisting of one Colour or of a Combination of Colours (Article 6 of the Regulations)

If the application requests the registration of a sign consisting of one colour or of a combination of colours, the colours shall be listed and described in the application along with the relevant colour mark from the internationally recognized system of colour identification (according to the judgment delivered by ECJ in the “Libertel” case, C-104/01).

Where a sign consisting of a combination of colours is concerned, the reproduction must also contain a systematic order of colours in accordance with the previously determined and identical manner (according to the judgment delivered by ECJ in the “Heidelberger” case, C-49/02).

#### 2.3.5.5 Other Types of Signs (Article 7 of the Regulations)

If the application requests the registration of another type of a sign, the application shall state the type of the sign, and depending on the type of the sign shall be accompanied by a graphical representation of a sign, which is clear, precise, self-contained, easily available, durable and objective (according to the judgment delivered by ECJ in the “Sieckmann” case, C-273/00).

#### 2.3.5.6 Other Requirements Concerning the Representation of a Sign (Article 8 of the Regulations)

The reproduction of the sign shall be of such quality, form and colours that enable the elements of the sign to be clearly distinguished in all their details. The representation of the sign shall not be pasted over and shall be free from deletions and over colouring. The representation of the sign shall fit within the space provided for that purpose on the application form (square of 8 x 8 cm) and the distance between the two points of the sign farthest from each other (vertically, horizontally, and in diameter) shall not be less than 1,5 cm.

The representation of a sign shall not contain ® marking, since it shall be used only with trademarks which are registered. The Office shall itself remove such marking from the sign, without changing the representation of the sign, if possible. If not, the Office shall invite applicant to do so.

#### 2.3.5.7 Attachments to the Application (Article 9 of the Regulations)

The application for the registration of a trademark shall be accompanied neither by samples nor by objects on or in which the signs for which registration is requested would be present. Objects so submitted shall be returned to the applicant, and in case that their return would not be possible, they shall be destroyed at the expense of the applicant, prior to the publication of the application for the trademark registration. Processing of the application shall not be resumed until the objects are not seized or until the costs of their destruction are not paid.

#### 2.3.6 Transliteration of a Sign (Article 2, paragraph 1 item 13 of the Regulations)

The applicant shall file a transliteration of the sign, if the sign contains elements written in characters other than Latin characters, or numerals other than Arabic or Roman numerals.

#### 2.3.7 Collective Marks (Article 53 of the Act)

Any sign within the meaning of Article 2 of the Act, which is indicated as such in the application for the registration of a trademark, and which is capable of distinguishing the goods or services of the members or partners of a certain legal person from the goods or services of other undertakings, and which is intended for collective designation of the goods or services put on the market by the members or the partners of that legal person, may be protected as a collective mark.

If the applicant applies for the registration of a collective mark, he shall file with the application a contract on a collective mark (Article 57 of the Act). The contract shall contain the following:

- the list of names of the persons authorized to use the collective mark
- the conditions of membership
- the conditions governing such use
- provisions relating to the infringement of rights in the case of misuse of the collective mark, or the breach of the provisions of the contract.

#### 2.3.8 Guarantee Mark (Article 54 of the Act)

Any sign within the meaning of the Article 2 of this Act, which serves to designate the quality, origin, manner of production, or other common characteristics of the goods or services may be protected as a guarantee mark. The holder of a guarantee trademark is not authorised to independently use the guarantee mark, but to approve and supervise such use in relation to the undertakings authorised to use it pursuant to the Contract on a Guarantee Mark.

The applicant for a guarantee mark shall furnish a contract on a guarantee mark with the application.

The applicant must specify whether he applies for the registration of a collective mark or a guarantee mark. It will be checked, in particular, whether the fees and charges for a collective or a guarantee mark have been paid in double amount.

#### 2.3.9 Signature (Article 33 of the Regulations)

A signature on communications may be a handwritten or a stamped signature (or a seal and a signature, when a legal person is concerned).

#### 2.3.10 Fees and Charges (Article 69 of the Act)

For the procedures prescribed by this Act, the applicant shall pay fees and procedural charges in compliance with the special provisions, and shall submit evidence of such payments. The fees and charges for examination of the applications for collective and guarantee trademarks shall be paid in double amount.

The charges for examination of the application shall be reduced by 20% in relation to a due amount if the application is filed electronically.

As evidence of payment, the applicant may submit: the original of a payment slip, a copy of the payment slip, e-payment receipt. With regard to e-payment receipt, the date of transaction, and not the date on which the receipt is issued, is relevant. The Office shall examine whether the transaction has been effected within the time limit prescribed by law.

If the applicant fails to pay fees or charges within the time limit prescribed by law, the application or request shall be rejected.

#### 2.3.11 Description of a Sign and Translation (Article 2, paragraph 4 of the Regulations)

The applicant may, but is not required to, indicate a description of a sign and its translation in Croatian in the application.

#### 2.3.12 Remedy of Deficiencies (Article 22 of the Act)

If the application does not comply with the abovementioned additional requirements, the Office shall invite the applicant to remedy the deficiencies within 60 days, allowing him the possibility to extend this period for additional 60 days. If the applicant remedies the deficiencies within the



given time limit, the application shall be considered correct from the beginning. If he fails to do so, the application shall be rejected.

## 2.4 General Procedural Provisions

### 2.4.1 Communication (Articles 85-95 AGAP)

The communication of files is not specifically prescribed under the Trademarks Act and the Act on General Administrative Procedure shall apply to this matter.

As a rule communication of documents is effected to the addressee. At SIPO it is made by mail, as a rule.

Where a party has a representative, a delivery shall be effected by the representative. Any representative having an office post-box at SIPO, the documents shall be communicated to the addressee via the office post-box.

The communication shall be deemed regular, where a receipt of the effected delivery, i.e. delivery note, carrying a handwritten signature by the recipient/addressee and by a deliveryman. A delivery note shall have a clearly indicated date of receipt, as a rule a handwritten signature by the recipient. Where the recipient refuses to sign a delivery note or the deliveryman does not find the recipient/addressee at the indicated time, the deliveryman shall leave the document in his mailbox or another place visible to the recipient/addressee and indicate it accordingly by handwritten delivery date in letters, and the delivery shall be deemed effected. Time limit shall begin on the first day following the date of the effected delivery.

Where pending proceedings before SIPO, the change of the place of residence or establishment of a party or his representative occurs, such a change shall be communicated to SIPO. In case of failure to act, any subsequent communication under proceedings for this party shall be made by an announcement on the office notice-board at SIPO. In such a case delivery shall be deemed effected upon the expiry of eight days following such announcement.

Where pending proceedings before SIPO, the change of the place of residence or establishment of the attorney at law failing to notify SIPO occurs, communication shall be effected, so as if the attorney at law has not been nominated, if a Croatian applicant is concerned. If a foreign applicant is concerned, the communication will be delivered by diplomatic channels.

Where a delivery note is missing from the file, communication may be evidenced otherwise. Where a delivery note is missing from the file, and communication may not be evidenced otherwise, such documents shall be redelivered. Where following the second redelivery the relevant evidence is missing, communication shall be effected by announcement on the office notice-board at SIPO.

Where during communication an error was committed, delivery shall be deemed effected on the day of the effective day of receipt of the document by the addressee.

### 2.4.2 Time Limits (Articles 72; 79-81 of the AGAP)

Time limits for the pursuit of individual activities under proceedings are provided under the Trademarks Act and Trademark Regulations. Time limits for any matter not provided under the Trademarks Act and Trademark Regulations, time limits provided under the Act on General Administrative Procedure shall apply. General provisions concerning time limits are laid down under Articles 79-81 of the Act on General Administrative Procedure. Time limits may be specified under law or any other provisions (legal time limits); or time limits may be fixed by an official person in charge to conduct the proceedings, given the circumstances of the case.

Time limits may be fixed by days, months or years. Where time limits are fixed by days, the initial day shall be deemed the first day following the effected delivery. Time limits fixed by months or

years shall end by the expiry of the day, month or year complying by the number with the day of the effected delivery. Where the last month has no such date, the time limit shall expire on the last day of such month (for example: where the time limit is three months and the initial date thereof is August 31, the time limit shall expire on November 30).

Where the last day of the time limit is Sunday or a public holiday, or a day, which is not a working day of the authority for the pursuit of the activities, the time limit shall expire on the expiry of the first subsequent working day.

The submission shall be filed on time where received before the expiry of the time limit. Where the submission was sent by registered mail or by telegraph, the filing day to SIPO shall be deemed the filing date of the post office stamp (Article 72 AGAP).

The time limits specified by legal provisions may be extended upon request of the interested person, if such a possibility is provided for, if the request is filed before the expiry of such time limit, if there are justified reasons for such an extension, and if the prescribed fees and charges have been paid. The same shall apply to the time limits specified by an official person.

#### 2.4.3 Restitutio in Integrum (Article 82 AGAP)

By failure to pursue certain activities, provided that a certain justified reason for such failure existed, the applicant may claim for restitution subject to the provisions under the Act on General Administrative Procedure. It is essential for the applicant to file the claim for restitution within three months following the expiry of such time limit at the latest (an objective time limit) and within eight days after the reason for failing the time limit ceased to exist (a subjective time limit). Restitutio in integrum may be requested only during a procedure, and not after the conclusion of a procedure by the final decision. The Office shall consider the reasons for the pursuit of such activity of natural persons, such as disease or absence on official duties. Where legal persons are concerned, such reasons do not, as a rule, constitute the reason for restitutio in integrum. The applicant shall at least make probable the mentioned reasons that hampered the pursuit of his activities.

The applicant shall pay the prescribed fees and procedural charges with such claim and concurrently pursue the activity, which was omitted.

The Office shall issue a decision concerning the claim for restitutio in integrum.

Following the time limit of three months from the date of failure, the claim for restitution may not be filed. Where the time limit for claiming restitution is failed, the applicant may not file the claim for restitution due to the failure of deadline.

If a request for restitutio in integrum is filed before the Office has rejected the application due to failure, the Office shall first reject the application, and then decide on the restitutio in integrum, accepting it, if the request is well founded.

#### 2.4.4 Consultation of Documents and Notifications Pending Proceedings (Article 84 AGAP)

The parties are entitled to consult the documents of the file within the premises of the Office and copy the required documents against payment under the supervision of the responsible official. Any other person is entitled to consult the documents and to copy the required document against payment, provided that such person makes probable legal interest therefore. An oral request may be placed to consult and to copy documents. The person filing the request may be required to submit to the Office the grounds for the existence of legal interest in writing or by verbal minutes/records.

The Office may refuse the files to be consulted or copied (e.g.: there are no grounds given as to public interest, the documents contain classified information where the purpose of the

proceedings might be obstructed, or where they are contrary to public interest or reasonable interest of the party or third persons.

Any party and any other person, who makes likely to have legal interest in a case, including interested State bodies, shall have the right to exchange information during the procedure.

#### 2.4.5 Continued Processing (Article 36a of the Act)

In proceedings before the Office, in spite of failing to pursue an activity with a direct consequence of causing the loss of rights conferred by the application for trademark(s) registration, the applicant or the holder of a trademark may file a request for continued processing within two months upon learning about legal consequences of the activity which was omitted. The request filed within the prescribed time limit, in relation to the activities with a possibility of continued processing against payment of the prescribed fees and procedural charges for continued processing eliminates adverse legal consequences of omitting an activity and all the decisions and conclusions made by the Office concerning the failure shall be revoked and the procedure shall be continued as if there were no failure at all.

Unlike the procedure of requesting restitutio in integrum that already exists pursuant to the Act on General Administrative Procedure, the reason of failure needs not to be given or justified.

The request for continued processing cannot be filed for failing the time limit for the following pending activities: for recognition of the Union or the exhibition priority right, for filing a request for trademark registration renewal, for filing a request for continued processing, in relation to the activities in procedures with several parties participating, for filing a request for restitutio in integrum, for filing an appeal against decisions made by the Office in the first instance.

## CHAPTER III

### CLASSIFICATION

#### 3.1 Procedure

After establishing that the trademark application complies with the basic requirements for the accordance of a filing date, the list of the goods and services shall be referred to the examiner in charge who shall examine its compliance with the Classification in force and the common practice of national trademark offices of the European Union, and if necessary, amend it so that it conforms to the mentioned Classification and practice.

#### 3.2 General Rules

The goods or services, which are the subject matter of an application for the registration of a trademark, shall be classified pursuant to the Nice Classification. (Article 16 of the Act).

The Classification of Goods and Services serves exclusively for administrative purposes, and any goods or services shall not be considered as being similar only on the ground that they appear in the same class of the Nice Classification (Article 10, paragraph 2 of the Regulations). Consequently, goods and services may be similar even if they are not classified in the same class.

With filing an application for trademark registration, the list of goods and services needs to contain the class number and the individual name of goods and/or services from a specific class. With filing a trademark application in paper, and in order to deliver an orderly alphabetical printout of goods and/or services within a specific class, it is recommended to use terms from the Croatian TMclass version, a harmonised database of goods and services classification of the European Union Intellectual Property Office (EUIPO), through search on the web site of the Office or the EUIPO.

In case of filing an e-Application, the list of the goods and services requested to be protected by a trademark is created by using a **harmonised database TMclass incorporated in the system of e-Application for a trademark**.

The TMclass tool contains a harmonised database of valid indications of goods and services for the applicant to compile a correct list of the goods and services in compliance with the practice of other EU offices. By using a TMclass, the registration process is made easier and shorter.

#### 3.3 Importance of the List of Goods and Services

The list of goods and services define the scope of the rights granted by registration, in the case of the infringement thereof. A trademark shall be used for all the goods and services for which it is protected; the trademark may be revoked for those goods and services for which it is not actually used, regardless of the classification of goods and/or services being correct or incorrect.

Protection of advertising services including one's own goods and/or services is frequently applied for. However, advertising is not considered to be a service where it concerns advertising of one's own goods and/or services but only where it is provided to third persons (for example, if coffee is concerned, it shall be sufficient to protect it in class 30, because it also implies that the applicant advertises it, whereas its protection in class 35, comprising advertising, would mean that advertising for third persons is performed under such trademark).

### 3.4 Examination of the List of Goods and Services

When checking the list, the examiner shall apply provisions of the Act and the Regulations, as well as the established practices, in particular, the practices as contained in these Guidelines, in order to ensure that all the examiners achieve the same result in respect of the same list.

It is important for goods and services indications to be sufficiently clear and precise to enable a clear determination of the protection scope of a trademark. It is important to be guided by correct punctuation so that indications are separated from one another by a semicolon (e.g. fruit beverages; sparkling water; beer in class 32). A comma is used for several categories to be enumerated within the same indication (e.g. marzipan, nougat, honey and chocolate sweets in class 30).

Unless the meaning of an indication is sufficiently clear and precise to enable a clear determination of the protection scope in a designated class, it needs to be clarified by additional characteristics such as the intended purpose or a marketing sector of goods and/or services (e.g. an indication *bag* is precise enough for class 18, but it needs to be specified in class 9 as a *bag for laptops* or in class 28 as a *bag adapted for sports equipment*). With retail, wholesale and similar services in class 35 (e.g. commerce, electronic, i.e. e-commerce, commerce by post), it is necessary to indicate products or groups of products (e.g. *electric house appliances, furniture, food products* and the like) which these services refer to.

The examiner in charge shall accept the use of the class headings. According to the established practices, the indications “services not covered by other classes” or “all goods in class X” shall not be acceptable.

If the list of the goods and services contains the class headings of the Nice Classification, the protection scope comprises only the goods and/or services arising from literal and unambiguous meaning of the term from a heading (for details please refer to the Common Communication on the Implementation of “IP Translator” case, v.1.2).

If the applicant wishes to comprise all or a part of the goods and/or services within a particular class in the application, all goods and/or services within that class of the Nice Classification that the applicant wishes to comprise in the protection scope need to be listed alphabetically.

