

**SUBMISSION OF THE STATE OFFICE OF INDUSTRIAL PROPERTY OF THE
REPUBLIC OF MACEDONIA
SOIP**

GROUNDS FOR REFUSAL OF TRADEMARK REGISTRATION
Office practice

This submission contains the absolute and relative ground of refusal the registration of the trademark applications, according to the Macedonian Industrial Property Law and examples of the trademark examination practice in the Office.

NOT ELIGIBLE FOR PROTECTION:

1. Color marks

A color on its own cannot be protected as a trademark. Color is just an additional element of the mark, which might contain a certain shape, it can be figurative or part of a complex design or form.

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.

Example:



This color mark(violet) has been filed in respect of class 30, for: cocoa, chocolate, chocolate-based beverages.

Color “per se” A single color mark, as mentioned above, can not be protected, because of the lack of distinctiveness, with the exception of those cases, when the mark has already acquired a high level of distinctiveness **through its practical use**, prior to the filing of the trademark application. We should stress that it was filed for other product than “MILKA” chocolate and different applicant, and has not acquired distinctiveness. The application has been refused on the ground of lack of distinctiveness.

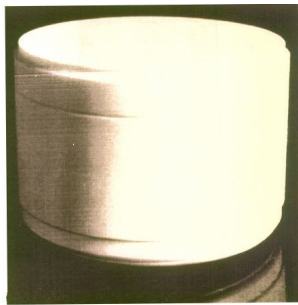
Three-dimensional marks

Every specific mark has to be examined individually and this has to be done always in relation to the specific product or service.

The packaging of products, for practical purposes, is usually limited to the simplest geometric shapes, because they are easy to pack and easy for storage. Such shapes have functional character and usability, and therefore it is necessary for them to remain available to be used by all producers and nobody can acquire a monopoly over such shapes.

Examples:

Two applications for three-dimensional mark: filed in respect of class 3 (example “A”) and for class 29(example “B”)



A



B

In both of the applications “A” and “B” the functional character dominates and have no distinctive characteristics in relation to the goods the protection of which is requested and should remain available to be used by all producers of those product. None of them have acquired distinctiveness. Because of aforementioned grounds both application have been refused.

Plant variety name

Example, “**NS 26**” is a mark claimed for class 31 with a specification for a sunflower seed. Although the names NS26 might look like fanciful, this is name of plant variety after all, and is non-distinctive and incapable for distinguishing the products on the market.

The name that is given to a plant variety is the only name or mark, under which that particular variety can appear on the market and it should remain freely available to be used by other undertakings on the market.

Application has been refused.

Anyhow, although these are names of variety and have to remain freely available for the competition, individual undertakings on the market can have their own marks, under which they will sell certain specific species, which will be sufficiently distinctive, in order to be registered as trademarks.

Name or abbreviated name of a country

Mark which contains the name or abbreviation of that name, the coat of arms, flag, emblem or other official symbol of the Republic of Macedonia, as well as their imitations will be registered only with authorization from a competent state administrative body;

Example:



The mark in color is comprised of several figurative elements, as well as of a verbal part, which amongst others, also contains the name MACEDONIA. The name of the country in this specific case has a significant importance, if one considers the mark as a whole. The permission to use the name wasn't obtained. The application was refused.

Cultural heritage

A trademark shall not protect a sign which contains or imitates name, shape or other recognisable part of protected cultural inheritance of the Republic of Macedonia, except with authorization from a competent state administrative body.

These goods are of public interest and they have to remain freely available to be used by all undertakings on the market, and therefore nobody can have a monopoly over their use.

Examples:



Menada from Tetovo region in Macedonia is unsuitable for distinguishing the goods on the market.

Application has been refused.

If sufficient number of distinctive elements are added, the mark in its entirety may become distinctive and eligible for trademark registration. Any way the authorization from a competent state administrative body has to be obtained.

Generic terms

According to this provision, marks that are comprised of, or represent a generic indication in relation to the products and services for which protection is being sought, are excluded from trademark registration and **they can never acquire the required distinctiveness**. A “generic” mark is a common descriptive term for a certain product or service and do not serve the purpose of identification of the source and are freely available to be used by the competition.

Example 1:

The word mark “**Ayvar**” was filed in respect of class 29, but it is generic term indicating a product made of red peppers, preserved vegetables;

This product is typical and famous in the whole Balkan region, and the name is generic term, referring to a certain type of product, and therefore is ineligible for registration.

