



The International Comparative Legal Guide to:

Trade Marks 2013

2nd Edition

A practical cross-border insight into trade mark work

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General Chapters:

1	The Race for “Modernity” in Shaping Trade Mark Policy Around the World – 2012 Developments - John Olsen, Edwards Wildman	1
2	Admissibility of Trade Mark Revocation Actions: Discrepancies Between the European and the French Approaches - Frank Valentin, De Gaulle Fleurance & Associés	4

Country Question and Answer Chapters:

3	Albania	Boga & Associates: Renata Leka & Ened Topi	9
4	Australia	Gilbert + Tobin: Lisa Lennon & Lauren Eade	17
5	Austria	Hausmaninger Kletter Attorneys-at-Law: Dr. Leonhard Reis	26
6	Belgium	Baker & McKenzie: Pierre Sculier & Elisabeth Dehareng	34
7	Brazil	Kasznar Leonardos Intellectual Property: Filipe da Cunha Leonardos & Claudio Roberto Barbosa	44
8	Canada	Bereskin & Parr LLP: Daniel R. Bereskin, Q.C. & Cynthia Rowden	54
9	Chile	Beuchat, Barros & Pfenniger: Andrés Melossi	61
10	China	CCPIT Patent and Trademark Law Office: Chumeng (Jessica) Xu	68
11	Cyprus	Papacharalambous & Angelides L.L.C: Eleni Papacharalambous & Coralía Papacharalambous	76
12	Czech Republic	Johnson Šťastný Kramář, advokátní kancelář, s.r.o.: Roman Šťastný & Eva Haisová	84
13	Ecuador	Quevedo & Ponce: Alejandro Ponce Martínez & Roque Albuja Izurieta	93
14	European Union	Bristows: Paul Walsh & David Kemp	99
15	France	Armengaud & Guerlain: Catherine Mateu	107
16	Germany	Hengeler Mueller: Dr. Wolfgang Kellenter & Dr. Andrea Schlaffge	115
17	Greece	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	123
18	Hong Kong	Ella Cheong (Hong Kong & Beijing) Limited: Coral Toh & Vincent Oey	131
19	Hungary	Danubia Patent & Law Office: Michael Lantos	139
20	India	Subramaniam, Nataraj & Associates, Patent & Trademark Attorneys: Hari Subramaniam	145
21	Italy	Avvocati Associati Franzosi Dal Negro Setti: Vincenzo Jandoli & Dario Palmas	153
22	Japan	Anderson Mori & Tomotsune: Yasufumi Shiroyama & Ai Nagaoka	161
23	Kosovo	Boga & Associates: Renata Leka & Ened Topi	168
24	Luxembourg	Loyens & Loeff, avocats à la Cour: Véronique Hoffeld	175
25	Macedonia	Pepeljugin Law Office: Professor Dr. Valentin Pepeljugin & Ana Pepeljugin	183
26	Malaysia	Tay & Partners: Su Siew Ling & Joanne Kong	193
27	Mexico	Olivares & Cia.: Alonso Camargo & Daniel Sanchez	202
28	Nigeria	Banwo & Ighodalo: Femi Olubanwo & Chinasa Uwanna	210
29	Philippines	SyCip Salazar Hernandez & Gatmaitan Law Offices: Vida M. Panganiban-Alindogan & Enrique T. Manuel	218
30	Portugal	Abreu Advogados: João Veiga Gomes & João Gonçalves Assunção	226
31	South Africa	DM Kisch Inc.: Andrew Papadopoulos & Derek Momberg	236
32	Spain	ELZABURU: Fernando Ilardia & Luis Baz	243
33	Switzerland	ThomannFischer: Daniel Plüss	253
34	Taiwan	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	260
35	Ukraine	Vasil Kisl & Partners: Oleksandr Mamunya & Yulia Chyzhova	270
36	UAE	Abu Ghazaleh Intellectual Property (AGIP): Amjad El Husseini & Karim El Gebaily	278
37	United Kingdom	Bristows: Paul Walsh & David Kemp	285
38	USA	Edwards Wildman: David I. Greenbaum & H. Straat Tenney	294
39	Vietnam	Pham & Associates: Pham Vu Khanh Toan	301

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Albania

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1 Relevant Authorities and Legislation

1.1 What is the relevant Albanian trade mark authority?

The relevant trademark authority is the General Directorate of Patents and Trademarks (“GDPT”).