11 out of hundred and ninety seven general indications of the class headings of the Nice Classification are considered to be lacking clearness and precision for the specification of the protection scope they provide; therefore, effective as of 1 January 2014, they cannot be accepted without further specification (for details please refer to the Common Communication on the Common Practice on the General Indications of the Nice Class Headings v.1.2 and the Common Communication on the Common Practice on the Acceptability of Classification Terms v.1.0).

The examiner in charge consults the TMclass database and the Alphabetical List of Goods and Services of the Nice Classification to examine the classification of each and every good and/or service.

### 3.5 Correction of the List of Goods and Services

When examining the list of goods and services, the examiner in charge checks whether the goods and/or services are classified in appropriate classes, and whether the list is clear and precise and whether the indication term of a good and/or a service is unambiguous pursuant to the Common Communication on the Implementation of “IP Translator” case, v.1.2. Precedence shall always be given to the terms appearing in standard, or specialized technical dictionaries. However, the terms not appearing in any of the mentioned dictionaries shall be accepted, if the applicant gives the appropriate explanation of the mentioned good or service.

After the application has been filed, it is not permitted to extend the scope of the list of goods and/or services because it would mean that the application is amended in terms of an extension. Where the applicant has incorrectly classified particular goods and/or services, and their classification in the correct classes extends the number of classes, this does not mean that the list itself has been extended. For example, an application covering wines and tobacco in Class 33 will be corrected, and wine will be put into Class 33, and tobacco into Class 34. Although the number of classes has been extended, the list itself has not.

If necessary, the Office shall invite the applicant to remedy deficiencies, i.e. to correct the list in accordance with the Classification in force and the Common Communication on the Common Practice on the General Indications of the Nice Class Headings (see paragraph 2.3.12 Remedy of Deficiencies).

For the list of goods and services up to three classes, the applicant shall pay the amount of the administrative fees and procedural charges as fixed. For each additional class, he shall pay charges in the amount as fixed. In the case of extension of the number of classes, resulting from the correction of the list, the applicant shall pay additional charges for the number of classes as extended, or may withdraw certain classes to leave the original number of classes.

The applicant may amend the list of goods and services contained in the application in the prescribed time limit, provided that the mentioned amendment comprises restriction of the goods and services, the explanation thereof in more detail, but in no way the extension thereof or the change of the class.

### 3.6 Restriction of the List of Goods and Services

The applicant for the registration of a trademark may at any time restrict the list of goods or services contained in the application. It actually concerns surrender of a trademark in respect of such goods and services. In the case the application has already been published, the mentioned restriction shall be published in the Office official gazette later on. Such a restriction shall not be subject to payment of the administrative fee / procedural charges (Article 11 of the Regulations).

## CHAPTER IV

### SUBSTANTIVE EXAMINATION (ABSOLUTE GROUNDS)

#### 4.1 General – Procedure

After it has been established that the application complies with all the formality requirements, the application enters the phase of substantive examination or the examination as to absolute requirements, respectively.

Each sign shall be considered on its own merits, taking into account, in particular, the representation of the sign and goods and/or services for which registration is applied for. Decisions shall be consistent, to ensure equal treatment of all the applicants. When making decisions, the examiner shall consult dictionaries containing general terms and dictionaries containing technical terms, encyclopaedia, the Internet, and where necessary, other available sources.

The examiner shall issue a decision on the grant or preliminary refusal of a trademark application in compliance with the ECJ decisions. He shall also take into consideration GC, EUIPO decisions and decisions issued by other national offices, but such decisions are not decisive when issuing decisions on the trademark registration. EUIPO is competent in deciding on granting protection to the Community trademark pursuant to the provisions of the Council Regulation (EC) No. 207/2009 on the Community Trademark. Compliance of legal regulations on trademark protection with *acquis communautaire* of the European Union does not imply replacement of national legislation with the European regulations in the field of trademark protection due to the territorial principle. Granting protection to a trademark in the territory of the EU is taken into consideration with making a decision on granting protection to an identical or a similar trademark in the territory of the Republic of Croatia. However, the decision on granting trademark protection in the Republic of Croatia is always based on implementing the provision from the Trademarks Act. The Office's practice in implementing these provisions is conditioned by specific features of the market of the Republic of Croatia.

If, in the phase of substantive examination, the examiner finds any absolute grounds for refusal, he shall issue a notification on the preliminary refusal in respect of all or a part of the goods and services applied for. The examiner shall clearly indicate factual and legal basis for his decision, in order that the applicant, or representative, is able to submit observations concerning the examiner's decision.

#### 4.2 Absolute Grounds (Article 5 of the Act)

##### 4.2.1 Graphical Representation of a Sign and Absolute Distinctiveness (Article 2, Article 5 paragraph 1, item 1 of the Act)

A sign shall comply with the requirements referred to in Article 2 of the Act to be protected as a trademark; otherwise it shall not be protected. According to the aforementioned, any sign capable of being represented graphically, **particularly** words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, three-dimensional forms, colours, as well as the combinations of all the above indicated signs, may be protected as a trademark, provided that such signs are capable of distinguishing the goods or services of one undertaking from goods or services of another undertaking.

In compliance with Article 2, no sign shall be automatically excluded from the possibility of registration. The signs mentioned are examples that represent those that are most frequently used by undertakings to designate their goods or services (the so called conventional signs). However, this list does not exclude the possibility of registering other signs. To conclude, the

signs which are not expressly indicated may be protected as a trademark, provided they comply with the requirements referred to in this Article.

When examining this absolute ground, the examiner shall establish whether the sign applied for complies with two basic trademark pre-requirements: that it is capable of being represented graphically and that it is capable of distinguishing.

### **Graphical Representation of a Sign**

The Office shall accept primarily drawings, written signs or photographs as satisfactory graphical representation of a sign. The abovementioned does not exclude other types of representations, provided that they allow a non-visible sign to be perceived visually.

The judgment delivered by ECJ in the “Sieckmann” case (C-273/00) set requirements for the graphical representation of non-visible signs. Such signs shall be represented graphically by means of images, lines or characters, provided the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. When establishing the compliance of a sign with a graphical representation requirement, the examiner shall assess whether the representation complies with the mentioned requirements.

Where an **olfactory sign** is concerned, the Office will not accept the following representations:

- chemical formula – due to its non-intelligibility owing to which the odour concerned cannot be readily recognized;
- a description in words is not sufficiently clear, precise and objective
- the deposit of a sample which is not durable.

Where a **sound** is concerned, the Office shall accept a graphical representation determining the pitch and duration of the sound. Such a representation is constituted by a musical notation on the corresponding music paper, or represented on a staff divided into bars and containing a clef, musical notes and rests, as well as accidentals (sharps and flats) (according to the judgment delivered by ECJ in the “Shield” case C-283/01).

In addition to a musical notation, the applicant can enclose a sound database of a sound filed in an e-Application. The sound database without the musical notation does not meet a legal requirement of a graphical representation of the sign and consequently prescribed requirements to determine the filing date (refer to item 2.2.1).

In respect of signs applying for protection of a **colour or combination of colours**, the Office shall accept the description of a colour together with a sample in colour, indicating a designation of the colour using an internationally recognized identification code. The applicant need not limit the colour applying for protection to the object to which it will be applied. This will permit the possibility of protecting the signs consisting of colours even for services (according to the judgment delivered by ECJ in the “Libertel” case, C-104/01).

However, when the protection of combination of two or several colours is applied for, the representation, to be acceptable, shall define the proportion in which each of the colours is used in relation to the other, and the arrangement in which the colours appear (according to the judgment delivered by ECJ in the “Heidelberger” case C-49/02). The Office will refuse signs applying for the protection of two or several colours “in any proportion” or “in any possible combination”.

A graphical representation of a three-dimensional sign shall comply with the content referred to in 2.3.5.3 and 2.3.5.6. The Office will not accept a description in words as adequate graphical representation. A photographic reproduction or a graphical representation of different perspectives of the sign is required. The protection of 3D sign applies to the full, three-



dimensional form, and not to individual representations of different perspectives of the sign.

### **Signs Capable of Distinguishing the Goods or Services**

The second basic requirement contained in the definition of a trademark is that the sign shall be capable of distinguishing goods and/or services of one manufacturer from goods and/or services of other manufacturers. The examiner will have to establish abstract distinctiveness, or distinctiveness, which is not examined in relation to the goods and/or services for which the protection has been applied for, but the fact whether a sign can possibly perform the function of a trademark.

The Office shall consider the signs such as indications of dates on goods, bar codes, secret or hidden signs as signs absolutely devoid of distinctive character, i.e. signs that in no case can act as trademarks. For instance, a consumer will always perceive a bar code on goods as a bar code and not as a sign associating goods with a particular manufacturer. Such signs cannot acquire distinctiveness on the market based on a long-standing use.

#### **4.2.2 Distinctive Character (Article 5 paragraph 1, item 2, of the Act)**

A sign, which is devoid of distinctive character in relation to the goods or services for which registration is applied for shall not be registered.

Within the framework of this absolute ground, the examiner shall assess distinctive character of a sign applied for in relation to the goods and/or services for which the protection with such sign has been applied for. The examiner shall assess a distinctive character considering the sign in its entirety, without dissecting it, and assessing the distinctiveness of its individual elements.

The distinctiveness of a sign is defined as being able to perform the basic function of a trademark, to identify the origin of the goods or services thus enabling the consumer to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent use (according to the definition of the GC in the "LITE" case, T-79/00). A sign devoid of distinctive character per se, may acquire it by the use (see paragraph 4.3 for evidence of acquired distinctiveness).

Descriptive signs (elaborated under paragraph 4.2.3 Descriptiveness of Signs) shall also be considered to be devoid of distinctive character. This absolute ground shall also constitute legal basis for the preliminary refusal of descriptive signs. However, a sign may be devoid of distinctive character even if not consisting exclusively of descriptive terms.

The distinctive character may be achieved by adding figurative or other elements that are distinctive. Minimum level of distinctive character may be achieved by use of ornamental or decorative typefaces, dependant on the level of stylization, which will be established by the examiner in each case individually. The use of standard typefaces does not contribute to the achievement of distinctiveness. The Office shall consider that distinctive character has not been achieved merely by misspelling, substitution of letters by a symbol, writing of abbreviations according to their pronunciation or the like. Signs consisting of several elements, which are non-distinctive per se may acquire distinctive character by their combination, but such a combination of non-distinctive elements, depending on the circumstances of the case, does not necessarily lead to the distinctiveness of the sign, in particular, if made according to grammatical rules or in a conventional manner.

##### **4.2.2.1 Distinctiveness in Relation to Certain Categories of Signs**

When assessing distinctiveness of certain categories of signs, the examiner shall take into account different perception of consumers in relation to different categories of signs, or the fact that the consumer will perceive three-dimensional forms, colours, slogans or unconventional trademarks as packaging, marketing messages or the like, rather than as trademarks.

### Signs Consisting of a Single Letter or a Single Numeral; Punctuation

With signs consisting of a single letter represented in standard characters, it needs to be established whether such signs can serve to differ certain goods and services from one another (confirmed in the judgement delivered by ECJ in the 'α' case, C-265/09 P). When assessing the same, a special attention has to be paid to the possible meaning of a letter in relation to certain goods and/or services applied for, owing to which the sign might be descriptive. For example, the Office shall refuse a sign consisting of the letters S, M or L for clothing, because such letters designate clothing sizes, and the letter L designates driving school. This applies in relation to signs consisting of a single numeral, e.g. No. 7 in relation to footwear would be non-distinctive, because it can designate size.

Punctuation marks such as *full stop*, *comma*, *question mark*, etc. have no distinctive character at all, i.e. consumers will not perceive them as a designation of commercial origin of certain goods and services. Distinctiveness can be achieved by additional distinctive elements, figurative or verbal ones.

#### **Non-distinctive signs:**

L.

(for driving school services)



#### **Distinctive signs**



(in relation to clothing under class 25)



### Combination of Two or More Letters/Numerals

A sign consisting of a combination of two or more letters and/or numerals may have distinctive character, and will be examined like any other sign in relation to the goods and/or services applied for. The Office shall refuse a sign, which represents a standard abbreviation, or has any other descriptive meaning (indicating time, measures, etc.) in relation to the goods and/or services applied for, being essential whether the specialized public recognizes it or not. It is not necessary that the general public understands the abbreviation. The Office shall refuse a sign consisting of an abbreviation, if the abbreviation has several meanings, and at least one of the meanings is non-distinctive in relation to the goods and/or services applied for.

Just as in the case of one letter or numeral, distinctive character may be achieved by adding figurative elements. The examiner shall assess for each case individually sufficiency of such elements for achieving distinctive character.

#### *Non-distinctive signs:*

# 24

A sign 24 is non-distinctive in relation to services, because it is descriptive: it denotes the time of rendering services (services rendered 24 hours a day).

# TDI

A sign TDI is an abbreviation for Turbo Diesel Intercooler. The sign is not acceptable in relation to cars.

#### *Distinctive sign:*

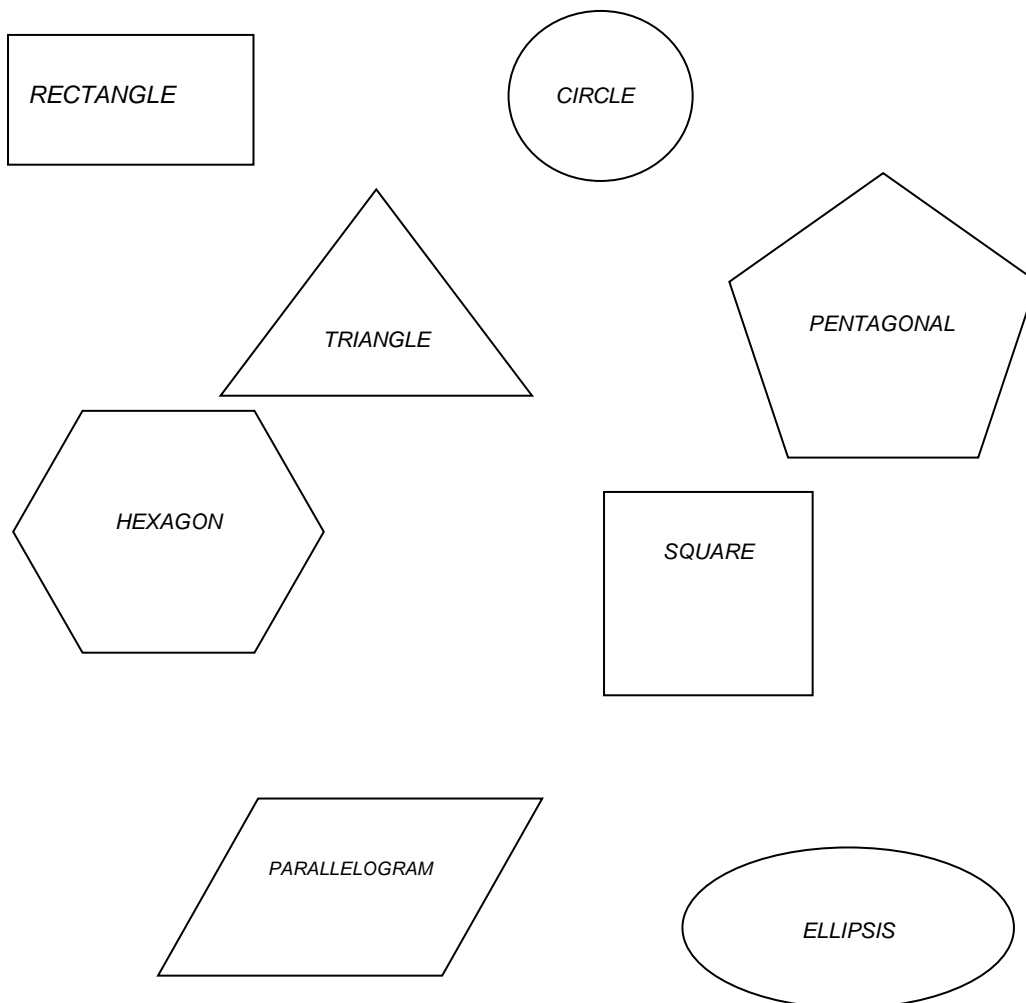
# ABC

A sequence of three letters ABC in relation to the goods indicated in class 2 (paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists) has distinctive character. The above indicated sequence has no special meaning in relation to the mentioned class.

