

# Trademarks

in 50 jurisdictions worldwide

Contributing editors: Stuart J Sinder  
and Michelle Mancino Marsh

# 2013



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# Kosovo

## Tamara Bubalo

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### 1 Ownership of marks

Who may apply?

Any natural or legal person (or an undertaking that is not a legal person if it has the legal capacity to acquire rights and incur liabilities) may apply for the registration of a mark in Kosovo. Foreign parties in Kosovo enjoy the same rights regarding trademark protection as do domestic parties, should such rights derive from international treaties or the principle of reciprocity. However, the party claiming reciprocity has to prove its existence. Additionally, that foreign parties have to be represented in proceedings before the Kosovo Patent Office by a professional representative who has a BA degree in law and is registered in the appropriate register maintained by Patent Office, or by a domestic legal practitioner.

### 2 Scope of trademark

What may and may not be protected and registered as a trademark?

Under the Kosovo Law on Trademarks, trademark protection shall be offered to any signs, particularly words, including personal names, designs, letters, numerals, audio marks, three-dimensional configurations, including the shape of goods or their wrapping or other packaging, including colours, or combinations of colours, that are capable of distinguishing the goods or services of one undertaking from those of another.

However, a sign that consists exclusively of a shape shall not be protected as a trademark if such shape results from the nature of the concerned good itself, is necessary to obtain a technical result, or gives substantial value to the concerned good.

At present the following cannot be registered:

- a trademark which does not contain any distinctive character;
- a trademark that consists exclusively of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of the rendering of the services, or to designate other characteristics of the goods or services;
- a trademark that consists exclusively of signs or indications that have become common in the current language or are used confidently and have become common trade practices;
- signs that consist exclusively of: the shape which results from goods nature, the shape of goods which is necessary to obtain a technical result, the shape which gives substantial value to the goods;
- a trademark which is contrary to moral principles and public order;
- a trademark that is of such a nature as can reasonably be expected to deceive the public, in particular, as to the nature, quality or geographical origin of the goods or services;
- a trademark that includes the armorial bearings, flags or other emblems of a state;

- a trademark for wines or alcohol drinks containing or consisted of a geographical indication which identifies such wines or alcohol drinks not having that origin; and
- a trademark containing or consisting of a denomination of origin or a geographical indication with effect in the territory of the Republic of Kosovo, if application for registration of the trademark has been submitted after application for registration of a denomination of origin or a geographical indication and it is in application request for registration of geographical indication, determined by respective legislation, basis of such denominations are registered for types of similar goods.

### 3 Common law trademarks

Can trademark rights be established without registration?

For certain marks considered as famous marks, it is possible to establish trademark rights even without their registration. However, we do recommend that such marks are registered in Kosovo.

### 4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration?

The trademark registration procedure, where a mark is not found to be in opposition to any other previously registered trademark, usually takes somewhere from six to 12 months.

However, please note that should there be a parallel court procedure initiated, the registration procedure may be extended by several years, since the registration procedure is suspended until a decision is rendered in the court proceedings.

The average total cost for the registration proceedings is approximately €160.

### 5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed?

The classification system applicable in Kosovo is the International Classification of Goods and Services under the Nice Agreement, containing 34 classes of goods and 11 classes of services.

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## 6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

The examination report consists of formal requirements and of material conditions for the trademark registration.

Formal examination consists of verifying the validity of the filed trademark application (consisting of the trademark application form, the mark claimed, list of goods and services to which the mark applies, and power of attorney should the applicant be represented by someone).

Where the examiner finds that an application is invalid, the examiner will send an examination report to the applicant specifying the irregularities noted and inviting the applicant to remedy the deficiencies within a provided time limit.

If the applicant fails to remedy the deficiencies in the application within the time limit assigned, or if the applicant fails to pay the fee for remedying the deficiencies, the examiner will issue a procedural order rejecting the application.

Material examination takes place once the application is found to be in good order. The material examination procedure aims at examining the existence of any potential conflicts with other previously registered trademarks. If there are objections, the Patent Office will notify the applicant of this in writing, asserting the reasons why the mark cannot be registered and asking the applicant to submit its comments within the specified time limit of 60 days. If the applicant does not act upon the Patent Office's request, or if it does but the Patent Office nevertheless finds that the mark may not be registered, it will decide to reject the application. The Patent Office can also decide to accept the application partially.

