

**NEW TYPES OF MARKS**  
**LAW ON INDUSTRIAL PROPERTY**  
of the Republic of Macedonia

I. INTRODUCTION

According to Article 124 of the Law, paragraph (1) “Trademark protection can be provided for a sign that can be graphically represented and ..”. Graphical representation means that the mark has to be clear, precise, comprehensive, easily accessible, lasting and objective.

The list of signs of which a trade mark may consist are listed in Article 124 (2) “*Trademark shall protect signs capable for distinguishing, in particular: words, letters, numerals, pictures, drawings, combinations of colors, three-dimensional forms, including shapes of goods or their packaging, as well as combinations of all of the above-mentioned signs.*”

But this provision doesn't mean that other types of signs are excluded since they are capable to be graphically presented, or providing that they are visually perceptible and their representation is clear, precise, easily accessible and durable.

When examining the capability of a mark in relation to its graphical representation, special attention should be paid to new types of marks.

In relation to the new types of marks identified in the document SCT/16/2 as visible signs the following signs according to the national practice are accepted:

- three-dimensional
- color marks
- slogans
- titles of films and books

Regarding to holograms, motion or multimedia signs, position marks and gesture marks, the Office has only limited practical experience and they are not accepted since their representation does not satisfy the requirement of precise representation.

Nevertheless, the application should:

- clearly state the type of the mark applied for, to be registered as a trademark (color, sound, smell,...), otherwise the mark will be only considered as a word or an image; and
- contain a mark that is clear, precise, comprehensive, easily accessible, lasting and objective.

Concerning the types of marks listed as non-visible category: sounds marks olfactory, taste or texture marks the Office has no experience.

The Macedonian law provide that a mark can be protected if it is capable to be graphically represented which includes the new types of marks. It is mentioned ahead that SOIP has limited experience in practice with this new types marks. It is for shore that there are so many open questions which are waiting to be resolved. We should invest in further developing and defining of long list of details.

## II. METHODS OF REPRESENTATION AND DESCRIPTION OF NEW TYPES OF MARKS

In relation to the methods of representation we deal in this paper only with the types of marks that Office has experience.

### 1. VISIBLE SIGNS

#### Three-dimensional marks

According to the Macedonian legislation “*three-dimensional forms, including shapes of goods or their packaging*” are signs that may constitute trademark.

Applicants are required to provide the two-dimensional presentation of the appearance of the sign and it shall be presented on the designated area in the Application Form. The shape of the good must be shown by a single perspective view. Multiple views of the shape, if submitted, shall not be published.

An indication that the mark is a three-dimensional sign should be indicated in the application form. Otherwise the application will be examined as if it was a figurative mark. A written description of the features of the mark is not required and shall not be published if submitted.

In case of the three-dimensional marks additional costs for IP office does not exist. Technically such marks are treated as a figurative marks.

#### Color marks

Applicants are required to indicate the information to the effect that the trademark is a color mark. Otherwise the application will be examined as if it was a figurative mark. A mere sample of a color and the designation of the color using the common name of the color is sufficient and the applicant is not required to refer to the international color codes. If the designation of the color is accompanied by the relevant code from an internationally recognized color identification system the Office will accept this application and the code shall also be published.

Technically such marks are treated as a figurative marks. In case of the color marks there are additional costs. Precisely, if the applicant require publication of the trademark application in color he has to pay additional cost.

### Slogans and Titles of films and books

Slogans and Titles of films and books technically are treated as a word marks and additional costs for IP office does not exist.

## 2. NON-VISIBLE SIGNS

### Sounds marks, olfactory marks, taste marks and texture or feel marks

The state Office do not have any experience with the above mentioned non-visible marks.

## III. TRADEMARK PRINCIPLES TO NEW TYPES OF MARKS

All trademark principles established by the national legislation and practice must apply to new types of marks. Nevertheless, the Macedonian practice takes into consideration also the following:

### Three-dimensional marks

The law provisions provides for the signs which consists of the product shapes and/or packaging cannot be registered as trademark if the shape results exclusively from the nature of goods themselves, or if it necessary to obtain a technical result or if they solely serve the purpose of giving value to the goods. But, the principles of distinctiveness and public order or morality as well as the issues of public interest should also apply.

Distinctiveness is the element to be sought for registration of three-dimensional trademarks, just like with other trademarks. The element of distinctiveness can be inherent, which means that the shape, *per se*, is clearly distinctive in relation to the goods or services, the protection of which is requested, and that it can be immediately recognized and perceived by the public as a mark of distinction. On the other hand, distinctiveness may be acquired through use.

### Color marks

In accordance with Article 124, paragraph 2, Trademark protection can be provided for *color combinations*, which immediately excludes the protection of a mark that simply comprises of a single color, unless it defines a specific shape. Without any additional verbal or figurative elements, such a mark, as a color on its own, cannot be protected.

*Color»per se«*: a limited number of available colors should be taken into account. Registration should be limited for reasons relating to the public interest. In general a single color has a little inherent distinctiveness. For these reasons applicants are required to provide evidence to demonstrate that the color has become distinctive in relation to the goods or services for which the registration is requested

Generally, it has to be mentioned that in order to register a trademark, the color or color combination of the mark has to be capable of distinguishing the goods or services on the market. The mark has to carry information for the consumers, which will make the goods and services distinguishable on the market, i.e. it should refer to the producer or service provider.

### Slogans and Titles of films and books

In case of Slogans and Titles of films and books the general trademark principles used in the relation with the traditional types of marks are apply.

## ***Law on Industrial Property of the Republic of Macedonia (relevant articles):***

### ***Object of trademark protection***

#### *Article 124*

*(1) A trademark shall protect a sign which may be represented graphically and which is capable for distinguishing goods or services of one undertaking from those of other undertakings.*

*(2) Trademark shall protect signs capable for distinguishing, in particular: words, letters, numerals, pictures, drawings, combinations of colors, three-dimensional forms, including shapes of goods or their packaging, as well as combinations of all of the above-mentioned signs.*

*(3) The words and letters referred to in paragraph (2) of this Article may be written in any language and alphabet.*

### ***Distinctiveness***

#### *Article 125*

*(1) A sign shall be capable for distinguishing if it gives to certain goods or services comparing them with the identical or similar goods or services, a special distinctive character.*

*(2) While establishing whether a given sign is capable for distinguishing, all circumstances shall be taken into consideration, particularly the time and scope of its past use in trade.*

**Book of Regulation on Trademark  
(Opposition Procedure - relevant article):**

***Three-dimensional signs***

*Article 8*

*(1) In case the trade mark application, contains a request for protection of a three-dimensional sign, the two-dimensional presentation of the appearance of the sign shall be presented on the designated area in the Application Form.*

*(2) In case a protection of the three-dimensional sign in color is sought, the conditions referring to the colors are identical to the conditions laid down in Article 7, paragraph 2, of this Book of Regulations.*