



ICLG

The International Comparative Legal Guide to:

Trade Marks 2016

5th Edition

A practical cross-border insight into trade mark work

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EDITORIAL

Welcome to the fifth edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

Three general chapters. These are designed to provide readers with a comprehensive overview of key issues affecting trade mark laws and regulations, particularly from an EU and US perspective.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 41 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the contributing editor John Olsen of Locke Lord LLP for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

The *International Comparative Legal Guide* series is also available online at www.iclg.co.uk.

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1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authority is the Agency for Industrial Property (“Agency”).

1.2 What is the relevant trade mark legislation in your jurisdiction?

The main applicable legislation is the following:

- Law no. 04/L-026, dated 29.07.2011 “On Trademarks” and its sub-legal acts, as amended (“Law on Trademarks”).
- Law no. 03/L-154, dated 25.06.2009 “On Property”.
- Law dated 1978 “On Contracts and Torts”.
- Law no. 03/L-006, dated 30.06.2008 “On Contested Procedure”.
- Law no. 02/L-28, dated 22.07.2005 “On Administrative Procedure”.
- Law no. 04/L-082, dated 20.04.2012 “On Criminal Code of Republic as Kosovo” as amended.
- Law no. 04/L-123, dated 13.12.2012 “On Criminal Procedure Code” as amended.
- Law no. 03/L-109, dated 11.11.2008 “The Customs and Excise Code of the Republic of Kosovo” as amended.
- Law no. 03/L-170, dated 29.12.2009 “On Customs Measures for Protection of Intellectual Property Rights”.
- Law no. 03/L-181 dated 22.07.2010 “On Inspection and Surveillance of the Market”.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Every sign which could be represented graphically, particularly words, including personal names, designs, letters, numbers, the form of goods or their packaging, and colours, as well as a combination of the aforementioned that serve to distinguish the goods or services of an enterprise from another one can be registered as a trademark.

2.2 What cannot be registered as a trade mark?

Signs that are not likely to be represented graphically are not registered. The Agency (*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 the 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 Agency:

- a) application form;
- 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 × 8cm;
- f) special power of attorney granting powers to the trademark attorney;
- g) the specification of the trademark details to be registered (word, device, colours);
- h) information on whether the trademark is used or not in the territory of Kosovo;
- i) priority declaration; and
- j) 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 Agency examines the application from a formal point of view (if documents indicated in question 2.3 above are duly filed) within a three-month period. Provided that the application is duly filed, the formal examination is followed by the publication of the application in the Bulletin of the Agency. The application will be published for a period of three months in the Bulletin in order for parties to oppose the trademark intended to be registered based on absolute or relative grounds for refusal. With the elapsing of the said term, the Agency performs a thorough examination of the application and provides for the registration with the Register of Trademarks and publishes the trademark in the Bulletin.

2.5 How can a trade mark be adequately graphically represented?

A trademark can be adequately graphically represented based on the Instruction on Completion of the Application Form for the Registration of the Trademark issued by the Ministry of Trade and Industry; the depiction format should be 8cm × 8cm.

2.6 How are goods and services described?

Goods and services are described as per 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 a trade mark in your jurisdiction?

The trademark will receive protection in the Republic of Kosovo.

2.8 Who can own a trade mark in your jurisdiction?

Trademarks may be owned either by foreign or domestic natural/legal persons.

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?

It would take approximately nine to 12 months from the filing date.

2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fees applicable for registering trademarks are set out in the Administrative Instruction of the Ministry of Industry and Trade no. 12/2012 "On administrative fees for registration of Industrial Property objects". Based on its provisions, the official applicable fees are as follows:

- The application fee for one trademark in up to three classes is EUR 40.
- The application fee for any additional class is EUR 5.
- The registration fee is EUR 40.
- The registration fee for each additional class is EUR 10.
- The issuance of the certificate is EUR 10.

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

The trademarks receive protection by filing a request for national registration with the Agency.

