

II. Grounds for refusal of registration of all kinds of trademarks

The grounds for refusal of protection are laid down taxatively in section 4, Act No. 441/2003 Coll., on Trademarks.

The following shall not be registered:

- a) a sign which is not capable of serving as trademark 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 authorization to registration of the competent authorities,
- j) a sign which contains badges, emblems and escutcheons other than those mentioned in Article 6ter 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.

The above given grounds are examined ex officio by the Industrial Property Office of the Czech Republic within the examination procedure. The relevant legal regulations are published on the website of the Office, in Czech as well as in English.

The basic criteria to determine the registrability of the trademark are graphical representability and the capacity of a trademark to distinguish the goods and services of one undertaking from

the goods and services of other undertaking. Meeting the condition of graphical representability is an absolutely elementary prerequisite of an applied for mark to be registered as a trademark. "

„A trademark 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 1, Act. No. 441/2003 Coll., on Trademarks)

The strictest criteria are applied on the registration of generic names and describing denominations. Such signs may be registered provided that the applicant has proven that the mark had acquired the distinguishing capacity.

„A sign mentioned in Section 4 letters b) to d) can be registered in the Register, when 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 5, Act No. 441/2003 Coll., on Trademarks)

Acquirement of the distinguishing capacity may be demonstrated by submitting of credible documents, complying with three following cumulative conditions: A relevant mark has to be present on these document in the to be registered resemblance, it has to refer to the respective cope of the protection sought and it has to refer to the subject of the applicant. Among such most frequent documents may be included invoices, delivery notes, call cards and various advertising and promotional bulletins and leaflets, however, the last mentioned documents play rather supportive than decision making role.

In overwhelming majority of the cases are the absolute grounds of refusal applied in the cases that do not demonstrate any other distinctive characters, and therefore may rise doubts if such a sign would enable to an average consumer an orientation within the market with similar goods or services. The most important criteria to assessment of level of distinctive character of a given sign is the general impression of it, which such a sign would awake in public in respect to applied for goods and services. More moderate criteria are applied to determination of registrability of laudatory signs.

When a mark consisting of words, a slogan, is being applied for registration, the IPO CZ requires to a great extent a proof that the distinguishing capacity of the trademark has been acquired. The slogans may be included between the signs the distinguishing capacity of which is more difficult to proof, however, the more strict criteria as to other types of non-distinctive signs are not applied to them.. As the examples of non-distinctive trademarks may be mentioned for example: „POTĚŠENÍ PRO KAŽDĚHO“ (“JOY FOR EVERYONE”), „Domácí lékař od A do Z“ (“Family doctor from A to B”), „S námi je to hračka“ (“It is a pleasure with us”).

Another special type of verbal marks the IPO CZ meets in its practice are composite trademarks. The substantive factor to examined in respect to the distinguishing capacity and absolute grounds of refusal is the level of distinctiveness of the mark. The compound mark has to provide the average consumer not only with the information regarding the technical operation of the product and its qualities but it also has to manifest a level of distinctiveness not permitting doubts about the origin of the goods or services the trademark would be affixed to. Examples of non-distinctive trademarks: PROFITAXI, SOJAMILK, hypocredit.

As for three-dimensional trademarks, may we from the up to now established practice assume that registration by the IPO CZ will be performed provided that these marks have the requested distinctive ability, their shape does not imply from the nature of the product itself, does not give

the product substantial utility value, and the shape is not necessary condition to reach the technical outcome. Graphical representability, which plays substantial role during their assessment, has to be sustained by submitting several bi-dimensional views presented in frame of one graphical reproduction. Under the most frequently three-dimensional trademarks applied by the IPO CZ may be included the characteristic shape of a bottle.

Among non-traditional types of trademarks may be included marks consisting of a colour or colour combination as such. Compared to three-dimensional signs, the IPO CZ has significantly less experience with this kind of signs. To meet the requirements for the registration, the IPO CZ requires determination of a colour by an internationally approved identification code. As an average consumer is not used to perceive a colour as determining commercial origin of goods or services, the IPO CZ invariably requires the approval of acquirement of distinguishing capacity of sign. No trademark represented solely by a colour or by a colour combination has been registered by the IPO CZ so far. An application consisting of a red colour in class 38 (telecommunication) has already been published in the Official Journal of the IPO CZ, but the registration procedure has not been finished lawfully yet.

The IPO CZ has no experience with other types of trademarks such as sound, scent, motion, multimedia, posture or gesture or hologram marks so far. Nevertheless, on such marks the condition with respect to graphical representability and distinguishing capacity of goods or services from one undertaking from goods or services from other undertaking would be applied as well.

f) a sign which is contrary to public policy or to accepted principles of morality

The above mentioned absolute ground of refusal is examined by the IPO CZ particularly in cases of signs, which might appeal to the public vulgar or scandalous, while the goods or services the mark would be affixed to must always be taken into account. I.e. signs that would contain names of significant religious or political personalities would be assessed in different way in connection to e.g. charity services than to goods such as alcohol and tobacco.

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

Deceiveness regarding the information regarding the geographical origin implicated within the mark has been observed by the Office particularly in relation with wines and liquors. Deceiveness in respect to other goods and services may be used by the Office in cases of strictly untrue indication contained in the mark. Only in trademarks of goods „produced in line with legal regulation on ecological agriculture and production“ may contain words „EKO“ and „BIO“.

i) a sign which contains signs protected by virtue of Article 6ter of the Paris Convention without the authorization to registration of the competent authorities

When performing the examination on registrability, the IPO CZ uses a database containing all signs virtue of 6ter of Paris agreement. When a mark similar to an applied for mark is found in the database, the IPO CZ applies this ground for refusal.

k) a sign which contains signs of high symbolic value, mainly religious symbols

Hereunder covered grounds of refusal include not only the religious symbols, but also symbols of various significant charities and funds, cultural and educational associations or names

of historically important personalities. As highly symbolic are considered as well signs the registration of which might be seen as controversial, offensive or insufficiently respectful to cultural heritage, national or religious sentiments, or as dispraising and defaming cultural, national or religious symbols. Should these grounds of refusal be applied, will the registration by the IPO CZ be most likely refused.

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

When performing the examination registrability, the IPO CZ uses a database, containing all signs protected within out territory according to bilateral agreements of the Czech Republic with other countries, and signs excluded from registration according to legal regulations, such as the symbol of the Olympics or national emblems of the Czech Republic. Should such a sign similar to a sign applied for registration be found in the database, the ground for refusal would be applied.

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

The ground of refusal mentioned above was newly incorporated into the act on Trademarks in 2003. This condition is applied „ex officio“ by IPO CZ only in cases of obvious mala fide registration, when the applicant must have known that the application infringes rights of third party. This ground of refusal is more likely applied in opposition procedure as a mean of private law than within the public law.

In Prague, February 11, 2009