

TRADEMARKS ACT

And

THE ACT ON AMENDMENTS
TO THE TRADEMARKS ACT*

NN 173/2003 , in force from January 1, 2004

*NN 76/2007, in force from July 31, 2007

Zagreb, September 2007

I. BASIC PROVISIONS

SCOPE OF APPLICATION

Article 1

This Act shall apply to individual, collective and guarantee trademarks which are the subject of a registration or an application for the registration of a trademark filed with the State Intellectual Property Office of the Republic of Croatia (hereinafter: "the Office"), or of an international registration having effect in the Republic of Croatia.

SIGNS WHICH CAN BE PROTECTED AS TRADEMARKS

Article 2

Any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, three-dimensional forms, colors, as well as the combinations of all the above indicated signs, may be protected as a trademark, provided that such signs are capable of distinguishing the goods or services of one undertaking from goods or services of another undertaking.

PERSONS WHO MAY BE HOLDERS OF A TRADEMARK

Article 3

- (1) Any natural or legal person may be a holder of a registered trademark or an applicant for the registration of a trademark.
- (2) Foreign legal and natural persons not having a principle place of business or a domicile or a habitual residence, respectively, in the Republic of Croatia shall, under this Act, enjoy the same rights as are enjoyed by the persons having a domicile or a real and effective industrial or commercial principle place of business in the Republic of Croatia, if it results from the international treaties binding the Republic of Croatia or from the application of the principle of reciprocity.

ACQUISITION OF A TRADEMARK

Article 4

- (1) In the Republic of Croatia a trademark shall be acquired by registration.
- (2) For the purposes of this Act, "registration" shall mean entry of a trademark in the trademark register kept by the Office.

ABSOLUTE GROUNDS FOR REFUSAL

Article 5

- (1) The following shall not be registered:
 1. signs, which may not be protected as trademarks in accordance with the requirements set out in Article 2 of this Act,
 2. signs, which are devoid of distinctive character in relation to the goods or services for which registration is requested,
 3. signs which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of providing of the service, or to designate other characteristics of the goods or services,
 4. signs which consist exclusively of signs or indications which have become customary in the everyday language or in good faith and the established practices of trade,
 5. signs which consist exclusively of the shape which results from the nature of the goods as such, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods,
 6. signs, which are contrary to public policy or to accepted principles of morality,
 7. signs which are of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services,
 8. signs, which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property (hereinafter: "the Paris Convention".)
 9. signs for wines which contain or consist of geographical indications identifying wines and signs for spirits which contain or consist of geographical indications identifying spirits with respect to such wines or spirits not having that geographical origin,
 10. signs, which contain the name or abbreviation of the name, national coat of arms, emblem, flag or other official

sign of the Republic of Croatia, or a part thereof, and the imitation thereof, except with the authorization of the competent authority of the Republic of Croatia.

- (2) Registration shall not be refused to signs specified in paragraph (1) items 2 to 4 of this Article, if the applicant for the registration of a trademark proves that the sign has, before the date of filing of the application for the registration and following the use which has been made of it, acquired a distinctive character in respect of the goods or services for which registration is requested.

RELATIVE GROUNDS FOR REFUSAL

Article 6

- (1) Upon an opposition as filed, a sign shall not be registered:
1. if it is identical with an earlier trademark registered for identical goods or services,
 2. if because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services, there is a likelihood of confusion on the part of the public, which includes the likelihood of its association with the earlier trademark.
- (2) For the purposes of this Act, "earlier trademark" shall mean:
1. trademarks registered in the Republic of Croatia, enjoying priority right referred to in Articles 17, 18 and 19 of this Act,
 2. trademarks registered under international treaties, having effect in the Republic of Croatia, and enjoying priority right referred to in Articles 17, 18 and 19 of this Act,
 3. applications for the registration of trademarks referred to in item 1 of this paragraph, provided that the trademarks become registered,
 4. trademarks which, on the date of application for the registration of a trademark, or, if priority is claimed, on the date of priority right claimed in the application, are well known in the Republic of Croatia, in the sense in which the words "well known" are used in Article 6bis of the Paris Convention.
- (3) Upon opposition as filed by the holder of an earlier trademark, a sign shall not be registered if it is identical with, or similar to,

an earlier trademark and the registration has been requested 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 Croatia and where the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trademark;

- (4) Upon opposition as filed, a sign shall not be registered if its use would infringe one of the following earlier rights:
1. a right to a personal name,
 2. a right of personal portrayal,
 3. a copyright,
 4. industrial property rights.
- (5) For the purposes of this Act, "earlier right" shall mean rights acquired on the date which is earlier than the date of application for the registration of a trademark, or, if priority right is claimed, as from the date of priority claimed in the application.
- (6) On the basis of opposition as filed, a sign shall not be registered if its use would infringe the right of the person who, at the time of filing of an application for the registration of a trademark, had a firm, provided that such firm or the essential part thereof is identical with or similar to the sign in respect of which the application is filed and provided that identical or similar goods or services are the subject matter of the firm's activity, unless the applicant had the identical or similar firm at the time of filing the application for registration of a trademark.
- (7) On the basis of opposition as filed, a sign shall not be registered if it is identical with, or similar to, an earlier trademark which was registered for identical or similar goods or services and conferred on them a right which has expired for failure to renew the registration of the trademark within a period of not more than two years as from the expiry of the trademark, unless the holder of the earlier trademark gave his consent for the registration of the later trademark or did not use his trademark.

II. EFFECTS OF A TRADEMARK

RIGHTS CONFERRED BY A TRADEMARK

Article 7

- (1) A registered trademark shall confer on its holder the exclusive rights therein.
- (2) The holder shall be entitled to prevent all third parties not having his authorization from using in the course of trade:
 1. any sign which is identical with his trademark in relation to goods or services which are identical with those for which the trademark is registered,
 2. any sign where, because of its identity with, or similarity to, his trademark and the identity or similarity of the goods or services covered by the trademark and the sign, there is a likelihood of confusion on the part of the public, which includes the likelihood of association of the sign with the trademark,
 3. any sign which is identical with, or similar to, his trademark in relation to goods or services which are not similar to those for which the trademark is registered, where the trademark has a reputation in the Republic of Croatia and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark.
- (3) Within the meaning of paragraph (2) of this Article, the holder of a trademark may also prohibit the following:
 1. affixing the sign to the goods or to the packaging thereof,
 2. offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or providing services there under,
 3. importing or exporting the goods under the sign,
 4. using the sign on business papers and in advertising.
- (4) The rights conferred by a trademark shall have effect against third parties as from the date of publication of the registration of a trademark.

REPRODUCTION OF A TRADEMARK IN DICTIONARIES

Article 8

If the reproduction of a trademark in a dictionary, encyclopedia or similar publications, including

those in electronic form, gives the impression that the trademark constitutes the generic name of the goods or services for which it is registered, the publisher of the work shall, on request of the holder of the trademark, ensure that the reproduction of the trademark is, at the latest in the next edition of the publication, accompanied by a note that it is a registered trademark.

PROHIBITION OF THE USE OF A TRADEMARK REGISTERED IN THE NAME OF A TRADE AGENT OR A REPRESENTATIVE

Article 9

Where a trademark is registered in the name of the trade agent or a representative of a holder of the trademark, without the holder's authorization, the holder shall be entitled to prohibit the use of this trademark by the agent or representative.

LIMITATION OF THE EFFECTS OF A TRADEMARK

Article 10

- (1) A trademark shall not entitle its holder to prohibit a third party from using, in the course of trade: his own name or address, indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of providing of a service, or indications concerning other characteristics of goods or services.
- (2) A trademark shall not entitle its holder to prohibit a third party from using, in the course of trade the trademark where it is necessary to indicate the intended purpose of a product or a service, in particular as accessories or spare parts, provided that such sign is used in accordance with established and honest practices in industrial or commercial activity and fair competition.
- (3) A trade mark shall not entitle the holder of the trademark to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality if that right is recognized by the laws of the Republic of Croatia and within the limits of the territory in which it is recognized.

EXHAUSTION OF THE RIGHTS

Article 11

- (1) Exhaustion of the right to prohibit the use of a trademark in relation to goods or services shall start having effect by putting these goods or services on the market in the Republic of Croatia by the holder of the trademark or with his authorization.

- (2) Paragraph (1) of this Article shall not apply where there are justified reasons for the holder of the trademark to oppose further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.
- (3) The exhaustion of the rights referred to in paragraph (1) of this Article may be extended beyond the territory of the Republic of Croatia, if this is in conformity with international treaties, binding the Republic of Croatia.

LIMITATION OF RIGHTS IN CONSEQUENCE OF ACQUIESCENCE

Article 12

- (1) Where the holder of an earlier trademark has acquiesced, within a continuous period of five years, in the use of a later trademark while being aware of such use, he shall no longer be entitled on the basis of the earlier trademark either to file a request for a declaration that the later trademark is invalid or to oppose the use of the later trademark in relation to the goods or services for which the later trademark has been used, unless the registration of the later trademark was applied for in bad faith.
- (2) Paragraph (1) of this Article shall also apply to the holders of earlier rights referred to in Article 6 paragraphs (4) or (6) of this Act.
- (3) In the cases referred to in paragraphs (1) and (2) of this Article, the holder of a later registered trademark shall not be entitled to oppose the use of the earlier right, even though the holder of the earlier right may no longer invoke that right against the later trademark.

III. USE OF A TRADEMARK

USE OF A TRADEMARK

Article 13

- (1) A holder of a trademark shall be entitled to use a trademark in relation to the goods or services for which it is registered.
- (2) The following shall also constitute the use within the meaning of paragraph (1) of this Article:
 1. use of the trademark in a form differing in elements which do not alter the distinctive character of the trademark in

respect of the form in which it was registered,

2. affixing of the trademark to goods or to the packaging thereof in the Republic of Croatia concerned solely for export purposes.
- (3) Use of the trademark with the authorization of the holder or by any person who has authority to use a collective mark or a guarantee mark shall be deemed to constitute use by the holder.
- (4) If, within a continuous period of five years following the date of registration, the holder has not put his trademark to genuine use in the Republic of Croatia in relation to the goods or services for which it is registered, or if such use has been suspended during an uninterrupted period of five years, the consequences of such non-use are prescribed in Article 29, Article 46 paragraph (2) and Article 51 paragraph (5) of this Act, unless there are justified reasons for non-use.

