

Act No. 441/2003 Coll. of 3 December 2003

On Trademarks and on amendments to Act No. 6/2002 Coll. on judgements, judges, assessors and state judgement administration and on amendments to some other Acts (Act on Courts and judges) in the wording of later regulations

ACT ON TRADE MARKS

PART ONE

TRADE MARKS

CHAPTER I

GENERAL PROVISIONS

Definition of a trade mark

Section 1

Signs of which a trade mark may consist

Under the terms of this Act, a trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, colours, designs, letters, numerals, the shape of goods or their packaging, provided that such sign is capable of distinguishing goods or services of one undertaking from those of another undertaking.

Section 2

The following trade marks are protected in the territory of the Czech Republic

- a) trade marks registered in the Register of trade marks (hereinafter referred to as “the Register”) maintained by the Industrial Property Office (hereinafter referred to as “the Office”) (hereinafter referred to as “national trade marks”),
- b) trade marks registered with effects for the Czech Republic in the register maintained by the International Bureau of the World Intellectual Property Organisation on the basis of an international application within the meaning of the Madrid Agreement concerning the International Registration of Marks or of the Protocol to the Madrid Agreement (hereinafter referred to as “international trade marks”),
- c) trade marks registered in the register maintained by the Office for Harmonisation in the Internal Market (trade marks and designs) on the basis of the Council Regulation on the Community trade mark (hereinafter referred to as the “Council Regulation”) (hereinafter referred to as “the Community trade marks”),
- d) trade marks which are well known in the territory of the Czech Republic within the meaning of Article 6*bis* of the Paris Convention for the Protection of Industrial Property (hereinafter referred to as “the Paris Convention”) and of Article 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as “well known trade marks”).

Section 3

For the purposes of this Act, an “earlier trade mark”, having regard to the claimed right of priority (Section 20) means

- a) a registered trade mark, if it has an earlier date of application, meaning
 1. national trade mark,
 2. international trade mark,
 3. Community trade mark;
- b) a Community trade mark, which has a valid claim to seniority from an earlier trade mark mentioned in letter a) point 1 and 2 within the meaning of Article 34 of the Council Regulation, even if such an earlier trade mark was surrendered by its proprietor or when such an earlier trade mark ceased to exist;
- c) a trade mark in respect of which an application for registration has been made pursuant to letters a) and b), if such a trade mark is registered;
- d) a well known trade mark, the protection of which is dated before the date of application for a subsequent trade mark, if such protection persists to the date of application for the subsequent trade mark.

Grounds for refusal of protection

Section 4

The following shall not be registered

- a) a sign which is not capable of serving as trade mark within the meaning of Section 1,
- b) a sign which is devoid of any distinctive character,
- c) a sign which consists exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of goods or of rendering of services, or other characteristics of goods or services,
- d) a sign which consists exclusively of signs or indications which have become customary in the current language or in *bona fide* and established practices of the trade,
- e) a sign which consists exclusively of the shape which results from the nature of the product itself or which is necessary to obtain a technical result or which gives substantial value to the product,
- f) a sign which is contrary to public policy or to accepted principles of morality,
- g) a sign which is of such a nature as to deceive the public, mainly as to the nature, quality or geographical origin of the goods or services,
- h) a sign applied for wines or spirits which contains a geographical indication, and such wines or spirits do not have that geographical origin,
- i) a sign which contains signs protected by virtue of Article 6ter of the Paris Convention without the authorisation to registration of the competent authorities,

- j) a sign which contains badges, emblems and escutcheons other than those mentioned in Article 6^{ter} of the Paris Convention, if their use is subject of special public interest, unless the competent authority has given its consent to such signs being registered,
- k) a sign which contains signs of high symbolic value, mainly religious symbols,
- l) a sign the use of which is contrary to provisions of other laws or which is contrary to the obligations of the Czech Republic ensuing from international treaties,
- m) if it is obvious that the application for registration of the trade mark (hereinafter referred to as “the application for registration”) has not been filed in good faith.

Section 5

A sign mentioned in Section 4 letters b) to d) can be registered in the Register, if the applicant proves that before registration of the mark in the register, such a sign has acquired distinctive character in relation to goods or services of the applicant, for which the registration is requested, in consequence of use of the sign in the trade.

Section 6

A sign shall not be registered in the register if it is identical with an earlier trade mark which is applied for or registered for another proprietor or applicant for identical goods or services; this does not apply if the proprietor or the applicant of the earlier trade mark grants a written consent to the registration of the subsequent trade mark in the register.

Section 7

(1) The sign applied for shall not be registered in the register upon opposition against the registration of the trade mark in the register (hereinafter referred to as “the opposition”) filed with the Office by

- a) the proprietor of an earlier trade mark if because of the identity or similarity with the earlier trade mark and because of the identity or similarity of the goods or services covered by the sign applied for and the trade mark there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes also the likelihood of association with the earlier trade mark,
- b) the proprietor of an earlier trade mark which is identical with or similar to the sign applied for, if this sign is to be registered for goods or services which are indeed not similar to those goods or services covered by the earlier trade mark, but the earlier trade mark has a good reputation in the Czech Republic, and the use of that sign would without due cause take unfair advantage of or would be detrimental to the distinctive character or the reputation of the earlier trade mark,
- c) the proprietor of an earlier well known trade mark, if because of the identity or similarity with the earlier well known trade mark and the identity or similarity of the goods or services covered by the sign applied for and the well known trade mark there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trade mark,
- d) the proprietor of an earlier well known trade mark which is identical with or similar to the sign applied for, if this sign is to be registered for goods or services which are indeed not

similar to those goods or services covered by the earlier well known trade mark, but the earlier well known trade mark has a good reputation in the Czech Republic, and the use of that sign would suggest a relationship between the goods or services and the proprietor of the earlier well known trade mark,