1.2 What is the relevant Albanian trade mark legislation?

The main applicable legislation is the following:

- Law no. 9947, dated 07.07.2008 “On industrial property” and its sub-legal acts (“Law on Industrial Property”).
- Law no. 7850, dated 29.07.1994 “The Civil Code of the Republic of Albania”, as amended.
- Law no. 8116, dated 29.03.1996 “The Civil Procedure Code of the Republic of Albania”, as amended.
- Law no. 7895, dated 27.01.1995 “The Criminal Code of Republic of Albania”, as amended.
- Law no. 7905, dated 21.03.1995 “The Criminal Procedure Code of the Republic of Albania”, as amended.
- Law no. 8449, dated 27.01.1999 “The Customs Code of the Republic of Albania”, as amended.
- Council of Ministers Decision no. 205, dated 13.04.1999 “On implementing provisions of the Customs Code”, as amended.
- Law no. 10433, dated 16.06.2011 “On Inspection in the Republic of Albania”.

The following international laws also apply:

- World Intellectual Property Organization Madrid Convention.
- Paris Convention for the Protection of Industrial Property.
- Madrid Agreement on the System for the International Registration of Marks.
- Madrid Protocol related to the System for the International Registration of Marks.
- Nice Agreement concerning the International Classification of Goods and Services for the Purposes of Registration of Marks.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Every sign or combination of signs presented graphically that serves to distinguish the goods or services of a natural/legal person

from those of another, is eligible to constitute a trademark. To this end, the following signs can be registered:

- a) words, including personal names, letters, numbers, abbreviations;
- b) figurative signs, including drawings;
- c) two- or three-dimensional forms, forms of goods and/or their packaging;
- d) combinations of colours or shades, as well as colours *per se*; and
- e) every combination of the above mentioned signs.

2.2 What cannot be registered as a trade mark?

Signs that are not likely to be represented graphically are not registered. The GDPT (*ex-officio* action) will not register a trademark based on absolute grounds for refusal and on relative grounds for refusal following opposition to the publication of the trademark by interested parties. In case of registration of the trademark, the same can be challenged before the court sustaining the above mentioned grounds.

2.3 What information is needed to register a trade mark?

The following documents should be filed with the GDPT:

- a) application form FM1;
- b) specification of the name and address of the applicant;
- c) extract from the Commercial Register (or similar document) where the natural/legal person is registered;
- d) the list of goods and services according to classification of the Nice Agreement;
- e) 8 (eight) samples for each trademark to be registered measuring 8cm x 8cm;
- f) special Power of Attorney granting powers to the trademark attorney for the filing of the request with the GDPT;
- g) the specification of the trademark details to be registered (word, device, colours);
- h) priority declaration, if applicable; and
- i) evidence of payment of the official fee.

2.4 What is the general procedure for trade mark registration?

Following the filing of an application as indicated in question 2.3 above, the GDPT within three months will examine the application from a formal point of view (if documents indicated in question 2.3 above have been duly filed). Provided that the application is duly

filed, the formal examination is followed by the publication of the application with the Bulletin of the GDPT. The application will be published for a period of three months with the Bulletin in order for interested parties to oppose the trademark intended to be registered. With the elapsing of the said term, the GDPT performs a thorough examination of the application (eligibility as per questions 2.1 and 2.2 above) and provides for the registration with the Register of Trademarks kept by the GDPT and publication with the Bulletin.

