

# Trademarks

LEGAL PROTECTION

and

# Legal Protection

TRADEMARKS

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## WHAT IS A TRADEMARK?

A trademark is a designation which serves to distinguish products or services on the market. The purpose of a trademark is to distinguish goods or services of the same kind produced or provided by different producers or service providers, respectively. The trademarks help consumers to find their way around offers of products and services and to select the ones they want. Because trademarks have been promoted extensively, especially in the media, a company's product name or logo becomes an integral part of our daily lives.

Relevant questions on trademarks are governed particularly by the following legislation:

- Act No. 441/2003 of the Coll., on Trademarks;
- Regulation No. 97/2004 of the Coll., Concerning Implementation of the Trademark Act;
- Act No. 634/2004 of the Coll., on Administrative Fees;

## WHAT CAN BE TRADEMARKED?

A trademark can only be a designation that can be graphically represented (written, drawn) and intended to distinguish the products or services for which it is protected from other identical products or services on the market supplied from other business sources. So a trademark cannot exist in and of itself, but is always in connection with the specific products or services it designates.

A trademark application is filed by an applicant with the Industrial Property Office (hereinafter referred to only as Office). The right to a trademark stems from being registered in the trademark register managed by the Office. The trademark owner has exclusive right to designate his products or services with the trademark or to use the trademark in connection with these products or services. Nobody can use an identical or similar designation for the same or similar products or services without the owner's prior consent.

### A TRADEMARK CAN BE:

- A word designation in standard writing (words, names, word and number combinations and the like);
- A word designation in a special form of graphical writing;
- Figurative designations;
- Combined designations consisting of both word and drawing (logos);
- 3D designations formed by product shapes or packaging (such as bottles);
- Combinations of product shape or packaging with words or a drawing (such as bottle with a label);
- A colour or a combination of colours.

In addition to word designations in standard writing, a trademark can also be registered either in a black and white or colour version as the applicant chooses. As far as a colour trademark is concerned, the protection also relates to the colours used and their arrangement. The trademark must consistently be used only in the colour version registered.

### WHICH DESIGNATIONS CAN'T BE REGISTERED IN THE TRADEMARK REGISTER?

THE FOLLOWING ARE EXCLUDED FROM REGISTRATION  
IN THE TRADEMARK REGISTER:

- Designation that cannot be graphically represented (such as theme tunes, special aromas, television broadcasts);
- Designation without the capability to distinguish products or services;
- Designation exclusively formed by signs or data serving in trade to determine a kind, grade, amount, purpose, value of products or services, further by data relating to geographical origin or production time of a product or supply of a service;
- Designation consisting exclusively of signs or marks being common in current language or employed in good faith and in commercial usage;
- Designation formed exclusively by the shape of the product which arises from its nature or is essential for achieving a technical result and/or which gives the product a substantial utility value (the shape of the product being universally used or being conditioned by the technical features of goods);
- Designation that goes against public order or morality;
- Designation that can mislead the public, particularly as far as nature, quality or geographical origin of goods or services is concerned;
- Designation registered for wines or spirits, containing a geographical indication being contrary to the actual place of origin of that wine or spirit;
- Designation consisting of elements protected according to the article 6<sup>ter</sup> of the Paris Agreement, registration of which was not approved by the respective authorities;
- Designation consisting of signs, emblems and coats of arms other than those specified in the article 6<sup>ter</sup> of the Paris Agreement, provided their use is subject to special public interest, unless the respective authority gives consent to its registration;
- Designation containing signs of high symbolic value, especially religious symbols;
- Designation, whose use would be inconsistent with provisions of other legal regulation or is contrary to obligations resulting from international treaties;
- Designation where it is apparent that the trademark application was not filed in good faith;



- Designation that is identical with a trademark registered or applied for earlier by another person and for identical products or services and designations containing elements of such trademark that could lead to confusion. This fact can be verified by carrying out a search prior to filing the trademark application;.
- Designation infringing third persons' rights, enforced by duly and in time filed objections against the trademark registration.

### WHO CAN APPLY FOR A TRADEMARK?

A trademark can be applied for by any individual or legal entity competent to perform legal acts.

Trademark registration can be applied for either directly by the applicant or he may select a representative for this purpose, particularly a solicitor or a patent attorney. In filing the application, the representative must identify himself as having power of attorney signed by the applicant. Unless the applicant has a company, permanent residence or seat in the Czech Republic, he must file the trademark registration application through a member of the Czech bar association or Patent Attorney Chamber. This condition does not apply provided the applicant is an EU citizen or resides in a country which is a contracting party of the EEC (or has its administration or seat in the above mentioned countries), and provided that he resides or provides services in the Czech Republic. Those people must provide addresses in the Czech Republic to which official documents concerning the application or the registered trademark will be sent. All documents sent to the Office must be in Czech.