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## 7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Use of a mark prior to registration is not mandatory. However, following the trademark registration, its use is compulsory. The Patent Office may, at the request of an interested party, terminate a trademark if the trademark holder or authorised person fails, without a justified reason, to use the trademark on the domestic market for an uninterrupted five-year period as of the day on which the trademark was registered, or from the day of its last use. In such a case, the burden of proof is on the trademark holder, so the trademark holder or authorised person must prove that the trademark has been used. Advertising the registered trademark without the possibility of supplying the goods or using the services for which the trademark was registered, payment of the fees for extending trademark validity or concluding contracts regarding the trademark, such as assignment contract or licence agreement, will not be considered as trademark 'use'.

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## 8 Appealing a denied application

Is there an appeal process if the application is denied?

Where an application is denied, an appeal may be filed with the administrative court within three months as of the date the Patent Office decision was made.

In the appeal proceedings, the Patent Office is entitled to voluntarily appear and be heard or may be compelled to do so by the court.

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## 9 Third-party opposition

May a third party oppose registration, or seek cancellation of a trademark or service mark? What are the primary bases of such challenges, and what are the procedures?

The Patent Office may, upon a request filed by an interested party, pass a decision on a trademark termination on the following grounds:

- if it is identical to a trademark filed or registered earlier;
- if the goods or services for which registration is sought are identical to the goods or services covered by a trademark filed or registered earlier;
- if, because it is identical or similar to a trademark filed or registered earlier and the goods or services covered by both trademarks are similar or identical, there is a reasonable likelihood of confusion on the part of the public, including the likelihood that the public will associate the trademark for which registration is sought with the previously filed or registered trademark;
- should the previously filed or registered trademark have acquired a reputation in Kosovo, and
- should the use of the trademark without due cause take unfair advantage of, or be detrimental to, the distinctive character or reputation of a trademark filed or registered earlier.

There is no specific procedure for the filing of opposition other than the ordinary filing procedure before the Patent Office.

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## 10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

The trademark lasts for 10 years as of the date of filing of the application for registration, and is indefinitely renewable for further 10-year periods upon payment of prescribed administrative fees. A request for trademark renewal should be filed with the Patent Office before the expiration of the current 10-year term and upon the information provided by the Patent Office

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## 11 The benefits of registration

What are the benefits of registration?

The benefits of registering a trademark are multiple, but the main benefit is protection. The trademark holder has the exclusive right to use the trademark for goods or services to which it relates, and to prohibit others from unauthorised use of an identical or similar mark for marking identical or similar goods or services, if such could cause confusion in commerce.

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## 12 Licences

May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?

Yes, it is possible to record a licence against a mark in Kosovo. A licence to use a registered trademark may be general or limited. It must be in writing, signed by or on behalf of the grantor of the licence and entered into an appropriate register upon the payment of administrative fees.

The Law on Trademarks also defines an exclusive licence which refers to a licence (whether general or limited) authorising the

licensee, to the exclusion of all other persons, including the grantor of the licence, to use a registered trademark in the manner authorised by the licence.

The benefit of registering a trademark licence before the appropriate registrar of the competent authority is that it shall produce an effect in relation to third parties.

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### 13 Assignment

What can be assigned?

All trademarks or a right from an application may be assigned by a contract for all or part of the goods or services for which it is registered. A trademark may be assigned alone; no other business assets need to be assigned to make it a valid transaction. Even though it is not mandatory to register the assignment, we strongly suggest that it be registered. Once registered the assignment can produce legal effects with regards to third parties, and the assignee is formally conferred all the rights stipulated by the assignment.

A trademark holder or applicant may assign the trademark or the right (or both) in the trademark application on the basis of an assignment in respect of all or some of the goods and services.

The assignment agreement needs to be drawn up in writing and it shall contain: the date of signing the agreement, name and surname or business name, domicile or residence or seat of the contractual parties, the trademark registration number or the number of the trademark application and the amount of the fee, if stipulated.