- e) the proprietor of an earlier Community trade mark which is identical with or similar to the sign applied for, if this sign is to be registered for goods or services which are indeed not similar to those goods or services covered by the earlier trade mark, but the earlier trade mark has a good reputation in the territory of the European Communities and the use of the sign applied for would without due cause take unfair advantage of or would be detrimental to the distinctive character or the reputation of the earlier Community trade mark;
- f) the proprietor of a trade mark registered in another State party of the Paris Convention or in a member country of the World Trade Organisation, if the application for registration has been filed by a representative or agent or another person entrusted with the protection of economic interests of the proprietor of the trade mark pursuant to Article 6septies of the Paris Convention (hereinafter referred to as “the agent”) in his own name without the proprietor’s consent, unless the agent justifies his action;
- g) the proprietor of a non-registered sign or of another sign used in the course of trade of more than mere local significance for identical or similar goods and services, if such sign is identical with or similar to the sign applied for, if the rights to that sign were acquired prior to the date of the application for registration;
- h) the natural person whose rights to his/her name and whose rights to the protection of personal performances could be affected by the sign applied for, or by a person who is entitled to claim these personal rights;
- i) the proprietor of copyright, if the work protected by the copyright could be affected by the use of the sign applied for;
- j) the proprietor of an earlier industrial property right, if the rights from the industrial property right can be affected by the use of the sign applied for;
- k) any person who is affected in his/her rights by the application for registration, which has not been filed in *bona fide*.

(2) The opposition pursuant to paragraph 1 letters a), b), e) and f) can be also filed by the applicant for registration of the trade marks mentioned in these provisions.

(3) If the person entitled to file opposition pursuant to paragraph 1 (hereinafter referred to as “the opponent”) grants consent to the registration of the trade mark applied for in the register after the opposition has been filed, the opposition is deemed to be withdrawn and the Office terminates the opposition proceeding.

CHAPTER II

EFFECTS OF A TRADE MARK

Section 8

Rights conferred by a trade mark

(1) The proprietor of the trade mark shall have the exclusive right to use the trade mark in relation to the goods or services covered by the trade mark. The proprietor of the trade mark proves his rights by means of an abstract from the Register, or by means of a certificate of registration. The proprietor of the trade mark has the right to use the sign ® together with the trade mark.

(2) Unless otherwise provided by this Act (Sections 10 and 11), third parties may not use without the consent of the proprietor of the trade mark in the course of trade

- a) any sign which is identical with the trade mark for goods or services which are identical with those for which the trade mark is registered;
- b) any sign where because of its identity with or similarity to the trade mark and because of the identity or similarity of the goods or services to which the trade mark and that sign are affixed, there exists a likelihood of confusion on the part of the public, including the likelihood of association between the sign and the trade mark;
- c) any sign identical with or similar to the trade mark for goods or services which are not similar to those for which the trade mark is registered, where the trade mark has a good reputation in the Czech Republic and where the use of that sign would without due course take advantage of or be detrimental to the distinctive character or the good reputation of the trade mark.

(3) For the purposes of paragraph 2, the use in the course of trade means, in particular,

- a) affixing the sign to goods or the packaging thereof,
- b) offering goods for sale, putting them on the market or stocking them for those purposes under the sign, or offering or supplying services under the sign,
- c) importing or exporting goods under the sign,
- d) using the sign on business papers or in advertising.

(4) In case of infringement of trade mark rights the proprietor of the trade mark has the right to apply to the court for an order prohibiting the infringement or the impending infringement and the consequences of the infringement be remedied; the proprietor of the trade mark may also claim appropriate satisfaction, including pecuniary appropriate satisfaction. The right to claim the surrender of unjustified enrichment and to claim the damages shall not be affected.

(5) The proprietor of the trade mark may also claim damages caused by actions committed after the date of publication of the application for registration. The court shall decide upon the merits of the case after the registration of the trade mark in the register.

(6) The proprietor of the trade mark has towards any third person who puts or intends to put on the market goods or to offer services, to which or to the packaging of which or in the documents accompanying them a mark identical or similar with his trade mark is affixed, the right to obtain information on the origin of the goods or of the documents accompanying the goods or services; the authority to decide on this right lies with the court; the court shall refuse the legal action if this would be out of proportion to the seriousness of the infringement or endangering.

(7) The proprietor of the trade mark may apply to the court to order any third party infringing or endangering his trade mark rights to withdraw from the market and to destroy goods, whose manufacturing or introduction on the market would endanger or infringe the rights protected by this Act, or to destroy materials and tools which are to be used or which are used

exclusively or predominantly for activities endangering or infringing the rights protected by this Act. The court shall not order the destruction, if the person against whom the claim is directed is not the proprietor of the goods, or where the endangering or the infringement of the right could be remedied otherwise and the destruction would not be proportionate to the endangering or the infringement. The removal of the sign or the counterfeit trade mark from the goods before their introduction on the market may be allowed only in exceptional cases.

(8) If the trade mark has been registered in the name of the agent without the consent of the proprietor of the trade mark (hereinafter referred to as “the trade mark registered in the name of the agent”), the proprietor of the trade mark has the right to prohibit the agent from using the trade mark, unless the agent justifies his action.

Section 9

Reproduction of trade marks in dictionaries

If the reproduction of a registered trade mark in a dictionary, encyclopaedia or similar reference work gives the impression that it constitutes a generic name of goods or services, the proprietor of the trade mark may ask the publisher to ensure that the reproduction of the trade mark at the latest in the next edition of the publication is accompanied by an indication that it is a registered trade mark.

Section 10

Limitation of the effects of a trade mark

(1) The proprietor of a trade mark is not entitled to prohibit third persons from using in the course of the trade

- a) their name and surname, corporate name or name or address,
- b) indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- c) a sign where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts,

provided they use them in accordance with honest commercial practices, good morals and competition rules.

(2) The proprietor of a trade mark has to tolerate in the course of trade the use of an identical or similar sign, where the rights to this sign were created prior to the date of filing the application for registration and the use of that sign is in accordance with the laws of the Czech Republic.

Section 11

Exhaustion of trade mark rights

(1) The proprietor of a trade mark is not entitled to prohibit its use in relation to goods which have been put on the market in the Czech Republic under that trade mark by the proprietor or with his consent.

(2) The proprietor of a trade mark is not entitled to prohibit its use in relation to goods which have been put on the market in a member state of the European Communities or in another member state of the European Economic Area under that trade mark by the proprietor or with his consent.

(3) The provisions of paragraphs 1 and 2 above do not apply where the proprietor of the trade mark has legitimate reasons to prohibit further commercial dealings in the goods, in particular where the condition of the goods has been changed or impaired after they have been put on the market.

