

Trademarks

in 50 jurisdictions worldwide

Contributing editors: Stuart J Sinder
and Michelle Mancino Marsh

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Law

Business

Research

Overview Michelle Mancino Marsh <i>Kenyon & Kenyon LLP</i>	3
The Community Trademark Mathias Kleespies and Simone Schaefer <i>Vossius & Partner</i>	4
Angola Patricia Rodrigues <i>Raul César Ferreira (Herd) SA</i>	9
Argentina Julio César Villano <i>Estudio Villano Attorneys at Law & IP Agents</i>	13
Austria Peter Israiloff <i>Barger, Piso & Partner</i>	19
Bosnia and Herzegovina Tamara Bubalo <i>Karanović & Nikolić Law Office</i>	25
Brazil Philippe Bhering and Mina Kaway <i>Bhering Advogados</i>	30
British Virgin Islands Vanessa King and Feroza Kartick <i>O'Neal Webster</i>	38
Canada James Buchan and Jennifer McKay <i>Gowling Lafleur Henderson LLP</i>	41
Cape Verde Patricia Rodrigues <i>Raul César Ferreira (Herd) SA</i>	48
China Jay Sha <i>Liu Shen & Associates</i>	53
Colombia Juan Guillermo Moure, Juan Felipe Acosta and María Clara Calderón <i>OlarteMoure</i>	59
Denmark Johnny Petersen <i>Delacour Dania</i>	64
Ecuador María Rosa Fabara Vera <i>Fabara & Guerrero Intellectual Property</i>	70
El Salvador José Roberto Romero <i>Romero Pineda & Asociados</i>	77
France Aurélie Marie <i>Cabinet Beau de Loménie</i>	83
Germany Astrid Gérard <i>Preu Bohlig & Partner</i>	88
Greece Alkisti-Irene Malamis and Lina Galanopoulou <i>Malamis & Associates</i>	95
Honduras Ricardo Anibal Mejia M <i>Bufete Mejia & Asociados</i>	102
Hungary Péter Lukácsi <i>SBGK Patent & Law Offices</i>	108
India P V Balasubramaniam, D Ferdinand and K M Aasim Shehzad <i>BFS Legal</i>	113
Italy Fabrizio de Benedetti and Pier Luigi Roncaglia <i>Società Italiana Brevetti (SIB) / Studio Legale SIB</i>	119
Japan Yasufumi Shiroyama <i>Anderson Mōri & Tomotsune</i>	124
Kosovo Tamara Bubalo <i>Karanović & Nikolić Law Office</i>	129
Macao Patricia Rodrigues <i>Raul César Ferreira (Herd) SA</i>	134
Macedonia Tamara Bubalo <i>Karanović & Nikolić Law Office</i>	139
Malaysia Benjamin J Thompson, Haneeta Kaur Gill and Hannah Ariffin <i>Thompson Associates</i>	144
Mexico Sergio L Olivares Jr <i>Olivares & Cia</i>	151
Montenegro Tamara Bubalo <i>Karanović & Nikolić Law Office</i>	159
Mozambique Patricia Rodrigues <i>Raul César Ferreira (Herd) SA</i>	164
Netherlands Maarten Haak <i>Hoogenraad & Haak, Advertising + IP Advocaten</i>	168
Nigeria Tolushuwa Oyebokun <i>Bloomfield Advocates & Solicitors</i>	173
Norway Per A Martinsen <i>Oslo Patentkontor AS</i>	179
Peru Rosa María Kresalja Santos <i>Duany & Kresalja Estudio de Abogados</i>	185
Poland Anna Zakrocka and Bartek Kochlewski <i>Patpol</i>	192
Portugal Patricia Rodrigues <i>Raul César Ferreira (Herd) SA</i>	198
Puerto Rico Eugenio J Torres-Oyola and Maristella Collazo-Soto <i>Ferraiuoli LLC</i>	202
Romania Cosmin Vasile <i>Zamfirescu Racoti Predoiu Attorneys at Law</i>	208
Russia Elizaveta Dmitrieva, Yuriy Korchuganov and Olga Zakondryna <i>MGAP Attorneys at Law</i>	214
São Tomé and Príncipe Patricia Rodrigues <i>Raul César Ferreira (Herd) SA</i>	219
Serbia Tamara Bubalo <i>Karanović & Nikolić Law Office</i>	223
Singapore Lam Chung Nian and Jeffrey Lim <i>WongPartnership LLP</i>	229
Slovenia Nina Drnovšek <i>Law Office Drnovšek LLC</i>	234
South Africa Debbie Marriott, Eugene Honey and Craig Shapiro <i>Adams & Adams</i>	240
Switzerland Brendan Bolli, Barbara Gehri and Felix Locher <i>E Blum & Co AG</i>	246
Taiwan Fali Lin and Michael Zuck <i>Formosa Transnational, Attorneys at Law</i>	252
Turkey Korcan Dericioglu <i>Dericioglu & Yasar Law Office</i>	258
United Kingdom Sarah Hadland, Isabel Davies, Holly Strube and Chloe Fernandez <i>Boyes Turner</i>	265
United States Michelle Mancino Marsh and Stuart J Sinder <i>Kenyon & Kenyon LLP</i>	272
Uruguay Martin Pittaluga and Fernanda Alonso Durán <i>Pittaluga Abogados</i>	279
Venezuela Maria Nebreda <i>Hoet Pelaez Castillo & Duque</i>	284
Vietnam Duong Thanh Long and Doan Phuong Thao <i>Aliat Legal</i>	290