2.5 How can a trade mark be adequately graphically represented?

According to the Decision Council of Ministers no. 1706, dated 29.12.2008 "On the approval of the regulation for registration of trademarks", the depiction format should measure 8cm x 8cm.

2.6 How are goods and services described?

Goods and services are described in line with the latest version of the international classification set forth by the Nice Agreement.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by an Albanian trade mark?

The trademark will receive protection in the Republic of Albania and, if required (by way of direct registration/extension), also internationally following the rules of the Madrid Agreement and its Protocol.

2.8 Who can own an Albanian trade mark?

Either foreign or domestically based natural/legal persons may own a trademark.

2.9 Can a trade mark acquire distinctive character through use?

A sign may acquire distinctive character through use (before the application date) and, as such, may be eligible for registration as a trademark.

2.10 How long on average does registration take?

Starting from the application date, provided that the application is duly filed with the GDPT and no opposition is filed during the publication period, the whole process would take approximately 9 months.

2.11 What is the average cost of obtaining an Albanian trade mark?

The official fees applicable for registering trademarks are set out in the Decision of Council of Ministers no. 883, dated 13.05.2009 "On the approval of fees for registration of Industrial Property objects" as amended. Based on its provisions, the official applicable fees are as follows:

- Application fee for one trademark in one class is ALL 5,000 or approx. EUR 35.
- Application fee for any additional class is ALL 2,500 or approx. EUR 18.
- Registration fee is ALL 6,500 or approx. EUR 45 (regardless of the classes).

For searches and eventual extracts, the fee applicable is ALL 500 each or approx. EUR 3.50.

2.12 Is there more than one route to obtaining a registration in Albania?

The trademarks receive protection by filing a request for registration with the GDPT (national registration), and internationally following the rules of the Madrid Agreement and its Protocol, by way of direct registration or extension request.

2.13 Is a Power of Attorney needed?

Yes, if the applicant appoints a trademark attorney.

Foreign entities are required to engage local based trademark attorneys for filing of the request for registration.

2.14 How is priority claimed?

An application for registration may contain a declaration claiming priority if it is equivalent to an earlier and regular national application, pursuant to:

- a) the national legislation of a member state of Paris Convention; and
- b) the national legislation of a member of the World Trade Organization.

The application will benefit from priority from the date of the first application in the country of origin provided that the application is filed with the GDPT within 6 months from the filing date of the first application.

The applicant, in order to benefit from the priority, should indicate in the application, the date, place and number of the first application and provide the GDPT within 3 months from the submitting of the request with a copy of the first application translated into the Albanian language.

Priority rights from international expositions/fairs are also recognisable in Albania. To this end, applicants participating in recognised expositions in the Republic of Albania or of another country being a member of the Paris Convention, within 6 months may apply for the registration of the trademark claiming as priority date the exhibition date. The application for registration is accompanied by a certificate issued by the respective authorities of the member state of the Paris Convention and a document showing the kind of exposition/fair, the place where it was organised, the opening/closure date and the first day of the exhibition of the goods and/or services indicated in the application for registration of the trademark.

2.15 Does Albania recognise Collective or Certification marks?

Yes, collective trademarks are recognised by Albanian law. Certification trademarks are not recognised in Albania.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

The sign has to be graphically represented and should have a distinctive character, otherwise it will not be registered.

The sign cannot be registered as a trademark if it consists:

- a) exclusively of elements or indicators that may serve in the market to indicate the kind, quality, quantity, purpose, value, geographical origin or time of production of the goods or the performance of the services, or other characteristics of the goods or services;
- b) exclusively of elements or indicators that have become customary in daily language or have become customary in the course of trade;
- c) of shapes or lines imposed by the very nature of the goods or services and/or forms or lines essential to achieve a technical result;
- d) of shapes that give a fundamental value to the goods;
- e) of elements that affect public interests or are in conflict with public moral and order;
- f) of elements tending to disorient the public, principally so far as concerns the nature, quality or geographical origin of the goods and/or services that they aim to distinguish;
- g) of geographical indications, for wines or alcoholic beverages, that do not originate from the place indicated by the geographical indication in question, even if the true origin of the good has been indicated or the geographical indications have been translated and are accompanied by such expressions as: “kind”; “type”; “style”; “imitation”; or similar;
- h) of names, portraits, personal pseudonyms, well known by the public in the Republic of Albania, if they are not authorised by the person or its descendant; or
- i) of elements conflicting with article six *bis* of the Paris Convention.

