



**Act No. 577/2001 Coll. Amending  
the Act No. 55/1997 Coll. on Trademarks**

Part I General Provisions	2
Trademark	2
Identity and Similarity of Signs or Trademarks and Identity of Goods or Services	3
Part II Procedure on Matters Concerning a Trademark	5
Trademark Application	5
Priority Right	5
Modification of the Application, Assignment and Transfer of the Application	6
Examination and Publication of the Application	6
Oppositions against the Entry in the Register	7
Registration of a Trademark	8
Term of Protection	8
Modification of a Trademark and of List of Goods and Services	8
Termination of a Trademark	9
Invalidation and Revocation of a Trademark	9
Specific Provision Concerning Collective Trademarks	12
Part III Rights and Obligations in Trademarks	13
Rights of Trademark Owners	13
Limitations of Trademark Rights	14
Obligations in Trademarks	15
Assignment and Transfer of Trademarks	15
License	16
Lien on a Trademark	16
Forfeiture of Trademark and Rectification of Trademark Owner	16
Specific Rights and Obligations in Collective Trademarks	16
Part IV Relations with Foreign Countries, International Registration of Trademarks	17
Relations with Foreign Countries	17
International Registration of Trademarks	17
Part V Common, Transitional and Final Provisions	18
Common Provisions	18
Further Processing	19
Restitutio in Integrum	19
Grounds for the Decision	20
Remedies	21
Provision of Authorisation	21
Transitional Provisions	22
Repealed Provisions	23
Effectiveness	23

National Council of the Slovak Republic has adopted the following Act:

## **Part I** **General Provisions**

### *Trademark*

**1.—(1)** A trademark is any sign capable of being represented graphically, consisting particularly of words, including personal names, letters, numerals, drawings, shape of goods or of their packaging, or their mutual combinations capable of distinguishing goods or services of various entrepreneurs, registered in the Register of Trademarks (hereinafter referred to as “the Register”).

(2) A collective trademark is a sign referred to in Paragraph 1 thereof, if it is capable of distinguishing products or services, originated by members of a legal entity established for the purpose of protection of their interests or for other purposes (hereinafter referred to as “Association of entrepreneurs,<sup>1</sup>” from goods or services provided by other entrepreneurs and which is registered in the Register.

**2.—(1)** The following shall not be recognised as a trademark:

- a)* sign which does not conform to the requirements of Article 1,
- b)* sign which has no distinctive capacity,
- c)* sign consisting exclusively of indications or elements that serve in the trade to designate the kind, quality, quantity, purpose, value, geographical origin or other characteristics of goods or services, or, if appropriate, time of production of goods or of rendering of services,
- d)* sign consisting exclusively of signs or indications which have become customary in current language or have been using in established practices of trade,
- e)* sign consisting exclusively of the shapes of goods or of their packaging which results from the nature of goods themselves or is necessary to obtain a technical result, or gives substantial value to the goods,
- f)* sign which is of such a nature as to deceive the public, particularly with regard to the nature, quality or geographical origin of the goods or services,
- g)* sign which is contrary to public order or principles of morality,
- h)* sign whose use would be contrary to the obligations of the Slovak Republic under international treaties,
- i)* sign containing a sign of a high symbolic value, particularly a religious symbol.
- j)* sign applied for wines or spirits containing a geographical indication identifying wines or spirits with respect to such wines or spirits not having that origin

(2) The signs referred to in paragraph 1 (b) to (d) may be accepted and registered in the Register if a natural person or a legal entity filing an application for registration (hereinafter referred to as “Applicant”) proves that such sign has acquired distinctive character in relation to the goods or services for which registration is requested following the use which has been made of it on the territory of the Slovak Republic or in relation to this territory prior the date of filing of the application for the entry in the Register (hereinafter referred to as “Application”).

3. The following shall not be recognised as the trademark:

a) sign identical with the trademark with the earlier priority right which has been registered for another owner for identical or similar goods or services,

b) sign identical with applied sign of another applicant with the earlier priority right provided that such sign is registered for identical or similar goods or services,

c) sign identical with a trademark registered for identical or similar goods or services that has expired under Article 15 (1)(a) if the application was filed within two years after the expiration date of the trademark; this provision shall not apply if the application was filed by the person who at the time of the expiration of the trademark thereof has been registered as the owner of the trademark or its legal successor,

(2) Provisions of paragraph 1 shall not apply if the owner of the earlier trademark or applicant of the identical sign with the earlier priority right gives his written consent to the registration of later sign.

#### *Identity and Similarity of Signs or Trademarks and Identity of Goods or Services*

**3a.**—(1) Signs or trademarks, which are identical or differ only in inessential elements which do not change the character of the sign or trademark as a whole shall be deemed identical.

(2) Signs or trademarks and goods or services shall be deemed similar if because of this similarity there exists a likelihood of confusion of signs or trademarks or goods or services originating from different entrepreneurs or there exists the likelihood of association with the sign or trademark with the earlier priority right on the part of the public.

4. The sign shall not be recognised as a trademark where the Industrial Property Office of the Slovak Republic (hereinafter referred to as “the Office”), on the grounds of oppositions filed pursuant to Article 9, ascertains that it is:

a) confusingly similar to a trademark with the earlier priority right if the trademark has been registered for identical or similar goods or services,

b) confusingly similar to an applied sign with the earlier priority right provided that such sign is registered for identical or similar goods or services,

c) identical with or confusingly similar to a sign which is registered as a trademark for identical or similar goods or services in the country or in relation to the country which is the



member state of the international convention<sup>1a)</sup> or is a member of the World Trade Organization<sup>1b)</sup> (hereinafter referred to as “Foreign trademark”) provided that the applicant of this sign is an agent or a representative of the owner of the foreign trademark for the territory of the Slovak Republic on the basis of other relation<sup>1c)</sup> (hereinafter referred to as “Representative”) and applies for registration thereof in his own name without the owner’s consent,

d) identical with or confusingly similar to an unregistered sign used by his owner in the course of trade prior to the filing date of the application if the use of an applied sign could be deemed as an act of unfair competition<sup>1d)</sup> in relation to the rights of the owner of unregistered sign,

e) identical with or confusingly similar to the trade name or its essential part, registered in the Register of Companies or a similar register for an entrepreneur who conducted an economic activity with identical or similar goods or services prior to the filing date of the application,

f) identical with or confusingly similar to the forename and surname or an assumed name or a portrait of a person if the entry of this sign in the Register could interfere with the rights to individual’s protection,

g) identical with or confusingly similar to the subject matter of other industrial property right with the earlier priority right,

h) identical with or confusingly similar to an author’s work created prior to filing date of the application where by using such sign the author’s copyright could be affected.

