

# **TRADEMARKS ACT**

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(UNOFFICIAL CLEAR TEXT)

## **Part One: BASIC PROVISIONS**

### SCOPE OF APPLICATION

#### Article 1

This Act shall apply to individual, collective and guarantee trademarks which are the subject of a registration or an application for the registration of a trademark filed with the State Intellectual Property Office of the Republic of Croatia (hereinafter: "the Office"), or of an international registration having effect in the Republic of Croatia.

### SIGNS WHICH CAN BE PROTECTED AS TRADEMARKS

#### Article 2

Any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, three-dimensional forms, colors, as well as the combinations of all the above indicated signs, may be protected as a trademark, provided that such signs are capable of distinguishing the goods or services of one undertaking from goods or services of another undertaking.

### PERSONS WHO MAY BE HOLDERS OF A TRADEMARK

#### Article 3

(1) Any natural or legal person may be a holder of a registered trademark or an applicant for the registration of a trademark.

(2) Foreign legal and natural persons not having a principle place of business or a domicile or a habitual residence, respectively, in the Republic of Croatia shall, under this Act, enjoy the same rights as are enjoyed by the persons having a domicile or a real and effective industrial or commercial principle place of business in the Republic of Croatia, if it results from the international treaties binding the Republic of Croatia or from the application of the principle of reciprocity.

### ACQUISITION OF A TRADEMARK

#### Article 4

(1) In the Republic of Croatia a trademark shall be acquired by registration.

(2) For the purposes of this Act, "registration" shall mean entry of a trademark in the trademark register kept by the Office.

### ABSOLUTE GROUNDS FOR REFUSAL

#### Article 5

(1) The following shall not be registered:

1. signs, which may not be protected as trademarks in accordance with the requirements set out in Article 2 of this Act,
2. signs, which are devoid of any distinctive character in relation to the goods or services for which registration is requested,
3. signs 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 providing of the service, or to designate other characteristics of the goods or services,
4. signs which consist exclusively of signs or indications which have become customary in the everyday language or in good faith and the established practices of trade,
5. signs which consist exclusively of the shape which results from the nature of the goods as such, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods,
6. signs which are contrary to public policy or to accepted principles of morality,
7. signs 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,
8. signs which have not been authorized by the competent authorities and are to be refused pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property (hereinafter: “the Paris Convention”),
9. signs for wines which contain or consist of geographical indications identifying wines and signs for spirits which contain or consist of geographical indications identifying spirits with respect to such wines or spirits not having that geographical origin,
10. signs which contain the name or abbreviation of the name, national coat of arms, emblem, flag or other official sign of the Republic of Croatia, or a part thereof, and the imitation thereof, except with the authorization of the competent authority of the Republic of Croatia,
11. signs which contain or consist of designations of origin or geographical indications, in effect in the territory of the Republic of Croatia, if a request for the registration of a trademark has been filed after the filing date of a request for the registration of a designation of origin or a geographical indication within the scope provided by legislation, by virtue of which such designations are registered, and which refer to the same type of products and services.

(2) Registration shall not be refused to signs specified in paragraph (1) items 2, 3 and 4 of this Article, if the applicant for the registration of a trademark proves that the sign has, before the date of filing of the application for the registration and following the use which has been made of it, acquired a distinctive character in respect of the goods or services for which registration is requested.

## RELATIVE GROUNDS FOR REFUSAL

### Article 6

- (1) Upon an opposition as filed, a sign shall not be registered:

1. if it is identical with an earlier trademark registered for identical goods or services,
2. if because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services, there is a likelihood of confusion on the part of the public, which includes the likelihood of its association with the earlier trademark.

(2) For the purposes of this Act, “earlier trademark” shall mean:

1. trademarks registered in the Republic of Croatia, enjoying earlier priority right referred to in Articles 17, 18 and 19 of this Act,
2. trademarks registered under international treaties, having effect in the Republic of Croatia, and enjoying earlier priority right referred to in Articles 17, 18 and 19 of this Act,
3. applications for the registration of trademarks referred to in item 1 of this paragraph, provided that the trademarks become registered,
4. trademarks which, on the date of application for the registration of a trademark, or, if priority is claimed, on the date of priority right claimed in the application, are well known in the Republic of Croatia, in the sense in which the words “well known” are used in Article 6bis of the Paris Convention.

(3) Upon opposition as filed by the holder of an earlier trademark, a sign shall not be registered if it is identical with, or similar to, an earlier trademark and the registration has been requested for goods or services which are not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Republic of Croatia and where the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trademark.

(4) Upon opposition as filed, a sign shall not be registered if its use would infringe one of the following earlier rights:

1. a right to a personal name,
2. a right of personal portrayal,
3. a copyright,
4. industrial property rights.

(5) For the purposes of this Act, “earlier right” shall mean rights acquired on the date which is earlier than the date of application for the registration of a trademark, or, if priority right is claimed, as from the date of priority claimed in the application.

(6) On the basis of opposition as filed, a sign shall not be registered if its use would infringe the right of the person who, at the time of filing of an application for the registration of a trademark, had a firm, provided that such firm or the essential part thereof is identical with or similar to the sign in respect of which the application is filed and provided that identical or similar goods or services are the subject matter of the firm’s activity, unless the applicant had the identical or similar firm at the time of filing the application for registration of a trademark.

(7) On the basis of opposition as filed, a sign shall not be registered if it is identical with, or similar to, an earlier trademark which was registered for identical or similar goods or services and conferred on them a right which has expired for failure to renew the registration

of the trademark within a period of not more than two years as from the expiry of the trademark, unless the holder of the earlier trademark gave his consent for the registration of the later trademark or did not use his trademark.

(8) Upon an opposition as filed, a sign shall not be registered in the name of a trade agent or representative of a trademark holder without his authorization, unless a trade agent or representative justifies his action.

## **Part Two: EFFECTS OF A TRADEMARK**

### **RIGHTS CONFERRED BY A TRADEMARK**

#### Article 7

(1) A registered trademark shall confer on its holder the exclusive rights therein.

(2) The holder shall be entitled to prevent all third parties not having his authorization from using in the course of trade:

1. any sign which is identical with his trademark in relation to goods or services which are identical with those for which the trademark is registered,

2. any sign where, because of its identity with, or similarity to, his trademark and the identity or similarity of the goods or services covered by the trademark and the sign, there is a likelihood of confusion on the part of the public, which includes the likelihood of association of the sign with the trademark,

3. any sign which is identical with, or similar to, his trademark in relation to goods or services which are not similar to those for which the trademark is registered, where the trademark has a reputation in the Republic of Croatia and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark.

(3) Within the meaning of paragraph (2) of this Article, the holder of a trademark may also prohibit the following:

1. affixing the sign to the goods or to the packaging thereof,

2. offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or providing services thereunder,

3. importing or exporting the goods under the sign,

4. using the sign on business papers and in advertising.

(4) The rights conferred by a trademark shall have effect against third parties as from the date of publication of the registration of a trademark.

### **REPRODUCTION OF A TRADEMARK IN DICTIONARIES**

#### Article 8

If the reproduction of a trademark in a dictionary, encyclopedia or similar publications, including those in electronic form, gives the impression that the trademark constitutes the generic name of the goods or services for which it is registered, the publisher of the work shall, on request of the holder of the trademark, ensure that the reproduction of the trademark

is, at the latest in the next edition of the publication, accompanied by a note that it is a registered trademark.

## PROHIBITION OF THE USE OF A TRADEMARK REGISTERED IN THE NAME OF A TRADEMARK REGISTERED IN THE NAME OF A TRADE AGENT OR A REPRESENTATIVE

### Article 9

Where a trademark is registered in the name of the trade agent or a representative of a holder of the trademark, without the holder's authorization, the holder shall be entitled to prohibit the use of this trademark by the agent or representative.

## LIMITATION OF THE EFFECTS OF A TRADEMARK

### Article 10

(1) A trademark shall not entitle its holder to prohibit a third party from using, in the course of trade: his own name or address, indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of providing of a service, or indications concerning other characteristics of goods or services.

(2) A trademark shall not entitle its holder to prohibit a third party from using, in the course of trade the trademark where it is necessary to indicate the intended purpose of a product or a service, in particular as accessories or spare parts, provided that such sign is used in accordance with established and honest practices in industrial or commercial activity and fair competition.

(3) A trademark shall not entitle the holder of the trademark to prohibit a third party from using, in the course of trade , an earlier right which only applies in a particular locality if that right is recognized by the laws of the Republic of Croatia and within the limits of the territory in which it is recognized.

## EXHAUSTION OF THE RIGHTS

### Article 11

(1) The placing on the market in the territory of the Republic of Croatia, or, after the accession of the Republic of Croatia, or, after the accession of the Republic of Croatia into the full membership of the European Union, in the territory of any of the States of the European Union, or States Parties to the Agreement on the European Economic Area, of a product designated by a trademark, by the holder of the trademark, or with his express authorization, shall exhaust for the territory of the Republic of Croatia, the exclusive rights conferred by the trademark in respect to such a product, unless there are justified reasons for the holder of the trademark to retain the exclusive rights conferred by the trademark.

(2) The justified reasons for the holder of the trademark to oppose further commercialization of the product shall exist, especially where the condition of the product is changed or impaired after it has been put on the market.

## LIMITATION OF RIGHTS IN CONSEQUENCE OF ACQUIESCENCE

### Article 12

(1) Where the holder of an earlier trademark has acquiesced, within a continuous period of five years, in the use of a later trademark while being aware of such use, he shall no longer be entitled on the basis of the earlier trademark either to file a request for a declaration that the later trademark is invalid or to oppose the use of the later trademark in relation to the goods or services for which the later trademark has been used, unless the registration of the later trademark was applied for in bad faith.

(2) Paragraph (1) of this Article shall also apply to the holders of earlier rights referred to in Article 6 paragraphs (4) or (6) of this Act.

(3) In the cases referred to in paragraphs (1) and (2) of this Article, the holder of a later registered trademark shall not be entitled to oppose the use of the earlier right, even though the holder of the earlier right may no longer invoke that right against the later trademark.

## **Part Three: USE OF A TRADEMARK**

### USE OF A TRADEMARK

#### Article 13

(1) A holder of a trademark shall be entitled to use a trademark in relation to the goods or services for which it is registered.