### Simple Geometric Forms

The Office shall refuse simple geometric shapes, such as a circle, a square, a rectangle, a triangle, especially if used as frames, on the ground of non-distinctiveness, since due to their simplicity a consumer would not be able to perceive them as a trademark. When examining the signs consisting of such shapes, the examiner shall take into account the use of figurative elements, the use of colours, and general perception of such a sign in terms of performing the function of a trademark.

Simple geometric shapes (the list is not final):



## Slogans

When examining distinctive character of a slogan, the examiner shall take into account the fact that average consumer will perceive slogans primarily as an advertising message and not as an indication of the origin of a product or as a trademark, respectively (according to the judgment delivered by ECJ in “Das Prinzip der Bequemlichkeit” case, C-64/02). The examiner shall establish whether a slogan has primarily an advertising function, and whether it describes the manufacturer’s policy, qualities or other special characteristics of the goods and/or services, or describes them, respectively. The Office shall refuse such slogans. Slogans which are ordinary and banal and which directly describe characteristics of the goods or services, are not distinctive, and therefore will be refused. The examiner shall establish whether distinctiveness of a sign is achieved by use of various linguistic and stylistic techniques (unusual syntax, alliteration, rhyme, paradoxes, a play on words).

The Office shall consider as distinctive a slogan that is not distinctive per se, if it contains an element, which is distinctive per se. Such elements may be the name of a product, or a manufacturer’s logo, as contained in the slogan.

**Examples:****JEDNO MJESTO, BROJNE MOGUĆNOSTI (ONE PLACE, NUMEROUS POSSIBILITIES)**

The indicated slogan is an advertising message, and consumer would not perceive it as a trademark. The slogan is not distinctive, and therefore has been refused by the Office.

**POVJERENJE POVEZUJE (TRUST IS BONDING)**

The indicated slogan is an advertising message and is non-distinctive in relation to financial services.

**MORE OKUSA U OKUSU MORA (SEA OF TASTES IN THE TASTE OF SEA)**

Using unusual syntax and play on words this sign is removed sufficiently far from any advertising function. This sign is distinctive in relation to food (the sign is registered with SIPO).

**Signs Containing Misspellings**

The Office shall not consider as distinctive the signs that contain misspellings of descriptive terms, achieved by the replacement of letters, replacement of letters by symbols, writing of abbreviations that are the phonetic equivalent. The abovementioned has been established in the LITE case (see paragraph 4.2.2). The sign LITE has been refused on the ground of non-distinctiveness. The pronunciation of a sign "LITE" is identical with the pronunciation of a term "LIGHT" in English, which has descriptive character in relation to foodstuffs (food that is light in calories, fat). With regard to the fact that the sign, due to its misspelling, does not consist of the "exclusively" descriptive term, the ground for refusal is not descriptiveness of the sign, but its non-distinctiveness. When establishing distinctive character, the examiner shall assess whether the sign is unusual, and striking, and whether such elements have achieved removal from the descriptive element of the sign.

In the case of abbreviated forms of a word that is the phonetic equivalent of that word, and in the case of misspelled words, the examiner shall also take into account whether the abbreviation is usual (due to influences of slang language or the like). Abbreviations, such as XTRA, XPERT are usual, and the Office shall refuse them as non-distinctive. If the abbreviated word results in an unusual and striking sign, the Office shall establish whether the sign has distinctive character.

**Compound Words**

When examining compound words consisting of descriptive terms, the examiner shall establish whether a sign consisting of them removed in its entirety far from the basic descriptive terms, or descriptive character, respectively. The combination itself of two descriptive terms according to the linguistic and grammatical rules leaves the sign non-distinctive in its entirety (e.g. a sign COMPANYLINE, despite the fact that such a compound is invented). Minimum requirements for such removal have been set in the judgment delivered by GC in the BABY-DRY case, T-163/98. It is considered that the way in which the words DRY and BABY are put together is not usual. While the term DRY BABY (as well as dry-baby) would be descriptive, it is considered that the inversion of words and writing with a hyphen is not a usual joining of two terms; therefore such word would never be formed in the language. Therefore, the Office shall consider this sign as distinctive.

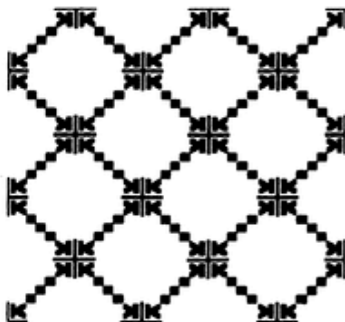
### Personal names

The Office shall register personal names as distinctive, regardless of their frequent occurrence (according to the judgment delivered by ECJ in the “Nichols” case, C-404/02) or their usual use in designating particular goods or services (e.g. in fashion industry). However, the Office shall refuse a sign, if the examiner establishes that a personal name has at the same time a meaning that is descriptive and non-distinctive in relation to the goods and/or services applied for.

### Pattern (as decoration for clothing and the like)

A sign consisting of the representation of a pattern in relation to particular goods, e.g. in class 25 (clothing, footwear, headgear) has decorative purpose, and is not capable of distinguishing goods of different undertakings. The Office shall refuse a sign, if the examiner establishes that the main purpose of pattern in relation to the goods applied for is just decoration.

*Example:*



A sign consisting of the representation of a pattern in relation to classes 18 and 25 has pure decorative function, and therefore is not distinctive.

### Figurative Signs

When examining stylized words or figurative signs of descriptive character, the examiner shall take into account a level of descriptiveness, as well as overall impression achieved by stylization of a sign or by figurative elements. Thus, the Office shall, for example, consider a figurative representation of vegetables in relation to vegetables as non-distinctive (see the example below).

*Example:*



Although the sign is figurative, it has direct descriptive character in relation to vegetables. The Office has refused the sign on the ground of non-distinctiveness.



The above-represented sign, although containing figurative elements, has very descriptive character in relation to beverages, and is considered by the Office as non-distinctive.

#### 4.2.2.2 Special Categories of Signs

##### **Colours**

When examining signs consisting of colours, the examiner shall take into account the fact that consumers are not used to perceive colours as trademarks, and that signs consisting of a single colour or a combination of colours (colours *per se*) require higher level of distinctiveness for registration.

##### **– A Sign Consisting of a Single Colour (colour per se)**

The Office shall refuse a sign consisting of a single colour on the ground of non-distinctiveness, except under special circumstances. The Office shall consider that such special circumstances comprise a colour of a special and unusual shade used for designation of particular goods or services, which are not usually designated by colours (according to the judgment delivered by ECJ in the “Libertel” case, C-104/01).

##### **– Combinations of Colours**

The examiner shall assess distinctive character of signs consisting of a combination of two colours on their own merits in relation to the goods and/or services claiming trademark protection.

When examining a sign consisting of a combination of colours, the examiner shall establish whether the graphic representation complies with the mentioned requirements (see paragraph 4.2.1 – graphic representation of a sign).

If a combination of two colours is concerned, and one of the colours is the usual colour for the good and/or service, the examiner shall assess distinctive character of the sign on the basis of the additional colour, and most frequently, ground for refusal as of a single colour will apply. For example, white is the natural and usual colour of washing tablets, and the addition of a layer of any other colour does not mean that sufficient distinctive character has been acquired.

*Example:*



The Office shall examine any sign claiming protection of a single colour or a combination of colours in compliance with the careful analysis of the goods and services claiming trademark protection, and the situation on the market. The sign shall be refused if any of the colours:

- represents merely a decorative element of the goods or comply with the consumer's request (e.g. colours for cars or clothing);
- indicates merely the nature of the goods (e.g. blue colour of ink);
- is descriptive or technically functional (e.g. colours used for electric cables);
- if a colour contained in a combination of colours is usual or generic in relation to goods and services (e.g. red for fire extinguishers; yellow for postal services);
- indicates particular characteristics of goods such as a taste (e.g. yellow for lemon taste, green for apple taste);
- a colour combination shall be refused, if the existence of the colour combination can be proved on the market, in particular if used by several undertakings (e.g. if we can prove that the colour combination red and yellow is used by various undertakings on juice packaging)

**Examples:**



As mentioned, a colour “per se” is devoid of distinctive character, except in special cases. Consequently, the Office has refused red colour in relation to all the goods and services



The Office has also refused a sign consisting of a combination of two colours, green and ochre in relation to honey. The sign was refused on the ground of non-distinctiveness. Namely, the two colours are descriptive in relation to the mentioned product. The green colour usually designates environment friendly manufacture, while the ochre colour usually designates honey.

**Three-dimensional forms**

When examining signs consisting of three-dimensional forms, the examiner shall establish whether such sign on its own merits may function as a trademark, taking into account the fact that such signs require higher level of distinctiveness, since it has been established that consumers are not used to perceive shapes of products as trademarks (according to the



judgment delivered by ECJ in joint Procter & Gamble cases, C-468-472/01 P).

Three-dimensional forms may be grouped in three categories:

- shapes unrelated to the goods/services themselves
- shapes representing the shapes of the goods
- shapes representing packaging or containers

**Shapes unrelated to the goods and/or services themselves** have distinctive character (e.g. a star sign on Mercedes).

When examining **shapes representing the shapes of products**, the examiner shall take into account the above mentioned, and shall, in compliance with the same, carry out the process of establishing distinctiveness of a sign applied for.

The examiner shall first of all establish whether the absolute ground for refusal referred to in Article 5, paragraph 1, item 5 of the Act is present, because it excludes any possibility of providing evidence of acquired distinctiveness.

According to the mentioned Article it shall be established whether a sign consists exclusively of:

- the shape which results from the nature of the goods as such
- the shape of goods which is necessary to obtain a technical result
- or the shape which gives substantial value to the goods

– **Shape that Results from the Nature of the Goods**

When examining whether the shape of the goods results from the nature of the goods themselves, the examiner shall examine whether the shape is the natural one or other characteristic shape of the goods concerned. For example, the Office shall refuse the shape of a lemon in relation to fruit, or the shape of a ball in relation to a ball. Here, the natural shapes of goods are concerned, and consequently, detergents, fruit juices etc., as liquids, do not possess natural shape. Only the shapes of their packaging (see below) may be considered non-distinctive.

– **Shape of Goods Necessary to Obtain a Technical Result**

For the application of this ground for refusal it is not necessary to establish whether the same technical result might be obtained in any other way (according to the judgment delivered by ECJ in the “Philips” case, C-299/99). The examiner shall establish whether the essential (main and required) elements of the shape may be attributed exclusively to functionality and technical result. If this has been established, this ground for refusal shall apply even if additional arbitrary elements exist, provided that they are not distinctive per se.

– **Shape that Gives Substantial Value to the Goods**

When establishing this ground, the examiner shall establish whether a shape has an exclusively aesthetic function which has no connection with the commercial value of the goods. The examiner shall assess this by comparing such shapes with the shapes of competitive goods (according to the judgment delivered by ECJ in the “Philips” case, C-299/99, see above).

Further to the examination of a sign as to the absolute ground set out above, the examiner shall establish whether the three-dimensional form has distinctive character per se. As mentioned

above (according to the judgments referred to), the examiner shall take into account that distinctive character of such a sign is rather difficult to establish, since its perception by the general public differs from such perception of verbal or figurative signs (according to the judgment delivered by ECJ in the “Maglite” case, C-136/02).

In addition to the above mentioned, when assessing distinctiveness, the Office shall consider that a shape consisting of a basic geometric form or of a combination of basic geometric forms is devoid of distinctive character (e.g. basic geometric form of washing tablets). The Office shall also refuse simple and banal shapes for their non-distinctiveness.

According to the judgment delivered by ECJ in the “Maglite” case, C-136/02 (see above), it has been established that the more closely the shape as examined resembles the shape itself of the product in question, the greater likelihood is that it is not distinctive. The examiner shall establish whether the shape departs from the shape that is expected by the consumer. In addition to this, a shape shall significantly depart from standards or customs of the sector. The Office shall refuse a sign, if its shape represents only a variant of a common shape or a variant of a number of existing shapes, even where there is a huge difference in designs.

So, the examiner shall assess whether the shape is so materially different from basic, common or expected shapes that it can enable a consumer to identify a product just by its shape and to buy it again after having previous positive experience with it.

If existence of any ground referred to in Article 5, paragraph 1, item 5, or non-distinctive character has been established, the examiner shall establish whether such a shape contains a significant visible element as distinctive per se (verbal or figurative). In such a case, the shape may achieve sufficient distinctive character, and the Office shall register such a sign.

When examining distinctiveness of **packaging/containers** the examiner shall establish whether a three-dimensional sign, representing packaging/containers is materially different from a combination of basic and customary elements, and whether it is unusual (striking). Apart from the above mentioned, the examiner shall take into account the functional character of such elements.

The examiner shall assess distinctiveness in relation to a particular market. He shall take into account the fact that e.g. perfumes are distinguished on the market by their bottles, while such perception by consumers of packaging as trademarks in relation to cleaning products is rather difficult. When assessing distinctiveness in relation to the goods incorporated in packaging, the examiner shall also take into account the time of purchasing the goods.

The Office shall consider as distinctive a sign consisting of a representation of standard packaging, having a significant visible element, which is distinctive per se.

If it is questionable whether the shape consists of a product or packaging, the Office shall refuse the sign on the ground of non-distinctiveness, and not on this absolute ground.

**Examples:**



Bottles - the two signs as presented above are standard containers. As mentioned before, during examination, account shall be taken of the fact that containers of cleaners are hardly perceived by consumers as trademarks. The Office has refused these signs because distinctive character achieved by the application of green and red colours was not sufficient. The examiner has taken into account that the colour is usual for packaging, and in addition to that, it is descriptive (e.g. green as environment friendly and the colour of an apple etc.).



Although identification by the shape of bottle is usual on the perfume market, this simple shape is not sufficiently distinctive (refused by EUIPO).



The shape of the bottle as shown above is usual on the market of strong and soft drinks, and is not distinctive as such. Distinctiveness of the sign may be achieved by adding an element that is distinctive per se, e.g. if such a bottle had a distinctive label, the shape with such a label on it would have sufficient distinctive character.



Such bottle shape with stylistically convex circular shape of the upper part of the bottle, having no functional character, is not usual in relation to products in class 3 (bleaching preparations and products for cleaning), i.e. the mentioned shape gives it sufficient distinctive character.

#### 4.2.3 Descriptiveness of a Sign (Article 5, paragraph 1, item 3 of the Act)

A sign shall not be registered if consisting **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 services, or to designate other characteristics of the goods or services.

This Article shall apply where a sign consists exclusively of indications describing the goods or services applied for, or where they describe basic characteristics of such goods or services.

As mentioned before, a sign, which is descriptive, is at the same time non-distinctive, and the ground for refusal, in addition to the one referred to in Article 5, paragraph 1, item 3, shall also be non-distinctive character of the sign referred to in Article 5, paragraph 1, item 2. However, if a sign, in addition to the “exclusively” descriptive term contains certain distinctive elements, it shall not be descriptive, but the examiner may establish that such additional elements do not give it sufficient distinctiveness, and that the sign is non-distinctive and as such refused.

