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Trademarks and Their Legal Protection

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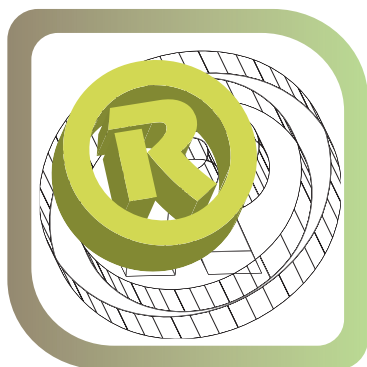
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TRADE MARKS

AND THEIR LEGAL PROTECTION



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INDUSTRIAL PROPERTY OFFICE
OF THE CZECH REPUBLIC





What is a trade mark?

A trade mark is a designation which has, above all, a distinguishing function. Its purpose is to distinguish on the market goods or services of the same kind produced or provided by different manufacturers or service providers. Trade marks help consumers get more easily oriented in the offer of goods and services and choose goods according to their wish. As a result of extensive advertising disseminated particularly by the media, trade marks, as works marks or brands of individual business entities, become an integral part of our everyday life. Problematiku ochranných známek upravují zejména následující právní normy:

- Act No. 441/2003 Coll., on trade marks, as amended;
- Decree No. 97/2004 Coll., implementing the Act on Trade Marks;
- Act No. 634/2004 Coll., on administrative fees.

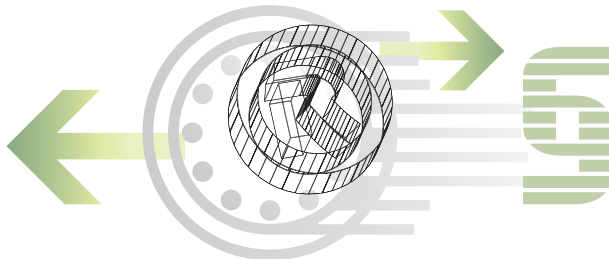
Texts of legal regulations are available on the website of the Industrial Property Office (hereinafter referred to as "Office") at <http://www.upv.cz>.



What can be a trade mark?

A trade mark can be any designation (words, names, drawings, letters, digits, shapes, combinations of these elements) which can be graphically represented (written, drawn) and which is capable of distinguishing goods or services for which it is protected from identical goods or services on the market, provided from other business sources. Therefore, a trade mark cannot exist of its own but always only in conjunction with particular goods it designates or with particular services that are provided under this trade mark.

The applicant files the trade mark application with the Industrial Property Office (hereinafter referred to as "Office"). By filing the application, the applicant acquires the right of priority in respect of the designation applied for vis-à-vis other competitors on the market. The right of property in the trade mark is created only upon its registration in the register of trade marks administered by this Office. The trade mark owner has the exclusive right to designate their goods or services with the trade mark or to use it in connection with these goods or services. Nobody may use a designation identical with or confusingly similar to the owner's trade mark for identical or similar goods or services without the owner's consent.





A trade mark can be a:

- verbal designations with a common form of writing (words, names, a combination of words and digits, etc.);
- verbal designations with a special form of writing;
- figurative designations (drawings);
- combined designations using words and a drawing (logos);
- three-dimensional designations consisting of the shapes of products or their packaging (e.g. bottles);
- combinations of the shape of the product or the packaging with words or a drawing (e.g. a bottle with a label);
- colour on its own or a combination of colours.

In addition to verbal designations with a common form of writing, a trade mark may be applied for, at the applicant's discretion, as a trade mark in black and white or as a colour trade mark. In the case of a colour trade mark, the protection also applies to the colours used and their arrangement.



Which designations cannot be entered in the register of trade marks?