2.13 Is a Power of Attorney needed?

A power of attorney is required in cases where the applicant acts through an authorised trademark attorney.

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

2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

The power of attorney does not need notarisation and/or legalisation. However, it needs to be duly signed and sealed by the authorised person on behalf of the company.

2.15 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 the 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 Agency within six 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 Agency within three months from the submitting of the request with a true copy of the first application.

Priority rights from international exhibitions/fairs are also recognisable in Kosovo. To this end, applicants participating in recognised exhibitions in the Republic of Kosovo or another country that is a member of the Paris Convention or WTO, within six months may apply for the registration of the trademark claiming as priority date the date of the exhibition. 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 exhibition/fair, the place where it was organised, the opening/closing date and the first day of exhibition of the goods and/or services indicated in the application for registration of the trademark.

2.16 Does your jurisdiction recognise Collective or Certification marks?

Collective and certifications trademarks are recognised by the Republic of Kosovo.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

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

The sign cannot be registered as a trademark, and if registered should be held invalid, if:

- a) it consists 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) it consists exclusively of elements or indicators that have become customary in daily language or used in good faith as well as those that have become customary in the course of trade;
- c) it consists 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) it consists of shapes that give a fundamental value to the goods;
- e) it consists of elements that affect public interests or are in conflict with public morals and order;
- f) it consists 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) the trademark has not been authorised by the competent authorities, pursuant to Article 6 of the Paris Convention;
- h) the use of the trademark is prohibited by provisions of any applicable law;
- i) the trademark contains symbols, emblems and state blazons which have not been specified in Article 6 of the Paris Convention and which are of general interest of the Republic of Kosovo, except in cases when their registration has been permitted by the competent body;
- j) the trademark for wines or alcoholic drinks contains or consists of a geographical indication which identifies such wines or alcoholic drinks not having the indicated origin; and
- k) the trademark contains or consists of a denomination of origin or a geographical indication with effect in the territory of the Republic of Kosovo, if the application for registration of the trademark has been submitted after the application for registration of a denomination of origin or a geographical indication and the denomination/indication are specified under the respective legislation and are identical with the goods covered by the trademark.

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

Gaining 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 applicant is entitled to appeal in front of the Commission. The Commission is created upon the decision of the Minister of Trade and Industry.

3.4 What is the route of appeal?

The appeal request should be filed with the Commission within 15 days starting from the notification of the decision of the refusal

awarded by the Agency. The decision of the Commission can be challenged in front of the Basic Court within 30 days commencing from the notification of the Commission's decision.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

According to the provisions of the Law on Trademarks, the trademark shall not be registered or, if registered, shall be held invalid in the case:

- a) the trademark is identical with an earlier trademark and the goods or services for which the trademark has been submitted are identical with the goods or services covered by the earlier trademark; or
- b) the trademark is identical or similar to an earlier trademark and the goods or services which have been submitted are similar to the goods and services covered by the earlier trademark, and, due to similarity, there exists a likelihood of confusion by the public, which includes the likelihood of association with the earlier trademark.

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 rights holder.

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

The same conditions as per question 3.3 apply.

4.4 What is the route of appeal?

The same conditions as per question 3.4 apply.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

During the publication period in the Bulletin of the Agency, the interested parties may challenge the registration of the trademark either on the basis of the relative or absolute grounds for refusal.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Interested parties may challenge the registration of the trademark either on the basis of the relative or absolute grounds for refusal.

5.3 What is the procedure for opposition?

The opposition is filed with the Agency within three months from the publication date of the trademark.

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

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;
- importing or exporting goods by using this sign; and
- using the sign in business and advertisements.

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

The trademark protection term starts from its 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 six months before its expiry or six months after the elapsing of the protection term, upon payment of twice the fee.

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 over the trademark by way of written agreement.

7.2 Are there different types of assignment?

The assignment is done by way of agreement or by way of a decision of the competent authority (i.e. the courts).