Section 12

(1) The proprietor of an earlier trade mark or the proprietor/user of an earlier sign mentioned in Section 7 paragraph 1 letter g) is not entitled to claim a later identical or similar trade mark be revoked (Section 32), or to prohibit its further use, if the proprietor of the earlier trade mark has tolerated the use of that later trade mark for 5 (five) years from the day on which the proprietor of the earlier trade mark learned about the use of the later trade mark, unless the application for registration of the later trade mark has not been filed in *bona fide*.

(2) The proprietor of the later trade mark is not entitled to prohibit the use of the identical or similar earlier trade mark or to claim that earlier trade mark be revoked, even if the proprietor of the earlier trade mark would no longer be entitled to enforce his trade mark rights.

CHAPTER III USE OF A TRADE MARK

Section 13

Use of a trade mark

(1) If, within the period of five years following the registration, the proprietor of the trade mark has not put the trade mark to genuine use for goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be subject to the sanctions provided for in this Act (Sections 14 and 31), unless there are proper reasons for non-use.

(2) The proper use of a trade mark for the purpose of paragraph 1 includes also

- a) use of the trade mark in a form differing in elements which do not alter the distinctive character of the trade mark in the form in which it was registered,
- b) affixing of the trade mark to goods or to the packaging of goods solely for export purposes.

(3) The use of a trade mark on the basis of a licence agreement (Section 18) and the use of a collective trade mark by an authorised person shall be deemed to constitute use by the proprietor.

Section 14

Some consequences of non-use of trade mark

- (1) A trade mark cannot be revoked because of an earlier trade mark, if this earlier trade mark does not fulfil the conditions of use as mentioned in Section 13.
- (2) If the earlier trade mark is not used within the meaning of Section 13 for all goods and services for which this trade mark is registered, the earlier trade mark can constitute a ground for revocation of a later trade mark only in respect to those goods and services, for which the earlier trade mark is used.

CHAPTER IV

TRADE MARK AS OBJECT OF PROPERTY

Change of ownership

Section 15

- (1) The trade mark may be assigned independently from any assignment of the undertaking in respect of all or some of the good or services for which the trade mark is registered. The assignment of the trade mark shall be made in writing by means of a contract.
- (2) The trade mark shall be transferred to a new proprietor also in cases pursuant to special laws.
- (3) The assignment or the transfer of the trade mark become effective towards third persons upon its entry in the Register; the assignee of the trade mark may take any actions towards the Office once the request for entry of the assignment or transfer has been delivered to the Office. Any of the contractual parties may request the entry of the assignment or transfer in the Register, or in case of a transfer the entry may be requested by the legal successor of the original proprietor. The requirements of the request for the entry of the assignment or transfer of the trade mark concerning the parties and the respective trade mark shall be laid down in the implementing regulation.
- (4) The provisions of paragraphs 1 to 3 shall be applied accordingly to the assignment and transfer of the application for registration.

Section 16

The proprietor of a trade mark which is registered in a Convention country of the Paris Convention may apply to the court for a declaration of his right to have the Register rectified so as to substitute his name as the proprietor of the trade mark, if the trade mark has been registered in the name of the agent. The court shall refuse the application if the agent justifies his actions properly and presents evidence for the reasons. On the basis of the final judgement the Office shall record the change of the proprietor of the trade mark in the Register and the Office shall publish this fact in the Official Journal of the Czech Industrial Property Office (hereinafter referred to as "Official Journal"). The requirements of the request for the substitution of the proprietor of the trade mark concerning the parties and the respective trade mark shall be laid down in the implementing regulation.

Section 17

Other rights

- (1) The trade mark may be given as security, levied in execution and it may be levied in bankruptcy proceeding or in the proceedings on compulsory settlement.
- (2) Upon request the Office shall enter the facts mentioned in paragraph 1 in the Register, and this within the time limit of one month from the filing of the request. The requirements of the request for the entry concerning the parties and the respective trade mark shall be laid down in the implementing regulation.
- (3) The lien on the trade mark is perfected upon its entry in the Register, unless otherwise stipulated by other special law.

Section 18

Licences

- (1) The right to use the trade mark may be licensed by means of a licence agreement concluded pursuant to a special legal regulation for all or some of the goods or services for which the trade mark is registered. The licence may be granted as exclusive or non-exclusive.
- (2) The proprietor of the trade mark may invoke his rights conferred by his trade mark against a licensee who breaches any provision of the licence agreement with regard to its duration, the form in which the trade mark may be used, the scope of goods and services for which the licence is granted, the territory in which the trade mark may be used, or the quality of goods manufactured or services provided by the licensee.
- (3) The licence agreement becomes effective against third persons upon its entry in the register; any of the parties to the agreement may request the entry in the register. The requirements of the request for the entry of the licence agreement in the register concerning the parties to the proceeding and the respective trade mark shall be laid down in the implementing regulation.
- (4) Unless otherwise provided by the licence agreement, the licensee may bring proceedings for infringement of the trade mark rights only with the consent of the proprietor of the trade mark. However, the holder of an exclusive licence may bring such proceedings for infringement without the consent of the proprietor of the trade mark, if the proprietor of the trade mark does not bring himself the proceedings for infringement of the trade mark rights within 2 (two) months after he has received the notice of the licensee about the infringement of the trade mark rights.

CHAPTER V

APPLICATION

Section 19

Application for registration

- (1) Application for registration of a trade mark shall be made to the Office; each application for registration may comprise only one trade mark.
- (2) The application shall contain
 - a) a request for registration of the trade mark in the register,

- b) the name and address of the natural person and his/her permanent address, or an address for service, if the applicant is a natural person, or the corporate name, or other name and the seat, if the applicant is a legal person (hereinafter referred to as “the information identifying the applicant”),
 - c) information identifying the representative, if the applicant is represented by a representative,
 - d) a list of goods or services in respect of which it is sought to register the trade mark,
 - e) a representation of the trade mark.
- (3) Within 1 (one) month from the date of filing of the application, the applicant has to pay the administrative fee pursuant a special law; if the administrative fee is not paid within the prescribed time limit, the application is deemed as not filed. The time limit for the payment of the application fee cannot be extended and the non-observance of this time limit cannot be restituted.
- (4) The list of goods and services for which the registration of the trade mark is sought shall be listed in the application in the order as listed in the international classification together with the respective number of the class. The administrative fee pursuant to paragraph 3 shall be paid in the amount corresponding to the number of the classes of the international classification of the goods and services for which the application for registration of the trade mark is filed. The Office publishes the International Classification of Goods and Services in such way which enables access by means of telecommunications.
- (5) If the applicant claims the right of priority pursuant to Section 20, the applicant shall state in the application the date of filing of the application from which the right of priority is derived and the country in which the application has been filed. If the applicant claims right of priority from more than one application, the applicant has to state for each of the goods and services from which application the right of priority is claimed.
- (6) The application has to be signed by the applicant or his representative.
- (7) Further requirements of the application concerning information about the representation of the trade mark are laid down in the implementing regulation.

