



ICLG

The International Comparative Legal Guide to:

Trade Marks 2016

5th Edition

A practical cross-border insight into trade mark work

Published by Global Legal Group, with contributions from:

Beuchat, Barros & Pfenniger

Boga & Associates

Bolet & Terrero

Camilleri Preziosi

DANIEL Advogados

Ellis & Co.

ELZABURU

Fross Zelnick Lehrman & Zissu, P.C.

Gorodissky & Partners (Ukraine)

GRATA International

Hamdan AlShamsi Lawyers & Legal Consultants

International Trademark Association (INTA)

Jackson Etti & Edu

Jones Day

Koushos Korfiotis Papacharalambous L.L.C.

Law Offices of Patrinos & Kilimiris

Lee International IP & Law Group

Legaltree

Lendvai Partners

LLC "Card Patent"

Locke Lord LLP

Lubberger Lehment

Miller Thomson LLP

Nomenius

OLIVARES

PATENTNA PISARNA D.O.O.

Patice IP Legal

Pham & Associates

Popovic Popovic & Partners

Quevedo & Ponce

Ropes & Gray LLP

Schwärzler Attorneys at Law

Shobayashi International Patent & Trademark Office

Simba & Simba Advocates

Sołtysiński Kawecki & Szlęzak

Subramaniam & Associates

SyCip Salazar Hernandez & Gatmaitan Law Offices

Synch

Tay & Partners

TIPLO Attorneys-at-Law (also Taiwan International Patent & Law Office)

Wilkinson & Grist

Wrays



Contributing Editor

John Olsen,
Locke Lord LLP

Sales Director

Florjan Osmani

Account Directors

Oliver Smith, Rory Smith

Sales Support Manager

Toni Hayward

Editor

Caroline Collingwood

Senior Editor

Rachel Williams

Chief Operating Officer

Dror Levy

Group Consulting Editor

Alan Falach

Group Publisher

Richard Firth

Published by

Global Legal Group Ltd.
59 Tanner Street
London SE1 3PL, UK
Tel: +44 20 7367 0720
Fax: +44 20 7407 5255
Email: info@glgroup.co.uk
URL: www.glgroup.co.uk

GLG Cover Design

F&F Studio Design

GLG Cover Image Source

iStockphoto

Printed by

Stephens & George
Print Group
April 2016

Copyright © 2016
Global Legal Group Ltd.
All rights reserved
No photocopying

ISBN 978-1-910083-92-5
ISSN 2049-3118

Strategic Partners



General Chapters:

1	INTA Expands its Scope for Brand Owners and Consumers – Ronald van Tuijl, International Trademark Association (INTA)	1
2	Global Trade Mark Transformation 2016 – John Olsen & Charlie Clarence-Smith, Locke Lord LLP	4
3	From Disparagement to Fame and Other Key Developments in U.S. Trademark Law – Karen Lim & Jason D. Jones, Fross Zelnick Lehrman & Zissu, P.C.	8

Country Question and Answer Chapters:

4	Albania	Boga & Associates: Renata Leka & Armando Bode	13
5	Australia	Wrays: Tim Francis	21
6	Bolivia	Bolet & Terrero: Juan Ignacio Zapata	29
7	Brazil	DANIEL Advogados: Robert Daniel-Shores & Roberta Arantes	38
8	Canada	Miller Thomson LLP: Catherine M. Dennis Brooks	49
9	Chile	Beuchat, Barros & Pfenninger: Andrés Melossi	57
10	Cyprus	Koushos Korfiotis Papacharalambous L.L.C.: Eleni Papacharalambous & Eleni Korfiotis	64
11	Ecuador	Quevedo & Ponce: Alejandro Ponce Martínez & Roque Albuja Izurieta	73
12	France	Jones Day: Emmanuel G. Baud & Philippe Marchiset	79
13	Germany	Lubberger Lehment: Dr. Ulrich Hildebrandt & Anja Wulff	90
14	Greece	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	98
15	Hong Kong	Wilkinson & Grist: Andrea Fong & Annie Tsoi	106
16	Hungary	Lendvai Partners: András Lendvai	114
17	Iceland	Patice IP Legal: Ólafur Ragnarsson	121
18	India	Subramaniam & Associates: Hari Subramaniam & Aditi Subramaniam	129
19	Japan	Shobayashi International Patent & Trademark Office: Masayuki Shobayashi & Yukihiro Higashitani	138
20	Kazakhstan	GRATA International: Aizhan Mukhammad & Timur Berekmoynov	146
21	Kenya	Simba & Simba Advocates: Benard Murunga & Perpetua N. Mwangi	156
22	Korea	Lee International IP & Law Group: Mi-Cheong Lee & Robert M. Kim	163
23	Kosovo	Boga & Associates: Renata Leka & Armando Bode	170
24	Liechtenstein	Schwärzler Attorneys at Law: Dr. Alexander Amann, LL.M.	178
25	Malaysia	Tay & Partners: Lin Li Lee & Kah Yee Chong	185
26	Malta	Camilleri Preziosi: Henri Mizzi & Sharon Xuereb	196
27	Mexico	OLIVARES: Alonso Camargo & Daniel Sánchez	204
28	Netherlands	Legaltree: Olav Schmutzer & Marjolein Driessen	212
29	Nigeria	Jackson Etti & Edu: Toyosi Odunmbaku & Busola Bakinson	221
30	Philippines	SyCip Salazar Hernandez & Gatmaitan Law Offices: Vida M. Panganiban-Alindogan & Enrique T. Manuel	230
31	Poland	Sołtysiński Kawecki & Szlęzak: Dr. Ewa Skrzydło-Tefelska & Karol Gajek	240
32	Romania	Nomenius: Elena Grecu & Bogdan Bularda	248
33	Russia	LLC “Card Patent”: Olga Krivelskaya & Svetlana Obida	256
34	Serbia	Popovic Popovic & Partners: Katarina Kostic	264
35	Slovenia	PATENTNA PISARNA D.O.O.: Irena Kadunc & Vesna Kovič	271
36	Spain	ELZABURU: Fernando Ilardia & Luis Baz	279
37	Sweden	Synch: David Leffler & Elisabeth Sundberg	290
38	Taiwan	TIPLo Attorneys-at-Law (also Taiwan International Patent & Law Office): J. K. Lin & H. G. Chen	298