Registration of the assignment of a trademark or the rights arising from the application shall not be granted if such assignment is liable to cause confusion in trade in respect of the type, quality or geographical origin of the goods or services for which the trademark has been registered or in respect of which the trademark application has been filed, unless the assignee disclaims protection for the goods or services in respect of which there is a likelihood of confusion.

Registration of the assignment of a trademark or the rights arising from an application that refers only to certain goods or services shall not be approved where the goods or services being assigned are essentially similar to the goods or services in respect of which the mark remains registered for the benefit of the assignor.

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### 14 Assignment documentation

What documents are required for assignment and what form must they take?

Documents required for the registration of assignment before the Patent Office are the assignment form, the evidence of legal grounds for assignment such as the assignment contract and the power of attorney should the request be filed through a representative (legalisation and notarisation of the power of attorney are not required).

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### 15 Validity of assignment

Must the assignment be recorded for purposes of its validity?

In order to be effective against third parties, the assignment contract must be in writing and must be entered into the appropriate trademark register at the Patent Office at the request of a contracting party.

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### 16 Security interests

Are security interests recognised and what form must they take?  
Must the security interest be recorded for purposes of its validity or enforceability?

Trademarks can be transferred as means of a security interest. Even though it is not mandatory to register the security interest over a trademark, we strongly suggest that it is registered.

A security interest over a trademark is registered with the appropriate trademark register held at the Patent Office by filing a corresponding form, containing, among other things, a description of the security to be registered. Alongside the form should be provided the evidence of legal grounds for the registration of the security interest, such as an agreement, and the power of attorney in the case of a designated attorney.

Please note that there is no specific provision providing for the mandatory notarisation of any of the above-mentioned documents.

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### 17 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

No words or symbols are necessary to indicate trademark use or registration, hence the marking is not mandatory. However, if the reproduction of the protected mark in a dictionary, encyclopaedia or similar publication creates an impression that the mark is a generic term for goods or services for which that mark has been protected, the trademark holder may request the publisher to show that in the following edition, at the latest, the mark is accompanied with the symbol '®' as an indication clarifying that it is a protected mark. Therefore, words and symbols are not obligatory, but may be used as an indication that a mark is registered.

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### 18 Trademark enforcement proceedings

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals?  
Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

As is the case in neighbouring jurisdictions, border control mechanisms are also available to trademark holders. This means that trademark holders, applicants or exclusive licence holders may file a demand for trademark protection at a state border with the customs authorities. The customs authorities are empowered, ex officio or upon request of the trademark holder, to temporarily seize all goods that are either the object or means of an IP rights infringement, whenever there is prima facie evidence establishing that an IP right has been infringed, irrespective of whether they perform supervision ex officio.

It is possible to file an opposition in the case of trademark dilution by any person or undertaking by giving written notice of such opposition to the Patent Office within three months' from the publication of the trademark application in the Official Bulletin. The written notice of opposition must include a statement of the grounds of opposition.



**19 Procedural format and timing**

What is the format of the infringement proceeding?

Infringement proceedings are started by the filing of a complaint with the competent court. The infringement complaint is usually filed with a demand for a preliminary injunction. After receiving such a complaint, the court quickly decides on the preliminary injunction. Furthermore, before rendering the final decision on the complaint, the court schedules a hearing to receive the statements of the parties. The judge will schedule as many hearings as is deemed necessary before rendering a decision. The infringement proceedings usually last approximately one year.

**20 Burden of proof**

What is the burden of proof to establish infringement or dilution?

In infringement proceedings, the burden of proof is on the trademark holder: the holder has to prove that its intellectual property rights have been infringed.

**21 Standing**

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

An infringement action or a criminal complaint may be brought by the trademark holder, by an applicant, by an exclusive licence holder, by any user of the collective trademark (with the consent of the collective trademark holder) or by any user of the warranty trademark (with the consent of the warranty trademark holder). The infringement action may be filed within three years of the day on which the plaintiff became aware of the infringement and the identity of the infringer, but no later than five years from the date of the first infringement.

**22 Foreign activities**

Can activities that take place outside the country of registration support a charge of infringement or dilution?

