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Trademarks and Their Legal Protection

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TRADE MARKS

AND THEIR LEGAL PROTECTION



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What is a trade mark?

A trade mark is a sign which has, in particular, the distinguishing function. Its purpose is to distinguish products or services of the same kind, produced or provided by various producers or service providers. Trade marks help consumers orientate more easily in the offer of products and services and choose the goods they wish. In consequence of the extensive advertising spread, in particular, through media, trade marks, such as production or commercial brands of individual undertakings, have become an integral part of our everyday lives.

Trade marks are regulated, in particular, in the following laws:

- Act No. 441/2003 Coll., on Trademarks, as amended;
- Act No. 634/2004 Coll., on Administrative Fees, as amended

The texts of the Acts are available on the website of the Industrial Property Office (<http://www.upv.cz>).



What can constitute a trade mark?

A trade mark can be any sign (words, names, colours, paintings, letters, numerals, shapes, sounds, or a combination of these features) which is capable of being represented in the Register of Trademarks in a manner enabling the competent authorities and the public to clearly and precisely determine the subject of protection granted to a proprietor of a trade mark and which is capable of distinguishing the products or services for which it is protected from identical products or services on the market provided from different sources. Therefore, a trade mark cannot exist alone, but is always associated with particular products or services it represents.

An applicant shall file an application for the registration of a trade mark with the Industrial Property Office ("Office"). By filing an application, the applicant acquires a right of priority to the sign applied for towards other competitors on the market. The title to the trade mark shall arise only after the trade mark is entered in the Register of Trademarks kept by the Office. The proprietor of the trade mark has an exclusive right to mark his products or services with the trade mark or use the trade mark in relation to such products or services. Without the proprietor's consent, nobody is allowed to use a sign identical to, or likely to be confused with, the proprietor's trade mark for identical or similar products or services.



Types of trade marks and their identification in the application:

WORD – consists exclusively of words or letters in the Roman script, of Arabic or Roman numerals, of other usual typographic signs, or of their combination and shall be submitted in the form a reproduction of the sign, using the usual font and usual arrangement without any graphical features or colours.

FIGURATIVE – consists of unusual features, styles, arrangements, graphical features or colours, including trade marks consisting exclusively of figurative features or a combination of word and figurative features, and shall be submitted in the form of a reproduction of the sign the registration of which is applied for, representing all its features and colours.

THREE-DIMENSIONAL – consists of, or is completed by, a three-dimensional shape representing vessels, packaging, or the goods themselves or their portrayal and shall be submitted in the form

of a graphic reproduction of the shape, including computer-generated images, or a photographic reproduction. The graphic or photographic reproduction may include various views.

Trade mark in colour formed ONLY BY COLOUR or a COMBINATION OF COLOURS – consists exclusively of a colour without contours or exclusively of a combination of colours without contours and shall be submitted in the form of:

- a) a reproduction of the colour and its identification by reference to the generally recognized colour code; or
- b) a reproduction representing a systematic arrangement of the combination of colours in a uniform and pre-defined manner and identifying such colours by reference to the generally recognized colour code; a description of a systematic arrangement of colours can also be attached to the trade mark in colour.

POSITION – consists of a special manner in which a trade mark is positioned on, or affixed to, a product and shall be submitted in the form of a reproduction identifying the position of the trade mark and its size or the proportions for relevant products. The features which are not part of the subject of registration shall be visually marked, preferably by means of broken or dotted lines. The representation may be accompanied by a description specifying in detail the method of affixing the trade mark to a product.

WITH A PATTERN – consists exclusively of a group of regularly recurrent features and shall be submitted in the form of a reproduction representing a recurrent pattern. The representation may be supplemented by a description specifying in detail the method of the regular recurrence of such features.

SOUND – consists exclusively of a sound or a combination of sounds and shall be submitted in the form of an audio record reproducing the sound or through a precise representation of the sound in the form of sheet music.

MOTION – consists of, or is completed by, a motion or a change of a position of the features on a trade mark and shall be submitted in the form of a video record or a series of static images in the relevant order, representing a motion or a change of position. Where static images are used, they can be numbered or accompanied by a description explaining their order.