Section 20

Date of filing the application

- (1) With the date of filing the application, the applicant acquires the right of priority against any third person who later files an application for an identical or similar trade mark for identical or similar goods or services.
- (2) The right of priority ensuing from the Paris Convention has to be claimed by the applicant in the application and it has to be proven within 3 (three) months after the filing of the application, otherwise the Office shall not grant the right of priority. The right of priority may be claimed from an application filed in any Convention country of the Paris Convention or in a member country of the World Trade Organization; if the country of the first application is neither a Convention country of the Paris Convention nor a member country of the World Trade Organization, the right of priority based on this application can be granted under the condition of mutuality. The time period for proving the right of priority cannot be extended and the non-observance of this time limit cannot be restituted.

(3) Upon request of the applicant, the Office shall issue a certificate about the grant of the right of priority (the priority certificate).

CHAPTER VI APPLICATION PROCEDURE

Section 21

Formal examination

(1) The Office shall examine whether the application satisfies the requirements as laid down in Section 19.

(2) If the application does not satisfy the requirements as laid down in Section 19 paragraph 1, 2, 4 to 6, the Office shall request the applicant to remedy the deficiencies within the prescribed time limit, which cannot be shorter than 15 (fifteen days).

(3) If the deficiencies of the requirements as laid down in Section 19 paragraph 1, 2, 4 and 6 are not remedied, the Office shall refuse the application.

(4) If the administrative fee is not paid in the amount as laid down in Section 19 paragraph 4, the Office shall request the applicant after the expiry of the time limit as laid down in Section 19 paragraph 3 to pay the outstanding amount of the fee and the Office can set a time limit of 15 (fifteen days) for the payment of the outstanding amount. If the outstanding fee is not paid within this time limit, the application is deemed to be filed in the scope of classes of goods and services corresponding to the paid amount. If it is not clear to which classes of goods or services the paid amount corresponds, the application is deemed to be filed for classes of goods and services as given in the application in the ascending order, which are covered by the paid amount. If the administrative fee is not paid in the amount corresponding to the administrative fee for the filing of the application, the administrative fee is deemed not to be paid and the Office shall refund the paid amount of the administrative fee to the applicant.

Section 22

Substantive examination

(1) If the sign applied for does not meet the conditions for registration pursuant to Section 4 or 6, the Office shall refuse the application. If the sign applied for does not meet the conditions for registration only in respect to some goods or services, the Office shall refuse the application as regards those goods or services. The Office shall publish the information about the decision on the refusal of the application in the Official Journal.

(2) The Office shall refuse the application, if the sign applied for contains elements of an earlier trade mark, which has been applied for or registered for another proprietor, if these elements could cause confusion with the earlier trade mark; the Office shall not refuse the application if the proprietor or applicant of the earlier trade mark grants written consent to the registration of the earlier trade mark in the register.

(3) If the sign applied for contains an element which is not distinctive and if the inclusion of the said element in the trade mark could give rise to doubts as to the scope of protection, the applicant may limit the scope of protection in respect to the element of the trade mark; the

Office shall publish the limitation of the scope of protection together with the application (Section 23). The limitation of the scope of protection cannot be withdrawn.

(4) Before the decision on refusal of an application, the Office has to allow the applicant to submit his arguments to the grounds, for which the Office intends to refuse the application.

Section 23

Publication of the application

If the conditions as laid down in this Act have been fulfilled, the Office shall publish the application in the Official Journal.

Observations and opposition

Section 24

Observations

(1) Any person may at any time before the registration of the trade mark in the Register make observations in writing to the Office based in particular on grounds pursuant to Section 4 or 6; the Office shall consider the observations while deciding on the registration of the trade mark in the register. A person who has made the observations does not thereby become a party to the proceedings on the application.

(2) The Office has to inform the applicant about the observations and about the outcome of their consideration and the applicant may submit his comments to the observations within the time limit set by the Office. The Office shall inform the person who has made the observations about the outcome of the consideration of the observations.

(3) The observations mentioned in paragraph 1 cannot be filed for grounds pursuant to Section 7. The observations have to fulfil requirements as laid down in the implementing regulation.

Section 25

Opposition

(1) Persons mentioned in Section 7 may file opposition within the period of 3 (three) months following the publication of the application; the opposition may be filed based on grounds mentioned in Section 7. The time limit for filing the opposition cannot be extended and the non-observance of this time limit cannot be restituted.

(2) The opposition has to be filed in writing and the opposition has to include grounds on which it is made and the opposition has to be supported by evidence. The Office shall not consider any amendments to the opposition or any evidence submitted in support of the opposition made after the time limit as mentioned in paragraph 1. Together with the opposition the opponent has to pay the administrative fee pursuant to a special legal regulation; if the opposition fee is not paid, the opposition is deemed as not to be filed.

(3) The detailed requirements of the opposition shall be laid down in the implementing regulation.