(2) The following shall also constitute the use within the meaning of paragraph (1) of this Article:

1. use of the trademark in a form differing in elements which do not alter the distinctive character of the trademark in respect of the form in which it was registered,

2. affixing of the trademark to goods or to the packaging thereof in the Republic of Croatia concerned solely for export purposes.

(3) Use of the trademark with the authorization of the holder or by any person who has authority to use a collective mark or a guarantee mark shall be deemed to constitute use by the holder.

(4) If, within a continuous period of five years following the date of registration, the holder has not put his trademark to genuine use in the Republic of Croatia in relation to the goods or services for which it is registered, or if such use has been suspended during an uninterrupted period of five years, the consequences of such non-use are prescribed in Article 29, Article 46 paragraph (2) and Article 51 paragraph (5) of this Act, unless there are justified reasons for non-use.

## **Part Four: APPLICATION FOR THE REGISTRATION OF A TRADEMARK**

### FILING OF AN APPLICATION

#### Article 14

(1) An application for the registration of a trademark shall be filed with the Office.

(2) An applicant cannot, by one application, request registration of more than one sign for which trademark protection is sought.

## REQUIREMENTS WHICH AN APPLICATION MUST COMPLY WITH

### Article 15

(1) An application for the registration of a trademark shall contain:

1. a request for the registration of a trademark,
2. information about the applicant,
3. a list of the goods or services for which the registration is requested,
4. a representation of the sign of which the registration is requested.

(2) An application for the registration of a trademark shall be considered to have been filed if it complies with the requirements set out in paragraph (1) of this Article.

(3) Other elements of the application and the attachments thereto shall be filed in accordance with the Regulations on Trademarks (hereinafter: „the Regulations“).

## CLASSIFICATION

### Article 16

The goods or services in relation to which an application for the registration of a trademark is filed shall be classified in conformity with the International Classification of Goods and Services established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

## APPLICATION FILING PRIORITY

### Article 17

(1) If the application for the registration of a trademark is filed in accordance with Article 15 paragraph (1) of this Act, the applicant for the registration of the trademark shall acquire the right of priority on the basis of the application filing date over any other applicant filing later an application for the identical or similar sign for which the registration for the identical or similar goods or services is requested.

(2) Every application filed under multilateral agreements to which the Republic of Croatia is a party also gives rise to a right of priority.

## UNION PRIORITY RIGHT

### Article 18

(1) If the applicant for the registration of a trademark has filed the application for the first time in a Member State of the Paris Union for the Protection of Industrial Property (hereinafter: "the Paris Union") or in a Member State of the World Trade Organization, he may, when filing the application for the same trademark in the Republic of Croatia, invoke the date of the first filing, provided that he files the application in the Republic of Croatia within six months from the date of the first filing.



(2) The applicant invoking the union priority right shall indicate, in the application he is filing with the Office, the relevant data on the application he is invoking (State, date and number of the application) and shall attach thereto a true copy of the first application certified by the competent authority of the Member State of the Paris Union or the Member State of the World Trade Organization not later than within three months from the date of filing a priority claim, and the translation of the first application into Croatian.

## EXHIBITION PRIORITY RIGHT

### Article 19

(1) If the applicant for the registration of a trademark has displayed the goods or services designated by a specific sign at an official or officially recognized international exhibition in the Republic of Croatia, in any of the Member States of the Paris Union or in any of the Member States of the World Trade Organization, he may request that the date of the first day of the exhibition of the goods or of providing of the services be accorded as the date of the first application, provided that he files the application in the Republic of Croatia within six months as from that date.

(2) The applicant invoking the exhibition priority right shall, in addition to the application he is filing with the Office, submit a certificate issued by the competent authority of the Member State of the Paris Union or the Member State of the World Trade Organization indicating the type of the exhibition, the venue thereof, its opening and closing dates and the first day of the exhibition of the goods or services specified in the application.

## **Part Five: PROCEDURE FOR THE REGISTRATION OF A TRADEMARK**

### THE OFFICE AUTHORITY

#### Article 20

(1) The Office shall carry out the administrative procedures for the registration of a trademark, procedures for the declaration that a trademark is invalid, and shall perform other administrative and professional tasks concerning the protection of trademarks.

(2) The decisions issued by the Office cannot be appealed, but an administrative dispute can be instituted before the Administrative Court in Zagreb.

(3) The procedure referred to in paragraph (2) of this Article is urgent.

### EXAMINATION OF THE CORRECTNESS OF THE APPLICATION

#### Article 21

(1) The examination of the correctness of the application shall include the examination of compliance with all the requirements prescribed by this Act and the Regulations.

(2) The application for the registration of a trademark shall be correct:

1. if it is filed in accordance with Article 14 paragraph (2) of this Act,
2. if it is filed in accordance with the requirements set out in Article 15 paragraphs (1) and (3) of this Act.

## REMEDYING THE DEFICIENCIES OF THE APPLICATION

### Article 22

(1) If the application for the registration of a trademark complies with the requirements set out in Article 15 paragraph (1) of this Act, but is not filed in a way to contain all the necessary elements and attachments in accordance with the Regulations, the Office shall order the applicant by conclusion to remedy the deficiencies within 60 days upon receipt of the conclusion.

(2) If the applicant remedies the deficiencies in the application in accordance with the conclusion referred to in paragraph (1) of this Article within the prescribed time limit, the application shall be considered to be correct as from the beginning.

(3) If the application does not comply with the requirements set out in Article 15 paragraph (1) of this Act, it shall not be considered as the application for the registration of a trademark, and the Office shall order the applicant by conclusion to remedy all the found deficiencies within 60 days as from the day of receipt of the conclusion.

(4) The date of receipt of the application corrected within the meaning of paragraph (3) of this Article shall be considered to be the date for establishing the priority right referred to in Article 17 of this Act.

(5) On request of the applicant, the time limit laid down in paragraphs (1) and (3) of this Article may be extended for not more than 60 days.

## REJECTION OF THE APPLICATION

### Article 23

If the applicant for the registration of a trademark does not, within the prescribed time limit, comply with the conclusion sent by the Office and does not remedy the found deficiencies within the meaning of Article 22 paragraphs (1) and (3) of this Act, the application shall be rejected by a decision.

## REFUSAL OF THE REGISTRATION OF A TRADEMARK

### Article 24

(1) If the Office finds that any of the reasons for the refusal of a trademark according to Article 5, paragraph (1) of this Act exists, it shall notify the applicant for the registration of a trademark in writing of the grounds for refusal and shall invite him to file observations and to submit evidence on the possible new facts that might influence the final decision of the Office.

(2) The applicant shall have the right to act according to paragraph (1) of this Article within 60 days from the day of the receipt of the written notification of the grounds for refusal of the registration.

(3) On request of the applicant, the time limit referred to in paragraph (2) of this Article may be extended for not more than 60 days.

(4) If the applicant for the registration of a trademark fails to file within the prescribed time limit his observations on the notification of the grounds for refusal of the registration in

respect of all the goods or services for which the registration has been applied for, or fails to challenge the grounds for such refusal, a decision on the total refusal of the registration shall be issued.

(5) If the applicant for the registration of a trademark fails to file within the prescribed time limit his observations on the notification of the partial refusal of the registration of a trademark, or if in the course of the procedure concerning the observations on the notification of the grounds for refusal of the registration in respect of all the goods or services for which registration has been applied for, it has been found that a sign does not comply with the requirements for registration in respect of only some of the goods or services for which the registration has been applied for, a partial decision on the refusal of the registration shall be issued.

## PUBLICATION OF THE APPLICATION

### Article 25

(1) If all the requirements set out in Article 21 paragraph (2) of this Act are complied with, if there are no grounds for refusal of the registration under Article 5 paragraph (1) of this Act, the application data shall be published in "The Croatian Intellectual Property Gazette" (hereinafter: "the Office official gazette").

(2) Where the registration of a trademark is partially refused in accordance with Article 24 paragraph (5) of this Act, the application data relating to the goods or services for which the registration applied for may be granted shall be published after this partial decision becomes final.

(3) The application data to be published in the Office official gazette shall be prescribed by the Regulations.

## OPINIONS BY THIRD PARTIES

### Article 26

(1) Following the publication of an application for the registration of a trademark, any natural or legal person and any group or body representing manufacturers, providers of services, traders or consumers, may submit to the Office, within a period of three months from the date of publication of the application for the registration of a trademark, their written opinions, explaining, in particular, the grounds referred to in Article 5 paragraph (1) of this Act.

(2) The persons, groups or bodies referred to in paragraph (1) of this Article shall not be considered parties to the proceedings.

(3) The Office shall send the opinions referred to in paragraph (1) of this Article to the applicant for the registration of a trademark who may submit his observations thereon within 15 days as from the day of receipt of a copy of the opinion.

## OPPOSITION

### Article 27

(1) Within a period of three months from the date of publication of an application for the registration of a trademark, entitled to file with the Office an opposition to registration of the trademark, which may be based only on the grounds for refusal referred to in Article 6 of this Act, shall be:

1. in respect of Article 6 paragraphs (1) and (3) of this Act, the holder of an earlier trademark and the licensee in accordance with Article 39 paragraph (4) or (5) of this Act,
2. the holder of any of the rights referred to in Article 6 paragraph (4) of this Act,
3. the person who had a firm within the meaning of Article 6 paragraph (6) of this Act,
4. the holder of an earlier trademark within the meaning of Article 6, paragraph (7) of this Act,
5. the holder of an earlier trademark within the meaning of Article 6, paragraph (8) of this Act.

(2) If, on the date of publication of an application, the earlier trademark, on which the opposition is based, is subject to a pending revocation procedure or a pending procedure for a declaration that the trademark is invalid, the Office shall suspend the opposition procedure until the decision from the earlier initiated revocation procedure or the procedure for a declaration that the trademark is invalid has become final.

(3) The time limit for filing the opposition, laid down in paragraph (1) of this Article, shall not be extended, nor shall it be possible, after the expiry of this time limit, to submit additions to the opposition, which include submissions of additional evidence and documentation supporting the justification of the grounds specified in the opposition.

(4) The opposition shall be filed under conditions and in the manner as prescribed by the Regulations.

## OPPOSITION PROCEDURE

### Article 28

(1) The Office shall examine whether the opposition is filed by the person entitled to file the opposition within the meaning of Article 27 paragraph (1) of this Act, whether the opposition is filed within the prescribed time limit and whether it is filed as prescribed by the Regulations.

