

BOGA & ASSOCIATES

NEWSLETTER

To keep you up to date with the latest legal and economic developments, this newsletter prepared by our Team provides information that may affect the operation of your business in Kosovo.

New Law
“On Trademarks”

New Law “On Trademarks”

On 23.06.2022, the Assembly of Kosovo adopted Law no. 08/L-075 “On Trademarks” (“**New Law**”) which sets out new rules in the field of trademark protection.

The newly adopted law is partially harmonized with EU Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 on the approximation of the laws of the Member States relating to trademarks and Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the Enforcement of Intellectual Property Rights.

The main novelties introduced by the New Law are:

The definition of criteria for well-known trademarks is foreseen to be regulated with a sub-legal act that will be issued by the Minister. The specification of the well-known criteria will help, in particular, parties involved in the opposition procedures.

The transfer of the enterprise ownership shall also include the transfer of the trademark. This is excluded only in cases when in the transfer agreement it is specifically stated that trademarks are not transferred along with the enterprise.

The license contract is regulated by the new provisions. The trademark may be licensed for part or all goods or services for which it is registered, for all or part of the territory of Kosovo. A license may be exclusive or non-exclusive.

The holder of the trademark may claim the rights acquired by that trademark against the licensee who opposes any provision in his licensing contract regarding: its duration; the area covered by the registration in which the trademark may be used; scope of the goods or services for which the license contract has been granted; the territory in which the trademark may be affixed; or quality of goods produced or services provided by the licensee.

Without prejudice to the provisions of the license contract, the licensee may proceed with trademark infringement only if its holder agrees to it. However, the holder of an exclusive license may initiate such a procedure if the trademark holder, after official notification, does not initiate the infringement procedure himself within a reasonable period.

The licensee has the right to intervene in the infringement procedure initiated by the holder of the trademark for compensation of the damage suffered by him.

Upon request of one of the parties, the license contract shall be filed with the Trademark Register. The copy of the licensing agreement, or part of that agreement for the grant of the license made in writing and signed by both parties, is submitted to the Industrial Property Agency, upon payment of the respective fee for the registration of the license in the Trademark Register.

The trademark owner may file a lawsuit against any person who has infringed a trademark by performing, without authorization, any of the acts referred to in Article 9, 10 or 12 of the New Law by claiming: establishment of trademark rights infringement; distancing oneself from the act of infringement, termination of the infringement and prohibition of such and similar future infringements.

In addition to the above, the trademark owner may request appropriate measures: withdrawal from trade channels or seizure of goods established to infringe the trademark right and in appropriate cases, materials that are used for the creation or production of those goods; the removal of the infringed mark, or where this is not possible, the final removal of the goods bearing the infringed trademark from trade channels; and destruction of those goods.

The court shall, in considering the request for the above measures, take into account the need for proportionality between the seriousness of the violation and the legal remedies undertaken, and the interests of third parties. The court shall order the execution of these measures to the detriment of the trademark infringer, unless there are special reasons for such non-implementation.

In order to prevent the continuation of the trademark infringement, the court may issue against the infringer a fine in the amount of five thousand (5,000) to ten thousand (10,000) Euro for each infringement in favor of the holder.

When the infringer did not know or could not have known that was committing an infringement, the court may order the recovery of the profits that the infringer gained from the unauthorized use of the trademark, according to the general rules for unjust enrichment or payment of damages, which can be predetermined.

Claims may be filed within three (3) years from the date the applicant was aware about the infringement and the infringer and no later than five (5) years from the date of the infringement or the date of the latest infringement where the infringement occurs continuously.

During the procedure, in relation to the infringements of trademark rights, as the case may be, the provisions of the relevant law "*On Contested Procedure*" and the law "*On Obligational Relationships*" will apply.

Additional novelties will enter into force with the New Law, such as provisions on the: non-use as protection in infringement proceedings; Proofs-Claim for provision of information; provisional and preventive measures; exhaustion of rights, Literal Interpretation of Class Headings, Additional Absolute and Relative Grounds for Refusal, The Non-Use Defense, the right of the trademark holder to

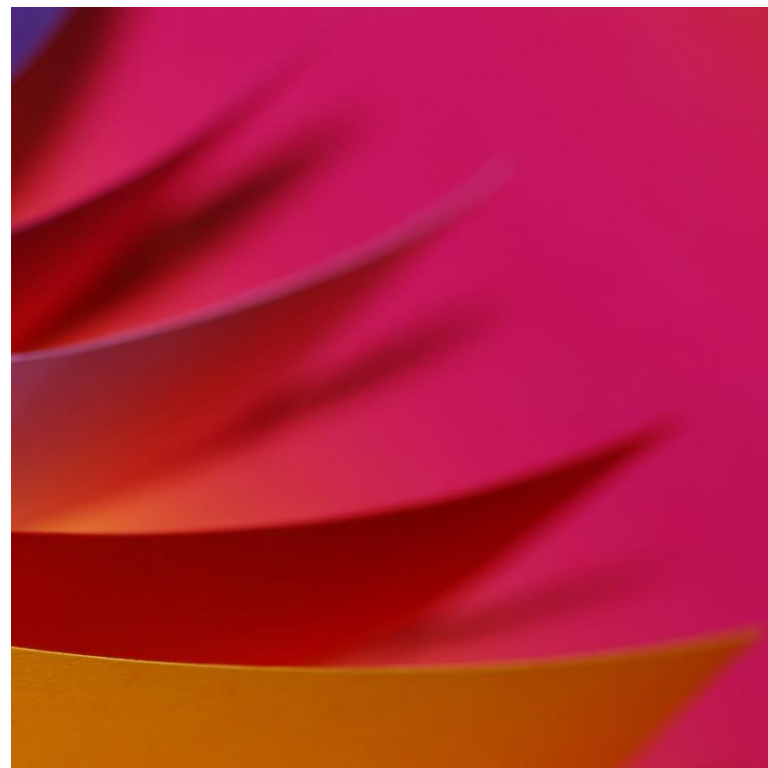
intervene later in order to protect himself in the infringement proceedings.

The following changes have been made on the punitive provisions:

- A natural person who conducts individual business during the exercise of its commercial activity is punished with a fine in the amount of one thousand (1,000) Euro to three thousand (3,000) Euro, who acts in contradiction with Article 9 of this law.
- A natural person who acts in contrary to Article 9 of the law shall be punished by a fine in the amount from two hundred (200) Euro to three hundred (300) Euro.

The New Law has abrogated provisions regarding international trademark registration and community trademark.

The New Law, published in the Official Gazette on 13.07.2022 entered into force on 28.07.2022.





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Chambers Europe 2022: Ranked **Band 1** in 3 practice areas

The Legal 500 2022: Ranked **Tier 1** in Legal Market Overview

Benchmark Litigation Europe 2022: Top Ranked in Dispute Resolution

WTR1000 2022: Top Ranked in Trademarks

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