Or if it consists of:

- names of countries (complete or abbreviated);
- state emblems, medals, honours of distinction;
- official seals and signs approved by the country;
- the emblems of recognised international organisations or their abbreviations;
- religious symbols; or
- national flags.

3.2 What are the ways to overcome an absolute grounds objection?

The gaining of a distinctive character before the date of application for registration of the trademark will make the sign eligible for receiving protection through registration.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision of the GDPT on the refusal of the registration of the trademark may be appealed by the applicant in front of the Board of Appeal. The Board of Appeal is a body structured and organised under the GDPT.

3.4 What is the route of appeal?

Within 2 months from the date of receipt of GDPT’s notification on the refusal of the application for registration of the trademark, the applicant is entitled to appeal with the Board of Appeal by submitting the following documents:

- a) application form FM10 of the appeal signed by the applicant or its representative;
- b) document evidencing the payment of the official fee; and
- c) Special Power of Attorney.

The Board of Appeal shall examine the request on the appeal within 3 months from the filing date and shall notify in writing the applicant on its decision.

During the examination, the Board of Appeal may ask the applicant to provide additional documents within one month from the date of notification.

The decision of the Board of Appeal may be challenged in front of the First Instance Court of Tirana within 30 days from the notification date.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

According to the provisions of the Law on Industrial Property, the trademark shall not be registered or, if registered, shall be held invalid:

- a) if it is identical with an earlier trademark, and the goods or services for which the trademark is applied for or is registered are identical with the goods or services for which the earlier trademark is protected;
- b) if it is identical with, or similar to, an earlier trademark which is protected for identical or similar goods of services, and if, because of the identity or similarity, a likelihood of confusion by the public exists, which includes the likelihood of association with the earlier trademark; or
- c) if it is identical with, or similar to, an earlier trademark, even when it is about to be, or has been, registered for goods or services which are not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Republic of Albania, and the use or registration, without due cause, takes unfair advantage of, or damages, the distinctive nature or the good name of the earlier trademark.

Additionally, the trademark cannot be registered, or, if registered, shall be held invalid if it infringes other prior rights that have been obtained such as:

- a) the right of trade name, save that this name or the fundamental part of it shall be identical or similar to the trademark intended to be registered, and the owner of the trade name produces or provides, respectively, goods or services that are identical or similar to those of the trademark that is intended for registration;
- b) the right of a person whose name, surname or external appearance is identical or similar to the trademark intended to be registered;
- c) industrial property rights, including the names of protected varieties of plants and/or animals and geographical indications; or
- d) copyright in a work or piece of work, on the condition that it is identical or similar to the trademark intended for registration.

4.2 Are there ways to overcome a relative grounds objection?

The applicant should reach an agreement on the co-existence of the trademarks with the right holder.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Same conditions as per question 3.3.

4.4 What is the route of appeal?

Same conditions as per question 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

During the publication period with the Bulletin of the GDPT, the interested parties may challenge the registration of the trademark on the basis of the relative grounds for refusal.

5.2 Who can oppose the registration of an Albanian trade mark?

Every natural/legal person whose earlier rights as per question 4.1 are prejudiced by the trademark intended for registration has the right to oppose the registration.

5.3 What is the procedure for opposition?

The opposition is filed with the Board of Appeal of the GDPT within 3 months from the publication date of the trademark. Provided that the opposition request is duly filed (otherwise it will be considered as not filed), the Board of Appeal shall award its decision within 3 months from the filing date.

The decision of the Board of Appeal can be challenged in front of the court within 30 days from the notification date.