(2) If the requirements set out in paragraph (1) of this Article are not complied with, the Office shall reject the opposition by a decision.

(3) If the requirements set out in paragraph (1) of this Article are complied with, the Office shall notify the applicant of the opposition as filed, and shall send him a copy of the opposition, inviting him to submit his observations on the opposition within 60 days from the day of receipt of the notification.

(4) The time limit referred to in paragraph (3) of this Article shall not be extended, nor shall it be possible, after the expiry of this time limit, to submit additions to the observations on the opposition, which include submissions of additional evidence and documentation.

(5) If the applicant does not submit his observations on the opposition within the prescribed time limit, the requested registration of the trademark shall be refused within the limits of the requests referred to in the opposition.

(6) If the Office considers it necessary, it may provide for oral hearings to be held in the opposition procedure.

## EXAMINATION OF THE OPPOSITION

### Article 29

(1) If the applicant for the registration of a trademark submits his observations on the opposition within the prescribed time limit, the Office shall examine the justification of the grounds specified in the opposition.

(2) If the applicant for the registration of a trademark so requests, the holder of an earlier trademark who has filed the opposition to the registration shall furnish proof that, during the period of five years preceding the date of publication of the application, he has used the trademark in the Republic of Croatia within the meaning of Article 13 paragraphs (2), (3) and (4) of this Act, for the goods or services in respect of which it is registered and which he cites as justification for the opposition, or he shall furnish proof that there are justified reasons for non-use, provided that the earlier trademark has, on the date of publication of the application for the registration of the trademark, been registered for not less than five years.

(3) The Office shall transmit a copy of the observations on a request for the proof of use furnished by the holder of an earlier trademark to the applicant for the registration of a trademark and shall invite him to file his observations within a period of 30 days from the day of receipt of the invitation.

(4) If the holder does not prove the use of his trademark within the meaning of paragraph (2) of this Article, the opposition shall be refused.

(5) If the earlier trademark has been used in relation to a part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

(6) If, in the examination procedure concerning the opposition, the Office finds that the opposition is unjustified, it shall be refused and the decision to that effect shall be sent to the applicant and to the opponent.

(7) If, in the examination procedure concerning the opposition, the Office finds that the opposition is justified, the registration of the trademark shall be refused or partially granted, and the decision to that effect shall be sent to the applicant and to the opponent.

(8) The applicant for the registration of a trademark and opponent may, in a request signed by both of them and filed in the course of the examination procedure concerning the opposition, request the Office to suspend the examination procedure concerning the opposition for the purpose of attempting to reach a settlement.

(9) The Office shall continue the examination procedure concerning the opposition on request either of the applicant for the registration of a trademark or the opponent, and not later than within a period of 24 months from the filing of the first request referred to in paragraph (8) of this Article, if the procedure has not been concluded up to the expiry of that period.

## WITHDRAWAL OF THE APPLICATION AND RESTRICTION OF THE LIST OF GOODS OR SERVICES

### Article 30

(1) The applicant for the registration of a trademark may at any time withdraw his application or restrict the list of goods or services contained therein.

(2) If the application has already been published, the withdrawal of the application or restriction of the list of goods or services shall be published in the Office official gazette later on.

(3) If the applicant for the registration of a trademark restricts the list of goods and services after an opposition to the registration of a trademark as filed, the Office shall notify the opponent of the restriction of the list of goods or services, and shall invite him to state whether he insists on the opposition as filed, within a period of 15 days from the day of receipt of the invitation. If the opponent fails to notify the Office that he insists on the opposition as filed, the Office shall consider that he has withdrawn his opposition, and shall discontinue the opposition procedure.

## AMENDMENTS TO THE APPLICATION FOR THE REGISTRATION OF A TRADEMARK

### Article 31

(1) On request of the applicant for the registration of a trademark or ex officio, amendments to the application can be made only in cases where it is necessary to correct the name or address of the applicant, errors of wording or of copying, or to correct some other obvious mistakes, provided that such amendments do not require extension of the list of goods or services.

(2) The representation of a sign that is applied for shall not be altered, except where it includes the name and address of the applicant for the registration of a trademark. In that case, on request of the applicant, an alteration, not substantially affecting the identity of the sign as originally entered in the register, may be entered in the register.

(3) If the application for the registration of a trademark has already been published, the amendments to the application shall be published in the Office official gazette later on, subject to the prior payment of the prescribed procedural charges.

## REGISTRATION OF THE TRADEMARK

### Article 32

(1) If the grounds referred to in Article 5 paragraph (1) and Article 6 of this Act do not constitute a barrier to the registration, the Office shall order the applicant by a conclusion to

pay the prescribed procedural charges for the maintenance of the trademark for the first ten-year period and for the publication of the trademark data within a period of 30 days from the day of receipt of the conclusion.

(2) If the procedural charges referred to in paragraph (1) of this Article are not paid, the application for the registration of a trademark shall be rejected by a decision.

(3) If the charges referred to in paragraph (1) of this Article are paid on time, a trademark shall be entered in the Register of Trademarks.

## DIVISION OF THE APPLICATION AND THE REGISTRATION

### Article 33

(1) Any application or a registration of a trademark may be, on request of the applicant or the holder of the trademark, divided into two or several applications or registrations in respect of the list of the goods or services covered by the application or the registration.

(2) The divisional applications or registrations shall maintain the priority right from the first application or the registration.

(3) The procedure of division of an application or a registration shall be prescribed by the Regulations.

(4) The data concerning divisional applications or registrations shall be entered in the register and published in the Office official gazette.

## PUBLICATION OF THE TRADEMARK

### Article 34

(1) The data concerning a trademark shall be published in the Office official gazette not later than within three months from the date of entry of the trademark in the register.

(2) The data to be published in the Office official gazette shall be prescribed by the Regulations.

## TRADEMARK CERTIFICATE

### Article 35

(1) On request of the holder of a trademark, and subject to the prior payment of the prescribed procedural charges for the issuance of the trademark certificate, the Office shall issue the certificate to the holder of the trademark after the publication of a registered trademark in the Office official gazette.

(2) The data to be contained in the trademark certificate shall be prescribed by the Regulations.

## AMENDMENTS TO THE REGISTRATION OF A TRADEMARK

### Article 36

(1) On request of the holder of a trademark or ex officio, amendments to the registration of a trademark can be made only in cases where it is necessary to correct the name or address

of the holder of the trademark, and errors of wording or of copying, or to correct some other obvious mistakes, provided that such amendments do not require extension of the list of goods or services.

(2) The representation of a trademark shall not be altered during the period of registration or on renewal thereof, except where it includes the name and address of the holder. In that case, on request of the holder, an alteration, not substantially affecting the identity of the trademark as originally entered in the register, may be entered in the register.

(3) Where the registration has already been published, the amendments to the registration shall be published in the Office official gazette later on, subject to the prior payment of the prescribed procedural charges.

## CONTINUED PROCESSING

### Article 36a

(1) If the applicant for a trademark registration or the holder of a trademark has failed to comply with a time limit for an act in a procedure before the office, and that failure has the direct consequence of causing the loss of rights conferred by the trademark application or trademark, he may file a request for the continued processing with respect to the trademark application or trademark. The Office shall authorize the continued processing provided that the applicant:

1. files a request for the continued processing and performs all the omitted acts within the prescribed time limit, referred to in paragraph (2) of this Article, and
2. pays the administrative fee and procedural charges.

(2) A request for the continued processing may be filed within two months from the day on which he learned about the legal consequences referred to in paragraph (1) of this Article.

(3) If the omitted acts have not been performed within the time limit referred to in paragraph (2) of this Article, a request for the continued processing shall be rejected by a decision.

(4) A request for the continued processing shall not be filed, if failure to comply with concerns the time limit:

1. referred to in paragraph (2) of this Article,
2. for filing the request referred to in Article 18 and Article 19 of this Act,
3. for filing the request referred to in Article 44 of this Act,
4. for filing a request for restitution in integrum pursuant to the provisions of the Act on General Administrative Proceedings,
5. for all the acts in the procedures before the Office involving several parties.

(5) If the Office complies with the requirement referred to in paragraph (1) of this Article, the consequences of having failed to comply with a time limit shall be deemed not to have occurred, and all the decisions and conclusions issued by the Office concerning the failure shall be revoked.



## **Part Six: CHANGES RELATING TO A TRADEMARK**

### **ENTRY OF CHANGES**

#### **Article 37**

(1) On request of the applicant for the registration of a trademark or the holder of a trademark, the Office shall enter in the register all the changes occurring after the filing of the application for the registration of a trademark or after the registration of a trademark, provided that they correspond to the real situation and that they do not affect the representation of the registered trademark.

(2) The changes entered in the trademark register shall be published in the Office official gazette.

(3) The data to be contained in the request for the entry of any change relating to a trademark shall be prescribed by the Regulations.

### **TRANSFER OF RIGHTS**

#### **Article 38**

(1) The holder of a trademark may transfer his trademark to other persons in respect of some or all of the goods or services for which it is registered.

(2) In case of a trademark transfer in respect of some of the products and/or services only, for which the trademark is registered, such registration shall be divided in accordance with the provisions of Article 33 of this Act.

(3) On request of one of the parties, the transfer of rights shall be entered in the register, if a certified copy of the transfer contract, or the certified part of the contract, or the original certificate of the transfer signed both by the former and the new holder of the right is submitted to the Office.

(4) The transfer of rights shall be published in the Office official gazette and it shall have effect against third parties after the entry thereof in the register.

(5) The request for the entry of the transfer of rights in the register shall be filed under the conditions and in the manner as prescribed by the Regulations.

### **LICENSE**

#### **Article 39**

(1) A trademark may be licensed for some or all of the goods or services for which it is registered and for the whole or a part of the territory of the Republic of Croatia.

(2) A license may be exclusive or non-exclusive.

(3) The holder of a trademark may invoke the rights conferred by the trademark against a licensee who contravenes any provision of the licensing contract with regard to its duration, the form covered by the registration in which the trademark may be used, the scope of the goods or services for which the license is granted, the territory in which the trademark may be affixed, the quality of the goods manufactured or of the services provided by the licensee.