The term “exclusively” relates to additional distinctive elements that a sign may contain, and not to the single meaning of the sign. For example, a compound word Doublemint may have several meanings in relation to chewing gums. It may mean chewing gums with intensified peppermint flavour or with two different peppermint flavours. The examiner shall establish that at least one of the possible meanings in relation to the goods and services is descriptive. In such a case the sign shall be refused. This principle has been established by the judgment delivered by ECJ in the “Doublemint” case, C-191/01 P.

The examiner need not prove that such descriptive sign has already been in use, but this absolute ground shall apply provided that the sign might be used in relation to the goods and services applied for. It results from the part of the provision “may be used” (according to the judgment delivered in the “Doublemint” case, C-191/01 P, see above).

The examiner shall not take as relevant the fact that there are existing synonyms or other words that express descriptive meanings (according to the judgment delivered in the “Biomild” case, C-265/00).

The examiner need not prove that the need or actual interest to use such descriptive term exists or will exist in the future (according to the judgments delivered by ECJ in the “Chiemsee”, C-108/97 and C-109/97 and “Postkantoor”, C-363/99 cases). Apart from this, the examiner need not establish whether the manufacturer is the only one to produce such goods or to provide such services in relation to which the sign is descriptive, but in this case the possibility of proving the acquired distinctiveness shall exist.

To apply descriptiveness as the ground for refusal, a descriptive term must affect the consumer's decision to purchase a product. The Office shall not refuse for their descriptive character signs evoking any of the characteristics of the goods and/or services, namely the characteristics that do not affect the consumer's purchasing choice (e.g. "Poison" for perfumes).

#### 4.2.3.1 Examination of Descriptive Character in Relation to Particular Categories of Signs

##### **Compound Words**

If a compound word consists of a combination of elements, which individually and in their entirety describe characteristics of the goods and services, the Office shall consider that the sign in its entirety has descriptive character in relation to such characteristics. The examiner shall consider that a combination of such elements lacking unusual syntax variation or new meaning results in descriptive character of a sign. The same shall apply in the case of neologisms consisting of elements, which are individually descriptive, except in the case of introduction of unusual combination, which will result in a term, which is "more than a sum of elements" (according to the judgment delivered by ECJ in the "Biomild" case, C-265/00). In the "BIOMILD" case, the sign was refused in relation to yoghurt, because it described it as biological (bio) and mild. In this category, the Office shall consider various prefixes and suffixes, which in principle describe a term to follow, such as BIO, ECO, EURO, as non-distinctive.

The examiner shall establish whether the introduction of an unusual combination (not complying with the linguistic and grammar rules) has achieved distinctive character of a sign. Minimum requirements to that effect have been set in the judgment delivered by CFI in the BABY-DRY case, T-163/98 (see paragraph 4.2.2.1).

When examining compound words, the examiner shall establish the existence of the usual and obvious understanding of a sign. The examiner need not establish that a term is used in dictionaries, but that the invented term of descriptive character is arranged in compliance with the grammar rules. This has been established in the judgment delivered in the "Doublemint" case C-191/01 P, and in the judgments delivered by ECJ in the "Postkantoor" case, C-363/99, and "Univeresaltelefonfonbuch", C-326/01. The "Postkantoor" (post office) sign shall be considered as descriptive in relation to marketing, insurance and building services, due to the fact that although it is not descriptive in relation to the mentioned services at this moment, the possibility that such services will be provided in the post office in the future may not be excluded.

In the case of "Univeresaltelefonbuch" (universal directory book) sign, although a word as such doesn't exist, it is essential to take into account that it is reasonably foreseeable that the relevant public will associate the sign with the characteristics of the product in the future.

##### **Example:**

PLINOBROD

##### **Abbreviations**

When examining abbreviations, it is not sufficient to prove that it consists of descriptive terms, but the examiner shall establish that the use of an abbreviation is usual, or understood by relevant specialists. If an abbreviation is accepted by relevant specialists, the examiner need not establish its understanding by the general public.

If the examiner cannot establish actual, and not only assumed, descriptive function of an abbreviation, or if there is many possible meanings, which cannot be associated directly with the abbreviation, the Office shall register the sign.

### Misspelled Words

It is considered that misspelled words have a particular distinctive element, and even if the examiner establishes descriptive character the Office shall not refuse a sign on this absolute ground, but on the absolute ground of non-distinctiveness (see paragraph 4.2.2.1).

**Example:**

**Coffe2go**

### Figurative Signs

The Office shall not refuse a descriptive figurative sign that includes an insufficiently distinctive element, which itself is not descriptive on this absolute ground, but on the ground of insufficient distinctiveness (see paragraph 4.2.2.1).

**Example:**



An exclusively descriptive figurative sign shall be considered as descriptive, and shall be refused on this absolute ground (e.g. the image of a coffee bean for coffee). A figurative sign, such as the image of coffee, containing also the word coffee shall also be refused on the ground of descriptive character.

**Example:**



#### 4.2.3.2 Terms Referred to in the Provision on Descriptiveness

##### Kind

The examiner shall establish whether a sign designates the goods or services themselves, and the type or nature of the goods or services (e.g. the Office shall refuse the verbal sign BANK in relation to financial services, and a figurative representation of bread in relation to bread).

## **Quality**

The Office shall not register terms indicating quality of the goods or services – e.g. excellent, super, ideal, ultra, the best in relation to all the goods or services, unless a sign containing such words is distinctive on the ground of an additional verbal or figurative element. When examining compounds, the examiner shall assess whether a sign in its entirety deviates from the description of quality. For example, a compound “ULTRAPLUS” lacks descriptive character, since it does not contain a term in relation to which one of the terms “ultra” or “plus” would be descriptive. In combination, the sign has no meaning, and it does not indicate any characteristics or quality of the product.

## **Quantity**

The examiner shall establish whether a sign consists exclusively of indications of quantity used in the sale of goods, e.g. one litre for drinks, 100 grams for chocolate, etc. In relation to such signs the Office shall consider as relevant for refusal only the indications or measures actually used in trade and not the measures for which it is presumed that could indicate quantity.

## **Intended Purpose**

The examination shall be carried out in relation to the indications, which describe the function of the use of particular good or service. In compliance with the opinion concerning the “New Born Baby” case, C-498/01 the mentioned term has not direct descriptive character in relation to toys. However, such sign is directly descriptive in relation to the intended purpose of the product (the fact that a toy may represent a new born baby is considered as intended purpose of the toy), and therewith also in relation to toys. The Office shall consider that a term that describes the goods describes also the intended purpose for accessories to those goods. A term “New born baby” is also descriptive in relation to accessories to toys (e.g. clothing and footwear for dolls), and shall be refused in relation to the mentioned goods.

## **Value**

When examining whether a sign consists of indications of value, the examiner shall assess whether the sign indicates value as a price or as a value resulting from any other characteristics of the goods. Such terms are “extra”, “top”, “the cheapest”, “more for your money”, “premium”, etc. The Office shall refuse signs consisting of such terms or of such terms in combination with other directly descriptive terms.

## **Geographical Origin**

The Office shall consider geographical terms as descriptive if the relevant public associates them with the goods or services applied for protection, or if they could be used as geographical indications in relation to such goods and/or services in the future (according to the judgment delivered by ECJ in the “Chiemsee” case, C-108-109/97).

When examining descriptiveness as to such criterion, the examiner shall establish whether connection between a geographical term and the goods or services exists, and shall assess whether such connection will be established in the future. At the same time, the examiner shall assess whether it is reasonable to expect that the public perceive such geographical term as geographical origin of the goods and/or services. He shall particularly take into account the knowledge about a geographical term by the relevant public (it is considered that small places or villages are not known), the characteristics of such territory as well as of the goods and/or services. If a geographical term is only suggestive or fanciful term, the Office shall not refuse it as to this criterion. For example, in the case of MARS chocolate, the public will not reasonably perceive such term as geographical origin. The same shall apply to the North Pole, which in

relation to ice cream does not indicate geographical origin.

When assessing whether a geographical term will be associated with geographical origin for the goods and services by the relevant public, the reputation of the term is not essential, but essential is the fact whether association of the geographical term and the goods and/or services is created by the public. The Office shall refuse the registration of terms such as Vode Kalnika or Krčki sir (Kalnik Waters or Krk Cheese) considering them as descriptive.

### **The Time of Production of the Goods or of Rendering of the Service**

The Office shall refuse on absolute grounds the signs consisting of indications that may indicate the time at which services are rendered (e.g. evening news, 24, 24/7) or the time at which particular goods are produced.

### **Other Characteristics of Goods (or Services)**

A list of characteristics referred to in the Article is not exhaustive. Pursuant to this provision, the Office shall refuse any sign consisting of indications designating any other characteristic of the goods or services. Such may be the definition of a target group, technical characteristics of goods that cannot be grouped under indicated characteristics (e.g. “lead-free” for gasoline).

#### **4.2.4 Generic Signs (Article 5, paragraph 1, item 4 of the Act)**

The Office shall not register as trademarks signs, which consist exclusively of signs or indications, which have become customary in the everyday language or in good faith and the established practices of trade. The term “exclusively” concerns additional distinctive elements contained in the sign. If the examiner establishes that the sign containing additional distinctive elements is dominated by a generic term, and that the sign in its entirety lacks sufficient distinctive character, the sign shall be refused on the absolute ground of non-distinctiveness.

The terms to which traders or the public have attributed a particular meaning which they originally did not have in the language sense shall be considered as generic terms. The verbal signs, such as NET for network, the letter L for driving school, and figurative signs, such as a star for hotel services shall be considered as such signs. The examiner shall also take into account the terms in foreign languages, which are used in their original form, when new technologies are concerned.

When examining as to this absolute ground, the examiner shall establish and identify only those goods and/or services for which the sign is generic.

Unlike when establishing descriptiveness, where it is sufficient to establish that a term may be used in trade, when establishing whether a term is generic, the examiner shall establish that the term is actually used in trade in relation to the goods and/or services applied for.

When assessing whether a sign is generic, the examiner shall take into account trade practices in relation to the end consumer, particularly when the goods of general use are concerned, such as food or drinks. If it is a matter of the goods the choice of which cannot be influenced by the end consumer, the examiner shall take into account trade practices of retailers.

For a sign established by the examiner to consist exclusively of a generic term, descriptive character shall not be taken into account. A sign to be refused by the Office on the absolute ground of being generic shall not at the same time be refused on the absolute ground of descriptiveness (according to the judgment delivered by ECJ in the BRAVO case, C-517/99).



#### 4.2.5 Public Policy and Moral Principles (Article 5, paragraph 1, item 6 of the Act)

The Office shall not register a sign, which is contrary to public interest or to accepted principles of morality. When examining as to this absolute ground, the examiner shall establish whether such signs contain insulting words or images, such as curses, signs having racist connotations or blasphemous signs, or signs encouraging consummation or promotion of drugs or inviting to commit criminal acts. The examiner shall take into account whether the meaning of such a sign is expressed directly and clearly, and whether it breaches directly the basic norms of the society. The Office shall not refuse those signs “of bad taste” that are not insulting the public.

The examiner shall take into account a sign as such, and not the applicant’s behaviour or the manner in which he will use it. Therefore, a trademark application filed in bad faith, a sign applied for by the applicant not registered for the activity concerned, or the use of BIO as a part of a sign not relating to a biological product shall not be refused on this ground.

The names of Heads of States and Church shall be refused, if the examiner establishes that such use is in conflict with the norms of the society.

When assessing whether a sign is contrary to public policy or accepted principles of morality, the examiner shall take into account the changeability of such criteria resulting from the changes concerning morality occurring in the public awareness.

#### 4.2.6 Deceptiveness (Article 5, paragraph 1, item 7 of the Act)

Signs, 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 shall not be registered.

When establishing this absolute ground for refusal, the examiner need not establish that a sign consists “exclusively” of the terms, which are deceptive. The Office shall refuse on this absolute ground a sign, which in addition to such a term contains additional distinctive elements.

The examiner shall establish whether actual deceptiveness relevant for purchasing is concerned, and whether a consumer will expect to find a particular characteristic of a good which is decisive for his purchasing decision, and which is lacking in such a good and/or service resulting in deceptiveness of the consumer. For example, if it results from the sign that a good consists of particular material, which will significantly affect the quality of the good or the purchasing decision, and the good is not made of such a material.

The examiner shall assess deceptiveness in relation to the list of the goods and/or services applied for. There is no possibility of deceptiveness when APPLE sign is concerned in relation to computers, but as regards consumers of any other fruit, deceptiveness will exist in relation to the nature of the goods.

The Office shall allow the registration of signs comprising a wider list of the goods and/or services, if there is no actual possibility of deceptiveness. The Office shall register a figurative sign “coffee” also in relation to other goods in class 30 such as salt, vinegar, rice, because there is no actual possibility of deceptiveness of consumers.

When examining signs consisting of geographical indications themselves or in combination with descriptive terms, the examiner shall establish whether actual possibility exist that a consumer bases its purchasing decision on the relation between a geographical origin as an essential characteristic and the goods /services applied for protection. If the goods concerned are not from such geographical place, it shall be considered that deceptiveness exists and the sign shall be refused.

The signs which are only suggestive in relation to particular goods and/or services, and in relation to which actual possibility of deceptiveness does not exist, shall be registered. Consequently, a sign “Metal Jacket” (registered by EUIPO) will not create confusion in relation to jackets made of textile.

#### 4.2.7 Article 6ter of the Paris Convention (Article 5, paragraph 1, item 8 of the Act)

The signs which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention shall not be registered as trademarks. In compliance with the mentioned Article, the Office shall refuse the registration of a sign containing emblems, flags or other national emblems, official signs and hallmarks indicating control and warranty as well as their heraldic imitations.

The Office shall refuse such signs irrespective of the goods/services applied for.

When examining this absolute ground, the examiner shall take into account that flags are protected per se, while for other symbols as subject to the protection pursuant to Article 6ter, he shall consult a list of symbols protected and published by WIPO. The examination shall be based on the heraldic description, and the Office shall refuse only such signs, which are almost identical with the protected sign.

#### 4.2.8 Geographical Indications for Wines and Spirits (Article 5, paragraph 1, item 9 of the Act)

The Office shall not register the signs for wines which contain or consist of geographical indications identifying wines and signs for spirits which contain or consist of geographical indications identifying spirits, with respect to such wines or spirits not having that geographical origin.

For refusal on this absolute ground it is not necessary to be established that the sign consists exclusively of a geographical indication, since it may contain additional distinctive elements.

When examining as to this ground, the examiner shall consult national lists of geographical indications for wines and spirits protected with the Ministry of Agriculture, namely the following regulations:

##### **Wines**

- List of Geographical Indications (OG No 6/2004, 11/2008)
- Regulations on Geographical Vine-Growing Areas (OG No. 74/2012, 80/2012-correction, 48/2013)

##### **Spirits**

- Regulations on Spirits (OG No. 61/2009, 141/2009, 86/2011, 104/2011, 118/2012)

Since 1 July 2013, i.e. since the date of the Republic Croatia becoming a State Member of the European Union, the lists of protected geographical origin indications are being checked (the “e-bacchus” database) and spirits of the European Union as well (the “e-spirits” database).

In the case that a sign applied for contains a geographical indication, the goods for which registration has been applied for shall be limited to the specified region. For instance, if a sign contains indication of the Plešivica region, and the goods applied for are wines under class 33 of the Nice Classification, the applicant shall limit it to wines from Plešivica. If the examiner established in such a case that the good (wine or spirit) is not limited to the specified region, the Office shall send to the applicant a preliminary refusal for the goods.

#### 4.2.9 Official Signs (Article 5, paragraph 1, item 10 of the Act)

The Office shall refuse the signs, which contain the name or abbreviation of the name, national coat of arms, emblem, flag or other official signs of the Republic of Croatia, or a part thereof, and the imitation thereof, except those having the authorization of the competent authority of the Republic of Croatia.