### HOW CAN A TRADEMARK REGISTRATION APPLICATION BE FILED?

The application for a trademark registration must be filed with the Industrial Property Office either in person, by post, or electronically (provided it has a guaranteed electronic signature).

If the filing is done by fax or electronically and has no guaranteed electronic signature, then the original document must be received by the Office within five days.

THE APPLICATION MUST CONTAIN THE FOLLOWING:

- Request for the trademark registration in the trademark register;
- A company name and address or a name and an address of the applicant;
- Wording or figurative representation of the trademark to be registered;
- A list of the products or services for which the trademark is to be registered. Products or services must be arranged and classified according to the classes of international classification (International Classification of Products and Services for the Purposes of Registration of Marks, according to the Nice Agreement of June 15, 1957). Publication of this classification is available either in the Office where it can be bought or borrowed, or the necessary information can be obtained via the Internet.
- Signature of the applicant or his representative.

Upon receipt of the application, the Office will mark it with the date and time of filing. From this moment the applicant acquires the right of priority over everyone else applying subsequently for an identical mark for identical products or services.

### THE APPLICATION CAN FURTHER CONTAIN:

- The representative's name and address, if the applicant is represented by him;
- Mailing address, if different from the address of the applicant or that of his representative.

### ENCLOSURES TO THE APPLICATION:

- Three copies of trademark representation in a format ranging from A8 to A4 (with the exception of word designation applied for in standard writing);
- A power of attorney if the applicant is represented.

## WHAT ARE THE APPLICATION PROCEEDINGS?

After the filing, the Office determines whether the application contains all the necessary parts. If there are any errors that would impede further proceedings (such as incorrect classification of the list of products or services), a written invitation is sent to the applicant to remove the errors within a given time schedule. The period is usually two months.

If there is no reply from the applicant and the flaws are not removed, the Office will reject the trademark application.

If the application is free of such errors or if the applicant removed them, the Office will carry out a so-called substantive examination, the purpose of which is to determine whether the designation is not excluded from registration. If the designation cannot be registered in the trademark register, the applicant will receive announcement of this fact and can react to it within the specified time and possibly remove the obstacles. If the removal of the obstacle to registration is impossible, the Office will refuse the registration of the respective trademark.

If the designation to be registered is qualified for registration in the register, the trademark application is published in the Office Journal published once a week. Within a period of three months from the date of publishing, the persons who may be potentially infringed in their previously acquired rights by the published designation may object to the registration of the trademark in the register. The Trademark Act determines the circle of those entitled to file opposition. In the event of filing an objection, the Office must decide whether the objection is justified and whether the applied designation infringes the rights of the person who made the filing. In such cases the Office will also reject the trademark application. If no opposition is filed within the due time schedule against the registered designation, or if this opposition is rejected as unjustified, the Office will register the applied designation in the trademark register. Based on the above act the Office will issue a certificate of registration in the trademark register to the owner of the trademark.



## HOW LONG ARE TRADEMARKS VALID FOR?

The term of protection of a registered trademark is ten years from the date of filing the application with the Office. The duration of protection can be renewed for another 10 years upon the owner's request. The request for a registered trademark renewal, the form of which is available in the Office, can be filed within the last year of its term of protection at the earliest, but prior to the expiration date. A registration renewal request can also be filed within six months after the expiration date, however an increased fee is charged. If the request for renewal is not filed, the trademark ceases to exist.

## WHAT IS A COLLECTIVE TRADEMARK?

A collective trademark is a designation capable of distinguishing products or services provided by members or partners of a legal entity or participants of an association whose purpose is to jointly designate products and services to be distinguished from those of other entrepreneurs. A written agreement concluded among all members or partners of the respective legal entity or participants of the association determining conditions of the collective trademark use, including sanctions for infringement, must form an integral part of the collective trademark application.

## HOW DOES ONE PROCEED WITH A TRADEMARK APPLICATION ABROAD?

A trademark registered in the trademark register maintained by the Office, based on application filed with the Office is only valid within the territory of the Czech Republic. If the applicant wishes to ensure protection of their trademark in another state, they must either file the trademark application directly with the registration office in that state or file an application for international trademark registration with the Office, under conditions specified further. The third option is to file an EC trademark application for the entire territory of the European Union, which can be filed with the Office for Harmonization in the Internal Market – OHIM (trademarks and designs) in Alicante, Spain or with the national office in any of the EU member countries.

## WHAT IS AN INTERNATIONAL TRADEMARK?

Trademarks registered in the Czech Republic can be filed for registration through the Industrial Property Office as so-called international trademarks in certain other states on the basis of the Madrid Agreement Concerning the International Registration of Marks and on the basis of the Protocol Relating to that Agreement.