Continued Overleaf ➡

Further copies of this book and others in the series can be ordered from the publisher. Please call +44 20 7367 0720

Disclaimer

This publication is for general information purposes only. It does not purport to provide comprehensive full legal or other advice. Global Legal Group Ltd. and the contributors accept no responsibility for losses that may arise from reliance upon information contained in this publication. This publication is intended to give an indication of legal issues upon which you may need advice. Full legal advice should be taken from a qualified professional when dealing with specific situations.

Country Question and Answer Chapters:

39	Ukraine	Gorodissky & Partners (Ukraine): Nina Moshynska	309
40	United Arab Emirates	Hamdan AlShamsi Lawyers & Legal Consultants: Dr. Ghandy AbuHawash	320
41	United Kingdom	Locke Lord LLP: John Olsen & Charlie Clarence-Smith	327
42	USA	Ropes & Gray LLP: Peter M. Brody & Emilia F. Cannella	338
43	Vietnam	Pham & Associates: Pham Vu Khanh Toan	346
44	Zambia	Ellis & Co.: Bonaventure Chibamba Mutale, S.C.	355

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.

Alan Falach LL.M.
Group Consulting Editor
Global Legal Group
Alan.Falach@glgroup.co.uk

Albania

Renata Leka



Boga & Associates

Armando Bode



1 Relevant Authorities and Legislation

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

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

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

The main applicable legislation is the following:

- Law no. 9947, dated 07.07.2008 "On industrial property" as amended 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 the 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 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 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 the classifications 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 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 in the Bulletin of the GDPT. The application will be published for a period of three months in 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 in the Bulletin.

2.5 How can a trade mark be adequately graphically represented?

According to the Decision of Council of Ministers no. 1706, dated 29.12.2008 "On the approval of the regulation for registration of trademarks", the trademark depiction should measure 8cm × 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 a trade mark in your jurisdiction?

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 a trade mark in your jurisdiction?

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 nine months.

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 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:

- The application fee for one trademark in one class is ALL 5,000 or approx. EUR 35.
- The application fee for any additional class is ALL 2,500 or approx. EUR 18.

- The 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 your jurisdiction?

The trademark receives 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 locally based trademark attorneys for filing of the request for 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 GDPT 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 GDPT within three 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 six 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.

2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, collective and certification trademarks are recognised by Albanian law.

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 morals 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 of figures well known by the public in the Republic of Albania, if they are not authorised by the person or its descendant;
- i) of elements conflicting with article 6*bis* of the Paris Convention;
- j) of elements conflicting with article 6*ter* of the Paris Convention, except in the case the competent authorities have authorised their use;
- k) does not constitute a trademark as per the provisions of the law; or
- l) contains or includes a geographical denomination or indication, having effect in the Republic of Albania, in case the application for the trademark registration has been filed after the filing date of the application for registration of the geographical denomination or indication involving the same products.

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?

The applicant is entitled to appeal with the Board of Appeal within two months from the date of receipt of GDPT's notification on the refusal of the application for registration of the trademark by submitting the following documents:

- a) application form FM10 of the appeal signed by the applicant or its representative;
- b) a 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 three months from the filing date and shall notify in writing the applicant of 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 or 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 a 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?

The same conditions apply as per question 3.3.

4.4 What is the route of appeal?

The same conditions apply as per question 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

During the publication period in 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 a trade mark in your jurisdiction?

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 three 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 three months from the filing date of all related documents, arguments and additional materials by the parties to the proceedings.