The examination of official signs shall be carried out, in the same way as when examining symbols pursuant to Article 6ter, on the basis of heraldic imitation. The examiner shall not take into account a detailed description of the coat of arms pursuant to the Act on the Coat of Arm, Flag and National Anthem of the Republic of Croatia, and the Flag and Sash of the President of the Republic of Croatia OG 55/90). Essential for examination would not be the fact whether the first square of the coat of arm is of red or white colour but only the fact that the coat of arms consisting of red and white squares and coats of arms of particular counties in the crown is concerned.

When examining official signs, the examiner shall concentrate on the official name, abbreviation and emblems, as follows:

- Republic of Croatia
- RH

Verbal or figurative signs, which contain the words Croatia or CRO, the abbreviation RH or the domain **.hr** shall be refused only if established that such signs are associated with the State as institution, or if indicated words are descriptive in relation to the other element of the sign, but in the latter case the sign shall be refused on account of Article 5 paragraph 1 item 2 and 3 of the Act. The examiner shall also take into account existence of additional distinctive elements of the sign.

#### 4.2.9.1 Other Official Signs

According to the above mentioned criteria, the Office shall refuse a sign of the Red Cross (Act on the Protection of the Sign and Name of the Red Cross, OG 71/10), and the sign consisting of or containing the Olympic Symbol (Nairobi Agreement on the Protection of the Olympic Symbol of 1981 – OG – “International Agreements” No. 7/04 and 11/04).

#### 4.2.10 Designations of Origin and Geographical Indications (Article 5, paragraph 1, item 11 of the Act)

The Office shall not register the signs for agricultural and food products or non-agricultural goods and services containing or consisting of designations of origin or geographical indications registered with competent bodies and serving to indicate agricultural and food products or to indicate non-agricultural goods and services if they do not originate from that geographical area.

The examiner shall apply the same rules of procedure as provided in item 4.2.8 for refusal on account of this absolute ground.

National lists of designations of origin and geographical indications for agricultural and food products (signs registered with the Ministry of Agriculture), as well as the list of designations of origin and geographical indications of non-agricultural products (signs registered with the Office) shall be checked. As of 1 July 2013, designations of origin and geographical indications of agricultural products of the European Union are checked (the “DOOR” database).

The practice as provided in item 4.2.8 for protected signs of wines and spirits shall be applied to examine appropriateness of sign to be registered under designation of origin or geographical indication in this item, i.e. products need to be restricted to the area such geographical indication refers to. Should the examiner establish in such case that the products (food or non-food products) applied for registration are not restricted to the area in the scope of geographical indication or designation of origin, the Office shall preliminary refuse the application.

#### 4.3 Acquired Distinctiveness

The signs preliminary refused by the Office on the ground of non-distinctiveness, descriptiveness or generic character (Article 5, paragraph 1, items 2, 3 and 4 of the Act) shall not be refused registration, if the applicant for the trademark registration proves that such signs have acquired distinctiveness. The applicant shall prove that the sign has acquired distinctive character in relation to the goods or services applied for registration, before the date of filing of the application and in consequence of the use, which has been made of it. Thus, the applicant shall not prove the use itself of a trademark, but that the sign that would otherwise be refused has become distinctive through the use, and that a sufficiently large part of the relevant public recognizes it as a trademark and identifies through it its producer.

When examining evidence of acquired distinctiveness, the examiner shall establish that such evidence concerns the sign applied for, and not the sign in its **(significantly) modified form**. The examiner shall take into account that the sign may still acquire distinctiveness as an element of or in connection with a registered trademark. The mentioned shall also be affected by the level of non-distinctiveness or descriptiveness of the sign applied for protection. According to

the judgment delivered by ECJ in the “Have a break” case, C-353/03, it has been established that a sign “Have a break” acquired distinctiveness through use within a slogan “Have a break, have Kit- Kat”. This is essential, particularly for figurative signs. Evidence relating to a sign, which is similar to the sign applied for, but is distinctive per se, shall not be acceptable.

The examiner shall assess evidence of acquired distinctiveness in relation to the goods/services applied for. Thus, evidence as submitted must show that it concerns exactly the goods and/or services applied for registration (e.g. if the application is filed for “meat”, evidence relating to “food” in general shall not be relevant, particularly when specifying indications concerning turnover). Apart from that, evidence must show relation between the producer and the goods and/or services for the examiner to be able to establish that the consumer will be able to identify a trademark as a sign of particular producer, and associate the goods and/or services applied for with the producer concerned.

The examiner shall assess evidence in relation to the relevant public - to which the sign is addressed primarily taking into account the list of goods and/or services applied for. Unless these goods or services are by their nature addressed to specialists or a limited public, it shall be considered that they are addressed to the general public. For example, it is considered that products in class 1 are generally intended for trade, while the products such as food are intended for the general public.

The submitted evidence shall relate to the place, time, scope and nature of the use of the goods and/or services. A special attention shall be paid to the scope of use and the time period of use. The evidence shall show the commencement of use (except for the case where the use began long before the filing date). The evidence must also show that the use has been continuous. The Office shall accept the evidence relating to a period after filing of the application only in the case that they prove that distinctiveness existed as on the filing date. The Office shall consider that such evidence is less relevant, particularly taking into account a time period between the filing date and the date to which the evidence relate.

### ***Evidence:***

It is for the applicant to decide on the nature of the evidence he will present to the Office. The applicant shall also take into account that all the evidence shall bear the date, which is essential for establishing its authenticity. In addition to the mentioned above, only evidence relating to the territory of the Republic of Croatia will be relevant. Evidence shall relate to the whole territory of the Republic of Croatia (e.g. not only to the territory of the town of Zagreb). A non-exhaustive list of evidence to be taken into account by the Office shall include:

- opinion polls and surveys
- statements from the trade
- evidence of presence in the media and intensity of promotion of a sign (catalogues, advertisements, articles, brochures, certificates and awards)
- indications concerning turnover

***Opinion Polls and Surveys*** - The Office shall consider these as relevant evidence where the questions asked are relevant and not leading and where they relate to the date before the filing of the application, and the sample interviewed is properly chosen. The examiner shall particularly take into account whether such research is carried out by independent and well-recognized institutions.

The Office shall accept **statements from the trade** as evidence of acquired distinctiveness, taking into account that statements given by distributors and suppliers will have less importance. The statements given by independent trade associations, consumer organizations and competitors will have greater importance.

The examiner shall assess the relevance of the **promotional material and other promotional activities**, such as catalogues, brochures, articles, the advertising evidence, promotion investment, certificates and awards. When assessing the relevance of the above mentioned, the examiner shall take into account all the mentioned general instructions relating to the goods/services, place and time to which the evidence relates, the scope of use resulting from the above mentioned, the relevant public, etc. Internet sites may also be taken as evidence, but it shall be necessary to show them in the form in which they were before the date of application, and provide information about their visits (it is essential that consumers are familiar with them).

When assessing indications concerning **turnover**, the examiner shall take into account exclusively the evidence relating to the goods and/or services applied for registration. Invoices per se shall not be accepted as evidence of acquired distinctiveness, since they only prove presence on the market, and may be taken as indications of turnover. The evidence shall show the size of the relevant market, as well as the commencement of use. The Office shall consider that the bigger the scope of use is, the more it is relevant.

#### 4.4 Procedure

Where the examiner establishes the grounds for refusal according to one of the absolute grounds and with respect to all or some of the products or services applied for, the Office shall issue a notice of preliminary refusal (in part or in whole) and notify the applicant to issue a statement thereon within 60 days. This time limit may be extended for not more than 60 days.

The Office shall take into account only the evidence submitted within the prescribed time limit of 60 days, or in case of the application for the extension of the time limit, within the subsequent 60 days. Where the applicant issues a statement or submits evidence on the acquired distinctive character within the prescribed time limit, the Office shall examine the supplied evidence in detail and make a final decision.

Where the applicant fails to issue a statement concerning the notice of refusal in whole (in relation to all products and/or services applied for) within the prescribed time limit or fails to contest the grounds of such refusal, the Office shall issue a decision on refusal of the trademark registration in whole.

If during the procedure regarding the statement concerning the notice of refusal in whole is established that the trademark does not meet the registration requirements only in relation to a part of products/services applied for, the Office shall issue a decision on refusal of the trademark registration in part.

The Office shall issue a decision on refusal of the trademark registration in part also in case where the applicant fails to issue a statement concerning the notice of refusal in part within the prescribed time limit or where the applicant issues the statement but fails to contest the grounds of such refusal in the procedure regarding the statement concerning the notice of refusal in part.

In case of the trademark refusal in relation to the part of the products and services, the Office shall exclude the indicated products and services applied for from protection.

Upon this decision on acceptance of the trademark registration in relation to the part of the products and services coming into effect, the registration procedure shall be resumed.

Where the examiner established non-existence of the grounds for refusal of the trademark registration in whole or in relation to some products and/or services, the trademark shall be published in the Croatian Intellectual Property Gazette.

#### 4.5 Publication of the Trademark Application

Where all the requirements have been met, the trademark application shall be published in «The Croatian Intellectual Property Gazette» (hereinafter: «the Office official gazette»). The following information (Article 12 paragraph 1 of the Regulations) shall be published In the Office official gazette

1. the number of the application;
2. the application filing date;
3. the name and address of the applicant;
4. the name and address of the representative, if the applicant has a representative;
5. the list of goods or services for which registration is requested;
6. indications concerning the granted priority right (the date of exhibition priority or the date and number of the first application and the State of its filing);
7. a representation of the sign of which the registration is requested;
8. an indication that the registration of the sign in colour is requested and the names of the colours claimed as distinctive features of the sign, if the registration of the sign in colour is requested;
9. an indication that the registration of a verbal sign is requested, if the registration of a verbal sign is requested;
10. an indication that the registration of a figurative sign is requested, if the registration of a figurative sign is requested;
11. an indication that the registration of the three-dimensional sign is requested, if the registration of the three-dimensional sign is requested;
12. an indication that the registration of a sign consisting of one colour or a combination of colours is requested, if the registration of a sign consisting of one colour or a combination of colours is requested;
13. an indication that the registration of another type of sign is requested if the registration of another type of sign is requested;
14. an indication that the registration of a collective trademark is requested, if the registration of a collective trademark is requested;
15. an indication that the registration of a guarantee trademark is requested, if the registration of a guarantee trademark is requested.

On the date of publication of the trademark application a three-month period shall commence, within which third parties may deliver opinion or file opposition.

#### 4.6 Opinions by Third Parties (Article 26 of the Act)

Within a period of 3 months following the publication of the trademark application, a third party (any natural or legal person and any group or body representing the manufacturers, service suppliers, merchants or consumers), may deliver to the Office a reasoned opinion concerning the reasons for refusal of the application under absolute grounds. The Office shall not consider the third party as a party to the proceedings. The Office shall communicate the opinion to the applicant and invite him to issue a statement within the time limit of 15 days.

The Office shall, based on the newly delivered opinion and the statement of the applicant, or based on the opinion, if the applicant fails to issue a statement, reconsider the adopted decision on the grant, and shall, based on this, issue a decision.

The decision is of internal character. An official note concerning such decision is prepared and put in the file without informing third parties thereof. The procedure shall be resumed or the preliminary refusal shall be sent to the applicant.



## CHAPTER V

### OPPOSITION – RELATIVE GROUNDS FOR REFUSAL

#### 5.1 Introduction

Opposition to the registration of a trademark may be filed to the Office within a period of three months from the date of publication of an application for the registration of a trademark, on the basis of the relative grounds as indicated below, and 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 international official gazette in which such mark has been published (Article 65 paragraph 2 of the Act).

#### 5.2 Earlier Trademark (Article 6, paragraph 2 and Article 67c of the Act)

The Office shall consider as earlier trademarks:

- any trademarks registered in the Republic of Croatia enjoying earlier filing, union or exhibition priority right, and applications for the registration of a trademark, provided that the trademarks become registered;
- trademarks registered under international treaties, having effect in the Republic of Croatia, and enjoying earlier filing, union or exhibition priority right and claims for trademark protection, provided that the protection is recognised for the Republic of Croatia;
- trademarks which, on the date of application for the registration of a 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 of the definition referred to in Article 6bis of the Paris Convention. Article 6bis defines that a well-known mark provides protection against the registration and use of identical signs or the essential parts thereof for identical or similar products, provided that the mark is well known in the territory of the state concerned;
- Community trademark applications and the Community trademark in relation to national trademark applications filed, as well as national trademarks acquired on the basis of such applications after 1 July 2013 i.e. upon accession of the Republic of Croatia as a full State Member of the European Union.

##### 5.2.1 Identity with an Earlier Trademark for Identical Goods or Services (Article 6 paragraph 1 item 1 of the Act)

The Office shall not register a sign if it is identical with the earlier trademark registered for identical goods and services.

#### – Identity as the basis for opposition

If the holder of an earlier trademark bases its opposition on the identity of the signs and the goods and services, and if the Office establishes that the identity does not exist, it shall assess whether the signs and the goods and services are similar, and shall establish whether there is a possibility of deception, irrespective of the fact that similarity is not indicated as the basis for the opposition.

If the holder of an earlier trademark bases his opposition on the identity to or similarity with an earlier trademark, and the identity or similarity of the goods or services, owing to which there is a

likelihood of confusion on the part of the public, which includes the likelihood of its association with the earlier trademark, and if the Office, examining the opposition, establishes the identity of the signs and the goods and services, it shall issue a decision on the acceptance of the opposition due to the identity of the sign and the goods/services, without establishing the likelihood of confusion on the part of the public.

If the opponent refers to identity, the existence of both the identity of the signs and the identity of the goods and services shall be necessary, in which case the Office shall not establish the likelihood of confusion.

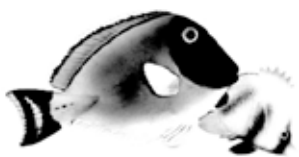
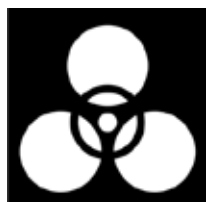
#### – Identity of signs

The Office shall consider that a contested sign is identical with an earlier trademark where it reproduces, without any modification or addition, all the elements constituting the earlier trademark, or where, viewed as a whole, it contains *differences so insignificant that they may go unnoticed by an average consumer* (according to the judgment delivered by ECJ in the Arthur/Arthur et Felicie case No. C-291/00).

The Office shall consider as identical:

- identity of signs is to be strictly interpreted: two signs are identical in every aspect or contain insignificant difference that may go unnoticed by an average consumer;
- finally, two signs may be established to be identical, if the differences between the version in black and white colour and the version in a particular colour of the same sign can be noticed by an average consumer in a comparative analysis only.

#### ***Practical examples of insignificant differences (signs are considered identical):***



#### ***Practical examples of significant differences (signs are not considered identical):***





For details please refer also to the Common Communication on the Common Practice of the Scope of Protection of Black and White Marks.

#### – Identity of goods and services

Goods and services shall be considered as identical, where designated by identical terms or synonyms. Where identical terms are contained in both lists, the identity shall be considered obvious. In the case of synonyms it is necessary to show that the meanings of the terms are identical on the commercial basis. The Office shall compare actual lists of goods/services, considering that actual or intended manner of use is irrelevant for this examination.

A correct interpretation of the wording of the list shall be essential to determine the scope of the goods and services to be taken into consideration. It concerns in particular the cases in which the list contains the terms, such as “in particular” or “namely” or other equivalents used to indicate the relationship between particular goods and a broader category. Where a list contains the terms such as “in particular”, “for example” etc., it shall be considered that the goods thus indicated are given as examples which are included in the broader category, and that the protection covers the whole broader category. On the other hand, where the list contains terms such as “namely” or other equivalent, it shall be considered that the protection is restricted to the specified goods/services only. For example, the wording: clothing, in particular, trousers and shirts shall mean that such goods are indicated as examples, and that the scope of protection is restricted to clothing in its entirety. On the other hand, if the wording is: clothing, namely (or i.e.) trousers and shirts, shall mean that the scope of protection is restricted to trousers and shirts only.