IV. APPLICATION FOR THE REGISTRATION OF A TRADEMARK

FILING OF AN APPLICATION

Article 14

- (1) An application for the registration of a trademark shall be filed with the Office.
- (2) An applicant cannot, by one application, request registration of more than one sign for which trademark protection is sought.

REQUIREMENTS WITH WHICH AN APPLICATION MUST COMPLY

Article 15

- (1) An application for the registration of a trademark shall contain:
 1. a request for the registration of a trademark,
 2. information about the applicant,
 3. a list of the goods or services for which the registration is requested,
 4. a representation of the sign of which the registration is requested.
- (2) An application for the registration of a trademark shall be considered to have been filed if it complies with the requirements set out in paragraph (1) of this Article.

- (3) Other elements of the application and the attachments thereto shall be filed in accordance with the Regulations on Trademarks (hereinafter: "the Regulations").

CLASSIFICATION

Article 16

The goods or services in relation to which an application for the registration of a trademark is filed shall be classified in conformity with the International Classification of Goods and Services established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

APPLICATION FILING PRIORITY

Article 17

- (1) If the application for the registration of a trademark is filed in accordance with Article 15 paragraph (1) of this Act, the applicant for the registration of the trademark shall acquire the right of priority on the basis of the application filing date over any other applicant filing later an application for the identical or similar sign for which the registration for the identical or similar goods or services is requested.
- (2) Every application filed under multilateral agreements to which the Republic of Croatia is a party also gives rise to a right of priority.

UNION PRIORITY RIGHT

Article 18

- (1) If the applicant for the registration of a trademark has filed the application for the first time in a Member State of the Paris Union for the Protection of Industrial Property (hereinafter: "the Paris Union") or in a Member State of the World Trade Organization, he may, when filing the application for the same trademark in the Republic of Croatia, invoke the date of the first filing, provided that he files the application in the Republic of Croatia within six months from the date of the first filing.
- (2) The applicant invoking the union priority right shall indicate, in the application he is filing with the Office, the relevant data on the application he is invoking (State, date and number of the application) and shall attach thereto a true copy of the first application certified by the competent authority of the Member State of the Paris Union or the Member State of the World

Trade Organization not later than within three months from the date of filing a priority claim, and the translation of the first application into the Croatian language.

EXHIBITION PRIORITY RIGHT

Article 19

- (1) If the applicant for the registration of a trademark has displayed the goods or services designated by a specific sign at an official or officially recognized international exhibition in the Republic of Croatia, in any of the Member States of the Paris Union or in any of the Member States of the World Trade Organization, he may request that the date of the first day of the exhibition of the goods or of providing of the services be accorded as the date of the first application, provided that he files the application in the Republic of Croatia within six months as from that date.
- (2) The applicant invoking the exhibition priority right shall, in addition to the application he is filing with the Office, submit a certificate issued by the competent authority of the Member State of the Paris Union or the Member State of the World Trade Organization indicating the type of the exhibition, the venue thereof, its opening and closing dates and the first day of the exhibition of the goods or services specified in the application.

V. PROCEDURE FOR THE REGISTRATION OF A TRADEMARK

THE OFFICE AUTHORITY

Article 20

- (1) The administrative tasks relating to the registration of trademarks shall be carried out by the Office.
- (2) The administrative decisions made by the Office shall not be subject to any appeal, but an administrative lawsuit may be instituted.

EXAMINATION OF THE CORRECTNESS OF THE APPLICATION

Article 21

- (1) The examination of the correctness of the application shall include the examination of compliance with all the requirements prescribed by this Act and the Regulations.

- (2) The application for the registration of a trademark shall be correct:
1. if it is filed in accordance with Article 14 paragraph (2) of this Act,
 2. if it is filed in accordance with the requirements set out in Article 15 paragraphs (1) and (3) of this Act.

REMEDYING THE DEFICIENCIES OF THE APPLICATION

Article 22

- (1) If the application for the registration of a trademark complies with the requirements set out in Article 15 paragraph (1) of this Act, but is not filed in a way to contain all the necessary elements and attachments in accordance with the Regulations, the Office shall invite the applicant to remedy the deficiencies within 60 days as from the day of receipt of the invitation.
- (2) If the applicant remedies the deficiencies in the application in accordance with the invitation referred to in paragraph (1) of this Article within the prescribed time limit, the application shall be considered to be correct as from the beginning.
- (3) If the application does not comply with the requirements set out in Article 15 paragraph (1) of this Act, it shall not be considered as the application for the registration of a trademark, and the Office shall invite the applicant to remedy all the found deficiencies within 60 days as from the day of receipt of the invitation.
- (4) The date of receipt of the corrected application within the meaning of the paragraph (3) of this Article shall be considered to be the date for establishing the priority right referred to in Article 17 of this Act.
- (5) On request of the applicant, the time limit laid down in paragraphs (1) and (3) of this Article may be extended for not more than 60 days.

REJECTION OF THE APPLICATION

Article 23

If the applicant for the registration of a trademark does not, within the prescribed time limit, comply with the invitation sent by the Office and does not remedy the found deficiencies within the meaning of Article 22 paragraphs (1) and (3) of this Act, the application shall be rejected by a decision.

REFUSAL OF THE REGISTRATION OF A TRADEMARK

Article 24

- (1) The decision on the refusal of the registration in full or the decision on the refusal of the registration in relation to only some goods or services for which the registration was requested shall not be made before the applicant for the registration of the trademark is notified in writing about the grounds for refusal and invited to withdraw the application or to amend it or to submit his observations on the grounds for refusal of the registration.
- (2) The applicant shall have the right to act according to paragraph (1) of this Article within 60 days from the day of the receipt of the written notification of the grounds for refusal of the registration and to submit evidence on the possible new facts that might influence the final decision of the Office.
- (3) On request of the applicant, the time limit referred to in paragraph (2) of this Article may be extended for not more than 60 days.

PUBLICATION OF THE APPLICATION

Article 25

- (1) If all the requirements set out in Article 21 paragraph (2) of this Act are complied with, if there are no grounds for refusal of the registration under Article 5 paragraph (1) of this Act, and if the prescribed procedural charges for the publication of an application are paid, the application data shall be published in "The Croatian Intellectual Property Gazette" (hereinafter: "the Office official gazette").
- (2) The application data to be published in the Office official gazette shall be prescribed by the Regulations.

OPINIONS BY THIRD PARTIES

Article 26

- (1) Following the publication of an application for the registration of a trademark, any natural or legal person and any group or body representing manufacturers, providers of services, traders or consumers, may submit to the Office, within a period of three months from the date of publication of the application for the registration of a trademark, their written opinions,

- explaining, in particular, the grounds referred to in Article 5 paragraph (1) of this Act.
- (2) The persons, groups or bodies referred to in paragraph (1) of this Article shall not be considered parties to the proceedings.
 - (3) The Office shall send the opinions referred to in paragraph (1) of this Article to the applicant for the registration of a trademark who may submit his observations thereon within 15 days as from the day of receipt of a copy of the opinion.

OPPOSITION

Article 27

- (1) Within a period of three months from the date of publication of an application for the registration of a trademark, entitled to file with the Office an opposition to registration of the trademark, which may be based only on the grounds for refusal referred to in Article 6 of this Act, shall be:
 1. in respect of Article 6 paragraphs (1) and (3) of this Act, the holder of an earlier trademark and the licensee in accordance with Article 39 paragraph (4) or (5) of this Act,
 2. the holder of any of the rights referred to in Article 6 paragraph (4) of this Act,
 3. the person who had a firm within the meaning of Article 6 paragraph (6) of this Act,
 4. the holder of an earlier trademark within the meaning of Article 6 paragraph (7) of this Act.
- (2) If, on the date of publication of an application, the earlier trademark, on which the opposition is based, is subject to a pending revocation procedure or a pending procedure for a declaration that the trademark is invalid, the Office shall suspend the opposition procedure until the decision from the earlier initiated revocation procedure or the procedure for a declaration that the trademark is invalid has become final.
- (3) The time limit for filing the opposition, laid down in paragraph (1) of this Article, shall not be extended, nor shall it be possible to submit, after the expiry of this time limit, additions to the opposition, which include submissions of additional evidence and

documentation supporting the justification of the grounds specified in the opposition.

- (4) The opposition shall be filed under conditions and in the manner as prescribed by the Regulations.

OPPOSITION PROCEDURE

Article 28

- (1) The Office shall examine whether the opposition is filed by the person entitled to file the opposition within the meaning of Article 27 paragraph (1) of this Act, whether the opposition is filed within the prescribed time limit and whether it is filed as prescribed by the Regulations.
- (2) If the requirements set out in paragraph (1) of this Article are not complied with, the Office shall reject the opposition by a decision.
- (3) If the requirements set out in paragraph (1) of this Article are complied with, the Office shall notify the applicant of the opposition as filed, and shall send him a copy of the opposition, inviting him to submit his observations on the opposition within 60 days from the day of receipt of the notification.
- (4) The time limit referred to in paragraph (3) of this Article shall not be extended, nor shall it be possible to submit, after the expiry of this time limit, additions to the observations on the opposition, which include submissions of additional evidence and documentation.
- (5) If the applicant does not submit his observations on the opposition within the prescribed time limit, the requested registration of the trademark shall be refused within the limits of the requests referred to in the opposition.
- (6) If the Office considers it necessary, it may provide for oral hearings to be held in the opposition procedure.

EXAMINATION OF THE OPPOSITION

Article 29

- (1) If the applicant for the registration of a trademark submits his observations on the opposition within the prescribed time limit, the Office shall examine the justification of the grounds specified in the opposition.
- (2) If the applicant for the registration of a trademark so requests, the holder of an

earlier trademark who has filed the opposition to the registration shall furnish proof that, during the period of five years preceding the date of publication of the application, he has used the trademark in the Republic of Croatia within the meaning of Article 13 paragraphs (2), (3) and (4) of this Act, for the goods or services in respect of which it is registered and which he cites as justification for the opposition, or he shall furnish proof that there are justified reasons for non-use, provided that the earlier trademark has, on the date of publication of the application for the registration of the trademark, been registered for not less than five years.