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 as 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, where the former may cause a likelihood of confusion to the public where the possibility of association of the sign with the trademark is concerned; and
- c) the same or similar sign for goods or services even when they are either not 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 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 their packaging;
- putting goods into the market and offering them for sale by using this sign, or creating stockpiles for these purposes;
- offering of services by using this sign;
- importing or exporting 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 six months before expiry or six 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 on an 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 an 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?

Security interest over trademarks can be obtained by entering into a pledge contract based on the provisions of the Albanian Civil Code. No registration is needed for the creation of the security interest over the trademark. Instead, the delivery of the trademark certificate to the creditor is required for the completion of the transaction.

7.8 Are there different types of security interest?

Trademarks are granted as security interest based on pledge contract as per the provisions of the Albanian Civil Code.

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 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?

Interested third parties requesting the revocation of a trademark may address the First Instance Court of Tirana. 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?

A lawsuit may be filed by the interested parties.

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 during the interval between the expiry of the five-year period and the filing of the application or of the claim, 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?**

Invalidity is declared where absolute/relative grounds of refusal exist and the application for trademark registration is made in bad faith.

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?

An invalidation proceeding can be initiated by interested parties.

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

In the 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 grounds that infringe the rights of an earlier trademark, in the case the latter has not been used for a period of five 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. Interested parties should address their claim to 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 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 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 civil circulation, or in the 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 the 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 points “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 above cannot be obtained in the 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 three 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 five consecutive years or that it has accepted usage of the alleged infringing trademark without taking any action for a period of five consecutive years.

12 Relief

12.1 What remedies are available for trade mark infringement?

Damage relief consisting of the damage suffered plus loss of profit is available. Also 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 one year. With the creation 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).

15 Other Related Rights

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

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 an application for registration with the Commercial 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 rights are covered by copyright law.

16 Domain Names

16.1 Who can own a domain name?

Local and foreign natural/legal persons as well individuals can own a domain name under “.al”, whilst second level domains (i.e. “.com.al”, etc.) can be registered only by local natural/legal persons.

16.2 How is a domain name registered?

Registration is handled via accredited registrars or by personally applying with the relevant authority.

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

Once the domain name is registered, no one else 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?

Following the amendments of the Law on IP in 2014, sublegal acts were amended accordingly, especially as regards to the concept of certification trademarks. Additionally, in late 2015, DCM no. 205, dated 13.04.1999 “On implementing provisions of the Customs Code” was amended as regards the chapter dedicated to the protection of intellectual property as described in question 14.1.

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

1. Decision of the First Instance Court of Tirana with *plaintiff* Viacom International Inc., vs defendant Andi Alla (trademark

infringement by way of registration of the domain name MTV.AL.).

2. Decision of the First Instance Court of Tirana with *plaintiff* Cartier International AG, *vs* defendant Marsela Bici (trademark infringement by way of unauthorised use of registered trademarks of the plaintiff).
3. Decision of the Appeal Court of Tirana dated with *plaintiff* COMPAGNIE GERVAIS DANONE S.A., *vs* defendant General Directorate of Patents and Trademarks (invalidation of the decision of the Board of Appeal with regard to the registration of the trademark DUKAT SENSIA BIFIDUS NATURALIS PRIRODNO REGULIRA PROBAVU with IR 1011661).

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

During 2016, the National Strategy 2016–2020 of Intellectual Property will be launched.

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.



Renata Leka

Boga & Associates
Ibrahim Rugova Str.
P.O. Box 8264 Tirana
Albania

Tel: +355 4 2251 050
Fax: +355 4 2251 055
Email: rleka@bogalaw.com
URL: www.bogalaw.com

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* – “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.

Renata is fluent in English and Italian.



Armando Bode

Boga & Associates
Ibrahim Rugova Str.
P.O. Box 8264 Tirana
Albania

Tel: +355 4 2251 050
Fax: +355 4 2251 055
Email: abode@bogalaw.com
URL: www.bogalaw.com

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”.

Other titles in the ICLG series include:

- Alternative Investment Funds
- Aviation Law
- Business Crime
- Cartels & Leniency
- Class & Group Actions
- Competition Litigation
- Construction & Engineering Law
- Copyright
- Corporate Governance
- Corporate Immigration
- Corporate Recovery & Insolvency
- Corporate Tax
- Data Protection
- Employment & Labour Law
- Enforcement of Foreign Judgments
- Environment
- Franchise
- Gambling
- Insurance & Reinsurance
- International Arbitration
- Litigation & Dispute Resolution
- Merger Control
- Mergers & Acquisitions
- Mining Law
- Oil & Gas Regulation
- Outsourcing
- Patents
- Pharmaceutical Advertising
- Private Client
- Private Equity
- Product Liability
- Project Finance
- Public Procurement
- Real Estate
- Securitisation
- Shipping Law
- Telecoms, Media & Internet
- Trade Marks



59 Tanner Street, London SE1 3PL, United Kingdom
Tel: +44 20 7367 0720 / Fax: +44 20 7407 5255
Email: sales@glgroup.co.uk

www.iclg.co.uk