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DECREE of the Industrial Property Office

from September 7 1995
to Implement the Law on Trademarks

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Pursuant to Article 41, par. 1 and 2 of the Law on Trademarks No 137/1995 of Collection of Law (hereinafter "Law"):

PART ONE

TRADEMARK APPLICATION PROCEDURE

Trademark application (Article 4 up 6 of the Law)

Article 1

- (1) An applicant shall also state in the trademark application:
 - a) information whether the trademark shall be registered in the common characters used by the Industrial Property Office (hereinafter "Office") or in other characters, or the trademark in question be three-dimensional; if the filed sign contains the data written in other than Latin characters the transliteration of the data in Latin characters must be added,
 - b) information whether the trademark is filed in black and white or in colour,
 - c) information on the representative, including the name and address of the headquarters of the representative, who is legal entity, in the case of a physical person the name and surname and the address of residence and/or the mail address.
- (2) If the applicant claims the priority right under Article 6, par. 2 of the Law, he shall state the date, file number and the country of application filing by virtue of that he claims the priority right, in the trademark application; had the trademark be registered also the registration number. The applicant shall submit the document on application filing by virtue of which he claims his priority right or the priority right document as an evidence of his priority right.
- (3) Goods and services, the trademark protection is claimed for, are listed in sequence of international classification/1 classes accompanied by the respective number of the classification.
- (4) The trademark application is signed by the applicant or his authorized representative.
- (5) Office shall furnish the trademark application with the precise time date of filing and file number.

Article 2

- (1) Trademark application in different characters than common must be furnished with five figures of the filed sign, reproducing clearly the filed sign in fine details.
- (2) Office may request the applicant to enclose further figures in the trademark application to clearly distinguish details of the filed trademark or its description in writing and/or its sample.
- (3) Collective trademark application must be furnished with the agreement on business association and the applicant points out also the persons authorized to handle the collective trademark procedures on behalf of business association.

Article 3

Divided application

(under Article 7. par. 3 of the Law)

Divided application contains in addition to the items stated in Article 1:

- a) wording or pictorial representation of applied sign,
- b) list of goods or services being the subject to divided application in sequence of international classification accompanied by the respective number of the classification,
- c) filing date of the initial trademark application,
- d) file number of the initial trademark application.

Article 4

Requirements of the opposition to the registration of the trademark into the trademark register:

(under Article 6 of the Law)

- (1) Opposition to the registration of the applied sign in the trademark register (hereinafter "Register") shall contain:
 - a) trade name and address of the headquarters or name, surname and address of the person having filed the opposition,
 - b) file numbers and publication date of attacked trademark application,
 - c) name and address of the headquarters or name, surname and address of the applicant and tenor and/or representation of the filed sign being opposed,
 - d) list of goods or services involved in opposition including their classes under the international classification or the fact that all the goods and/or services stated in the application are involved in opposition.
 - e) substantial justification of the opposition,
 - f) proposal of the way, how the decision on the application shall be made.
- (2) The person claiming opposition justifies its filing by documents, backing the opposition; if the opposition backed by the trademark application of the earlier priority right, its file designation or registration number and its tenor and/or representation is sufficient.
- (3) If the opposition is filed on the background of identity or confusingly similarity with the well known mark, the opposing person proves its mark had become well known in the Czech Republic before priority right of the attacked mark arose.
- (4) If the opposition reason is the infringement of the rights of unregistered sign holder, the holder of such sign submits the list of products and/or services that the unregistered sign in term provided in the law has got the distinctive character or designates the area and/or region, within that the customers would attach the products and/or services designated with the opposed sign with the business activity of the unregistered sign holder.
- (5) If the opposition reason is identity or confusingly similarity with trade name, the entrepreneur is obliged to prove he has been entered in the Trade or other similar Register and/or established before the published trademark priority right origin and to submit the range of goods and/or services virtually provided by the company under the given trade name.

- (6) If the opposition is filed on the background of infringement of the rights to the personality protection the legitimacy to exercise the rights of personality protection must be proved and stated in particular how the entry of the published trademark into the Register could jeopardize personality protection rights.
- (7) If the opposition is filed on the background of infringement of the right on the virtue of other industrial property, the evidence must be submitted, which protected industrial right this infringement concerns and how the registration of the published sign into the Register could endanger the right to industrial property subject.
- (8) If the opposition is filed on the background of infringement of copyright, active legitimacy to exercise the copyright must be proved, the authors work stated, being endangered by the entry of the published sign into the Register including the scope, in which the author's work is endangered.
- (9) If the opposition is filed under Section 42 par. 3 of the Law, the owner of the trademark is obliged to state the file number and the date of decision of the Office, declaring the trademark to be well known.