Section 26

Opposition proceedings

- (1) The Office shall terminate the opposition proceedings, if the reason for filing the opposition has ceased to apply. The Office shall deliver the decision terminating the opposition proceedings to both the applicant and the opponent.
- (2) The Office shall refuse the opposition if it is not filed within the time limit, or if the opposition is not filed by a person mentioned in Section 7, or if the opposition does not include grounds on which it is made or it is not supported by evidence.
- (3) If the Office does not terminate the opposition proceedings pursuant to paragraph 1 or if the Office does not refuse the opposition pursuant to paragraph 2, the Office shall inform the applicant about the content of the opposition and it shall set a time limit, within which the applicant may present his observations to the opposition. The Office may also invite the opponent and the applicant to make a friendly settlement on the opposition within the time limit as set by the Office. If the opposition has been withdrawn, the Office shall terminate the proceeding on the opposition. If the applicant has not presented his arguments to the opposition within the time limit as set by the Office, the Office shall decide on the opposition based on the documentary evidence as contained in the file.
- (4) The Office shall refuse the opposition, if the Office concludes that the trade mark applied for does not infringe upon the rights of persons mentioned in Section 7 as protected by law.
- (5) If in the course of the opposition proceedings the Office concludes that the trade mark applied for does not fulfil the requirements for registration for some of the goods or services for which the application has been filed, the application shall be refused in respect of the goods or services for which the application does not fulfil the requirements for registration.
- (6) The Office shall deliver the decision in writing on the refusal of the application or the decision on the refusal of the opposition to the applicant and the opponent. The Office shall publish the information on the refusal of the application or on the refusal of the opposition in the Official Journal.

Section 27

Amendment of the application

- (1) Unless otherwise provided, it is not possible to make any changes in the application after the filing of the application, it is in particular not possible to extend the list of goods and services, for which the application has been filed.
- (2) The application may be amended upon request of the applicant only for the purpose of correcting the name and surname, name, corporate name and address of permanent residence, the seat, or the errors in formulations, copying or other obvious mistakes, provided that such amendment is in accordance with the reality and that it does not substantially change the sign applied for. Where the amendment affects the sign applied for or the list of goods or services and it is made after the publication of the application, the application shall be published again as amended.
- (3) The applicant may at any time withdraw his application. The Office shall terminate the proceedings on application which has been withdrawn; the administrative fee which has been already paid shall not be refunded.
- (4) The applicant may at any time restrict the list of goods or services in the application. This restriction cannot be withdrawn.

(5) Until the registration of the trade mark in the register, the applicant can split an application which has been filed for more goods or services. The right of priority from the original application shall be accorded also to the split applications, provided they contain only goods or services as contained in the original application. The application has to pay an administrative fee pursuant to a special legal regulation for the applications which originated from the splitting of the original application.

(6) The requirements of the request for the amendment and the splitting of the application concerning the applicant, or his representative, the proceedings and the information on the trade mark applied for shall be laid down in implementing regulation.

(7) The provisions of paragraphs 1 and 2 shall be applied accordingly to a registered trade mark.

Section 28

Registration

(1) Where the application meets the requirements of this Act and the proceedings on the application have not been terminated and no opposition was filed within the time limit pursuant to Section 25 paragraph 1 or where the opposition was refused by a definitive decision or the opposition proceedings was terminated by a definitive decision, the Office shall register the trade mark in the register together with the date of the registration and the Office shall issue to the proprietor of the trade mark a certificate of registration of the trade mark in the register.

(2) The Office shall publish the registration of the trade mark in the register in the Official Journal.

(3) The registration of the trade mark takes effect with the day of registration of the trade mark in the register.

CHAPTER VII

DURATION AND RENEWAL OF THE TRADE MARK REGISTRATION

Section 29

Duration and renewal of trade mark registration

(1) The trade mark shall be registered for a period of 10 (ten) years from the date of filing of the application. If the proprietor does not request the renewal of the registration, the trade mark shall lapse.

(2) The registration of a trade mark shall be renewed upon request of the proprietor of the trade mark for the period of the next ten years. The filing of the request for renewal of the registration is subject to payment of administrative fee pursuant to a special legal regulation. The request for renewal may be filed at the earliest within 12 months before the expiry of the registration, however at the latest on the day of expiry of the validity. The requirements of the request for renewal of the trade mark registration are laid down in the implementing regulation. The time limit for filing the request for renewal of the trade mark registration cannot be extended and the non-observance of this time limit cannot be restituted.

(3) If the administrative fee is not paid or if it is not paid in the appropriate amount, the Office shall request the proprietor of the trade mark to pay the administrative fee within the time limit as set by the Office, or to pay the outstanding amount of the administrative fee. If the administrative fee is not paid within the set time limit, or if the outstanding administrative fee is not paid, the request for renewal of the registration is deemed as not filed; the Office shall refund the paid portion of the administrative fee to the applicant.

(4) The request for renewal of the registration may be filed at the latest within the additional period of 6 (six) months following the expiry of the registration; the double amount of the administrative fee referred to in paragraph 2 has to be paid.

(5) If the request for renewal of the registration is filed outside the time limits as mentioned in paragraphs 2 or 4, it shall be deemed as not filed; the Office shall refund the paid administrative fee to the applicant.

(6) If the request for renewal is filed in respect of only some of the goods or services for which the trade mark is registered, the registration shall be renewed only for those goods or services.

(7) The renewal of the registration shall take effect as of the date of expiry of the registration of the trade mark; the Office shall register the renewal in the register and it shall publish the renewal in the Official Journal.

CHAPTER VIII

SURRENDER, REVOCATION AND INVALIDITY

Section 30

Surrender of trade mark rights

(1) The proprietor may surrender his rights to the trade mark by means of a written declaration in respect of some or all goods or services for which the trade mark is registered; the surrender shall take effect with the date of delivery of the respective declaration of the proprietor to the Office and the surrender cannot be withdrawn. The Office shall enter the surrender of the rights to the trade mark in the register and it shall be published in the Official Journal.

(2) The proprietor of a trade mark may by means of a written declaration filed with the Office limit the scope of protection in respect to an element of the trade mark. The Office shall decide on the limitation of the scope of protection taking into account the fulfilment of the requirements as laid down by this Act. The limitation of the scope of protection cannot be withdrawn.

Section 31

Revocation

(1) The Office shall revoke the trade mark in a proceeding started at the request of a third person -

- a) if the trade mark has not been properly used within the continuous period of 5 (five) years for goods or services in respect of which the trade mark is registered, and there are no proper reasons for non-use; the use which commenced or which was

resumed following 5 (five) years of non-use of the trade mark within three months preceding the filing of the request for revocation shall be disregarded where the preparations for the commencement or the resumption of the use occurred only after the proprietor becomes aware that a request for revocation of the trade mark might be filed;

- b) if by the consequence of acts or inactivity of the proprietor the trade mark has become the common name in the trade for products or services for which it is registered;
- c) if the trade mark after the date of its registration in consequence of the use made of it by the proprietor or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) In a proceeding started upon request filed within 6 (six) months following the date on which the court decision declaring the use of a trade mark to be unfair competition conduct becomes final, the Office shall revoke the trade mark. The time limit for filing the request for revocation of the trade mark cannot be extended and the non-observance of this time limit cannot be restituted.

