

### Serbia adopts a new Law on Trademarks

In adopting the new Law on Trademarks, the Republic of Serbia has continued to harmonise its domestic regulations in the field of intellectual property in accordance with European Union Directives. Further information on harmonisation is available [here](#) and [here](#).

The Law on Trademarks introduces quite a few reforms to the national trademark protection system, however on this occasion, we will highlight those that we found to be particularly interesting.

#### 1. *The Appearance (Representation) of the Sign*

The Law on Trademarks no longer dictates that a trademark can only consist of a sign that is capable of being represented graphically. This opens the door to possibilities offered by modern technologies. A trademark can now consist of any signs, which can be represented in any form, in any manner that renders them capable of being represented in the Trademark Register, that is, which enables the public and competent authorities to clearly and precisely determine the subject matter of the protection.

In light of these new developments, we anticipate applications for entirely new types of trademarks, such as sound trademarks, motion picture trademarks, multimedia trademarks, etc.

#### 2. *Opposing the Registration of a Trademark*

Certainly, one of the most significant innovations that the new Law on Trademarks has brought is the **introduction of the opposition procedure**, which has existed in the trade mark protection systems of European States for years.

The purpose of the opposition is to give interested parties (more precisely, the holder of an earlier right) an opportunity to oppose the registration of a certain trademark, through the established legal procedure, if they consider that the registration in question threatens or violates their rights and interests.



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Of course, it is not possible to simply file an opposition on any grounds, since the Law on Trademarks stipulates that the grounds invoked must correspond to either:

- **relative grounds** for refusal of registration, which are exhaustively enumerated in the Law, for example, the disputed trademark is identical to an earlier trademark for the same type of goods or services or it infringes on copyright, etc. or
- **special grounds** for refusal of registration concerning the authorization granted to a company (that is already registered in a relevant register) to prevent the registration of a trademark that is identical or similar to the name or a substantial part thereof of that particular company (the opponent) on condition that the goods and services of the opponent are identical or similar to the goods and services that are the subjects of the trademark application.

An opposition must be filed within a period of three months following the date of publication of the trademark application in the Intellectual Property Gazette, otherwise the Intellectual Property Office will determine it to be inadmissible. If during the course of the proceedings it is shown that the accepted opposition has merit, the opposed trademark registration application will be dismissed.

### 3. *Exhaustion of Intellectual Property Rights and Parallel Imports*

The national exhaustion regime, about which we previously wrote in 2013 after it was introduced with the aim of preventing parallel imports [https://tsg.rs/wp-content/uploads/2013/11/57\\_English.pdf](https://tsg.rs/wp-content/uploads/2013/11/57_English.pdf), has now been abolished, in other words, **we have reverted back to the international exhaustion regime.**

Almost seven years since it was incorporated into the Republic of Serbia's legislation, the national exhaustion regime has created far too much controversy in practice, both for reasons related to its conflict with the rules of free trade and competition protections (namely, exclusive/sole distributors

were given control over the sale of goods in the domestic market), and for reasons related to the incongruous prevention of parallel imports at the border given that customs authorities, in accordance with the powers conferred by the regulations governing customs measures for the protection of intellectual property, were not authorized to seize authentic goods, that is, goods that were manufactured with the consent of the right-holder, but were solely authorised to seize counterfeit and pirated goods.

Hence, taking into account these problems and controversies, as well as the fact that the Republic of Serbia's European path inevitably leads to a single market within the European Union, the new Law on Trademarks had no option but to reinstate the international exhaustion regime, according to which the trademark holder is not entitled to prohibit the use of the trademark in relation to goods bearing the trademark, which they or a party with their consent have released into free circulation **anywhere in the world**.

#### *4. The Holder of an Exclusive License May Now Bring Proceedings for Trademark Infringement*

Within the ambit of civil law protection, the new Law on Trademarks introduces an interesting remedy according to which, **the holder of an exclusive license can, provided that they have informed the trademark holder of the trademark infringement, bring proceedings for the infringement if the trademark holder does not himself bring infringement proceedings within a period of thirty days of having received a formal notice.**

This remedy indisputably works in favour of local importers and dealers, given that foreign principals (manufacturers) are for the most part not interested in undertaking legal proceedings themselves and leading the battle against intellectual property right infringements in the Republic of Serbia (to them an unfamiliar battle ground), at the same time they were reluctant to surrender these powers to local partners (who in fact have a primary interest in preventing intellectual property right infringements). Consequently, in practice a “vacuum” was often created due to a lack of communication and co-ordinated action, which was known to be exploited by unfair competitors for their own needs and to develop

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businesses through the misuse of trade marks belonging to others.

The new Law on Trademarks was published in the RS Official Gazette No. 6/2020 and entered into force on the 1st of February 2020.

For all questions regarding the new Law on Trademarks, and the trade mark system in the Republic of Serbia in general, you can contact us at: [predrag.groza@tsg.rs](mailto:predrag.groza@tsg.rs).

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