Article 5

Trademark Register

(under Article 40 of the Law)

- (1) The Register shall state:
 - a) number of trademark,
 - b) precise date of the trademark application filing with the Office and/or priority right date,
 - c) publication date of the filed sign in the Gazette of the Industrial Property Office (hereinafter "Gazette"),
 - d) date of the registration of the trademark to the Register,
 - e) file number
 - f) wording and/or representation of the trademark; if the trademark contains the data in different from Latin characters, the transliteration shall be furnished into Latin characters.
 - g) classification of figurative elements of the trademark,
 - h) trade name and address of headquarters or the name, surname and residence address of a trademark owner,
 - i) the kind of trademark.
 - j) the list of goods and or services the trademark is assigned for in the sequence of international classification/1 accompanied by the respective number of the class of the classification,
 - k) the date of the trademark registration renewal,
 - l) international registration of trademark,
 - m) license contracts in the trademark or designation of the association members entitled to use a collective trademark.
 - n) the assignment of the right to the trademark,
 - o) provision and lapse of the right of lien to the trademark,
 - p) trade name and address of headquarters or the name, surname and residence address of the applicant representative,
 - r) lapse of trademark right.
- (2) The modifications can be entered on request, occurred after the trademark registration.
- (3) Office shall enable access to the Register data to everybody.

Article 6

- (1) The data provided for in Article 5 par. 1 shall be stated in the certificate of registration of the trademark to the Register. Office shall issue the certificate amendment on the request to the owner to reflect modifications of registration in the Register occurred after the certificate had been issued.
- (2) If requested, Office shall issue original copy of the certificate of registration of a trademark in the Register. The original copy contains data stated in the certificate of the registration of a trademark in the Register.

- (3) If requested, Office shall issue the extract from the Register and/or the extract of the data on the filed trademark to anybody, who files the request. The extract from the Trademark Register contains the data only, valid as of the date of application filing on Register extract.
- (4) Office shall publish data stated under Section 5, par. 1 after the entry of the trademark to Register in the Gazette; any data modification occurred after the registration of the trademark to Register shall be published in the Gazette.

PART TWO

AMENDMENTS AND MODIFICATIONS IN TRADEMARK

Article 7

Amendment in trademark

(under Article 7, par. 1 and Article 22 of the Law)

- (1) Request to change the filed sign and/or trademark containing the data on headquarters address or name and surname and residence address of an applicant and/or trademark owner shall contain following:
- a) number of trademark registration and/or file number,
 - b) trade name and headquarters address or name and surname and residence address of an applicant and/or trademark owner,
 - c) wording or representation of the trademark,
 - d) trade name and headquarters address or name and surname and residence address of an attorney, if applicable,
 - e) the requested amendment
 - f) signature of applicant.
- (2) Request to change the filed sign and/or trademark must be furnished with the official document to confirm the change in data under the par. 1.

Article 8

Restriction of the List

(to Article 7, par. 2 of the Law)

The request to restrict the list of goods or services contains as follows:

- a) number of trademark registration and/or file number,
- b) trade name and headquarters address or name and surname and residence address of an applicant and/or trademark owner,
- c) list of goods or services reflecting the restriction,
- d) trade name and headquarters address or name and surname and residence address of a representative, if applicable.
- e) signature of applicant.

Article 9

Change in trade name and headquarters address or name and surname and residence address data

The request to enter the change of data in the trade name and headquarters address or name and surname and residence address of an applicant and/or trademark owner shall contain following:

- a) number of trademark registration and/or file number,
- b) the trade name and headquarters address or name and surname and residence address of an applicant and/or trademark owner
- c) the new data in trade name or headquarters address or name and surname and residence address of an applicant and/or trademark owner, the registration of which in the Register is demanded,

- d) trade name and headquarters address or name and surname and residence address of a representative, if applicable.
- e) signature of applicant.