This application, in lack of distinctiveness has been refused .

Example 2:

The word mark “**FOLIC ACID**” was filed in respect of class 5 is generic term and indicating the type of product only, make it ineligible for registration. This application, in lack of distinctiveness has been refused .

Foreign words

There are many foreign words in the Macedonian language, especially in the computer terminology, mainly English, which have been accepted as they are in everyday speech. Quite often, they are written in Cyrillic, according to their English pronunciation. Therefore, the examination of an application has to include an examination of the phonetic transcription, i.e. the link between the sound of the mark and the meaning of the original English word. For example, if the original word is “**Play Station**”, one might file an application using Cyrillic letters.

Example: “**PlеiStеj{n**”, which, in fact, sounds exactly the same like the original English word “**Play Station**”. The word PlеiStеj{n is nowhere to be found in Macedonian dictionaries, which means it has no meaning in Macedonian language, but, this does not mean that it is distinctive and eligible for registration. This mark is descriptive and should remain available to be used by all producers. The mark has been refused .

Examples related to descriptive terms

Type

When a single word on its own, or in a combination with another one that describes the product or service refers to the type, it should remain freely available to be used by all traders on the market.

Example:

The word mark “**PaprikaMayonnaise**” was filed in respect of class 30, mayonnaise (containing paprika), and it is descriptive, because it describes the product. The words that make up the mark are descriptive and to be found in a dictionary, and the fact that the words are written together and this newly formed word can not be found in a dictionary, does not make the mark distinctive, and eligible for registration.

The trademark application has been refused.

Quality /kind

Example 1:

No 1 in Air Conditioning

The mark “No 1 in Air Conditioning” has been filed in respect of classes 11 (air conditioning apparatus) and 37 (installation services), is not eligible for trademark registration first of all because it indicates exclusively the kind of goods or services and their purpose (air conditioning) and it should remain available to be used by all producers and nobody can acquire a monopoly over such term. Second ground that make this mark ,not eligible is expressions: ”No1”, which will be perceived by the public, as an indicator of the quality of products and services, more specifically that they are of top quality, whereas such terms should also be available for all other traders on the market and can not be put out of use, by registering them to a single right-owner.

This application, in lack of distinctiveness has been refused .

Example 2:

The mark “YPGURT PLUS” has been filed in respect of classes 29 (edible oils and fats.....) It contain word YOGURT that indicate the kind of product is not distinctive and is not capable for distinguishing of the products. Furthermore, the protection was sought for the products other then yogurt which can confused the consumer in regard of content of the product. And, the mark contains as well the word “PLUS” that may serve to designate the quality of the products, namely that product has special quality or contains other additional substance that make its better.

This application, because aforementioned grounds has been refused .

Example 3:

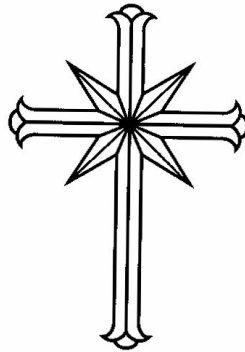
**ЕУРО
БИНГО**

The transliteration of the mark in Latin characters is like “EURO-BINGO”, has been filed in respect of class 36 (lottery, organizing lottery.....) and 41 lottery games

This mark is descriptive, consisting of two words BINGO, common for indication of certain cervises and EURO may serve to designate that the characteristics of the services is in a European style or that this game is organized widely in Europe. In lack of distinctive elements and possibility for misleading the user of the services this application has been refused.

A trademark shall not protect a sign which contains religious symbols or imitations thereof.

Example:



The trademark application has been filed for the mark that is comprised of cross which is the symbol of the Christian religion. The use of this mark for commercial purposes is contrary to the morality and is sufficient for the mark to be considered as an insult and therefore it is ineligible for trademark registration. This application has been refused.

Geographical indication

The application of a mark, which consists entirely of a geographical indication will be refused and not registered, even if it is believed that the mark does not mislead the consumer with regards to the origin of the product.

Example:

- **“LIVANJSKI SIR” or “LIVANJSKI CHEESE”**, a word mark filed in respect of class 29, for cheese. The cheese from Livno (Bosnia and Herzegovina) also has a great reputation for its quality and characteristics. The geographical names are collective right of the producers or service providers of a specific geographic area. And nobody can have exclusive right on its use. The registration of the trademark application was refused, because, the mark is descriptive and it also represents a geographic origin, which makes it non-distinctive and incapable of distinguishing traders on the market.