- (3) If the holder does not prove the use of his trademark within the meaning of paragraph (2) of this Article, the opposition shall be refused.
- (4) If the earlier trademark has been used in relation to a part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.
- (5) If, in the examination procedure concerning the opposition, the Office finds that the opposition is unjustified, it shall be refused and the decision to that effect shall be sent to the applicant and to the opponent.
- (6) If, in the examination procedure concerning the opposition, the Office finds that the opposition is justified, the registration of the trademark shall be refused or partially granted, and the decision to that effect shall be sent to the applicant and to the opponent.

WITHDRAWAL OF THE APPLICATION AND RESTRICTION OF THE LIST OF GOODS OR SERVICES

Article 30

- (1) The applicant for the registration of a trademark may at any time withdraw his application or restrict the list of goods or services contained therein.
- (2) If the application has already been published, the withdrawal of the application or restriction of the list of goods or services shall be published in the Office official gazette later on.

AMENDMENTS OF THE APPLICATION FOR THE REGISTRATION OF A TRADEMARK

Article 31

- (1) On request of the applicant for the registration of a trademark or ex officio, amendments of the application can be made only in cases where it is necessary to correct the name or address of the applicant, errors of wording or of copying, or to correct some other obvious mistakes, provided that such amendments do not require extension of the list of goods or services.
- (2) The representation of a sign that is applied for shall not be altered, except where it includes the name and address of the applicant for the registration of a trademark. In that case, on request of the applicant, an alteration, not substantially affecting the identity of the sign as originally entered in the register, may be entered in the register.
- (3) If the application for the registration of a trademark has already been published, the amendments of the application shall be published in the Office official gazette later on, subject to the prior payment of the prescribed procedural charges.

REGISTRATION OF THE TRADEMARK

Article 32

- (1) If the grounds referred to in Article 5 paragraph (1) and Article 6 of this Act do not constitute a barrier to the registration, the trademark shall be entered in the trademark register, subject to the prior payment of the procedural charges for the maintenance of the trademark for the first ten-year period and for the publication of the data on the trademark.
- (2) If the procedural charges referred to in the paragraph (1) of this Article are not paid, the application for the registration of a trademark shall be rejected by a decision.

DIVISION OF THE APPLICATION AND THE REGISTRATION

Article 33

- (1) Any application or a registration of a trademark may be, on request of the applicant or the holder of the trademark, divided into two or several applications or registrations in respect of the list of the goods or services covered by the application or the registration.

- (2) The divisional applications or registrations shall maintain the priority right from the first application or the registration.
- (3) The procedure of division of an application or a registration shall be prescribed by the Regulations.
- (4) The data concerning divisional applications or registrations shall be entered in the register and published in the Office official gazette.

PUBLICATION OF THE TRADEMARK

Article 34

- (1) The data concerning a trademark shall be published in the Office official gazette not later than within three months from the date of entry of the trademark in the register.
- (2) The data to be published in the Office official gazette shall be prescribed by the Regulations.

TRADEMARK CERTIFICATE

Article 35

- (1) On request of the holder of a trademark, and subject to the prior payment of the prescribed procedural charges for the issuance of the trademark certificate, the Office shall issue the certificate to the holder of the trademark not later than within three months from the date of publication of the trademark in the Office official gazette.
- (2) The data to be contained in the trademark certificate shall be prescribed by the Regulations.

AMENDMENTS OF THE REGISTRATION OF A TRADEMARK

Article 36

- (1) On request of the holder of a trademark or ex officio, amendments of the registration of a trademark can be made only in cases where it is necessary to correct the name or address of the holder of the trademark, and errors of wording or of copying, or to correct some other obvious mistakes, provided that such amendments do not require extension of the list of goods or services.
- (2) The representation of a trademark shall not be altered during the period of registration or on renewal thereof, except where it includes the name and address of the holder. In that case, on request of the holder, an alteration, not substantially

affecting the identity of the trademark as originally entered in the register, may be entered in the register.

- (3) Where the registration has already been published, the amendments of the registration shall be published in the Office official gazette later on, subject to the prior payment of the prescribed procedural charges.

VI. CHANGES RELATING TO A TRADEMARK

ENTRY OF CHANGES

Article 37

- (1) On request of the applicant for the registration of a trademark or the holder of a trademark, the Office shall enter in the register all the changes occurring after the filing of the application for the registration of a trademark or after the registration of a trademark, provided that they correspond to the real situation and that they do not affect the representation of the registered trademark.
- (2) The changes entered in the trademark register shall be published in the Office official gazette.
- (3) The data to be contained in the request for the entry of any change relating to a trademark shall be prescribed by the Regulations.

TRANSFER OF RIGHTS

Article 38

- (1) The holder of a trademark may transfer his trademark to other persons in respect of some or all of the goods or services for which it is registered.
- (2) On request of one of the parties, the transfer of rights shall be entered in the register, if a certified copy of the transfer contract, or the certified part of the contract, or the original certificate of the transfer signed both by the former and the new holder of the right is submitted to the Office.
- (3) The transfer of rights shall be published in the Office official gazette and it shall have effect against third parties after the entry thereof in the register.
- (4) The request for the entry of the transfer of rights in the register shall be filed under the

conditions and in the manner as prescribed by the Regulations.

LICENSE

Article 39

- (1) A trademark may be licensed for some or all of the goods or services for which it is registered and for the whole or a part of the territory of the Republic of Croatia.
- (2) A license may be exclusive or non-exclusive.
- (3) The holder of a trademark may invoke the rights conferred by the trademark against a licensee who contravenes any provision of the licensing contract with regard to its duration, the form covered by the registration in which the trademark may be used, the scope of the goods or services for which the license is granted, the territory in which the trademark may be affixed, the quality of the goods manufactured or of the services provided by the licensee.
- (4) Without prejudice to the provisions of the licensing contract, the holder of a non-exclusive license may institute proceedings for the infringement of a trademark only if the holder of the trademark consents thereto.
- (5) Without prejudice to the provisions of the licensing contract, the holder of an exclusive license may institute proceedings for the infringement of a trademark, if the holder of the trademark, after a formal notice, does not himself institute infringement proceedings within an appropriate period.
- (6) On request of one of the parties, the license shall be entered in the register, if a certified copy of the licensing contract, or the certified part of the contract, or the original certificate of granting the license signed both by the licensor and the licensee is submitted to the Office.
- (7) If the prescribed fee and procedural charges are paid, the license shall be published in the Office official gazette, and it shall have effect against third parties after the entry thereof in the register.
- (8) The request for the entry of the license in the register shall be filed under the conditions and in the manner as prescribed by the Regulations.

RIGHTS IN REM AND LEVY OF EXECUTION

Article 40

- (1) A trademark may be subject to the rights in rem and levy of execution.
- (2) On request of one of the parties, the rights in rem and levy of execution shall be entered in the register.
- (3) Rights in rem and levy of execution shall be published in the Office official gazette and shall have effect against third parties after the entry thereof in the register.
- (4) The request for the entry of the rights in rem or levy of execution in the register shall be filed under the conditions and in the manner as prescribed by the Regulations.

BANKRUPTCY PROCEEDINGS

Article 41

Where a trademark is involved in bankruptcy proceedings, on request of the competent authority an indication to that effect shall be entered in the register and published.

RIGHTS CONFERRED BY AN APPLICATION

Article 42

Articles 38 to 41 of this Act shall also apply to applications for the registration of a trademark.

VII. DURATION, RENEWAL AND CEASING OF EFFECTS OF A TRADEMARK

PERIOD OF PROTECTION

Article 43

The period of protection of a registered trademark shall last ten years counting from the date of filing of the application for the registration of a trademark.

RENEWAL OF THE REGISTRATION OF A TRADEMARK

Article 44

- (1) The registration of a trademark may be renewed indefinite number of times, for the periods of ten years each, provided that the holder of the trademark files with the Office a request for renewal of the registration of the trademark and pays the prescribed fee and procedural charges in the course of the last year of the ten-year period of protection.
- (2) The request for renewal of the registration of a trademark may be submitted and the

- fee and procedural charges paid within the additional period of six months following the expiry of the period referred to in paragraph (1) of this Article, in which case the amount of the prescribed fee and procedural charges shall be doubled.
- (3) The new period of protection shall begin with the day of expiry of the previous ten-year period.
 - (4) The request for renewal of the registration of a trademark may be filed with the Office by the holder of the trademark or a person expressly authorized by him.
 - (5) Where the request for renewal of the registration of a trademark is filed in respect of only of some of the goods or services for which the trademark is registered, the registration shall be renewed for those goods or services only.
 - (6) The renewal of the registration of a trademark shall be entered in the register and published in the Office official gazette.
 - (7) If the registration is not renewed, the trademark shall cease to have effect from the day of expiry of the period of protection.
 - (8) The data to be contained in the request for renewal of the registration of a trademark shall be prescribed by the Regulations.
- (2) A trademark may be revoked if, within a continuous period of five years, it has not been put to genuine use in the Republic of Croatia in relation to the goods or services in respect of which it is registered, and there are no justified reasons for non-use.
 - (3) A trademark may also be revoked if, after the date on which it was registered,
 1. in consequence of acts or inactivity of the holder, it has become a common name in the trade for products or services in respect of which it is registered,
 2. in consequence of the use made of it by the holder of the trademark or with his authorization, in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
 - (4) The request for revocation of a trademark shall be filed under conditions and in the manner as prescribed by the Regulations.

PROCEDURE CONCERNING THE REQUEST FOR REFUSAL OF A TRADEMARK

Article 47

SURRENDER OF THE TRADEMARK

Article 45

- (1) The holder of a trademark may surrender the trademark in respect of some or all of the goods or services for which it is registered by a written declaration.
- (2) If a license has been entered in the register, the surrender of the trademark shall only be entered in the register if the holder of the trademark proves that he has informed the licensee of his intention to surrender the trademark.
- (3) On the basis of the declaration of surrender, the trademark shall cease to have effect on the day the holder has submitted the declaration of surrender.