(2) The sign shall not be recognised as a trademark where Office on the grounds of oppositions filed pursuant to Article 9, ascertains that it is:

a) identical with or confusingly similar to a sign which, before filing date of the application, had become well-known, following its use in the Slovak Republic or in relation to the territory of the Slovak Republic according to the international treaty<sup>2</sup>, for goods or services of its owner (hereinafter referred to as “Unregistered well-known mark”), if this sign is applied for identical or similar goods or services,

b) identical with or confusingly similar to a trademark which, before filing date of the application, had become well-known, following its use in the Slovak Republic or in relation to the territory of the Slovak Republic according to the international treaty<sup>1b)</sup>, for goods or services of its owner (hereinafter referred to as “Registered well-known mark”), if the use of such sign for any goods or services would indicate connection between the thus-marked goods or services and the owner of the registered well-known mark, and if the interests of its owner are likely to be damaged by such use.

## Part II Procedure on Matters Concerning a Trademark

### *Trademark Application*

5.—(1) The application may be filed by applicant for goods or services that are, at the filing date, the subject of his economic activity.

(2) An application shall contain:

a) a request for the entry of the sign as a trademark in the Register, name, surname and domicile if the applicant is a natural person, and name or trade name and seat if the applicant is a legal entity,

b) a wording or graphical presentation of the sign; in case of a three-dimensional sign its surface presentation,

c) list of the goods or services in respect of which the registration is requested.

(3) Goods or services included in the list under paragraph 2 (c) shall be classified in accordance with the international treaty.<sup>3</sup>

(4) The application can be filed for one sign only.

### *Priority Right*

6.—(1) For the purpose of starting the proceedings and the rise of priority right the filing date of the application shall be deemed the date of delivery of the submission or the date of elimination of deficiencies of submission, which contains at least:

a) data indicating the express intention of the applicant to file a trademark application,

b) data enabling identification of the applicant and correspondence with the applicant,

c) requirements in accordance with Article 5 (2)(b) and (c) except the classification referred to in Article 5 (3).

(1) The applicant shall enjoy the priority right against any person who subsequently files an application containing identical or confusingly similar sign for identical or similar goods or services

a) on the filing date of the application according to paragraph 1 or

b) on the date of priority right pursuant to international convention<sup>1a)</sup> following from the earlier trademark application.

(3) The applicant must claim the priority right according to paragraph 2(b) in the application and prove this right within the period of three months as from the date of filing of application; otherwise the right of priority shall not be recognised.



(4) The priority right according to paragraph 2(b) shall be applied to one application only, provided that this application is filed in the state which is the member state of the international convention<sup>1(a)</sup> or is a member of the World Trade Organization<sup>1(b)</sup>; otherwise this right may be claimed only if the condition of reciprocity is fulfilled.

(5) The priority right pursuant to paragraph 2(b) applies also to services.

*Modification of the Application, Assignment and Transfer of the Application*

7.—(1) Upon the request of the applicant the Office shall permit modification of the application where it concerns the forename, surname or name, or the trade name, seat, domicile and business address if a change occurred after filing of the application and the modification of the application for registration reconciles data adduced therein with reality without affecting the general nature of the trademark. No other changes in the application after its filing shall be permitted.

(2) After filing of the application the applicant may reduce the list of goods or services for which the trademark is to be registered; such reduction cannot be withdrawn. No extension of the list of goods or services for which the trademark is to be registered after filing of application is permitted.

(3) Prior to the entry of the trademark in the Register the applicant is entitled to divide the application containing more than one kind of goods or services to separate applications. The priority right and the date of filing of application of the original application shall be maintained also for the divisional applications, provided they only include the goods or services listed in the original application.

(4) By written agreement the applicant may assign his right arising from the application for the goods or services which are listed in the application, or for part of them, to another natural person or legal entity if these goods or services constitute the subject of his economic activity as of the date of the agreement.

(5) Rights following from application shall be transferred to another person in cases stated by special Act<sup>4</sup>.

*Examination and Publication of the Application*

8.—(1) The Office shall conduct an examination whether the application complies with the conditions laid down by this Act and its implementing regulation.<sup>4(a)</sup>

(2) If the application does not satisfy the conditions according to Article 5(2) to (4), as well as specified by the implementing regulation, the Office shall invite the applicant to eliminate the deficiencies within a prescribed period of time. If the applicant fails to eliminate those deficiencies within the prescribed period of time, the Office shall suspend the procedure. The applicant must be advised in advance about this by the notice asking to eliminate the deficiencies.



(3) If the applied sign does not satisfy with conditions according to Articles 1 to 3 or the applicant does not satisfy the conditions according to Article 5 (1), the Office shall refuse the application. Before taking this decision the Office shall require from the applicant the statement concerning the reasons on the basis of which the application is to be refused.

(4) If the reasons on the basis of which the application is to be refused according to paragraph 3 concern only the part of goods or services, the Office shall refuse the application only for this part of goods or services.

(5) If the proceedings on application was not suspended according to paragraph 2 or if the application was not refused according to paragraph 3, the Office shall publish the application in the Official Journal of the Industrial Property Office of the Slovak Republic (hereinafter referred to as “Journal”).