(4) On request of one of the parties, a license shall be entered in the register, if an extract from the licensing contract indicating the parties to that contract and the rights being licensed, certified as being a true extract from that contract or the original certificate of granting the license, signed by both the licensor and the licensee has been filed with the Office.

(5) If the prescribed fee and procedural charges are paid, the license shall be published in the Office official gazette, and it shall have effect against third parties after the entry thereof in the register.

(6) The request for the entry of the license in the register shall be filed under the conditions and in the manner as prescribed by the Regulations.

## RIGHTS IN REM AND LEVY OF EXECUTION

### Article 40

(1) A trademark may be subject to the rights in rem and levy of execution.

(2) A right in rem shall be entered in the register upon the request of a lien creditor or a lien debtor. The court levying an execution ex officio shall inform the Office without delay of the execution levied upon a trademark for the purpose of the entry of the levy of execution in the register.

(3) Rights in rem and levy of execution shall be published in the Office official gazette and shall have effect against third parties after the entry thereof in the register.

(4) The request for the entry of the rights in rem in the register shall be filed under the conditions and in the manner as prescribed by the Regulations.

## BANKRUPTCY PROCEEDINGS

### Article 41

Where a trademark is involved in bankruptcy proceedings, an indication to that effect shall be entered in the register and published on request of the competent authority.

## RIGHTS CONFERRED BY AN APPLICATION

### Article 42

Articles 38 to 41 of this Act shall also apply to applications for the registration of a trademark.

## **Part Seven: DURATION, RENEWAL AND CEASING OF EFFECTS OF A TRADEMARK**

### PERIOD OF PROTECTION

#### Article 43

The period of protection of a registered trademark shall last ten years counting from the date of filing of the application for the registration of a trademark.

## RENEWAL OF THE REGISTRATION OF A TRADEMARK

### Article 44

(1) The registration of a trademark may be renewed indefinite number of times, for the periods of ten years each, provided that the holder of the trademark files with the Office a request for renewal of the registration of the trademark and pays the prescribed fee and procedural charges in the course of the last year of the ten-year period of protection.

(2) The request for renewal of the registration of a trademark may be submitted and the fee and procedural charges paid within the additional period of six months following the expiry of the period referred to in paragraph (1) of this Article, in which case the amount of the prescribed fee and procedural charges shall be doubled.

(3) The new period of protection shall begin with the day of expiry of the previous ten-year period.

(4) The request for renewal of the registration of a trademark may be filed with the Office by the holder of the trademark or a person expressly authorized by him.

(5) Where the request for renewal of the registration of a trademark is filed in respect of only of some of the goods or services for which the trademark is registered, the registration shall be renewed for those goods or services only.

(6) The renewal of the registration of a trademark shall be entered in the register and published in the Office official gazette.

(7) If the registration is not renewed, the trademark shall cease to have effect from the day of expiry of the period of protection.

(8) The data to be contained in the request for renewal of the registration of a trademark shall be prescribed by the Regulations.

## SURRENDER OF THE TRADEMARK

### Article 45

(1) The holder of a trademark may surrender the trademark in respect of some or all of the goods or services for which it is registered by a written declaration.

(2) If a license has been entered in the register, the surrender of the trademark shall only be entered in the register if the holder of the trademark proves that he has informed the licensee of his intention to surrender the trademark.

(3) On the basis of the declaration of surrender, the trademark shall cease to have effect on the day the holder has submitted the declaration of surrender.

## REVOCATION OF A TRADEMARK

### Article 46

(1) The request for revocation of a trademark may be filed with the Office by any natural or legal person.

(2) A trademark may be revoked if, within a continuous period of five years, it has not been put to genuine use in the Republic of Croatia in relation to the goods or services in respect of which it is registered, and there are no justified reasons for non-use.

(3) A trademark may also be revoked if, after the date on which it was registered:

1. in consequence of acts or inactivity of the holder, it has become a common name in the trade for products or services in respect of which it is registered,

2. in consequence of the use made of it by the holder of the trademark or with his authorization, in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(4) The request for revocation of a trademark shall be filed under conditions and in the manner as prescribed by the Regulations.

## PROCEDURE CONCERNING THE REQUEST FOR REVOCATION OF A TRADEMARK

### Article 47

(1) The Office shall examine whether the request for revocation of a trademark is filed in accordance with Article 46 of this Act.

(2) If the request for revocation of a trademark is filed before the expiry of a period of five years from the registration of the trademark the revocation of which is requested, and if it is not filed on the grounds specified in Article 46 paragraphs (2) and (3), the Office shall reject the request by a decision.

(3) If the request for revocation of a trademark is not filed as prescribed by the Regulations, the Office shall order the person who filed the request by a conclusion to remedy the deficiencies in the request within 60 days from the day of receipt of the conclusion.

(4) If the person who filed the request for revocation of a trademark does not, within the prescribed time limit, comply with the conclusion sent by the Office and does not remedy the deficiencies in the request within the meaning of paragraph (3) of this Article, the request shall be rejected by a decision.

(5) If the requirements set out in paragraph (1) of this Article are complied with, the Office shall notify the holder of the trademark of the request for revocation of the trademark as filed, and shall send him a copy of the request, inviting him to submit his observations on the request within 60 days from the day of receipt of the invitation.

(6) If the holder of the trademark in respect of which the revocation is requested does not submit his observations on the request within the prescribed time limit, the trademark shall be revoked for those goods or services in respect of which the request was filed.

(7) The Office shall transmit a copy of the observations on the request for revocation of a trademark furnished by the holder of a trademark to the person who filed a request for the revocation of a trademark and shall invite him to file his observations within a period of 60 days from the day of receipt of the invitation.

(8) On request, the time limits referred to in paragraphs (3), (5) and (7) of this Article may be extended for not more than 60 days.

(9) If the Office considers it necessary, it may provide for oral hearing to be held in the revocation procedure.

## EXAMINATION OF THE REQUEST FOR REVOCAION OF A TRADEMARK

### Article 48

(1) After the expiry of the time limit referred to in Article 47 paragraph (7) of this Act, the Office shall examine the justification of the grounds specified in the request for revocation of the trademark.

(2) In the examination procedure concerning the request for revocation of a trademark, the Office may invite the parties to submit additional evidence, documentation and observations within 60 days from the day of receipt of the invitation.

(3) On request, the time limit laid down in paragraph (2) of this Article may be extended for not more than 60 days.

(4) If the party in the procedure does not respond to the invitation referred to in paragraph (3) of this Article within the prescribed time limit, the Office shall make a decision on the basis of the facts available from the previously submitted documentation.

(5) It may not be requested that a trademark be revoked where genuine use of the trademark has been started or resumed during the interval between expiry of the five-year period of non-use and filing of the request for revocation.

(6) The commencement or resumption of use within a period of three months preceding the filing of the request for revocation, which began, at the earliest, on expiry of the continuous period of five years of non-use, shall be disregarded if preparations for the commencement or resumption occur only after the holder becomes aware that the request for revocation may be filed.

(7) If, in the examination procedure concerning the request for revocation of a trademark, the Office finds that the request is unjustified, the request shall be refused and the decision to that effect shall be sent to the person who has filed the request and to the holder of the trademark in respect of which the revocation is requested.

(8) If, in the examination procedure concerning the request for revocation of a trademark, the Office finds that the request is justified, the trademark shall be revoked in full or partially and the decision to that effect shall be sent to the person who has filed the request and to the holder of the trademark in respect of which the revocation is requested.

(9) When a trademark is revoked, it shall be deemed that its effects ceased on the date of the filing of the request for revocation.

(10) The revocation of a trademark shall be entered in the register and published in the Office official gazette.

## DECLARATION THAT THE TRADEMARK IS INVALID

### Article 49

(1) If the trademark was not registered in accordance with the provisions of Article 3 paragraph (1) and Article 5 paragraph (1) of this Act, the procedure for a declaration that a trademark is invalid may be initiated ex officio, on request of the state attorney or on request of an interested person.

(2) On the grounds specified in Article 6 of this Act, which shall also apply to the procedure for a declaration that a trademark is invalid, the procedure for a declaration that a trademark is invalid may be initiated:

1. within the meaning of Article 6 paragraphs (1) and (3) of this Act, on request of the holder of an earlier trademark and the licensee in accordance with Article 39 paragraph (4) or (5) of this Act,

2. on request of the holder of any of the rights referred to in Article 6 paragraph (4) of this Act,

3. on request of the person who had a firm within the meaning of Article 6 paragraph (6) of this Act,

4. on request of the holder of an earlier trademark referred to in Article 6 paragraph (7) of this Act,

5. on request of the holder of an earlier trademark referred to in Article 6 paragraph (8) of this Act.

(3) The procedure for a declaration that a trademark is invalid may be initiated on the request of an interested person also in the case where the holder of the trademark requested to be declared invalid was acting in bad faith at the moment of filing an application for the registration of such trademark.

(4) Where a trademark has not been registered in accordance with the provisions of Article 5 paragraph (1) items 2, 3 or 4 of this Act, it may only be declared invalid if the procedure for a declaration that the trademark is invalid has been initiated within a period of ten years from the date of registration.

(5) A trademark may not be declared invalid on the grounds of an earlier trademark with a reputation if the earlier trademark has not acquired the reputation within the meaning of Article 6 paragraph (3) of this Act up to the date of priority right of the later trademark.

(6) Where the holder of the right referred to in paragraph (2) of this Article has previously filed a request for a declaration that a trademark is invalid, he may not file a new request for a declaration that a trademark is invalid on the basis of any other of the said rights which he could have invoked in support of his first request.

(7) If, on the date of filing of the request for a declaration that a trademark is invalid, the earlier trademark on which the request is based is subject to a pending revocation procedure or a pending procedure for a declaration that the trademark is invalid, the Office shall suspend the procedure until the decision from the earlier initiated revocation procedure or the procedure for a declaration that the trademark is invalid has become final.

(8) The request for a declaration that a trademark is invalid shall be filed under the conditions and in the manner as prescribed by the Regulations.

## PROCEDURE CONCERNING THE REQUEST FOR A DECLARATION THAT A TRADEMARK IS INVALID

### Article 50

(1) The Office shall examine whether the request for a declaration that a trademark is invalid is filed in accordance with Article 49 paragraphs (2), (3), (4), (5), (6) and (8) of this Act.