REVOCATION OF A TRADEMARK

Article 46

- (1) The request for revocation of a trademark may be filed with the Office by any natural or legal person.
- (2) If the request for revocation of a trademark is filed before the expiry of a period of five years from the registration of the trademark the revocation of which is requested, and if it is not filed on the grounds specified in Article 46 paragraphs (2) and (3), the Office shall reject the request by a decision.
- (3) If the request for revocation of a trademark is not filed as prescribed by the Regulations, the Office shall invite the person who filed the request to remedy the deficiencies in the request within 60 days from the day of receipt of the invitation.
- (4) If the person who filed the request for revocation of a trademark does not, within the prescribed time limit, comply with the invitation sent by the Office and does not remedy the deficiencies in the request within the meaning of paragraph (3) of this Article, the request shall be rejected by a decision.
- (5) If the requirements set out in paragraph (1) of this Article are complied with, the Office shall notify the holder of the trademark of the request for revocation of the trademark

as filed, and shall send him a copy of the request, inviting him to submit his observations on the request within 60 days from the day of receipt of the invitation.

- (6) On request, the time limits laid down in paragraphs (3) and (5) of this Article may be extended for not more than 60 days.
- (7) If the holder of the trademark in respect of which the revocation is requested does not submit his observations on the request within the prescribed time limit, the trademark shall be revoked for those goods or services in respect of which the request was filed.
- (8) If the Office considers it necessary, it may provide for oral hearing to be held in the revocation procedure.

EXAMINATION OF THE REQUEST FOR REVOCATION OF A TRADEMARK

Article 48

- (1) If the holder of the trademark in respect of which the revocation is requested submits his observations on the request within the prescribed time limit, the Office shall examine the justification of the grounds specified in the request for revocation of the trademark.
- (2) In the examination procedure concerning the request for revocation of a trademark the Office may invite the parties to submit additional evidence, documentation and observations within 60 days from the day of receipt of the invitation.
- (3) On request, the time limit laid down in paragraph (2) of this Article may be extended for not more than 60 days.
- (4) If the party in the procedure does not respond to the invitation referred to in paragraph (3) of this Article within the prescribed time limit, the Office shall make a decision on the basis of the facts available from the previously submitted documentation.
- (5) It may not be requested that a trademark be revoked where genuine use of the trademark has been started or resumed during the interval between expiry of the five-year period of non-use and filing of the request for revocation.
- (6) The commencement or resumption of use within a period of three months preceding the filing of the request for revocation,

which began, at the earliest, on expiry of the continuous period of five years of non-use, shall be disregarded if preparations for the commencement or resumption occur only after the holder becomes aware that the request for revocation may be filed.

- (7) If, in the examination procedure concerning the request for revocation of a trademark, the Office finds that the request is unjustified, the request shall be refused and the decision to that effect shall be sent to the person who has filed the request and to the holder of the trademark in respect of which the revocation is requested.
- (8) If, in the examination procedure concerning the request for revocation of a trademark, the Office finds that the request is justified, the trademark shall be revoked in full or partially and the decision to that effect shall be sent to the person who has filed the request and to the holder of the trademark in respect of which the revocation is requested.
- (9) When a trademark is revoked it shall be deemed that its effects ceased on the date of the filing of the request for revocation.
- (10) The revocation of a trademark shall be entered in the register and published in the Office official gazette.

DECLARATION THAT THE TRADEMARK IS INVALID

Article 49

- (1) The procedure for a declaration that a trademark is invalid shall be carried out by the Office.
- (2) If the trademark was not registered in accordance with the provisions of Article 3 (1) and Article 5 (1) of this Act, the procedure for a declaration that a trademark is invalid may be initiated ex officio, on request of the state attorney or on request of an interested person.
- (3) On the grounds specified in Article 6 of this Act, which shall also apply to the procedure for a declaration that a trademark is invalid, the procedure for a declaration that a trademark is invalid may be initiated:
 - 1. within the meaning of Article 6 paragraphs (1) and (3) of this Act, on request of the holder of an earlier trademark and the licensee in accordance

- with Article 39 paragraph (4) or (5) of this Act,
2. on request of the holder of any of the rights referred to in Article 6 paragraph (4) of this Act,
 3. on request of the person who had a firm within the meaning of Article 6 paragraph (6) of this Act,
 4. on request of the holder of an earlier trademark referred to in Article 6 paragraph (7) of this Act.
- (4) Where a trademark has not been registered in accordance with the provisions of Article 5 paragraph (1) items 2, 3 or 4 of this Act, it may only be declared invalid if the procedure for a declaration that the trademark is invalid has been initiated within a period of ten years from the date of registration.
 - (5) A trademark may not be declared invalid on the grounds of an earlier trademark with a reputation if the earlier trademark has not acquired the reputation within the meaning of Article 6 paragraph (3) of this Act up to the date of priority right of the later trademark.
 - (6) Where the holder of the right referred to in paragraph (3) of this Article has previously filed a request for a declaration that a trademark is invalid, he may not file a new request for a declaration that a trademark is invalid on the basis of any other of the said rights which he could have invoked in support of his first request.
 - (7) If, on the date of filing of the request for a declaration that a trademark is invalid, the earlier trademark on which the request is based is subject to a pending revocation procedure or a pending procedure for a declaration that the trademark is invalid, the Office shall suspend the procedure until the decision from the earlier initiated revocation procedure or the procedure for a declaration that the trademark is invalid has become final.
 - (8) The request for a declaration that a trademark is invalid shall be filed under the conditions and in the manner as prescribed by the Regulations.
- PROCEDURE CONCERNING THE
REQUEST FOR A DECLARATION THAT
A TRADEMARK IS INVALID*
- Article 50
- (1) The Office shall examine whether the request for a declaration that a trademark is invalid is filed in accordance with Article 49 paragraphs (3), (4), (5), (6) and (8) of this Act.
 - (2) If the request for a declaration that a trademark is invalid is not filed in accordance with Article 49 paragraphs (3), (4) and (6) of this Act, the Office shall reject the request by a decision.
 - (3) If the request for a declaration that a trademark is invalid is not filed as prescribed by the Regulations, the Office shall invite the person who filed the request to remedy the deficiencies in the request within 60 days from the day of receipt of the invitation.
 - (4) If the person who filed the request does not, within the prescribed time limit, comply with the invitation sent by the Office and does not remedy the deficiencies in the request within the meaning of paragraph (3) of this Article, the request shall be rejected by a decision.
 - (5) If the requirements set out in Article 49 of this Act are complied with, the Office shall notify the holder of the contested trademark of the initiated procedure for a declaration that the trademark is invalid, and shall send him a copy of the request, inviting him to submit his observations on the request within 60 days from the day of receipt of the invitation.
 - (6) On request, the time limits laid down in paragraphs (3) and (5) of this Article may be extended for not more than 60 days.
 - (7) If the holder of the contested trademark does not submit his observations on the request for a declaration that the trademark is invalid within the prescribed time limit, the trademark shall be declared invalid for those goods or services in respect of which the procedure was initiated.
 - (8) If the Office considers it necessary, it may provide for oral hearing to be held in the procedure concerning the request for a declaration that a trademark is invalid.

*EXAMINATION OF THE REQUEST
FOR A DECLARATION THAT A
TRADEMARK IS INVALID*

Article 51

- (1) If the holder of the contested trademark submits his observations on the request for a declaration that a trademark is invalid within the prescribed time limit, the Office shall examine the justification of the grounds specified in the request.
- (2) Where a trademark has not been registered in accordance with Article 3 paragraph (1) and Article 5 paragraph (1) of this Act, the trademark shall be declared invalid only if the grounds for a declaration that a trademark is invalid still exist at the time when the decision on the request for a declaration that a trademark is invalid is made.
- (3) Where a trademark has not been registered in accordance with Article 5 paragraph (1) items 2, 3 or 4 of this Act, it shall not be declared invalid if the holder of the trademark proves that the trademark has, after the registration and following the use, which has been made of it, acquired a distinctive character in respect of the goods or services for which it is registered.
- (4) A trademark may not be declared invalid if the holder of the right referred to in Article 49 paragraph (3) of this Act consented expressly to the registration of that trademark before filing of the request for a declaration that a trademark is invalid.
- (5) A trademark may not be declared invalid on the ground that there is an earlier conflicting trademark if this earlier trademark does not comply with the requirements of use set out in Article 13 paragraphs (2) to (4), provided that the earlier trademark has, on the date of filing the request for a declaration that a trademark is invalid, been registered for not less than five years.
- (6) If the earlier trademark has been used in relation to a part only of the goods or services for which it is registered it shall, for the purposes of the examination of the request for a declaration that a trademark is invalid, be considered to be registered in respect only of that part of the goods or services.
- (7) In the examination procedure concerning the request for a declaration that a trademark is invalid the Office may invite the parties to submit additional evidence, documentation and observations within 60 days from the day of receipt of the invitation.
- (8) On request, the time limit laid down in paragraph (7) of this Article may be extended for not more than 60 days.
- (9) If the party in the procedure does not respond to the invitation within the prescribed time limit, the Office shall make a decision on the basis of the facts available from the earlier submitted documentation.
- (10) If, in the examination procedure concerning the request for a declaration that a trademark is invalid, the Office finds that the request is unjustified, the request shall be refused and the decision to that effect shall be sent to the person who has filed the request and to the holder of the contested trademark.
- (11) If, in the examination procedure concerning the request for a declaration that a trademark is invalid, the Office finds that the request is justified, the trademark shall be declared invalid in full or partially, and the decision to that effect shall be sent to the person who has filed the request and to the holder of the contested trademark.
- (12) Where a trademark is declared invalid, the effects of that trademark shall be considered to have been invalid as from the day of filing the application for the registration of the trademark.
- (13) The declaration that a trademark is invalid shall be entered in the register and published in the Office official gazette.