6 Registration

6.1 What happens when a trade mark is granted registration?

The owner of a registered trademark has the exclusive right of use of the trademark.

The owner of the trademark is entitled to impede any third party from using, in the course of trade, without its authorisation:

- a) a sign that is the same for goods or services with those covered by its trademark;
- b) a sign that is identical or similar to the trademark or, because of the goods or services being identical or similar for which the sign is used, with the goods or services covered by the registered trademark, the former may cause a likelihood of confusion to the public where it is included the possibility of association of the sign with the trademark; and
- c) the same or similar sign for goods or services even when they are not either identical or similar to those for which the trademark is registered, in case the trademark has a reputation in the Republic of Albania and from the use of the sign, without due cause, an unfair benefit is created or is harmed the distinctive nature or good name of the trademark.

Based on the above, the following are also prohibited:

- putting the sign onto goods or on their packaging;
- putting goods into the market, offering them for sale, by using this sign, or creating stockpiles for these purposes;
- offering of services by using this sign;
- importing or exporting of goods by using this sign; and
- using the sign in business and in advertisements.

6.2 From which date following application do an applicant's trade mark rights commence?

The trademark enjoys protection starting from the filing date.

6.3 What is the term of a trade mark?

The term of protection is 10 years, which is renewable.

6.4 How is a trade mark renewed?

The trademark can be renewed perpetually, upon filing a request for renewal 6 months before expiry or 6 months after the elapsing of the protection term, upon payment of a fine.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Natural/legal persons can transfer all or part of their rights on the trademark through written agreement to be registered with the GDPT.

7.2 Are there different types of assignment?

All permitted transactions on transfer of rights under the Albanian Civil Code apply.

7.3 Can an individual register the licensing of a trade mark?

Natural/legal persons can enter into licensee agreements on an exclusive or non-exclusive basis.

7.4 Are there different types of licence?

The licence agreement might be entered into for exclusive or non-exclusive basis.

7.5 Can a trade mark licensee sue for infringement?

The consent of the right owner is required unless in the licence agreement it is provided for the contrary.

Under the licence agreement on exclusive basis, the licensee can file a lawsuit without the consent of the owner in case the latter, being duly notified by the licensee, fails to take appropriate actions.

7.6 Are quality control clauses necessary in a licence?

Yes, the licence agreement may provide for such a clause.

7.7 Can an individual register a security interest under a trade mark?

Yes, the trademark is subject to a security interest to be registered with the Securing Charges Register.

7.8 Are there different types of security interest?

The trademarks are granted as collateral based on the securing in

charge agreement to be registered with the Securing in Charge Register.

8 Revocation

8.1 What are the grounds for revocation of a trade mark?

The registration of a trademark is revoked when:

- a) its owner has not used the trademark for an uninterrupted period of 5 years;
- b) as a consequence of acts or inactivity of the owner, the trademark has become an ordinary name in the market; or
- c) as a consequence of the use made by the owner or with its consent for the goods or services for which the same is registered, the trademark disorients the public, principally about the nature, quality or geographical origin of the goods or services.

8.2 What is the procedure for revocation of a trade mark?

Third interested parties may address the First Instance Court of Tirana requiring the revocation of the trademark. The decision is appealable in front of the Appeal Court of Tirana and afterwards (if applicable) in front of the Supreme Court.

8.3 Who can commence revocation proceedings?

The lawsuit is filed by the interested parties.

8.4 What grounds of defence can be raised to a revocation action?

In first place, the revocation cannot be claimed adducing the 5-year period of non-use, in case during the interval between expiry of the 5-year period and the filing of the application or of the claim, the genuine use of the trademark has been started or resumed.

Additionally, the revocation of the trademark cannot be claimed when:

- a) it has been used by a licensee or another person when this is permitted by the owner, or by any person who has the authority to use a collective trademark;
- b) it has been used in a form which differs only in elements, that do not alter the distinctive character of the trademark;
- c) it has been affixed to goods or to the packaging thereof in the Republic of Albania solely for export purposes; and
- d) it has been used for publicity and business correspondence.