MULTIMEDIA – consists of, or is completed by, a combination of image and sound and shall be submitted in the form of an audio visual record containing the combination of image and sound.

HOLOGRAPHIC – consists of features with holographic signs and shall be submitted in the form of a video record or graphic or photographic reproduction containing the views necessary to clearly recognize the holographic effect in its entirety.

OTHERS – where a sign does not match any of the types specified above – shall be submitted in any appropriate form with the use of generally available technology if it is capable of being reproduced in the register in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective for the competent authorities and the public to be able to clearly and precisely determine the subject of protection granted to a proprietor of a trade mark. The representation may be completed by a description.

In addition to word signs using the usual font and to sound signs, a trade mark can, at the applicant's discretion, be represented in black and white. If a trade mark is registered in black and white, the protection shall also apply to the used colours and their arrangement.



What mark cannot be entered in the Register of Trade marks?

The following trade marks shall be excluded from registration:

- trade marks which cannot be identified in the Register of Trademarks in a manner enabling the competent authorities and the public to clearly and precisely identify the subject of protection granted to a proprietor of a trade mark (e.g. smell, taste);
- trade marks which are devoid of any distinctive character;
- trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the services;
- trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
- trade marks which consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves or which is necessary to obtain a technical result or which gives substantial value to the goods (shape of a product which is generally used or is conditional upon the technical properties of the goods);
- trade marks which are contrary to public policy or to accepted principles of morality;
- trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or services;
- trade marks which consist of, or reproduces an earlier plant variety denomination registered in accordance with the legislation of the Czech Republic or the European Union legislation or international agreements to which the Czech Republic or the European Union is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species;
- trade marks which have not been authorized by the competent authorities and are to be refused or invalidated pursuant to Article 6ter of the Paris Convention;
- trade marks which consist of other signs, emblems, and escutcheons other than those covered by Article 6ter of the Paris Convention and which are of public interest, unless the consent of the competent authority to their registration has been given;
- trade marks which include a sign of high symbolic value, in particular, a religious symbol;
- trade marks the use of which is contrary to the legislation of the Czech Republic or the European Union or contrary to the obligations which result for the Czech Republic from international agreements to which the Czech Republic or the European Union is party, in particular, where they concern protected designation of origin and geographical designation of traditional terms for wine and traditional specialties guaranteed;
- trade marks which infringe third party rights invoked through a due and timely opposition to the application for the registration of a trade mark.



Who can apply for the registration of a trade mark?

Any natural person or legal entity having legal capacity shall be entitled to file an application for the registration of a trade mark.

The application for the registration of a trade mark can be filed directly by the applicant, or the applicant may appoint a representative, in particular, an attorney-at-law or patent attorney, to this effect. In filing the application, the representative shall be required to submit a power of attorney signed by the applicant. Where the applicant does not have his undertaking or his permanent or registered address on the territory of the Czech Republic, he shall be required to file an application for the registration of a trade mark through a member of the Czech Bar Association or the Chamber of Patent Attorneys of the Czech Republic. This condition shall not apply where the applicant is a citizen of the EU or a state which is party to the EEA (or has his administration or registered address there) and is located or provides services on the territory of the Czech Republic. These persons shall specify the address in the Czech Republic to which official documents relating to the application or the registered trade mark shall be sent. All submissions to the Office shall be made in the Czech language.



How to file an application for the registration of a trade mark?

An application for the registration of a trade mark shall be filed electronically (if furnished with guaranteed electronic signature or submitted through the applicant's data box), by mail, or in person to the Industrial Property Office.

Where the application is filed by fax or electronically without certified electronic signature, the Office must receive its written original at the latest within five (5) days.