(2) If the request for a declaration that a trademark is invalid is not filed in accordance with Article 49 paragraphs (3), (4) and (6) of this Act, the Office shall reject the request by a decision.

(3) If the request for a declaration that a trademark is invalid is not filed as prescribed by the Regulations, the Office shall order the person who filed the request by a conclusion to remedy the deficiencies in the request within 60 days from the day of receipt of the conclusion.

(4) If the person who filed the request does not, within the prescribed time limit, comply with the conclusion sent by the Office and does not remedy the deficiencies in the request within the meaning of paragraph (3) of this Article, the request shall be rejected by a decision.

(5) If the requirements set out in Article 49 of this Act are complied with, the Office shall notify the holder of the contested trademark of the initiated procedure for a declaration that the trademark is invalid, and shall send him a copy of the request, inviting him to submit his observations on the request within 60 days from the day of receipt of the invitation.

(6) On request, the time limits laid down in paragraphs (3) and (5) of this Article may be extended for not more than 60 days.

(7) If the holder of the contested trademark does not submit his observations on the request for a declaration that the trademark is invalid within the prescribed time limit, the trademark shall be declared invalid for those goods or services in respect of which the procedure was initiated.

(8) If the Office considers it necessary, it may provide for oral hearing to be held in the procedure concerning the request for a declaration that a trademark is invalid.

## EXAMINATION OF THE REQUEST FOR A DECLARATION THAT A TRADEMARK IS INVALID

### Article 51

(1) If the holder of the contested trademark submits his observations on the request for a declaration that a trademark is invalid within the prescribed time limit, the Office shall examine the justification of the grounds specified in the request.

(2) Where a trademark has not been registered in accordance with Article 3 paragraph (1) and Article 5 paragraph (1) of this Act, the trademark shall be declared invalid only if the

grounds for a declaration that a trademark is invalid still exist at the time when the decision on the request for a declaration that a trademark is invalid is made.

(3) Where a trademark has not been registered in accordance with Article 5 paragraph (1) items 2, 3 or 4 of this Act, it shall not be declared invalid if the holder of the trademark proves that the trademark has, after the registration and following the use, which has been made of it, acquired a distinctive character in respect of the goods or services for which it is registered.

(4) A trademark may not be declared invalid if the holder of the right referred to in Article 49 paragraphs (2) and (3) of this Act consented expressly to the registration of that trademark before filing of the request for a declaration that a trademark is invalid.

(5) A trademark may not be declared invalid on the ground that there is an earlier conflicting trademark if this earlier trademark does not comply with the requirements of use set out in Article 13 paragraphs (2) to (4), provided that the earlier trademark has, on the date of filing the request for a declaration that a trademark is invalid, been registered for not less than five years.

(6) If the earlier trademark has been used in relation to a part only of the goods or services for which it is registered, it shall, for the purposes of the examination of the request for a declaration that a trademark is invalid, be considered to be registered in respect only of that part of the goods or services.

(7) In the examination procedure concerning the request for a declaration that a trademark is invalid, the Office may invite the parties to submit additional evidence, documentation and observations within 60 days from the day of receipt of the invitation.

(8) On request, the time limit laid down in paragraph (7) of this Article may be extended for not more than 60 days.

(9) If the party in the procedure does not respond to the invitation referred to in paragraph (8) of this Article within the prescribed time limit, the Office shall make a decision on the basis of the facts available from the earlier submitted documentation.

(10) If, in the examination procedure concerning the request for a declaration that a trademark is invalid, the Office finds that the request is unjustified, the request shall be refused and the decision to that effect shall be sent to the person who has filed the request and to the holder of the contested trademark.

(11) If, in the examination procedure concerning the request for a declaration that a trademark is invalid, the Office finds that the request is justified, the trademark shall be declared invalid in full or partially, and the decision to that effect shall be sent to the person who has filed the request and to the holder of the contested trademark.

(12) Where a trademark is declared invalid, the effects of that trademark shall be considered to have been invalid as from the day of filing the application for the registration of the trademark.

(13) The declaration that a trademark is invalid shall be entered in the register and published in the Office official gazette.



PARTIAL REFUSAL OF REGISTRATION OF A TRADEMARK, REVOCATION OF A  
TRADEMARK OR DECLARATION THAT A TRADEMARK IS INVALID

Article 52

Where the grounds for refusal of the registration of a trademark or for revocation of a trademark or for a declaration that a trademark is invalid exist in respect of only some of the goods or services for which the trademark has been applied for or registered, refusal of the registration or revocation or the declaration that a trademark is invalid shall cover those goods or services only.

**Part Eight: COLLECTIVE AND GUARANTEE MARK**

COLLECTIVE MARK

Article 53

Any sign within the meaning of Article 2 of this Act, which is indicated as such in the application for the registration of a trademark, and which is capable of distinguishing the goods or services of the members or partners of a certain legal person from the goods or services of other undertakings, and which is intended for collective designation of the goods or services put on the market by the members or the partners of that legal person, may be protected as a collective mark.

GUARANTEE MARK

Article 54

Any sign within the meaning of Article 2 of this Act, which is intended to designate the quality, origin, manner of production, or other common characteristics of the goods or services may be protected as a guarantee mark. The holder of a guarantee mark is not entitled to use a guarantee mark by himself, however, he shall be entitled to authorize and supervise such use in respect of entrepreneurs who have the authorization to use a guarantee mark pursuant to the Contract on a Guarantee Mark.

SPECIAL PROVISIONS ON COLLECTIVE MARKS AND GUARANTEE MARKS

Article 55

(1) The provisions of this Act and the Regulations shall also apply to collective marks and guarantee marks, unless this part of the Act provides otherwise.

(2) By way of derogation from the provision of Article 5 paragraph (1) item 3 of this Act, signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may be protected as a collective mark.

(3) The mark referred to in paragraph (2) shall not entitle the holder to prohibit a third party to use in the course of trade signs or indications specified in paragraph (2) of this Article, provided that he uses them in accordance with established and honest practices in industrial or commercial activity. In particular, such a mark may not be invoked against a third party who is entitled to use a geographical name.

## PERSONS WHO MAY BE HOLDERS OF A COLLECTIVE MARK

### Article 56

The holder of a collective mark or the applicant for the registration of a collective mark may be legal persons and associations of manufacturers, providers of services, or traders, which may, in their own name, assume obligations and exercise rights, make contracts or perform other legal actions.

## CONTRACT ON A COLLECTIVE MARK

### Article 57

A contract on a collective mark shall be filed with the application for the registration of a collective mark and shall contain: the list of names of the persons authorized to use the collective mark, the conditions of membership, the conditions governing such use and provisions relating to the infringement of rights in the case of misuse of the collective mark, or the breach of the provisions of the contract.

## USE OF COLLECTIVE MARKS

### Article 58

Any person who has been authorized to use a collective mark shall be entitled to use it, provided that all the requirements, which this Act prescribes with regard to the use of trademarks, are complied with.

## AMENDMENTS TO THE CONTRACT GOVERNING A COLLECTIVE MARK

### Article 59

(1) The holder of a collective mark must submit to the Office all the amendments to the contract relating to the use of the collective mark.

(2) Amendments to the contract governing the use of the collective mark shall have effect against third parties after the entry thereof in the register.

## **Part Nine: PROTECTION OF TRADEMARKS UNDER THE MADRID AGREEMENT CONCERNING THE INTERNATIONAL REGISTRATION OF MARKS AND THE PROTOCOL RELATING TO THE MADRID AGREEMENT**

### SPECIAL PROVISIONS ON INTERNATIONAL REGISTRATIONS OF MARKS

#### Article 60

The provisions of this Act and the Regulations on Trademarks shall apply to international registrations of marks the protection of which extends to the territory of the Republic of Croatia under the Madrid Agreement Concerning the International Registration of Marks (hereinafter: "the Madrid Agreement") and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (hereinafter: "the Protocol"), in all the matters not regulated by these treaties, unless this part of the Act provides otherwise.

FILING OF THE APPLICATION FOR THE INTERNATIONAL REGISTRATION OF A  
MARK AND THE REQUEST FOR RECORDING OF A CHANGE IN THE  
INTERNATIONAL REGISTER

Article 61

(1) An application for the international registration of a mark and requests for recording of a change in the International Register shall be filed with the Office as prescribed by the Madrid Agreement, the Protocol, the Common Regulations under the Madrid Agreement Concerning the International Registration of Marks and the Protocol (hereinafter: "the Common Regulations") and this Act and the Regulations.

(2) If the application for the international registration of a mark or a request for recording of a change in the International Register is not filed as prescribed by the Madrid Agreement, the Protocol, the Common Regulations and the Regulations on Trademarks, the Office shall order the applicant by a conclusion or the person who filed the request to remedy the deficiencies in the application or the request within 30 days from the day of receipt of the conclusion.

(3) On request, the time limit laid down in paragraph (2) of this Article may be extended for not more than 60 days.

(4) If the application for the international registration of a mark is filed in accordance with paragraph (1) of this Article and if the prescribed fee and procedural charges are paid, the Office shall transmit the application to the International Bureau of the World Intellectual Property Organization (hereinafter: "the International Bureau").

(5) If the applicant for the international registration of a mark or the person who filed the request for recording of a change in the International Register does not, within the prescribed time limit, comply with the conclusion sent by the Office, and does not remedy the found deficiencies within the meaning of paragraph (2) of this Article, or if the application or request according to the Madrid Agreement, the Protocol and the Common Regulations may not be filed with the Office, the application or the request shall be rejected by a decision.

FEES

Article 62

All the fees payable under the Madrid Agreement and the Protocol shall be paid directly to the International Bureau.

ENTRY IN THE TRADEMARK REGISTER

Article 63

The date and number of the international registration of a mark shall be entered in the trademark register kept by the Office, provided that the international application resulted in the registration.

## CONVERSION (TRANSFORMATION) OF AN INTERNATIONAL REGISTRATION OF A MARK INTO A NATIONAL TRADEMARK APPLICATION

### Article 63a

(1) Where, on or before the day of cancellation of an international registration from the International Register all the requirements, laid down under the Protocol, for the conversion (transformation) of an international registration of a mark, as protected in the territory of the Republic of Croatia into a national trademark are complied with, such trademark shall, upon the request of its holder, be entered in the trademark register kept by the Office pursuant to this Act, subject to the prior payment of the procedural charges for the maintenance of the trademark for the first ten-year period and the publication of the trademark data.