*PARTIAL REFUSAL OF REGISTRATION OF A
TRADEMARK, REVOCATION OF A
TRADEMARK
OR DECLARATION THAT A TRADEMARK IS
INVALID*

Article 52

Where the grounds for refusal of the registration of a trademark or for revocation of a trademark or for a declaration that a trademark is invalid exist in respect of only some of the goods or services for which the trademark has been applied for or registered, refusal of the registration or revocation or the declaration that a trademark is invalid shall cover those goods or services only.

VIII. COLLECTIVE AND GUARANTEE MARK

COLLECTIVE MARK

Article 53

Any sign within the meaning of Article 2 of this Act, which is indicated as such in the application for the registration of a trademark, and which is capable of distinguishing the goods or services of the members or partners of a certain legal person from the goods or services of other undertakings, and which is intended for collective designation of the goods or services put on the market by the members or the partners of that legal person, may be protected as a collective mark.

GUARANTEE MARK

Article 54

Any sign within the meaning of the Article 2 of this Act, which serves to designate the quality, origin, manner of production, or other common characteristics of the goods or services of the undertakings that are under the supervision of the holder of a trademark and use that trademark, may be protected as a guarantee mark.

SPECIAL PROVISIONS ON COLLECTIVE MARKS AND GUARANTEE MARKS

Article 55

- (1) The provisions of this Act and the Regulations shall also apply to collective marks and guarantee marks, unless this part of the Act provides otherwise.
- (2) By way of derogation from the provision of Article 5 paragraph (1) item 3 of this Act, signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be protected as a collective mark.
- (3) The mark referred to in paragraph (2) shall not entitle the holder to prohibit a third party to use in the course of trade signs or indications specified in paragraph (2) of this Article, provided that he uses them in accordance with established and honest practices in industrial or commercial activity. In particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.

PERSONS WHO MAY BE HOLDERS OF A COLLECTIVE MARK

Article 56

The holder of a collective mark or the applicant for the registration of a collective mark may be legal persons and associations of manufacturers, providers of services, or traders, which may, in their own name, assume obligations and exercise rights, make contracts or perform other legal actions.

CONTRACT ON A COLLECTIVE MARK

Article 57

A contract on a collective mark shall be filed with the application for the registration of a collective mark and shall contain: the list of names of the persons authorized to use the collective mark, the conditions of membership, the conditions governing such use and provisions relating to the infringement of rights in the case of misuse of the collective mark, or the breach of the provisions of the contract.

USE OF COLLECTIVE MARKS

Article 58

Any person who has been authorized to use a collective mark shall be entitled to use it, provided that all the requirements, which this Act prescribes with regard to the use of trademarks, are complied with.

AMENDMENTS OF THE CONTRACT GOVERNING A COLLECTIVE MARK

Article 59

- (1) The holder of a collective mark must submit to the Office all the amendments of the contract relating to the use of the collective mark.
- (2) Amendments of the contract governing the use of the collective mark shall have effect against third parties after the entry thereof in the register.

IX. PROTECTION OF TRADEMARKS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THE MADRID AGREEMENT

SPECIAL PROVISIONS ON INTERNATIONAL REGISTRATIONS OF MARKS

Article 60

The provisions of this Act and the Regulations on Trademarks shall apply to international registrations of marks the protection of which extends to the territory of the Republic of Croatia under the Madrid Agreement Concerning the International Registration of Marks (hereinafter: "the Madrid Agreement") and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter: "the Protocol"), in all the matters not regulated by these treaties, unless this part of the Act provides otherwise.

FILING OF THE APPLICATION FOR THE INTERNATIONAL REGISTRATION OF A MARK AND THE REQUEST FOR RECORDING OF A CHANGE IN THE INTERNATIONAL REGISTER

Article 61

- (1) An application for the international registration of a mark and requests for recording of a change in the International Register shall be filed with the Office as prescribed by the Madrid Agreement, the Protocol, the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol (hereinafter: "the Common Regulations") and this Act and the Regulations.
- (2) If the application for the international registration of a mark or a request for recording of a change in the International Register is not filed as prescribed by the Madrid Agreement, the Protocol, the Common Regulations and the Regulations on Trademarks, the Office shall invite the applicant or the person who filed the request to remedy the deficiencies in the application or the request within 30 days from the day of receipt of the invitation.
- (3) On request, the time limit laid down in paragraph (2) of this Article may be extended for not more than 60 days.
- (4) If the application for the international registration of a mark is filed in accordance with paragraph (1) of this Article and if the prescribed fee and procedural charges are paid, the Office shall transmit the application to the International Bureau of the World Intellectual Property Organization (hereinafter: "the International Bureau").

- (5) If the applicant for the international registration of a mark or the person who filed the request for recording of a change in the International Register does not, within the prescribed time limit, comply with the invitation sent by the Office, and does not remedy the found deficiencies within the meaning of paragraph (2) of this Article, the application or the request shall be rejected by a decision.

FEES

Article 62

All the fees payable under the Madrid Agreement and the Protocol shall be paid directly to the International Bureau.

ENTRY IN THE TRADEMARK REGISTER

Article 63

The date and number of the international registration of a mark shall be entered in the trademark register kept by the Office, provided that the international application resulted in the registration.

REFUSAL OF PROTECTION TO THE INTERNATIONAL REGISTRATION OF A MARK

Article 64

For the holder of an international registration of a mark the time limit laid down in Article 24 paragraph (2) of this Act shall be replaced by the time limit of four months as from the date of the notification of refusal.

OPPOSITION TO THE INTERNATIONAL REGISTRATION OF A MARK

Article 65

- (1) For the purposes of international registrations of marks under the Madrid Agreement and the Protocol, the publication of the application prescribed in Article 25 of this Act shall be replaced by the publication in the official gazette of international registrations of marks published by the International Bureau (hereinafter: the international official gazette).
- (2) The time limit for filing the opposition to an international registration of a mark shall run from the first day of the month following the month indicated on the edition of the international official gazette in which such mark has been published.
- (3) In the procedure concerning the opposition to an international registration of a mark,

- the Office, in accordance with the Madrid Agreement or the Protocol, shall send to the holder of the international registration of a mark a notification of provisional refusal on the basis of the opposition and shall invite him to appoint a representative who shall, within four months from the date of the notification of refusal, file with the Office a power of attorney. A copy of the opposition shall be sent to the representative after filing of the power of attorney. The time limit for submitting the observations on the opposition is 60 days from the day of receipt of the copy of the opposition by the representative.
- (4) The time limits referred to in paragraph (3) of this Article shall not be extended.
- (2) The time limit referred to in paragraph (1) of this Article shall not be extended.
- (3) A copy of the request shall be sent to the representative after filing of the power of attorney. The time limit for submitting the observations on the request is 60 days from the day of receipt of the copy of the request by the representative.
- (4) On request, the time limit laid down in paragraph (3) of this Article may be extended for not more than 60 days.
- (5) In the procedure for revocation of an international registration of a mark, for the purposes of proving the use of a mark, the date of registration shall be considered to be the date specified in Article 66 of this Act.

OPPOSITION AND THE PROCEDURE FOR A DECLARATION THAT A TRADEMARK IS INVALID ON THE BASIS OF AN INTERNATIONAL REGISTRATION OF A MARK

Article 66

If, on the basis of an international registration of a mark, an opposition procedure or the procedure for a declaration that a trademark is invalid is initiated, for the purposes of proving the use of a mark, the date of the registration shall be considered to be the date on which the period according to Article 5 paragraph (2) of the Madrid Agreement or Article 5 paragraph (2) subparagraph (a) of the Protocol expired or, if the granting or opposition procedures have not yet been concluded on that date, the date of the notification concerning the final decision of the Office on the grant of protection, sent to the International Bureau.

DECLARATION THAT AN INTERNATIONAL REGISTRATION OF A MARK IS INVALID AND REVOCATION OF AN INTERNATIONAL REGISTRATION OF A MARK

Article 67

- (1) In the procedures concerning the request for a declaration that an international registration of a mark is invalid and the request for revocation of an international registration of a mark, the Office shall notify the holder of the international registration of a mark of the request and invite him to appoint a representative who, within 60 days from the date of receipt of the invitation, has to file with the Office a power of attorney.

X. COMMON PROVISIONS RELATING TO THE PROCEDURE BEFORE THE OFFICE

OTHER REGULATIONS APPLIED IN THE PROCEDURE BEFORE THE OFFICE

Article 68

The Act on the General Administrative Procedure shall apply to particular matters relating to the procedure, not regulated by this Act.

FEES AND PROCEDURAL CHARGES

Article 69

- (1) The procedures prescribed by this Act shall be subject to the payment of fees and procedural charges in compliance with the special provisions.
- (2) If the fees or procedural charges referred to in paragraph (1) of this Article have not been paid, an application or a request shall be rejected, and in the case of non-payment of the appropriate fee or procedural charges for the renewal of a trademark, the trademark shall lapse.

CERTIFICATE OF PRIORITY RIGHT

Article 70

On request of the applicant for the registration of a trademark or the holder of a trademark, and after the prescribed fee and procedural charges have been paid, the Office shall issue a certificate of priority right.

TRADEMARK REGISTER

Article 71

- (1) The Office shall keep the trademark register, which contains the data, the entry of which

is prescribed by this Act and the Regulations.

- (2) Any person shall be entitled to inspect the trademark register.
- (3) On request of any interested person, and after the prescribed fee and procedural charges have been paid, the Office shall issue the extract and the printout from the trademark register.

OFFICIAL GAZETTE

Article 72

The Office shall publish the official gazette containing all the data the publication of which is prescribed by this Act and the Regulations.

SEARCH

Article 73

On the request of any interested person, the Office shall carry out identity and similarity searches of applied for and registered trademarks having effect in the Republic of Croatia.

REPRESENTATION BEFORE THE OFFICE

Article 74

- (1) Natural or legal persons not having a domicile nor a real and effective industrial or commercial principle place of business in the Republic of Croatia may exercise rights arising from this Act in the procedures before the Office only through authorized representatives.
- (2) General principles of representation, and special conditions under which the persons specified in paragraph (1) of this Article may exercise rights arising from this Act shall be regulated by special regulations.