#### *Oppositions against the Entry in the Register*

9. After publishing the application in the Journal, a person, affected due to reasons stated in Article 4 (hereinafter referred to as “Opponent”), may file oppositions against the entry of the sign in the Register within the period of three months from this publication at the Office. The oppositions shall contain legal and factual justification as well the documentary evidence or indication of documentary or other evidence, which shall be submitted by the opponent.

10.—(1) The Office shall examine whether the oppositions have been filed duly and in time according to Article 9 and whether the conditions of obligatory representation according to Article 34 (3) is satisfied.

(2) If the oppositions have not been filed duly and in time according to Article 9 or if the opponent does not submit the indicated evidence upon the invitation of the Office within prescribed time period or does not prove the satisfaction of the condition of obligatory representation according to Article 34 (3) upon the invitation of the Office within prescribed time period, the Office shall suspend the opposition proceedings.

(3) The Office shall advise the applicant of the oppositions filed pursuant to Article 9, proceedings on which were not suspended, and invites him to make a statement related to the oppositions within the prescribed time period.

(4) If the applicant fails to make a statement regarding the oppositions within the prescribed time period according to paragraph 3 or fails to satisfy the condition of obligatory representation according to Article 34 (3) upon the invitation of the Office within prescribed time period, the Office shall suspend the application proceedings to the extent of the oppositions filed. The applicant must be, however, warned about this in the invitation to make a statement.

(5) The Office shall deliver a written text of the decision according to paragraph 2 to the opponent and a written text of the decision according to paragraph 4 to both the opponent and the applicant.



11.—(1) The Office shall examine, on the basis of the oppositions with regard to which the applicant made a statement, whether an applied sign satisfies the conditions for registration with respect to Article 4.

(2) If the Office in the proceedings according to the paragraph 1 on the basis of evidence evaluated on the proposal of the parties

a) ascertains that the applied sign does not satisfy requirements for registration with respect to Article 4, it shall refuse the application or

b) does not ascertain the existence of the grounds with respect to Article 4 or ascertains that the opponent is not a person affected according to Article 9, it shall refuse the oppositions.

(3) The Office shall deliver a written text of the decision according to paragraph 2 to both the applicant and the opponent.

#### *Registration of a Trademark*

12.—(1) If the requirements for registration of a sign as a trademark in the Register laid down by this Act, are satisfied, the Office shall enter the trademark in the Register.

(2) By entering the trademark in the Register the applicant acquires the trademark rights and becomes the owner of the trademark and the Office shall issue a certificate of registration to the owner.

(3) The Office shall publish the registration of the trademark in the Journal.

(4) Legal or natural person entered as the owner in the Register shall be deemed the owner of the trademark.

#### *Term of Protection*

13.—(1) The term of protection for a registered trademark is ten years as from filing date of the application with the Office (Article 6 (1)).

(2) At the request of the trademark owner for renewal of a registration submitted at the earliest during the final year of the term of protection and at the latest within six months after its expiry (hereinafter referred to as “Request for registration renewal”) the term of protection of the trademark shall be repeatedly extended for additional ten years.

#### *Modification of a Trademark and of List of Goods and Services*

14.—(1) At the request of the trademark owner the Office shall permit modification of the trademark where it concerns the forename, surname or name, or trade name or seat, domicile, trade establishment if this change occurred after the entry of the trademark in the Register and if this modification reconciles data adduced therein with reality without affecting the general nature of the trademark.



(2) Upon the request of the trademark owner the Office shall reduce the list of goods or services for which the trademark is registered; such reduction cannot be withdrawn. No extension of the list of goods or services for which the trademark is registered is permitted

#### *Termination of a Trademark*

**15.**—(1) A trademark is terminated:

*a)* on the expiry of the term of protection, unless an request for registration renewal was filed in due time,

*b)* on the day of the declaration of renunciation to the right made by the owner of the trademark presented to the Office, this statement has no legal effects if rights of a third party hinder the declaration of renunciation.

*c)* by extinction of legal capacity of the owner, unless the right to the trademark has been assigned or transferred to a new owner,

*d)* on the effectiveness of the revocation of the trademark according to Article 16 paragraphs 3 to 12, Article 17 and Article 23.

(2) A trademark which is the subject to the rights of third party will cease to exist pursuant to paragraph 1 (*b*) on the day when the trademark owner provides proof of termination of these rights or, the approval of the authorised persons with the termination of the trademark.

(3) The Office enters the termination of a trademark in the Register.

#### *Invalidation and Revocation of a Trademark*

**16.**—(1) The Office shall declare the registration of a trademark invalid if it ascertains in the proceedings started at the request of a third party or ex-officio that the trademark was registered contrary to the conditions laid down by this Act for registration of trademarks.

(2) The declaration of trademark registration invalid pursuant to paragraph 1 shall not proceed if the trademark has been registered contrary to Article 2 (1) (*b*) to (*d*) but its owner proves that such trademark has acquired distinctive character in relation to the goods or services for which it was registered following the use which has been made of it on the territory of the Slovak Republic or in relation to this territory prior the start of the invalidation proceedings.

(3) The Office shall revoke the registration of a trademark if in the proceedings started at the request of a third party or ex officio it ascertains that the trademark in consequence of use of it by its owner or with his consent is liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services for which it is registered.

(4) The Office shall revoke the registration of a trademark if in the proceedings started at the request of a third party it ascertains that the trademark has not been used in the Slovak Republic for at least five consecutive years preceding the start of revocation proceedings and

the trademark owner has not given proper reasons for non-use. Trademark is deemed not to be used during five consecutive years on the territory of the Slovak Republic unless proved otherwise. Trademark shall not be revoked if the owner started to use it in good faith after the expiry of five consecutive years; starting to use the trademark in good faith within the time limit of three months preceding the filing of the request for revocation shall not be deemed starting to use the trademark in good faith, unless proved otherwise.