The following designations are excluded from the registration in the register:

- designation that cannot be represented graphically (e.g. signature tunes, special fragrances, TV broadcast);
- designation lacking the capacity to distinguish goods or services;
- designation which consists 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 goods or of rendering of services;
- designation which consists exclusively of signs or indications which have become customary in the current language or in bona fide and established practices of the trade;
- designation which consists exclusively of the shape which results from the nature of the product itself or which is necessary to obtain a technical result or which gives substantial value to the product (the product shape which is generally used or is conditioned by the technical characteristics of the goods);
- designation which is contrary to public order or to accepted principles of morality;
- designation which is of such a nature as to deceive the public, mainly as to the nature, quality or geographical origin of the goods or services;
- designation applied for wines or spirits which contains a geographical indication, where such wines or spirits do not have that geographical origin;

- designation which contains signs protected by virtue of Article 6ter of the Paris Convention for whose registration the consent of the competent authorities has not been given;
- designation which contains badges, emblems and escutcheons other than those mentioned in Article 6ter of the Paris Convention, if their use is the subject of special public interest, unless the competent authority has given its consent to such signs being registered;
- designation which contains signs of high symbolic value, mainly religious symbols;
- designation the use of which is contrary to the provisions of other laws or which is contrary to the obligations of the Czech Republic ensuing from international treaties;
- designation where it is obvious that the trade mark application was not filed in good faith;
- designation which is identical with an earlier trade mark that was applied for or is registered for another person and for identical goods or services, or a designation including elements of an earlier trade mark that could lead to confusion; the applicant can verify this fact even before filing the trade mark application by performing a search;
- designation which encroaches upon third-party rights exercised by means of duly and timely lodged objections against the registration of the trade mark.



Who can apply for a trade mark?

Any natural person or legal entity capable to perform legal acts may apply for a trade mark.

The trade mark application may be filed directly by the applicant, or the applicant may choose a representative for this purpose, especially an attorney or a patent attorney. When filing the application, the representative must present a power of attorney signed by the applicant. If the applicant does not have an enterprise, its permanent residence or registered office in the territory of the Czech Republic, they must file the trade mark application through a member of the Czech Bar Association or the Chamber of Patent Attorneys of the Czech Republic. This condition does not apply if the applicant is a national of the EU or a member state of the EEC (or has the headquarters or seat there), and is established or provides services in the territory of the Czech Republic. These persons must provide an address in the Czech Republic to which official documents concerning the application or the registered trade mark will be sent. All submissions to the Office are in the Czech language.



How to file a trade mark application?

The trade mark application is filed electronically (if signed using an advanced electronic signature or filed through the applicant's data box), in person or by post with the Industrial Property Office.

If the application is filed by fax or electronically without a certified electronic signature, the Office must receive its written original copy within 5 days at the latest.

The application must include:

- request for registration of the trade mark in the register;
- company name and registered office (for a legal entity) or the name and the place of residence (for a natural person) of the applicant;
- wording or the surface representation of the trade mark applied for;
- list of goods or services for which the trade mark is to be registered. The goods or services must be arranged and classified according to the classes of the international classification of goods and services (the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957). The international classification is available on the Office's website at <http://www.upv.cz> (link "Classification systems"). The TMclass electronic database of goods and services (EUIPO) can also be used for the classification purposes.
- signature of the applicant or their representative.

Once the Office receives the application, it marks the date and time of filing. From this point on, the applicant has the right of priority over anyone who subsequently files an application for an identical designation for identical goods or services.

The application may also include:

- name and address of the representative, if the applicant is represented;
- address for delivery, if different from the address of the application or the representative. (The address for delivery cannot be used if the applicant or the representative has a data box and the nature of the documents does not rule out their sending through the data box.)

Application enclosures:

- three representations of the trade mark applied for, size A8 to A4 (except for verbal trade marks applied for with a common form of writing);
- representative's power of attorney, if the applicant is represented.

What is the course of the trade mark application procedure?

The trade mark applicant is obliged to pay the administrative fee within 1 month after filing the application. If the administrative fee is not paid, the application is regarded as not filed.

After the application is filed, the Office shall ascertain whether the application meets all necessary requirements. If it finds defects that would prevent further proceedings (e.g. incorrect classification of the list of goods or services, missing power of attorney), it shall invite the applicant in writing to rectify those defects within the prescribed time limit. The time limit is usually 2 months.

If the applicant fails to respond to the Office's notification and rectify the defects, the Office will reject the trade mark application by its decision. If the application has no such defect or if the applicant rectified the defects, the Office will carry out the so-called substantive examination of the designation applied for, where it ascertains whether the designation applied for is not excluded from the registration in the register. If the designation cannot be registered in the register, the Office will notify the applicant accordingly and the applicant may comment on the Office's notification within the prescribed period of time and remove the obstacle to registration. If the obstacle to registration cannot be removed, the Office will reject the trade mark application by its decision.