Serbia

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1 Ownership of marks

Who may apply?

Any natural or legal person may apply for the registration of a mark in the Republic of Serbia. Foreign parties in Serbia enjoy the same rights regarding trademark protection as 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, foreign parties have to be represented in proceedings before the Serbian Intellectual Property Office by a professional representative having a BA degree in law and registered in the Register of Representatives maintained by Intellectual Property Office, or by a domestic legal practitioner.

Additionally, please note that a representative office of a foreign legal person in Serbia shall not be considered as an applicant, since the Company Law specifies that representative offices do not have the status of a legal person.

2 Scope of trademark

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

Under the Serbian Law on Trademarks, any mark that is used to distinguish goods and services in trade and that may be graphically presented shall be offered trademark protection. Marks subject to protection may comprise the following: words, slogans, letters, numbers, images, drawings, combinations of colours, three-dimensional shapes, combinations of such marks and of graphically presentable musical notes.

At present the following cannot be registered:

- sound marks, fragrance marks and taste marks;
- any mark that is in contrary to morality or public policy;
- marks having a general appearance that does not enable goods or services to be distinguished in the course of trade;
- marks representing a shape determined exclusively by the nature of the product or a shape indispensable to obtain a given technical result;
- marks designating exclusively the type, purpose, time or method of production, quality, price, quantity, weight or geographical origin of the goods or services;
- marks customary for designating a given type of goods or services;
- marks having the appearance or content that may create confusion in commerce with respect to the origin, type, quality or other characteristics of the goods or services;
- marks containing official marks or hallmarks of quality control or warranty, or imitations thereof;
- marks identical to a protected mark of another person for identical or similar goods or services;
- marks similar to a mark already protected on behalf of another person for identical or similar goods or services, if such similarity may lead to confusion in commerce and mislead participants;

- marks identical or similar to a mark for identical or similar goods or services that are well known in Serbia within the meaning of article 6-bis of the Paris Convention for the Industrial Property Protection;
- marks that, regardless of the goods or services concerned, are reproductions, imitations, translations or transliterations of a registered trademark, or the essential segment thereof, that is known without any doubt to those participating in the commerce in Serbia as a mark of widespread reputation (well-known trademark) used by other persons for marking their goods or services, and where the use of such a mark would result in an unfair benefit from the reputation acquired by the well-known trademark or in harm to its distinctive character or reputation;
- marks that, by their appearance or content, infringe copyright or industrial property rights;
- marks comprising state or other public coats of arms, flags or other emblems, name or abbreviation of the name of a country or of an international organisation, or imitations thereof, unless the competent authority of the country or organisation concerned has given its authorisation for such use; and
- marks representing or imitating a national or religious symbol.

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 Serbia.

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 two months to six months, thereby comprising any potential examination reports rendered by the IP Office leading to the extension of the procedure.

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

Average total cost for the registration proceedings excluding any potential additional costs for responses to the examination report amounts to approximately €360 pursuant to the median exchange rate of the National Bank of Serbia.

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 Serbia is the International Classification of Goods and Services under the Nice Agreement, containing 34 classes of goods and 11 classes of services.