Where the list of goods and services protected by the earlier trademark contains broad (generic) terms, which cover the goods and services specifically designated in the application, the goods and services shall be considered identical, and vice versa. So, if one or more goods/services specifically designated in the earlier trademarks are covered by a broad (generic) term used in the application, the goods/services shall be considered identical.

In the case of using such “broad” lists of goods and services, or if the applicant does not specify or restrict the list, the Office shall treat the “broad terms” as a single unit and reject it as a whole.

#### ***Examples of the national practice:***

MEGAMIN	vs	MEGAMIN (earlier trademark)
Class 5		Class 5

The Office has established the identity of the goods applied for with the goods covered by the earlier trademark. The identity as to all the criteria (aural, visual, semantic) has been established, and the opposition has been accepted.

### 5.2.2 Similarity to an Earlier Trademark for Similar Goods or Services Including a Likelihood of Confusion (Article 6 paragraph 1 item 2 of the Act)

The Office shall not register a sign if because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services, there is a likelihood of confusion on the part of the public, which includes the likelihood of its association with the earlier trademark.

The Office shall not register a sign:

- if the signs are identical, and the goods or services are similar, or
- if the goods or services are identical, and signs are similar, or
- if the signs are similar for the similar goods or services, and there is a likelihood of confusion on the part of the public.

In the application of this Article of the Act, the examiner shall establish that due to similarity there is a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trademark.

The examiner shall establish the existence of all the conditions. When examining the opposition, the examiner shall first establish whether the goods and services are similar, and then whether the signs are similar. If the examiner establishes that there is no similarity of the goods and services, the opposition shall be refused for non-fulfilment of one of the conditions; however, regardless of the aforementioned, he shall proceed to establish the similarity of the signs. Upon analysis of the similarity of signs and analysis of the similarity of the related goods and/or services, the examiner shall assess the likelihood of confusion. Such assessment shall be based on the sign as a whole including the goods and services applied for.

#### 5.2.2.1 Similarity of Signs

The examiner shall establish the similarity of signs on the basis of the overall visual, aural and semantic similarity of the signs concerned. Such assessment shall be based on the overall impression given by the signs, taking into account, in particular, their distinctive and dominant components. So, the examiner shall consider that the perception of signs in the mind of the average consumer of the goods and services, based on imperfect recollection, plays a decisive role in the evaluation of the similarity of signs (according to the judgment delivered by ECJ in the “Sabel” case, No. C-251/95).

In the examination procedure, the examiner shall establish distinctive and dominant components of a sign, and shall accordingly establish similarity and likelihood of confusion on the part of the consumer. He shall analyse separately visual, aural and semantic similarity of signs.

#### – **Visual criterion for assessing similarity**

The visual criterion is considered to be of special importance as regards figurative signs, 3D signs and word and figurative signs, the word element of which is not a dominant component or is generic. It is considered that aural (or semantic) criterion is of greater relevance for word signs or certain word and figurative signs. However, the examiner shall also take into account their visual similarity in terms of comparing their length, representation of peculiar letters, or use of separately written words, hyphens, marks, such as ? or ! and the like.

#### – **Aural criterion for assessing similarity**

When applying the aural criterion, the examiner shall take into account the manner of

pronunciation of the signs. This criterion shall not be applied to signs, which are exclusively figurative or three-dimensional. The examiner shall assess whether the words of the language concerned are used in the general public, and whether they are pronounced correctly, according to the rules of such foreign language. Otherwise, he shall assess the sign on the basis of the assumption that the relevant public will most likely pronounce it in accordance with the phonetic rules of its native language.

#### – **Conceptual criterion for assessing similarity**

The examiner shall consider that conceptual or semantic similarity exists between signs, which have similar meanings, or between signs, which are written in different scripts, or between a verbal sign representing a particular term and figurative representation of such a term. For example, verbal signs SHARK (in English) and HAI (in German) would be similar according to the semantic criterion, and the same applies to the shark sign and the image of shark. However, the examiner shall assess overall similarity on the basis of all three criteria.

If none of the signs has a meaning, conceptual or semantic similarity cannot be compared. Unless one of the signs has a meaning, the signs are conceptually not similar.

When assessing overall similarity, the examiner shall establish whether there are differences as to any of the elements. Thus, in the case that a similarity exists according to two criteria, and a difference according to one criterion, it may be assessed that there is no similarity between two signs, provided that such difference prevails. (For example, it has been established that the signs PICASSO/PIKARO are different, due to a conceptual, semantic difference between them – according to the judgment delivered by GC T-185/02).

#### 5.2.2.2 Assessment of Similarity in Relation to Particular Categories of Signs

The examiner shall assess the similarity of word signs on the basis of all three criteria for assessing identity of signs taking into account, in particular, the structure of letters, the existence of shared syllables, rhythm and intonation of signs. He shall also take into account, in particular, the beginning of the sign which is considered to be the part of the sign that makes a stronger impression on the mind of the consumers. The Office shall also take into account the possibility that the last syllable is stressed. The examiner shall also take into account the length of the signs, and the number of letters.

When examining the so-called weak signs, the examiner shall take into account distinctive elements of a sign e.g. the figurative elements, or a special manner of their representation, and the signs taken as a whole, without taking into account the non-distinctive parts of the sign.

If the signs concerned consist of two letters, it shall generally be considered that the signs containing different letter/letters or several letters are not similar. Consequently, the Office shall not consider as similar the signs:

TC	vs	PC
AB	vs	ABC

### 5.2.2.3 Similarity of Goods and Services

The similarity of goods and services shall be assessed without taking into account a degree of similarity of the signs concerned (according to the judgment delivered by ECJ in the CANON case, No. C-39/97).

When assessing the similarity of goods and services, the examiner shall take into account all the relevant factors related to the goods and services applied for.

**The basic criteria** to be established are as follows:

- the nature of goods and services;
- the purpose;
- the method of use;
- complementarity of goods and services
- interchangeability of goods and services

#### 5.2.2.3.1 Nature of Goods and/or Services

When establishing the nature of goods and services, the examiner shall take into account the fact that falling under a broad heading does not necessarily mean that the goods are similar in terms of their nature. For example, pastry and meat fall under the category of foodstuffs, but they are not similar.

When narrow heading is concerned, it may be established that all the goods are similar, e.g. light drinks (fruit juice, mineral water).

When establishing the nature of goods/services, the examiner shall take into account the following criteria:

- composition (raw materials, ingredients)
- functioning principle
- physical condition (e.g. liquid or solid)
- appearance (design)
- value

The nature of goods/services, as well as other factors used when establishing similarity of goods/services shall be assessed on the basis of a commercial perspective of goods and services. For example, when comparing **ice** for cooling and edible ice, i.e. **ice** cream, the similarity shall be established in the composition of the goods (both consist of frozen water). However, if commercial aspect is taken into account, this is irrelevant, since one of them falls under the category of foodstuffs and the other does not. Therefore, it shall be established that their nature is not similar.

The examiner shall also take into account the fact that certain ones of the abovementioned categories will be more or less relevant for particular goods/services. Thus, for example, the relevant criterion for spirits, or light drinks is the composition of the goods, while for toys is their appearance or a presentation of their functioning.

#### 5.2.2.3.2 Purpose of Goods/Services

The Office shall consider that the purpose means the intended use of the goods or services and not any accidental use. The term purpose shall be interpreted as the economic function of goods/services, in terms of satisfying the needs (of the consumers) or solving the problems (business customers).

The purpose shall be considered as one of the most important criteria for establishing the similarity of goods/services. The similarity will be very frequently established in relation to the goods or services of a different nature but of the same purpose. Thus footwear and clothing are considered to be similar goods. Thus, for example, raincoat and umbrella, or edible oil and vinegar will be considered as similar goods.

#### 5.2.2.3.3 Method of Use

The Office shall interpret the method of use as the manner in which the good is used to achieve its purpose. The method of use often follows directly from the nature or purpose of use of goods/services, and therefore has little significance as an individual factor.

**Example** of the nature, purpose and method of use: according to the judgment delivered by GC in the HUBERT case, No. T-110/01).

Goods compared: edible fats, vinegar and sauces.

**The nature** of the goods represents the kind of the goods, including their basic purpose and method of their use. The nature of the above mentioned goods is that they fall under the category of foodstuffs, their basic method of use is to be ingested by a living organism, and their purpose is to be metabolized into energy. **The purpose** of such goods is human consumption, i.e. the basic purpose and the method of use (constitute the nature of goods). Daily seasoning of food represents **the method of use**.

#### 5.2.2.3.4 Complementary Goods/Services

When assessing the similarity of goods/services, the examiner shall establish whether the goods concerned are complementary. It is considered that the goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other and is not merely auxiliary.

When establishing this factor, the distribution channels shall also be taken into account, since complementary goods usually have the same distribution channels (e.g. cameras and films, hardware and software).

#### 5.2.2.3.5 Interchangeable Goods/Services

When establishing whether the goods concerned are interchangeable, the examiner shall establish whether the goods concerned completely achieve the same purpose and that in the same manner, and whether the consumers may use one good as substitute for the other for the same purpose. When establishing interchangeability, the examiner shall take into account the purpose of the good and its price range.

When examining the similarity, the examiner shall also take into account **additional factors**, such as:

- the channels of distribution – to be taken into account, in particular when establishing complementary character of goods. It shall be considered that this factor is not sufficient per se, unless the goods which are sold exclusively in specialized shops or on commission are in question;
- position of goods – the fact that goods are sold at the same shops and the same departments of department stores shall be taken into account;
- end consumer – this factor shall be considered decisive only in exceptional cases, if the goods concerned are intended for special consumer circles;
- production of goods or services – the examiner shall establish whether the goods and services concerned are usually produced in the course of trade by the same or economically linked undertakings. In such a case, even if the goods concerned are not similar, it shall be considered that the consumers will assume that the goods or services concerned come from the same undertaking (e.g. undertakings manufacturing sportswear usually manufacture sports bags as well).

The indicated list of the basic and additional factors is not exclusive, and does not exclude the possibility of introducing other relevant factors when assessing the similarity of goods and services. The examiner shall determine the relevant factors, the degree of their relevance, and appropriate characteristics concerning the relationship between goods and services, on the merits of the case.

When comparing goods and services, the examiner need not establish all the characteristics of the goods and services in the abstract sense, but common characteristics of the goods and/or services compared.

For example, when assessing the factors related to “water”, the examiner shall take into account only such characteristics, which are essential in relation to the good compared with “water”. Thus, for example, when comparing water and milk, the purpose will be quenching of one’s thirst, and when comparing water and washing chemicals, the purpose will be cleaning.



### ***Similarity between Goods and Services***

The similarity between goods and services shall be examined taking into account the circumstances of the case.

#### ***List of Goods and Services***

The lists containing the terms “in particular” and “namely” will be treated in the same way as when assessing the existence of identity of goods and services (please refer to 5.2.1). The similarity of goods and services shall not be established on the basis of their position taken in the same or different class of the Nice Classification, but on the basis of the actual factors. If the list of pharmaceutical products contains broader terms, account will be taken of the average consumer.

On the basis of all the above mentioned factors, the examiner shall also establish the degree of similarity on which the assessment of the likelihood of confusion shall depend.

#### 5.2.2.4 Likelihood of Confusion

When the examiner has assessed the similarity of the signs and the similarity of the goods and services, he shall establish whether the likelihood of confusion exists. On the basis of the degree of such similarities, the examiner shall assess whether the similarity in relation to the sign as a whole is sufficient to give rise to the likelihood of confusion on the part of the public. The Office shall consider that the risk that the public might believe that the goods or services concerned come from the same undertaking or from economically linked undertakings constitutes a likelihood of confusion.

The examiner shall establish whether such confusion is direct or indirect, i.e. whether there is the likelihood of confusion on the part of the signs (direct), or on the part of the holders i.e. the association of the sign with the earlier trademark (indirect confusion).

The examiner shall assess the likelihood of confusion assuming that the trademarks are used in the usual and conscious manner in relation to the goods and services applied for. If established that the signs are used, data on the actual existence or non-existence of confusion on the market shall be taken into account.

When assessing the likelihood of confusion, the Office shall consider that a higher degree of similarity between the goods or services and a lesser degree of similarity between the signs may give rise to confusion, and vice versa, in particular if the signs concerned are identical (according to the judgment delivered by ECJ in the CANON case, No. C-39/97). It is also considered that the more distinctive the earlier trademark is, the higher will be the likelihood of confusion.

The likelihood of confusion shall be established in relation to the public consisting of reasonably well-informed consumers, buying on the basis of their imperfect recollection. Such public shall consist of the relevant consumers of goods and services usually circumspect when choosing goods and services.

The moment of the purchase, and, in certain cases, a period before it (promotion) as well as a period after it (e.g. unpacked goods; use by the members of the family) shall be relevant for the assessment of the likelihood of confusion.

**Examples of the National Practice:****1.a**

BIOSOL vs BIOSOL (the earlier trademark)

Products:

Class 1 *Clarification and degreasing preparations for use in metal products manufacturing*

Class 1 *Fertilizers for agriculture (the earlier trademark)*

The Office established that the similarity of the goods did not exist, and refused the opposition as unfounded.

**1.b**

HELLO

vs



(earlier trademark)

Products:

Class 16 *Paper and cardboard*

Class 16 *Newspapers, books, magazines and literary and artists' publications (the earlier trademark)*

The Office established that consumers of the products registered under the earlier trademark are consumers in the broadest sense, whereas targeted group of consumers of the products comprised under the later trademark is specific i.e. consumers in a narrower sense (various printing houses and the like), which means that for their specific character such products will not be available for consumers in general. Hence, these are the products intended for various users, with completely different purposes and distribution methods; thus, it is concluded that these are different products within class 16 in total. Therefore, there exists no likelihood of confusion regardless of high degree of similarity between the signs.

**2.**

**PROLON**

vs **PRILEN** (the earlier trademark)

Products:

Class 5 – pharmaceutical preparations and substances used in the treatment of urinary diseases

Class 5 – pharmaceutical and veterinary products (the earlier trademark)

In the examination procedure the Office established that the broader heading of the earlier trademark – pharmaceutical and veterinary products included the products specified in the application, and that the products were identical. The aural and visual similarities were established in the examination. As concerns semantic criterion, it was established that the signs have no meaning in our language. The Office established the existence of the likelihood of confusion, and the opposition was accepted in relation to the mentioned products.

#### 5.2.2.5 Well-known Marks (Article 6bis of the Paris Convention)

When assessing evidence concerning well-known trademarks, the Office shall take into account criteria established in the Joint Recommendation of the World Intellectual Property Organization (hereinafter: WIPO) concerning provisions on the protection of well-known marks.

The criteria are as follows:

- the degree of knowledge or recognition of the mark in the relevant sector of the public;
- the duration, extent and geographical area of any use of the mark;
- the duration, extent and geographical area of any promotion of the mark, including advertising and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- the record of successful enforcement of rights in the mark;
- the value associated with the mark.

These factors represent the basic guidelines, and the relevance of the factors as indicated or particular additional factors shall be assessed on the merits of the case.

The basic requirement for well-known marks to be the basis for opposition to a trademark registration is to prove that they are well-known in the territory of the Republic of Croatia. Thereby, the mark, which is well-known but not protected, will be able to prevent registration of the identical/similar sign for the identical/similar goods, despite the fact that it is not registered. A sign which is registered, and which proves to be well-known in the territory of the Republic of Croatia will have its scope of protection extended, in the sense that it will be considered that signs of lower level of similarity will create confusion on the part of the public for expressed distinctiveness of a well-known mark and thus higher probability of associating the earlier trademark with the later trademark on the part of the relevant general public i.e. consumers.

#### 5.2.3 Similarity with an Earlier Trademark Having a Reputation (Article 6 paragraph 3 and Article 67c paragraph 2.<sup>2</sup> of the Act)

The Office shall not register a trademark, which is identical with, or similar to, an earlier trademark and the registration has been requested for goods or services which are not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation and where the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trademark.