A remedial instrument, i.e. an appeal, may be lodged against the decision made by the Office. If the designation applied for is registrable, the trade mark application will be published in the Bulletin of the Office which is published in electronic form once a week. Persons whose earlier acquired rights might be encroached upon by the published designation may lodge objections against the registration of the trade mark in the register within three months from the date of publication. The range of persons entitled to lodge objections is prescribed by the Act on Trade Marks. If objections are lodged, the Office must decide whether these objections are justified and whether the designation being applied for encroached upon the rights of the person who lodged those objections.

If this is the case, the Office shall also reject the trade mark application. If no objections are lodged against the designation applied for within the prescribed period of time or if such objections were rejected as unjustified, the Office registers the designation applied for in the register of trade marks. Based on that, the Office issues to the trade mark owner the trade mark registration certificate.

What is the period of validity of a trade mark?

The term of protection of a registered trade mark is ten years from the date on which the application was filed with the Office. Upon expiration of this term of protection, the trade mark may be renewed always for the next ten years at the request of the trade mark owner. A request for renewal of the trade mark registration is filed using the relevant form no earlier than in the last year of the term of protection but before the date of expiration. The request for renewal of the registration may be filed within six months after the date of expiration for an increased fee. If the request of renewal of the registration is not filed, the trade mark ceases to exist.

What is a collective trade mark?

A collective trade mark is a designation that is capable to distinguish the goods or services of members or partners of a legal entity or parties to an association established for the purpose of collective designation of goods or services from the goods or services of other entrepreneurs. The application for a collective trade mark must be accompanied by a written agreement concluded between all members or partners of a legal entity or between all parties to an association, which lays down the conditions for the use of the collective trade mark, including penalties for their breach.

How to file a trade mark application abroad?

A trade mark registered in the register of trade marks administered by the Office on the basis of a national application is valid only in the territory of the Czech Republic. If the applicant wishes to secure protection of their trade mark also in another state, the applicant has to file the respective trade mark application directly with the registration office of the respective state or to file an application for international registration of the trade mark with the Office under the conditions set out below. The third option is to file the European Union trade mark application for the entire territory of the European Union which can be filed with the European Union Intellectual Property Office (EUIPO) in Alicante, Spain. Detailed information is available at <http://oami.europa.eu>.

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 in some other countries on the basis of two international treaties to which the Czech Republic is a contracting party, namely the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating to that Agreement.

The Madrid Agreement and the Protocol relating to that Agreement provide nationals of the contracting parties with the possibility to protect their trade marks in all contracting states to the Madrid Agreement and/or the Protocol on the basis of a single application filed with the International Bureau of the World Intellectual Property Organization in Geneva (hereinafter referred to as "International Bureau") through the applicant's respective registration office of origin.

The form of the application for international registration of the trade mark, the list of contracting parties to both international treaties, the filing instructions and the schedule of fees set by the International Bureau are available in the Information Centre and on the Office's website. The applicant only completes the application for international registration of the trade mark and files it with the Office which, based on this application, prepares an international application for a trade mark. In addition to the administrative fee paid to the Office, the applicant must pay registration fees in Swiss francs directly to the International Bureau.

In the case of a trade mark application, the right of priority in respect of a trade mark application in the Czech Republic may be exercised before the International Bureau provided that the international application is filed with the International Bureau within six months after filing the application in the Czech Republic. The international registration can be made on the basis of the filing of the trade mark application in the Czech Republic, without it having to be already registered in the register of trade marks in the Czech Republic. However, such international registration is dependent on the subsequent registration of the trade mark in question in the Czech Republic. This means that if the trade mark is not registered and the trade mark application procedure in the Czech Republic results in the rejection of the trade mark or in the

discontinuation of the application procedure, the respective international registration in the international register of trade marks administered by the International Bureau will be cancelled. The extent of cancellation must always correspond to the resulting state of the basic national application. Therefore, if a national application is rejected in the Czech Republic only for a part of the list of goods or services applied for, also the international registration of the trade mark will be rejected only for the corresponding part of the list of goods or services and will remain valid for the remaining goods or services.

After the registration in the international register of trade marks of the trade mark for which an international application was filed, the International Bureau communicates the international registration of the trade mark to all contracting states of the Madrid Agreement and/or the Protocol relating to this Agreement in which the international trade mark applied for protection, i.e. those which are designated in the international application of the trade mark. The contracting states may refuse, within one year of the date of notification of international registration, to protect the international trade mark applied for in those states if it is inconsistent with their national rules.