(3) If the ground for revocation exists in respect of only some of the goods or services for which the trade mark is registered, the Office shall revoke the trade mark only in respect of those goods or services.

Section 32

Invalidity

(1) The Office shall upon request of a third person or on its own motion declare a trade mark invalid, if the trade mark has been registered in breach of the provisions of Section 4 or Section 6.

(2) Where the trade mark has been registered in breach of Section 4 letter b) or c) or d), it shall not be declared invalid if it has acquired a distinctive character in consequence of its use for goods or services for which it is registered after its registration.

(3) The Office shall also declare a trade mark invalid in proceedings instigated upon motion of a person mentioned in Section 7 and for reasons mentioned in that provision.

(4) Where the trade mark is declared invalid, the trade mark shall be deemed never to have been registered.

(5) A trade mark may be declared invalid even after its proprietor surrendered the trade mark or after the trade mark lapsed.

(6) Where the ground for invalidity exists only in respect of some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

Section 33

Special provisions on effects of revocation and invalidity

1) Effects of the revocation or invalidity of a trade mark do not affect

- a) decisions in the matter of infringement of trade mark rights which became effective and which were enforced before the effective date of the decision on revocation or invalidity of a trade mark,
 - b) agreements concluded before the effective date of the decision on revocation or invalidity of a trade mark in the extent of the fulfilment provided on their basis before the effective date of such a decision (on revocation or invalidity); it is however possible to claim the surrender of the fulfilment already provided on the basis of the agreement.
- (2) The provision of paragraph 1 does not affect the liability of the proprietor of the trade mark for damage or unjustified enrichment.

Section 34

Action for revocation or declaration of invalidity

- (1) The action for revocation or declaration of invalidity of a trade mark shall be filed in writing and it shall contain grounds and it shall be supported by evidence. It shall be deemed filed only after the payment of the administrative fee under a special legal regulation.
- (2) The requirements of the action for revocation or declaration of invalidity of a trade mark concerning the parties to the proceedings and particulars of the trade mark shall be laid down in the implementing regulation.
- (3) The Office shall invite the proprietor of the trade mark to present his statement to the action for revocation or declaration of invalidity . If the proprietor of the trade mark does not present his statement within the set time limit, the Office shall decide on the basis of the content of the file.

CHAPTER IX

SPECIAL PROVISIONS CONCERNING COLLECTIVE TRADE MARKS

Section 35

Collective trade mark

- (1) A collective trade mark is trade mark which is described as such already when the trade mark is applied for and is capable of distinguishing the goods and services of the members or shareholders of a legal person or of the members of an association from the goods and services of other persons.
- (2) The conditions of use of the collective trade mark including the sanctions for the breach of the conditions shall be laid down in a written agreement on use of the collective trade mark concluded among all members or shareholders of the legal person or among all members of the association (hereinafter referred to as “the agreement on use”).
- (3) Unless otherwise provided, the provisions of Section I to VIII and X do apply accordingly to the application for the collective trade mark, the application proceedings, the rights from the collective trade mark, the revocation proceedings and the invalidation of the collective trade mark.

Section 36

Requirements of the application for collective trade mark

- (1) Application for registration of a collective trade mark shall be made in writing to the Office.
- (2) Besides the requirements mentioned in Section 19, the application for a collective trade mark has to contain information on the identity of the members, shareholders or members of the applicant who may use the trade mark.
- (3) The agreement on use has to be enclosed to the application for a collective trade mark.

Section 37

Examination of application for collective trade mark

- (1) The Office shall examine the application for a collective trade mark within the scope of Section 21 to 27, and the Office shall consider the fulfilment of the condition laid down in Section 4 letter b) with respect to Section 35 paragraph 1.
- (2) Upon request the Office shall record in the register any change of the members or shareholders of the legal person or of the members of the association.

Section 38

Rights conferred by a collective trade mark

- (1) The members or the shareholders of the legal person or the members of the association registered in the register have the exclusive right to affix the collective trade mark to goods or services covered by the collective trade mark or to use the trade mark in relation to the goods or services cover by the collective trade mark.
- (2) The proprietor of the collective trade mark has the rights within the scope of Section II of this Act, unless otherwise provided in this Section.
- (3) The members or shareholders of the legal person or the members of the association have the rights pursuant to paragraph 1 under conditions laid down in the agreement on use.

Section 39

Limits on rights conferred by a collective trade mark

The collective trade mark cannot be subject of licence and it cannot be given as pledge and it cannot be assigned to another person.

Section 40

Revocation and invalidation of collective trade mark

- (1) For revocation of the collective trade mark, the provisions of Section 31 shall apply.
- (2) The Office shall revoke the collective trade mark if the members or the shareholders of the legal person or the members of the association seriously breach the agreement of use and they do not agree on the change of the agreement on use or if the legal person or the association ceased to exist.

(3) For the invalidation of the collective trade mark, the provision of Section 32 shall be applied and the fulfilment of the condition laid down in Section 4 letter b) is to be considered with respect to Section 35 paragraph 1.

CHAPTER X

GENERAL PROVISIONS ON THE PROCEDURE BEFORE THE OFFICE

Section 42

Submissions

Any submission to the Office is to be made in the Czech language.

Section 43

Appeal

(1) An appeal shall lie from any decision of the Office within the time limit of one month from the delivery of the decision. The appeal shall have suspensive effect. The time limit for filing the appeal cannot be extended and the non-observance of this time limit cannot be restituted.

(2) The appeal shall be deemed to have been filed only after the administrative fee pursuant to a special legal regulation has been paid.

(3) The substantive statement of the appeal has to be filed with the Office within one month after the filing of the appeal. The time limit for filing the substantive statement of the appeal cannot be extended and the non-observance of this time limit cannot be restituted.