The reputation of an earlier trademark shall be proved, and the examiner shall assess it in relation to the territory of the Republic of Croatia, and if it is an earlier trademark of the Community, the examiner shall assess its reputation in relation to the territory of the Community in compliance with Article 8 paragraph 5 of the Regulation on the Community Trademark No. 207/2009 and the usual practice of the EU regarding the assessment of the trademark reputation in the territory of the EU.

The first condition to be established is whether a **trademark** concerned is **registered**. When a registered trademark having a reputation is concerned, the similarity of the goods needs not to be established. The mentioned Article of the Act may be used as the basis for refusal, if the goods concerned are similar, and even if they are not. It should be taken into account if the goods of confronted signs are substantially different in the way that consumers of a product of the earlier trademark are substantially different from consumers of a product of the later

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<sup>2</sup> Article 67c paragraph 2 of the Trademarks Act should read: "Within the meaning of Article 6 paragraph 3" instead of "Within the meaning of Article 6 paragraph 2 item 4"

trademark, i.e. the possibility of associating these consumers is not obvious from submitted evidence of a holder of a trademark with reputation, which substantially reduces the probability of associating the earlier trademark with the later trademark on the part of the relevant public.

#### – Reputation

The Office shall consider that a trademark has a reputation when it is known to the relevant sector of the public to which the goods and services are intended (according to the judgment delivered by ECJ in the *General Motors v. Yplon SA*, No. C-375/97). When establishing whether a trademark is known to the relevant sector of the public, the examiner shall take into account all the relevant factors relating to the circumstances of the case. The examiner shall assess a reputation in relation to the goods and services for which such a reputation has been proved, provided that the goods and services concerned are those for which the trademark is registered. The holder of an earlier trademark shall prove that a reputation existed at the time preceding the application of the later trademark, and that it concerns the earlier trademark on which the opposition is based, and that the trademark has acquired a reputation in the Republic of Croatia or in the territory of the EU, if reputation is proved to exist for a Community trademark before the filing date of the application for the registration of the trademark in respect of which the opposition is filed, or, if the priority right is claimed, before the date of priority right claimed in the application. The reputation will be assessed on the basis of the degree of knowledge, the intensity of use, the duration of use, the territory of use, and the amount invested in the promotion. The examiner shall also take into account the economic value of the trademark achieved on the market, which is reflected in strong licencing, sponsoring or trade on account of its value or awards granted in relation to the trademark use on the market. When assessing the trademark reputation, account shall be taken of evidence proving successful exercise of rights in relation to other undertakings that offer goods/services not similar to the registered trademark, but accept demands of its holder through agreements or arrangements invoking reputation and restrict the use of or stop using their trademark, thus confirming reputation of the registered trademark. Furthermore, relevant evidence of trademark reputation can refer to frequent decisions by court and administrative authorities granting protection to such trademark against infringements.

#### – Similarity

After it has been established on the basis of evidence, that a reputation of a trademark exists, the examiner shall also establish the existence of **similarity** of the earlier trademark with the reputation of the sign applied for. The similarity shall be established according to the criteria specified in paragraph 5.2.2.1, except for the fact of likelihood of confusion on the part of the public.

#### – Detrimental effects

It has to be established that other detrimental effects in relation to the earlier trademark will incur, implying that the similarity of signs has to be such that the relevant sector of the public associate the earlier trademark with the sign applied for (according to the judgment delivered by ECJ in the *Adidas v Fitnessworld*, C-408/01).

The fact that the trademark applied for will take unfair advantage of, or will be detrimental to, the distinctive character or the reputation of the earlier trademark shall be considered as detrimental. The mentioned Article of the Act shall be the ground for refusal only in the case of proving one of the two-abovementioned situations. The Office shall consider that such situations are the following:

- if the trademark applied for would be detrimental to the distinctive character of the earlier trademark (weaken it);
- if the trademark applied for would be detrimental to the reputation of the earlier trademark

(diminish its reputation);

- if the trademark applied for would use distinctive character of the earlier trademark (use its attraction);
- if the trademark applied for would take unfair advantage of the reputation of the earlier trademark (use its image in terms of quality).

If the trademarks concerned are used on the market, the holder of the earlier trademark has to prove actual damage caused to the earlier trademark, or the profit that the holder of the later trademark has gained. If the trademarks are not used on the market, the likelihood of their use on the market has to be proved. In addition to the abovementioned, it has to be proved that the exploitation or damage is unfair, and not accidental.

The applicant for the trademark as opposed may try to prove the existence of a particular ***justified reason for using the contested trademark***. If the applicant fails to indicate the same as a possible argument, the Office shall consider that there is no reason that justifies his behaviour.

### 5.3 Other Earlier Rights as the Basis for Opposition (Article 6, paragraph 4 of the Act)

The Office shall not register a trademark if its use would infringe one of the following:

- a right to a personal name,
- a right of personal portrayal,
- a copyright,
- industrial property rights.

The Office shall consider that such earlier rights are the rights acquired on the date, which is earlier than the date of the application for the registration of a trademark, or the date of the claimed and granted priority right.

The mentioned shall be assessed in compliance with the special provisions, regulating the abovementioned rights.

Thus for example, when opposition based on an earlier copyright is concerned, it shall be necessary to establish that the later sign is the result of improper use of the earlier copyright work. The existence of the improper use by an earlier trademark of a work protected copyright will be assessed in accordance with the standards and provisions of the Copyright and Related Right Act (OG 167/03, 79/2007, 80/2011, 141/2013 and 127/2014).

If the opponent is a legal person, it shall furnish evidence showing the basis of its being a copyright holder, since only a natural person may be the original holder (the author) of copyright. A legal person may furnish evidence showing that it has become the holder of a copyright on the basis of a contract (to be furnished), or the company legislation regarding employees who create a copyright work in the course of their duties performed under the employment contract (also to be furnished).

### 5.4 A Firm as the Basis for Opposition (Article 6, paragraph 6 of the Act)

The Office shall refuse the registration of a trademark if its use would infringe the right of the person who, at the time of filing of an application for the registration of a trademark, had a firm, provided that such firm or the essential part thereof is identical with or similar to the sign in respect of which the application is filed and provided that identical or similar goods or services are the subject matter of the firm's activity, unless the applicant had the identical or similar firm at the time of filing the application for registration of a trademark.

The holder of the earlier right shall file evidence of the registration of the firm, the duration of the registration and of the activities covered by the registration. The examiner shall assess the similarity of the firm with a later sign applied for and the similarity of its activities with the list of goods and services.

#### 5.5 The Right Conferred by an Earlier Trademark, Which Has Expired for Failure to Renew the Registration as the Basis for Opposition (Article 6, paragraph 7 of the Act)

The Office shall refuse the registration of a sign which it is identical with, or similar to, an earlier trademark which was registered for identical or similar goods or services and conferred on them a right which has expired for failure to renew the registration of the trademark within a period of not more than two years as from the expiry of the trademark. The aforementioned shall not apply if the holder of the earlier trademark gave his consent for the registration of the later trademark or did not use his trademark. However, if during the opposition procedure, the trademark, which is the basis for opposition, expires, the Office shall not decide automatically on the opposition on the basis of this ground. In such a case the Office shall reject the opposition with regard to the fact that the basis for opposition (earlier trademark) shall be valid (in force) at the time of filing the opposition.

#### 5.6 The Right of the Holder as the Basis for Opposition and Prohibition of the Use of a Trademark Registered in the Name of a Trade Agent or a Representative (Article 9 of the Act)

If the trade agent or a representative of the holder of a trademark applies for the trademark registration without the holder's authorization, the holder shall be entitled to file an opposition and the trademark shall not be registered, unless the agent or a representative justifies such act. The holder of a trademark shall be entitled to prohibit the use of this trademark registered on behalf of the agent or a representative, if the trademark is registered without the holder's authorization.

The earlier trademark and the trademark applied for/registered by the representative or the trade agent shall be identical or similar, in such a way that the trademark applied for substantially repeats the earlier trademark with minor modifications, not substantially affecting its distinctiveness. The goods and services must be identical or very similar.

### 5.7 Opposition Procedure

#### 5.7.1 General

The opponent may file the opposition within 3 months from the date of publication of the application for the registration of a trademark. The opposition shall be based on the abovementioned relative grounds for refusal.

As regards legal basis for opposition referred to in paragraphs 5.2.1, 5.2.2 and 5.2.3 the holder of an earlier trademark and a licensee shall be entitled to file an opposition. The holder of the right concerned shall be entitled to file an opposition in respect of other earlier rights (a right to a personal name, a right of personal portrayal, a copyright, and industrial property rights). If the opposition referred to in paragraph 5.4 is concerned, the person who had a firm within the meaning of the mentioned conditions shall be entitled to file an opposition. The holder of an earlier trademark, the protection of which has expired (if the period of less than two years is concerned) shall be entitled to file an opposition.

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 suspend the opposition procedure until the decision from such procedures has become final.

The period of three months may not be extended. The Office shall not take into account the additions to the opposition submitted upon expiry of this time limit.

#### 5.7.2 Basic and Additional Requirements to be Complied with When Filing an Opposition

**The basic indications** to be contained in an opposition as filed are as follows (Article 13 of the Regulations):

1. the number of the application for the registration of a trademark in respect of which the opposition is filed;
2. the name and address of the applicant of the application in respect of which the opposition is filed;
3. the name and address of the opponent;
4. the name and address of the representative, if the opponent has a representative;
5. the list of goods and services in respect of which the opposition is filed;
6. legal grounds for the opposition
7. evidence of the legal grounds for the opposition;
8. reasons for filing the opposition
9. if the opposition is based on Article 6, paragraph (1), paragraph (3) and paragraph (4), item 4 of the Act, and the name and address of the opponent are not identical with the name and address of the holder of the earlier trademark or other earlier industrial property right that is entered in the relevant register as the holder of this right, evidence of the legal connection between the opponent and the holder entered in the relevant register;
10. the signature or the seal of the opponent, or the signature or the seal of his representative;
11. evidence of the payment of the prescribed fee and procedural charges.

The opposition is to be filed with the Office in duplicate.

***Additional requirements to be complied with when filing an opposition*** (Article 13, paragraph 1, items 6 and 7 of the Regulations, Article 14 of the Regulations):

- A separate opposition shall be filed in respect of any application for the registration of a trademark, which is opposed.
- Where an opposition is based on a well-known trademark, the opponent shall prove that the trademark is well-known in the territory of the Republic of Croatia.
- Where the opposition is based on an earlier trademark having a reputation, the opponent has to prove that the trademark acquired the reputation in the Republic of Croatia before the filing date of the application for the registration of a trademark in respect of which the opposition is filed, or, if the priority right is claimed, up to the date of priority right claimed in the application.
- If the opposition is based on the right of a firm, the opponent has to prove that the firm was entered in the court register before the filing date of the application for the registration of a trademark in respect of which the opposition is filed, or, if the priority right is claimed, before the date of priority right claimed in the application.



- If the applicant for the trademark registration so requests, the opponent has to prove that, during the period of five years preceding the date of publication of the application, he was producing the products or supplying the services in respect of which the opposition is filed.

### 5.7.3 Examination of the Opposition (Articles 28 and 29 of the Act)

After the opposition has been filed, the examiner shall, in the first phase, carry out formalities examination: whether the opposition is filed by the person entitled to file the opposition, whether the opposition is filed within the prescribed time limit, and whether it complies with the abovementioned requirements as set out in the Regulations. If the examiner establishes that any of the mentioned requirements is not complied with, the Office shall reject the opposition.

If the requirements are complied with, the Office shall notify the applicant of the opposition as filed, and shall send him a copy of the opposition. The Office shall invite the applicant to submit his observations on the opposition within 60 days from the day of receipt of the notification. This time limit may not be extended, and the Office shall not take into account additions to the observations on the opposition, after the expiration of this time limit.

If the applicant fails to submit observations on the opposition, the Office shall refuse the requested registration within the limits of the claims referred to in the opposition. If the applicant submits his observations on the opposition, the Office shall examine the justification of the grounds specified in the opposition.

### 5.7.4 Procedure with Requesting Proof of Use

When the applicant submits observations on the opposition and requests proof from the holder of an earlier trademark filing the opposition that he has used the earlier trademark during the period of five years preceding the date of publication or justified reasons for non-use, the Office shall inform the opponent thereon and invite him to furnish evidence on using the earlier trademark in duplicate within 60 days upon receipt of the invitation. Upon submitting the aforementioned evidence, the Office shall deliver a copy of the evidence of using the trademark to the holder of the trademark and invite him to submit observations on the evidence of using the trademark within 30 days upon receipt of the invitation. If the holder of the earlier trademark does not furnish proof that, during the period of five years preceding the date of publication, he has used the trademark or does not furnish proof that there are justified reasons for non-use, provided that the earlier trademark has, on the date of publication of the registration of the trademark, been registered for not less than five years, the opposition shall be refused. If the earlier trademark has been used only in relation to a part of the goods or services, it shall be deemed that such trademark is registered only in respect of that part of the goods or services, and the similarity of the goods or services of the later trademark the registration of which is opposed will be assessed only in relation to such part of the goods and services.

If the examiner establishes that the opposition is unjustified, the opposition shall be refused. If he establishes that the opposition is justified, it shall be accepted, in whole or in part i.e. the registration of a trademark shall be refused, or partially granted.

### 5.7.5 Suspension of the Procedure on Account of the Opposition, for Settlement

During the examination of the opposition, the applicant and the opponent may both sign a joint request asking the Office to suspend the examination of the opposition in the attempt to reach a settlement. The procedure shall be resumed upon request of any of the parties concerned, and within 24 months upon filing such request for suspension of the procedure at the latest, unless the procedure is completed before this time limit has expired.

## 5.8 Publication of a Trademark

If the Office hasn't received an opposition within the prescribed time limit, or has decided that the opposition is unjustified or partially unjustified, it shall invite the applicant to pay a 10-year period maintenance, and publication charges. If the applicant pays the charges, the Office shall publish the data concerning a trademark in the Office official gazette not later than within three months from the date of the entry of the trademark in the register.

The indications to be published in the Office official gazette are (Article 17 of the Regulations):

1. the number of the registration of the trademark;
2. the date of the registration of the trademark;
3. the application filing date;
4. the name and address of the applicant;
5. the name and address of the representative, if the applicant has a representative;
6. the list of goods and services;
7. indications concerning the granted priority right (the date of exhibition priority or the date and the number of the first application and the State of its filing);
8. a representation of the sign;
9. an indication that the sign is in colour, and the names of the colours that are distinctive features of the sign, if the sign is in colour;
10. an indication that the sign is verbal, if the sign is verbal;
11. an indication that the sign is figurative, if the sign is figurative;
12. an indication that the sign is three-dimensional, if the sign is three-dimensional;
13. an indication that the sign consists of one colour or a combination of colours, if the sign consists of one colour or a combination of colours;
14. an indication that the sign is another type of a sign and which one, if the sign is another type of a sign;
15. an indication that the trademark is a collective trademark, if the trademark is a collective trademark;
16. an indication that the trademark is a guarantee trademark, if the trademark is a guarantee trademark;
17. the date up to which the trademark shall have effect.

## 5.9 Trademark Certificate

The holder of a trademark may request to be issued a trademark certificate. If the prescribed procedural charges have been paid, the Office shall issue the certificate to the holder of a trademark not later than within three months from the date of publication of the trademark in the Office official gazette. A request for the trademark certificate may be filed at any time during the term of the trademark. The issue of the certificate is not subject to payment of the administrative

fee.