Article 10

Assignment of the right
(under Article 19 of the Law)

- (1) Request for registration of the assignment and/or transition of the trademark in the Register contains as follows:
- a) number of trademark registration and/or file number,
 - b) the trade name and headquarters address or name and surname and residence address of a trademark owner and information on the trade name and headquarters address or name and surname and residence address of a trademark assignee,
 - c) information whether the trademark is transferred for all the assigned products and/or services or solely for some of them, listed in the sequence of the international classification/1 classes accompanied with the respective class number of the above classification,
 - d) trade name and headquarters address or name and surname and residence address of a representative, if applicable,
 - e) signature of applicant.
- (2) When the trademark transferred, the contract on transfer or the extraction of the contract shall be enclosed to the request and/or some other official document evidencing the change in trademark assignee and in trademark transition the document on trademark transition undergoing different regulations. If the document on trademark assignment and/or transition is submitted in other than Czech language, Office can demand its translation.
- (3) In case the assignment and or transition of the rights from trademark application is requested, the appropriate provisions of the paragraphs 1 and 2 shall be applied.

Article 11

Licence
(to Article 18 of the Law)

- (1) The request for registration of the licence contract shall contain following:
- a) number of trademark registration and/or file number,
 - b) the trade name and headquarters address or name and surname and residence address of a trademark owner and information on the trade name and headquarters address or name and surname and residence address of a trademark licensee.
 - c) information whether the trademark is licensed for all the assigned products and/or services or solely for some of them,
 - d) trade name and headquarters address or name and surname and residence address of an representative, if applicable,
 - e) signature of applicant.
- (2) The licence contract is enclosed to the request for registration of the licence contract to Register. If the licence contract is submitted in other than Czech language, Office can demand its translation.

Article 12

Lien
(under Article 21 of the Law)

- (1) The request for registration of the lien shall contain following:
- a) number of trademark registration and/or file number,

- b) the trade name and headquarters address or name and surname and residence address of a trademark owner and information on the trade name and headquarters address or name and surname and residence address of a lien creditor,
 - c) trade name and headquarters address or name and surname and residence address of a representative, if applicable,
 - d) signature of applicant.
- (2) The lien establishment contract is enclosed to the request for registration of lien right contract to the Register. If contract submitted in other than Czech language, Office can demand its translation.

Article 13

Proposal for cancellation of the trademark from the Register

(under Article 25 of the Law)

- (1) The proposal for cancellation of the trademark from the Register contains following:
- a) registration number of trademark and/or file number,
 - b) trade name and headquarters address or name and surname and residence address of a trademark owner,
 - c) wording or representation of the trademark,
 - d) trade name and headquarters address or name and surname and residence address of proposer,
 - e) trade name and headquarters address or name and surname and residence address of petitioner representative, if applicable,
 - f) proposal how to decide in this matter,
 - g) proposal substantial reasoning and supporting evidence,
 - h) signature of applicant.
- (2) A proposal for cancellation shall be submitted in four copies; the copies of evidence supporting the proposal for cancellation must be enclosed to each copy of the proposal.
- (3) In case the trademark owner attacked by the proposal for cancellation is a legal or physical entity having neither headquarters nor residence in the Czech Republic, the proposal for cancellation shall be furnished with certified translation into French or English language.
- (4) Office shall invite the trademark owner to express his approach to the proposal for cancellation.

Article 14

Request for cancellation of the trademark from the Register

(under Article 26 of the Law)

- (1) The request for cancellation of the trademark from the Register shall contain following:
- a) registration number of trademark and/or file number,
 - b) trade name and headquarters address or name and surname and residence address of a trademark owner,
 - c) trade name and headquarters address or name and surname and residence address of petitioner for cancellation of the trademark,
 - d) trade name and headquarters address or name and surname and residence address of representative, in case the petitioner has a representative.
- (2) The petitioner shall enclose the copy of authorized Court order to the request for cancellation in compliance with that the trademark encroaches upon the rights of personality protection, infringes the legal entity reputation or encroaches upon the copyright an/or the trademark application represents an unfair competition.

Article 15

Renewal of registration

(under Article 23 of the Law)

- (1) Request for renewal of registration shall contain following:

- a) registration number of trademark and/or file number,
 - b) trade name and headquarters address or name and surname and residence address of trademark owner,
 - c) the statement the renewal of registration is requested,
 - d) trade name and headquarters address or name and surname and residence address of a representative, in case the trademark owner has a representative,
 - e) signature of applicant.
- (2) If the request for renewal of trademark registration in the Register comprises the request to restrict the list of products and/or services the renewed trademark is assigned for, the trademark owner is obliged to state the data under Article 8.

PART THREE OFFICE ACTS

Article 16 **File keeping**

Office keeps separate file on trademark application and on registered trademark, containing all items filed in the course of the trademark application procedure, in the life time of trademark registration and orders and decisions of the Office.