An application shall contain:

- information identifying the applicant [corporate name and registered address (legal entity) or name, surname and address (natural person) of the applicant];
- the wording or the spatial or other representation of the sign the registration of which is requested;
- a list of the goods or services in respect of which the trade mark shall be registered; the goods or services shall be arranged and classified according to the classes of the international classification of goods and services (International Classification of Goods and Services for the Purposes of the Registration of Marks established by the Nice Agreement of 15 June 1597). The international classification classes are available on the website of the Industrial Property Office (<http://www.upv.cz>) [Sorting Systems link]. For the purposes of the classification, the electronic database of goods and services TM-Class (EUIPO) can also be used.
- signature of the applicant or the applicant's representative.

As soon as the Office receives the application, it shall furnish it with a date and time of filing. At this moment, the applicant shall acquire the right of priority towards anyone who, subsequently, could apply for registration of an identical mark for identical products or services.

The application may also contain:

- information identifying the representative, if the applicant is represented;
- delivery address if different from the address of the applicant or the applicant's representative (no delivery address can be used if the applicant or the applicant's representative has a data box and the nature of the documents does not exclude their sending through a data box).

Attachments to the application:

- *spatial A8 to A4 representation of the trade mark the registration of which is requested or another representation of the trade mark, satisfying the technical requirements available on the Office's website*
(except for word marks applied for in the usual font)
- *power of attorney of the representative, if the applicant is represented.*

»» How does the procedure for the registration of a trade mark take place?

An applicant for the registration of a trade mark shall be obliged, within one month from delivery of the application, to pay an administrative fee. If the administrative fee is not paid, the application shall be considered as not filed.

After an application is filed, the Office shall ascertain whether it contains all necessary information. If the Office finds defects which prevent further procedure (e.g. an incorrect classification of the list of goods or services, a missing power of attorney, etc.), it shall request in writing that the applicant removes them within the set time (usually two months).

If the applicant does not react to the Office's request and does not remove the defects, the Office shall reject the application. If the defects apply only to a part of the list of goods or services, the Office shall reject the application only in relation to such part. If the application does not have such defects or they have been removed by the applicant, the Office shall carry out the so-called substantive examination of the trade mark the registration of which is requested to make sure that the trade mark applied for is not excluded from registration. If the trade mark cannot be registered, the Office shall inform the applicant, who may furnish his reaction within the set time and may remove the given obstacle. If the obstacle to the registration cannot be removed, the Office shall reject the application.

A due remedy, i.e. an appeal, may be filed against a decision of the Office.

If the mark applied for is capable of being registered, the application for the registration of a trade mark is published in the Office's Journal coming out once a month in electronic form. Within three months from the publication, the persons whose earlier rights may be infringed by the published mark may file an opposition to the registration of the trade mark. The persons authorized to file an opposition are specified in the Trademark Act. If an opposition is filed, the Office shall determine whether it is justified and whether the mark applied for infringes the rights of the person who has filed the opposition.

If so, the Office shall reject the application for the registration of the trade mark. If no opposition is lodged against the sign applied for within the set deadline or an opposition has been rejected as unjustified, the Office shall enter the mark in the Register of Trademarks. On that basis, the Office shall then issue the proprietor of the trade mark a certificate of registration of the trade mark.

»» What is the duration of the registration of a trade mark?

Trade marks shall be registered for a period of 10 years from the date of filing of the application. After the expiry of this period, the registration of a trade mark may be renewed at the request of the proprietor of the trade mark for further 10-year periods. The request for renewal of the registration of a trade mark shall be submitted through the relevant form at the earliest in the last year of the registration period but prior to the date of its expiry. The request

for renewal may also be submitted within six months from such date for an increased fee. If no request for renewal is submitted, the trade mark shall expire.

»» *What is a collective trade mark?*

Collective trade mark is a trade mark which is described as such when the trade mark is applied for and is capable of distinguishing the goods or services of the members of an association which is the proprietor of the mark from the goods or services of other undertakings. Associations of manufacturers, producers, suppliers of services or traders, which, under the terms of the law governing them, have the capacity in their own name to have rights and obligations, to make contracts or accomplish other legal acts, and to sue and be sued, as well as legal persons governed by public law, may apply for collective trade marks. Regulations governing use of a collective mark, specifying at least the persons authorized to use the collective mark, the conditions of membership in a legal entity, and the conditions for using the collective mark, including sanctions, shall be attached to the application for the registration of a collective mark.

