

POSSIBLE AREA OF CONVERGENCE No. 1 NOTION OF COUNTRY NAME

At least for the purposes of examination of marks, and unless the applicable law specifies otherwise, a country name may cover: the official or formal name of the State, the name that is in common use, translation and transliteration of that name, the short name of the State, as well as use of the name in abbreviated form and as an adjective.

The Trademarks Act in Croatia does not contain specific provision that prohibits the registration of country names. Croatia may support the definition of country names as set out in possible Area of convergence no. 1. for the trademark examination purposes.

POSSIBLE AREA OF CONVERGENCE No. 2 NON-REGISTRABLE IF CONSIDERED DESCRIPTIVE

At least for the purposes of examination, trademarks consisting solely of a country name should be refused where the use of that name is descriptive of the place of origin of the goods or services.

According to the Article 5 (1) point 3. of the Trademarks Act the trademarks that consist exclusively of the signs or indications which may serve in trade to designate the kind, quantity, quality, intended purpose, value, geographical origin, or the time of production of the goods or of the providing of services, or designate their other characteristics shall not be registered. Trademarks consisting solely of a country name may be considered as indications of geographical origin of goods or services and therefore refused on the grounds of descriptiveness. When assessing descriptiveness the examiner should consider whether the relevant public associates the geographical term with the goods or services applied for protection, or if it could be used as geographical indication in relation to such goods and/or services in the future (according to the judgment delivered by ECJ in the “Chiemsee” case, C-108-109/97).

Examples of Croatian Office practice:

Trademarks consisting solely of a country name:

RUSSKAYA (Z20031022) applied for goods in class 33 (alcoholic beverages, except beers; vodka, spirits). The sign is an adjective with the meaning “Russian; of or relating to Russia”. The Office concluded that the sign was descriptive since it would be perceived by the consumer as being the indication of the geographical origin of the goods in class 33. Consequently the sign was refused.

Trademarks consisting of country names and other elements:

MOROCCANOIL (Z20131834) applied for goods in class 3 (skin and hair care preparations; shampoos). The sign consists of the indication of the origin of the products (Moroccan) and the kind of product. It was refused on the grounds of descriptiveness.

RUSSIAN STANDARD (Z20110578) applied for goods in classes 25, 30, 32, 33, 35, 36, 42. The Office decided that the consumer will establish a link with the quality and certain characteristics of the goods and services. The sign was refused on the grounds of descriptiveness.

Montenegro Lines (IR906775) applied for goods and services in classes 12, 25 and 39. The Office concluded that the sign as a whole informs the consumer of the geographical origin of the goods and services and it was refused.

FloraHolland (IR958204) applied for goods and services in classes 31, 35 and 39. The sign was found descriptive in relation to the goods and services and it was refused.

POSSIBLE AREA OF CONVERGENCE No. 5 INVALIDATION AND OPPOSITION PROCEDURES

The grounds for refusal described in possible areas of convergence No. 2, 3 and 4 above should constitute grounds for invalidation of registered marks, and where the applicable law so provides, also grounds for opposition.

According to the Trademark Act, Article 49(1), the request for invalidity of a registered trademark may be based on the absolute grounds for refusal, including non-distinctiveness, descriptiveness or deceptiveness. It is not possible to file an opposition against the registration of a trademark based on absolute grounds. There is a possibility for any interested third party to submit a written opinion concerning the reasons for refusal of the application under absolute grounds, within a period of three months from the date of publication of the application for the registration of a trademark.

POSSIBLE AREA OF CONVERGENCE No. 6 USE AS A MARK

Appropriate legal means should be made available for interested parties to prevent the use of country names if such use is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services and to request the seizure of goods bearing false indications as to their source.

The several national laws enable interested parties to protect from misleading or deceptive use of country names or indications of source:

The Consumer Protection Act of 2014 (as amended) contains provision to prevent the use of geographical origin indications that misleads or deceives the consumer as to the geographical origin or a quality of a product (Article 33(3)2) The officials of Market Inspection are authorised to investigate and record infringements Article (138(1)43.)

The Merchandise Act of 2008 (as amended) contains provisions on unfair competition including *inter alia* the labelling or describing the goods that is likely to deceive the public as to the geographical origin or quality of goods (Article 63, Article 64(1)). The officials of Ministry of finances are authorised to investigate and record infringements and they are in charge to issue the measures to prohibit the commercial activities with regard the infringed goods (Article 8 (1)). The merchandiser or trade chambers or associations whose interest are threatened or infringed may request the damages claim in the court proceedings (Article 65)

The Act on Prohibited Advertising of 2009 contains provision on misleading advertising (Article 4) and the criteria for assessing misleading advertising that includes *inter alia* geographical origin of advertised product (Article 5). The authorised bodies that represent the interest of merchandisers' association may request the cessation of misleading advertising before the commercial court (Article 7.)

The Act of 2016 on the Implementation of the Regulation (EU) no. 952/2013 of the Union Customs Code contains provisions on the misdemeanours with regard the origin of goods in trade and preferential origin of goods in trade (Article 63(1) 8.-9.)). The customs inspectors are authorised to investigate and record infringements