(5) The Office shall revoke the registration of confusingly similar trademark if during the proceedings started at a request of owner of trademark with the earlier priority right it ascertains that the contested trademark has been registered for identical or similar goods or services.

(6) The Office shall revoke the registration of a trademark if in the proceedings started at the request of the owner of a unregistered or registered well-known mark it ascertains that the contested trademark is

*a)* identical or confusingly similar to unregistered well known mark which, before filing date of the application of the contested trademark, had become well-known (Article 4 (2)(a)) for identical or similar goods or services or

*b)* identical or confusingly similar to registered well known mark which, before filing date of the application of the contested trademark, had become well-known (Article 4 paragraph 2(b)) if the use of such trademark for any goods or services would indicate connection between the thus-marked goods or services and the owner of the registered well-known mark, and if the interests of its owner are likely to be damaged by such use.

(7) The Office shall revoke the registration of trademark which is identical with or confusingly similar to the unregistered sign if during the proceedings started at a request of owner of the unregistered sign which used this sign in the course of trade prior to the filing date of the contested trademark ascertains that the use of contested trademark could be deemed as an act of unfair competition<sup>1d)</sup> in relation to the rights of the owner of unregistered sign,

(8) The Office shall revoke the registration of a trademark if in the proceedings started at the request of a third party it ascertains that the trademark, as a result of use or failure to use by its owner, has lost its distinctive character because in the trade relations it has become a general designation for goods or services for which it has been registered.

(9) The Office shall revoke the registration of a identical or confusingly similar trademark if in the proceedings started at the request of an entrepreneur ascertains that the trademark is identical with or confusingly similar to the trade name or its essential part, registered in the Register of Companies or a similar register for such entrepreneur if he conducted an economic activity with identical or similar goods or services prior to the filing date of the application of contested trademark.

(10) The Office shall revoke the registration of a identical or confusingly similar trademark if in the proceedings started at the request of third party ascertains that the



trademark is identical with or confusingly similar to the forename and surname or an assumed name or a portrait of a person use of this sign in the Register could interfere with the rights to individual's protection.

(11) The Office shall revoke the registration of a identical or confusingly similar trademark if in the proceedings started at the request of the owner of another industrial property right ascertains that the contested trademark is identical with or confusingly similar to the subject matter of other industrial property right with the earlier priority right.

(12) The Office shall revoke the registration of a identical or confusingly similar trademark if in the proceedings started at the request of third party ascertains that the trademark is identical with or confusingly similar to an author's work created prior to filing date of the application of contested trademark if by using such sign the author's copyright could be affected.

(13) If the reasons for revocation of the registration of a trademark refer solely to one part of the goods or services for which the trademark has been registered, the Office shall revoke the registration of a trademark only for those goods or services.

(14) File a request for invalidation of registration of a trademark pursuant to paragraphs 1 may also be effected after the termination of the trademark pursuant to Article 15 (1)(a) to (c) if the claimant proves legal interest.

(15) The Office shall not revoke the registration according to paragraphs 5 to 7 if the owner of the right:

*a)* has acquiesced for a period of five consecutive years the use of contested trademark on the territory of the Slovak Republic since the moment he was aware of such use; it shall not apply if the owner of the right proves that the application of contested trademark was applied for in bad faith or

*b)* has not used the trademark registered or unregistered well-known mark or unregistered sign on the territory of the Slovak Republic for five consecutive years and has not given proper reasons for such non-use.

**17.—(1)** The Office shall revoke registration of a trademark on the grounds of the court decision according to which the trademark

*a)* containing the forename and surname or a portrait of a natural person, or his assumed name, violates the rights to individual's protection,

*b)* containing the name or trade name of a natural person or a legal entity, registered in the Register of Companies or a similar register prior to filing of the application, interferes with its reputation,

*c)* interferes with the earlier copyright.

(2) The Office shall revoke the registration of an identical or a confusingly similar trademark on the basis of a court decision according to which the use of such trademark is prohibited as an act of unfair competition<sup>1d)</sup>.



(3) The revocation shall be proceeded at the request of an authorised person within six months from the date when the court decision becomes valid.

**18.** In case of invalidation of registration of a trademark pursuant to Article 16 (1) the registration of this trademark in the Register shall be deemed to have never occurred; otherwise the revocation shall be effective from the date of starting the revocation proceedings.

**19.** Together with the request for starting of the invalidation or revocation proceedings pursuant to Article 16 the claimant is requested to deposit a sum of 2 500 SK. The Office will refund the deposit if in the proceedings it shall be proved that the starting of the invalidation or revocation proceedings has been filed with proper reason.

*Specific Provision Concerning Collective Trademarks*

**20.—(1)** An association of entrepreneurs, as an applicant, can file the application for the registration of a sign as collective trademark.

(2) Together with the application in addition to the formalities referred to in Article 5 (3) and (4), the following must be attached:

*a)* the written contract between all members of the association, in which the conditions of the use of the collective trademark are laid down, including the sanctions for their infringement,

*b)* a list of members of the association of entrepreneurs who are entitled to use the collective trademark and the address of their seats.

(3) The proceedings concerning the collective trademark are governed by the provisions of Articles 5 to 19, as appropriate.

**21.—(1)** The members of an association of entrepreneurs registered in the Register have the exclusive right to mark with the collective trademark their goods or services for which it is registered or to use it in connection with these goods or services.

(2) At the request of the owner of the collective trademark supported with an agreement amending the original association agreement, the Office shall enter the change regarding the list of the members of the association of entrepreneurs in the Register

(3) At the request of the members of an association of entrepreneurs, the Office will issue an extract to each of the members of the association registered in the Register.

(4) At the request the Office shall permit the inspection of the association agreement.