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 on an exclusive or non-exclusive basis.

7.5 Can a trade mark licensee sue for infringement?

The licensee that is party to an agreement on an exclusive basis can sue for infringement.

7.6 Are quality control clauses necessary in a licence?

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

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

Yes, natural/legal persons can register a security interest over the trademark.

7.8 Are there different types of security interest?

The security interest (non-possessory pledge contract) should be filed with the Pledge Register and, upon request of either of the parties, is registered with the Register of Trademarks.

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 five years;
- b) as a consequence of the acts or inactivity of the owner, the trademark has become an ordinary denomination in the market; and
- 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?

The request for revocation should be made in writing and filed with the Agency. The Agency shall notify the owner of the trademark and invite the same to submit its observations within 60 days (extended up to an additional 60 days if requested by the owner) from the notification date. The Agency might provide for a hearing in order to discuss with both parties. The decision is registered with the Register of Trademarks kept by the Agency and published in its Bulletin.

8.3 Who can commence revocation proceedings?

The request is filed by any natural or legal person and any group or entity representing the interests of manufacturers, producers and suppliers of services, entrepreneurs or consumers.

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

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

Additionally, the revocation of the trademark cannot be claimed when the same has been used by the licensee.

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

The interested parties may file an appeal with the Commission within 15 days from the notification of the decision issued by the Agency.

9 Invalidation

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

Invalidity is declared where absolute/relative grounds of refusal exist. Additionally, the trademark is held invalid if its use is prohibited by virtue of an earlier right, such as:

- a) right on a name;
- b) right of personal portrait;
- c) copyright;
- d) industrial property rights; and
- e) when the use of the trademark infringes rights to a sign used in the course of trade in the Republic of Kosovo where it was earlier acquired and that sign confers on its holder the right to prohibit the use of a subsequent trademark.

The trademark is held also invalid in cases where the applicant has acted in bad faith when the filing of the request for a trademark registration took place.

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

The request for invalidation should be made in writing and filed with the Agency. The Agency shall notify the owner of the trademark and invite the same to submit its observations within 60 days (extended up to another 60 days if requested by the owner) from the notification date. The Agency may allow the parties to provide for additional evidence, documents, etc., within 60 days from the notification date.

The decision is registered with the Register of Trademarks held by the Agency and published in the Bulletin.

9.3 Who can commence invalidation proceedings?

An invalidation proceeding can be initiated by interested third parties.

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

A defence against an invalidation action can be raised in the case the trademark *in interim* has achieved distinctive character. Invalidation of the trademark cannot be claimed based on the grounds that infringe the rights of an earlier trademark, in cases where the latter is not used for a period of five years. The invalidation can be challenged on the arguments that the earlier trademark was not considered a well-known trademark in the Republic of Kosovo or the earlier trademark has no reputation in the country up to the moment of priority of the later trademark.

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

The interested parties may file appeal with the Commission within 15 days from the notification of the decision issued by the Agency.

10 Trade Mark Enforcement

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

The party should file a lawsuit with the Commercial Section of the Basic Court.

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

In the preparatory session, the parties should provide the facts and evidence that their claims are based on. The hearing should be held within 30 days after the closure of the preparatory session.

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

With 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; and
- 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.

With the final decision, the court orders:

- a) the prohibition of further acts that constitute infringement of the rights;
- b) the removal of the items that constitute infringement from the civil circulation, their seizure or destruction at the expense of the infringer; or
- c) the 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 civil proceedings, the court may order the provision of information on the origin and distribution network of the infringing goods. To this end, the request is addressed to the following:

- a) the defendant;
- b) the person who, within its economic activities, is in possession of the goods suspected of infringing the trademark;
- c) the person who provides, within its economic activities, services suspected of infringing the trademark;
- d) persons who provide, within their economic activities, services used in the activities suspected of infringing the trademark; and
- e) the person who is indicated by any of the mentioned persons as being involved in the manufacturing or distribution of the goods or the provision of the services suspected of infringing the trademark.