8.5 What is the route of appeal from a decision of revocation?

The interested parties may file an appeal with the Appeal Court of Tirana.

9 Invalidity

9.1 What are the grounds for invalidity of a trade mark?

The invalidity is declared where absolute/relative grounds of refusal exist.

9.2 What is the procedure for invalidation of a trade mark?

A lawsuit may be filed by the interested party with the First Instance Court of Tirana.

9.3 Who can commence invalidation proceedings?

The invalidation proceeding can be initiated by interested parties.

9.4 What grounds of defence can be raised to an invalidation action?

In case the trademark *in interim* has achieved distinctive character, the same is not invalid but the priority date shall be shifted in order to coincide with such date.

Invalidation of the trademark cannot be claimed based on the grounds that infringe the rights of an earlier trademark, in case the latter is not used for a period of 5 years.

9.5 What is the route of appeal from a decision of invalidity?

The decision of the court is appealed before the Appeal Court of Tirana.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

There are no specialised courts in Albania dealing with IPR infringements. The interested parties should address their claim with the Commercial Section of the First Instance Court of Tirana.

10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

With the preparatory acts, the court asks the plaintiff to complete the lawsuit with elements required by the law, if necessary, and sets out the date for the preliminary hearing in order to convene the defendant or third parties who may provide their arguments and submit their evidences. The first hearing shall take place within 15 days at the latest.

10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

With the preliminary injunctions, the court may:

- a) impede imminent infringements or infringements that have started;
- b) prohibit the entry of the goods into civil circulation;
- c) order the preservation of relevant evidence in respect of the alleged infringement, subject to the protection of confidential information;
- d) seize, take out of circulation or take under control, for the period of the proceedings, the items that constitute infringement or the means used for the production of the items that constitute infringement; or
- e) order, in the case of an infringement committed on a commercial scale and if the injured party demonstrates circumstances likely to endanger the recovery of damages,

the precautionary seizure of the movable and immovable property of the alleged infringer, including the blocking of the bank accounts and other assets.

With the final decision, the court orders:

- a) prohibition of further acts that constitute infringement of the rights;
- b) removal of the items that constitute infringement from the civil circulation, or in case it is not possible, their destruction;
- c) removal of means used exclusively or almost exclusively for the creation of the infringing goods or, in case it is not possible, their destruction; and
- d) publication of the final decision of the court in the public media at the expense of the infringer as prescribed by the court.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

During the civil proceedings, the court may order that information on the origin and distribution network of the infringing goods or services be provided by the infringer and/or any other person who is:

- a) found in possession of the infringing goods on a commercial scale;
- b) found to be using the infringing services on a commercial scale;
- c) found to be providing on a commercial scale services used in infringing activities; or
- d) indicated by the person referred to in point “a”, “b” or “c” above as being involved in the production, manufacture or distribution of the goods or the provision of the services.

The information as per above cannot be obtained in case:

- a) on the basis of the information available, the court has reason to assume that the right to information is misused;
- b) providing the requested information would force the alleged infringer to admit its own participation or that of its close relatives in the infringement of the trademark; or
- c) disclosure of the information cannot be requested pursuant to provisions protecting the confidentiality of information sources or the processing of personal data.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

The evidence is submitted in writing. Yes, cross-examination of witnesses is possible.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The court may suspend the civil proceeding where the case cannot be solved before another case (criminal, civil or administrative) is solved.

10.7 After what period is a claim for trade mark infringement time-barred?

The lawsuit should be filed within 3 years from the date the plaintiff becomes aware of the infringement and the identity of the infringer.

10.8 Are there criminal liabilities for trade mark infringement?

Pursuant to paragraph c) of article 149/a of the Albanian Criminal Code, the intentional manufacturing, possession for commercial purposes, selling, offering to sell, supplying, exporting or importing of goods or services covered by a trademark without the consent of the trademark owner constitutes criminal contravention punishable with a fine or by imprisonment up to one year.