The term of protection of an international trade mark is ten years, it can be renewed always for the next ten years.

After effecting the international registration of the trade mark, its owner may, at any time during the term of validity of the international registration, file this trade mark in other contracting states of the Madrid Agreement and the Protocol in the form of the so-called subsequent designation of other contracting states.

The international registration of a trade mark is dependent, for the period of five years, on the existence of the registration of the same trade mark in the Czech Republic. If this trade mark ceases to exist (due to expiration of the term of validity, waiver of the owner's rights, declaring the trade mark invalid) within five years from the date of the international registration, its international registration in the international register will also be cancelled. This shall also apply if the waiver of the rights to the trade mark by the owner, its cancellation or declaring the trade mark as invalid applies only to a part of goods and/or services for which the national trade mark is registered. If the event of cancellation of international registration for the reason of dependence on the basic national registration or on the basic national application, the owner is entitled, within three months from the date of cancellation to request conversion of international registration to national applications for trade marks in the designated contracting states. Conversion is requested directly with the registration offices of the individual states which are obliged in such case to recognize the date of international registration of the trade mark as the date of the filing of the national application.

Detailed information about the conditions and the course of the international registration is available at WIPO's website www.wipo.int, in the Trademarks section.

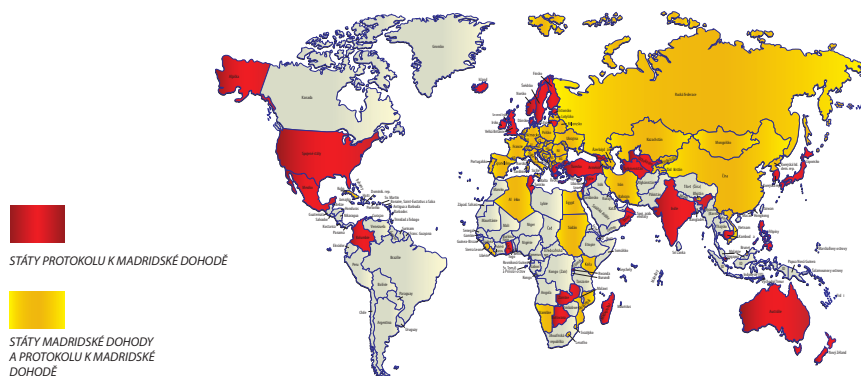
From 1 October 2004, the applicant can apply for a trade mark, in the form of an international registration, also for the European Union as a whole by designating the European Union in the application for international registration. The European Union Intellectual Property Office (EUIPO) in Alicante decides on the protection of the trade mark in the territory of the

European Union. If EUIPO refuses to grant the protection to the international trade mark for the territory of the European Union or if the effects of international registration of the trade mark for the European Union cease to exist (e.g. due to the annulment of the trade mark), the applicant may file a request for conversion of the designation of the European Union as a whole to the subsequent designation of the international registration of the trade mark for individual member states of the European Union of their choice. The applicant can also decide whether they will request subsequent designation in member states for the whole list of goods or services, or for a part thereof only. Furthermore, the applicant may decide for conversion of the designation of the European Union in the international registration of the trade mark to national applications in the individual member states. In that case, the applicant files a request for conversion directly with the registration offices of those states pursuant to the European Union Trade Mark Regulation.

The applicant files the request for conversion of the designation of the European Union to the subsequent designation of member states with the International Bureau through EUIPO within the time limit set by the European Union Trade Mark Regulation, i.e. within three months from the date on which decisive facts occurred (e.g. issuance of the notification of refusal of protection by EUIPO). The request is filed on a special form of the International Bureau of the World Intellectual Property Organization MM16 which is available at www.wipo.int. The date on which the date of the designation of the European Union was entered in the international register will be recognized for the subsequent designation of member states.

As a result of the said conversion, the registration offices of the selected member states of the European Union will decide on the grant or refusal of the protection for the international trade mark in question in accordance with their own trade mark regulations.