»» *What is a certification trade mark?*

Certification trade mark is a trade mark which is described as such when it is applied for and is capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics, from goods and services which are not so certified. Any natural or legal person who is competent to certify the goods or services for which the certification mark is to be registered and who does not carry out a business involving the supply of goods or services of the kind certified may apply for certification marks. Regulations governing the use of certification mark shall be attached to the application for the registration of the certification mark.

How to apply for a trade mark protection abroad?

A trade mark entered in the Register of Trademarks kept by the Office on the basis of a national application shall be protected only on the territory of the Czech Republic. If the applicant wishes to apply for protection in another state, he may file an application for the registration of the trade mark directly with the registration authority of the relevant state or may file an application for international registration of the trade mark with the Office under the conditions specified below. The third option may be to file an application for the registration of a European Union trade mark covering the whole European Union, which may be filed with the European Union Intellectual Property Office (EUIPO) in Alicante, Spain. Detailed information is available at <https://euipo.europa.eu/ohimportal/cs>.

»» *What is an international trade mark?*

Trade marks registered or applied for in the Czech Republic can be registered, through the Industrial Property Office, as the so-called international trade marks for some other states according to two international agreements to which the Czech Republic is party, the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating to the Madrid Agreement.

The Madrid Agreement and the Protocol relating to the Madrid Agreement provide their parties with an opportunity to protect their marks in all contractual states of the Madrid Agreement and the Protocol relating to the Madrid Agreement on the basis of a single application filed with the International Bureau of the World Intellectual Property Organization in Geneva ("International Bureau") through the competent registration office of the applicant's origin.

The form of the application for international registration of a trade mark, the list of contracting parties to both international agreements, the instructions for completing the application, and the tariffs set by the International Bureau are available in the information centre or on the Office's website. The applicant shall complete only the application for international registration of a trade mark and shall file it with the Office, which shall then draw up an international application for the registration of the trade mark. In addition to the administrative fee, the applicant shall pay the registration fees in Swiss francs directly to the International Bureau.

In an international application for registration of a trade mark, it shall be possible to invoke the right of priority on the basis of an application for registration of a trade mark in the Czech Republic provided that no more than six months have lapsed between the date of filing of the application in the Czech Republic and the date of filing of the application for international registration. The International Bureau shall recognize the right of priority of the date of filing of the application for registration of a trade mark in the Czech Republic if it is delivered the international application within two months from the date of filing of the application for international registration in the Czech Republic.

International registration may be made only on the basis of an application for registration of a trade mark in the Czech Republic without the trade mark having to be entered in the Register of Trademarks in the Czech Republic. However, such international registration shall depend on the subsequent registration of the trade mark in the Czech Republic. It means that, if a trade mark is not registered and the procedure for the registration of the trade mark in the Czech Republic results in the refusal of the trade mark or the discontinuation of the procedure on the application, the international registration in the International Register of Trademarks kept by the International Bureau shall be revoked. The scope of the revocation shall always correspond to the final result of the basic national application. Therefore, if a national application is rejected in the Czech Republic only in respect of a part of the list of goods or services, the international registration of the trade mark shall be revoked only in respect of such part of the list of goods or services and shall continue to apply to the remaining goods or services.

After an international trade mark is entered in the International Register of Trademarks, the International Bureau shall communicate the international registration of the trade mark to all the contracting states of the Madrid Agreement or the Protocol relating to the Madrid Agreement where the international trade mark is registered for protection, i.e. the states which are specified in the international registration of the trade mark. The contracting states may, within one year from the date of communication of the international registration, refuse to grant protection for the international trade mark on their territories if this is contrary to their national laws. The contracting states of the Protocol relating to the Madrid Agreement may, through a declaration, extend this period to eighteen months and, if the refusal relies on an opposition lodged by an authorized person, the refusal may be communicated after the expiry of this period upon prior notice. If, however, the designated state is a party to both international agreements (Madrid Agreement and Protocol relating to the Madrid Agreement), it may refuse protection of an international trade mark only within a period of one year from the date of communication of the international registration rather than within the extended 18-month period.