Please note that only activities performed inside the borders of Kosovo can be subject to the infringement cases within the country, except for the import and export activities mentioned above.

Since foreign activities fall outside of scope of infringement cases in Kosovo, there are no significant jurisdictional issues regarding such activities.

**23 Discovery**

What discovery devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

The Law on Trademarks provides for the following discovery techniques: the inspection of premises, seizure of goods, and use of such goods as evidence in court hearings.

In criminal cases, the discovery device available for obtaining evidence is the seizure of infringing goods where there is a threat of the evidence being destroyed.

**24 Timing**

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

The time frame for rendering the final decision for the infringement action both before the first instance court and on the appellate level is several years, usually more than two years.

**25 Litigation costs**

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

Litigation costs depend on the value of the claim, the length of the proceedings and the number of hearings. In Kosovo, litigation costs comprise the costs of filing of the complaint to which are added the costs of rendering the decision of the first instance court, and in the case of appeal, for rendering the decision on the appellate level. As cases can be very different, it is impossible to determine a typical range of costs in an infringement action.

At the moment, there is no specific case law or legislation defining the procedure for recovery of costs by the successful plaintiff.

**26 Appeals**

What avenues of appeal are available?

Once the first instance court renders a decision, an appeal may be filed with the second instance court within 15 days as of the date of receipt of the decision.

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**27 Defences**

What defences are available to a charge of infringement or dilution, or any related action?

The most common defence used is that the mark is not similar to the registered trademark in question or, where goods are seized on the state border, that goods did not enter the Kosovo market and therefore could not infringe any trademark registered in Kosovo.

**28 Remedies**

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The plaintiff may request the following:

- obtaining of judicial remedy for the violation of the trademark;
- determination of infringement;
- termination of the infringement;
- destruction or alteration of the infringing objects;
- destruction or alteration of the tools and equipment used to manufacture the infringing objects, if necessary for the protection of the rights;
- reimbursement of pecuniary damages and justifiable legal costs and expenses (if the infringement was intentional, the plaintiff may, instead of the pecuniary damage reimbursement, request compensation amounting to up to three times the usual licence fee it would have obtained for the trademark use);
- publication of the court decision at the expense of the defendant; and
- information about third parties participating in the infringement; the plaintiff may also request for a preliminary injunction.

**29 ADR**

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

Even though ADR techniques are still rarely used in the Kosovo, it is necessary to mention that most common techniques are arbitration and mediation. Interestingly, in the past few years, mediation has increasingly been used as an alternative to regular court procedures. However, to our knowledge, there were no trademark-related disputes submitted to ADR techniques.

The most important benefits of both mediation and arbitration are the efficiency and speed of the procedure and lower formality than is the case for general court procedures.

However, mediation is prone to potential risks, mainly because the decision thereby rendered is not binding but is only given the status of an agreement between the parties. In recent years, in order to remedy such deficiency, the common practice is to record the decision issued in mediation before a competent court, thereby granting it binding power.

**30 Famous foreign trademarks**

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What protection is provided?

In Kosovo the threshold for identifying a famous mark is that a mark is deemed 'famous' when 70 per cent of the population of a given territory knows of such mark and relates it to a specific activity, good or service. Taking into consideration the principle whereby a famous mark is afforded protection even though it is not registered, it is possible to conclude that famous foreign trademarks enjoy protection even if they are not used domestically.

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| Data Protection                   | Product Recall               |
| Dispute Resolution                | Project Finance              |
| Dominance                         | Public Procurement           |
| e-Commerce                        | Real Estate                  |
| Electricity Regulation            | Restructuring & Insolvency   |
| Enforcement of Foreign Judgments  | Right of Publicity           |
| Environment                       | Securities Finance           |
| Foreign Investment Review         | Shipbuilding                 |
| Franchise                         | Shipping                     |
| Gas Regulation                    | Tax on Inbound Investment    |
| Insurance & Reinsurance           | Telecoms and Media           |
| Intellectual Property & Antitrust | Trademarks                   |
| Labour & Employment               | Trade & Customs              |
|                                   | Vertical Agreements          |



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