

Information on Trademark Opposition Procedures

Slovak Republic

Following the outcomes of 16th Session of SCT (Summary by the Chair SCT/16/8, November 17, 2006) please find enclosed a brief information on national practice concerning trademark opposition procedures.

After the trademark application is filed with the Office it is a subject of examination as to the absolute ground for refusal under **Article 2** of the Act no 55/1997 Coll. on Trademarks as amended.

Article 2

- (1) *The following shall not be recognised as a trademark:*
- a) *sign which does not conform to the requirements of Article 1,*
 - b) *sign which has no distinctive capacity,*
 - c) *sign consisting exclusively of indications or elements that serve in the trade to designate the kind, quality, quantity, purpose, value, geographical origin or other characteristics of goods or services, or, if appropriate, time of production of goods or of rendering of services,*
 - d) *sign consisting exclusively of signs or indications which have become customary in current language or have been using in established practices of trade,*
 - e) *sign consisting exclusively of the shapes of goods or of their packaging which results from the nature of goods themselves or is necessary to obtain a technical result, or gives substantial value to the goods,*
 - f) *sign which is of such a nature as to deceive the public, particularly with regard to the nature, quality or geographical origin of the goods or services,*
 - g) *sign which is contrary to public order or principles of morality,*
 - h) *sign whose use would be contrary to the obligations of the Slovak Republic under international treaties,*
 - i) *sign containing a sign of a high symbolic value, particularly a religious symbol.*
 - j) *sign applied for wines or spirits containing a geographical indication identifying wines or spirits with respect to such wines or spirits not having that origin*
- (2) *The signs referred to in paragraph 1 (b) to (d) may be accepted and registered in the Register if a natural person or a legal entity filing an application for registration (hereinafter referred to as "Applicant") proves that such sign has acquired distinctive character in relation to the goods or services for which registration is requested following the use which has been made of it on the territory of the Slovak Republic or in relation to this territory prior the date of filing of the application for the entry in the Register (hereinafter referred to as "Application").*

Article 3

- (1) *The following shall not be recognised as the trademark:*
- a) *sign identical with the trademark with the earlier priority right which has been registered for another owner for identical or similar goods or services,*
 - b) *sign identical with applied sign of another applicant with the earlier priority right provided that such sign is registered for identical or similar goods or services,*
 - c) *sign identical with a trademark registered for identical or similar goods or services that has expired under Article 15 (1)(a) if the application was filed within two years after the expiration date of the trademark; this provision shall not apply if the application was filed by the person who at the time of the expiration of the trademark thereof has been registered as the owner of the trademark or its legal successor,*

Provisions of paragraph 1 shall not apply if the owner of the earlier trademark or applicant of the identical sign with the earlier priority right gives his written consent to the registration of later sign.

If the trademark application fulfils all requirements of the Article 2 then the application is published in the Official Gazette and third party may file an oppositions against the entry of the sign in the

Register within the period of three months from this publication at the Office. The period of 3 months can not be extended. The reasons for opposition concern third party's rights only (*see Art.4*).

Article 4

(1) The sign shall not be recognised as a trademark where the Industrial Property Office of the Slovak Republic (hereinafter referred to as "the Office"), on the grounds of oppositions filed pursuant to Article 9, ascertains that it is:

- a) identical with a trademark with the earlier priority right if the trademark has been registered for similar goods or services, or confusingly similar to a trademark if the trademark has been registered for identical or similar goods and services,*
- b) identical with an applied sign with the earlier priority right provided that such sign is registered for similar goods or services, or confusingly similar to a trademark with the earlier priority right provided that such sign is registered for identical or similar goods or services,*
- c) identical with or confusingly similar to a trademark with the earlier priority right which has acquired reputation in the Slovak Republic if the use of such sign for goods and services, which are not similar to those for which the earlier trademark has been registered, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark,*
- d) identical with or confusingly similar to a sign which is registered as a trademark for identical or similar goods or services in the country or in relation to the country which is the member state of the international convention or is a member of the World Trade Organization (hereinafter referred to as "Foreign trademark") provided that the applicant of this sign is an agent or a representative of the owner of the foreign trademark for the territory of the Slovak Republic on the basis of other relation (hereinafter referred to as "Representative") and applies for registration thereof in his own name without the owner's consent,*
- e) identical with or confusingly similar to an unregistered sign which in the course of trade prior to the filing date of the application has acquired distinctive character for identical or similar goods or services of its owner and where such sign is not of a mere local significance,*
- f) identical with or confusingly similar to the trade name or its essential part, registered in the Register of Companies or a similar register for an entrepreneur who conducted an economic activity with identical or similar goods or services prior to the filing date of the application,*
- g) identical with or confusingly similar to the forename and surname or an assumed name or a portrait of a person if the entry of this sign in the Register could interfere with the rights to individual's protection,*
- h) identical with or confusingly similar to the subject matter of other industrial property right with the earlier priority right,*
- i) identical with or confusingly similar to an author's work created prior to filing date of the application where by using such sign the author's copyright could be affected.*

(2) The sign shall not be recognised as a trademark where Office on the grounds of oppositions filed pursuant to Article 9, ascertains that it is:

- a) identical with or confusingly similar to a sign which, before filing date of the application, had become well-known, following its use in the Slovak Republic or in relation to the territory of the Slovak Republic according to the international treaty, for goods or services of its owner (hereinafter referred to as "Unregistered well-known mark"), if this sign is applied for identical or similar goods or services,*
- b) identical with or confusingly similar to an unregistered well-known mark, if the use of such sign for any goods or services would indicate connection between the thus-marked goods or services and the owner of the unregistered well-known mark, and if the interests of its owner are likely to be damaged by such use.*

(3) The sign shall furthermore not be recognised as a trademark where the Office, on the basis of oppositions filed pursuant to Article 9, ascertains that it is identical with or confusingly similar to an earlier Community trademark which has a reputation in the Community, if the use of such sign for goods or services, which, however, are not similar to those for which the earlier Community trademark with a reputation has been registered, would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier Community trademark.

In addition, any person may submit an observations in the written form to the Office, before the entry of the trademark in the Register. Office takes into account the observations in proceedings leading to the decision on the entry of the trademark in the Register. The person who submitted the observations will not become a party of this proceedings. Office communicates the observations to the applicant who may comment them within prescribed period of time.

Base on observations the Office can re-examine the trademark application. Assessment of the observations is independent of the opposition procedures. (Art. 8a)

Article 8a
Observations

- (1) Before the entry of the trademark in the Register, any person may submit observations in the written form to the Office on the grounds of fulfilling the conditions of Article 2 and 3; the Office shall take into account the observations in proceedings leading to the decision on the entry of the trademark in the Register. The person who submitted the observations will not become a party to the proceedings.*
- (2) The Office shall communicate the observations to the applicant who may comment them within prescribed period of time. The Office shall inform both the applicant and the person who submitted the observations about the results of the assessment of observations.*

The main advantage of opposition procedures before the registration of a trademark is a better protection of a third party`s rights and higher legal certainty of the applicant.

An oppositions against trademark registration are communicated to the applicant for his/her comments. If the applicant fails to make a comments regarding the oppositions within the prescribed time period, the Office shall suspend the application proceedings to the extent of the oppositions filed. This is so called “*shortened procedure*”. If the applicant does not submit a comments then the Office does not examine the reasons for oppositions.

When the applicant submits the comments regarding the oppositions within the prescribed time period, the Office shall examine and decide on oppositions. If the oppositions are found justified, then the application is refused (entirely or partly) otherwise the submitted oppositions are refused.