**22.** A collective trademark shall not be assigned to another owner and shall not be licensed or given as lien.

**23.** The Office shall revoke a collective trademark from the Register, except in the cases referred to in Articles 16 and 17 thereof, if the members of the association of entrepreneurs seriously violate the agreement on the use of the collective trademark.

### Part III Rights and Obligations in Trademarks

#### *Rights of Trademark Owners*

24.—(1) A trademark owner has the exclusive right to affix his goods or services with the trademark for which it is registered or use it in connection with those goods or services.

(2) A trademark owner is authorised to use the “®” mark with the trademark.

25.—(1) Without the authorisation of the trademark owner no one may use a sign which is identical with or confusingly similar to his trademark for identical or similar goods or services for which the trademark has been registered. Accordingly, no one may use this sign in connection with these goods or services, in particular, affix it on goods or their packaging, offer or introduce on the market thus marked goods or packaging, or store them for this purpose, import or export goods or their packaging with this sign or use this sign in the trade, correspondence or advertising.

(2) The trademark owner is entitled to require information about the origin of goods or documents accompanying the goods or services from everybody introducing or intending to introduce on the market goods or services which are marked with a sign identical with or confusingly similar to his trademark. The trademark owner shall prove his rights by presenting the registration certificate or an extract from the Register.

(3) The trademark owner is authorised to require from the publisher of a publication where his trademark is reproduced to publish a statement that it is a trademark, including the registration number of the trademark.

26.—(1) The trademark owner may request from any one to refrain from the use of his trademark or sign confusingly similar to his trademark for identical or similar goods or services and may request that thus marked items be withdrawn from market.

(2) The owner of a well-known trademark registered in the Register may enforce his rights under paragraph 1 thereof regardless of identity or similarity of the goods or services, provided that use of that trademark in relation to other goods or services would indicate a connection between thus marked goods or services, and the owner of the registered well-known trademark and provided that the interests of the owner are likely to be damaged by such use.

(3) If the violation of the trademark rights resulted in a damage, the injured party is entitled to have his damage compensated. If such violation should result in non-pecuniary injury the injured party is entitled to claim reasonable satisfaction which may have a form of pecuniary settlement.

(4) Disputes arising from legal situations in respect of trademarks shall be heard and decided by the courts.

**26a.**—(1) On proposal the court is entitled to order that products, materials or instruments through which the infringement or jeopardising of right protected by this Act is directly conducted be

- a) disposed of outside the channels of commerce,
- b) rendered to plaintiff,
- c) otherwise secured by a method preventing further infringement or jeopardising of the right; the simple removal of the sign unlawfully affixed shall not be deemed to be the remedy preventing from the further infringement of right,
- d) destroyed in a suitable manner at the cost of the person infringing the right, unless a more appropriate solution is available.

(2) The proposal of the plaintiff pursuant to paragraph 1(d) in the part related to the manner of destruction of objects shall not be binding for the court.

(3) The court shall not grant the right to submitting the data pursuant to Article 25(2), if the seriousness of jeopardising or infringing the right is disproportionate to the seriousness of consequences following from the fulfilment of obligation imposed in this manner.

**26b.**—(1) When protecting the rights pursuant to this Act, a court by means of preliminary ruling<sup>4b)</sup> is entitled to impose obligations identical in content with decision on the matter as such in case any delay may cause the entitled party damage which can be repaired only with difficulties, or non-pecuniary injury.

(2) Within a preliminary ruling the court is also ex officio entitled to impose on the plaintiff an obligation to deposit a financial security in a reasonable amount, or it is entitled to condition the effectiveness of the decision by fulfilment of the imposed obligation. When making a decision on the amount of the financial security, the court shall take into account the scope of pecuniary or non-pecuniary injury which can occur to the counterpart, as well as to the financial situation of the plaintiff, where the imposition of the obligation to deposit a financial security shall not create a substantial obstacle for effective enforcement of the right.

(3) On proposal the court is entitled to decide upon releasing the financial security to the counterpart, as compensation of pecuniary injury or satisfaction of non-pecuniary injury caused directly by the enforcement of the injunction decision without a reasonable title.

(4) If within a time limit of six months from the finding of the injury pursuant to paragraph 3, the claim to compensation is not exercised before the court or if no agreement of the parties is reached on the use of the financial security, the court shall return the financial security.

#### *Limitations of Trademark Rights*

**27.**—(1) The trademark owner is not entitled to claim his rights under Articles 25 and 26 during the revocation proceedings of this trademark pursuant to Article 16 (4).

(2) The trademark owner has no right to prohibit to a third party to use the trademark on the goods which have been introduced on the market marked with such trademark by the owner himself or with his consent. This provision does not apply if, after having brought the goods on the market, an essential change or deterioration of the state or properties of the goods occurred without the owner's fault.

#### *Obligations in Trademarks*

**28.**—(1) The trademark owner shall be obliged to use the trademark, in particular on goods and on their packaging or commercial documents; in promotional, advertising and publicity materials, in strict compliance with the form in which it was entered in the Register, or in the form differing only in elements that do not change its distinctive capacity. The use of a trademark by a third party on the basis of an agreement is considered as the use of the trademark by its owner.

(2) The trademark owner is obliged to tolerate

*a)* if a third party uses, in commercial relations, the own forename, surname, address or indication concerning the kind, quality, quantity, purpose, value, geographical origin, date of production of goods or providing of services, or other characteristics of goods or services despite the fact that they are identical with or confusingly similar to the owner's trademark or create a part thereof; provided that the indications thereof are used in accordance with practices of the trade and good morals of economic competition,

*b)* if a third party uses, in commercial relations, a sign identical with or confusingly similar to the owner's trademark if it is necessary for the designation of the purpose of the goods, mainly of their accessories or spare parts, or kind of services, provided that it is used in compliance with practices of the trade and good morals of economic competition,

*c)* if an owner of an unregistered sign uses, in commercial relations, in the same extent, an identical or confusingly similar unregistered sign, where such use started before filing date of trademark application.