The duration of an international trade mark shall correspond to ten years and may be renewed for further 10-year periods.

After an international registration of a trade mark is made, the proprietor of the trade mark may, at any time during the validity of the international registration, apply for its registration, i.e. extend its registration territorially, in other contracting states of the Madrid Agreement or the Protocol relating to the Madrid Agreement by designating the other contracting states subsequently. The subsequent specification may be requested either for the entire list of goods or services or only for a part of it. The protection period resulting from the territorial extension shall expire on the same date as the international registration; the date of renewal of an international trade mark is, therefore, identical for all designations the international trade mark may contain.

An international registration of a trade mark shall, for a period of five years, be dependent on the existence of a registration of the trade mark in the Czech Republic. If the trade mark ceases to have effect (expiry of the duration, surrender of the proprietor's rights, revocation, declaration of invalidity) within five years from the date of the international registration, its international registration in the international register shall also be revoked. This shall also apply when the proprietor's surrender of the trademark rights or the revocation of the trade mark or the declaration of the trade mark invalid applies only to a part of the goods or services for which a national trade mark is registered. If the international registration in the international register is revoked by reason of its dependency on the basic national registration or on a basic national application, the proprietor shall be entitled, within three months from the date of revocation, to apply for a transformation of the international registration into national applications for the registration of trade marks in the designated contracting states. The transformation shall be applied for directly with the registration authorities of the individual states, which, in such case, shall be obliged to recognize the date of the international registration of a trade mark as the date of filing of a national application.

Detailed information on the conditions and the course of the international registration is available on the WIPO's website (www.wipo.int) in the Trade Marks section.

Since 1 October 2004, it has been possible to register a trade mark, in the form of an international registration, also for the European Union as a whole. In such case, the applicant shall designate the European Union in the application for international registration. The protection of a trade mark on the territory of the European Union shall be decided by the European Union Intellectual Property Office (EUIPO) in Alicante. If this Office refuses protection of the international trade mark for the territory of the European Union or the international registration of the trade mark in the European Union ceases to have effect (e.g. because the trade mark has been declared invalid), the applicant may apply for a transformation of the registration designating the European Union as a whole into an application for a subsequent international registration of the trade mark designating the individual states of the European Union at his discretion. The applicant may also choose whether to apply for a subsequent designation in the Member States for the entire list of goods or services or only for a part of it. The applicant may opt for a transformation of the international registration of a trade mark designating the European Union into a national application in individual Member States. In such case, the applicant shall apply for the transformation directly with the registration authorities of these states pursuant to the Regulation on the European Union Trade Mark (Regulation (EU) 207/2009 of the Council, as amended by Regulation (EU) 2015/2424 of the European Parliament and of the Council, codified Regulation 2017/1001 on the European Union Trade Mark).

The applicant shall file an application for a transformation of the registration designating the European Union into a registration designating Member States with the International Bureau through the EUIPO within the deadline laid down in the Regulation on the European Union Trade Mark, i.e. within three months from the decisive facts (e.g. a notice of refusal of protection on the part of the EUIPO). The application shall be filed on special form MM16 of the International Bureau of the World Intellectual Property Organization, which is available at www.wipo.int. For the subsequent designation of Member States, the date shall be recognized on the date on which the date of designation of the European Union was entered in the international register.

In consequence of a transformation, the recognition or refusal of protection of an international trade mark shall be determined by the registration authorities of the selected Member States of the European Union in compliance with their own trademark laws.

If the proprietor of a trade mark wishes to be granted protection for the trade mark in a state which is not a contracting state of the Madrid Agreement or the Protocol relating to the Madrid Agreement, he shall apply for its registration nationally, i.e. directly with the Industrial Property Office of the given state, usually through a local authorized representative and in compliance with the national trademark laws of such state. In this manner, trade marks may be registered in states which are not party to the Madrid Agreement or the Protocol relating to the Madrid Agreement, as well as in the individual Member States of the European Union.