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 applicable legislation is silent on such regard.

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

The lawsuit should be filed within three years from the date the plaintiff becomes aware of the infringement and of the identity of the infringer. In any event, the prescription period for the claims of damage compensation is five years starting from the event of damage.

10.8 Are there criminal liabilities for trade mark infringement?

A criminal offence is punishable by up to three years of imprisonment.

10.9 If so, who can pursue a criminal prosecution?

The Public Prosecutor can pursue 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 five consecutive years or that it has accepted the usage of the alleged infringing trademark without taking any action during the period of five consecutive years.

12 Relief

12.1 What remedies are available for trade mark infringement?

Damage relief consists of the damage suffered plus loss of profit.

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 Commercial Section of the Basic Court is appealable in front of the Appeal Court.

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

New evidence can be brought only in cases where the claimant proves that the non-submission of the new evidence was not its fault.

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 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 one year. With the making available of the customs watch, 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), destroy infringing goods.

15 Other Related Rights

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

The law is silent on this matter.

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

In the course of an application for registration with the Kosovo Business Register, natural/legal persons cannot register a name which is identical or similar to 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 above-mentioned are covered by copyright.

16 Domain Names

16.1 Who can own a domain name?

The Republic of Kosovo has not been awarded a top-level domain name. This is because the country has not been fully recognised internationally.

16.2 How is a domain name registered?

This is not applicable.

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

This is not applicable.

17 Current Developments

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

Law no. 04/L-026, dated 29.07.2011 "On Trademarks" was amended during 2015.

17.2 Please list three important judgments in the trade marks and brands sphere that have issued within the last 18 months.

To the best of our knowledge, there have been no important judgments on trademarks issued by Kosovo courts in the last 18 months.

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

No significant developments are expected.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction 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 international clients in all aspects of the IPR. She is also head of the IPR Committee of the American Chamber of Commerce in Albania and is active in all its activities *vis-à-vis* public authorities in matters of IPR in Albania.

For years, Renata has been recognised as a "Leading Individual" in "Intellectual Property" in *Chambers and Partners* and *Chambers Europe* – "The Europe's Leading Lawyers for Business" (2010, 2011, 2012 and 2013). According *Chambers Europe* 2013, Renata continues to be highly active, and assists a number of international corporations with trademark protection. She is also contributing to *World Trademark Review* magazine for Albania.

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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Armando is an Associate at Boga & Associates, which he joined in 2015.

His practice is mainly focused in intellectual property, corporate law and employment. Armando recent experience covers filing applications before the Albanian Patent and Trademark Office and portfolio management.

Armando graduated Law at University of Tirana (2014) and is pursuing a Master's Degree in Public Law at the University of Tirana.

Armando is fluent in English and Italian.

BOGA & ASSOCIATES

LEGAL • TAX • ACCOUNTING

Boga & Associates, established in 1994, has emerged as one of the premier law firms in Albania, earning a reputation for providing the highest quality legal, tax and accounting services to its clients. The firm also operates in Kosovo (Pristina), offering a full range of services. Until 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.

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

With its diverse capabilities and experience, the firm services leading clients in most major industries, banks and financial institutions, as well as companies engaged in insurance, construction, energy and utilities, entertainment and media, mining, oil and gas, professional services, real estate, technology, telecommunications, tourism, transport, infrastructure and consumer goods. The firm also has an outstanding litigation practice, representing clients at all levels of Albanian courts. This same know-how and experience has been drawn upon by the Legislature in the drafting of new laws and regulations.

The firm is continuously ranked by Chambers and Partners as a "top tier firm" for Corporate/Commercial, Dispute Resolution, Projects, Intellectual Property and Real Estate, as well as by IFLR in Financial and Corporate Law. The firm is praised by clients and peers as a "law firm with high-calibre expertise", being distinguished "among the elite in Albania" and "accessible, responsive and wise".

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