#### *Assignment and Transfer of Trademarks*

**29.**—(1) The owner of a trademark may assign his trademark by a written contract to a natural person or a legal entity for all or part of the goods or services for which it has been registered.

(2) A trademark is transferred to a new owner in cases given by special regulations.<sup>4)</sup>

(3) The contract on the assignment of the trademark and transfer of a trademark enters into force vis-à-vis third parties on the day of its entry in the Register. This entry must be requested by the acquirer.

### *License*

**30.**—(1) The right to use a trademark may be granted under the licensing contract<sup>5</sup> in respect of all or part of the goods or services for which the trademark has been registered or only for a part thereof.

(2) The licensing contract enters into force vis-à-vis third parties on the day of its entry in the Register. This entry must be requested by the trademark owner.

(3) The licensing contract which provides for the right to use the sign which is the subject of the trademark application shall be deemed to be the licensing contract providing the right to use the trademark after the sign is registered, unless the parties to the licensing contract agreed otherwise.

### *Lien on a Trademark*

**31.**—(1) A trademark is lienable<sup>6</sup>.

(2) The right of lien on a trademark enters into force on the day of its entry in the Register. The entry of the trademark lien must be requested by the lienor. Together with the request for the entry of the right of lien in the Register the lienor is obliged to submit to the Office the lien agreement with officially certified signatures of the parties.

### *Forfeiture of Trademark and Rectification of Trademark Owner*

**32.** The Office, on proposal, shall forfeit the trademark from the trademark owner entered in the Register and shall enter the person who proposes it as trademark owner provided that

- a)* the proposal has been filed by a owner of the foreign trademark (Article 4 (1)(c)),
- b)* trademark is identical or confusingly similar to the foreign trademark and is registered for the identical or similar goods or services,
- c)* the foreign trademark was registered pursuant to letter (*a*) before filing of the application of the trademark and
- d)* the trademark owner was at the time of filing of application the representative (Article 4 (1)(c)) of the owner of the foreign trademark and filed the trademark application in his name without the consent of the owner of the foreign trademark.

### *Specific Rights and Obligations in Collective Trademarks*

**33.**—(1) The owner of a collective trademark has rights and obligations with respect to that trademark in the extent as referred to in Articles 24 to 32 unless otherwise provided by the Act.



(2) The members of an association of entrepreneurs have the rights under paragraph 1 thereof to the extent provided in agreement.

(3) The members of an association of entrepreneurs in pursuing their economic activities are entitled to mark goods or services also with their registered trademark, or with the trademark that they have the right to use on the basis of the licensing contract.

#### **Part IV** **Relations with Foreign Countries,** **International Registration of Trademarks**

##### *Relations with Foreign Countries*

**34.—**(1) The provisions of international treaties, agreements and conventions by which the Slovak Republic is bound, are not affected by this Act.

(2) Person who have their residence or seat in the territory of the member state of the international treaty<sup>1a)</sup> or in the territory of the member state of World Trade Organization<sup>1b)</sup> shall have the same rights and obligations as the domestic applicants or trademark owners; if the state in which the persons have the residence or seat is not the member state of the international treaty<sup>1a)</sup> or in the territory of the member state of World Trade Organization<sup>1b)</sup> rights and obligations pursuant to this Act is possible to recognise only if the reciprocity condition is met.

(3) Natural persons and legal entities that do not have their domicile or seat in the Slovak Republic must be represented in the trademark procedure by an authorised representative<sup>8</sup>.

##### *International Registration of Trademarks*

**35.—**(1) Natural persons and legal entities having their domicile or seat in the Slovak Republic are entitled to apply with the Office for the international registration of a trademark or registration of changes with regard to international registration of a trademark in accordance with the International Convention.<sup>9</sup>

(2) The applicant requesting international registration of a trademark or the registration of changes with regard to international registration of a trademark as referred to in paragraph 1, is obliged to pay fees in accordance with the International Convention.<sup>9</sup> The Office shall publish the fees provided by the International Convention in the Journal.

**36.—**(1) The international registration of a trademark including the request for providing of protection in the Slovak Republic has the same effects as the entry of the trademark in the Register performed by the Office.

(2) The time limit for filing the oppositions against providing of protection to an internationally registered trademark begins on the first day of the month following the month



in which the trademark was published in the Gazette of the World Intellectual Property Organisation.

(3) If the protection to an internationally registered trademark has been refused in the Slovak Republic, such trademark is deemed to have never been registered in the Slovak Republic.

## **Part V** **Common, Transitional and Final Provisions**

### *Common Provisions*

**37.** The proceedings concerning trademarks shall be governed by general provisions on administrative proceedings<sup>10</sup> except the provisions of Articles 19, 23, 28 to 30, 32 to 34, 39, 49, 50, 59 (1) and Article 60.

**38.—(1)** The applicant, or the owner of the trademark shall be the parties to the proceedings concerning trademarks or collective trademarks (hereinafter referred to as “Parties to the proceedings”).

(2) The authorised person who has filed oppositions against the entry of a sign as a trademark in the Register pursuant to Article 9, the person authorised pursuant to Article 32 and the person requesting invalidation or revocation of a trademark registration shall be the parties to the proceedings as well.

**39.—(1)** All submissions addressed to the Office shall be in a written form in the official language.

(2) A submission shall concern one trademark or one collective trademark only. In case of the request for permission to change the data referring to the person of the owner of a trademark or a collective trademark, a request for registration of assignment or transfer of a trademark, a request for registration of a representative or of a change in the representative, or a request for correction of an error in the application, in the Register or in the Journal, one submission may concern more trademarks of the same owner.

(3) The provision of paragraph 2 thereof will also apply to identical requests concerning more applications of the same trademark owner.

(4) If the party to the proceedings concerning trademarks who submitted the proposal for the starting of the proceedings fails to comply with the invitation of the Office requesting to remove deficiencies or to amend the filing within the prescribed period of time, the Office shall suspend the proceedings; the party of the proceedings must be warned to this effect in advance. The Office shall also suspend the proceedings at the request of the person who submitted the proposal.