If the trade mark owner wishes to obtain protection for the trade mark in a state which is not a contracting state of the Madrid Agreement and/or the Protocol relating to that Agreement, the trade mark owner must apply for its registration using the so-called national route, i.e. directly with the industrial property office of that state, usually through the local authorized



representative and in accordance with the trade mark regulations of that state. In this way, trade marks can be applied for even in individual states which are members of the Madrid Agreement and/or the Protocol relating to that Agreement, as well as in the individual states of the European Union.



What are the basic administrative fees?

For filing an application	-	individual TM	5,000 CZK
	-	collective TM	10,000 CZK

This fee includes a list of goods or services in the extent of three classes of the international classification of goods and services. If the list of goods or services in the application contains more than three classes of the international classification, an additional fee in the amount of 500 CZK for each additional class must be paid in addition to this amount (e.g. if the application contains a list of goods or service in five classes of the international classification, the total amount of the fee will be 6,000 CZK).

For filing a request for renewal	-	individual TM	2,500 CZK
	-	collective TM	5,000 CZK

If the request for renewal is filed within six months after the expiration of the term of protection, these fees will increase to 5,000 CZK for an individual trade mark and 10,000 CZK for a collective trade mark.

For filing an application for international registration of TM	2,500 CZK
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Registration fees in Swiss francs, paid to the International Bureau of the World Intellectual Property Organization in Geneva, are specified in a special schedule of fees which is available in the Information Centre and on the website www.wipo.int, including the calculator.

Fees paid to the European Union Intellectual Property Office are specified on that office's website: <https://oami.europa.eu/ohimportal/en/fees-and-payments>.

Trade mark search

An interested party may order with the Office processing of search for verbal, figurative and combined trade marks, not only for the territory of the Czech Republic (i.e. national trade marks, international trade marks designating the Czech Republic and the European Union, and the European Union trade marks), but also for the territory of the selected countries of the whole world.

This is an informative search which does not include the Office's statement concerning the registrability of the designation in question nor the possible risks associated with the possible filing of the trade mark application. Still, the search may help the prospective applicant to gain a general knowledge of existing earlier rights that could affect the trade mark application procedure.

An order for a trade mark search valid in the territory of the Czech Republic as well as abroad can only be submitted in writing. The price includes a flat fee for the processing and print outputs in accordance with the price list of services provided by the Office, plus postage and packing charges. The standard term for the processing of a search is 30 days, express processing (within 3 days or 24 hours) can be requested for an extra charge.

Searches are performed in sources freely available on the Internet (national offices' databases) or in the commercial database Corsearch.

A historical search for a lapsed trade mark can also be performed.

For more detailed information, you can contact employees from the Patent Information Department (email: objednavky@upv.cz, tel.: 220 383 430).



Where can I get further information?

Public reading room

Information Centre

Employees of the Information Centre are ready to answer your questions related to the protection of industrial property, to provide general information on the individual institutes of industrial law, on formal requirements for applications or the circumstances of proceedings concerning these applications, on administrative fees and performance of searches. The Information Centre can be visited personally every working day or you can call 220 383 120.

Internet

You can get information about the activities and services of the Office also on the Internet at www.upv.cz.

On its website, the Office provides access to information about the individual subject matters of industrial property, provided services, relevant legal regulations and activity of the Industrial Property Training Institute. The presentation of the individual subject matters of industrial property includes the relevant electronically fillable application forms which can be used for online filing.

Trade mark databases are available to the public on the Office's website, in which informative searches can be performed for free. There is a database of trade marks with the effect in the territory of the Czech Republic which includes both national trade marks, international trade marks with designation CZ and EM, and the European Union trade marks. Furthermore, there are links here to some foreign databases, such as ROMARIN (WIPO), eSearch plus (EUIPO), TMView and databases of selected national offices.

Industrial Property Office

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224 311 566 (public reading room)
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Internet: www.upv.cz

Office hours of the public reading room and the Information Centre:

Monday 8:00 a.m. – 5:00 p.m.
Tuesday 8:00 a.m. – 4:00 p.m.
Wednesday 8:00 a.m. – 5:00 p.m.
Thursday 8:00 a.m. – 4:00 p.m.
Friday 8:00 a.m. – 2:30 p.m.

Attorneys and patent attorneys:

Attorneys and patent attorneys provide expert advice and assistance to natural persons and legal entities in industrial property matters, arrange preparation of applications, their filing and representation in proceedings before the Office.

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