The Madrid Agreement and the Protocol Relating to that Agreement ensure nationals of the contracting parties the possibility to protect their trademarks in all contracting states of the Madrid Agreement and/or of the Protocol on the basis of

one application filed with the International Bureau of the World Intellectual Property Organization in Geneva through the respective registration office according to the origin of the applicant.

In case of a trademark application filed with the International Bureau, priority rights from the trademark application filed in the Czech Republic can be claimed, providing that the international application is filed with the International Bureau within six months after filing the application in the Czech Republic.

If only contracting states of the Madrid Agreement are mentioned (designated) in the international application which are not, at the same time, contracting states of the Protocol Relating to the Madrid Agreement, the international application aimed at these states has to be based on registration of the trademark in the Czech Republic.

If the applicant seeks protection in states which are either members of the Protocol only or members of both treaties (the Madrid Agreement and the Protocol), the international registration can be effected only on the basis of filing of the trademark application in the Czech Republic without the trademark having to be registered in the register of trademarks in the Czech Republic. Such international registration depends, however, on the subsequent registration of the subject trademark in the Czech Republic. This means that if the trademark is not registered and the trademark application procedure in the Czech Republic ends in refusal of the application or termination of the application procedure, the respective international registration in the international register of marks administered by the International Bureau of the World Intellectual Property Organization will be cancelled. The cancellation has always to correspond with the final state of the main national application. Therefore, if the national application in the Czech Republic is refused only in respect of a part of the list of the products or services filed for registration, the international trademark registration shall be also cancelled only with respect to the corresponding part of the list of products and services and shall remain valid in respect of the remaining products or services.

Following registration of a trademark filed for the international registration in the international register of marks, the International Bureau will announce international registration of the trademark to all contracting states of the Madrid Agreement and/or of the Protocol Relating to that Agreement in which the international trademark is filed for protection, i.e. in the states designated in the international trademark application. The contracting states can refuse, within the time limit of one year from the date of notification of the international registration, protection of an international trademark filed for registration in those states in case the trademark contradicts their national regulations. The contracting parties of the Protocol can extend this time limit to eighteen months on the basis of their declaration, and if the refusal is based on opposition filed by an authorized person, the refusal can be announced, following a prior notice, even after expiration of this time limit. However, if the designated state is a member of both international treaties (the Madrid Agreement and the Protocol), it can refuse protection in respect of the international trademark in its territory only within the time limit of one year from the date of notification of the international registration, not within the extended time limit of eighteen months.



The period of protection of international trademarks is 10 years and can be renewed always for another 10 years.

After effecting the international registration of a trademark, the owner of the trademark can file the trademark for registration in other contracting states of the Madrid Agreement and of the Protocol at any time during the period of duration of the international registration in the form of the so-called subsequent designation of other contracting states.

The international registration of a trademark is dependent, for the period of five years, on existence of registration of the same trademark in the Czech Republic.

If the trademark ceases to exist for any reason within the period of five years from the date of the international registration, its international registration in the international register shall be cancelled as well. If the international registration is cancelled on the grounds of its dependence on the main national registration or on the main national application, its owner is entitled to request, within a time limit of three months from the date of cancellation, conversion of the international registration into national trademark applications in the designated contracting states. Such a conversion shall be requested directly with the registration offices of the individual states, which are obliged to acknowledge the date of the international trademark registration as the date of filing of the national application in such case.

Since 1<sup>st</sup> October 2004, a trademark can also be filed in the form of an international registration for the European Community as a whole; the applicant has to designate the European Community in the application for the international registration. Protection of trademarks in the territory of the European Community is determined by the Office for Harmonization in the Internal Market (OHIM) in Alicante, Spain. If this Office refuses protection in respect of an international trademark in the territory of the European Community or if effects of the international registration of the trademark for the European Community become extinct (e.g. on the grounds of cancellation of the trademark registration), the applicant may request conversion of the designation of the European Community as a whole to the subsequent designation of the international trademark registration for the individual member states of the European Community of the applicant's choice. The applicant can also determine whether the subsequent designation in the member states will be requested for the whole list of products or services, or only for a part of the list. Furthermore, the applicant can decide for conversion of the designation of the European Community in the international trademark registration to national applications in the individual member states. In such a case, the conversion will be requested directly with the registration offices of the respective states in accordance with the Community Trademark Regulation.

The request for conversion of the designation of the European Community to the subsequent designation of member states shall be filed by the applicant with the International Bureau through OHIM within the time limit prescribed by the Community Trademark Regulation, i.e. within three months from the date of occurrence of decisive facts (e.g. issuance of notification concerning the refusal of protection on the part of OHIM). The request shall be filed on the special MM16 form of the International Bureau of the World Intellectual Property Organization; this form is available at <http://www.wipo.int>. The date acknowledged for the



subsequent designation of member states shall be the day when the date of designation of the European Community was entered in the international register. In consequence of the said conversion, the registration offices of the selected member states of the European Community shall decide on granting or refusing protection to the subject international trademark pursuant to their own trademark regulations.