### *Further Processing*

**40.**—(1) On the basis of the request of the party to the proceedings on extension of the time limit set by the Office for performing an act, while such request has been filed before the expiry of such a time limit, the Office is entitled to extend the relevant time limit.

(2) If a party to the proceedings before the Office has failed to comply with the time limit set by the Office for performing an act, he is entitled to ask the Office for further processing and at the same time perform the omitted act no later than two months from the delivery of the Office decision issued as a consequence of failure to comply with the time limit.

(3) The Office shall refuse a request pursuant to paragraph 1 or 2 in case of time limits pursuant to paragraphs 1, 2, Articles 6(3), Article 9, Article 10 (2) and (4), Article 13 (2), Article 17 (3), Article 40a (1) and Article 42 (1) and in case of failure to comply of time limits pursuant to Article 10 (3).

(4) The Office shall refuse the request for extension of time limits or for further processing which fails to comply with conditions pursuant to paragraphs 1 or 2 or to which a ban pursuant to paragraph applies; before the refusal of the request the Office shall enable the person who requests it to react to the ascertained reasons on the basis of which it is to be refused.

(5) If the Office grants request for further processing the legal effects of the decision issued as a consequence of failure to comply with time limit shall be retracted or shall not ensue.

(6) If the Office fails to make a decision about refusing the request pursuant to paragraphs 1 or 2 within two months from its delivery, the request shall be deemed to be granted.

### *Restitutio in Integrum*

**40a.**—(1) If the party to the proceedings before the Office without causing it himself has failed to comply with the statutory time limit or the time limit set by the Office for performing an act where a consequence of non-performance of the act is suspension of the proceedings or another right is lost, he is entitled to ask the Office for *restitutio in integrum* and at the same time perform the omitted act within two months from the removal of the cause for which he could not perform the act, however, no later than within 12 months from the expiry of the non-complied time limit.

(2) The party to the proceedings shall justify the request pursuant to paragraph 1 and state particularly the facts, which had prevented the performance of the action. Statements submitted after the expiry of any of the time limits pursuant to paragraph 1 shall not be taken into consideration by the Office when making a decision about the request.

(3) In case of reasonable doubt about the veracity of the statement pursuant to paragraph 3 the Office may ask the applicant to prove his statements.

(4) Request for *restitutio in integrum* shall not be granted in case of failure to comply with the time limits for performance of the act pursuant to Article 40 (3).

(5) The Office shall refuse the request for *restitutio in integrum* which fails to meet conditions pursuant to paragraphs 1 and 2, or to which the ban pursuant to paragraph 4 applies or the person who requests has not proven his statements pursuant to paragraph 3; before the refusal of the request the Office shall enable the person who requests it to react to the ascertained reasons on the basis of which it is to be refused.

(6) If the Office grants the request for *restitutio in integrum*, the legal effects of the decision issued as a consequence of failure to comply with the time limit shall be retracted or shall not ensue.

(7) Third party that, that in the territory of the Slovak Republic, has use the sign identical or confusingly similar to the applied sign or trademark in good faith in the period since the validity of the decision issued as a consequence of failure to comply with the time limit until the cessation of legal effects of this decision pursuant to paragraph 6, is entitled to use this sign within its business activity without the obligation for remuneration for the use of the sign.

#### *Grounds for the Decision*

**40b.**—(1) Parties to the administrative proceedings before the Office shall be obliged to submit or indicate evidence in support of their statements.

(2) The Office shall develop the evidence and evaluate the evidence at its discretion, namely each of them separately and all of them in their mutual relationships.

(3) The Office shall decide on the basis of the facts of the case ascertained from the developed evidence submitted or indicated by the parties.

**41.**—(1) Upon the request, the Office may permit a third party to inspect the file if this party proves a legal interest.

(2) Right for a file inspection shall include a right for making photocopies for the fee.

(3) On the basis of a request of applicant or trademark owner those parts of the file which contain trade secret or other important information which publication is not necessary for a guarantee of the right for an information of third parties including the parties to the proceedings shall be excluded from the file inspection.

(4) Rights pursuant to paragraphs 1 and 2 shall not be exercised in relation to the parts of the file kept confidential according to the paragraph 3, to the record on voting and to those parts of the file containing ancillary notes or draft versions of decisions or other correspondence.

### Remedies

42.—(1) An appeal against the decision of the Office may be filed within 30 days from the delivery of the decision.

(2) When making decisions on the appeal the Office shall be bound by its scope; this shall not apply

a) in matters in which proceedings can be started *ex officio*,

b) in case of joint rights or obligations concerning several parties on one side.

(3) Filing an appeal remonstrations shall not be admissible against a decision on which a request for further processing or request for *restitutio in integrum* is granted.

43.—(1) The Office shall keep the Register wherein important data concerning trademarks are entered. The Register is public and open to inspection.

(2) Data entered in the registers pursuant to paragraph 1 shall be considered valid, unless a decision of the relevant authority determines otherwise.

(3) Change of data entered in the register, following from valid and enforceable decision of the court, shall be entered in the register without delay by the Office on delivery of the court decision with validity clause.

(4) Entry of data and facts following from the operation of the law or from a decision of the relevant authority shall not be considered a decision issued in the proceedings pursuant to a general provisions on administrative proceedings<sup>10</sup>.

(5) The Office publishes the Journal wherein applications for trademarks and collective trademarks pursuant to Article 8 (5), as well as entries and renewals of registrations of trademarks and changes in data concerning trademarks which have been performed after the entry of the trademark in the Register, are published.