XI. CIVIL PROTECTION

ACTION CONCERNING THE INFRINGEMENT OF RIGHTS

Article 75

- (1) The holder of a trademark, if his rights referred to in Article 7 of this Act have been infringed or threatened to be infringed, may, by instituting an action, require from the competent court:
 1. establishment of the existence of the infringement of a trademark,
 2. prohibition of the committed or intended infringement of a trademark,

3. elimination of a condition caused by the committed infringement of a trademark,
4. ordering to the defendant to inform of the identity of third persons involved in the production and distribution of the infringing goods or services and of their channels of distribution.
5. compensation for damage,
6. publication of the court decision at the expense of the defendant.

- (2) The imitation of a trademark, as well as the use of a collective mark and a guarantee mark contrary to the contract on the collective mark or guarantee mark, shall also be considered to be the infringement of a trademark within the meaning of paragraph (1) of this Article.
- (3) The proceedings concerning the action within the meaning of paragraph (1) of this Article shall be urgent.

REQUEST FOR THE DESTRUCTION

Article 76

- (1) On the request of the plaintiff, the court may order the destruction of the objects unlawfully designated by a trademark, which are in the possession of a defendant.
- (2) The court shall decide whether the objects unlawfully designated by a trademark are to be destroyed, made unrecognizable or used in any other way.

LIMITATION OF ACTIONS

Article 77

The action concerning the infringement of a trademark may be brought within three years from learning about the infringement and the infringer, and not later than within five years as from the commitment of the infringement.

PROVISIONAL MEASURES

Article 78

- (1) If the holder of a trademark makes it likely that his right has been infringed or that there is a likelihood of infringement which might cause the irreparable harm, he may require from the court:
 1. ordering of the provisional measure comprising the prohibition of acts infringing the right of the holder of a trademark,

2. provisional seizure of the articles unlawfully designated by a trademark or the exclusion thereof from the circulation;
 3. measures comprising the assurance of evidence concerning articles unlawfully designated by a trademark and measures comprising the preservation of the existing situation.
- (2) The holder of a trademark may require the ordering of provisional measures even before the action is brought, provided that he brings the action within a period of 20 working days or 31 calendar days, whichever expires later.
 - (3) If the holder of a trademark does not bring an action within the time limit laid down in paragraph (2) of this Article, the court may, on the request of the defendant, conclude the procedure and lift the required measures.
 - (4) The judicial authorities may adopt provisional measures without hearing the other party where appropriate, in particular, if any delay is likely to cause irreparable harm to the holder of a trademark, or if there is a demonstrable risk of evidence being destroyed.

COMPENSATION FOR DAMAGE

Article 79

- (1) The court may impose on the holder of a trademark the compensation for damage if it is proved that the required measures referred to in Article 78 (1) of this Act have been unjustified.
- (2) The court may impose on the holder of a trademark the deposit of an adequate amount as a security for the person the provisional measure has been ordered against.

XII. PROVISIONS CONCERNING MISDEMEANOURS

Article 80

- (1) Any legal person who uses somebody else's trademark, reproduces it or imitates, affixes it to the goods or the packaging thereof, offers the goods under somebody else's trademark, puts them on the market or stocks them for these purposes under somebody else's trademark, imports or exports the goods under somebody else's

trademark, uses somebody else's trademark when providing services or on business papers and in advertising, without the authorization, shall be punished for the misdemeanor by a fine amounting from HRK 20,000.00 up to 100,000.00 (Article 7).

- (2) The natural person shall be punished for a misdemeanor referred to in paragraph (1) of this Article by a fine amounting from HRK 2.000,00 up to 8.000,00.
- (3) The responsible person in the legal person shall be punished for a misdemeanor referred to in paragraph (1) of this Article, by a fine amounting from HRK 5,000.00 up to 10,000.00.
- (4) Articles intended or used for the committed misdemeanors referred to in paragraphs (1), (2) and (3) of this Article shall be seized, and the court shall decide whether the objects unlawfully designated by a trademark are to be destroyed, made unrecognizable or used in any other way.

XIII. TRANSITIONAL AND FINAL PROVISIONS

PENDING PROCEDURES CONCERNING APPLICATIONS FOR REGISTRATION OF A TRADEMARK

Article 81

Procedures concerning trademark applications, as filed before the day the application of this Act starts, which are pending on the day the application of this Act starts, shall be carried out in compliance with the provisions of this Act.

OTHER PENDING PROCEDURES

Article 82

- (1) The procedures concerning the infringement of a trademark or the rights conferred by an application for the registration of a trademark which are pending on the day the application of this Act starts, shall be carried out in compliance with the provisions which were in force up to the day the application of this Act starts.
- (2) The procedures concerning the declaration of the decision on the grant of a trademark null and void and the procedures concerning requests for ceasing of the effect of a trademark due to non-use which are pending on the day the application of this Act starts, shall be carried out in compliance

with the provisions which were in force up to the day the application of this Act starts.

IMPLEMENTING REGULATION

Article 83

The matters referred to in: Article 15 paragraph (3); Article 21 paragraph (1); Article 25 paragraph (2); Article 27 paragraph (4); Article 33 paragraph (3); Article 34 paragraph (2); Article 35 paragraph (2); Article 37 paragraph (3); Article 38 paragraph (4); Article 39 paragraph (8); Article 40 paragraph (4); Article 44 paragraph (8); Article 46 paragraph (4); Article 49 paragraph (8); Article 61 paragraph (1); Article 71 paragraph (1) and Article 72 of this Act shall be regulated by the Minister competent for the work of the Office in the Regulations, to be enacted by him upon a proposal of the Director General of the Office up to the day the application of this Act starts.

ABILITY CEASING OF THE VALIDITY OF OTHER PROVISIONS

Article 84

On the day application of this Act starts, the provisions of the Law on Trademarks (Official Gazette No 78/99, 127/99) shall cease to be valid, except for the provisions concerning the representation (Article 59), which shall be applied up to the enactment of a special regulation.

ENTRY INTO FORCE

Article 85

This Act shall enter into force on the eighth day from the date of its publication in the Official Gazette of the Republic of Croatia, and shall be applied as from January 1, 2004.

THE ACT ON AMENDMENTS TO THE TRADEMARKS ACT

Article 1

In the Trademarks Act (Official Gazette 173/2003), Article 11 is amended to read:

“(1) The placing on the market in the territory of the Republic of Croatia, or, after the accession of the Republic of Croatia into the full membership of the European Union, in the territory of any of the States of the European Union, or States Parties to the Agreement Creating the European Economic Area, of a product designated by a trademark, by the holder of the trademark, or with his express authorization, shall exhaust for the territory of the Republic of Croatia, the exclusive rights conferred by the trademark in respect to such a product, unless there are justified reasons for the holder of the trademark to retain the exclusive rights conferred by the trademark.”

(2) The justified reasons for the holder of the trademark to oppose further commercialization of the product shall exist, especially where the condition of the product is changed or impaired after it has been put on the market.”

Article 2

Article 20 is amended to read:

“(1) The Office shall carry out the administrative procedures for the registration of a trademark, procedures for the declaration that a trademark is invalid, and shall perform other administrative and professional tasks concerning the protection of trademarks.

(2) The administrative decisions issued by the Office in the first instance may be appealed and the appeals shall be decided on by the Board of Appeal in accordance with the provisions of this Act. The filing of an appeal shall be subject to payment of the administrative fee and procedural charges in accordance with special regulations. If the administrative fee and procedural charges have not been paid up to the expiration of the appeal period, the appeal shall be considered as not filed.

(3) The provisions of the Act on General Administrative Proceedings shall apply to particular matters concerning the procedure referred to in paragraphs (1) and (2) of this Article, not regulated by this Act.

(4) The administrative decisions issued in by the Board of Appeal in the second instance may be subject to administrative disputes, in accordance with the Act on Administrative Disputes.”

Article 3

In Article 39, paragraphs (4) and (5) are deleted.

The former paragraphs (6), (7) and (8) become paragraphs (4), (5) and (6).

Article 4

In Article 40, paragraph (2) is amended to read:

“(2) A right in rem shall be entered in the register upon the request of a lien creditor or a lien debtor. The court levying an execution ex officio shall inform the Office without delay of the execution levied upon a trademark for the purpose of the entry of the levy of execution in the register.”

Article 5

In Article 49, paragraph (1) is deleted.

The former paragraphs (2), (3), (4), (5), (6), (7) and (8) become paragraphs (1), (2), (3), (4), (5), (6) and (7).

Article 6

After Article 67 a new “Part Ten”: “COMMUNITY TRADEMARK”, as well as headings and Articles 67a to 67i are added to read:

“DEFINITIONS”

Article 67a

For the purpose of this Act, the following terms mean:

(a) „Regulation on the Community trade mark“ is the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark and its amendments;

(b) a „Community trade mark“ is a trademark as defined in Article 1, paragraph (1) of the Regulation on the Community trade mark;

(c) an „application for a Community trade mark“ is an application for registration of a Community trade mark filed in accordance with the provisions of the Regulation on the Community trade mark;

(d) a “national trademark” is a trademark acquired in the procedure before the Office in accordance with the provisions of this Act;

(e) a „national application for a trademark“ is an application for a trademark filed with the Office in accordance with the provisions of this Act.

EXTENSION OF EFFECTS OF A COMMUNITY TRADE MARK

Article 67b

The effects of applications for a Community trade mark filed and Community trade marks acquired before the day of the acceptance of the Republic of Croatia into the full membership of the European Union shall extend to the territory of the Republic of Croatia.

A COMMUNITY TRADE MARK AS AN EARLIER TRADEMARK

Article 67c

(1) Within the meaning of Article 6 of this Act, a Community trade mark shall be an earlier trade mark in relation to national trademark applications which are filed, as well as national trademarks which are acquired on such applications after the day of the acceptance of the Republic of Croatia into the full membership of the European Union.

(2) Within the meaning of Article 6, paragraph (2) item 4 of this Act, an earlier Community trade mark having reputation in the European Union shall be taken into consideration in accordance with the provisions of Article 9, paragraph (1), item (c) of the Regulation on the Community trade mark .

(3) A national trademark may not be declared to be invalid for the reason of being in conflict with an earlier Community trade mark, if such earlier Community trade mark fails to fulfill the conditions of use provided for in Article 15 of the Regulation on the Community trade mark.