Filing for registration in states which are not members of the Madrid Agreement Concerning the International Registration of Marks or of the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

If the owner of a trademark wants to obtain protection for a trademark in a state which is not a contracting state of the Madrid Agreement or of the Protocol Relating to that Agreement, the owner has to apply for its registration using the so-called national way, i.e. directly at the industrial property office of the respective state, usually through a local authorized agent, and pursuant to the trademark regulations of the given state. In this manner, trademarks can also be filed for registration in the individual states which are members of the Madrid Agreement or of the Protocol Relating to that Agreement, as well as in the individual states of the European Community.

## WHAT ARE THE BASIC ADMINISTRATIVE FEES?

For filing the application	- Individual trademark	CZK 5,000.00
	- Collective trademark	CZK 10,000.00

This fee includes a list of products and services within the range of three classes of the international classification of products and services. If the list contains more than three classes it is necessary to pay additional CZK 500.00 per each additional class (e.g. when the application contains a list of products and services with five classes of the international classification the total amount of the fee is CZK 6,000.00).

For filing a request for renewal	- Individual trademark	CZK 2,500.00
	- Collective trademark	CZK 5,000.00

If a renewal request is filed within six months after the lapse of the protection term, these fees are increased to CZK 5,000.00 for the individual trademark and to CZK 10,000.00 for the collective trademark.

For application for international trademark registration	CZK 2,500.00
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Registration fees in CHF payable to the International Office of the World Intellectual Property Organization (WIPO) in Geneva are specified in a special schedule of charges that is available in the Information Center and on the Office website.

## WHERE CAN YOU GET FURTHER INFORMATION?

### INDUSTRIAL PROPERTY OFFICE (IPO)

Employees of the IPO are ready to answer your questions connected with the trademarks, to provide general information on formal requirements related to applications, or circumstances of application procedure as well as on administrative fees and execution of searches..

### THE IPO PUBLIC STUDY ROOM PROVIDES THE FOLLOWING SERVICES:

#### Trademark searches

- in the national trademark database of all trademarks registered in the Office,
- in the ROMARIN database of all trademarks registered according to the Madrid Agreement in International Office of the World Intellectual Property Organization, Geneva;
- in the CTM ONLINE (OHIM) database of all EC trademarks (valid in all EU countries).

Request for a trademark search can be set either by wording, representation or by individual bibliographic data including international classification of figurative elements according to the Vienna agreement or international classification of products and services. In addition to searches from the trademark databases the Office also carries out searches for expired trademarks. Search specialists can carry out a search for history of an expired trademark, i.e. to determine an original owner, expiration date and priority date. It is also possible to carry out searches in selected national trademark databases such as the USA, France and so on.

### INFORMATION CENTER

Employees of our trademark information center will be glad to provide you with all the necessary information connected with trademark rights, trademark application proceedings or classification of products and services for purposes of trademark proceedings on the following phone number: +420 220 383 120.

### INTERNET

Information about the activities and services of the Office are also available on the Internet:

**[www.upv.cz](http://www.upv.cz)**

The Office home page provides access to information about individual industrial property rights, services, legislation and activities of the Industrial Property Training Institute. Relevant application forms are also available.

As part of its expanded services for Internet users, the Office website also contains electronic forms, through which it is possible to order on-line patent, industrial



design and trademark searches. Office Journals and publications of the Industrial Property Training Institute are also available on the website.

The Office also plans to develop its electronic services in the future. Currently it provides access to individual classifications from the field of industrial property rights (in PDF format) A database of national and international trademarks is also accessible to applicants through the Office website where it is possible to carry out informative searches free of charge.

## **Industrial Property Office**

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### **Reading Room is open to the public:**

Monday	8.00 - 17.00
Tuesday	8.00 - 16.00
Wednesday	8.00 - 17.00
Thursday	8.00 - 16.00
Friday	8.00 - 14.30

### **Information Centre is open to the public:**

Monday	8.00 - 12.00	13.00 - 17.00
Tuesday	8.00 - 12.00	13.00 - 16.00
Wednesday	8.00 - 12.00	13.00 - 17.00
Thursday	8.00 - 12.00	13.00 - 16.00
Friday	8.00 - 12.00	13.00 - 14.30

### **Patent attorneys and lawyers:**

Patent attorneys and lawyers provide professional assistance on industrial property matters for individuals and legal entities. They provide professional advice and represent you before the Industrial Property Office.

Contacts:

#### **Chamber of Patent Attorneys of the Czech Republic**

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