(2) The date of the international registration of the trademark, which is the basis for conversion (transformation), shall be taken as the date of registration of the national trademark, resulting from the conversion (transformation), carried out in accordance with paragraph (1) of this Article.

(3) An international registration of a mark, which is not protected in the territory of the Republic of Croatia on or before the day of cancellation of the international registration from the International Register, in respect of which the procedures and measures are taken before the Office, and are pending on or before the day of filing a request for conversion (transformation), are deemed to be integral parts of the procedure for a national trademark application, in compliance with the provision of this Act.

(4) The date of the international trademark registration for which the extension of protection to the territory of the Republic of Croatia is requested, shall be taken as the date of the national trademark application referred to in paragraph (3) of this Article, resulting from a request for conversion (transformation).

## REFUSAL OF PROTECTION TO THE INTERNATIONAL REGISTRATION OF A MARK

### Article 64

For the holder of an international registration of a mark, the time limit laid down in Article 24 paragraph (2) of this Act shall be replaced by the time limit of four months as from the date of the notification of refusal.

## OPPOSITION TO THE INTERNATIONAL REGISTRATION OF A MARK

### Article 65

(1) For the purposes of international registrations of marks under the Madrid Agreement and the Protocol, the publication of the application prescribed in Article 25 of this Act shall be replaced by the publication in the official gazette of international registrations of marks published by the International Bureau (hereinafter: the international official gazette).

(2) The time limit for filing the opposition to an international registration of a mark shall run from the first day of the month following the month indicated on the edition of the international official gazette in which such mark has been published.

(3) In the procedure concerning the opposition to an international registration of a mark, the Office, in accordance with the Madrid Agreement or the Protocol, shall send to the holder of the international registration of a mark a notification of provisional refusal on the basis of the opposition and shall invite him to appoint a representative who shall, within four months from the date of the notification of refusal, file with the Office a power of attorney. A copy of the opposition shall be sent to the representative after filing of the power of attorney. The time limit for submitting the observations on the opposition is 60 days from the day of receipt of the copy of the opposition by the representative.

(4) The time limits referred to in paragraph (3) of this Article shall not be extended.

## PROVING THE USE OF AN INTERNATIONAL REGISTRATION OF A MARK

### Article 66

(1) For the purpose of proving the use of an international registration of a mark in the opposition procedure, procedure for the declaration that a trademark is invalid, and the revocation procedure relating to an international registration of a mark, the date of the expiry of a one-year period running from the day following the date of notification communicated by the International Bureau concerning the request for the extension of protection of the international registration of a mark to the territory of the Republic of Croatia, shall be taken as the date of the international trademark registration.

(2) If, upon the expiry of a one-year period referred to in paragraph (1) of this Article, the procedure concerning a request for the extension of protection of an international registration of a trademark to the territory of the Republic of Croatia has not yet been concluded, the date on which the Office notified the International Bureau its final decision on the grant of protection, shall be taken as the date of the international registration.

## DECLARATION THAT AN INTERNATIONAL REGISTRATION OF A MARK IS INVALID AND REVOCATION OF AN INTERNATIONAL REGISTRATION OF A MARK

### Article 67

(1) In the procedures concerning the request for a declaration that an international registration of a mark is invalid and the request for revocation of an international registration of a mark, the Office shall notify the holder of the international registration of a mark of the request and order him by conclusion to appoint a representative who, within 60 days from the date of receipt of the conclusion, has to file with the Office a power of attorney.

(2) The time limit referred to in paragraph (1) of this Article shall not be extended.

(3) A copy of the request shall be sent to the representative after filing of the power of attorney. The time limit for submitting the observations on the request is 60 days from the day of receipt of the copy of the request by the representative.

(4) On request, the time limit laid down in paragraph (3) of this Article may be extended for not more than 60 days.

## **Part Ten: COMMUNITY TRADEMARK**

### DEFINITIONS

#### Article 67a

For the purpose of this Act, the following terms have the following meanings:

- a) “Regulation on the Community trade mark” is the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark and its amendments;
- b) a “Community trade mark” is a trademark as defined in Article 1, paragraph (1) of the Regulation on the Community trade mark;
- c) an “application for a Community trade mark” is an application for registration of a Community trade mark filed in accordance with the provisions of the Regulation on the Community trade mark;
- d) a “national trademark” is a trademark acquired in the procedure before the Office in accordance with the provisions of this Act;
- e) a “national application for a trademark” is an application for a trademark filed with the Office in accordance with the provisions of this Act.

### EXTENSION OF EFFECTS OF A COMMUNITY TRADE MARK

#### Article 67b

The effects of applications for a Community trade mark filed and Community trade marks acquired before the day of the acceptance of the Republic of Croatia into the full membership of the European Union shall extend to the territory of the Republic of Croatia.

### A COMMUNITY TRADE MARK AS AN EARLIER TRADEMARK

#### Article 67c

(1) Within the meaning of Article 6 of this Act, a Community trade mark shall be an earlier trade mark in relation to national trademark applications which are filed, as well as national trademarks which are acquired on such applications after the day of the acceptance of the Republic of Croatia into the full membership of the European Union.

(2) Within the meaning of Article 6, paragraph (2) item 4<sup>1</sup> of this Act, an earlier Community trade mark having reputation in the European Union shall be taken into consideration in accordance with the provisions of Article 9, paragraph (1), item (c) of the Regulation on the Community trade mark.<sup>2</sup>

(3) A national trademark may not be declared to be invalid for the reason of being in conflict with an earlier Community trade mark, if such earlier Community trade mark fails to fulfill the conditions of use provided for in Article 15 of the Regulation on the Community trade mark.

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<sup>1</sup> Note: In Article 67.c paragraph 2, instead of “Within the meaning of Article 6 paragraph (2) item 4” it should read “Within the meaning of Article 6 paragraph (3)”

## FORWARDING OF AN APPLICATION FOR A COMMUNITY TRADE MARK

### Article 67d

If an application for a Community trade mark has been filed with the Office pursuant to Article 25 of the Regulation on the Community trade mark, a fee and charges for forwarding shall be paid in accordance with special regulations.

## CONVERSION OF A COMMUNITY TRADEMARK APPLICATION AND A COMMUNITY TRADEMARK INTO A NATIONAL TRADEMARK APPLICATION

### Article 67e

(1) Upon a request for conversion of a Community trademark application, or a Community trademark, respectively, into a national trademark application, filed pursuant to the provision of Article 109, paragraph (3) of the Regulation on the Community trade mark, the Office shall carry out the procedure for the trademark registration in accordance with the provisions of this Act.

(2) The administrative fees and procedural charges for the registration referred to in paragraph (1) of this Article shall be paid in accordance with the provisions of this Act and other regulations.

(3) The Office shall notify the person filing the request referred to in paragraph (1) of this Article of the receipt thereof and shall order him/her by a conclusion to file a translation of the Community trademark application into Croatian, within a period of 60 days.

(4) The date of filing, the date of priority and the seniority shall be determined pursuant to the provision of Article 108, paragraph (3) of the Regulation on the Community Trademark.

## SENIORITY

### Article 67f

The seniority of a national trademark, within the meaning of Articles 34 and 35 of the Regulation on the Community trade mark, may be claimed for a Community trade mark:

- if a national trademark has been acquired before the day of the accession of the Republic of Croatia into the full membership of the European Union and
- if a national trademark has priority in relation to the Community trademark for which the seniority is claimed.

## PROHIBITION OF USE OF A COMMUNITY TRADE MARK

### Article 67g

If the use of a Community trade mark referred to in Article 67b of this Act conflicts with the use of a national trademark acquired before the day of the acceptance of the Republic of Croatia into the full membership of the European Union, or acquired on a national application, filed before the day of the acceptance of the Republic of Croatia into the full

membership of the European Union, the holder of such national trademark may institute a legal action, claiming prohibition of the use in the Republic of Croatia of the Community trade mark, the effect of which is, in accordance with Article 67b of this Act, extended to the territory of the Republic of Croatia. The plaintiff shall prove that the Community trade mark conflicts with his/her national trademark.

## PROTECTION OF A COMMUNITY TRADE MARK AGAINST INFRINGEMENT

### Article 67h

The provisions on the protection of a national trademark in the case of infringement shall apply *mutatis mutandis* to the protection of a Community trade mark in the case of infringement.

## THE COURT COMPETENT FOR A COMMUNITY TRADE MARK

### Article 67i

(1) In the Republic of Croatia, the Commercial Court in Zagreb shall be the Community Trade Mark Court competent for the first instance decisions, within the meaning of the Regulation on the Community trade mark.

(2) In the Republic of Croatia, the High Commercial Court shall be the Community Trade Mark Court competent for the second instance decisions, within the meaning of the Regulation on the Community trade mark.

## **Part Eleven: COMMON PROVISIONS RELATING TO THE PROCEDURE BEFORE THE OFFICE**

### CORRECTION OF MISTAKES

#### Article 68

(1) Where the entry in the register of a trademark or the publication of an application or a registration of a trademark contains a mistake attributable to the Office, the Office shall correct the mistake *ex officio* or on request of the party.

(2) A request for the correction of a mistake referred to in paragraph (1) of this Article shall not be subject to payment of any fee or procedural charges.

(3) The Office shall publish the correction of mistakes made in accordance with this Article.

### INITIATION OF A PROCEDURE

#### Article 68a

(1) An application for the registration of a trademark may be filed with the Office directly in writing, by post, or by electronic means.

(2) Requests for the initiation of other procedures governed by this Act shall be filed with the Office directly in writing, or by post.



(3) The requirements and manner in which an application for the registration of a trademark and other requests for the initiation of procedures shall be communicated to the Office shall be prescribed by the Regulations.

## FEES AND PROCEDURAL CHARGES

### Article 69

The procedures prescribed by this Act shall be subject to the payment of fees and procedural charges in compliance with the special provisions.

## CERTIFICATE OF PRIORITY RIGHT

### Article 70

On request of the applicant for the registration of a trademark or the holder of a trademark, and after the prescribed fee and procedural charges have been paid, the Office shall issue a certificate of priority right.

## TRADEMARK REGISTER

### Article 71

(1) The Office shall keep the trademark register, which contains the data, the entry of which is prescribed by this Act and the Regulations.