A trademark certificate shall contain the following indications (Article 18 of the Regulations):

1. the number of the registration of the trademark;
2. the date of the registration of the trademark;
3. the application filing date;
4. the name and address of the holder of the trademark;
5. the name and address of the representative, if the holder of the trademark has a representative;
6. the list of the goods or services;
7. indications concerning the granted priority right;
8. a representation of the sign;
9. an indication that the sign is in colour and the names of the colours that are distinctive features of the sign, if the sign is in colour;
10. an indication that the sign is verbal, if the sign is verbal;
11. an indication that the sign is figurative, if the sign is figurative;
12. an indication that the sign is three-dimensional, if the sign is three-dimensional;
13. an indication that the sign consists of one colour or a combination of colours, if the sign consists of one colour or a combination of colours;
14. an indication that the sign is another type of a sign and which one, if the sign is another type of a sign;
15. an indication that the trademark is a collective trademark, if the trademark is a collective trademark;
16. an indication that the trademark is a guarantee trademark, if the trademark is a guarantee trademark;
17. the date of publication of the registration of the trademark in the Office official gazette;
18. the date up to which the trademark shall have effect.

## CHAPTER VI

### TRADEMARK REGISTER

#### 6.1 General

The Office shall keep the trademark register, which contains the data, the entry of which is prescribed by the Act and the Regulations. Any person shall be entitled to inspect the trademark register. The Office shall issue, upon request, the extract and the printout from the trademark register to any interested person who has paid the prescribed fee and procedural charges.

#### 6.2 Amendments to the Application for the Registration of a Trademark and the Registration of a Trademark and Correction of Mistakes (Articles 31, 36 and 68 of the Act)

Amendments of the trademark application or trademark registration shall be made only in cases where it is necessary to correct the name or the address of the applicant, errors of wording or of copying, or to correct any other obvious mistakes. The mentioned amendments shall not require extension of the list of goods or services. The Office can make amendments upon a request of the applicant or ex officio.

The representation of a sign applied for or of a registered trademark shall not be altered, except where it includes the name and address of the applicant. Upon a request of the applicant the alteration may be made, since it does not substantially affect the identity of the sign as originally entered in the register.

The applicant shall pay the prescribed procedural charges for the mentioned amendments. If the published application or the published trademark is concerned, the Office shall publish the amendments later on, provided that the charges are paid.

Correction of mistakes of the entry in the register or the publication of an application or a registration of a trademark attributable to the Office shall not be subject to payment of prescribed fee and procedural charges.

#### 6.3 Amendments Relating to the List of Goods and/or Services (Article 30 of the Act)

As described in detail in item 3.6, the applicant may at any time restrict the list of goods and/or services. The restriction shall not be subject to payment of the charges, or to a request for the amendment to the application for the registration of a trademark or the amendment to the trademark.

#### 6.4 Division of the Application and the Registration (Article 33 of the Act and Article 15 of the Regulations)

The applicant for or the holder of a trademark may file a request for the division of an application or a registration of a trademark into two or more applications or registrations in respect of the list of the goods and/or services covered by the application or the registration.

A request for the division shall contain:

1. the number of the first application or registration of the trademark;
2. the name and address of the applicant or the holder of the trademark;
3. a representation of the sign;
4. the list of the goods or services to be covered by the divisional applications or registrations;

5. the signature or the seal of the person filing the request, or the signature or the seal of his representative;
6. evidence of the payment of the prescribed fee and procedural charges.

The applicant shall file a separate request for the division of any trademark application or registration. The lists of goods or services covered by the divisional applications or registrations and the list of goods or services of the remnants of the first application or registration, viewed together, shall be identical with the list of goods or services covered by the first application or registration, at the time when a request for the division was received. Where the division concerns goods or services falling under a general term, the general term shall be used both in the remnant of the first application or registration and the divisional application or registration. The list shall be restricted by appropriate additions to avoid any overlapping of the lists of goods or services.

The Office shall allot new numbers to the divisional applications or registrations.

The procedures initiated in respect of the first application or registration shall also concern divisional applications or registrations, if they cover the goods or services in respect of which the procedures were initiated.

A divisional application shall maintain the right of priority from the first application or the registration.

The Office shall enter the data concerning divisional applications or registrations in the register and shall publish them in the Office official gazette.

## 6.5 Amendments to an Application for the Registration of a Trademark / to a Trademark

On request of the applicant, the Office shall enter in the register all the changes occurring after the filing of the application for the registration of a trademark or after the registration of a trademark, provided that they correspond to the real situation and that they do not affect the representation of the trademark. The applicant shall pay the prescribed fees and charges for a particular amendment.

The Office shall publish all the amendments in the Office official gazette.

### 6.5.1. Request for Recording of a Change (Article 19 of the Regulations)

#### **Basic Requirements**

A request for recording of a change shall contain:

1. the number of the application for the registration of a trademark or the number of the registration of the trademark;
2. the name and address of the applicant or the holder of the trademark;
3. the name and address of the person filing the request;
4. the name and address of a representative;
5. a clear indication of the kind of the change concerned;
6. the signature or the seal of the person filing the request or the signature or the seal of his representative.

A person filing the request shall specify the mentioned indications either on the Ž-2 form, which forms part of the Regulations, or on any form, which corresponds to the contents of the Ž-2 form.

The person filing the request shall present evidence of the legal basis for the recording of the change, except when the request is filed for the recording of a change in the name or address of the applicant, the holder of the trademark, or the representative. The person filing the request shall also present evidence of the payment of the prescribed fee and procedural charges. If a foreign applicant or a foreign holder is concerned, the power of attorney granted to a representative appointed by such person shall also be presented (in accordance with the Act on Representation under which foreign persons shall have a representative).

Where several changes in the name or address are concerned, the person filing the request for recording the changes shall not file separate requests to cover all the changes, but a single request for recording of the last change, and shall pay the administrative fee and procedural charges for one change only. In such a case, however, the register shall not contain legal sequence of changes, and the person filing the request shall not request a change related to the legal sequence.

If the person filing the request has presented evidence accompanying one request, he shall not present evidence in support of the same request (the same person and the same change) in respect of other cases, but he may invoke evidence presented in the other case. The person filing the request shall indicate the number of the case containing the mentioned evidence on the last page of the form (evidence of the legal basis).

**- Other Requirements for Filing a Request for Recording of a Change** (Article 20 of the Regulations)

Where a request for recording of changes relates to several applications the applicant of which is the same person, or to several registrations of a trademark the holder of which is the same person, the person filing the request may file a single request. Such request shall contain all the numbers of applications or registrations the requested change concerns.

In such a case, the party may pay a cumulative amount of a fee, for all the requests indicated on a single payment slip, or a cumulative amount of procedural charges on the other payment slip.

#### 6.5.2 Transfer of Rights (Article 38 of the Act)

The holder of a trademark may transfer the trademark to other persons, in respect to all or a part of the goods and/or services.

The holder shall file to the Office a request on the basis of which the Office shall record the transfer of the right. The transfer shall be recorded only if the holder has furnished:

- a certified copy of the contract on the transfer of rights, or
- a certified extract of the contract , or
- the original copy of the certificate of transfer of rights signed by the former and new holder of the right

The transfer of rights shall be effective against third parties upon entry in the register.

**Other Requirements for Filing** (Article 20, paragraphs 2-5 of the Regulations)

If the person filing a request requests recording of a partial transfer, the Office shall create a new application or a new registration of a trademark that covers the goods or services in respect of which the transfer has been made. Where the transfer concerns goods or services falling under a general term, the general term shall be used in all the new lists of goods or services to which it is transferred, and it shall be restricted by appropriate additions to avoid any overlapping of the lists of goods or services.

A complete copy of the files of the original application or registration shall become a part of the files of the new application or registration referred to in this Article, and a copy of the request for the recording of the transfer shall become a part of the files of the original application or registration.

The new application or registration shall be allotted a new number.

The procedures initiated in respect of the original application or registration of a trademark shall also concern the new applications or registrations, if they cover the goods or services in respect of which the procedures were initiated.

#### 6.5.3 License (Article 39 of the Act)

The holder may file a request for recording of a license for the use of a trademark in respect of all or a part of the registered goods or services, for the whole or a part of the territory of the Republic of Croatia. A license may be exclusive or non-exclusive.

Upon a request of the licensor or the licensee, the license shall be recorded, provided that

- a certified extract of the licensing contract, or
- the original copy of the certificate of granting the license signed both by the licensor and the licensee

is submitted to the Office.

If the prescribed fee and procedural charges are paid, the license shall be published in the Office official gazette. It shall have effect against third parties after the entry thereof in the register.

#### 6.5.4 Rights in Rem and Levy of Execution (Article 40 of the Act)

A right in rem shall be entered in the register upon the request of a lien creditor or a lien debtor. The court levying an execution ex officio shall inform the Office without delay of the execution levied upon a trademark. Rights in rem and levy of execution shall be published in the Office official gazette. They shall have effect against third parties after the entry thereof in the register.

#### 6.5.5 Bankruptcy Proceedings (Article 41 of the Act)

Where a trademark is involved in the bankruptcy proceedings, the Office shall, upon a request of the competent authority, enter an indication to that effect in the register, and shall publish it in the Office official gazette.

The provisions referred to in paragraphs 6.5.2 – 6.5.5 shall also apply to applications for the registration of a trademark.

#### 6.5.6 Remedy of Deficiencies

If the request fails to comply with the mentioned requirements, the Office shall invite a person filing the request to remedy the found deficiencies or to present appropriate evidence within a period of 60 days, which may be extended for additional 60 days. If the applicant remedies deficiencies within the given time limit, the Office shall issue a decision on the entry of the change in the register, and shall enter the change in the register. If the person filing the request fails to comply with the invitation, the Office shall reject the request by a conclusion.

## 6.6 Duration and Renewal of the Registration of a Trademark (Articles 43 and 44 of the Act)

The period of protection of a registered trademark shall last ten years counting from the date of filing of the application for the registration of a trademark. Such a period may be extended indefinite number of times, for the periods of ten years each, subject to payment of the prescribed procedural charges.

If the holder of a trademark files with the Office a request for the renewal of the registration in the course of the last year of a ten-year period of protection, the Office shall enter the renewal in the register, and shall publish it in the Office official gazette. Failing this, the trademark shall cease to have effect on the day of expiration of this period. The request may be filed, apart from the holder, by the person expressly authorized by him.

*According to the law, the Office is not obliged to inform the holder of a trademark about the expiration of a ten-year period of protection. However, before the expiration of such period, the Office does inform the holder not having a representative about such expiration, and invite him to pay the fees and procedural charges. The Office intends to keep such practice in the future.*

A request for the renewal shall contain (Article 22 of the Regulations):

1. the number of the registration of the trademark;
2. the name and address of the holder of the trademark;
3. the name and address of the person filing the request, in accordance with Article 32 of this Regulations;
4. the name and address of the representative, in accordance with Article 32 of this Regulations, if the person filing the request has a representative;
5. an indication to the effect whether the renewal is requested for all the goods or services, or only for some of the goods or services for which the trademark is registered;
6. the signature or the seal of the person filing the request, or the signature or the seal of her/his representative.

Indications from the request shall be specified either on the Ž-3 form, which forms part of the Regulations, or on any form, which corresponds to the contents of the Ž-3 form.

In addition to the above mentioned, the person filing the request shall file a list of the goods and/or services for which the trademark is registered, and shall indicate whether the request relates to all or a part of the registered goods and/or services, and the registration shall be renewed only for such goods and/or services.

The person filing the request shall pay the prescribed fee and procedural charges for the renewal, and shall present evidence to that effect.

The holder may also file the request and pay the fee and procedural charges in an additional period of six months after the expiration of the last year of protection. In such a case, he shall pay the fee and procedural charges in a double amount. The holder, who fails to file the request and pay the fee and procedural charges in the additional period of six months, may not file a request for restitutio in integrum, because it concerns a period in relation to which restitutio in integrum is prescribed by AGAP. Also, the holder cannot request for continued proceeding, if he failed to file a request for renewal of the trademark and pay the fee and procedural charges in an additional period of six months (please refer to item 2.4.5).



If the person filing the request fails to pay the fee and procedural charges for renewal, the request shall be rejected, and the trademark shall cease to have effect.

If the holder fails to file a request for renewal, the trademark shall cease to have effect on the day on which the period of protection has expired.

For the remedy of deficiencies see paragraph 6.5.6.

#### 6.7 Surrender of a Trademark (Article 45 of the Act)

The Office shall enter the surrender of a trademark in the register, if the holder submits a written declaration to the effect that he surrenders the trademark in respect of some or all of the goods and/or services for which it is registered. A representative shall have an express authorization for surrender indicated in the power of attorney, otherwise, the Office shall invite her/him to correct deficiencies contained in its power of attorney.

If a license has been entered in the register, the surrender of the trademark shall only be entered in the register if the holder of the trademark proves that he has informed the licensee of his intention to surrender the trademark.

A trademark shall cease to have effect on the day on which the holder has submitted his declaration of surrender.

#### 6.8 Revocation (Articles 46 – 48 of the Act, Article 24 of the Regulations)

A request for the revocation of a trademark may be filed with the Office by any natural or legal person. A separate request for the revocation of a trademark shall be filed for any trademark in respect of which the request is filed.

A trademark may be revoked if, within a continuous period of five years, it has not been put to genuine use in the Republic of Croatia in relation to the goods and/or services in respect of which it is registered, unless there are justified reasons for non-use.

Apart from for non-use, a trademark may also be revoked if, after the date on which it was registered, it has become a common name in the trade for products or services in respect of which it is registered, or if it, in consequence of the use (by the holder or with his authorization), is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

A request for the revocation shall contain

1. the number of the registration of the trademark in respect of which the request is filed;
2. the name and address of the holder of the trademark;
3. the name and address of the person filing the request, in accordance with Article 32 of this Regulations;
4. the name and address of the representative, in accordance with Article 32 of this Regulations, if the person filing the request has a representative;
5. a list of the goods or services in respect of which the request is filed;
6. reasons for filing a request for the revocation of a trademark;
7. the signature or the seal of the person filing the request, or the signature or the seal of his representative;
8. evidence of payment of the prescribed fee and procedural charges.

The Office shall examine whether the request complies with the basic requirements. If the request for the revocation is filed before the expiration of a period of five years from the registration of the trademark the revocation of which is requested, and if it is not filed on the grounds specified above, the Office shall reject it.

If the request does not contain the indications referred to in the Regulations, the Office shall invite the person filing the request to remedy the deficiencies found in the request within a period of 60 days. This period may be extended for not more than 60 days.

If the holder of the trademark in respect of which the revocation is requested fails to submit his observations within the prescribed time limit, the trademark shall be revoked for such goods and services in respect of which the request was filed.

If the holder submits his observations, the Office shall forward a copy of the observations by the holder of the trademark to the person filing the request and invite him to submit his observations thereon within 60 days upon receipt of the invitation. This period may be extended for not more than 60 days.

The Office shall examine the justification of the grounds specified in the request for the revocation of the trademark and it may invite the parties to submit additional evidence. If the party fails to comply with the invitation within the prescribed time limit (60 days, possibly extended for 60 days), the Office shall decide on the basis of the already available facts.

It may not be requested that a trademark be revoked where genuine use of the trademark has been started or resumed during the interval between the expiration of a five-year period of non-use and filing of the request for revocation. 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.

If, in the examination procedure, the Office finds that the request is justified, it shall enter the revocation in full or partially in the register of trademarks and shall publish it in the Office official gazette, including the date of filing the request for revocation when the revocation became effective. The decision to that effect shall be sent to the person who has filed the request and to the holder of the trademark. If the Office finds that the request is unjustified, the request shall be refused, and the notification to that effect shall be sent to both parties.

#### 6.9 Declaration That the Trademark is Invalid

If, in the examination procedure, the Office finds that the request for the declaration that a trademark is invalid is justified, it shall enter the invalidity of the trademark in full or partially in the register of trademarks, and shall publish it in the Office official gazette; it shall be considered invalid from the date of applying for the trademark registration.