PART FOUR APPLICATION FOR INTERNATIONAL REGISTRATION OF TRADEMARK

(under Article 36 of the Law)

Application for International registration

Article 17

- (1) In case of a trademark registered in the Register kept by the Office, the application for international registration shall contain following:
- a) registration number of trademark to Register and its tenor or representation, when the trademark filed in other than Latin writing and/or contains other than Arabic or Roman numerals its transliteration into Latin is carried out under the rules of French pronunciation and transliteration into Arabic digits,
 - b) trade name and headquarters address or name and surname and residence address of an applicant, that must be identical with the data on name and headquarters address or name and surname and residence address of trademark owner, having been registered in the Register kept by the Office,
 - c) list of goods and services, the trademark protection is claimed for, identical with or shorter than the list of goods and services, the trademark is registered for in the Register kept by the Office, in precise translation into French and items listed in sequence of international classification/1 classes accompanied by the respective number of the classification,
 - d) the time, the protection is requested for,
 - e) the list of countries, the protection is requested in,
 - f) the royalties payment fashion for international registration under the International Agreement on International Registration of Marks/2, trade name and headquarters address or name and surname and residence address of payer and/or certificate number of the World Intellectual Property Organization with its seat in Geneva (hereinafter "International Office") on payment having been settled,
 - g) if the trademark filed in colour, list of applied colours in French and information on the way of publishing,

- h) trade name and headquarters address or name and surname and residence address of the representative, if applicable,
 - i) applicant signature.
- (2) If the trademark has not been registered into Register kept by Office, application for international registration contains file number of the trademark application and its filing date with the Office and data stated under par. 1, letter b) up to i).

Article 18

- (1) Application for international trademark registration filed in other than common writing must be furnished by the applicant with five copies of black and white representation of the filed sign of the size 15 x 15 mm as minimum and 80 x 80 mm as maximum.
- (2) Applicant shall furnish the international trademark application in a coloured representation, besides the representation under the par. 1, with following:
- a) 52 copies of representation of the sign in colour of the size smaller than 210 x 297 mm, if he likes to have the trademark published in black and white or
 - b) five copies of representation of the filed sign in colour of the size 15 x 15 mm as minimum and 80 x 80 mm as maximum, if he likes to have the trademark published in colour.
- (3) Applicant shall furnish the international trademark application with three copies of list of products or services in precise translation into French and items listed in sequence of international classification/1 classes accompanied by the respective number of the classification.

Article 19

Request for Acts in International Register of Marks

- (1) Office shall request for acts in the International Register of Marks concerning registration renewal, territory extension, assignment, data modification in name or name and surname and/or headquarters address or residence address of the internationally registered trademark owner, restriction of the goods or services list, the renunciation of the protection, request for cancellation, data correction, registration or change of a representative or any other acts, following the written request of the internationally registered trademark owner filed for each individual procedure.
- (2) Request for acts under par. 1 shall contain:
- a) trademark number, its wording or representation,
 - b) file number of international registration.
 - c) trade name and headquarters address or name and surname and residence address of internationally registered trademark owner,
 - d) the royalties payment fashion for act under the international treaty /2 and data on trade name and headquarters address or name and surname and residence address of payer and/or certificate number of International Office on payment having been settled,
 - e) further properties requested by international treaty, /2
 - f) signature of applicant.

PART FIVE COMMON AND CONCLUSION PROVISIONS

Article 20

Should the Office have good reason to be in doubts about data reliability comprised in application, it may invite applicant to submit the evidence and prove them to be truthful.



Article 21

This decree comes into effect on October 1 1995.

President:
Ing. **Jakl** CSc.

Notes:

- 1/ Decree of the Ministry of Foreign Affairs No 118/1979 of Coll., to the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of Registration of Marks from July 15, 1957, revised in Stockholm on July 14, 1967 and in Geneva on May 13, 1977, in wording of Decree No 77/1985 of Coll.
- 2/ Decree of the Ministry of Foreign Affairs No 65/1975 of Coll., to the Madrid Agreement Concerning the International Registration of Marks from April 14, 1891, reviewed in Bruxelles on December 14, 1900, in Washington on June 2, 1911, In The Hague on November 6, 1925, in London on June 2, 1934, in Nice on June 15, 1957 and in Stockholm on July 14, 1967, in wording of Decree No 78/1985 of Coll.