(2) Any person shall be entitled to inspect the trademark register.

(3) On request of any interested person, and after the prescribed fee and procedural charges have been paid, the Office shall issue the extract and the printout from the trademark register.

## OFFICIAL GAZETTE

### Article 72

The Office shall publish the official gazette containing all the data the publication of which is prescribed by this Act and the Regulations.

## SEARCH

### Article 73

On the request of any interested person, the Office shall carry out identity and similarity searches of applied for and registered trademarks having effect in the Republic of Croatia.

## REPRESENTATION BEFORE THE OFFICE

### Article 74

(1) Natural or legal persons not having a domicile or a real and effective industrial or commercial principle place of business in the Republic of Croatia may exercise rights arising from this Act in the procedures before the Office only through authorized representatives.

(2) General principles of representation and special conditions under which the persons specified in paragraph (1) of this Article may exercise rights arising from this Act shall be regulated by special regulations.

## **Part Twelve: CIVIL PROTECTION**

### **PERSONS ENTITLED TO CLAIM THE PROTECTION OF RIGHTS**

#### **Article 75**

The protection of the rights under this Act may be claimed by a right holder, or a person authorized by her/him pursuant to the general provisions on representation, and, apart from her/him by the holder of the exclusive license, to the extent that he has acquired the right of exploitation of a trademark on the basis of a legal transaction or law.

### **CLAIM FOR THE ESTABLISHMENT AND TERMINATION OF INFRINGEMENT**

#### **Article 76**

(1) The holder of a trademark may institute a legal action against any person who has infringed a trademark by performing without authorization any of the acts referred to in Article 7 paragraphs (2) and (3) of this Act, claiming establishment of the infringement.

(2) The holder of a trademark may institute a legal action against any person who has infringed a trademark by performing without authorization any of the acts referred to in Article 7 paragraphs (2) and (3) of this Act, claiming termination of the infringement and prohibition of such and similar future infringements.

(3) The holder of a trademark may institute a legal action against any person who has by performing any of the acts without authorization caused a serious threat that his trademark might be infringed, claiming desistance from the act concerned and prohibition of the infringement of the trademark.

(4) The claims referred to in paragraphs (1), (2) and (3) of this Article may also be made against a person who in the course of her/his economic activities renders services used in the acts infringing a trademark or threatening to infringe it.

### **CLAIM FOR SEIZURE AND DESTRUCTION OF OBJECTS**

#### **Article 77**

(1) The holder of a trademark may institute a legal action against any person who has infringed a trademark by performing without authorization any of the acts referred to in Article 7 paragraphs (2) and (3) of this Act, claiming that the products infringing the trademark be removed from the market, seized or destroyed at the expense of that person.

(2) The court shall order the measures referred to in paragraph (1) of this Article against the defendant, unless there are special reasons for not deciding so.

(3) When ordering the measure referred to in paragraph (1) of this Article, the court shall take due care that they are proportionate to the nature and seriousness of the infringement.

## CLAIM FOR DAMAGES, USUAL COMPENSATION AND UNFAIR PROFITS

### Article 78

(1) The holder of a trademark may take a legal action against any person who has caused him damage by performing without authorization any of the acts referred to in Article 7 paragraphs (2) and (3) of this Act, claiming damages pursuant to the general rules on the legal redress laid down in the Obligations Act.

(2) The holder of a trademark may institute a legal action against any person who has performed without authorization any of the acts referred to in Article 7, paragraphs (2) and (3) of this Act, claiming payment of remuneration in the amount that he would have claimed, given the circumstances, in the license agreement, if concluded.

(3) The holder of a trademark may take a legal action against any person who has infringed a trademark by performing without authorization any of the acts referred to in Article 7, paragraphs (2) and (3) of this Act, without having basis for it in any legal transaction, court decision or the law, and has benefited from it, claiming the recovery or compensation of such benefits pursuant to the general rules on unjust enrichment laid down in the Obligations Act.

(4) The claims referred to in paragraphs (1), (2) and (3) shall not be mutually excluding. When deciding on the claims referred to in paragraphs (1), (2) or (3), filed cumulatively, the court shall observe the general principles laid down in the Obligations Act.

## CLAIM FOR PUBLICATION OF THE JUDGEMENT

### Article 79

The holder of a trademark may claim that the final judgment even partially upholding the claim for protection of the trademark in the case of infringement is published in the means of public communication at the expense of the defendant. The court shall decide, within the limits of the claim, on the means of public communication in which the judgment shall be published, and whether it shall be published entirely or partially. If the court decides that only a part of the judgment shall be published, it shall order, within the limits of the claim, that at least the dispositive part of it and, if necessary, the part of the judgment specifying the infringement concerned and the person, having committed it, is published.

## CLAIM FOR PROVISION OF INFORMATION

### Article 79a

(1) The holder of a trademark who has instituted civil proceedings for the protection of the trademark in the case of infringement may claim the provision of information on the origin and distribution channels of the goods or services infringing his trademark.

(2) The claim referred to in Article 1 may be made in the form of a legal action or a provisional measure against:

– a person who has been sued in the civil proceedings referred to in paragraph (1) of this Article;

– a person who is within her/his economic activities in possession of the goods suspected of infringing a trademark;

– a person who provides, within her/his economic activities, services suspected of infringing a trademark;

– persons who provide, within their economic activities, services used in the activities suspected of infringing a trademark;

– a person who is indicated by any of the mentioned persons as being involved in the manufacture or distribution of the goods or the provision of the services suspected of infringing a trademark.

(3) The claim referred to in Article 1 may also be included in a gradual legal action as the first claim, provided that a person acting as a counter party to the defendant is also included in the main claim.

(4) The claim for information on the origin of the goods and distribution channels of the goods and services referred to in paragraph (1) of this Article may include in particular:

– information on the names and addresses of the producers, distributors, suppliers and other previous holders of the goods and providers of the services, respectively, as well as the intended wholesalers and retailers;

– information on the quantities produced, delivered, received or ordered, as well as the price obtained for the goods or services concerned.

(5) The person required to provide the information referred to in this Article may refuse to provide such information on the same grounds as those allowing the refusal to present evidence as a witness pursuant to the provisions of the Act on Civil Proceedings. If the person concerned refuses to provide information without justified reasons, she/he shall be responsible for the damage incurred, pursuant to the provisions of the Obligations Act.

(6) The provisions of this Article shall be without prejudice to the provisions on the manner of use of confidential information in civil and criminal proceedings, the provisions regulating the responsibility for misuse of the right to acquire information, and the provisions regulating the processing and protection of personal data.

(7) The provisions of this Article shall be without prejudice to the provisions of 79c and 79d of this Act regulating the taking of evidence.

## PROVISIONAL MEASURES DUE TO INFRINGEMENT OF A TRADEMARK

### Article 79b

(1) Upon the request of the holder of a trademark who makes it likely that her/his trademark has been infringed or threatened to be infringed, the court may order any provisional measure comprising the termination or prevention of the infringement, and in particular:

– order the opposing party to cease or desist from, the acts infringing a trademark; the court may also issue such order against an intermediary whose services are being used by a third party to infringe a trademark;

– order the seizure or removal from the market of the goods unlawfully designated by a trademark.

(2) Upon the request of the holder of a trademark who makes it likely that his trademark has been infringed on a commercial scale for the purpose of acquiring commercial or economic benefit, and that such infringement has threatened to cause him irreparable damage, the court may, in addition to the provisional measures referred to in paragraph (1) of this Article, order the seizure of the movable and immovable property of the opposing party, not directly related to the infringement, including the blocking of his bank accounts and other assets.

(3) For the purpose of ordering and enforcing the provisional measure referred to in paragraph (2) of this Article, the court may require from the opposing party or other relevant persons disposing with it, the communication of the banking, financial and other economic information, or the access to other relevant information and documents. The court shall ensure the protection of confidentiality of such information, and prohibit any misuse thereof.

(4) The provisional measure referred to in paragraph (1) of this Article may be ordered without informing the opposing party thereof, if the applicant for measures makes it likely that otherwise the provisional measure would not be effective, or that irreparable damage is threatened to occur. The provisional measure referred to in paragraph (2) of this Article may be ordered without informing the opposing party thereof, if the applicant for measures makes it likely that otherwise the provisional measure would not be effective, or that, taking into consideration a very serious circumstances of the infringement, this would be necessary. If a provisional measure is ordered without informing the opposing party thereof, the court shall communicate a decision on the provisional measure to the opposing party, promptly upon its enforcement.

(5) In the decision ordering a provisional measure the court shall specify the duration of such measure, and, if the measure has been ordered before the institution of a legal action, the period, within which the applicant for measures shall institute a legal action to justify the measure, which shall not be less than 20 working days and not more than 31 calendar days, from the day of communication of the decision to the applicant for measures, whichever expires later.

(6) The provisions of the Execution Act shall apply to matters, not regulated by this Article.

(7) The provisions of this Article shall be without prejudice to the possibility to order provisional measures pursuant to other provisions of this Act, and the provisions of the Execution Act.

## PROVISIONAL MEASURES COMPRISING THE PRESERVATION OF EVIDENCE

### Article 79c

(1) Upon the request of the holder of a trademark who makes it likely that his trademark has been infringed or threatened to be infringed, the court may order a provisional measure comprising the preservation of evidence.

(2) By the provisional measure referred to in paragraph (1) of this Article, the court may order in particular:

- preparation of a detailed description of the goods made likely to infringe a trademark, with or without taking of samples;
- seizure of the goods made likely to infringe a trademark;
- seizure of the materials and implements used in the production and distribution of the goods made likely to infringe a trademark and the documentation relating thereto.

(3) The provisional measure referred to in this Article may be ordered even without informing the opposing party thereof, if the applicant for measures makes it likely that there is a risk of evidence being destroyed or irreparable damage of incurring. If a provisional measure is ordered without informing the opposing party thereof, the court shall communicate a decision on the provisional measure to the opposing party, promptly upon its enforcement.

(4) In the decision ordering a provisional measure the court shall specify the duration of the measure, and, if the measure has been ordered before the institution of a legal action, the period, within which the applicant for measures shall institute a legal action to justify the measure, which shall not be less than 20 working days and not more than 31 calendar days, from the day of communication of the decision to the applicant for measures, whichever expires later.