FORWARDING OF AN APPLICATION FOR A COMMUNITY TRADE MARK

Article 67d

If an application for a Community trade mark has been filed with the Office pursuant to Article 25 of the Regulation on the Community trade mark, a fee and charges for forwarding shall be paid in accordance with special regulations.

CONVERSION OF THE APPLICATION FOR A COMMUNITY TRADE MARK INTO A NATIONAL APPLICATION FOR A TRADEMARK

Article 67e

(1) The Office shall examine a request for conversion of a Community trade mark application into a national trademark application filed with it in accordance with the provision of Article 109, paragraph (3) of the Regulation on the Community trade mark.

(2) If the request referred to in paragraph (1) of this Article is not drafted in accordance with the provisions of Article 108, paragraph (2) of the Regulation on the Community trade mark, the Office shall invite the applicant to remedy the deficiencies.

(3) If the applicant fails to file observations or remedy the deficiencies in the specified time limit, or if the request referred to in paragraph (1) of this Article fails to comply with the provisions of Article 108, paragraph (2) of the Regulation on the Community trade mark, the Office shall refuse the request referred to in paragraph (1) of this Article. The decision on refusal shall be considered as a decision on the merits of the request.

(4) If the request referred to in paragraph (1) of this Article is in due form, the Office shall carry out a procedure for the trademark registration in accordance with the provisions of this Act.

(5) The fees and procedural charges for the registration referred to in paragraph (4) of this Article shall be paid in accordance with the provisions of this Act.

(6) The Office shall notify the person filing the request referred to in paragraph (1) of this Article of the receipt thereof, and shall invite her/him to file a translation of the application into the Croatian language within a period, which shall not be less than 30 and not more than 60 days.

(7) The date of filing, the date of priority and the seniority shall be determined pursuant to Article 108, paragraph (3) of the Regulation on the Community trade mark.

SENIORITY

Article 67f

The seniority of a national trademark, within the meaning of Articles 34 and 35 of the Regulation on the Community trade mark, may be claimed for a Community trade mark:

- if a national trademark has been acquired before the day of the accession of the Republic of Croatia into the full membership of the European Union; and

- if a national trademark has priority in relation to the Community trademark for which the seniority is claimed.

PROHIBITION OF USE OF A COMMUNITY TRADE MARK

Article 67g

(1) If the use of a Community trade mark referred to in Article 67b of this Act conflicts with the use of a national trademark acquired before the day of the acceptance of the Republic of Croatia into the full membership of the European Union, or acquired on a national application, filed before the day of the acceptance of the Republic of Croatia into the full membership of the European Union, the holder of such national trademark may institute a legal action, claiming prohibition of the use in the Republic of Croatia of the Community trade mark, the effect of which is, in accordance with Article 67b of this Act, extended to the territory of the Republic of Croatia. The plaintiff shall prove that the Community trade mark conflicts with his/her national trademark.

(2) If a Community trade mark referred to in Article 67b of this Act could have been refused registration on any of the absolute grounds referred to in Article 5 of this Act, or could have been declared to be invalid on the grounds referred to in Article 49, paragraph (2) of this Act before the day of the acceptance of the Republic of Croatia into the full membership of the European Union, the person having legal interest in it may institute a legal action claiming prohibition of the use of such Community trade mark in the Republic of Croatia. The plaintiff shall

prove existence of any of these grounds in relation to the Community trade mark.

PROTECTION OF A COMMUNITY TRADE MARK
AGAINST INFRINGEMENT

Article 67h

The provisions on the protection a national trademark in the case of infringement shall apply mutatis mutandis to the protection of a Community trade mark in the case of infringement.

THE COURT COMPETENT FOR A COMMUNITY
TRADE MARK

Article 67i

(1) In the Republic of Croatia, the Commercial Court in Zagreb shall be the Community Trade Mark Court competent for the first instance decisions, within the meaning of the Regulation on the Community trade mark.

(2) In the Republic of Croatia, the High Commercial Court shall be the Community Trade Mark Court competent for the second instance decisions, within the meaning of the Regulation on the Community trade mark."

The former "Part Ten" becomes "Part Eleven".

Article 7

After Article 74, a new „Part Twelve“: „APPEAL“ as well as headings and Articles 74a to 74d are inserted to read:

“RIGHT OF APPEAL”

Article 74a

(1) Any party entirely or partially adversely affected by the decisions of the Office issued in the first instance shall have the right to file an appeal within 30 days from the day of the communication of the decision.

(2) Other parties to the procedure terminated by a decision appealed shall have the right to be parties to the appeal procedure.

CONTENT OF AN APPEAL

Article 74b

In addition to the indications, which shall be contained in any communication, an appeal shall contain:

1. an indication of the decision appealed;
2. a statement defining whether the decision is contested in its entirety or in part;
3. the grounds for appeal;
4. a statement of reasons for appeal, and all the evidence supporting the appellant's allegations contained in the appeal;
5. the signature of the appellant
6. a power of attorney, if the appeal is filed through a representative.

DECISIONS ON AN APPEAL

Article 74c

(1) The Board of Appeal shall take decisions in sessions, by a majority vote.

(2) The Board of Appeal shall decide on the basis of communications filed by the parties, and if it considers it necessary, or upon the request of any party to the procedure, it may order oral proceedings. The parties shall be summoned to oral proceedings at least 45 days before it takes place.

BOARDS OF APPEAL

Article 74d

(1) The Boards of Appeal for industrial property rights shall decide on the appeals referred to in Article 74a of this Act.

(2) The provisions of the Patent Act shall apply to the composition and organization of the Boards of Appeal referred to in paragraph (1) of this Article."

Article 8

The former "Part Eleven" becomes "Part Thirteen" A heading above Article 75 is amended to read: "PERSONS ENTITLED TO CLAIM THE PROTECTION OF RIGHTS"

Article 75 is amended to read:

"The protection of the rights under this Act may be claimed by a right holder, or a person authorized by her/him pursuant to the general provisions on representation, and, apart from her/him by the holder of the exclusive license, to the extent that he has acquired the right of exploitation of a trademark on the basis of a legal transaction or law."

Article 9

A heading above Article 76 is amended to read: "CLAIM FOR THE ESTABLISHMENT AND TERMINATION OF INFRINGEMENT"

Article 76 is amended to read:

(1) The holder of a trademark may institute a legal action against any person who has infringed a trademark by performing without authorization any of the acts referred to in Article 7, paragraphs (2) and (3) of this Act, claiming establishment of the infringement.

(2) The holder of a trademark may institute a legal action against any person who has infringed a trademark by performing without authorization any of the acts referred to in Article 7, paragraphs (2) and (3) of this Act, claiming termination of the infringement and prohibition of such and similar future infringements.

(3) The holder of a trademark may institute a legal action against any person who has by performing any of the acts without authorization caused a serious threat that his trademark might be

infringed, claiming desistance from the act concerned and prohibition of the infringement of the trademark.

(4) The claims referred to in paragraphs (1), (2) and (3) of this Article may also be made against a person who in the course of her/his economic activities renders services used in the acts infringing a trademark or threatening to infringe it."

Article 10

A heading above Article 77 is amended to read: "CLAIM FOR SEIZURE AND DESTRUCTION OF OBJECTS"

Article 77 is amended to read:

"(1) The holder of a trademark may institute a legal action against any person who has infringed a trademark by performing without authorization any of the acts referred to in Article 7, paragraphs (2) and (3) of this Act, claiming that the products infringing the trademark be removed from the market, seized or destroyed at the expense of that person.

(2) The court shall order the measures referred to in paragraph (1) of this Article against the defendant, unless there are special reasons for not deciding so.

(3) When ordering the measure referred to in paragraph (1) of this Article, the court shall take due care that they are proportionate to the nature and seriousness of the infringement."

Article 11

A heading above Article 78 is amended to read: "CLAIM FOR DAMAGES, USUAL COMPENSATION AND UNFAIR PROFITS"

Article 78 is amended to read:

"(1) The holder of a trademark may take a legal action against any person who has caused him damage by performing without authorization any of the acts referred to in Article 7, paragraphs (2) and (3) of this Act, claiming damages pursuant to the general rules on the legal redress laid down in the Obligations Act.

(2) The holder of a trademark may institute a legal action against any person who has performed without authorization any of the acts referred to in Article 7, paragraphs (2) and (3) of this Act, claiming payment of remuneration in the amount that he would have claimed, given the circumstances, in the license agreement, if concluded.

(3) The holder of a trademark may take a legal action against any person who has infringed a trademark by performing without authorization any of the acts referred to in Article 7, paragraphs (2) and (3) of this Act, without having basis for it in

any legal transaction, court decision or the law, and has benefited from it, claiming the recovery or compensation of such benefits pursuant to the general rules on unjust enrichment laid down in the Obligations Act.

(4) The claims referred to in paragraphs (1), (2) and (3) shall not be mutually excluding. When deciding on the claims referred to in paragraphs (1), (2) or (3), filed cumulatively, the court shall observe the general principles laid down in the Obligations Act."

Article 12

A heading above Article 79 is amended to read: "CLAIM FOR PUBLICATION OF THE JUDGEMENT"

Article 79 is amended to read:

"The holder of a trademark may claim that the final judgment even partially upholding the claim for protection of the trademark in the case of infringement is published in the means of public communication at the expense of the defendant. The court shall decide, within the limits of the claim, on the means of public communication in which the judgment shall be published, and whether it shall be published entirely or partially. If the court decides that only a part of the judgment shall be published, it shall order, within the limits of the claim, that at least the dispositive part of it and, if necessary, the part of the judgment specifying the infringement concerned and the person, having committed it, is published."

Article 13

After Article 79, headings and Articles 79a to 79e are inserted to read:

"CLAIM FOR PROVISION OF INFORMATION

Article 79a

(1) The holder of a trademark who has instituted civil proceedings for the protection of the trademark in the case of infringement may claim the provision of information on the origin and distribution channels of the goods infringing his trademark.