10.9 If so, who can pursue a criminal prosecution?

The Public Prosecutor can pursue a criminal prosecution.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

This is not applicable.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Basically, the defendant should demonstrate that its trademark does not fall under the so-called relative grounds for refusal.

11.2 What grounds of defence can be raised in addition to non-infringement?

The defendant can argue that the plaintiff did not use the trademark for a period of 5 consecutive years or that it has accepted usage of the alleged infringing trademark without taking any action for a period of 5 consecutive years.

12 Relief

12.1 What remedies are available for trade mark infringement?

Damage relief consisting of the damages suffered plus loss of profit is available. Also the moral damages, if claimed, are liquidated if deemed necessary by the court.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

Yes, the costs of the civil proceedings are attached to the losing party.

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The decision of the First Instance Court of Tirana is appealable in front of the Appeal Court of Tirana.

13.2 In what circumstances can new evidence be added at the appeal stage?

The Appeal Court of Tirana decides whether to accept new evidence or not.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

Customs authorities on *ex-officio* basis or through *ex-parte* request provide for actions to prevent the import-export of the alleged infringing goods. To this end, the right holder (owner, licensee) should file a request with the authorities. Following examination of the request, customs authorities will award protection for up to 1 year. With the creation of the customs watch, the customs will seize and, where the case will provide the right holder with the faculty to, destroy the infringing goods (with the agreement of the holder of the goods).

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in Albania?

This is not applicable.

15.2 To what extent does a company name offer protection from use by a third party?

In the course of application for registration with the Commercial Register, natural/legal persons cannot register a name which is identical or similar with an earlier registered company name.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The abovementioned rights are covered by copyright law.

16 Domain Names

16.1 Who can own a domain name?

Natural/legal persons locally incorporated and individuals can own a domain name.

16.2 How is a domain name registered?

Parties should file an application request with the Authority on Electronic and Postal Communication.

16.3 What protection does a domain name afford *per se*?

Once the domain name is registered, no other can file a request for registering identical domain names.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

Amendments that occurred to the Criminal Code were the most significant development during last year.

17.2 Are there any significant developments expected in the next year?

Amendments to the Law on Industrial Property are being debated which are expected to pass into law during the current year.

17.3 Are there any general practice or enforcement trends that have become apparent in Albania over the last year or so?

No, there are not.

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Renata is a Partner at Boga & Associates, which she joined in 1998. She is an authorised trademark agent and has ample experience in trademark filing strategy, portfolio management and trademark prosecution and handles a range of international matters involving IPR issues. She manages anti-piracy and anti-counterfeit programmes regarding violation of copyright in Albania and assists an international alliance dedicated to promoting a safe and legal digital world.

For years, Renata has been recognised as "Leading Individual" in "Intellectual Property" in Chambers and Partners, Chambers Europe - "The Europe's Leading Lawyers for Business" (2010-2011-2012). Chambers Europe 2012 praises her for being a "prominent IP specialist".

Renata graduated in Law at the University of Tirana in 1996 and also holds a Practice Diploma in International Intellectual Property Law (2006) and a Practice Diploma in Anti-Trust Law (2009) from the College of Law of England and Wales, UK.

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Boga & Associates, established in 1994, has emerged as one of the premier law firms in Albania, earning a reputation for providing the highest quality of legal, tax and accounting services to its clients. Boga & Associates also operates in Kosovo (Pristina), offering a full range of services. Until 1st of May 2007, the firm was a member firm of KPMG International and the Senior Partner/Managing Partner, Mr. Genc Boga was also Senior Partner/Managing Partner of KPMG Albania.

Our firm's particularity is linked to the multidisciplinary services it provides to its clients. Apart from the wide consolidated legal practice, the firm also offers a significant expertise in tax and accounting services with a keen sensitivity to the rapid changes in the Albanian and Kosovar business environment.

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