Section 43

Restitutio in integrum

(1) If the applicant proves that he was unable to observe a time limit prescribed by the law or by the Office and that the non-observance was not due to his own fault, the Office shall re-establish his rights (*restitutio in integrum*) upon the application of the applicant, unless otherwise provided by this Act.

(2) The application pursuant to paragraph 1 must be filed in writing within two months from the removal of the cause for which the act could not be taken, at the latest within 12 months following the expiry of the time limit within which the act should have been taken; the applicant must state in the application the grounds on which he could not observe the time limit and the applicant must take the omitted act and pay the administrative fee for the *restitutio in integrum* pursuant to a special legal regulation. The time limit for filing the application for the *restitutio in integrum* cannot be extended and the non-observance of this time limit cannot be restituted.

(3) If the Office grants the application for the *restitutio in integrum*, the legal effects of the termination of the proceedings or of the loss of other right shall not occur; the Office shall publish the decision on the grant of the application for the *restitutio in integrum* in the Official Journal.

(4) Rights acquired by third persons in good faith in the course of the period between the termination of the proceeding and the mention of the grant of the application for the *restitutio in integrum* in the Official Journal shall not be affected by the decision to grant the application for the *restitutio in integrum*.

Section 44

Register and Official Journal

(1) The Office shall maintain a register which contains decisive particulars of applications for trade marks and decisive particulars of registered trade marks as provided by this Act, the implementing regulation or as decided by the Office.

(2) The register shall be public and it shall be open for public inspection by any person and any person can make copies and extracts from it. Upon application the Office shall issue an officially certified complete extract or a partial extract from the register or a copy of the registration or a certificate of a particular registration or a certificate that a particular information does not exist in the register. The certification certifies the conformity of the extract or the copy with the particulars in the register. Together with the application, the applicant for the extract or the copy has to pay an administrative fee pursuant to a special legal regulation.

(3) Upon receipt, the Office shall without undue delay enter in the register any change of the particulars of an application for registration of a trade mark or any change of the particulars of a registered trade mark which follows from a final decision of the respective authority.

(4) The register is maintained in electronic form and the Office shall publish the information contained in the register in a way enabling remote access.

(5) The details of the content of the register shall be laid down in the implementing regulation.

(6) The Office shall publish the Official Journal in which the Office shall publish mainly applications for registration of trade marks or registered trade marks and any further information concerning the trade marks, or notices and general information issued by the Office, as well as public notices and important decisions.

Section 45

1) Unless otherwise provided by this Act, the Administrative Procedure Code shall be applicable for proceedings on trade marks, except for the provisions on staying of the proceedings, time limits for decision making and measures against inactivity.

2) Legal action under a special law may be brought against a final decision of the Office.

CHAPTER XI

INTERNATIONAL MATTERS

Section 46

(1) Persons who have an enterprise, permanent residency or seat in a state which is party to the Paris Convention or a state which is member of the World Trade Organisation, or persons

who are nationals of that state have the same rights as persons who are Czech nationals or who have their enterprise, permanent residency or seat in the Czech Republic; where the person is a national of a state which is not a Convention country of the Paris Convention or a member of the World Trade Organisation or where the person has an enterprise, permanent residency or seat in such a state, the rights pursuant to this Act may be granted only on condition of reciprocity.

(2) Person who does not have an enterprise, permanent residency or seat in the territory of the Czech Republic has to be represented in proceedings on trade marks pursuant to special laws.

(3) The provision of paragraph 2 does not apply to natural persons who are nationals of a member state of the European Union or of a state party to the Agreement on the European Economic Area and who are domiciled in the territory of the Czech Republic or render services in the territory of the Czech Republic, or to legal persons who have their headquarters or seat of their business activities in the territory of a member state of the European Union or of a state party to the Agreement on the European Economic Area, and who are domiciled in the territory of the Czech Republic or render services in the territory of the Czech Republic. These persons have to appoint an address for service in the Czech Republic for proceedings before the Office, to which official documents concerning applications for registration or registered trade marks will be delivered.

Application for international registration

Section 47

(1) Persons who have their enterprise, permanent residency or seat in the Czech Republic or who are Czech nationals may file an application for international registration of a trade mark pursuant to an international treaty or file an application for registration of changes concerning the international registration by way of the Office.

(2) The requirements of the application for registration with application for international registration and the application for registration of changes concerning the international registration are laid down in the implementing regulation.

(3) The applicant for registration of a trade mark with application for international registration has to pay fees pursuant to the international treaty for acts done pursuant to paragraph 1; the Office shall publish the amount of the fees as prescribed by the international treaty in the Official Journal.

Section 48

(1) The international registration of a trade mark which enjoys protection in the Czech Republic has the same effects as the registration of a national trade mark in the register maintained by the Office.

(2) The time limit for filing opposition against a registration of an international trade mark starts on the first day of the month following the month in which the trade mark was published in the WIPO Gazette of International Trade Marks.

CHAPTER XII

TRADE MARK PURSUANT TO THE LAW OF THE EUROPEAN COMMUNITIES ON THE COMMUNITY TRADE MARK

Community Trade Mark

Section 49

The application for a Community trade mark may be filed with the Office; the Office shall accord a date of filing to the application and it shall forward the application to the Office for Harmonisation in the Internal Market (trade marks and designs). The applicant has to pay the costs connected with receiving and forwarding the application; the amount of the costs is laid down in the implementing regulation.

Section 50

Conversion to the national trade mark application

(1) The Office shall proceed the request for the national proceeding on conversion of the application for registration or the application for registration of a Community trade mark to the application for registration of a national trade mark pursuant to Article 109 of the Council Regulation, if the applicant within 2 months following the delivery of the official communication

- a) pays the administrative fee pursuant to a special legal regulation,
- b) submits a translation of the request and of the documents accompanying the request and attaches the original of the request,
- c) indicates an address for service in the Czech Republic,
- d) submits the wording or the representation of the trade mark in the number of copies as prescribed in the implementing regulation.

(2) The Office shall examine whether the request admissible pursuant to Article 108 paragraph 2 of Council Regulation. The Office shall refuse the request, if it is inadmissible.

(3) The application resulting from the conversion of the application for registration of a Community trade mark shall be accorded the date of filing or the date of priority of the original application or even the seniority which was claimed under Article 34 and 35 of the Council Regulation.