(2) The claim referred to in Article 1 may be made in the form of a legal action or a provisional measure against:

- a person who has been sued in the civil proceedings referred to in paragraph (1) of this Article;
- a person who is within her/his economic activities in possession of the goods suspected of infringing a trademark;
- a person who provides, within her/his economic activities, services suspected of infringing a trademark;

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- persons who provide, within their economic activities, services used in the activities suspected of infringing a trademark;

- a person who is indicated by any of the mentioned persons as being involved in the manufacture or distribution of the goods or the provision of the services suspected of infringing a trademark;

(3) The claim referred to in Article 1 may also be included in a gradual legal action as the first claim, provided that a person acting as a counter party to the defendant is also included in the main claim.

(4) The claim for information on the origin of the goods and distribution channels of the goods and services referred to in paragraph (1) of this Article may include in particular:

- information on the names and addresses of the producers, distributors, suppliers and other previous holders of the goods and providers of the services, respectively, as well as the intended wholesalers and retailers;

- information on the quantities produced, delivered, received or ordered, as well as the price obtained for the goods or services concerned.

(5) The person required to provide the information referred to in this Article may refuse to provide such information on the same grounds as those allowing the refusal to present evidence as a witness pursuant to the provisions of the Act on Civil Proceedings. If the person concerned refuses to provide information without justified reasons, she/he shall be responsible for the damage incurred, pursuant to the provisions of the Obligations Act.

(6) The provisions of this Article shall be without prejudice to the provisions on the manner of use of confidential information in civil and criminal proceedings, the provisions regulating the responsibility for misuse of the right to acquire information, and the provisions regulating the processing and protection of personal data.

(7) The provisions of this Article shall be without prejudice to the provisions of Articles 79c and 79d of this Act regulating the taking of evidence.

PROVISIONAL MEASURES DUE TO INFRINGEMENT OF A TRADEMARK

Article 79b

(1) Upon the request of the holder of a trademark who makes it likely that her/his trademark has been infringed or threatened to be infringed, the court may order any provisional measure comprising the termination or prevention of the infringement, and in particular:

- order the opposing party to cease or desist from, the acts infringing a trademark; the court may also issue such order against an intermediary whose services are being used by a third party to infringe a trademark;

- order the seizure or removal from the market of the goods unlawfully designated by a trademark.

(2) Upon the request of the holder of a trademark who makes it likely that his trademark has been infringed on a commercial scale for the purpose of acquiring commercial or economic benefit, and that such infringement has threatened to cause him irreparable damage, the court may, in addition to the provisional measures referred to in paragraph (1) of this Article, order the seizure of the movable and immovable property of the opposing party, not directly related to the infringement, including the blocking of his bank accounts and other assets.

(3) For the purpose of ordering and enforcing the provisional measure referred to in paragraph (2) of this Article, the court may require from the opposing party or other relevant persons disposing with it, the communication of the banking, financial and other economic information, or the access to other relevant information and documents. The court shall ensure the protection of confidentiality of such information, and prohibit any misuse thereof.

(4) The provisional measure referred to in paragraph (1) of this Article may be ordered without informing the opposing party thereof, if the applicant for measures makes it likely that otherwise the provisional measure would not be effective, or that irreparable damage is threatened to occur. The provisional measure referred to in paragraph (2) of this Article may be ordered without informing the opposing party thereof, if the applicant for measures makes it likely that otherwise the provisional measure would not be effective, or that, taking into consideration a very serious circumstances of the infringement, this would be necessary. If a provisional measure is ordered without informing the opposing party thereof, the court shall communicate a decision on the provisional measure to the opposing party, promptly upon its enforcement.

(5) In the decision ordering a provisional measure the court shall specify the duration of such measure, and, if the measure has been ordered before the institution of a legal action, the period, within which the applicant for measures shall institute a legal action to justify the measure, which shall not be less than 20 working days and not more than 31 calendar days, from the day of communication of the decision to the applicant for measures, whichever expires later.

(6) The provisions of the Execution Act shall apply to matters, not regulated by this Article.

(7) The provisions of this Article shall be without prejudice to the possibility to order provisional measures pursuant to other provisions of this Act, and the provisions of the Execution Act.

PROVISIONAL MEASURES COMPRISING THE
PRESERVATION OF EVIDENCE

Article 79c

(1) Upon the request of the holder of a trademark who makes it likely that his trademark has been infringed or threatened to be infringed, the court may order a provisional measure comprising the preservation of evidence.

(2) By the provisional measure referred to in paragraph (1) of this Article, the court may order in particular:

- preparation of a detailed description of the goods made likely to infringe a trademark, with or without taking of samples;
- seizure of the goods made likely to infringe a trademark;
- seizure of the materials and implements used in the production and distribution of the goods made likely to infringe a trademark and the documentation relating thereto.

(3) The provisional measure referred to in this Article may be ordered even without informing the opposing party thereof, if the applicant for measures makes it likely that there is a risk of evidence being destroyed or irreparable damage of incurring. If a provisional measure is ordered without informing the opposing party thereof, the court shall communicate a decision on the provisional measure to the opposing party, promptly upon its enforcement.

(4) In the decision ordering a provisional measure the court shall specify the duration of the measure, and, if the measure has been ordered before the institution of a legal action, the period, within which the applicant for measures shall institute a legal action to justify the measure, which shall not be less than 20 working days and not more than 31 calendar days, from the day of communication of the decision to the applicant for measures, whichever expires later.

(5) The provisions of the Execution Act shall apply to matters, not regulated by this Article.

(6) The provisions of this Article shall be without prejudice to the possibility of the court to order provisional measures comprising the preservation of evidence pursuant to the provisions of the Act on Civil Proceedings.

TAKING OF EVIDENCE IN THE COURSE OF THE
CIVIL PROCEEDINGS

Article 79d

(1) Where a party to the civil proceedings invokes evidence claiming that it lies with the opposing party or under its control, the court shall invite the opposing party to present such evidence within a specified time limit.

(2) Where the holder of a trademark as a plaintiff in a legal action claims that the infringement of a trademark has been committed on a commercial

scale for the purpose of acquiring commercial or economic benefit, and has made it likely during the proceedings, and where he invokes in the proceedings banking, financial or similar economic documents, papers or the like evidence, claiming that they lie with the opposing party or under its control, the court shall invite the opposing party to present such evidence within a specified time limit.

(3) Where the party, which is invited to present evidence, denies that the evidence lies with it or under its control, the court may take evidence to establish such a fact.

(4) The provisions of the Act on Civil Proceedings relating to the right of refusal to present evidence as a witness shall apply mutatis mutandis to the right of the party to refuse to present evidence.

(5) The court shall, taking into consideration all the circumstances of the case, decide at its own discretion, on the importance of the fact that the party having the evidence refuses to comply with the court's decision ordering it to present evidence, or denies, contrary to the court's opinion, that the evidence lies with it.

(6) Against the decision of the court referred to in paragraphs (1) and (2) a separate appeal shall not be allowed.

EXPEDITIOUS PROCEEDINGS AND APPLICATION
OF THE PROVISIONS OF OTHER ACTS

Article 79e

(1) A procedure concerning the infringement of the rights under this Act shall be expeditious.

(2) The provisions of the Act on Civil Proceedings, and the Execution Act, respectively, shall apply to the procedures concerning the infringement of a trademark.

(3) Upon the request of the court or any of the parties to the procedure concerning the infringement of a trademark, the Office or the Board of Appeal, respectively, shall promptly accept a request for the declaration of the decision on the registration of a trademark invalid, filed before or during the civil action and shall subject it to the expeditious proceedings. The court shall, taking into consideration the circumstances of the case, decide whether it shall decide on the stay of proceedings up to the final decision on the request for the declaration of the decision on the registration of a trademark invalid, or not."

Article 14

The former "Part Twelve" becomes "Part Fourteen".

In Article 80, paragraph (1) is amended to read:
"Any legal person who uses a sign which is identical with or similar to somebody else's trademark, reproduces it or imitates, affixes it to the goods or the packaging thereof, offers the goods designated by such a sign, puts them on the

market or stocks them for such purposes, imports or exports the goods designated by such a sign, uses such a sign when providing services or on business papers and in advertising, without authorization, shall be punished for the misdemeanor by a fine amounting from HRK 20 000.00 up to 100 000.00 (Article 7 paragraph (2) items 1 and 2)."

In paragraph (2) number "8,000.00" is replaced by number "10 000.00".

After paragraph (3), paragraph (4) is added to read:

"(4) A natural person – a craftsman or other self-employed person, respectively, shall be punished for the misdemeanor, referred to in paragraph (1) of this Article, by a fine amounting from HRK 5 000.00 to 50 000.00, where the misdemeanor has been committed in the performance of her/his activities as a craftsman or other self-employed person, respectively."

In the former paragraph (4), which becomes paragraph (5), numbers "1, 2 and 3" are replaced by numbers "1, 2, 3 and 4".

TRANSITIONAL AND FINAL PROVISIONS

Article 15

(1) The administrative disputes instituted before the Administrative Court before 1 June 2008 shall be completed before the Administrative Court in accordance with the provisions, which were in force up to that date.

(2) A party, which instituted a legal action before the Administrative Court before 1 June 2008, in accordance with the provisions which were in force up to that date, may require from the Administrative Court to stay the proceedings, provided that it has filed within 30 days from that date an appeal based on the same grounds and with the same statement of reasons as are those contained in the legal action, where an appeal against such administrative decision is admissible pursuant to the provisions of this Act. The administrative decision issued on such appeal in the second instance, may be subject to an administrative dispute pursuant to the provisions of the Act on Administrative Disputes."

Article 16

The procedures concerning the protection of a trademark in the case of infringement, pending on the date of the entry into force of this Act, shall be completed in accordance with the provisions, which were in force before the entry into force of this Act.

Article 17

The Ordinance referred to in Article 83 of the Trademarks Act (Official Gazette 173/2003) shall be aligned with the provisions of this Act, on a proposal given by the Director General of the Office, by the Minister responsible for the work of the Office, not later than within 3 months from the entry into force of this Act.

Article 18

This Act shall enter into force on the eight day following the day of its publication in the Official Gazette, with the exception of Articles 2 and 7 thereof, which shall enter into force on 1 June 2008, and Article 6, which shall enter into on the day of the acceptance of the Republic of Croatia into the European Union.