### Provision of Authorisation

44. The Office shall lay down by means of the generally binding Decree:

a) detailed procedure for filing of application and divisional application,

b) detailed formalities of the contract concerning the use of a collective trademark,

c) detailed formalities concerning the documents proving the acquisition of distinctive character of a trademark,

d) data in publishing of the trademark application in the Journal,

e) detailed formalities of the oppositions against the entry of a sign in the Register as a trademark,



- f) data entered in the Register and published in the Journal after the registration of a trademark,
- g) detailed formalities of the certificate, the duplicate, the extract from the Register and the certificate of the priority right,
- h) detailed formalities of request for the entry of other data in the Register,
- i) detailed formalities concerning the request for invalidation and revocation of a trademark registration
- j) detailed procedure for filing request for renewal of trademark registration,
- k) details on keeping of records concerning trademark applications and registered trademarks,
- l) details concerning correction of errors,
- m) detailed procedure for filing of application for registration of international trademarks and request for the entry of changes in the International Register of Marks.
- n) details on communication to the Office, delivery and on submission by electronic means.

#### *Transitional Provisions*

**45.** The proceedings on applications of trademarks, that are pending as of the date of this Act entering into force, will be pursued in accordance with this Act, where the applicant shall be obliged to amend his application in compliance with the provisions laid down by this Act within a prescribed period of time.

The rights and relations in trademarks registered in the Register prior to the entry into force of this Act shall be governed by the provisions of this Act. The rise of these rights and relations as well as the claims arising thereof prior to the entry into force of this Act shall be exercised according to the regulations valid at the time of their establishment.

The owner of a trademark which was declared as famous by the Office pursuant to the previous regulations, may request the revocation from the Register of identical or confusingly similar trademarks under the conditions referred to in Article 23 (3) of the Act No. 174/1988 Coll. on Trademarks within the validity period of the trademark; but at the latest within ten years from the entry into force of this Act. Within this period the owner of a famous trademark may also file the oppositions against the entry of an identical or confusingly similar sign in the Register pursuant to Article 9, regardless of the goods or services for which the opposed sign is filed for registration.

If the Office ascertains that the famous trademark does not fulfil requirements listed in Article 18 (1) of the Act No. 174/1988 Coll. on trademarks, it shall revoke the decision on the declaration of the trademark to be famous.



*Repealed Provisions*

46. The following regulations shall be repealed:

1. Act No. 174/1988 Coll. on Trademarks,
2. Decree of the Invention and Discovery Office No. 187/1988 Coll. on Proceedings in Trademarks,
3. Article II. of the Act of the National Council of the Slovak Republic No. 90/1993 Coll. on Measures in the Field of Industrial Property

*Effectiveness*

47. This Act shall become effective on January 1<sup>st</sup>, 2002.

Notes:

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<sup>1</sup> e.g. Article 20(f) to 20(j) of Civil Code, Article 69 of Act No. 455/1991 Coll. Trade Licensing Act as amended, Act No. 83/1990 Coll. on citizens associations as amended

<sup>1a)</sup> Paris Convention on the Industrial Property Protection from March 20, 1883, revised in Brussels on December 14, 1900; in Washington, D.C. on June 2, 1911; in The Hague on November 6, 1925; in London on June 2, 1934; in Lisbon on October 31, 1958 and in Stockholm on June 14, 1967, promulgated by the Decree of the Minister of Foreign Affairs No. 64/1975 Coll. and amended by the Decree of the Minister of Foreign Affairs No. 81/1985 Coll.

<sup>1b)</sup> Communication of the Ministry of Foreign Affairs of the Slovak Republic No. 152/200 Coll. on concluding the Agreement Establishing the World Trade Organization

<sup>1c)</sup> e.g. Articles 566 to 590 and 642 to 672 of the Commercial Code

<sup>1d)</sup> Articles 44 to 55 of the Commercial Code

<sup>2</sup> Article 6bis of the Paris Convention on the Industrial Property Protection from March 20, 1883, revised in Brussels on December 14, 1900; in Washington, D.C. on June 2, 1911; in The Hague on November 6, 1925; in London on June 2, 1934; in Lisbon on October 31, 1958 and in Stockholm on July 14, 1967, promulgated by the Decree of the Minister of Foreign Affairs No. 64/1975 Coll. and wording by the Decree of the Minister of Foreign Affairs No. 81/1985 Coll.

<sup>3</sup> The Nice Convention on International Classification of Goods and Services for the Purposes of Mark Registration from June 15, 1957; revised in Stockholm on July 14, 1967 and in Geneva on May 13, 1977, promulgated by the Decree of the Minister of Foreign Affairs No. 118/1979 Coll. and amended by the Decree of the Minister of Foreign Affairs No. 77/1985 Coll.

<sup>4</sup> e.g. Articles 69, 479 and 487 of the Commercial Code, Article 460 and 469 of the Civil Code, Article 12 to 17 of the Act No. 111/1990 Coll. on state enterprise as amended

<sup>4a)</sup> Decree of the Industrial Property Office of the Slovak Republic No. 117/1997 Coll, on implementation of the Act No. 55/1997 Coll. on trademarks

<sup>4b)</sup> Articles 74 to 77 and Article 102 of The Rules of Civil Procedure

<sup>5</sup> Article 508 and following of the Trade Code

<sup>6</sup> Article 151a and following of the Civil Code, Article 297 and following of the Commercial Code

<sup>8</sup> Article 40 of the Act No. 237/1991 Coll. on Patent Representatives as amended



<sup>9</sup> Madrid Convention on International Registration of Manufacturing or Trademarks from April 14, 1891; revised in Brussels on December 14, 1900; in Washington, D.C. on June 2, 1911; in The Hague on November 6, 1925; in London on June 2, 1934; in Nice on June 15, 1957 and in Stockholm on July 14, 1967 promulgated by the Decree of the Minister of Foreign Affairs No. 65/1975 Coll. amended by the Decree of the Minister of Foreign Affairs No. 78/1985 Coll.

<sup>10</sup> Act No. 71/1967 Coll. On Administrative Proceedings (the Administrative Code)