(5) The provisions of the Execution Act shall apply to matters, not regulated by this Article.

(6) The provisions of this Article shall be without prejudice to the possibility of the court to order provisional measures comprising the preservation of evidence pursuant to the provisions of the Act on Civil Proceedings.

## TAKING OF EVIDENCE IN THE COURSE OF THE CIVIL PROCEEDINGS

### Article 79d

(1) Where a party to the civil proceedings invokes evidence claiming that it lies with the opposing party or under its control, the court shall invite the opposing party to present such evidence within a specified time limit.

(2) Where the holder of a trademark as a plaintiff in a legal action claims that the infringement of a trademark has been committed on a commercial scale for the purpose of acquiring commercial or economic benefit, and has made it likely during the proceedings, and where he invokes in the proceedings banking, financial or similar economic documents, papers or the like evidence, claiming that they lie with the opposing party or under its control, the court shall invite the opposing party to present such evidence within a specified time limit.

(3) Where the party, which is invited to present evidence, denies that the evidence lies with it or under its control, the court may take evidence to establish such a fact.

(4) The provisions of the Act on Civil Proceedings relating to the right of refusal to present evidence as a witness shall apply *mutatis mutandis* to the right of the party to refuse to present evidence.

(5) The court shall, taking into consideration all the circumstances of the case, decide at its own discretion, on the importance of the fact that the party having the evidence refuses to comply with the court's decision ordering it to present evidence, or denies, contrary to the court's opinion, that the evidence lies with it.

(6) Against the decision of the court referred to in paragraphs (1) and (2) of this Article a separate appeal shall not be allowed.

## EXPEDITIOUS PROCEEDINGS AND APPLICATION OF THE PROVISIONS OF OTHER ACTS

### Article 79e

(1) A procedure concerning the infringement of the rights under this Act shall be expeditious.

(2) The provisions of the Act on Civil Proceedings, and the Execution Act, respectively, shall apply to the procedures concerning the infringement of a trademark.

(3) Upon the request of the court or any of the parties to the procedure concerning the infringement of a trademark, the Office shall promptly accept a request for the declaration of the decision on the registration of a trademark invalid, filed before or during the civil action and shall subject it to the expeditious proceedings. The court shall, taking into consideration the circumstances of the case, decide whether it shall decide on the stay of proceedings up to the final decision on the request for the declaration of the decision on the registration of a trademark invalid, or not.

## **Part Thirteen: PROVISIONS CONCERNING MISDEMEANOURS**

### Article 80

(1) Any legal person who uses a sign which is identical with or similar to somebody else's trademark, reproduces it or imitates, affixes it to the goods or the packaging thereof, offers the goods designated by such a sign, puts them on the market or stocks them for such purposes, imports or exports the goods designated by such a sign, uses such a sign when providing services or on business papers and in advertising, without authorization, shall be punished for the misdemeanor by a fine amounting from HRK 20,000.00 up to 100,000.00 (Article 7 paragraph (2) items 1 and 2).

(2) The natural person shall be punished for a misdemeanor referred to in paragraph (1) of this Article by a fine amounting from HRK 2,000.00 up to 10,000.00.

(3) The responsible person in the legal person shall be punished for a misdemeanor referred to in paragraph (1) of this Article, by a fine amounting from HRK 5,000.00 up to 10,000.00.

(4) A natural person – a craftsman or other self-employed person, respectively, shall be punished for the misdemeanor, referred to in paragraph (1) of this Article, by a fine amounting from HRK 5,000.00 to 50,000.00, where the misdemeanor has been committed in the performance of her/his activities as a craftsman or other self-employed person, respectively.

(5) Articles intended or used for the committed misdemeanors referred to in paragraphs (1), (2), (3) and (4) of this Article shall be seized, and the court shall decide whether the objects unlawfully designated by a trademark are to be destroyed, made unrecognizable or used in any other way.

## **Part Fourteen: TRANSITIONAL AND FINAL PROVISIONS**

### **PENDING PROCEDURES CONCERNING APPLICATIONS FOR REGISTRATION OF A TRADEMARK**

#### **Article 81**

Procedures concerning trademark applications, as filed before the day the application of this Act starts, which are pending on the day the application of this Act starts, shall be carried out in compliance with the provisions of this Act.

### **OTHER PENDING PROCEDURES**

#### **Article 82**

(1) The procedures concerning the infringement of a trademark or the rights conferred by an application for the registration of a trademark which are pending on the day the application of this Act starts, shall be carried out in compliance with the provisions which were in force up to the day the application of this Act starts.

(2) The procedures concerning the declaration of the decision on the grant of a trademark null and void and the procedures concerning requests for ceasing of the effect of a trademark due to non-use which are pending on the day the application of this Act starts, shall be carried out in compliance with the provisions which were in force up to the day the application of this Act starts.

### **IMPLEMENTING REGULATION**

#### **Article 83**

The matters referred to in: Article 15 paragraph (3); Article 21 paragraph (1); Article 25 paragraph (2); Article 27 paragraph (4); Article 33 paragraph (3); Article 34 paragraph (2); Article 35 paragraph (2); Article 37 paragraph (3); Article 38 paragraph (4); Article 39 paragraph (8); Article 40 paragraph (4); Article 44 paragraph (8); Article 46 paragraph (4); Article 49 paragraph (8); Article 61 paragraph (1); Article 71 paragraph (1) and Article 72 of this Act shall be regulated by the Minister competent for the work of the Office in the Regulations, to be enacted by him upon a proposal of the Director General of the Office up to the day the application of this Act starts.

### **ABILITY CEASING OF THE VALIDITY OF OTHER PROVISIONS**

#### **Article 84**

On the day application of this Act starts, the provisions of the Law on Trademarks (Official Gazette No 78/99, 127/99) shall cease to be valid, except for the provisions



concerning the representation (Article 59), which shall be applied up to the enactment of a special regulation.

#### ENTRY INTO FORCE

##### Article 85

This Act shall enter into force on the eighth day from the date of its publication in the Official Gazette of the Republic of Croatia, and shall be applied as from January 1, 2004.

TRANSITIONAL AND FINAL PROVISIONS OF THE ACT ON AMENDMENTS  
TO THE TRADEMARKS ACT \*  
(NN 76/07)

Article 15

(1) The administrative disputes instituted before the Administrative Court before 1 June 2008 shall be completed before the Administrative Court in accordance with the provisions, which were in force up to that date.

(2) A party, which instituted a legal action before the Administrative Court before 1 June 2008, in accordance with the provisions which were in force up to that date, may require from the Administrative Court to stay the proceedings, provided that it has filed within 30 days from that date an appeal based on the same grounds and with the same statement of reasons as are those contained in the legal action, where an appeal against such administrative decision is admissible pursuant to the provisions of this Act. The administrative decision issued on such appeal in the second instance, may be subject to an administrative dispute pursuant to the provisions of the Act on Administrative Disputes.

Article 16

The procedures concerning the protection of a trademark in the case of infringement, pending on the date of the entry into force of this Act, shall be completed in accordance with the provisions, which were in force before the entry into force of this Act.

Article 17

The Ordinance referred to in Article 83 of the Trademarks Act (Official Gazette 173/2003) shall be aligned with the provisions of this Act, on a proposal given by the Director General of the Office, by the Minister responsible for the work of the Office, not later than within 3 months from the entry into force of this Act.

Article 18

This Act shall enter into force on the eighth day from the date of its publication in the Official Gazette of the Republic of Croatia, with the exception of Articles 2 and 7 thereof, which shall enter into force on 1 June 2008, and Article 6, which shall enter into force on the day of the acceptance of the Republic of Croatia into the European Union.

FINAL PROVISIONS OF THE ACT ON AMENDMENTS  
TO THE TRADEMARKS ACT\*\*  
(NN 30/2009)

Article 18

This Act shall enter into force on the eighth day from the date of its publication in the Official Gazette of the Republic of Croatia.

TRANSITIONAL AND FINAL PROVISIONS OF THE ACT ON AMENDMENTS  
TO THE TRADEMARKS ACT\*\*\*  
(NN 49/11)

Article 23

The Minister responsible for the work of the Office shall, on a proposal given by the Director General of the Office, harmonize the Regulations referred to in Article 83 of the Trademarks Act (“Official Gazette” Nos. 173/03, 76/07 and 30/09) with the provisions of this Act not later than within a period of two months from the day of the entry into force of this Act.

Article 24

This Act shall enter into force on the eighth day from the date of its publication in the Official Gazette of the Republic of Croatia.

TRANSITIONAL AND FINAL PROVISIONS OF THE ACT ON AMENDMENTS  
TO THE TRADEMARKS ACT\*\*\*\*  
(NN 46/18)

Article 5

The Minister responsible for supervision of the work of the State Intellectual Property Office shall harmonise the Trademark Regulations (»Official Gazette«, No. 117/07, 66/11, 125/13 and 43/17) with the provisions of this Act within 30 days from the day of the entry into force of this Act.

Article 6

(1) Administrative procedures instituted by the provisions of the Trademarks Act (»Official Gazette«, No. 173/03, 54/05, 76/07, 30/09 and 49/11) where the State Intellectual Property Office as the first instance authority issued the decision until the day of the entry into force of this Act shall be completed in accordance with the provisions of that Act and the regulations issued pursuant to that Act.

(2) Boards of Appeal in the field of industrial property rights established and appointed on the basis of the Patents Act (»Official Gazette«, No. 173/03, 54/05, 87/05, 76/07, 30/09, 128/10, 49/11 and 76/13) shall continue to operate in accordance with the provisions of that Act and the regulations issued pursuant to that Act until all the administrative procedures referred to in paragraph (1) of this Article are completed by reaching final decisions, after which they shall cease to operate.

(3) If, because of dismissal of the president or members of the Boards of Appeal referred to in paragraph (2) of this Article, it is not possible to determine the Board of Appeal to decide on an appeal, the procedure of electing or appointing the president or necessary number of members of the Boards of Appeal can exceptionally be conducted in accordance with the provisions of the Patents Act (»Official Gazette«, No. 173/03, 54/05, 87/05, 76/07, 30/09, 128/10, 49/11 and 76/13), for the needs of resolving the case referred to in paragraph (1) of this Article.

Article 7

This Act shall enter into force on the eighth day following the day of its publication in the »Official Gazette«.