On 15 July 2009, however, the government ratified the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (1973) as amended on 1 October 1985, which entered into force in Serbia on 15 October 2009.

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 improper, he will notify the applicant by dispatching an examination report to him specifying the irregularities noted and inviting the applicant to remedy the deficiencies within a 30-day time limit.

If the applicant fails to remedy the deficiencies in the application within the time limit assigned, or if he 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 formally to be in order. Such procedure aims at examining the existence of any potential conflicts with other previously registered trademarks. If there are objections, the IP Office will notify the applicant of this in writing, asserting the reasons for which the mark cannot be registered and requesting the applicant to submit its comments within the specified time limit of 30 days (which may be extended upon a request by the applicant for a period deemed appropriate, provided the prescribed fees have been paid). If the applicant does not act upon the IP Office's request, or if it does but the IP Office nevertheless finds that the mark may not be registered, the IP Office will decide to reject the application. The IP Office can also decide to partially accept the application.

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 IP 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 upon 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 conclusion contracts regarding the trademark, such as assignment contract or licence agreement, will not be considered as trademark 'use'.

Foreign registrations may be granted priority rights only if the IP Office receiving the application for national registration of the said trademark is provided with proof of priority (a document stating that trademark registration for the mark has been applied for elsewhere, ie, a certificate of priority) within the three-month period as of the date of filing of the request for national registration.

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 government against the decisions rendered by the IP Office within a term of 15 days as of the date of receipt of the decision.

Administrative proceedings may be instituted against the decision on the appeal rendered by the government within a term of 30 days from the date of the receipt of the government's decision.

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

- should the protected mark, due to actions or omissions by the trademark holder or its rights successor, become a generic term for the goods or services for which it was registered;
- should the protected mark, due to the manner of use by its holder or its rights successor, cause confusion in the market about the origin, type, quality or other characteristics of the goods or services; or
- should the protected mark become contrary to morality or public order.

There is no specific procedure for the filing of the opposition other than the regular filing procedure before the IP office.

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 IP Office before the expiration of the current 10-year term. In the event of a trademark termination due to failure to pay the prescribed fee, the trademark holder will have the exclusive right to request, within a period of one year from the termination and subject to filing a new application, that the trademark be registered again in its name for the same goods and services.

11 The benefits of registration

What are the benefits of registration?

Benefits of registering a trademark are multiple, but the main benefit is in 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.

Additionally, the Trademark Law specifically governs that, in the event of intentional infringement of a trademark, the injured party may, instead of remunerating the pecuniary damage, request from the infringing party compensation of up to three times the usual licence fee it would have obtained for the use of the trademark.

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 trademark in Serbia. Collective trademarks and warranty trademarks are excluded, however, and cannot be the subject of a licence agreement. A trademark holder or trademark applicant may, on the basis of a licence agreement, grant licence for the right to use the trademark or for the rights arising from the application in respect of all or some of the goods or services.

The requirements for the trademark licence registration are the following:

- the licence agreement shall be done in writing and shall contain:
 - the date of the signing;
 - the name and surname or company title, domicile or residence, or business seat of the contractual parties;
 - the trademark registration number or the number of the trademark application;
 - the term of validity of the licence; and
 - the scope of the licence; and
- the licence agreement shall be recorded in the appropriate register with the competent authority at the request of the trademark holder or the applicant or assignee.

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

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 is 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, 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 (or both) 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 the application (or both) 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.

Please note that collective trademarks and warranty trademarks may not be the subject of assignment.

14 Assignment documentation

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

The request for the registration of an assignment of rights may be filed by either of the contracting parties (ie, the assignor or the assignee) and should comprise the following:

- official Z-4 form in triplicate for the assignment of rights;
- the Z-4 form is to be filed with evidence of the legal grounds for the assignment such as the assignment agreement;
- power of attorney (should the request be filed through a representative); and
- proof of the payment of the administrative fee.

Legalisation and notarisation of the above-mentioned documents is not required.

Additionally, a single request filed on the Z-4 form may specify registration of assignment relating to several trademarks or several applications, provided that the earlier right holder and the new right holder are the same in each of the trademarks or applications and that the registration numbers or the Z-numbers are indicated on the request. (The Z number represents an application number assigned by the IP Office to the initial application for trademark registration.) If the applicant of the request submits only one copy of the Z-4 form requesting the registration of several assignments of rights, the Office will use one Z-4 form for each of the trademarks or trademark applications included in the request. The original will be inserted in the file relating to the trademark first listed or to the trademark application first listed, respectively, while the copies will be inserted in the other files. Each copy is to bear an indication of the file where the original is kept.