A trademark shall not protect a sign which contains or consists of a geographic sign which serves to signify **wines** or other strong alcoholic drinks, if the reported sign refers to wines or alcoholic drinks which are not from that geographical area.

Example:

The word mark “**cran cru**” was filed in respect of class **33** wine and spirits. It was filed by Macedonian applicant. The term “grand cru” is a traditional name for the wine from specific region. Still it is part of list of the protected terms for the wines from France i.e. Luxemburg it mislead the consumer with regards to the origin of the product and is ineligible for trademark protection.

The application has been refused.

Flag or emblem

Mark which contains a national coat of arms or other public coat of arms, flag or emblem, name or abbreviated name of an international organization, as well as imitations thereof, according to Article 6-ter of the Paris Convention, except with authorization from the competent authority.

Example 1 :

The trademark application was filed by Mladinski evro-atlanski forum for classes 36, 41 and 42



The mark contains imitation of NATO emblem (star), and permission for its use has not been obtained.

The application has been refused.

Example 2 :

The trademark application was filed for figurative mark containing verbal part “Alamos Rent a car” for classe 39



The mark contains imitation of European Union flag, and permission for its use has not been obtained.

The application has been refused.

Likelihood of confusion

Trademark may not protect a sign which is identical with or similar to an earlier trademark, filed or registered by another right-owner designating the same or similar kind of goods or services which would create confusion at the average consumer, including the possibility of association to earlier filed for or registered trademark.

Existence of similarity in only one of these aspects can be sufficient to cause confusion among average consumers.

The example given below is such a case:

Example 1:



An application for trademark registration was filed for figurative mark containing verbal part "LIVIA" for the products of the class 3, that means that protection was

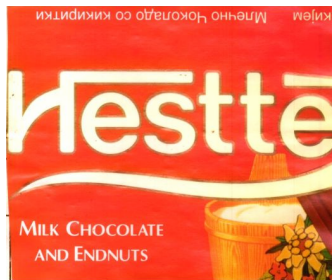
sought for the same product as original, i.e. "NIVEA" the prior registered trademark

Examining the marks presented, the Office has concluded that considerable visual and conceptual similarity exists, i.e. similarity in the arrangement of the elements, which constitute the marks, as well as similarity in color.

And vice versa, it should be stressed that even slight similarity in all of the different aspects could lead to a possibility of confusion.

The application was refused.

Example 2:



An application for trademark registration was filed for figurative mark containing verbal part "HESTTE" for the products of the class 30, that means that protection was sought for the same products as original, i.e. "NESTTLE" the earlier registered trademark.

Examining the mark presented, the Office has concluded that considerable visual and conceptual similarity exists, i.e. similarity in the arrangement of the elements, which constitute the marks.



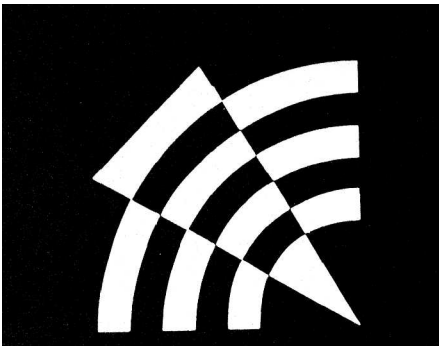
Even slight similarity in all of the different aspects, the mark "HESTTE" taken in consideration the mark in its entirety, could lead to a confusion and misleading the consumers in regards of the originating of the product.

The application was refused.

Example 3:



An application for trademark registration was filed for figurative mark, class 9



Office has concluded that strong similarity exists, almost identity of the two marks, i.e. it looks like a mirror presentation of the same mark. Furthermore that protection was sought for the same products class 9, as original, i.e. the prior registered trademark.

Both mark are so similar that might create confusion at the average consumer, including the possibility of association to earlier filed for or registered trademark. The application was refused.

Example 4:



An application for trademark registration was filed for figurative mark containing verbal part "VEGETAM" for the products of the class 30, spices, that means that protection was sought for the same products as original, i.e. "VEGETA" the prior registered trademark.



Examining the marks presented, the Office has concluded that considerable visual and conceptual similarity exists, i.e. similarity in the arrangement of the elements, which constitute the marks, filed by another right-owner designating the same kind of goods, would create confusion at the average consumer, including the possibility of association to earlier filed for or registered trademark. The application was refused.