(4) The Office shall register without any further requirements the application for registration resulting from the conversion of an already registered Community trade mark with the date of priority which was accorded to the Community trade mark; the Office shall publish this fact in the Official Journal.

Section 51

(1) The owner of a national trade mark the application of which was filed in good faith before or which has a right of priority dated before the accession to the European Union, has the right to prohibit the use of the Community trade mark the effects of which have been extended to the territory of the Czech Republic based on the accession of the Czech Republic to the European Union, if

- a) the Community trade mark is identical with the national trade mark and the goods and services covered by both trade marks are identical, or
- b) there is a likelihood of confusion on the part of the public because of the identity or similarity of the national trade mark and the Community trade mark and because of the identity or similarity of goods or services covered by the trade marks; the likelihood of confusion includes the likelihood of association with the national trade mark, or
- c) the Community trade mark is identical with the national trade mark or it is similar to the national trade mark, where the goods or services covered those trade marks are not identical or similar, if the national trade mark has a good reputation in the Czech Republic and if use of the Community trade mark would take unfair advantage of or be detrimental to the distinctive character or the good reputation of the national trade mark.

(2) The proprietor of the national trade mark mentioned in paragraph 1 may claim damages for the damage he suffered as a result of the use of the Community trade mark in the territory of the Czech Republic within the scope as mentioned in Section 8 paragraph 5.

CHAPTER XIII

TRANSITIONAL AND EMPOWERING PROVISIONS, REPEALS

Section 52

Transitional provisions

(1) Trade marks registered under earlier laws remain valid. Where an action for declaration of invalidity of a trade mark has been filed claiming that the trade mark was registered in breach of the law, the registrability of the trade mark shall be examined under the law as valid at the time of the registration of the trade mark in the register. However, the trade mark shall not be declared invalid if its registration is in compliance with this Act.

(2) This Act is to be applied to proceedings on applications for registration, which have not been completed before the commencement of this Act. The effects of procedural acts done in these proceedings remain unchanged and they shall be examined accordingly under this Act. Where an application filed before the commencement of this Act has deficiencies which hinder the application from being processed, the Office shall invite the applicant to remedy such deficiencies and it shall set an appropriate time limit for this purpose.

(3) Where the application was published before the commencement of this Act but the time limit for filing the opposition as set in Section 25 of this Act has not expired before the commencement of this Act, it is possible to file an opposition against the registration also under Section 7 of this Act within the prescribed time limit, however at the latest within 1 month following the commencement of this Act. Before the registration of the trade mark in the register, the Office shall examine also the fulfilment of the conditions of registrability under Section 1, 2, 5 and 6 of this Act.

(4) Where a cancellation action under Section 25 of the current law was brought before the commencement of this Act, it shall be heard as cancellation action or action for declaration of invalidity of a trade mark under the fulfilment of the conditions of this Act and with effects as laid down in this Act.

(5) Where the proceedings on cancellation of a trade mark under Section 25 paragraph 2 and 3 of the current law have not been completed before the commencement of this Act, the claimant in the cancellation action has to prove upon request of the Office the use of the earlier trade mark within the meaning of Section 13 of this Act.

(6) The request for cancellation of a trade mark from register under Section 26 of the current law may be filed within one year after the commencement of this Act.

(7) Where the collective trade mark was registered under previous laws and the present owners have not established a special legal person, they can do so within one year from the commencement of this Act. After the fruitless expiry of this time limit, the relations among the present owners of the collective trade mark shall be governed by general laws on co-ownership.

(8) The relations ensuing from trade marks registered in the register before the commencement of this Act shall be governed by this Act. However, the creation of these relationships as well as the claims ensuing from them shall be considered under the laws valid at the time of their creation.

(9) The declaration of a trade mark for famous trade mark under Section 18 of the act No. 174/1988 Coll., the Act on Trade Marks, shall remain valid for the time period laid down in Section 42 paragraph 3 of the act No. 137/1995 Coll., the Act on Trade Marks.

Section 53

Empowering provisions

The Office shall enact a decree, in which the Office shall regulate the requirements of the request for registration of assignment and transfer of the trade mark (Section 15), the requirements of the request for the entry of the change of the proprietor of the trade mark (Section 16), the requirement of the entry of the lien, enforcement of decision and execution, bankruptcy proceeding, compulsory settlement (Section 17), the requirements of the request for the registration of licence agreement (Section 18), the requirements of the application for registration (Section 19), the requirements of the observations to the application for registration (Section 24), the requirements of the oppositions against registration (Section 25), the requirements of the request for amendment or split of the application (Section 27), the requirements of the request for renewal of the registration of trade mark (Section 29), the requirements of the request for cancellation of a trade mark or for the declaration of invalidity of a trade mark (Section 34), the particulars contained in the Register (Section 44), the requirements of the application for international registration and the request for actions in the international register of trade marks (Section 47), the amount of the costs of receiving and forwarding the application for Community trade mark (Section 49) and the number of wording or representation of the trade mark (Section 50 paragraph 1 letter d)).

Section 54

Repeals

The following acts are hereby repealed:

1. Act No. 137/1995 Coll., the Act on Trade Marks in the wording of later regulations.
2. Decree No. 213/1995 Coll., Implementing the Act on Trade Marks.

PART II

Amendment of Act on Courts and Judges

Section 55

The current wording of Section 39 of the act No. 6/2002 Coll., Act on Courts, Judges, Assessors and the State Judgement Administration and on the Amendments of Some Other Acts (Act on Courts and Judges) shall be marked as paragraph 1 and paragraph 2 shall be added, reading as follows:

“(2) In the Czech Republic, the Town Court in Prague decides as the court of first instance for community trade marks under Art. 92 of the EC Council Regulation No. 40/1994 of 20th December 1993 on the Community Trade Mark.”.

PART III

ENTRY INTO FORCE

Section 56

This Act shall come into force on 1st April 2004, except for the provisions of Part I Section 2 letter c), Section 3 letter a) point 3 and Section 3 letter b), Section 7 paragraph 1 letter e), Section 11 paragraph 2, Section 46 paragraph 3, Section XII and Part II, which shall come into force on the day of the entry of the treaty on accession of the Czech Republic to the European Union into force.