Administrative fees for the registration of trademark assignment amount to €32.

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 register at the IP Office at the request of a contracting party.

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 also be subject to a pledge. Even though it is not mandatory to register the pledge, we strongly suggest that it is registered.

Pledge over a trademark is registered before the register of pledges held at the IP Office by filing a Z-5 form containing, among other things, the description of the security to be registered. Alongside the form should be provided the evidence of legal grounds

for the registration of security interests such as the pledge 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.

Administrative fees for the registration of a pledge amount to €32.

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 the protected mark. Therefore, words and symbols are not obligatory, but may be used as indications that a mark is registered.

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?

Border control mechanisms are available to trademark holders. This means that trademark holders, applicants or exclusive licence holders may file a demand for a trademark protection on a state border to the customs authorities. Upon an application of the rights holder, or ex officio, the authorities are empowered 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. Right after the measures have been taken, the customs officers are obliged to notify without delay the rights holder, the IP Office (if it is necessary to obtain relevant information) and any other interested parties (if any such parties are known) or just the rights holder (if the proceedings have been initiated upon the request of the holder of intellectual property rights) about the measures taken.

This notification is very important because it includes an invitation to the holder of the IP rights to initiate the proceedings for protection of its rights before the court and to inform the customs authorities about the proceedings initiated or the preliminary injunction issued by the court. The time limit for the rights holder to act in accordance with such invitation is 15 days as of the day when it receives the notification, which can be extended for a further 15 days. The goods that have been temporarily seized may be finally confiscated and destroyed on the basis of the court's decision or ex officio by the customs authorities, including donation for humanitarian purposes and sale for the purposes of recycling.

For an opposition against the registration of a trademark, it is possible to file an informal objection before the Trademark Office during the registration procedure. However, bearing in mind that the law does not formally provide for such action and hence this is solely an informal procedure, it is possible that the objection will be rejected. However, should the objection be taken into consideration by the trademark examiner and considered as valid, it may lead to a trademark cancellation.

There are no specialised courts or other tribunals dealing with trademarks.

Please note that the Serbian Criminal Law explicitly provides for sanctions in the event of trademark infringement. The aforementioned law generally provides that any person using someone else's trademark to deceive an end user as to the nature of the goods or services such person provides, or as to the identity of the company, shall be punished by three years' imprisonment and a pecuniary fine.

19 Procedural format and timing

What is the format of the infringement proceeding?

Infringement proceedings are started by filing a complaint with the competent court. The infringement complaint is usually filed with a demand for preliminary injunction. After receiving such a complaint, the court quickly decides on 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.

There is also a criminal enforcement mechanism. Consequently, the infringed party may file a criminal complaint to the Public Prosecutor's Office for unauthorised use of a firm, which also includes use of trademarks. The sanctions prescribed are monetary fines or imprisonment for up to eight years.

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 Serbia can be subject to infringement cases within the country, except for the import and export activities mentioned above.

Since the foreign activities fall outside of scope of infringement cases in Serbia, 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, vehicles, books and documents, as well as the seizure of objects, hearing of witnesses and expert witnesses and the securing of such evidence by the court without prior notification or hearing of the person from whom the evidence is to be collected.

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 typical time frame within which the court decides regarding the preliminary injunction ranges from one week to one month. However, with regard to the final decision for the infringement action, the time frame is approximately one to three years. The procedure before first instance courts usually takes one year, and the same would apply for the procedure initiated at the appellate level.

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, length of the proceedings and number of hearings. In Serbia, 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 case of appeal, for rendering the decision on the appellate level. As the range between 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 eight days of the day of

the receipt of the first instance decision should the parties be legal entities, and within 15 days should at least one of the parties be a natural person.

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 Serbian market and therefore could not infringe any trademark registered in Serbian territory.

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:

- 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 Serbia, it is necessary to mention that the 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.

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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 this deficiency, the common practice is to record the decision issued in mediation before a competent court, thereby granting it binding power.

Potential risks of the arbitration technique refer to the court recognition of the arbitration decision and its binding effects.

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 Serbia 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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