What are the basic administrative fees?

Filing an application for	- individual trade mark	CZK 5,000
	- collective trade mark	CZK 10,000
	- certification trade mark	CZK 10,000

These fees shall include a list of goods or services within the scope of three classes of the international classification of goods and services. If the list of goods or services in an application contains more than three classes of the international classification, an additional fee of CZK 500 for each additional class shall be paid in addition to the applicable fee (e.g. if the application contains a list of goods or services in five classes of the international classification, the total fee shall be CZK 6,000).

Filing an application for renewal - individual trade mark	CZK 2,500
- collective trade mark	CZK 5,000
- certification trade mark	CZK 5,000

If an application for renewal is filed within six months from the expiry of the protective period, these fees shall be increased to CZK 5,000 in respect of an individual trade mark and to CZK 10,000 in respect of a certification or collective trade mark.

Filing an application for an international registration of a trade mark	CZK 2,500
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The registration fees in Swiss francs paid to the International Bureau of the World Intellectual Property Organization in Geneva are specified in the special pricelist available in the Office's information centre and on the Office's website, including the calculator. The calculator of fees is also available on the WIPO's website (www.wipo.int) in the Trade Marks section.

The fees paid to the European Union Intellectual Property Office are specified on the Website of this Office (<https://euipo.europa.eu/ohimportal/en/fees-and-payments>).

Trade Mark Searches

Applicant may order trade mark searches with the Office, not only for the Czech Republic (i.e. national trade marks, international trade marks designating the Czech Republic and the European Union, and European Union trade marks) but also for the territories of selected states worldwide.

The search shall be an informative search, part of which shall not be a statement of the Office regarding the capability of a sign to be registered or the possible risks associated with the filing of an application for the registration of a trade mark. In spite of this, the search may help a potential applicant have an overview of the existing earlier rights, which could influence the procedure for the registration of the trade mark.

A trade mark search may only be ordered in writing. The price shall include a handling fee and, if the results are to be delivered by mail, the price of the printed copies shall be added according to the Office's pricelist of services plus postal and packaging fees. The standard deadline for delivering a search shall be thirty days from the delivery of an order. In searches for the territory of the Czech Republic, an express handling within 3 days or 24 hours may be requested for an additional fee.

Searches are carried out through freely available sources on the Internet (databases of national authorities, EUIPO, WIPO) or through the commercial database Corsearch.

A historical search of a terminated trade mark can also be made.

More detailed information can be obtained from the workers of the Patent Information Department (e-mail: objednavky@upv.cz, tel. 220 383 430).



Where can further information be obtained?

Public Study

Information Centre

The Information Centre workers are ready to answer inquiries relating to industrial property protection and provide general information on the individual industrial property law institutes, on the formal requirements for applications, on the circumstances of the procedure for such applications, and on the administrative fees and shall carry out the requested searches. The Information Centre can be visited in person every working day or can be contacted by phone at 220 383 120.

Internet

Information on the Office's activities and services can also be obtained on the Internet at <http://www.upv.cz>.

The Office's website provides information on individual subjects of industrial property, the provided services, the basic laws, and the activities of the Industrial Law Education Institute. Parts of the presentation of the individual subjects of industrial property are also electronic application forms which can be used for online filing.

The Office's website provides public databases of trade marks where informative searches can be made free of charge, such as the database of trade marks with effects in the Czech Republic, containing both national trade marks and international trade marks designating CZ and EM and European Union trade marks. There are also links to some foreign databases, such as Madrid Monitor (WIPO), eSearch plus (EUIPO), TMView, and databases of selected national authorities.

Industrial Property Office

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Opening hours of the Public Study and the Information Centre:

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

Patent attorneys and attorneys-at-law:

Patent attorneys and attorneys-at-law provide professional advice and assistance for natural persons and legal entities in matters of industrial property, draw up and file applications, and act as representatives in the procedure before the Office.

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